

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION

Petitioner

v.

IPR LICENSING, INC.

Patent Owner

U.S. Patent No.: 8,380,244

Filed: November 9, 2009

Issued: February 19, 2013

Title: Dual Mode Unit for Short Range, High Rate and Long Range, Lower Rate
Data Communications

**MOTION FOR JOINDER UNDER 35 U.S.C. 315(c) AND 37 C.F.R. §§ 42.22
AND 42.122(b) TO RELATED *INTER PARTES* REVIEW IPR2014-00525**

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Microsoft Corporation (“Microsoft”) respectfully submits this Motion for Joinder, together with a Petition for *Inter Partes* Review of U.S. Patent No. 8,380,244 (the “Microsoft Petition”) filed contemporaneously herewith. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Microsoft requests institution of an *inter partes* review and joinder with the *inter partes* review in *ZTE Corporation v. IPR Licensing, Inc.*, IPR2014-00525 (the “ZTE IPR”), which was instituted on September 17, 2014 and concerns the same patent. Microsoft’s request for joinder is timely. The Microsoft Petition is also narrowly tailored to the same claims, prior art, and grounds of unpatentability that are the subject of the ZTE IPR. In addition, Microsoft is willing to streamline discovery and briefing. Microsoft submits that joinder is appropriate because it will not prejudice the parties to the ZTE IPR while efficiently resolving the question of the 244 Patent’s validity in a single proceeding.

II. STATEMENT OF MATERIAL FACTS

1. In March 2013, IPR Licensing, Inc. and several other InterDigital entities filed amended complaints against Nokia Corporation, Nokia Inc., and ZTE in the District of Delaware, alleging that each defendant infringed the 244 Patent. *See InterDigital Commc’ns Inc. v. ZTE Corp.*, Case No. 13-cv-00009, D.I. 25 (D.

Motion for Joinder to Related *Inter Partes* Review of U.S. Patent No. 8,380,244 Del.); *InterDigital Commc'ns, Inc. v. Nokia Corp.*, Case No. 1:13-cv-00010, D.I. 15 (D. Del.).

2. On March 21, 2014, ZTE filed a petition for *inter partes* review (the “ZTE Petition”) requesting cancellation of the claims of the 244 Patent asserted against Nokia Corporation, Nokia Inc., and ZTE in the district court cases. *ZTE Corporation v. IPR Licensing, Inc.*, IPR2014-00525, Paper 1 (P.T.A.B.).

3. On April 25, 2014, Microsoft’s subsidiary, Microsoft Mobile Oy, acquired Nokia Inc.

4. On September 17, 2014, the Board instituted ZTE’s IPR on the unpatentability of claims 1–8, 14–16, 19–29, 36–38, and 41–44 of the 244 Patent as obvious over U.S. Patent No. 6,243,581 to Jawanda (“Jawanda”), the General Packet Radio Service Standards (“GPRS Standards”), and the IEEE 802.11 Standard. *ZTE Corporation v. IPR Licensing, Inc.*, IPR2014-00525, Paper 19 (P.T.A.B.).

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Board has authority under 35 U.S.C. § 315(c) to join a properly filed second *inter partes* review petition to an instituted *inter partes* review proceeding. 35 U.S.C. § 315(c). A motion for joinder must be filed within one month of institution of the original *inter partes* review. 37 C.F.R. § 42.122(b). In deciding

whether to exercise its discretion, the Board considers factors including: (1) the reasons why joinder is appropriate; (2) whether the new petition presents any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See Macronix Int'l Co. v. Spansion*, IPR2014-00898, Paper 15 at 4 (Aug. 13, 2014) (quoting *Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (April 24, 2013)).

B. Microsoft's Motion for Joinder is Timely

This Motion for Joinder is timely because it is filed within one month of the September 17, 2014 institution of the ZTE IPR. *See* 37 C.F.R. § 42.122(b). The time periods set forth in 37 C.F.R. § 42.101(b) do not apply to the Microsoft Petition because it is accompanied by this Motion for Joinder.¹ *See* 37 C.F.R. § 42.122(b); *Samsung Elecs. Co. v. Va. Innovation Scis., Inc.*, IPR2014-00557, Paper 10 at 15 (June 13, 2014).

C. The Factors Weigh in Favor of Joinder

Each of the four factors considered by the Board weighs in favor of joinder. As discussed below, joinder of the Microsoft Petition will not enlarge the scope of the ZTE IPR and will not negatively impact the ZTE IPR schedule, but a decision

¹ As set forth in the Microsoft Petition, however, the time period set forth in 37 C.F.R. § 42.101(b) and 35 U.S.C § 315(b) has not expired for Microsoft.

by the Board not to join could severely prejudice Microsoft. Thus, joinder is appropriate and warranted.

1. Joinder is Appropriate

Joinder with the ZTE IPR is appropriate because the Microsoft Petition involves the same patent, challenges the same claims, and is based not only on the same grounds and combinations of prior art that were submitted by ZTE, but also relies solely upon the same grounds on which the Board has already instituted *inter partes* review. In substance, the Microsoft Petition is virtually identical to the ZTE Petition, and contains only minor differences, as explained below.

First, the Microsoft Petition restructures some of the arguments presented in the ZTE Petition to emphasize certain points and does, in some limited instances, add citations to evidence already of record to support the invalidity arguments. The limited additional invalidity citations fall into three categories: (i) in Section V of Microsoft's Petition, Microsoft provided additional citations to parts of the GPRS Standards that support its positions regarding the PDP Context, (ii) in certain instances where the ZTE Petition cited only the declaration of Dr. Bims, Microsoft added the citations to the evidence that Dr. Bims referenced in the cited testimony, and (iii) in Section V, a single citation to Patent Owner's expert's testimony from a hearing before the International Trade Commission was added to support the same obviousness argument presented by ZTE. The claim charts in the

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