

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INC.,
Petitioner,

v.

BANDSPEED, INC.,
Patent Owner.

Case IPR2015-00316,
Case IPR2015-01581
Patent 7,477,624 B2

Before BART A. GERSTENBLITH, DAVID C. McKONE, and
PATRICK M. BOUCHER, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and Grant of Motion for Joinder
37 C.F.R. § 42.108
37 C.F.R. § 42.122(b)

INTRODUCTION

In IPR2015-00316, Marvell Semiconductor, Inc. (“Marvell”), MediaTek Inc., and MediaTek USA, Inc. (collectively, “MediaTek petitioners”) filed a Petition (Paper 1, “MediaTek Pet.”)¹ to institute *inter partes* review of claims 9–12 and 21–24 of U.S. Patent No. 7,477,624 B2 (Ex. 1001, “the ’624 patent”). Bandspeed, Inc. (“Patent Owner”) did not file a preliminary response. Marvell and Patent Owner settled and filed a Joint Motion to Terminate as to Marvell (Paper 9) on June 2, 2015, which we granted on June 10, 2015 (Paper 11). We instituted an *inter partes* review of claims 9–12 and 21–24 on June 11, 2015 (Paper 12, “Dec.”).

On July 13, 2015, in IPR2015-01581, Qualcomm Inc. (“Qualcomm”) filed a Petition (IPR2015-01581, Paper 1, “Qualcomm Pet.”) along with a Motion for Joinder (IPR2015-01581, Paper 2, “Mot. for Joinder”), seeking to join IPR2015-01581 to IPR2015-00316. On August 20, 2015, Patent Owner filed an Opposition to the Motion for Joinder (IPR2015-01581, Paper 8, “PO Opp.”). On August 31, 2015, Qualcomm filed a Reply to Patent Owner’s Opposition (IPR2015-01581, Paper 10, “Reply”).

While the parties were briefing the Motion for Joinder, the MediaTek petitioners settled with Patent Owner and the parties to IPR2015-00316 filed a Motion to Terminate (Paper 17) on August 5, 2015. On September 17, 2015, we granted the Motion to Terminate as to the MediaTek petitioners, but not as to Patent Owner. Paper 20, 4. We vacated the Scheduling Order (Paper 13) and stated that we would revisit the Motion to Terminate as to Patent Owner after ruling on the pending Motion for Joinder. *Id.* at 3–4.

¹ Unless otherwise noted, citations to papers and exhibits are to those filed in IPR2015-00316.

On October 28, 2015, Patent Owner purported to file a Preliminary Response to Qualcomm’s Petition (IPR2015-01581, Paper 11, “Prelim. Resp.”). Upon inspection, the Preliminary Response does not respond to any of the arguments and evidence presented in the Qualcomm Petition, aside from indicating that absent joinder, Qualcomm would be barred from filing a petition under 35 U.S.C. § 315(b). The majority of Patent Owner’s Preliminary Response introduces new arguments in opposition to the Motion for Joinder. In other words, Patent Owner used the Preliminary Response as an unauthorized sur-reply to the Motion for Joinder. Because Patent Owner did not seek, nor did we grant authorization for additional briefing on the Motion for Joinder, we do not consider Patent Owner’s joinder arguments presented in the Preliminary Response. *See* 37 C.F.R. §§ 42.20(b) (“*Prior authorization*. A motion will not be entered without Board authorization.”); 42.23–24 (setting forth the requirements for oppositions and replies, but not authorizing sur-replies).²

For the reasons described below, we institute an *inter partes* review of all the challenged claims and grant Qualcomm’s Motion for Joinder.

ANALYSIS

Institution on the same grounds as those asserted in the MediaTek Petition

Qualcomm represents that its Petition “is in all material respects the same as the petition in” IPR2015-00316. Mot. for Joinder 1. Qualcomm further represents that it “relies on the same expert declaration relied on by” MediaTek in IPR2015-00316. *Id.* The Ding Declaration submitted in

² As it was, we extended Patent Owner’s deadline to file its Opposition to the Motion for Joinder. IPR2015-01581, Paper 7.

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IPR2015-01581 (Ex. 1002) appears to be a copy of the declaration filed in IPR2015-00316 (also Ex. 1002). As explained above, while Patent Owner filed a paper styled a “Preliminary Response,” that paper did not address any of the challenges presented in Qualcomm’s Petition.

In view of the identity of the challenges in the Qualcomm Petition and those of the MediaTek Petition, we institute an *inter partes* review in IPR2015-01581 on the same grounds as those on which we instituted in IPR2015-00316. We do not institute *inter partes* review on any other grounds.

Joinder with IPR2015-00316

The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”) permits the joinder of like proceedings. *See* 35 U.S.C. § 315(c). Under Section 315(c), the Board, acting on behalf of the Director, has the discretion to join an *inter partes* review with another *inter partes* review:

If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join as a party to that *inter partes* review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

Qualcomm’s Petition was accorded a filing date of July 13, 2015, and therefore satisfies the joinder requirement of being filed within one month of our institution of trial in IPR2015-00316. *See* 37 C.F.R. § 42.122(b); *see also* 37 C.F.R. § 1.7(a); 37 C.F.R. § 42.1(a). 35 U.S.C. § 315(b) further establishes a one-year bar from the date of service of a complaint alleging

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infringement for requesting *inter partes* review, but specifies that the bar does not apply to a request for joinder under § 315(c). Although Qualcomm filed its Petition more than one year from the date of a complaint alleging infringement, that Petition nevertheless is timely if we grant Qualcomm's Motion for Joinder.

Previous panels of this Board have listed factors that should be addressed in a motion for joinder. For example:

A motion for joinder should: (1) set forth the reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified.

Enzymotec Ltd. v. Neptune Techs. & Bioresources, Inc., Case IPR2014-00556, slip op. at 4 (PTAB July 9, 2014) (Paper 19) (citing *Kyocera Corp. v. SoftView LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15)).

As explained above, Qualcomm's Petition includes no new grounds of unpatentability. Qualcomm agreed in its Motion for Joinder to abide by the Scheduling Order existing at the time its Motion for Joinder was filed. Mot. for Joinder 6. Qualcomm also agreed to rely primarily on MediaTek to prosecute the case in order to simplify discovery and minimize the impact of joinder on IPR2015-00316. *Id.* Because the MediaTek petitioners have settled, there are no longer issues of cooperation and duplication among petitioners.

Patent Owner opposes Qualcomm's Motion for Joinder, arguing that granting it would discourage early settlement. PO Opp. 7–8. According to Patent Owner,

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