

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED,
Petitioner

v.

BANDSPEED, INC.,
Patent Owner

Case IPR2015-01577
Patent No. 7,477,624

**PATENT OWNER'S OPPOSITION TO PETITIONER'S
MOTION FOR JOINDER UNDER 35 U.S.C. 315(C)
AND 37 C.F.R. §§ 42.22 AND 42.122(B)**

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I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.23 and the express authorization given by the Patent Trial and Appeal Board (“PTAB” or “Board”) in Paper Number 7 of this proceeding, Patent Owner Bandspeed (“Bandspeed” or “Patent Owner”) files this Opposition to Petitioner’s Motion for Joinder Under 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b). The Board should exercise its discretion to deny joinder under the facts of this proceeding. Denial of joinder would serve public policy interests, avoid scheduling issues and be consistent with PTAB *inter partes* review (“IPR”) precedent.

II. STATEMENT OF RELEVANT FACTS

On May 14, 2014 Qualcomm Incorporated (“Qualcomm”) was served with a complaint captioned *Bandspeed, Inc. v. Qualcomm Incorporated et al.*, 1:14-cv-00436, alleging infringement of U.S. Patent No. 7,477,624 (“’624 Patent”). Despite service of this complaint Qualcomm elected not to file an IPR related to the ‘624 Patent during the twelve (12) month window after service provided under 35 U.S.C. § 315(b).

On June 11, 2015, the PTAB instituted trial in IPR2015-00314, involving the ‘624 Patent, which was originally filed by Marvell Semiconductor, Inc. (“Marvell”) and MediaTek, Inc. and MediaTek USA, Inc. (“MediaTek”). On June 10, 2015, one day prior to institution, the PTAB granted Marvell and Bandspeed’s

joint request to terminate the proceedings with respect to Marvell only. On the last possible day under 37 C.F.R. §42.122(b), July 13, 2015, Petitioner Qualcomm filed its motion for joinder of the instant petition with IPR2015-00314. On August 5, 2015, MediaTek and Bandspeed filed their joint motion to terminate IPR2015-00314 after settlement of the litigation involving the underlying patent.¹

¹ Patent Owner Bandspeed has reviewed the Statement of Material Facts contained in Petitioner's Motion for Joinder Under 35 U.S.C. 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b). While Bandspeed generally agrees with the recitation of material facts contained therein, there are several instances in which the recited facts appear to contain typographical errors or are ambiguous. Paragraph 3 of the material facts mentions a petition for IPR challenging certain claims but no specific patent or IPR number is referenced. It is believed that the IPR being referred to is IPR2015-00314 and the patent being referred to is the '624 patent. Paragraph 4 of the material facts mentions trial being instituted in IPR2015-00314 for ground 3 (as modified) but it is unclear what "as modified" means. Nevertheless, it is not believed that any of these issues with respect to Petitioner's statement of material facts are relevant for purposes of deciding the instant motion. Patent Owner Bandspeed has recited additional facts herein that may be relevant to this motion for the PTAB's consideration.

III. LEGAL AUTHORITY AND ARGUMENT

A. Joinder of IPR Proceedings is Discretionary

The decision whether to join two IPR proceedings is entirely discretionary, and the Petitioner, as the moving party in this instance, bears the burden to show that joinder is appropriate. *See ZTE Corporation, ZTE (USA) Inc. and T-Mobile USA Inc. v. Adaptix, Inc.*, Case IPR2015-01184, Paper 10 at 4. *See also* 35 U.S.C. § 315(c) and 37 C.F.R. § 42.20(c). 35 U.S.C. § 315 provides in pertinent part:

(c) JOINDER.—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.

When exercising its discretion on joinder, the PTAB “is mindful that patent trial regulations, including the rules of joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding...As indicated in the legislative history, the Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case.” *See ZTE Corporation, ZTE (USA) Inc. and T-Mobile USA Inc. v. Adaptix, Inc.*, Case IPR2015-01184, Paper 10 at 6. Pursuant to the legislative history on joinder, the consent of the patent owner is also an important consideration. *Id.* at 7. Because both scheduling and policy considerations favor denial of joinder and because the

PTAB has previously terminated IPR proceedings even when there is a pending motion to join, Patent Owner Bandspeed requests that joinder be denied.

B. PTAB Precedent Allows for Denial of Joinder Request and Termination of Instituted IPR Proceeding

The PTAB has previously exercised its discretion to terminate an instituted IPR despite a pending motion for joinder with the instituted IPR filed in another IPR prior to the filing of a motion to terminate the instituted IPR. *Google Inc. and YouTube, LLC v. Personal Web Technologies, LLC and Level 3 Communications, LLC*, IPR2014-00977, Paper 10. In IPR2014-00977, Google, Inc. (“Google”) sought to join an already instituted IPR2014-00059 between Rackspace US, Inc. (“Rackspace”) and Personal Web Technologies, LLC (“Personal Web”). *Id.* at 4. IPR2014-00059 was instituted on April 15, 2014 and Google filed its motion for joinder on June 18, 2014.² *Id.* On October 16, 2014, Rackspace and Personal Web filed a joint motion to terminate IPR2014-00059 with respect to all parties as well

² Google’s motion to join was also ultimately determined to be untimely (i.e. filed more than one month after the time limit imposed under 37 C.F.R. §42.122(b)), and in denying the motion for joinder, the PTAB noted that the motion for joinder was moot because the proceeding to be joined had been terminated. The PTAB terminated the instituted IPR even though the motion to join had been filed prior to the motion to terminate. *Id.* at 5-6.

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