

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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QUALCOMM INCORPORATED,  
Petitioner

v.

BANDSPEED, INC.,  
Patent Owner

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Case IPR2015-01581  
Patent No. 7,477,624

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**PATENT OWNER'S PRELIMINARY RESPONSE  
UNDER 37 C.F.R. § 42.107**

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Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

## I. BACKGROUND

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”).<sup>1</sup>

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<sup>1</sup> U.S. Patent Nos. 7,027,418, 7,477,624, 7,570,614, 7,903,608, 8,542,643, and 8,873,500 are currently asserted in this district court litigation. All of these patents, except for U.S. Patent No. 8,873,500, were asserted in the original complaint against Qualcomm. U.S. Patent Nos. 7,027,418 and 7,570,614 are subject to *inter partes* reexamination proceedings. See Control Nos. 95/000,648-95/002,108 and Control Nos. 95/000,647-95/002,111. U.S. Patent Nos. 7,477,624 and 8,542,643 are involved in *inter partes* review proceedings that have been terminated with respect to all petitioners and that Qualcomm is seeking to join to avoid a time-bar on its petitions for *inter partes* review. See IPR2015-00314-IPR2015-00315-IPR2015-00316 and IPR2015-00531. U.S. Patent Nos. 7,903,608 and 8,873,500 are not currently subject to any post-grant patent proceeding. The *inter partes* review of U.S. Patent No. 7,903,608 that previously existed was terminated after the original parties settled and no other party, including Qualcomm, sought to join that proceeding. See IPR2015-00237.

Despite service of this complaint, Qualcomm elected not to file an *inter partes* review (“IPR”) related to the ‘624 Patent during the twelve (12) month window after service provided under 35 U.S.C. § 315(b).

On November 26, 2014, Marvell Semiconductor, Inc. (“Marvell”) and MediaTek, Inc. and MediaTek USA, Inc. (“MediaTek”), entities that also were served with complaints for infringement of the same patents asserted against Qualcomm on or around the same date Qualcomm was served its complaint, filed their Petition for *inter partes* review of the ‘624 Patent in IPR2015-00316.

On June 11, 2015, the Patent Trial and Appeal Board (“PTAB”) instituted trial in IPR2015-00316. 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 July 13, 2015, nearly eight (8) months after the Petition was filed in IPR2015-00316 and on the last possible day to request joinder under 37 C.F.R. § 42.122(b), Petitioner Qualcomm filed its motion for joinder of the instant petition with IPR2015-00316. On August 5, 2015, MediaTek and Bandspeed filed their joint motion to terminate IPR2015-00316 after settlement of the litigation involving the ‘624 Patent.

## **II. QUALCOMM’S PETITION IS UNTIMELY UNDER 35 U.S.C. § 315(B) ABSENT JOINDER.**

35 U.S.C. § 315(b) states:

(b) Patent Owner's Action. —An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent. The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).

Qualcomm's Petition was filed on July 13, 2015, almost fourteen (14) months after service of the complaint asserting the '624 Patent, meaning its Petition is time-barred absent joinder. Indeed, the Board has previously indicated that "[i]f the [Qualcomm] joinder motions are not granted, the related proceedings are barred under 35 U.S.C. § 315(b)." IPR2015-00316, Paper 20 at 2. Because Qualcomm has failed to establish that its joinder motion should be granted, the instant petition is time-barred and no trial should be instituted.

### **III. JOINDER IS INAPPROPRIATE UNDER THESE CIRCUMSTANCES.**

#### **A. Joinder 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 . . . [a]s 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. Both policy and scheduling considerations favor denial of joinder. Accordingly, the Board should deny Qualcomm’s request for joinder and should deny the instant Petition as time-barred. *See also* IPR2015-01581, Paper 8.

**B. Allowing Joinder in this Matter Would Undermine the Estoppel Provisions of the AIA and the Public Policies Favoring Settlement and Speedy Resolution of Disputes.**

1. Allowing Joinder After the Filing of a Motion to Terminate Undermines the Estoppel Provisions of the AIA.

Title 35, section 315(e) of the United States Code provides that any petitioner, or the real party in interest or privy of the petitioner, is estopped from asserting in civil actions or proceedings before the United States Patent and Trademark Office (“USPTO”) that a claim is invalid on any ground that the

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