UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.
Petitioner

v.

CELLULAR COMMUNICATIONS EQUIPMENT LLC
Patent Owner

INTER PARTES REVIEW OF U.S. PATENT NO. 8,385,966
Case IPR No.: IPR2016-00178

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

Filed on behalf of Petitioners

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), LG Electronics, Inc. moves for joinder with the *Inter Partes* Review of U.S. Patent No. 8,385,966, *Kyocera Commn's, Inc. v. Cellular Commn's Equip. LLC*, IPR2015-01559 ("the Kyocera IPR"), for which an institution decision is pending. This motion is timely because it is filed before one month of institution of the Kyocera IPR. 37 C.F.R. § 42.122(b).

Petitioner requests institution of its concurrently filed Petition for *Inter Partes* Review. The Petition is a carbon copy of the original Kyocera IPR petition in all material respects. The only changes are in the introduction to identify the correct Petitioner, and in the mandatory notices under 37 C.F.R. § 42.8(b). The concurrently filed Petition and the Kyocera IPR petition challenge the same claims of the '966 patent on the same grounds relying on the same prior art and evidence, including declarations identical in substance from the same declarants and expert.[1]

Petitioner requests that the institution of its Petition be limited solely to the grounds that will be instituted in the Kyocera IPR. Petitioner agrees to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced,

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[1] The declarations have been updated only to reflect retention by Petitioner and are otherwise identical to the declarations submitted in the Kyocera IPR.

in the Kyocera IPR as instituted. Thus, the Petition warrants institution under 35 U.S.C. § 314, and 35 U.S.C. § 315(c) permits Petitioner's joinder to the Kyocera IPR.

Further, if joined, Petitioner agrees to adhere to all applicable deadlines in the Kyocera IPR and coordinate all filings with the Petitioner in the Kyocera IPR ("the Kyocera Petitioner"). The Kyocera Petitioner will maintain the lead role in the proceedings so long as it is a party to the proceedings. Petitioner agrees to consolidated filings for all substantive papers in the proceeding. The Kyocera Petitioner and Petitioner will be jointly responsible for the consolidated filings. Petitioner will not advance any arguments separate from those advanced by Petitioner and the Kyocera Petitioner in the consolidated filings. These limitations will avoid lengthy and duplicative briefing. Also, Petitioner will not seek additional depositions or deposition time, and will coordinate deposition questioning and hearing presentations with the Kyocera Petitioner. Petitioner agrees to the foregoing conditions even in the event that other IPRs filed by other, third-party petitioners are joined with the Kyocera IPR.

Joinder will help efficiently resolve the disputes among the parties. By joinder, a single Board decision may dispose of the issues raised in the Kyocera IPR for all interested parties. Further, the Patent Owner has asserted the '966 patent in district court against LG Electronics, Inc., and LG Electronics U.S.A.,

Inc. ("LGE"). Joinder will estop LGE from asserting in district court those issues resolved in a final written decision in the Kyocera IPR, thus narrowing the issues in the district court actions. *See* 35 U.S.C. § 315(e)(2). Finally, joinder would not complicate or delay the Kyocera IPR, and would not adversely affect any schedule set in that proceeding. In sum, joinder would promote efficient adjudication in multiple forums. On the other hand, if instituted, maintaining the Petitioner's IPR proceeding separate from that of the Kyocera IPR would entail needless duplication of effort.

Joinder will not unduly prejudice any party. The Kyocera Petitioner consents to Petitioner's joinder. Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or increase needless filings, any additional costs on the Patent Owner would be minimal. On the other hand, denial of joinder would prejudice LGE. Their interests may not be adequately protected in the Kyocera IPRs, particularly if the Kyocera Petitioner settles with the Patent Owner. Petitioner should be allowed to join in a proceeding affecting a patent asserted against it.

II.   BACKGROUND AND RELATED PROCEEDINGS

Cellular Communications Equipment, LLC (the "Patent Owner") is the owner of the '966 Patent. The Patent Owner asserted the '966 Patent against LGE and Kyocera Communications, Inc. ("Kyocera"), among others, in

Communications Equipment LLC v. LG Electronics, Inc. et al., No. 6:14-cv-982 (E.D. Texas). On July 9, 2015, Kyocera filed its IPR petition, IPR2015-01559, against the '966 patent. The Board has not yet decided whether to institute the Kyocera IPR. Petitioner here moves for joinder with the Kyocera IPR.

III. STATEMENT OF REASONS FOR THE REQUESTED RELIEF

A. Legal Standards and Applicable Rules

The time limitation set forth in 35 U.S.C. § 315(b) does not apply to a request for joinder. 35 U.S.C. § 315(b). The Board has discretion to join a properly filed IPR petition to an IPR proceeding. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); *see also Dell Inc. v. Network-1 Sec. Solutions, Inc.*, IPR2013-00385, Paper 19, at 4-6; *Sony Corp. v. Yissum Res. & Dev. Co. of the Hebrew Univ. of Jerusalem*, IPR2013- 00326, Paper 15, at 3-4; *Microsoft Corp. v. Proxyconn, Inc.*, IPR2013-00109, Paper 15, at 3-4. "The Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations." *Dell*, IPR2013-00385, Paper 19, at 3. The movants bear the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b). 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

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