

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE USA, Inc.
Petitioner

v.

PARTHENON UNIFIED MEMORY ARCHITECTURE LLC
Patent Owner

INTER PARTES REVIEW OF U.S. PATENT NO. 5,182,789

Case IPR No.: IPR2016-00664

**MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c),
37 C.F.R. §§ 42.22, AND 42.122(b)**

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P.O. Box 1450 Alexandria, VA 22313-1450

I. INTRODUCTION

ZTE USA, Inc. (“Petitioner”) submits concurrently herewith a Petition for *Inter Partes* Review of U.S. Patent No. 5,182,789 (“the ’789 Patent”) (“Petition”) based on grounds identical to those asserted in *Samsung Elecs. Co., Ltd. v. Parthenon Unified Memory Architecture, LLC*, IPR2015-01944 (“the Samsung IPR”).

Pursuant to 35 U.S.C. § 315(c), Petitioner respectfully moves that this Petition be instituted and joined with the Samsung IPR, for which an institution decision is pending. The Petition is a copy of the Samsung IPR petition in all material aspects, challenging the same claims of the ’789 Patent on the same grounds while relying on the same prior art and evidence. Joining the Petition to the Samsung IPR will result in a consolidated IPR with three petitioners— Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively “Samsung”), and Petitioner—thereby promoting an efficient determination of the validity of the ’789 Patent. Petitioner requests that the institution of this Petition be limited solely to the grounds that will be instituted in the Samsung IPR, and further requests an opportunity to join the Samsung IPR as an “understudy,” only assuming an active role in the event Samsung settles with Parthenon Unified Memory Architecture LLC (“Parthenon”). Thus, Petitioner does not seek to alter the grounds upon which the Board has already considered, or

is currently considering, in instituting the Samsung IPR, and joinder will have no impact on the prospective schedule in the Samsung IPR.

Accordingly, Petitioner respectfully requests that the this motion for joinder to the Samsung IPR be granted.

II. BACKGROUND AND RELATED PROCEEDINGS

Parthenon is the owner of the '789 Patent. In 2014 and 2015, Parthenon sued nine (9) different companies, including Petitioner and Samsung, for allegedly infringing the '789 Patent (the "Underlying Litigation"). Samsung filed its petition for *inter partes* review of the '789 Patent on September 22, 2015. Parthenon filed its preliminary response on December 31, 2015. The Board has not yet decided to institute the Samsung IPR. Petitioner here moves for joinder with the Samsung 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 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.

Dell, IPR2013-00385, Paper 19, at 4.

B. This joinder motion and the Petition are timely

The Petitioner submits that the Petition and the instant motion for joinder are timely under 35 U.S.C. § 315(c), and 37 C.F.R. §§ 42.22 and 42.122(b). Rule 42.122 states that a motion for joinder shall be filed within one month from the granting of the petition that is sought to be joined. The Samsung IPR petition has not yet been instituted, but because the instant Petition is filed on February 26, 2016, the Petition is filed prior to the prospective institution of the Samsung IPR petition.

Moreover, even though the Petition is filed not more than one year from service of the complaint on February 26, 2015, the instant Petition is not subject to

the one year time bar of Section 315(b) because it is accompanied by this motion for joinder. *Dell*, IPR2013-00385, Paper 17 at 4-5; *see also* 37 C.F.R.

§§ 42.101(b), 42.122(b); *Microsoft Corp. v. Poxycorn, Inc.*, IPR2013-00109, Paper 15 (permitting joinder of a party beyond the one-year window). Accordingly, Petitioner respectfully submits that the Petition and the instant motion for joinder are indeed timely and properly filed under both the applicable statutes and regulations.

C. Joinder will not impact the schedule or the Board’s ability to complete the review within the one-year period

Joinder in this case will not impact the Board’s ability to complete its review in a timely manner. Section 316(a)(11) provides that IPR proceedings should be completed and the Board’s final decision issued within one year of institution of the review. *See also* 37 C.F.R. § 42.100(c). Here, joinder will not affect the Board’s ability to issue its final determination within one year because Petitioner agrees to an understudy role and does not raise any issues that are not already before the Board. Indeed, the Petitioner requests that only those grounds on which the Samsung IPR is instituted be herein instituted, copying verbatim the invalidity grounds asserted in the Samsung IPR petition.

Given that Petitioner will assume **an understudy role**, its presence will not introduce any additional arguments, briefing, or need for discovery.

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