

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE USA, INC., HTC CORPORATION, HTC AMERICA, INC., LG
ELECTRONICIS, INC., and APPLE INC.,¹
Petitioners,

v.

PARTHENON UNIFIED MEMORY ARCHITECTURE LLC,
Patent Owner.

Case IPR2016-00664 (Patent 5,812,789) Case IPR2016-00848 (Patent 5,960,464)
Case IPR2016-00665 (Patent 5,960,464) Case IPR2016-00923 (Patent 5,812,789)
Case IPR2016-00847 (Patent 5,812,789) Case IPR2016-00924 (Patent 5,960,464)²

Before MICHAEL R. ZECHER, JAMES B. ARPIN, and
MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

CLEMENTS, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ ZTE USA, Inc., is the Petitioner in Cases IPR2016-00664 and IPR2016-00665; HTC Corporation, HTC America, Inc., and LG Electronics, Inc. are the Petitioners in Cases IPR2016-00847 and IPR2016-00848; and Apple Inc. is the Petitioner in Cases IPR2016-00923 and IPR2016-00924.

² We exercise our discretion to issue one Order to be filed in each case. The parties, however, are not authorized to use this style heading in any subsequent papers.

IPR2016-00664 (Patent 5,812,789) IPR2016-00848 (Patent 5,960,464)
IPR2016-00665 (Patent 5,960,464) IPR2016-00923 (Patent 5,812,789)
IPR2016-00847 (Patent 5,812,789) IPR2016-00924 (Patent 5,960,464)

A conference call in the six proceedings identified above was held on June 7, 2016, between the parties and Judges Zecher, Arpin, and Clements. HTC Corporation, HTC America, Inc. and LG Electronics, Inc. (“Petitioner”) initiated the conference call to request authorization to file new motions for joinder in IPR2016-00847 (“the 847 IPR”) and IPR2016-00848 (“the 848 IPR”) requesting joinder to ZTE USA, Inc.’s (“ZTE’s”) pending Petitions (IPR2016-00664 and IPR2016-00665) or, alternatively, Apple Inc.’s (“Apple’s”) pending Petitions (IPR2016-00923 and IPR2016-00924).

I. BACKGROUND

On September 22, 2015, Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively “Samsung”) filed Petitions in IPR2015-01944 (“the 1944 IPR”) and IPR2015-01946 (“the 1946 IPR”) challenging U.S. Patent No. 5,812,789 (“the ’789 patent”) and U.S. Patent No. 5,960,464 (“the ’464 patent”), respectively. *Samsung Elecs. Co. v. Parthenon Unified Memory Architecture LLC*, Case IPR2015-01944, Paper 2; *Samsung Elecs. Co. v. Parthenon Unified Memory Architecture LLC*, Case IPR2015-01946, Paper 2.

On February 26, 2016, ZTE filed Petitions in IPR2016-00664 (“the 664 IPR”) and IPR2016-00665 (“the 665 IPR”) that are substantively identical to the Petitions filed by Samsung in the 1944 IPR and in the 1946 IPR, respectively. *ZTE USA, Inc. v. Parthenon Unified Memory Architecture LLC*, Case IPR2016-00664, Paper 2; *ZTE USA, Inc. v. Parthenon Unified Memory Architecture LLC*, Case IPR2016-00665, Paper 2. The Petitions in the 664 IPR and the 665 IPR were accompanied by Motions for Joinder seeking to join the 1944 IPR and the 1946 IPR, respectively. 664 IPR, Paper 3; 665 IPR, Paper 3.

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On March 30, 2016, we instituted *inter partes* reviews of the 1944 IPR and of the 1946 IPR. 1944 IPR, Paper 7; 1946 IPR, Paper 7.

On April 7, 2016, within one month of our Decisions to Institute the 1944 IPR and in the 1946 IPR, Petitioner filed Petitions in the 847 IPR and 848 IPR accompanied by Motions for Joinder seeking to join the 1944 IPR and the 1946 IPR, respectively. 847 IPR, Paper 1 (“847 Pet.”); 848 IPR, Paper 1 (“848 Pet.”).

On April 20, 2016, within one month of our Decisions to Institute the 1944 IPR and in the 1946 IPR, Apple filed Petitions in the Case IPR2016-00923 (“the 923 IPR”) and Case IPR2016-00924 (“the 924 IPR”) accompanied by Motions for Joinder seeking to join the 1944 IPR and the 1946 IPR, respectively.

On May 25, 2016, we granted Joint Motions to Terminate in the 1944 IPR and the 1946 IPR. 1944 IPR, Paper 12; 1946 IPR, Paper 12.

II. DISCUSSION

A. Petitioner’s Motions for Joinder

Petitioner was served with a complaint alleging infringement of the ’789 patent and the ’464 patent more than one year before it filed the Petitions in the 847 IPR and 848 IPRs. 847 Pet. 4; 848 Pet. 4. As a result, those Petitions are untimely under 35 U.S.C. § 315(b) unless accompanied by Motions for Joinder under § 315(c), such as the ones Petitioner filed seeking to join the 1944 IPR and 1946 IPR, respectively. Now that the 1944 IPR and the 1946 IPR are terminated, however, Petitioner’s Motions for Joinder in the 847 IPR and 848 IPR are moot. As a result, the Petitions in the 847 IPR and the 848 IPR would be untimely and, absent other circumstances, would be denied.

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In this case, however, the parties acknowledged during the conference call that two Petitions are substantively identical to the 847 Petition that are pending before us in the 664 IPR (filed by ZTE) and in the 923 IPR (filed by Apple), and two petitions are substantively identical to the 848 Petition that are pending before us in the 665 IPR (filed by ZTE) and in the 924 IPR (filed by Apple). Although ZTE filed a motion seeking joinder of the 664 IPR and 665 IPR with the 1944 IPR and the 1946 IPR, respectively, ZTE's Petitions are not barred under § 315(b) in the absence of joinder. Similarly, although Apple filed a motion seeking joinder of the 923 IPR and 924 IPR with the 1944 IPR and 1946 IPR, respectively, Apple's Petitions are not barred under § 315(b) in the absence of joinder. As a result, the timeliness of the 664 IPR, 665 IPR, 923 IPR, and 924 IPR is unaffected by our termination of the 1944 IPR and 1946 IPR. Thus, even if we deny institution of the 847 IPR and 848 IPR for lack of an instituted case to which they may be joined, we still must address the merits of the 664 IPR, 665 IPR, 923 IPR, and 924 IPR. And, in the event that we institute *inter partes* reviews in those cases,³ Petitioner could simply re-file, as new proceedings, the papers presently before us in the 847 IPR and 848 IPR, and seek joinder to the newly-instituted proceedings, rather than to the 1944 IPR and 1946 IPR.

In the interest of a just, speedy, and inexpensive resolution to any proceedings in the 847 IPR and 848 IPR and efficient consideration of the merits of nearly identical papers in a later proceeding, we dismiss without prejudice the Motions for Joinder currently pending in the 847 IPR and in the 848 IPR, and

³ We previously instituted substantively identical petitions in the 1944 IPR and 1946 IPRs, and Patent Owner waived its Preliminary Response in the pending proceedings (664 IPR, Paper 9; 665 IPR, Paper 9; 923 IPR, Paper 8; 924 IPR, Paper 8).

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authorize Petitioner to file, on or before June 15, 2016, renewed Motions for Joinder seeking joinder with the Petitions filed by ZTE in the 664 IPR and 665 IPR, respectively, or, alternatively, with the Petitions filed by Apple in the 923 IPR and 924 IPR, respectively.

B. Apple & ZTE's Motions for Joinder

Both Apple and ZTE filed Motions for Joinder of their Petitions with the 1944 IPR and the 1946 IPR, respectively. 664 IPR, Paper 3; 665 IPR, Paper 3; 923 IPR, Paper 3; 924 IPR, Paper 3. Like Petitioner's Motions for Joinder in the 847 IPR and 848 IPR, Apple's and ZTE's Motions for Joinder are now moot in view of the termination of the 1944 IPR and 1946 IPR. Those Motions are, therefore, dismissed without prejudice.

Although neither Apple's nor ZTE's Petitions are barred under § 315(b) in the absence of joinder, the panel expressed its desire to join the 664 IPR and 923 IPR and to join the 665 IPR and 924 IPR, so that two pairs of substantively identical proceedings do not move forward in parallel. The parties asked for time to discuss with each other which pair of cases—the 664 IPR and 665 IPR or the 923 IPR and 924 IPR—would be the cases to which the other cases would be joined. The panel finds it intuitive to address the earliest-filed cases—the 664 IPR and 665 IPR—on the merits due to the earlier statutory deadline in those cases, and for the later-filed cases—the 923 IPR and 924 IPR—to seek joinder with the earlier-filed cases, but leaves it to the parties to decide with which cases to proceed.

To account for both possibilities, the panel authorizes ZTE to file, on or before June 15, 2016, renewed Motions for Joinder seeking joinder to the Petitions filed by Apple in the 923 IPR and 924 IPR, respectively, and also authorizes Apple

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