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

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

I. INTRODUCTION

On February 26, 2016, ZTE USA, Inc. ("Petitioner") submitted 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"). Petitioner concurrently filed a Motion for Joinder seeking to join this petition with the Samsung IPR. On May 25, 2016, the Samsung IPR was terminated while the Motion for Joinder was pending. On June 8, 2016, the Board dismissed Petitioner's Motion for Joinder without prejudice and authorized Petitioner to file a renewed Motion for Joiner to join *Apple Inc. v. Parthenon Unified Memory Architecture, LLC*, IPR2016-00923 ("the Apple IPR"). IPR2016-00664 ("664 IPR"), Paper 10. The Apple IPR is also identical to the Samsung IPR.

Pursuant to 35 U.S.C. § 315(c), Petitioner respectfully moves that this Petition be instituted and joined with the Apple IPR, for which an institution decision is pending. The Petition is a copy of the Apple 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 Apple IPR will result in a consolidated IPR with two petitioners—Apple Inc. 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 Apple IPR, and further requests an opportunity to join the Apple IPR as an "understudy," only assuming an active role in the event Apple 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 Apple IPR, and joinder will have no impact on the prospective schedule in the Apple IPR.

Accordingly, Petitioner respectfully requests that this motion for joinder to the Apple 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 Apple, for allegedly infringing the '789 Patent (the "Underlying Litigation"). Apple filed its petition for *inter partes* review of the '789 Patent on April 20, 2016. Parthenon waived its preliminary response on May 26, 2016. The Board has not yet decided to institute the Apple IPR. Petitioner here moves for joinder with the Apple 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. 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 Apple IPR is instituted be herein instituted, which are verbatim copies of the invalidity grounds asserted in the Apple IPR petition.

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

Petitioner only offers identical support that Apple has also introduced. For example, Petitioner petition relies on the same expert witness as the Apple IPR, Dr. Harold Stone. Petitioner has not submitted a new declaration.

Parthenon has waived a preliminarily response to the grounds asserted in the instant Petition and the Apple IPR on May 26, 2016. 664 IPR, Paper 9 (May 26, 2016); Apple IPR, Paper 8 (May 26, 2016). Thus, Petitioner submits that the Board proceeds.

Further, for efficiency's sake, Petitioner will:

1. Adhere to all applicable deadlines in the Apple IPR;
2. Submit "consolidated" filings with the Apple, as set forth above in the statement of precise relief requested;
3. Refrain from requesting or reserving any additional depositions or deposition time;

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