

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. 7,777,753

Case IPR No. IPR2016-00670

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

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I. INTRODUCTION

ZTE USA, Inc. (“Petitioner”) submits concurrently herewith a Petition for *Inter Partes* Review of U.S. Patent No. 7,777,753 (“the ’753 Patent”) (“Petition”) based on grounds identical to those asserted in *HTC Corp. et al. v. Parthenon Unified Memory Architecture, LLC.*, IPR2015-01501 (“the HTC IPR”).

Pursuant to 35 U.S.C. § 315(c), Petitioner respectfully moves that this Petition be instituted and joined with the HTC IPR, which has already been instituted. The Petition is a copy of the HTC IPR petition (“the HTC Petition”) in all material aspects, challenging the same claims of the ’753 Patent on the same grounds while relying on the same prior art and evidence. Joining the Petition to the HTC IPR will result in a consolidated IPR with six petitioners—HTC Corp., HTC America, Inc., LG Electronics, Inc., Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. (collectively, “the Initial Petitioners”), and Petitioner—thereby promoting an efficient determination of the validity of the ’753 Patent.

Petitioner requests that the institution of this Petition be limited solely to the grounds that were instituted in the HTC IPR, and further requests an opportunity to join the HTC IPR as an “understudy,” only assuming an active role in the event that at least one of the Initial Petitioners settle with Parthenon Unified Memory

Architecture LLC (“Parthenon”). This petition does not add or alter any arguments that have already been considered by the Board, and this petition does not seek to expand the grounds of invalidity that the Board has already found support of institution of IPR proceedings. In addition, joinder will have no impact on the schedule in the HTC IPR.

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

II. BACKGROUND AND RELATED PROCEEDINGS

Parthenon is the owner of the ’753 Patent. In 2014 and 2015, Parthenon sued nine (9) different companies, including Petitioner and the Initial Petitioners, for allegedly infringing the ’753 Patent (the “Underlying Litigation”). The Initial Petitioners filed their petition for *inter partes* review of the ’753 Patent on June 24, 2015. Parthenon filed its preliminary response on October 7, 2015. The Board issued a decision granting Institution on Grounds B-D in the HTC IPR on January 6, 2016. Petitioner here moves for joinder with the HTC IPR.

III. STATEMENT OF REASONS FOR THE REQUESTED RELIEF

A. Legal standards and applicable rules

The Board has discretion to join a 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.

The Board also has discretion to “waive or suspend a requirement [of the rules]” including 37 C.F.R. § 42.122(b). 37 C.F.R. § 42.5(b).

B. Special circumstances warrant a waiver of 37 C.F.R. § 42.122(b)

Petitioner submits that the following special circumstances warrant invocation of waiver of pertinent requirements (most notably the requirement of Rule 42.122 that motions for joinder be filed no later than one month after the institution date of the IPR for which joinder is requested) pursuant to Board’s authority set forth in Rule 42.5(b):

- **The Petition raises only arguments and grounds that are substantively identical to the arguments and grounds in the HTC IPR.** PTAB decisions now clearly indicate that the copy-and-paste method is the preferred means to join an instituted IPR. *See, e.g., Sony Corp. of America, et al. v. Network-1 Security Solutions, Inc.,* IPR2013-00495, Paper No. 13, at 4 (Sep. 16, 2013). Thus, there would be no new issues beyond those already before the Board.
- **Petitioner agrees to an “understudy” role in the HTC IPR.** Petitioner will not file additional written submissions, nor will it pose questions at depositions or argue at oral hearing without prior permission. Only in the event that at least one of the Initial Petitioners settle, will Petitioner seek to become active in the HTC IPR.
- **Petitioner will be greatly prejudiced if not joined.** If Parthenon settles with the Initial Petitioners, and if a final decision in the HTC IPR is not issued, then Petitioner will have to meet a much higher standard (clear and convincing) when arguing invalidity before the court than before the Board (preponderance of the evidence).
- **The Petition is filed not more than one year of service of the complaint on February 26, 2015.** Thus, the instant Petition is not

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