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Paper No. 16
Entered: August 23, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION and HTC AMERICA, INC.,
Petitioner,

v.

PARTHENON UNIFIED MEMORY ARCHITECTURE LLC,
Patent Owner.

Case IPR2016-00847
Patent 5,812,789

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

ZECHER, *Administrative Patent Judge.*

DECISION
Institution of *Inter Partes* Review and
Granting Petitioner's Second Motion for Joinder
35 U.S.C. § 314(a), 37 C.F.R. §§ 42.108 and 42.122

I. INTRODUCTION

On April 7, 2016, the only Petitioner entities remaining in this proceeding, HTC Corporation and HTC America, Incorporated (collectively, "HTC"), filed a Petition requesting an *inter partes* review of claims 1, 3–6, 11, and 13 of U.S. Patent No. 5,812,789 (Ex. 1001, "the '789 patent"). Paper 1 ("Pet."). HTC filed its Petition along with an initial Motion for Joinder requesting that we join HTC as a party with *Samsung Elecs. Co. v. Parthenon Unified Memory Architecture LLC*, Case IPR2015-01944 ("Samsung IPR"). Paper 2. As we explained in an Order dated June 8, 2016, we instituted an *inter partes* review in the Samsung IPR on March 30, 2016, and we granted a Joint Motion to Terminate the Samsung IPR on May 25, 2016. Paper 11, 3. As a consequence, we dismissed without prejudice HTC's initial Motion for Joinder and authorized HTC to file a renewed Motion for Joinder that seeks joinder with a Petition filed by Apple Incorporated ("Apple") requesting an *inter partes* review of claims 1, 3–6, 11, and 13 of the '789 patent (Case IPR2016-00923, "Apple IPR"). On June 15, 2016, HTC filed a Second Motion for Joinder requesting that we join HTC as a party with the Apple IPR. Paper 12 ("HTC Mot. for Joinder").

In a Decision on Institution entered concurrently herewith, we institute an *inter partes* review in the Apple IPR as to claims 1, 3–6, 11, and 13 of the '789 patent. *See* Apple IPR, Paper 10 ("Apple IPR Dec. on Inst."). The Petition filed in this proceeding is essentially the same as the Petition filed in the Apple IPR. *Compare* Apple IPR, Paper 2, 1–48, *with* Pet. 1–49. HTC, however, represents that is willing to limit the asserted grounds of unpatentability ("grounds") in this proceeding to only those grounds that we determine satisfy the "reasonable likelihood" threshold standard for

institution in the Apple IPR. HTC Mot. for Joinder 3; Apple IPR Dec. on Inst. 17. HTC also represents that, if it is allowed to join the Apple IPR, it will assume an "understudy," i.e., a passive, role and only assume an active role in the event that Apple reaches a settlement agreement with Patent Owner, Parthenon Unified Memory Architecture Limited Liability Corporation ("Parthenon").[1] HTC Mot. for Joinder 6.

Parthenon waived its right to file a Preliminary Response in this proceeding. Paper 9. Parthenon also did not file an opposition to HTC's renewed Motion for Joinder.

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless the information presented in the Petition shows "there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." For the reasons discussed below, we institute an *inter partes* review as to claims 1, 3–6, 11, and 13 of the '789 patent, but only based on the same grounds instituted in the Apple IPR. We also *grant* HTC's Second Motion for Joinder.

II. INSTITUTION OF INTER PARTES REVIEW

In the Apple IPR, we instituted an *inter partes* review as to claims 1, 3–6, 11, and 13 of the '789 patent based on the following grounds: (1) claims 1, 3, 5, 11, and 13 as anticipated under 35 U.S.C. § 102(e) by Lambrecht;[2] (2) claim 4 as unpatentable under 35 U.S.C. § 103(a) over the

[1] For example, in its understudy role, HTC may not file any paper in the Apple IPR independent of Apple, absent our express authorization.
[2] U.S. Patent No. 5,682,484, filed Nov. 20, 1995, issued Oct. 28, 1997 (Ex. 1032, "Lambrecht").

combination of Lambrecht and Artieri;[3] and (3) claim 6 as unpatentable under § 103(a) over the combination of Lambrecht and Moore.[4] Apple IPR Dec. on Inst. 11–14, 17. As we indicated previously, the Petition filed in this proceeding is essentially the same as the Petition filed in the Apple IPR, and HTC is willing to limit the asserted grounds in this proceeding to only those grounds that we determine satisfy the "reasonable likelihood" threshold standard for institution in the Apple IPR. HTC Mot. for Joinder 3; Apple IPR Dec. on Inst. 11–14, 17.

As we explain below, we grant HTC's Second Motion for Joinder. Given that we are granting HTC's Second Motion for Joinder, and Parthenon has waived its right to file a Preliminary Response in this proceeding, we conclude that the information presented in the Petition establishes that there is a reasonable likelihood that HTC would prevail in challenging claims 1, 3, 5, 11, and 13 of the '789 patent as unpatentable under § 102(e), and claims 4 and 6 of the '789 patent as unpatentable under § 103(a). Pursuant to § 314, we institute an *inter partes* review as to these claims of the '789 patent, but only based on the same grounds instituted in the Apple IPR.

III. GRANTING HTC'S MOTION FOR JOINDER

Based on authority delegated to us by the Director, we have discretion to join an *inter partes* review with another *inter partes* review under, subject to certain exceptions not present here. 35 U.S.C. § 315(c). The regulatory

[3] U.S. Patent No. 5,579,052, filed May 24, 1994, issued Nov. 26, 1996 (Ex. 1036, "Artieri").
[4] Gordon E. Moore, *Cramming more components onto integrated circuits*, 38 ELECTRONICS (1965) (Ex. 1035, "Moore").

provisions governing an *inter partes* review proceeding address the appropriate timeframe for filing a motion for joinder. Section 42.122(b) of Title 37 of the Code of Federal Regulations provides, in relevant part, "[a]ny request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested."

The Petition was accorded a filing date of April 7, 2016 (Paper 4, 1), and the Second Motion for Joinder was filed on June 15, 2016. As such, HTC's Second Motion for Joinder was filed timely because joinder was requested no later than one month after the institution date of the Apple IPR.

In its Second Motion for Joinder, HTC contends that joinder is appropriate because this proceeding and the Apple IPR are identical because they involve the same patent, the same prior art references, the same expert declaration, and the same arguments and rationales. *See* HTC Mot. for Joinder 3–5. In other words, HTC asserts that the Petition and supporting evidence filed in this proceeding do not raise any new substantive challenges or procedural issues. *See id*. HTC further argues that joinder will not impact the schedule of the Apple IPR, thereby allowing us to complete one consolidated proceeding in a timely manner, because it is willing to work with counsel for Apple to consolidate all filings and discovery. *Id*. at 4–6. HTC also argues that, if this proceeding is joined with the Apple IPR, Parthenon will not suffer any prejudice because joinder effectively will decrease the number of papers the parties must file, reduce the time and expense for depositions and other discovery required for separate, parallel proceedings, and create certain efficiencies for both us and the parties. *Id.* at 6.

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