

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC., MICROSOFT CORPORATION, MICROSOFT MOBILE
OY, and MICROSOFT MOBILE INC.,
Petitioner,

v.

EVOLVED WIRELESS LLC,
Patent Owner.

Case IPR2017-00927
Patent 8,218,481 B2

Before WILLIAM V. SAINDON, CHRISTOPHER L. CRUMBLEY, and
TERRENCE W. McMILLIN, *Administrative Patent Judges*.

McMILLIN, *Administrative Patent Judge*.

DECISION
Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b)

I. INTRODUCTION

Apple, Inc., Microsoft Corporation, Microsoft Mobile Oy, and Microsoft Mobile, Inc. (f/k/a Nokia Inc.) (“Apple and Microsoft”) filed a Petition requesting an *inter partes* review of claims 1–4, 6, 8–11, and 13 of U.S. Patent No. 8,218,481 B2 (Ex. 1001, “the ‘481 patent”). Paper 2 (“Pet.”). Concurrently, with the Petition, Apple and Microsoft filed a Motion for Joinder with *ZTE (USA) Inc., Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. v. Evolved Wireless, LLC*, Case IPR2016-01342. Paper 3. Patent Owner, Evolved Wireless, LLC (“Evolved Wireless”), has not filed a preliminary response to the Petition¹ or an opposition or any other paper relating to the Motion for Joinder. For the reasons explained below, we grant the Motion for Joinder.

II. THE PETITION WARRANTS INSTITUTION OF *INTER PARTES* REVIEW

According to Apple and Microsoft, the Petition in this proceeding “substantively copies the petition filed in co-pending IPR2016-01342” (Pet. 1) and “includes only the grounds filed in IPR2016-01342 and is substantively identical on those grounds.” Paper 3, 1. For the reasons set forth in our institution decision in IPR2016-01342, *see* Paper 11, we determine that the information presented in the Petition establishes there is a reasonable likelihood that Apple and Microsoft will prevail in showing claims 1–4, 6, 8–11, and 13 of the ’481 patent are unpatentable.

III. GRANT OF MOTION FOR JOINDER

The Petition and Motion for Joinder in this proceeding were accorded a filing date of February 21, 2017. Paper 6, 1. Thus, the Motion for Joinder

¹ The preliminary response was due on June 13, 2017. Paper 6, 1.

was timely because joinder was requested no later than one month after the institution date of IPR2016-01342, i.e., January 20, 2017.² *See* 37 C.F.R. § 42.122(b).

The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads:

If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

By regulation, the Director's discretion has been delegated to the Board. 37 C.F.R. § 42.4(a). A motion for joinder should generally (1) set forth 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.

As noted, the Petition herein asserts the same unpatentability grounds on which we instituted trial in IPR2016-01342. *See* Paper 3, 2–3. Apple and Microsoft also rely on the same prior art analysis and expert testimony submitted by the Petitioner in IPR2016-01342. *See id.* at 4. Indeed, the instant Petition is nearly identical to the Petition in IPR2016-01342 with

² February 20, 2017, was a Federal holiday. *See* 37 C.F.R. § 1.7(a) (“When the day . . . for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or on a Federal holiday within the District of Columbia, the action may be taken . . . on the next succeeding business day.”).

respect to the grounds on which trial was instituted. *See id.* Thus, this *inter partes* review does not present any ground or matter not already at issue in IPR2016-01342.

If joinder is granted, Apple and Microsoft anticipate participating in the proceeding in a limited capacity. *Id.* at 4, 6–7. Apple and Microsoft agree to:

take an “understudy” role as petitioners in other, similarly joined proceedings have taken. In other words, so long as ZTE and Samsung maintain their IPR, all filings by Petitioner in the joined proceeding will be consolidated with the filings of ZTE and Samsung, unless a filing solely concerns issues that do not involve ZTE or Samsung; Petitioner will not introduce any argument or discovery not introduced by ZTE and Samsung; and Petitioner assents to ZTE and Samsung leading any depositions associated with the joined proceeding. Thus, if joined, there will be only one set of briefing on the issues, rather than briefing from both ZTE and Samsung and Petitioner. Petitioner will assume the primary role only if ZTE and Samsung cease to participate.

Id. at 6–7. With regard to the trial schedule, Apple and Microsoft expressly consent to the trial schedule in IPR2016-01342. *Id.* at 5.

The '481 patent is the subject of six other pending IPRs: IPR2016-00758, IPR2016-00981, IPR2016-01342, IPR2016-01349, IPR2017-00068, and IPR2017-00106. *See* Pet. 2. IPR2017-00068 (Paper 11) and IPR2017-00106 (Paper 14) have been joined with IPR2016-00758. IPR2016-01349 (Paper 15) has been joined with IPR2016-00981. IPR2016-01342 (Paper 13) and IPR2016-01349 (Paper 14) have been consolidated for trial with IPR2016-00758 (Paper 24).

The grounds for trial in the consolidated IPR2016-00758 proceedings (Paper 24, 4–5) include all the grounds asserted in the Petition. Pet. 25–26.

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Apple and Microsoft were joined as petitioners in the consolidated IPR2016-00758 proceedings pursuant to the joinder order in IPR2016-00068 (Paper 11, 5) entered February 23, 2017. IPR2016-00758 has been proceeding according to a Revised Scheduling Order (Paper 25) entered February 23, 2017.

On the record before us and having weighed the factors related to joinder, we exercise our discretion to grant the Motion for Joinder.

IV. ORDER

It is hereby:

ORDERED that the Motion for Joinder with IPR2016-01342 (which has been consolidated for trial with IPR2016-00758) is granted;

FURTHER ORDERED that the grounds for trial in IPR2016-00758 remain unchanged; and

FURTHER ORDERED that a copy of this Decision shall be entered into the records of IPR2016-00758 and IPR2016-01342.

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