Trials@uspto.gov
571.272.7822

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION, HTC AMERICA, INC.,
ZTE CORPORATION, AND ZTE (USA), INC.,
Petitioner,

v.

CELLULAR COMMUNICATIONS EQUIPMENT LLC,
Patent Owner.

Case IPR2017-01081
Patent 8,457,676 B2

Before BRYAN F. MOORE, GREGG I. ANDERSON, and JOHN A. HUDALLA, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review and
Grant of Motion for Joinder to IPR2016-01493
37 C.F.R. §§ 42.108, 42.122(b)

I. INTRODUCTION

Petitioner, HTC Corporation, HTC America, Inc., ZTE Corporation, and ZTE (USA), Inc. (collectively, "HTC et al."), filed a Petition ("Pet.") on March 13, 2017 (Paper 1) requesting *inter partes* review of claims 1, 3, 19, and 21 of U.S. Patent No. 8,457,676 B2 ("the '676 patent," Ex. 1001). Pet. 1. Along with the Petition, HTC et al. filed a Motion for Joinder ("Motion," Paper 3) with Case IPR2016-01493, *Apple Inc. v. Cellular Communications Equipment LLC* ("'1493 IPR"), a pending *inter partes* review involving the '676 patent. Paper 3, 1. Cellular Communications Equipment LLC is Patent Owner.

Patent Owner filed a Preliminary Response ("Prelim. Resp.," Paper 9) and an Opposition to Motion for Joinder ("Opp.," Paper 7). Patent Owner opposes HTC et al.'s Motion. Prelim. Resp. 1–11. For the reasons described below, we institute an *inter partes* review of all the challenged claims and grant HTC et al.'s Motion for Joinder.

II. ANALYSIS

We start with whether or not to institute trial and proceed to joinder.

A. Institution of Trial

The Board instituted a trial in the '1493 IPR on the following ground: whether claims 1 and 19 were unpatentable over U.S. Patent Application Publication No. 2004/0223455 to Fong ("Fong") and R2-052744, "Filtering for UE Power Headroom Measurement," TSG-RAN WG2 #49 Meeting, Seoul, Korea, November 7-11, 2005 ("Ericsson") under 35 U.S.C. § 103(a) and whether claims 3 and 21 were unpatentable over the combination of Fong, Ericsson, and U.S. Patent No. 6,445,917 to Bark under 35 U.S.C. § 103(a) ("Bark"). '1493 IPR, slip. op. at 4–5, 18–19 (PTAB January 31,

2017) (Paper 7) ("'1493 DI"). The instant Petition asserts the same grounds as that on which the Board instituted review in the '1493 IPR. *Compare* Pet. 8–64, *with* '1493 DI, 4–5, 18–19; *see also* Paper 3, 3 ("The grounds presented in the present petition are identical to those presented by Apple in its petition [in the '1493 IPR] upon which trial was instituted.").

Patent Owner opposes institution. Prelim. Resp. 1. Patent Owner raises the time bar under 35 U.S.C. § 315(b), which states, in part, "[a]n inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner … is served with a complaint alleging infringement of the patent." *Id.* at 7–8. Patent Owner acknowledges "previous Board decisions permitting institution of copy-cat petitions that would otherwise be time-barred when a request for joinder to an instituted trial is filed with the copy-cat petition." Opp. at 3.

Patent Owner first attempts to distinguish "filing a petition" from a "request for joinder" as precluding joinder under 35 U.S.C. § 315(c). Prelim. Resp. 5–8. This argument is unsupported by any precedent and we decline to accept it. *Id.*

Patent Owner next argues

> [t]he second sentence of §315(b) makes the time-bar inapplicable to the request for joinder, but the statutory language does nothing to alter or affect the institution decision which, according to §315(c), must be made as a prerequisite before joinder can even be considered. In making the institution decision, §315(b) very plainly states that a time-barred petition "may not be instituted . . . ."

Id. at 8. We also decline to determine that 37 C.F.R. § 42.122(b), which allows joinder of an otherwise time-barred Petition, is "not a valid regulation," as Patent Owner argues. *Id.* We are not persuaded by these

arguments and decline to abrogate 37 C.F.R. § 42.122(b) as suggested by Patent Owner and deny institution based on 35 U.S.C. § 315(b).

B. Joinder

An *inter partes* review may be joined with another *inter partes* review, subject to the provisions of 35 U.S.C. § 315(c), which governs joinder of *inter partes* review proceedings:

> (c) JOINDER. – 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 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

As the moving party, HTC et al. bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder should (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, slip. op. at 3–4 (PTAB April 24, 2013) (Paper 15). As noted above, the Petition asserts the same ground and is virtually identical in arguments and evidence to the petition in the '1493 IPR.

HTC et al. filed its Motion for Joinder on March 13, 2017. Paper 3. The Board instituted *inter partes* review in the '1493 IPR on February 13, 2017. '1493 IPR, Paper 7. Accordingly, the filing date of the Motion satisfies the joinder filing requirement, as set forth in 37 C.F.R. § 42.122. *See* 37 C.F.R. § 42.122(b) (2016) ("Any request for joinder must be filed . . .

no later than one month after the institution date of any *inter partes* review for which joinder is requested").

We have reviewed Patent Owner's arguments (*see* Opp. 7–11) opposing the Motion for Joinder, which are similar to those discussed above. *See supra* § II.A. We find them unpersuasive for the same reasons. Patent Owner first argues the Motion was not authorized by the Board. *Id.* at 6–7. However, as noted above, our regulations authorize the filing of a motion for joinder "no later than one month after the institution date of any *inter partes* review for which joinder is requested." 37 C.F.R. § 42.122(b). Patent Owner next argues that the Petition is untimely under 35 U.S.C. § 315(b) because it was filed more than a year after HTC et al. were served with the complaint in the underlying litigation. Opp. 7–11. As such, Patent Owner argues joinder is not permitted under 35 U.S.C. § 315(c) because the Petition was not properly filed in the first instance. *Id.* Yet Patent Owner cites no authority for its argument. Further, § 315(c) allows the Board, under the authority of the Director, to exercise its discretion and join parties to an *inter partes* review previously instituted.

Under the current schedule for the '1493 IPR, several of Petitioner's due dates have passed. Most notably, Petitioner's Reply date, August 14, 2017, has passed. *See* '1493 IPR (Scheduling Order, Paper 8). HTC et al. agreed, however, to take an understudy role to petitioner Apple in the '1493 IPR. *See also* Paper 2, 8–9 (assurances). As explained below, we go further and adopt Patent Owner's suggestions to ensure the efficient completion of the '1501 IPR.

HTC et al. also demonstrates sufficiently that joinder will promote efficiency. *See id.* Absent Board authorization, HTC et al. will not actively participate in further proceedings. HTC et al. is not authorized to file any

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