UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., MICROSOFT CORPORATION, MICROSOFT MOBILE OY, AND MICROSOFT MOBILE INC. (f/k/a NOKIA INC.)
Petitioner

v.

EVOLVED WIRELESS LLC,
Patent Owner

Case IPR2017-00068
Patent 8,218,481

PETITIONER'S MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c) AND 27 C.F.R. § 42.122(b), AND REQUEST FOR SHORTENED RESPONSE TIME FOR PATENT OWNER'S PRELIMINARY RESPONSE

I. RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Apple, Inc., Microsoft Corporation, Microsoft Mobile Oy, and Microsoft Mobile Inc. (f/k/a Nokia Inc.), Inc. ("Petitioner") hereby moves for joinder of any proceeding resulting from its new Petition for *Inter Partes* Review ("IPR") of United States Patent No. 8,218,481 ("the '481 patent") — filed concurrently with this Motion— with the recently instituted IPR for the '481 patent, IPR2016-00758, naming ZTE (USA) Inc., HTC Corporation, and HTC America, Inc. (hereinafter collectively "ZTE and HTC") as petitioner.

In conjunction with this request for joinder, Petitioner respectfully requests that the Board specify a shortened response period in which Patent Owner Evolved Wireless, LLC ("Patent Owner") may file a Preliminary Response to this new Petition. The new Petition includes only the grounds filed in IPR2016-00758 and is substantively identical on those grounds.[1] Given the identity of issues presented by this new Petition and those raised by ZTE and HTC in the prior co-pending

[1] The petitions, of course, are not wholly identical. The present Petition has been updated to account for the formalities of a different Petitioner and real parties in interest, the related matters have been updated, and there are nominal clerical changes.

proceeding, the proposal for a shortened response period does not impose an undue burden on Patent Owner. Moreover, in establishing a shortened deadline, the Board will provide itself with more time before the institution decision is due to consider any additional information furnished by Patent Owner in its Preliminary Responses to the new Petition, if any is raised.

Even if the Board declines to establish the proposed shortened response deadline for the Preliminary Response, Petitioner nevertheless maintains its motion for joinder.

II. STATEMENT OF MATERIAL FACTS

1. On March 23, 2016, ZTE and HTC filed a Petition for *Inter Partes* Review of US Patent No. 8,218,481, challenging claims 1-4, 6, 8-11 and 13 under §102(a), §102(b), and §103(a). On June 29, 2016, Patent Owner filed its Preliminary Responses in IPR2016-00758. On September 16, 2016, the Board issued an institution decision and scheduling order in IPR2016-00758.

2. On October 14 2016, Petitioner filed this Petition for *Inter Partes* Review ("IPR") of US Patent No. 8,218,481, challenging claims 1-4, 6, 8-11 and 13 under §102(a), §102 (b) and §103(a).

3. This new Petition for IPR challenges the same claims of the '481 patent using the same grounds as ZTE and HTC's previous Petition for IPR of the

'481 patent (i.e., IPR2016-00758). Moreover, as noted above, this new Petition is substantively identical as to those grounds, and presents no new issues.

III. DISCUSSION

The requested joinder will serve to secure the just, speedy, and inexpensive resolution of these proceedings. Under 35 U.S.C. § 315(c):

> 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.

In addition, 37 C.F.R. § 42.122(b) provides that "[j]oinder may be requested by a patent owner or petitioner. Any 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."

This Motion is timely under § 42.122(b) because ZTE and HTC's Petition for IPR was instituted on September 16, 2016. Moreover, at the time of this filing, IPR2016-00758 is pending.

The Board has further provided that 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 of the existing proceeding; and (4) address specifically how briefing and discovery may be simplified. *See, e.g.*, *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (Apr. 24, 2013). Analysis of these factors here warrants the Board's use of its discretion to grant the requested joinder.

A. *Joinder is Appropriate Because Both Proceedings Involve the Same Prior Art, the Same Claims, and the Same Grounds of Unpatentability – No New Grounds Are Presented*

The challenged claims and grounds of Petitioner's petition are substantively identical to claims and grounds presented in the petition filed by ZTE and HTC (IPR2016-00758). The same prior art, and even the same expert and expert declaration, are used in both proceedings. Petitioner proposes no new grounds of unpatentability. This strongly supports application of joinder.

Moreover, if joined, Petitioner agrees to take an "understudy" role as petitioners in other similarly joined proceedings have taken. *See* IPR2015-01353, Decision, paper 11 at 6 (October 5, 2015), granting institution and joinder where petitioner requested an "understudy role". *See also*, IPR2014-00550, paper 38 at 5 (April 10, 2015).

Accordingly, for at least the reasons outlined in this motion, any proceeding resulting from Petitioner's new IPR petition should appropriately be joined to the

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