

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE CORPORATION, and ZTE (USA), Inc.,
Petitioners,

v.

CELLULAR COMMUNICATIONS EQUIPMENT LLC,
Patent Owner

Case IPR2017-01079
Patent 8,457,676

**PETITIONER'S REPLY TO PATENT OWNER'S OPPOSITION TO
MOTION FOR JOINDER TO RELATED INSTITUTED *INTER PARTES*
REVIEW UNDER 35 U.S.C. 315(c), 37 C.F.R. §§ 42.22 AND 42.122(b)**

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Patent Trial and Appeal Board
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I. Prior authorization for the motion for joinder was not required

Patent Owner first argues that the motion for joinder should be denied because prior authorization was required. Paper 7 at 5-6. This is incorrect. “No prior authorization is required for filing the motion for joinder with the petition.” Frequently Asked Question H5, <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/ptab-e2e-frequently-asked-questions> (last visited May 12, 2017). The Trial Practice Guide agrees: no authorization is required for motions filed with a petition. Trial Practice Guide, 77 Fed. Reg. 157 at 48762 (exceptions to the requirement for prior authorization include “motions where it is impractical to seek prior Board authorization” such as “motions filed with a petition.”). The motion for joinder was filed with the petition in this case. Therefore no prior authorization was required.

II. The Board has correctly interpreted 35 U.S.C. § 315(b) and (c)

Patent Owner’s only other argument against joinder is to dispute the Board’s well-settled interpretation of 35 U.S.C. § 315(b) and (c) and the related regulations. Specifically, Patent Owner contends that the one-year time bar applies to petitions filed with requests for joinder despite the plain language in § 315(b) stating that it does not. Paper 7 at 6-11. Patent Owner is incorrect.

Section 315(b) bars institution on a petition filed more than one year after the petition was served with a complaint, but it expressly states that the one-year bar does not apply to one involving a request for joinder:

(b) Patent Owner's Action.—An 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, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent. **The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).**

35 U.S.C. § 315(b) (emphasis added). The final sentence is directly linked to the first sentence by the words “the preceding sentence.” The only “time limitation” set forth in the first sentence relates to the **filing of a petition** for *inter partes* review. That is consistent with § 315(c), which states that a party requesting joinder does so **by filing a petition**. *Id.* at § 315(c) (“**Joinder**. – [T]he director . . . may join as a party to the inter partes review any person **who properly files a petition . . .**”). Thus, *the* “time limitation set forth in the preceding sentence” that “does not apply to a request for joinder” is the time limit to file a petition for *inter partes* review accompanied with a request to join an instituted proceeding.

The Board has affirmed that interpretation on many occasions. IPR2016-00062, Paper 14 at 3-4; IPR2015-00825, Paper 20 at 10-12; IPR2014-00557, Paper 10 at 14-15; *Target Corporation v. Destination Maternity Corporation*, IPR2014-

00508, Paper 28 at 15; IPR2013-00386, Paper 16 at 4-6; IPR2013-00385, Paper 17 at 4-6; IPR2013-00256, Paper 10 at 3-4; IPR2013-00250, Paper 24 at 3 (listed on PTAB e2e as Paper 25); IPR2013-00109, Paper 15 at 3-4. Indeed, as patent owner acknowledges, this interpretation of 35 U.S.C. § 315(b) is inherent in the Board's rules for conduct of *inter partes* review, which state that:

(b) Request for joinder. Joinder 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. **The time period set forth in §42.101(b) shall not apply when the petition is accompanied by a request for joinder.**

37 C.F.R. §42.122(b) (emphasis added); *see also* Paper 7 at 9-10, fn 1

(acknowledging that the Board's regulations expressly contradict Patent Owner's position).

Patent Owner's interpretation is also incorrect because it would render the statute incomplete and illogical. Patent Owner apparently contends that "request for joinder" in § 315(b) refers only to a joinder motion, not the accompanying petition, and thus the time-bar exception applies only to the motion. Yet § 315 makes no mention of a joinder motion, let alone a time limitation on filing such a motion. In contrast, it does state that joinder is achieved by filing a petition, *see* § 315(c), and it expressly provides a time limitation on filing a petition, *see* § 315(b).

The only logical reading of "request for joinder" that gives meaning to that provision is therefore one that refers to the petition itself.

Patent Owner also wrongly argues that because § 315(c) requires that the joinder petition be “properly file[d] under section 311,” and because § 311 states that petitions must be filed “[s]ubject to the provisions of this chapter,” the joinder petition must meet § 315(b)’s time bar for the petition to be properly filed as required by § 315(c). Paper 7 at 8-9. The Board has considered, and rejected, that argument. *E.g.*, IPR2013-00385, Paper 17 at 5-6 (rejecting the argument that “properly fil[ing] a petition under section 311” requires “filing a petition within one year as required by Section 315(b)”). Indeed, Patent Owner’s argument is circular and effectively reads-out the express exception in the second sentence of § 315(b). *U.S. v. Atlantic Research Corporation*, 551 U.S. 128, 137 (2007) (“We must have regard to all the words used by Congress, and as far as possible give effect to them.”). Thus, a joinder petition—that is, a petition filed as a request for joinder—is not subject to the time-bar in § 315(b), and it is "properly filed" if it meets the requirements enumerated in § 311.

Finally, despite Patent Owner's argument, *see* Paper 7 at 9, the timing of when the Director may join a party to an instituted proceeding does not dictate or support Patent Owner's tortured interpretation. The provisions of § 315(c) merely require that for a joinder petition, like any other petition, the Director may only

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