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Paper 15
Entered: May 30, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

INVT SPE LLC,
Patent Owner.

Case IPR2019-00958
Patent 7,848,439 B2

Before THU A. DANG, KEVIN F. TURNER, and BARBARA A. BENOIT, *Administrative Patent Judges*.

BENOIT, *Administrative Patent Judge*.

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

I. INTRODUCTION

Apple Inc. ("Petitioner" or "Apple") filed a petition (Paper 1, "Pet.") seeking *inter partes* review of claims 1–7 of U.S. Patent No. 7,848,439 B2 (Ex. 1001, "the '439 patent" or "the challenged patent"). On the same day, Petitioner filed a Motion for Joinder with *HTC Corp. v. INVT SPEC LLC*, IPR2018-01555 ("the HTC IPR"). Paper 4 ("Mot.").[1] Patent Owner, INVT SPE LLC, filed a Preliminary Response and Response in Opposition to Petitioner's Motion for Joinder. Paper 8 ("Prelim. Resp.").

For the reasons described below, we institute an *inter partes* review of claims 1–7 of the challenged patent and grant Petitioner's Motion for Joinder.

A. Related Matters

As required by 37 C.F.R. § 42.8(b)(2), each party identifies various judicial or administrative matters that would affect or be affected by a decision in this proceeding. Pet. 1; Paper 6 (Patent Owner's Mandatory Notice), 2–3. The parties identify several district court proceedings and a U.S. International Trade Commission Investigation involving the challenged patent. Pet. 1; Paper 6, 2. Patent Owner additionally identifies various proceedings involving petitions for *inter partes* review. Paper 6, 2–3.

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[1] On April 8, 2019, Petitioner filed two copies of its Motion for Joinder as Papers 3 and 4. In the PTAB E2E electronic filing system, Petitioner identified Paper 3 as Paper Type "Other," whereas Petitioner identified Paper 4 as Paper Type "Motion." We refer to the later-filed Paper 4 as Petitioner's Motion for Joinder.

B. The Asserted Ground of Unpatentability

Petitioner challenges claims 1–7 of the '439 patent as unpatentable under 35 U.S.C. § 103[2] over the following references:

> U.S. Patent No. 6,904,283 B2, filed April 17, 2001, issued June 7, 2005 (Ex. 1003, "Li");
>
> U.S. Patent No. 7,221,680 B2, filed September 1, 2004, issued May 22, 2007 (Ex. 1004, "Vijayan"); and
>
> U.S. Patent No. 6,721,569 B1, filed September 29, 2000, issued April 13, 2004 (Ex. 1005, "Hashem").

Pet. 3. In its challenges, Petitioner cites to the references and declaration testimony from Zhi Ding, Ph.D. (Exhibit 1007). Pet. 3, 11–75.

II. DISCUSSION

A. Three Petitions Challenging Claims of the '439 Patent

In addition to the instant Petition challenging claims 1–7 of the '439 Patent, Petitioner and ZTE (USA) Inc. filed a petition in IPR2018-01477 challenging claims 1–11 of the '439 Patent and relying on Li, Vijayan, and U.S. Patent No. 7,885,228 B2 ("Walton"). IPR2018-01477, Paper 1 ("1477 Dec."), 9.[3] On March 7, 2019, we denied institution after concluding that the information presented in the petition did not show a reasonable

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[2] The Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112–29, 125 Stat. 284, 287–88 (2011), revised 35 U.S.C. § 103 effective March 16, 2013. Because the challenged patent was filed before March 16, 2013, we refer to the pre-AIA version of § 103.

[3] Specifically, Apple and ZTE (USA) Inc. asserted claims 1, 3, and 5–11 would have been obvious under 35 U.S.C. § 103 over Li and Walton and claims 2 and 4 would have been obvious over Li, Walton, and Vijayan. 1477 Dec. 9.

likelihood that Petitioner would prevail with respect to claims 1–11. 1477 Dec. 37.

On the same day, we instituted an *inter partes* review of claims 1–7 of the '439 patent under 35 U.S.C. § 103 over Li, Vijayan, and Hashem in IPR2018-01555 ("the HTC IPR") based on a petition filed by HTC Corp. and HTC America, Inc. (collectively, "the HTC Petitioner"). IPR2018-01555, Paper 1 ("HTC Petition" or "HTC Pet."), Paper 8 ("HTC Dec."), 2; IPR2018-01555, Paper 10.

B. Reasonable Likelihood of the Instant Petition

Institution of an *inter partes* review is authorized by statute when "the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a); *see* 37 C.F.R § 42.4(a) (delegating authority to institute trial to the Board). We address whether the Petition in this proceeding reaches the institution threshold before turning to Petitioner's Motion for Joinder and considering whether to exercise our discretion under 35 U.S.C. § 314(a).

The Petition in this proceeding asserts the same ground of unpatentability as the one on which we instituted review in the HTC IPR. *Compare* Pet. 3, 11–75, *with* HTC Pet. 3, 12–83; *see also* HTC Dec. 8, 17–46 (discussing asserted grounds). The Petition relies on the same expert declaration relied on in the HTC Petition. Mot. 4; Pet. 3 (relying on declaration testimony of Zhi Ding, Ph.D. (Ex. 1007)); HTC Dec. 8 (noting petition relies on declaration testimony of Zhi Ding, Ph.D. (Ex. 1007)). Indeed, Petitioner contends that the Petition "is substantively identical to the

HTC Petition, containing only minor differences related to formalities of a different party filing the petition as well as" arguments related to discretionary denial of the Petition. Mot. 4.

Patent Owner's Preliminary Response does not address Petitioner's prior art, arguments, or evidence. *See generally* Prelim. Resp.

For the reasons set forth in our institution decision in the HTC IPR, we determine the information presented in the instant Petition shows a reasonable likelihood that Petitioner would prevail in showing claims 1–7 would have been obvious over Li, Vijayan, and Hashem. *See* HTC Dec. 17–46.

C. Petitioner's Motion for Joinder

We have authority under 35 U.S.C. § 315(c) to join a properly filed *inter partes* review petition to an instituted *inter partes* review. A motion for joinder must be filed "no later than one month after the institution date of any *inter partes* review for which joinder is requested." 37 C.F.R. § 122(b).

The Petition in this proceeding was accorded a filing date of Monday, April 8, 2019. Paper 5 (Notice of Filing Date Accorded). The HTC IPR was instituted on March 7, 2019. HTC Dec. 1. Petitioner contends that its Motion for Joinder is timely because joinder was requested no later than one month after the institution of the HTC IPR. Mot. 3; *see* 35 U.S.C. § 21(b) ("When . . . the last day . . . for taking any action . . . in the United States Patent and Trademark Office falls on . . . Sunday . . . , the action may be taken . . . on the next succeeding secular or business day."); 37 C.F.R. § 1.7 (Expiration on Saturday, Sunday or Federal Holiday). We agree that Petitioner's Motion for Joinder is timely.

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