

Iturralde, Enrique W.

From: Lavenue, Lionel <lionel.lavenue@finnegan.com>
Sent: Wednesday, January 30, 2019 4:38 PM
To: Iturralde, Enrique W.; Schulz, Bradford; Bell, Cory
Cc: AGIS-Lit; Hartman, Sarah G.
Subject: RE: ZTE v. AGIS IPRs

Hello Enrique,

I appreciate the citation to my 2013 article, however, as you are aware, the caselaw is ever changing. And, not only has the caselaw changed, but the circumstances here are much different.

Your understanding of the issues is also incorrect, and your conclusion that, "because ZTE chose the district court as its forum to challenge the validity of these patents, ZTE is statutorily barred from filing and maintaining these petitions," is also flawed. The issue here is different from your erroneous characterization, at least because we filed a joinder petition and because of the differing factual circumstances.

As to joinder, in particular, the statute permits joinder by "**any person who properly files** a petition under section 311." 35 U.S.C. 315(c) (emphasis added). In view of this statutory language regarding "any person" that may file for joinder, the Board has concluded that, "when 'any person' is read in light of § 311(a), the only person excluded by the language is the owner of the patent at issue." *Target v. Destination Maternity Co.*, Case IPR2014-00508, Paper 28, p. 7 (PTAB 2015) (expanded panel). Accordingly, ZTE--which is not the patent owner--was permitted to request joinder under the statute.

Thus, ZTE will not withdraw its IPR2019-00389 ('838 patent), IPR2019-00485 ('970 patent), and IPR2019-00487 ('055 patent) petitions.

Of course, if you wish to further discuss these matters with the Board, then feel free to do so at your convenience.

Regards,

Lionel

From: Iturralde, Enrique W. <EIturralde@brownrudnick.com>
Sent: Monday, January 28, 2019 3:21 PM
To: Lavenue, Lionel <lionel.lavenue@finnegan.com>; Schulz, Bradford <Bradford.Schulz@finnegan.com>; Bell, Cory <Cory.Bell@finnegan.com>
Cc: AGIS-Lit <agislit@brownrudnick.com>; Hartman, Sarah G. <SHartman@brownrudnick.com>
Subject: ZTE v. AGIS IPRs

EXTERNAL Email:

Hi Lionel,

I write to request that ZTE immediately withdraw its frivolous IPR petitions against AGIS in IPR2019-00389 ('838 patent), IPR2019-00485 ('970 patent), and IPR2019-00487 ('055 patent). ZTE filed these petitions after filing its October 9, 2018 complaint for declaratory judgment for invalidity of the same patents in the Northern District of California. As you

already know, Section 315(a)(1) prohibits a declaratory-judgment plaintiff from filing an IPR petition if the plaintiff filed a declaratory judgment complaint for invalidity before filing the IPR petition. (See <https://www.finnegan.com/en/insights/behind-bars-a-closer-look-at-the-statutory-bars-for-filing-inter.html>.) Accordingly, because ZTE chose the district court as its forum to challenge the validity of these patents, ZTE is statutorily barred from filing and maintaining these petitions.

ZTE lacked the requisite Rule 11 basis to file the petitions, and ZTE has no Rule 11 basis to maintain any petitions on the '838, '970, and '055 patents. ZTE's petitions advance frivolous grounds by statutorily-barred party and constitute an improper use of these proceedings. AGIS has been diligent in reviewing ZTE's filings and preparing responses to the petitions. AGIS reserves all rights and remedies, particularly for sanctions under 37 CFR 42.12, should ZTE maintain these petitions.

Please confirm, by 5:00 PM ET Wednesday, January 28th, that ZTE will withdraw its petitions in IPR2019-00389, IPR2019-00485, and IPR2019-00487.

Regards,
Enrique



Enrique W. Iturralde

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