

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

AGIS SOFTWARE DEVELOPMENT, LLC,
Patent Owner

Case IPR2019-00485
Patent 8,213,970

MOTION FOR JOINDER TO *INTER PARTES* REVIEW
(35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b))

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioners HTC Corporation and HTC America, Inc. (respectively “HTC”) and ZTE (USA), Inc. (“ZTE”), (collectively “Petitioners”) move for joinder with the *Inter Partes* Review of U.S. Patent No. 8,213,970 (“the ’970 patent”), for which trial was recently instituted on November 20, 2018. IPR2018-01079, paper 9 (IPR2018-01079 referred to herein as the “Google IPR”). This motion is timely because it is filed within one month of institution of the Google IPR. 37 C.F.R. § 42.122(b). Petitioners understand that the petitioners in the Google IPR (“the Google Petitioners”) do not oppose Petitioners’ requests for joinder.

Petitioners request institution of the concurrently filed Petition for *Inter Partes* Review. The Petition is a carbon copy of the original Google IPR petition in all material respects. The only substantive changes are in the introduction to identify the correct Petitioners, the mandatory notices under 37 C.F.R. § 42.8(b), and changing “Google” to state “Petitioners.” The concurrently filed Petition and the Google IPR petition challenge the same claims of the ’970 patent on the same

grounds relying on the same prior art and evidence, including a declaration identical in substance from the same expert.¹

Petitioners agree to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the Google IPR as instituted. Thus, the Petition warrants institution under 35 U.S.C. § 314, and 35 U.S.C. § 315(c) permits Petitioners' joinder to the Google IPR.

Further, if joined, Petitioners agree to adhere to all applicable deadlines in the Google IPR and coordinate all filings with Google Petitioner in the Google IPR. The Google Petitioner will maintain the lead role in the proceedings so long as it is a party to the proceedings and is not estopped under § 315(e)(1). Petitioners will only assume the lead role in the proceedings if the Google Petitioner is no longer a party to the proceedings. Petitioners agree to consolidated filings for all substantive papers in the proceeding. The Google Petitioner and Petitioners will be jointly responsible for the consolidated filings. Petitioners will not advance any arguments separate from those advanced by the Google Petitioner in the consolidated filings. These limitations will avoid lengthy and duplicative briefing. Also, Petitioners will not seek additional depositions or deposition time, and Google Petitioner will lead

¹ The declaration has been updated only to reflect retention by Petitioners and is otherwise identical to the declaration submitted in the Google IPR.

deposition questioning and hearing presentations. Petitioners agree to the foregoing conditions even in the event that other IPRs filed by other, third-party petitioners are joined with the Google IPR.

Joinder will help efficiently resolve the disputes among the parties. By joinder, a single Board decision may dispose of the issues raised in the Google IPR for all interested parties. Further, the '970 patent is material in district court against ZTE (USA), Inc., as well as HTC Corporation and HTC America, Inc. Joinder will estop ZTE and HTC from asserting in district court those issues resolved in a final decision from the Google IPR, thus narrowing the issues in the district court actions. *See* 35 U.S.C. § 315(e)(2). Finally, joinder would not complicate or delay the Google IPR, and would not adversely affect any schedule set in that proceeding. In sum, joinder would promote efficient adjudication in multiple forums. On the other hand, if instituted, maintaining the Petitioners' IPR proceeding separate from that of the Google IPR would entail needless duplication of effort.

Joinder will not unduly prejudice any party. Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or increase needless filings, any additional costs on the Patent Owner would be minimal. On the other hand, denial of joinder would prejudice ZTE and HTC. Their interests may not be adequately protected in the Google IPR proceedings, particularly if the Google

Petitioner settles with the Patent Owner. Petitioners should be allowed to join in a proceeding affecting a patent asserted against them.

II. BACKGROUND AND RELATED PROCEEDINGS

AGIS Software Development LLC (the “Patent Owner”) is the owner of the ‘970 patent. The ‘970 patent is material in several district court cases:

Heading	Number	Court	Filed
<i>AGIS Software Development LLC v. HTC Corporation</i>	2:17-cv-00514	E.D. Tex.	June 21, 2017
<i>AGIS Software Development LLC v. Huawei Device USA Inc. et al.</i>	2:17-cv-00513	E.D. Tex.	June 21, 2017
<i>AGIS Software Development LLC v. Apple, Inc.</i>	2:17-cv-00516	E.D. Tex.	June 21, 2017
<i>AGIS Software Development LLC v. LG Electronics, Inc.</i>	2:17-cv-00515	E.D. Tex.	June 21, 2017
<i>ZTE (USA) Inc. v. AGIS Software Development LLC et al. (formerly 2:17-cv-00517 in E.D. Tex.)</i>	4:18-cv-06185	N.D. Cal.	Oct. 9, 2018

On May 15, 2018, Google filed its IPR petition, IPR2018-01079, against the ‘970 patent. The Board instituted the Google IPR on November 20, 2018. Petitioners here timely move for joinder with the Google IPR.

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