

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC,
Petitioner,

v.

INVT SPE LLC,
Patent Owner.

Patent No. 7,848,439 B2
Issued: December 7, 2010
PCT Filed: November 18, 2005
§371 Date: May 17, 2007
Inventors: Xiaoming She, Jifeng Li
Title: COMMUNICATION APPARATUS, COMMUNICATION
SYSTEM, AND COMMUNICATION METHOD

Inter Partes Review No. IPR2019-00958

**MOTION FOR JOINDER UNDER
35 U.S.C. § 315(c) AND 37 C.F.R. §§ 42.22 AND 42.122(b)
TO RELATED *INTER PARTES* REVIEW IPR2018-01555**

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Apple Inc. (“Petitioner”) respectfully submits this Motion for Joinder, together with a Petition for *Inter Partes* Review of U.S. Patent No. 7,848,439 (“the Apple Petition”) filed contemporaneously herewith. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner requests institution of an *inter partes* review and joinder with the *inter partes* review in *HTC Corporation and HTC America, Inc. v. INVT SPE LLC*, IPR2018-01555 (“the HTC IPR”), which the Patent Trial and Appeal Board (the “Board”) instituted on March 7, 2019. Petitioner’s request for joinder is timely under 37 C.F.R. §§ 42.22 and 42.122(b) as it is submitted no later than one month after the March 7, 2019 institution date of the HTC IPR. The Apple Petition is also narrowly tailored to the same claims, prior art, and grounds for unpatentability that are the subject of the HTC IPR. In addition, Petitioner is willing to streamline discovery and briefing.

Petitioner submits that joinder is appropriate because it will not unduly burden or prejudice the parties to the HTC IPR while efficiently resolving the question of the ’439 Patent’s validity in a single proceeding.

II. STATEMENT OF MATERIAL FACTS

1. INVT SPE LLC (“INVT” or “Patent Owner”) filed civil actions against Apple Inc., Case No. 2:17-cv-03738, in the U.S. District Court for the District of New Jersey, on May 25, 2017, HTC Corporation et al., Case No. 2:17-cv-03740, in the U.S. District Court for the District of New Jersey on May 25, 2017 and ZTE Corporation et

al., Case No. 2:17-cv-06522, in the U.S. District Court for the District of New Jersey on August 29, 2017.

2. On August 22, 2018, HTC filed a petition for *inter partes* review (IPR2018-01555) requesting cancellation of claims 1-7 of the '439 Patent.

3. On March 7, 2019, the Board instituted HTC's petition for *inter partes* review on all proposed grounds, finding that a reasonable likelihood existed that HTC's petition for *inter partes* review would prevail in showing unpatentability of claims 1-7 of the '439 Patent. *See* IPR2018-01555, Decision Instituting IPR Review, Paper No. 8.

4. On August 21, 2018, Apple filed a petition for *inter partes* review (IPR2018-01477) requesting cancellation of claims 1-11 of the '439 Patent.

5. On March 7, 2019, the Board denied institution of Apple's petition for *inter partes* review on all proposed ground. *See* IPR2018-01477, Decision Denying Institution, Paper No. 11.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Board has the authority under 35 U.S.C. § 315(c) to join a properly filed *inter partes* review petition to an instituted *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). A motion for joinder must be filed within one month of the Board instituting an original *inter partes* review. 37 C.F.R. § 42.122(b). In deciding whether to exercise its discretion and permit joinder, the Board considers factors, including: (1) the reasons

why joinder is appropriate; (2) whether the new petition presents any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See Kyocera Corporation v. Softview LLC*, IPR2013- 00004, Paper 15 at 4 (April 24, 2013).

B. Petitioner’s Motion for Joinder is Timely

This Motion for Joinder is timely because it is filed within one month of the March 7, 2019 institution decision of the HTC IPR. *See* 37 C.F.R. § 42.122(b). Further, the one-year bar set forth in 37 C.F.R. § 42.101(b) does not apply to the Apple Petition because this Motion for Joinder is filed concurrently with the Apple Petition. 37 C.F.R. §42.122(b).

C. Each Factor Weighs in Favor of Joinder

Each of the four factors considered by the Board weighs in favor of joinder here. Specifically, the Apple Petition does not present any new grounds of unpatentability; rather it is substantively identical to the HTC Petition. Further, joinder will have minimal, if any, impact on the trial schedule, as all issues are substantively identical and Petitioner will accept an “understudy” role. *See* IPR2015- 01353, Decision Instituting IPR Review, Motion for Joinder, paper 11 at 6; (granting IPR where petitioners requested an “understudy” role); *see also* IPR2015-01353, Motion for Joinder, paper 4 at 5-7. Lastly, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

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