

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.,
Petitioner

v.

BELL NORTHERN RESEARCH, LLC,
Patent Owner.

Case IPR2020-00108
U.S. Patent No. 8,416,862

PETITIONER'S MOTION FOR JOINDER

I. STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner, LG Electronics, Inc. (“LG” or “Petitioner”) and its real parties in interest¹ move for joinder with the *Inter Partes* Review of U.S. Patent No. 8,416,862 (“the ’862 patent”), *Huawei Technologies Co., Ltd. v. Bell Northern Research, LLC*, IPR2019-01439 (“the Huawei IPR”), which was filed on August 2, 2019. *See* IPR2019-01439, Paper 2. This motion is timely because it is being filed before the Board has reached a decision on institution in the Huawei IPR. 37 C.F.R. § 42.122(b).

Petitioner requests institution of the Petition for *Inter Partes* Review being filed concurrently herewith. The Petition is a copy of the original Huawei IPR petition in all material respects. The concurrently-filed Petition and the Huawei IPR petition challenge the same claims of the ’862 patent on the same grounds relying on the same prior art and evidence, including an identical declaration from the same expert.²

¹ LG Electronics, Inc., LG Electronics U.S.A., Inc. and LG Electronics Mobile Research U.S.A., LLC are real parties in interest, as identified in the Petition.

² The expert declaration is an exact duplicate of the declaration filed in IPR2019-01439.

Petitioner agrees to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the Huawei IPR. Thus, the Petition warrants institution under 35 U.S.C. § 314, and joinder to the Huawei IPR under 35 U.S.C. § 315(c).

Further, upon joining the Huawei proceeding, Petitioner will act as an “understudy” and will not assume an active role unless the Huawei Petitioner ceases to participate in the IPR, such as in the instance the Huawei Petitioner settles with Patent Owner. The Huawei Petitioner will maintain the lead role in the proceeding so long as it is a party to the proceeding. Petitioner will only assume the lead role in the proceeding if the Huawei Petitioner is no longer a party to the proceeding or is unable to advance arguments for one or more claims, or grounds. Absent a Board order precluding the Huawei Petitioner from making arguments that would otherwise be available to Petitioner, Petitioner will not advance any arguments separate from those advanced by the Huawei Petitioner. These limitations will avoid lengthy and duplicative briefing. Also, Petitioner will not seek additional depositions or deposition time. Petitioner agrees to the foregoing conditions even in the event that other IPRs filed by other, third-party petitioners are joined with the Huawei IPR. Accordingly, the proposed joinder will neither unduly complicate the Huawei IPR nor delay its schedule.

In fact, joinder will help efficiently resolve the disputes among the parties. By joinder, a single Board decision may dispose of the issues raised in the Huawei IPR for all interested parties. Further, the Patent Owner has asserted the '862 patent in district court against LG Electronics, Inc., LG Electronics U.S.A., Inc., and LG Electronics Mobile Research U.S.A., LLC. Joinder will, thus, narrow the issues in the district court actions. *See* 35 U.S.C. § 315(e)(2). Finally, joinder would not complicate or delay the Huawei IPR, and would not adversely affect any schedule set in that proceeding. In sum, joinder would promote efficient adjudication in multiple forums.

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 Petitioner. Its interests may not be adequately protected in the Huawei IPR proceeding, particularly if the Huawei Petitioner settles with the Patent Owner. Petitioner should be allowed to join in a proceeding affecting a patent asserted against them.

II. BACKGROUND AND RELATED PROCEEDINGS

Bell Northern Research, LLC (the "Patent Owner") is the purported owner of the '862 patent. The Patent Owner asserted the '862 patent against Petitioner in *Bell Northern Research, LLC v. LG Electronics, Inc., et al.*, Case No. 3:18-cv-

02864 (S.D. Cal.), which was filed with the District Court on Dec. 20, 2018.

Patent Owner has also asserted the '862 against other parties, including the Huawei Petitioner, in the following actions:

- *Bell Northern Research, LLC v. Huawei Technologies Co., Ltd., et al.*, Case No. 3:18-cv-1784 (S.D. Cal.) – filed Aug. 1, 2018,
- *Bell Northern Research, LLC v. Kyocera Corporation, et al.*, Case No. 3:18-cv-1785 (S.D. Cal.) – filed Aug. 1, 2018, and
- *Bell Northern Research, LLC v. ZTE Corporation, et al.*, Case No. 3:18-cv-1786 (S.D. Cal.) – filed Aug. 1, 2018.

In addition, U.S. Patent No. 8,416,862 is the subject of the following *inter partes* review:

- *ZTE (USA) Inc., et al. v. Bell Northern Research, LLC*, IPR2019-01438 (“Huawei IPR”) – filed August 2, 2019, and
- *Huawei Technologies Co., Ltd., v. Bell Northern Research, LLC*, IPR2019-01439 (“Huawei IPR”) – filed August 2, 2019.

The Huawei IPR (IPR2019-01439) raises grounds, evidence, and issues that are different from those raised in the ZTE IPR (IPR2019-01438). *See Huawei*, IPR2019-01439, Paper No. 2; *ZTE (USA)*, IPR2019-01438, Paper No. 1.

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