

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

In the Patent of: **Yang, Xiu Zheng**, Shulin (TW);
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Title: METHOD FOR CONSTRUCTING FRAME STRUCTURES

**PETITIONER'S MOTION FOR JOINDER UNDER 35 U.S.C.
§ 315(c), 37 C.F.R. § 42.22, AND 42.122(b)**

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b), ZyXEL Communications Corporation (“Petitioner”) moves for joinder with the *Inter Partes* Review of U.S. Patent No. 8,265,096 (“the ’096 patent”), *Qualcomm Incorporated v. UNM Rainforest Innovations*, IPR2021-00375, Paper 2 (Dec. 28, 2020) (“the Qualcomm IPR”), for which the petition for *inter partes* review was filed on December 28, 2020 (“the Qualcomm Petition”) and is currently pending. IPR2021-00375, Paper 2. This motion is timely because it is filed “no later than one month after the institution date” of the Qualcomm IPR. 37 C.F.R. § 42.122(b); *Central Security Group – Nationwide, Inc. v. Ubiquitous Connectivity, LP*, IPR2019-01609, Paper 11, at 8-9 (P.T.A.B. Feb. 26, 2020) (stating that § 42.122(b) is “[t]he only timing requirement for a motion for joinder”); *Dell Inc. v. Neodron Ltd.*, IPR2020-00731, Paper 9, at 5 (P.T.A.B. July 31, 2020) (granting motion for joinder to an IPR proceeding that was not instituted until after the motion for joinder was filed). Petitioner requests that action on this motion be held in abeyance until, and only in the event of, institution of the Qualcomm IPR. Petitioner understands that Qualcomm, the petitioner in the Qualcomm IPR, does not oppose Petitioner’s request for joinder.

ZyXEL’s Petition relies on the references cited and follows the arguments raised in the Qualcomm Petition, and is essentially a copy of the Qualcomm Petition.

Petitioner here asserts that the same claims are invalid based on substantially the same arguments presented in the Qualcomm IPR. Moreover, Petitioner's declaration is substantively identical to the declaration in the Qualcomm IPR. ZyXEL's Petition includes the identical grounds presented in the Qualcomm Petition and therefore would create no additional burden for the Board, Qualcomm, or UNM Rainforest Innovations if joined. Joinder would therefore lead to an efficient resolution of the validity of the '096 patent.

Moreover, the undersigned counsel is also the counsel of record for Qualcomm. ZyXEL stipulates that if joinder is granted, it will cooperate with Qualcomm in the joined proceeding, whether at hearings, at depositions, in filings, or otherwise, as outlined below. Unless Qualcomm is terminated from the proceedings, ZyXEL will proceed in a limited "understudy" role. Joinder will not impact the trial schedule because the proceeding based on the Qualcomm Petition is in its early stages.

The Board has granted joinder in other proceedings when presented with this fact pattern and procedural history. For example, in *Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11 (P.T.A.B. Oct. 30, 2018), the petitioner, Celltrion, filed a petition with a motion for joinder to Pfizer's pending petition IPR2017-01923. *Id.* at 13. Celltrion had agreed to take an understudy role to Pfizer and no deadlines in the original IPR were changed. *Id.* at 14. The Board therefore granted

joinder, finding that doing so did not increase the burden on either the alleged patent owner or the Board, and the timing of petition supported joinder. *Id.* The Board reached the same conclusion in *Pfizer, Inc. v. Genentech, Inc.*, IPR2017-02063, Paper 25 (P.T.A.B. Feb. 21, 2018), where Pfizer took “understudy” role to earlier filed and not-yet-instituted Celltrion petition.

Here, ZyXEL agrees to let Qualcomm take a lead role with ZyXEL taking the understudy role. Under these circumstances, like those in IPR2017-01063, there is no undue prejudice to UNM Rainforest Innovations (“UNM”), an assignee indicated as on the Patent Office’s record as an alleged patent owner , and therefore the Board should institute IPR and grant ZyXEL’s Motion for Joinder. *See* IPR2017-01063, Paper 25 at 3-5.

Accordingly, and for the reasons discussed below, joinder should be granted.

II. BACKGROUND AND RELATED PROCEEDINGS

UNM Rainforest Innovations which was formerly named STC.UNM, has asserted certain claims of the ’096 patent in the following pending district-court lawsuits: *UNM Rainforest Innovations v. ASUSTek Computer, Inc.*, No. 6:20-cv-00142 (W.D. Tex.); *UNM Rainforest Innovations v. Dell Techs. Inc. et al.*, No. 6:20-cv-00468 (W.D. Tex.); *UNM Rainforest Innovations v. D-Link Corp.*, No. 6:20-cv-00143 (W.D. Tex.); *UNM Rainforest Innovations v. TP-Link Techs. Co.*, No. 6:19-

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