

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZYXEL COMMUNICATIONS CORPORATION,

Petitioner,

v.

UNM RAINFOREST INNOVATIONS,

Patent Owner.

IPR2021-00734
Patent No. 8,265,096

**PATENT OWNER UNM RAINFOREST INNOVATIONS'
OPPOSITION TO PETITIONER'S MOTION FOR JOINDER**

1. INTRODUCTION

Petitioner ZyXEL Communications Corporation (“ZyXEL”) submitted a Motion for Joinder to *Qualcomm Incorporated v. UNM Rainforest Innovations*, IPR2021-00375, (the “Qualcomm IPR”) along with its Petition in the present IPR. IPR2021-00734, Paper 3 (Petitioner’s Motion for Joinder Under 35 U.S.C. § 315(c), 37 C.F.R. § 42.22, and 42.122(b)) (“Motion”). ZyXEL’s Petition largely mirrors Qualcomm’s Petition; however, its Petition introduces a substantial substantive new issue of first impression which is not present in the Qualcomm IPR. Specifically, Petitioner reintroduces the issue of patent ownership in this forum—despite having previously unsuccessfully raised it in district court (Ex. 2001) and the same issue being denied in a related case (Ex. 2002)—by filing its Petition effectively as *in rem*, *i.e.*, against the patent itself, instead of against Patent Owner UNM Rainforest Innovations (“UNM”). Even assuming that this forum is authorized to adjudicate patent ownership—which it is not—exploration of this issue in this forum introduces a significant substantive difference from the existing Qualcomm IPR which would unquestionably derail that proceeding. Further, if Petitioner’s self-imposed limitation to “proceed in a limited ‘understudy’ role” was truly given in good faith, Petitioner is asking this Board to accept the assumption that Qualcomm will argue an issue on ZyXEL’s behalf that Qualcomm did not raise

itself. This problem is compounded because ZyXEL's counsel is the same as counsel for Qualcomm. Motion at 2. It would be unclear on whose behalf counsel is truly acting. Petitioner's Motion for Joinder should be denied.

2. DISCRETIONAL DENIAL OF JOINDER IS JUSTIFIED.

The discretionary nature of joinder is designed to avoid gamesmanship and prejudice to the Patent Owner. *Proppant Express Investments, LLC, et al., v. Oren Tech., LLC*, IPR2018-00914, Paper 38 at 11 (PTAB, March 13, 2019). Congress' intent in establishing the AIA proceedings was "to provide a cheaper, faster alternative to district court litigation" that could "be used instead of, rather than in addition to, civil litigation." 157 Cong. Rec. S1363 (daily ed. Mar. 8, 2011) (statement of Sen. Schumer). Discretionary joinder under § 315(c) may be justified where, for example, a patent owner has taken certain actions in a co-pending litigation (*e.g.*, the late addition of newly asserted claims). *Id.* at 19. No such action has been taken here by the Patent Owner. Rather, Petitioner seeks to add a new issue into the Qualcomm IPR through its Petition and Motion for Joinder, and its Petition is both premature and defective.

A. JOINDER WOULD INTRODUCE NEW ISSUES INTO THE QUALCOMM IPR.

A motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the

petition; (3) explain what impact, if any, joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

Although ZyXEL asserts that its Petition “is essentially a copy of the Qualcomm Petition,” allowing ZyXEL to join the Qualcomm IPR would raise substantial new issues regarding ZyXEL’s challenge to UNM’s ownership rights of the ’096 patent—issues which ZyXEL unsuccessfully litigated in district court and apparently intends to attempt to re-litigate in this proceeding. Under similar circumstances where joinder would introduce new issues to the existing IPR, the Board typically denies motions for joinder. *See Unified Patents Inc., v. C-Cation Technologies, LLC*, IPR2015-01045, Paper 15 at 7 (“if we institute review based on the Petition and grant Petitioner’s Motion for Joinder, the real party-in-interest issue potentially could sidetrack the joined proceeding, shifting the focus away from the substantive issue to be addressed—the patentability of claims 1, 3, and 4 of the ’883 patent.”). The same reasoning applies here. Due to the overarching ownership issue introduced by ZyXEL, “joinder . . . could complicate, rather than simplify, briefing and discovery in the [PRIMARY] IPR”). *Id.* Here, ZyXEL’s Petition clearly challenges the ownership of the ’096 patent—despite the fact that

ZyXEL has previously lost the same argument in district court. *UNM Rainforest Innovations v. ZyXEL Communications Corporation*, 6-20-cv-00522, (W. D. Tex.) Text Order dated Jan. 27, 2021, Ex. 2001. ZyXEL's repeated attempt to challenge ownership of the patent is a major substantive variation from the Qualcomm IPR and would significantly complicate the Qualcomm IPR.

B. ZYXEL'S PETITION IS NOT PROPER.

ZyXEL's Petition is defective as it purports to raise an issue outside of the scope of IPR proceedings. "A petitioner in an *inter partes* review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications." 35 U.S.C. § 311(b). An IPR petition may not, for example, raise grounds based on 35 U.S.C. § 101. *Id.* Similarly, an IPR is not the proper forum to raise challenges to a patent's ownership or its assignment history. Out of 13,419 original, corrected, or amended petitions for IPR found on Docket Navigator, ZyXEL's petitions in this matter and two related matters are the only instances in which an IPR petition was filed as "in the patent of," *i.e.*, as an *in rem* proceeding against a patent itself, as opposed to the owner of the patent. ZyXEL's improper *in rem* IPR defeats the very purpose of the *inter partes* aspect of this reexamination.

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