

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE (USA) INC.,
Petitioner,

v.

EVOLVED WIRELESS LLC,
Patent Owner.

Case IPR2016-01349
Patent 8,218,481 B2

Before WILLIAM V. SAINDON, PETER P. CHEN, and
TERRENCE W. McMILLIN, *Administrative Patent Judges*

McMILLIN, *Administrative Patent Judge*

Decision
Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b)

I. INTRODUCTION

Petitioner, ZTE (USA) Inc. (“ZTE”), requested joinder of this proceeding with IPR2016-00981. Patent Owner, Evolved Wireless LLC (“Evolved Wireless”), does not oppose joinder. For the reasons given below, we grant the motion for joinder.

II. GRANT OF MOTION FOR JOINDER

On July 5, 2016, ZTE filed a Petition requesting an *inter partes* review of claims 1–4, 6, 8–11, 13, 15, and 16 of U.S. Patent No. 8,218,481 B2 (Ex. 1001, “the ’481 patent”). Paper 2. On January 12, 2017, the Board instituted trial on all the challenged claims. Paper 11.

On December 5, 2016, ZTE filed a “Motion for Joinder Under 35 U.S.C. § 315(c) and/or Consolidation under § 315(d) with Case No. IPR2016-00981.” Paper 8 (“Motion for Joinder”). On December 19, 2016, Evolved Wireless filed “Patent Owner’s Opposition to Petitioner’s Motion for Joinder and/or Consolidation with Case No. IPR2016-00981.” On December 29, 2016, we received a communication which stated that ZTE has filed a motion to consolidate and/or join IPR2016-00981 with IPR2016-01349, and that Patent Owner has confirmed that it would not oppose joinder if the Board institutes in IPR2016-001349. Paper 9. On January 12, 2017, ZTE filed its “Reply in Support of Petitioner’s Motion for Joinder and/or Consolidation with Case No. IPR2016-00981” which stated:

Petitioner’s joinder/consolidation motion (Paper 8) is now unopposed. Specifically after filing its opposition (Paper 9), Patent Owner represented that if the Board institutes an IPR in this proceeding then Patent Owner would not oppose joinder/consolidation with the instituted proceeding in IPR2016-00981. (Paper 10 at 2–3; 12/29/16 C. McMahon E-Mail to Board.) Today the Board instituted an IPR in the present

proceeding (Paper 11). Therefore, the Board should join or consolidate the present proceeding with IPR2016-00981.

Paper 13, 1. Thus, although Evolved Wireless previously indicated it opposed joinder (Paper 9), the Board understands that Evolved Wireless currently does not oppose joinder (Paper 13).

The Motion for Joinder was timely because joinder was requested no later than one month after the institution date of IPR2016-00981, i.e., November 3, 2016.¹ See 37 C.F.R. § 42.122(b).

The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads:

If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

By regulation, the Director's discretion has been delegated to the board. 37 C.F.R. § 42.4(a). A motion for joinder should generally (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. ZTE's Motion for Joinder addresses each of the above factors. Motion for Joinder 6–10. ZTE argues:

The ZTE petition [in this proceeding] challenges the same claims and relies on the same arguments, same evidence including the

¹ December 3, 2016, was a Saturday and December 4, 2016, was a Sunday.

same expert declaration, and substantively identical prior art as those presented in the Apple/Microsoft proceeding [IPR2016-00981]. Indeed, as Patent Owner acknowledges, the only relevant difference between ZTE's petition and the Apple/Microsoft petition is that the ZTE petition uses the Tan patent, rather than the Tan provisional, as a secondary reference in order to correct a minor procedural defect. *See* Paper 7 at 16.

Motion for Joinder 6. In IPR2016-0981, the Petitioners, Apple Inc., Microsoft Corporation, Microsoft Mobile Oy, and Microsoft Mobile, Inc. ("Apple and Microsoft"), relied on a US provisional patent application in challenging dependent claims 2–4, 6, 9–11 of the '481 patent. IPR2016-00981, Paper 4, 4–5. As US provisional patent applications are not prior art, the Board did not institute trial on dependent claims 2–4, 6, 9–11 of the '481 patent. IPR2016-00981, Paper 10, 20–21. In this proceeding, ZTE relies on US Patent No. 8,800,305 B2 (the "Tan patent") in challenging claims 2–4, 6, 9–11 of the '481 patent (Paper 2, 6). In this proceeding, Evolved Wireless did not separately address ZTE's challenge to claims 2–4, 6, 9–11 (*see generally* Prelim. Resp.) and the Board instituted trial on those dependent claims (Paper 11, 26).

If joinder is granted, ZTE anticipates participating in the proceeding in a limited capacity. Motion for Joinder 1 ("ZTE . . . agrees to accept a limited role, with counsel for Apple and Microsoft acting as the lead counsel."). ZTE agrees to:

(1) consolidate filings with Apple and Microsoft; (2) refrain from raising any new grounds not already considered by the Board in the Apple/Microsoft proceeding [IPR2016-00981]; (3) be bound by any agreement between Patent Owner and Apple and Microsoft concerning discovery and/or depositions; (4) limit any direct, cross-examination or redirect time beyond that permitted

IPR2016-01349
Patent 8,218,481 B2

for Apple and Microsoft under either 37 C.F.R. § 42.53 or any agreement between Apple and Microsoft and the Patent Owner, such that Petitioner's participation in the Apple/Microsoft proceeding does not result in any additional time being required for any deposition; and (5) limit any presentation at oral hearing to unused time previously allocated to Apple and Microsoft.

Id. at 8–9.

With regard to the trial schedule, joinder will require modification of the schedules entered in IPR2016-00981 and this proceeding. We have the authority to modify the schedule including the 1 year final determination time period. *See* 35 U.S.C. § 316(a)(11); 37 C.F.R. § 42.100(c). We note that Evolved Wireless has withdrawn its opposition to joinder and that all the parties to this proceeding and IPR2016-00981 have agreed to a modified schedule which we adopt in the Revised Scheduling Order being entered on the same day as this Decision.

On the record before us, in particular the agreement between the parties, and having weighed the factors related to joinder, we exercise our discretion to granting the Motion for Joinder. As the more complete record exists in this proceeding, especially relating to the Tan patent, we order that the Petitioners in IPR2016-00981 shall be added as parties to this proceeding and this proceeding shall continue after joinder.

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