

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE, INC., MICROSOFT CORPORATION, MICROSOFT MOBILE  
OY, and MICROSOFT MOBILE INC.,  
Petitioner,

v.

EVOLVED WIRELESS LLC,  
Patent Owner.

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Case IPR2017-00068  
Patent 8,218,481 B2

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Before CHRISTOPHER L. CRUMBLY, 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

Apple, Inc., Microsoft Corporation, Microsoft Mobile Oy, and Microsoft Mobile, Inc. (f/k/a Nokia Inc.) (“Apple and Microsoft”) filed a Petition requesting an *inter partes* review of claims 1–4, 6, 8–11, and 13 of U.S. Patent No. 8,218,481 B2 (Ex. 1001, “the ’481 patent”). Paper 2 (“Pet.”). Concurrently with the Petition, Apple and Microsoft filed a Motion for Joinder with *ZTE (USA) Inc., HTC Corporation, and HTC America, Inc. v. Evolved Wireless, LLC*, Case IPR2016-00758. Paper 3. On December 30, 2016, Apple and Microsoft filed a Supplemental Reply to Patent Owner’s Opposition to Motion for Joinder, which states:

Petitioner hereby expressly dismisses its petition as to claims 4 and 11 of the ’481 patent, which were not instituted in IPR2016-00758. Notably, Petitioner does not abandon any grounds in its petition directed to the claims that were instituted in IPR2016-00758.

Petitioner’s Motion for Joinder stands unopposed (Paper No. 13, “Counsel for Patent Owner agreed that, if the non-instituted claims are dismissed for the Petitions in the joinder cases, Patent Owner does not oppose joinder of Petitioners to IPR2016-00758.”) Petitioner thus requests that the Board institute an IPR on the remaining grounds in the present case and grant Petitioner’s Motion for Joinder to IPR2016-00758 with respect to the instituted grounds.

Paper 10, 1.

Patent Owner, Evolved Wireless, LLC (“Evolved Wireless”), has not filed a preliminary response to the Petition.<sup>1</sup> Evolved Wireless filed an opposition to the Motion for Joinder (Paper 7) but since has withdrawn its

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<sup>1</sup> The preliminary response was due on January 25, 2017. Paper 6, 2.

opposition. For the reasons explained below, we grant the Motion for Joinder.

## II. THE PETITION WARRANTS INSTITUTION OF *INTER PARTES* REVIEW

According to Apple and Microsoft, the Petition in this proceeding “substantively copies the petition in co-pending IPR2016-00758” (Pet. 1) and “includes only the grounds filed in IPR2016-00758 and is substantively identical on those grounds.” Paper 3, 1. For the reasons set forth in our institution decision, Paper 12, in IPR2016-00758, we determine that the information presented in the Petition establishes there is a reasonable likelihood that Apple and Microsoft will prevail in showing claims 1–3, 6, 8–10, and 13 of the ’481 patent are unpatentable.

## III. GRANT OF MOTION FOR JOINDER

The Petition and Motion for Joinder in this proceeding were accorded a filing date of October 14, 2016. *See* Paper 6. Thus, the Motion for Joinder was timely because joinder was requested no later than one month after the institution date of IPR2016-00758, i.e., September 16, 2016. *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.

As noted, the Petition herein asserts the same unpatentability grounds on which we instituted trial in IPR2016-00758. *See* Paper 3, 1. Apple and Microsoft also rely on the same prior art analysis and expert testimony submitted by the Petitioner in IPR2016-00758. *See id.* at 4. Indeed, the instant Petition is nearly identical to the Petition in IPR2016-00758 with respect to the grounds on which trial was instituted. *See id.* Thus, this *inter partes* review does not present any ground or matter not already at issue in IPR2016-00758.

If joinder is granted, Apple and Microsoft anticipate participating in the proceeding in a limited capacity. *Id.* at 4, 6–7. Apple and Microsoft agree to:

take an “understudy” role as petitioners in other, similarly joined proceedings have taken. In other words, so long as ZTE and HTC maintain their IPR, all filings by Petitioner in the joined proceeding will be consolidated with the filings of ZTE and HTC, unless a filing solely concerns issues that do not involve ZTE or HTC; Petitioner will not introduce any argument or discovery not introduced by ZTE and HTC; and Petitioner assents to ZTE and HTC leading any depositions associated with the joined proceeding. Thus, if joined, there will be only one set of briefing on the issues, rather than briefing from both ZTE and HTC and Petitioner. Petitioner will assume the primary role only if ZTE and HTC cease to participate.

*Id.*

With regard to the trial schedule, joinder will require modification of the schedule entered in IPR2016-00758 (*see* Paper 13 (Scheduling Order) as modified (*see* Papers 15, 21, 22, and 23). The Board has the authority to modify the schedule, including the 1 year final determination time period. *See* 35 U.S.C. § 316(a)(11). We note that Evolved Wireless has withdrawn its opposition to joinder and that all the parties to this proceeding and IPR2016-00758 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 grant the Motion for Joinder.

#### IV. ORDER

It is hereby:

ORDERED that the Motion for Joinder with IPR2016-00758 is granted;

FURTHER ORDERED that Apple, Inc., Microsoft Corporation, Microsoft Mobile Oy, and Microsoft Mobile, Inc. (f/k/a Nokia Inc.) are joined as petitioners in IPR2016-00758;

FURTHER ORDERED that the grounds for trial in IPR2016-00758 remain unchanged;

FURTHER ORDERED that the case caption in IPR2016-00758 shall be changed to reflect joinder of Apple and Microsoft;

FURTHER ORDERED that the Revised Scheduling Order entered in the consolidated IPR2016-00758 shall replace the original Scheduling Order

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