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Paper No. 9
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC AMERICA, INC.,
Petitioner,

v.

KONINKLIJKE KPN N.V.,
Patent Owner.

Case IPR2018-01639
Patent 9,014,667 B2

Before KEVIN F. TURNER, JONI Y. CHANG, and
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

WORMMEESTER, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

Grant of Motion for Joinder
37 C.F.R. § 42.122

I. INTRODUCTION

HTC America, Inc. ("Petitioner") filed a Petition (Paper 2, "Pet.") requesting *inter partes* review of claims 31, 33, and 35 of U.S. Patent No. 9,014,667 B2 (Ex. 1001, "the '667 patent"). Petitioner additionally filed a Motion for Joinder (Paper 3, "Joinder Mot.") seeking to join this proceeding with *LG Electronics, Inc. v. Koninklijke KPN N.V.*, Case IPR2018-00558 ("the LGE IPR"), which also concerns the '667 patent. Joinder Mot. 1.

In the LGE IPR, we instituted an *inter partes* review as to claims 31, 33, and 35 of the '667 patent based on the two grounds of unpatentability presented. LGE IPR, Paper 6, at 44. According to Petitioner, the instant Petition is "substantively identical" to the petition in the LGE IPR and presents the same grounds of unpatentability, the same prior art, and the same declarant testimony as the petition in the LGE IPR. Joinder Mot. 3–4. Petitioner also represents that, if it is allowed to join the LGE IPR, it would agree to consolidated filing with the petitioner in the LGE IPR to "simpl[if]y briefing and discovery" and "minimize any potential complications or delay that potentially may result by joinder." Joinder Mot. 5–7. Petitioner does not indicate whether the petitioner in the LGE IPR opposes Petitioner's Motion for Joinder.

Koninklijke KPN N.V. ("Patent Owner") did not file a Preliminary Response; nor did it file a paper opposing Petitioner's Motion for Joinder. *See* Paper 8 (Patent Owner's Waiver of Preliminary Response).

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a). Under 35 U.S.C. § 314(a), we may not authorize an *inter partes* review unless the information

in the petition "shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." For the reasons that follow, we institute an *inter partes* review of claims 31, 33, and 35 of the '667 patent based on the same grounds instituted in the LGE IPR. We also grant Petitioner's Motion for Joinder.

II. INSTITUTION OF *INTER PARTES* REVIEW

On August 3, 2018, we instituted a trial in the LGE IPR based on the two grounds of unpatentability presented: (1) obviousness under 35 U.S.C. § 103 of claims 31 and 33 over Obhan,[1] Shatzkamer,[2] and Budka;[3] and (2) obviousness under 35 U.S.C. § 103 of claim 35 over Ohban, Taniguchi,[4] and Budka. LGE IPR, Paper 6, at 44. As mentioned above, the Petition filed in this proceeding is essentially the same as the petition filed in the LGE IPR. Joinder Mot. 3–4; *see also* Pet. 1; LGE IPR, Paper 2, at 1. In view of the identity of the grounds in the instant Petition and in the LGE IPR petition, and for the same reasons stated in our Decision on Institution in the LGE IPR, we institute *inter partes* review in this proceeding on the same grounds discussed above and for the same claims we instituted *inter partes* review in the LGE IPR. *See* LGE IPR, Paper 6.

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[1] Obhan, U.S. Patent No. 6,275,695 B1, issued Aug. 14, 2001 (LGE IPR, Ex. 1005).
[2] Shatzkamer, U.S. Publ'n No. 2008/0220740 A1, published Sept. 11, 2008 (LGE IPR, Ex. 1006).
[3] Budka, European Publ'n No. EP 1009176 A2, published June 14, 2000 (LGE IPR, Ex. 1007).
[4] Taniguchi, U.S. Patent No. 7,505,755 B2, issued Mar. 17, 2009 (LGE IPR, Ex. 1008).

III. GRANT OF MOTION FOR JOINDER

Joinder in *inter partes* review is subject to the provisions of 35 U.S.C. § 315(c):

> (c) JOINDER.—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 parties review under section 314.

"Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested." 37 C.F.R. § 42.122(b). Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. The Board determines whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations. *See Sony Corp. of Am. v. Network-1 Security Solutions, Inc.*, Case IPR2013-00495, slip op. at 3 (PTAB Sept. 16, 2013) (Paper 13) ("*Sony*"). When exercising its discretion, the Board is mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b).

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder should (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; and (3) explain what impact, if any, joinder would have on the trial schedule for the existing

review. *See Sony* at 3; *see also* Frequently Asked Question H5, https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/ptab-e2e-frequently-asked-questions. Petitioner should address specifically how briefing and/or discovery may be simplified to minimize schedule impact. *See Kyocera Corp. v. SoftView LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15) (representative).

Petitioner's Motion for Joinder is timely because it was filed on August 31, 2018, which is within one month of our August 3, 2018, institution of the LGE IPR. *See* 37 C.F.R. § 42.122(b); Joinder Mot. 1.

In its Motion for Joinder, Petitioner contends that joinder is appropriate because the instant Petition "is substantively identical to the petition in the LG[E] IPR" and "does not present any new grounds of unpatentability." Joinder Mot. 3. In particular, Petitioner asserts, the Petition "challenges the same claims of the same patent, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the LG[E] Petition." *Id.* at 4. Petitioner further contends that "[j]oinder will have minimal impact, if any, on the LG[E] IPR trial schedule because the [instant] Petition presents no new issues or grounds of unpatentability." *Id.* at 5. Petitioner also "explicitly consents to the existing trial schedule." *Id.* at 5–6.

To "simpl[if]y briefing and discovery," Petitioner additionally agrees to assume the role of an "understudy," bound by the following conditions, if it is joined to the LGE IPR:

a) all filings by [Petitioner] in the joined proceeding [shall] be consolidated with the filings of the current petitioner, unless a filing concerns issues solely involving [Petitioner];

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