

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ZTE (USA) LLC,  
Petitioner,

v.

SEVEN NETWORKS, LLC,  
Patent Owner.

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Case IPR2019-00460  
Patent 9,516,127 B2

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Before THU A. DANG, JONI Y. CHANG, and  
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Motion for Joinder  
*35 U.S.C. § 315(c)*

Denying Institution of *Inter Partes* Review  
*35 U.S.C. § 315(b)*

## I. INTRODUCTION

On December 27, 2018, ZTE (USA) LLC (“ZTE”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review (“IPR”) of claims 1–24, 26–33, 35–42, and 44–50 (“the challenged claims”) of U.S. Patent 9,516,127 B2 (Ex. 1001, “the ’127 patent”). ZTE also filed a Motion for Joinder (Paper 3, “Mot.”) requesting that it be joined to Case IPR2018-01106 (the “Samsung IPR”) filed by Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, “Samsung”). Mot. 1. Subsequently, the Samsung IPR was terminated on January 11, 2019, because the parties involved in that proceeding had settled. *See* Case IPR2018-01106, Paper 29.

SEVEN Networks, LLC (“Patent Owner”) timely filed a Preliminary Response to the instant Petition on April 16, 2019. Paper 17 (“Prelim. Resp.”). Patent Owner also timely filed an Opposition (Paper 10, “Opp.”) to the Motion for Joinder, and ZTE filed a Reply (Paper 11, “Reply”) to the Opposition in support of its Joinder Motion.

For the reasons stated below, both ZTE’s Motion for Joinder and Petition are *denied*, and we do not institute an *inter partes* review.

### A. Related Matters

The parties indicate that the ’127 patent was involved in *SEVEN Networks, LLC v. ZTE (USA) Inc.*, Case No. 3:17-cv-01495 (N.D. Tex.). Pet. 75; Paper 14, 1. The parties also list other related proceedings. Pet. 75; Paper 14, 1–2.

*B. Prior Art Relied Upon*

ZTE relies upon the references listed below (Pet. 2–3).

	<b>Reference</b>	<b>Exhibit</b>
Giaretta	US 2012/0185577 A1, published July 19, 2012	1004
Backholm	US 2012/0023236 A1, published Jan. 26, 2012	1005
Pathak	“What is keeping my phone awake? Characterizing and Detecting No-Sleep Energy Bugs in Smartphone Apps,” ACM (2012).	1006
Aleksic	US 2008/0057894 A1, published Mar. 6, 2008	1007
Hackborn	US 8,280,456 B2, issued Oct. 2, 2012	1008
Murphy	“The Busy Coder’s Guide to Android Development,” CommonsWare, LLC (2012)	1011

*C. Asserted Grounds of Unpatentability*

ZTE asserts the following grounds of unpatentability (Pet. 2)<sup>1</sup>:

<b>Claims</b>	<b>Basis</b>	<b>References</b>
1–23	§ 103	Giaretta, Backholm, and Pathak

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<sup>1</sup> The relevant post-grant review provisions of the America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), took effect on March 16, 2013. 125 Stat. at 293, 311. The earliest possible effective filing date of the ’127 patent is March 25, 2013. Therefore, our citations to Title 35 are to its post-AIA version. Section 4(c) of the AIA designated 35 U.S.C. § 112 first and second paragraphs as 35 U.S.C. § 112(a) and (b), respectively, effective September 16, 2012. 125 Stat. at 296–297.

Claims	Basis	References
24, 26, 28–33, 36–42, 44, and 46–50	§ 103	Backholm and Aleksic
27, 35, and 45	§ 103	Backholm, Aleksic, and Hackborn

## II. ANALYSIS

### A. Motion for Joinder

The decision whether to grant joinder is discretionary, as 35 U.S.C. § 315 provides, in pertinent part with emphases added:

(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 partes review under section 314.

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). As the moving party, ZTE has the burden to establish that it is entitled to the requested relief. 37 C.F.R. § 42.20(c).

In its Motion, ZTE argues that joinder with the Samsung IPR is appropriate because its Petition and the Samsung IPR petition are substantively identical, in that they contain the same prior art grounds and

supporting evidence, against the same claims. Mot. 1, 5–6. ZTE also avers that joinder should have no impact on the Samsung IPR trial schedule. *Id.* at 6–7. ZTE further contends that ZTE agrees to take an “understudy” role which will simplify briefing and discovery. *Id.* at 7–9.

Patent Owner opposes, arguing that ZTE’s Motion for Joinder should not be granted because the Samsung IPR has been terminated. Opp. 1–4. We agree with Patent Owner. Given that the Samsung IPR is no longer pending, it cannot serve as a proceeding to which this proceeding may be joined.

In its Reply, ZTE argues that its Motion for Joinder was filed *prior to* the filing of the Joint Motion to Terminate the Samsung IPR. Reply 1–2. According to ZTE, the Board “routinely grants joinder motions despite a later-filed motion to terminate the proceeding to be joined.” *Id.* at 2 n.1.

Further to the aforementioned briefing, ZTE was provided an additional opportunity to present arguments in a conference call with the panel on February 26, 2019. Paper 15. During that call, ZTE argued that terminating the Samsung IPR before deciding ZTE’s Joinder Motion would prejudice ZTE, and that joinder with the Samsung IPR would be appropriate as its Petition submits identical grounds, arguments, and evidence presented in the Samsung IPR. *Id.* at 3.

However, as noted by Patent Owner (*id.*; Prelim. Resp. 3–9), filing a joinder motion *earlier* than a motion to terminate is *not determinative* because the Board also has previously *denied* joinder notwithstanding a later-filed motion to terminate. *See, e.g., ZTE USA, Inc. v. Parthenon Unified Memory Architecture LLC*, Case IPR2016-00664, slip op. at 3 (PTAB June 8, 2016) (Paper 10); *LG Elec., Inc. v. Cellular Commc’ns*

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