

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner

v.

IPR LICENSING, INC.
Patent Owner

Case IPR 2015-00074
Patent 8,380,244 B2

**REPLY IN SUPPORT OF MOTION FOR JOINDER UNDER 35 U.S.C.
315(c) AND 37 C.F.R. §§ 42.22 AND 42.122(b) TO RELATED *INTER*
PARTES REVIEW IPR2014-00525**

I. Microsoft Would Be Prejudiced By A Denial Of The Motion For Joinder

Absent joinder, Microsoft would be prejudiced in its interests related to the validity and interpretation of the 244 Patent. A decision on the merits in the ZTE IPR might be used by InterDigital against Microsoft in district court proceedings involving the 244 Patent. InterDigital cites, in a footnote, a decision by Judge Andrews, excluding a decision not to institute a different IPR filed by ZTE (Paper 9 at 8, n.2), but a decision not to institute is not a final decision on the merits. InterDigital has not agreed that it will not seek to use a final decision in the ZTE IPR against Microsoft. Further, because Patent Owner appears to contest Microsoft's ability to file a petition without joinder, failure to join Microsoft may prejudice Microsoft if ZTE settles and the IPR were to be terminated.

Rather than address the real prejudice Microsoft will suffer, Patent Owner argues that any prejudice is of Microsoft's own making because Microsoft could have filed its own petition during the one-year period prescribed under 35 U.S.C. § 315(b). As a preliminary matter, this argument is irrelevant as the one-year bar does not apply to motions for joinder. *See* 35 U.S.C. § 315(c); *Microsoft Corp. v. Proxyconn, Inc.*, IPR2013-00109, Paper 15 at 4 (Feb. 25, 2013); *Samsung Elecs. Co. v. Va. Innovation Scis., Inc.*, IPR2014-00557, Paper 10 at 15, 18-19 (June 13, 2014). Further, the one-year period for Microsoft has not expired because it did not have a privity relationship on the date of service of the complaint against Nokia, and Microsoft Mobile Oy and

Nokia Inc. are not real parties-in-interest to Microsoft's Petition (Paper 1 at 5-7). Microsoft's legitimate interests related to the validity and interpretation of the 244 Patent would therefore be prejudiced if joinder were denied.

II. Joinder Is Appropriate Where Petitions Are Substantively Identical

Patent Owner admits that the arguments in the present Petition are “substantively duplicative” of the ZTE IPR (Response at 6-7) and thus concedes that a primary factor weighs heavily in favor of joinder. *See Macronix Int'l Co. v. Spansion*, IPR2014-00898, Paper 15 at 4 (Aug. 13, 2014) (whether new petition presents any new grounds of unpatentability is a key factor). The present case is thus distinguishable from *Unified Patents, Inc. v. Personal Web Techs., LLC*, where the Board found that the petition raised a new substantive issue that would have required additional discovery. IPR2014-00702, Paper 12 at 5-6 (P.T.A.B. July 24, 2014).¹

III. Microsoft's Motion For Joinder Provides The Required Details

Microsoft's Motion provided the required details regarding the impact of joinder on the ZTE IPR. Microsoft demonstrated that the limited differences between the two petitions would result in no negative impact in the IPR schedule (Paper 3 at 7-8). Microsoft also provided specific examples of procedures implemented in other IPRs that would simplify the proceedings here, including consolidation of filings by ZTE and Microsoft and taking depositions in the normal

¹ Patent Owner cited the denial of the petition instead of the motion for joinder.

time allotted (*see id.* at 8) (citing procedures adopted in *Motorola Mobility LLC v. Softview LLC*, IPR2013-00256). Further, Microsoft showed that it understood fully the need to coordinate with ZTE and would be amenable to limited participation in the IPR if the Board deemed that necessary (*see* Paper 3 at 9). In light of the foregoing procedures, Microsoft has sufficiently explained how briefing and discovery could be simplified.

The only case cited by Patent Owner is distinguishable. In *Samsung Elecs. Co. v. Arendi S.A.R.L.*, IPR2014-001144, the joinder petitioner relied on the testimony of a new expert, provided no explanation of how to accommodate this new evidence, failed to identify the difference between the two petitions, and failed to state whether the two petitioners were willing to work together to simplify the proceedings. Paper 11 at 5. Here, in contrast, the ZTE and Microsoft's petitions rely on the same expert, are substantively the same, and the parties have agreed to work together.

Patent Owner claims, without any meaningful explanation, that a modification of the schedule will be necessary (Paper 9 at 5). As stated in Microsoft's Motion, joinder will not affect the timing of the ZTE IPR schedule or the content of Patent Owner's response (Paper 9 at 7), so the Board has ample flexibility to keep to the same schedule the ZTE IPR would otherwise follow or to adopt a modest alteration of the schedule if appropriate. Thus, joinder should not be denied on that basis alone (35 U.S.C. § 316(a)(1); 37 C.F.R. § 42.100(c); Paper 3 at 7).

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing “REPLY IN SUPPORT OF MOTION FOR JOINDER UNDER 35 U.S.C. 315(c) AND 37 C.F.R. §§ 42.22 AND 42.122(b) TO RELATED INTER PARTES REVIEW IPR2014-00525,” was served in its entirety on November 26, 2014, by electronic mail and UPS Overnight delivery on:

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