

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

IPR LICENSING, INC.,
Patent Owner.

Case IPR2015-00074
Patent 8,380,244 B2

Before MIRIAM L. QUINN, SALLY C. MEDLEY, and
BEVERLY M. BUNTING, *Administrative Patent Judges*.

BUNTING, Administrative Patent Judge.

DECISION

Institution of *Inter Partes* Review and Grant of Motion for Joinder
37 C.F.R. § 42.108
37 C.F.R. § 42.122(b)

I. INTRODUCTION

Petitioner, Microsoft Corporation (“Microsoft”), filed a Petition (“Pet.,” Paper 1) requesting an *inter partes* review of claims 1–8, 14–16, 19–29, 36–38, and 41–44 (“the challenged claims”) of U.S. Patent No. 8,380,244 B2 (“the ’244 patent,” Ex. 1001) and was accorded a filing date of October 16, 2014 (Paper 7). Concurrently with its Petition, Microsoft filed a Motion for Joinder (“Mot.,” Paper 3) seeking to join this proceeding with *ZTE v. IPR Licensing*, Case IPR2014-00525 (“ZTE IPR”). Mot. 1. The ZTE IPR concerns the same patent as at issue here, namely the ’244 patent. We instituted trial in the ZTE IPR on September 17, 2014. *See ZTE v. IPR Licensing*, Case IPR2014-00525, Paper 19 (Decision instituting *inter partes* review).

We authorized Patent Owner, IPR Licensing, Inc. (“IPR Licensing”), to file an opposition to Microsoft’s Motion for Joinder, and authorized Microsoft to file a Reply to the opposition. Paper 7, 2. IPR Licensing filed an Opposition to Petitioner’s Motion for Joinder (Paper 9) and Microsoft in turn filed a Reply (Paper 11). IPR Licensing timely filed a Patent Owner Preliminary Response (“Prelim. Resp.”). Paper 12. In response to a Board order (Paper 20), Microsoft filed a Notice Regarding Joinder Participation (“Notice”), effectively limiting its participation in the ZTE IPR, if it were joined as a party. Paper 19.

We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . 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 provided below, we (1) institute an *inter partes* review on the ground listed in the Order section of

this decision, and (2) grant Microsoft's Motion for Joinder, subject to the conditions detailed herein.

II. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same grounds as those asserted in the ZTE IPR. Pet. 12–13.¹ On September 17, 2014, we instituted a trial in the ZTE IPR on one ground:

Claims 1–8, 14–16, 19–29, 36–38, and 41–44 of the '244 patent as obvious over Jawanda, the GPRS Standards, and the IEEE 802.11 Standard.

ZTE v. IPR Licensing, Case IPR2014-00525, Paper 19, 22.

In its Notice, Microsoft expressly agreed to limit its challenge to the same ground on which we instituted trial in the ZTE IPR. Paper 19. With respect to the ground on which trial was instituted in the ZTE IPR, Patent Owner's Preliminary Response in this proceeding (Paper 12) did not raise substantially different arguments or present substantially different evidence, other than what we considered in the course of instituting trial in the ZTE IPR. In other words, institution of trial in this proceeding is based upon our consideration of the same issues, directed to the same prior art references, arguments, and oppositions already raised and considered with respect to the ZTE IPR.

In view of the arguments offered in the Preliminary Response, and further in view of Microsoft's agreement to limit its Petition to the same

¹ Although Microsoft asserts that one ground is presented in its Petition, Microsoft is actually asserting four grounds: Jawanda alone; Jawanda and GPRS; Jawanda and IEEE 802.11; and Jawanda, GPRS, and IEEE 802.11. Pet. 14.

ground on which we instituted trial in the ZTE IPR, we institute an *inter partes* review in this proceeding on the same ground as that on which we instituted trial in the ZTE IPR. We do not institute an *inter partes* review on any other grounds.

III. GRANT OF MOTION FOR JOINDER

An *inter partes* review may be joined with another *inter partes* review, subject to the provisions 35 U.S.C. § 315(c), which governs joinder of *inter partes* review proceedings:

(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.

As the moving party, Microsoft 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* Frequently Asked Question H5, <http://www.uspto.gov/patents-application-process/appealing-patentdecisions/trials/patent-review-processing-system-prps-0>.

The Petition in this proceeding has been accorded a filing date of October 16, 2014 (Paper 7), and the Motion for Joinder was filed on the same date (Mot.). Thus, both of these actions satisfy the joinder requirement of being filed within one month of our instituting a trial in the ZTE IPR. *See*

37 C.F.R. § 42.122(b) (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.).

In its Motion for Joinder, Microsoft contends that “the Microsoft Petition is virtually identical to the ZTE Petition, and contains only minor differences.” Mot. 4. Microsoft also contends that its Petition is limited to “the same claims, prior art, and grounds of unpatentability that are the subject of the ZTE IPR” upon which we instituted trial in the ZTE IPR. *Id.* at 1. Microsoft represents in its Motion for Joinder that it will streamline discovery and briefing (*Id.*), and that it will “coordinate with ZTE to consolidate filings, manage the questioning at depositions, manage presentations at the hearing, ensure that briefing and discovery occur within the time normally allotted, and avoid redundancies” (*Id.* at 8). Based on these representations, Microsoft contends that, in the event of joinder, the schedule in the ZTE IPR would not be affected, nor would IPR Licensing be prejudiced by joining this proceeding to the ZTE IPR. *Id.* 7–8.

Patent Owner opposes the Motion for Joinder, arguing that the instant Petition is “substantially duplicative to the currently pending ZTE IPR” (Opp. 1), and “introduces new information that would unnecessarily complicate the ZTE IPR” (*id.*). Nonetheless, Microsoft has confirmed that “should it be joined to IPR2014-00525, it would agree to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in IPR2014-00525.” Paper 19, 1.

Based on the present record, we agree with Microsoft that joinder would be appropriate under the circumstances.

IV. 35 U.S.C. § 315(b)

In its Patent Owner Preliminary Response, IPR Licensing argues that the Petition is barred under 35 U.S.C. § 315(b) because Nokia, a privy of Microsoft, was served with a complaint alleging infringement of the '244 patent more than a year before the filing of the instant Petition. Prelim. Resp. 26–35. Because we grant Microsoft's motion for joinder under 35 U.S.C. § 315(b), we need not address Patent Owner's arguments suggesting that the Petition is time-barred under 35 U.S.C. § 315(b).²

V. CONCLUSION

Based on the record before us, we institute an *inter partes* review in IPR2015-00074 and grant Microsoft's motion to join that proceeding to IPR2014-00525.

VI. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that a trial is instituted as to the challenged claims of the '244 patent only on the following ground:

Claims 1–8, 14–16, 19–29, 36–38, and 41–44 of the '244 patent as obvious over Jawanda, the GPRS Standards, and the IEEE 802.11 Standard;

FURTHER ORDERED that Microsoft's Motion for Joinder is granted and that this proceeding is joined with IPR2014-00525;

² The last sentence of 35 U.S.C. § 315(b) expressly states that “[t]he time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).” 35 U.S.C. § 315(b).

FURTHER ORDERED that the ground on which IPR2014-00525 was instituted is unchanged and no other grounds are instituted in the joined proceeding;

FURTHER ORDERED that the Scheduling Order in place for IPR2014-00525 (Paper 12) remains unchanged and shall govern the joined proceedings;

FURTHER ORDERED that, unless given prior authorization by the Board, Microsoft is not permitted to file papers, engage in discovery, or participate in any deposition or oral hearing in IPR2014-00525. Microsoft, however, is permitted to appear in IPR2014-00525 so that it may receive notification of filings and may attend depositions and oral hearing. Should Microsoft believe it necessary to take any further action, Microsoft should request a conference call to obtain authorization from the Board;

FURTHER ORDERED that IPR2015-00074 is terminated under 37 C.F.R. § 42.72 and all further filings in the joined proceeding are to be made in IPR2014-00525;

FURTHER ORDERED that a copy of this Decision be entered into the file of IPR2014-00525; and

FURTHER ORDERED that the case caption in IPR2014-00525 shall be changed to reflect joinder with this proceeding in accordance with the attached example.

IPR2015-00074
Patent 8,380,244 B2

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Example Case Caption for Joined Proceeding

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE CORPORATION and ZTE (USA) INC.,
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Case IPR2014-00525³
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³ Case IPR2015-00074 has been joined with this proceeding.