UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION

Petitioner

v.

IPR LICENSING, INC.

Patent Owner

U.S. Patent No.: 8,380,244
Filed: November 9, 2009
Issued: February 19, 2013

Title: Dual Mode Unit for Short Range, High Rate and Long Range, Lower Rate Data Communications

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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. STATEMENT OF THE PRECISE RELIEF REQUESTED

Microsoft Corporation ("Microsoft") respectfully submits this Motion for Joinder, together with a Petition for *Inter Partes* Review of U.S. Patent No. 8,380,244 (the "Microsoft Petition") filed contemporaneously herewith. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Microsoft requests institution of an *inter partes* review and joinder with the *inter partes* review in *ZTE Corporation v. IPR Licensing, Inc.*, IPR2014-00525 (the "ZTE IPR"), which was instituted on September 17, 2014 and concerns the same patent. Microsoft's request for joinder is timely. The Microsoft Petition is also narrowly tailored to the same claims, prior art, and grounds of unpatentability that are the subject of the ZTE IPR. In addition, Microsoft is willing to streamline discovery and briefing. Microsoft submits that joinder is appropriate because it will not prejudice the parties to the ZTE IPR while efficiently resolving the question of the 244 Patent's validity in a single proceeding.

II. STATEMENT OF MATERIAL FACTS

1. In March 2013, IPR Licensing, Inc. and several other InterDigital entities filed amended complaints against Nokia Corporation, Nokia Inc., and ZTE in the District of Delaware, alleging that each defendant infringed the 244 Patent. *See InterDigital Commc'ns Inc. v. ZTE Corp.*, Case No. 13-cv-00009, D.I. 25 (D.

Del.); *InterDigital Commc'ns, Inc. v. Nokia Corp.*, Case No. 1:13-cv-00010, D.I. 15 (D. Del.).

2. On March 21, 2014, ZTE filed a petition for *inter partes* review (the "ZTE Petition") requesting cancellation of the claims of the 244 Patent asserted against Nokia Corporation, Nokia Inc., and ZTE in the district court cases. *ZTE Corporation v. IPR Licensing, Inc.*, IPR2014-00525, Paper 1 (P.T.A.B.).

3. On April 25, 2014, Microsoft's subsidiary, Microsoft Mobile Oy, acquired Nokia Inc.

4. On September 17, 2014, the Board instituted ZTE's IPR on the unpatentability of claims 1–8, 14–16, 19–29, 36–38, and 41–44 of the 244 Patent as obvious over U.S. Patent No. 6,243,581 to Jawanda ("Jawanda"), the General Packet Radio Service Standards ("GPRS Standards"), and the IEEE 802.11 Standard. *ZTE Corporation v. IPR Licensing, Inc.*, IPR2014-00525, Paper 19 (P.T.A.B.).

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Board has authority under 35 U.S.C. § 315(c) to join a properly filed second *inter partes* review petition to an instituted *inter partes* review proceeding. 35 U.S.C. § 315(c). A motion for joinder must be filed within one month of institution of the original *inter partes* review. 37 C.F.R. § 42.122(b). In deciding

whether to exercise its discretion, the Board considers factors including: (1) the reasons why joinder is appropriate; (2) whether the new petition presents any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See Macronix Int'l Co. v. Spansion*, IPR2014-00898, Paper 15 at 4 (Aug. 13, 2014) (quoting *Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (April 24, 2013)).

B. Microsoft's Motion for Joinder is Timely

This Motion for Joinder is timely because it is filed within one month of the September 17, 2014 institution of the ZTE IPR. *See* 37 C.F.R. § 42.122(b). The time periods set forth in 37 C.F.R. § 42.101(b) do not apply to the Microsoft Petition because it is accompanied by this Motion for Joinder.[1] *See* 37 C.F.R. § 42.122(b); *Samsung Elecs. Co. v. Va. Innovation Scis., Inc.*, IPR2014-00557, Paper 10 at 15 (June 13, 2014).

C. The Factors Weigh in Favor of Joinder

Each of the four factors considered by the Board weighs in favor of joinder. As discussed below, joinder of the Microsoft Petition will not enlarge the scope of the ZTE IPR and will not negatively impact the ZTE IPR schedule, but a decision

[1] As set forth in the Microsoft Petition, however, the time period set forth in 37 C.F.R. § 42.101(b) and 35 U.S.C § 315(b) has not expired for Microsoft.

by the Board not to join could severely prejudice Microsoft. Thus, joinder is appropriate and warranted.

1. Joinder is Appropriate

Joinder with the ZTE IPR is appropriate because the Microsoft Petition involves the same patent, challenges the same claims, and is based not only on the same grounds and combinations of prior art that were submitted by ZTE, but also relies solely upon the same grounds on which the Board has already instituted *inter partes* review. In substance, the Microsoft Petition is virtually identical to the ZTE Petition, and contains only minor differences, as explained below.

First, the Microsoft Petition restructures some of the arguments presented in the ZTE Petition to emphasize certain points and does, in some limited instances, add citations to evidence already of record to support the invalidity arguments. The limited additional invalidity citations fall into three categories: (i) in Section V of Microsoft's Petition, Microsoft provided additional citations to parts of the GPRS Standards that support its positions regarding the PDP Context, (ii) in certain instances where the ZTE Petition cited only the declaration of Dr. Bims, Microsoft added the citations to the evidence that Dr. Bims referenced in the cited testimony, and (iii) in Section V, a single citation to Patent Owner's expert's testimony from a hearing before the International Trade Commission was added to support the same obviousness argument presented by ZTE. The claim charts in the

Microsoft Petition and ZTE Petition contain identical citations, except for four additional citations to the GPRS Standards. Thus, the Microsoft Petition does not present new substantive issues that would complicate the proceeding. *Enzymotec v. Neptune*, IPR2014-00556, Paper 19 at 5-6 (July 9, 2014) (allowing joinder even where the later-filed petition asserted that several additional claims were anticipated based on the same evidence already of record in the previously instituted IPR).

Second, the Microsoft Petition addresses a Delaware claim construction order that issued after the ZTE Petition was filed (Ex. 1025). These arguments, however, do not add any proposed constructions for the Board to consider as the order adopted the same constructions that ZTE proposed for the IPR. The addition of this order to the record would have likely occurred when the Patent Owner filed its mandatory disclosures, and thus does not increase the scope of the proceedings.

Finally, the Microsoft Petition cites additional evidence to support ZTE's assertion that the GPRS Standards are printed publications. While Microsoft believes that Dr. Bims' declaration provides sufficient evidence to show that the GPRS Standards were printed publications, Microsoft has provided a limited (4 page) supplemental declaration by Dr. Bims that cites two additional ETSI documents to corroborate his prior testimony. As the issue of whether the GPRS

Standards were printed publications was already before the Board, this limited additional corroborating evidence will not alter the scope of the proceedings.

In sum, because the Microsoft Petition is substantively nearly-identical to the ZTE Petition, good cause exists for joining this proceeding with IPR2014-00525 in order to resolve the grounds raised in the ZTE and Microsoft Petitions in the same proceeding.

Joinder is also warranted to permit Microsoft to protect its interests related to the validity and interpretation of the 244 Patent, and Microsoft could be prejudiced if it is not permitted to join and participate in the ZTE IPR. Patent Owner has already argued that any final decision on the merits from the Board in a ZTE IPR is admissible in a district court litigation against a party other than ZTE because it is part of the intrinsic record of the patent and is a decision on the merits regarding patentability (Ex. 1036 (InterDigital's September 5, 2014 letter to Judge Andrews) (attempting to submit findings by the Board in a decision not to institute a ZTE *inter partes* review of a different InterDigital patent as evidence in a Delaware district court trial not involving ZTE); Ex. 1035 (InterDigital's September 2, 2014 letter to Judge Andrews) (arguing the same issue))). As Patent Owner may attempt to use aspects of the ZTE IPR in a future proceeding against Microsoft, fairness dictates that Microsoft should be permitted to protect its interests in the ZTE IPR.

In addition, institution of a separate *inter partes* review of the 244 Patent for Microsoft would require the Board to determine the same validity and claim construction questions concerning the 244 Patent in multiple concurrent IPR proceedings. This would duplicate efforts and create a risk of inconsistent results. Proceeding with a consolidated *inter partes* review would avoid inefficiency and potential inconsistency. For these reasons, joinder is appropriate.

2. No New Grounds of Unpatentabiltiy

The Microsoft Petition does not present any new grounds of unpatentability. As mentioned above, the Microsoft Petition involves the same patent, the same grounds and combinations of prior art, and the same claims that the Board has already agreed to review in the ZTE IPR.

3. Joinder Will Not Negatively Impact the ZTE IPR Trial Schedule

Joinder will not unduly delay the proceedings or otherwise prejudice Patent Owner in any discernable way. The Microsoft Petition is based on the same claims, grounds, and combinations of prior art that were submitted by ZTE and granted by the Board in the ZTE IPR. Since the Microsoft Petition raises no issues that are not already before the Board, joinder would not affect the timing of the ZTE IPR schedule or the content of Patent Owner's response because its response to the Microsoft Petition would not require additional analysis beyond what it is already required to undertake in connection with the ZTE IPR. Similarly, the

Microsoft Petition relies on a declaration by the same expert declarant from the ZTE IPR such that a single deposition of the declarant can occur in this proceeding. Thus, joinder on the limited additional grounds here will not unduly complicate these proceedings – in fact, joinder of the proceedings will simplify briefing and discovery and "secure the just, speedy, and inexpensive resolution" of these proceedings. *See* 37 C.F.R. § 42.1(b). Even if the Board were to determine that joinder would require a modest extension to the schedule, such an extension is permitted by law and is not a reason for denying joinder. 35 U.S.C. § 316(a)(1); 37 C.F.R. § 42.100(c). Patent Owner cannot complain of such a modest extension as it already asked for and received an 11 day extension to file its response in the ZTE IPR (ZTE IPR, Paper No. 21 (extending DUE DATE 1 from Dec. 8th to Dec. 19th)).

4. Procedures to Simplify Briefing and Discovery

Since the ZTE and Microsoft Petitions are based on the same claims, grounds, and combinations of prior art, the Board may adopt procedures similar to those used in related cases to simplify briefing and discovery. *See e.g.*, *Motorola Mobility LLC v. Softview LLC*, IPR2013-00256, Paper 10 at 8-10 (June 20, 2013). Specifically, the Board may order petitioners ZTE and Microsoft to consolidate filings. *Id.* Further, no additional depositions are needed and Microsoft submits that depositions should take place in the normal time allotted. Moreover,

Microsoft 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. These procedures would minimize any complication or delay caused by joinder. Further, at a minimum, the Board should institute on the basis of the Microsoft Petition and join Microsoft even if the Board deems it efficient to limit Microsoft's participation in some manner.

IV. CONCLUSION

For the foregoing reasons, Microsoft respectfully requests that the Board institute its Petition for *Inter Partes* Review of U.S. Patent No. 8,380,244 and join this proceeding with *ZTE Corporation v. IPR Licensing, Inc.* (IPR2014-00525).

Dated: October 16, 2014

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing "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 October 16, 2014, by UPS Overnight delivery on:

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