IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT: US 7,454,212

INVENTOR: XIAODONG LI ET AL.

FILED: August 8, 2005 ISSUED: November 18, 2008

TITLE: OFDMA WITH ADAPTIVE SUBCARRIER-CLUSTER CONFIGURATION AND SELECTIVE LOADING

CASE NO.: IPR2015-00318

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

MOTION FOR JOINDER TO RELATED INTER PARTES REVIEW (37 C.F.R. § 42.122(b))

I. Statement of Relief Requested

Petitioners Kyocera Corporation and Kyocera Communications Inc. (collectively, "Kyocera") respectfully submit this Motion for Joinder. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Kyocera requests joinder of its Petition with *Sony Mobile Communications (USA) Inc. et al. v. Adaptix, Inc.*, Case IPR2014-01525 (the "'525 IPR"), in which trial was instituted on April 8, 2015 for Ground 1 of the '525 IPR petition. Kyocera's Motion for Joinder is being filed within one month of the decision instituting trial in the '525 IPR, and is therefore timely.

Kyocera is filing this joinder motion to ensure that the '525 IPR is completed in the event that the petitioners in the '525 IPR reach settlement with the Patent Owner. In the event of settlement and termination of the '525 IPR, Kyocera would be deprived of the opportunity to seek unpatentability on grounds for which the Board has already established a reasonable likelihood of finding obviousness in its decision to institute the '525 IPR.

Additionally, joinder will not significantly impact the trial schedule in the '525 IPR, as an institution decision on Kyocera's Petition, for which the Patent Owner has already filed its Preliminary Response, will be no more than two months subsequent to the institution decision of the '525 IPR. Joinder is also appropriate here because Kyocera's Petition is narrowly drafted to challenge only

the claims of USP 7,454,212 (the "'212 patent") that are being challenged in the '525 IPR.

Kyocera will coordinate with counsel for the '525 IPR petitioners regarding the consolidation of all filings and will not submit any separate filings unless Kyocera's position differs from the position of the '525 IPR petitioners.[1] This procedure and continued cooperation of counsel will greatly simplify briefing if the Board permits joinder.

Any additional costs incurred by the existing parties to the '525 IPR will be minor and do not outweigh the prejudice to Kyocera that would result from a denial of joinder. Accordingly, joinder is appropriate and will not prejudice any party to the '525 IPR. To the contrary, joinder will provide for the just, speedy and inexpensive determination of the validity of the challenged claims of the '212 patent.

II. Statement of Material Facts

1. Patent Owner has asserted the '212 patent in dozens of patent infringement lawsuits in the United States District Courts for the Northern District of California and the Eastern District of Texas against numerous parties, including Kyocera and the petitioners in Case IPR2014-01525. These cases are in a wide

[1] Kyocera will continue on this basis unless and until the '525 IPR is terminated as to all other petitioners.

variety of procedural postures, with some dismissed, some newly-filed, and others in various states of progression.

2. With regard to Kyocera, on November 27, 2013, Kyocera Communications Inc. was served with complaints captioned *Adaptix, Inc. v. Kyocera Corp. et al.*, Civil Action Nos. 6:13-cv-853 and -854 (E.D. Tex.), alleging infringement of the '212 patent—these cases were subsequently transferred to the Northern District of California, where they are currently pending as Civil Action Nos. 5:14-cv-02894-PSG and -cv-02895-PSG.

3. On August 28, 2014, a Petition for *Inter Partes* Review challenging claims 1, 8-13, 15, 16, 18-21 and 23-30 of the '212 patent was filed by BlackBerry Corporation and BlackBerry Limited ("BlackBerry"). BlackBerry settled its dispute with the Patent Owner, and BlackBerry's Petition was terminated on January 29, 2015, prior to a decision on institution.

4. On September 19, 2014, a Petition for *Inter Partes* Review challenging claims 1, 8-13, 15, 16, 18-21 and 23-30 of the '212 patent was filed by Sony Mobile Communications (USA) Inc. ("Sony").

5. On April 8, 2015, a decision instituting trial was entered in Case IPR2014-01525 on the ground of claims 1, 8-13, 15, 16, 18-21, and 23-30 of the '212 patent being obvious over Ritter (DE 19800953) and Kapoor (USP 6,795,424) under 35 U.S.C. § 103 (*i.e.,* Ground 1).

6. Kyocera filed a Petition on November 26, 2014, challenging claims 1, 8-13, 15, 18, 19 and 23-29 of the '212 patent on five grounds including grounds relying on the same prior art, Ritter, for which trial was instituted in the '525 IPR.

7. The five grounds in Kyocera's Petition include: claims 1, 8, 11-13, 18, 19, 23 and 26-28 being obvious over Frodigh (USP 6,726,978) and Sollenberger (USP 6,052,954) under 35 U.S.C. § 103(a); claims 1, 8-13, 15, 18, 19, 23-27, and 29 being obvious over Frodigh, Sollenberger and Ritter; claims 1, 8, 11-12, 18, 23, and 26-28 being obvious over Frodigh in view of Chuang ("A pilot based dynamic channel assignment scheme for wireless access TDMA/FDMA systems") under 35 U.S.C. § 103(a); claims 1, 8-12, 15, 18, 23-37, and 29 being obvious over Frodigh, Chuang, and Ritter under 35 U.S.C. § 103(a); and claims 1, 8-13, 15, 18, 19, 23-26 and 29 being obvious over Alamouti (USP 5,933,421), Minegishi (6,072,988), and Ritter under 35 U.S.C. § 103(a).

8. The Patent Owner filed a Preliminary Response to Kyocera's Petition on March 11, 2015. The Preliminary Response addressed each of the five grounds raised in Kyocera's Petition.

III. Statement of Reasons for Requested Relief

A. Legal Standard

The Leahy-Smith America Invents Act (AIA) permits joinder of like review proceedings, e.g. an *inter partes* review may be joined with another *inter partes*

review. 37 C.F.R. § 42.122(a). The Board has discretion to join parties to an existing *inter partes* review. 35 U.S.C. § 315(c). In deciding whether to exercise its discretion, the Board considers factors including: (1) the movant's 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. *Dell Inc. v. Network-1 Security Solutions, Inc.*, IPR2013-00385, Paper No. 17 at 4 (July 29, 2013).

B. Kyocera's Motion for Joinder is Timely

This Motion for Joinder is timely under 35 U.S.C. § 315© and 37 C.F.R. § 42.122(b) as being submitted within one month of the institution of trial in the '525 IPR on April 8, 2015.

C. Joinder is Appropriate

1. No Prejudice

Joinder is appropriate because no party to the '525 IPR will be significantly prejudiced. In contrast, declining to grant joinder would prejudice Kyocera by failing to ensure that the '525 IPR is completed in the event that Sony reaches settlement with the Patent Owner. Should Sony and the Patent Owner settle and successfully terminate the '525 IPR, Kyocera would be deprived of the opportunity to seek unpatentability based on Ground 1 for which the Board has already determined a reasonable likelihood of finding obviousness. Given that the Patent

Owner has settled with other defendants so far, including BlackBerry resulting in an early termination of BlackBerry's Petition, this is a significant concern. Joinder with the '525 IPR will guarantee the preservation of unpatentability based on Ground 1.

While Kyocera's Petition raises additional grounds of unpatentability including additional prior art, the Patent Owner will be required to address these grounds to the extent the Board institutes a trial based on Kyocera's Petition.[2] The non-cumulative nature of the grounds in Kyocera's Petition with respect to Ground 1 in the '525 IPR makes such an outcome a reasonably likely possibility. Moreover, since the Patent Owner has already filed a Preliminary Response to Kyocera's Petition, the Patent Owner has already reviewed and addressed the additional non-cumulative grounds presented in Kyocera's Petition. Whether the Patent Owner must face the additional non-cumulative grounds in a separate proceeding or joined with Ground 1 in the '525 IPR, the Patent Owner suffers no additional prejudice by granting joinder. In fact, granting joinder would more likely simplify the proceedings for the Patent Owner.

[2] Kyocera's Petition was filed within one year of service of the complaint asserting infringement of the '212 patent and therefore does not rely on joinder to avoid the one-year statutory deadline.

Finally, since Kyocera's Petition is narrowly drafted to address only claims upon which the '525 IPR trial has been instituted and includes overlapping prior art, joinder will result in no substantial additional cost to any party including the Patent Owner. Therefore, no party will be prejudiced if the Board permits joinder.

2. Minimal Impact to Schedule

Given the close timing between the filing of Kyocera's Petition and the '525 IPR, granting joinder will minimally impact the current trial schedule for the '525 IPR. In particular, the Board's decision on whether to institute a trial for Kyocera's Petition is scheduled to be within two months of the institution decision for the '525 IPR. With such a short time difference between institution decisions, joinder will not require any significant alteration to the trial schedule currently in place in the '525 IPR.

3. Briefing and Discovery Simplified

Kyocera is in communication with counsel for the '525 IPR petitioners and will cooperate on all briefing and discovery. Kyocera will also coordinate with counsel for the '525 IPR petitioners to consolidate filings. Unless and until the '525 petitioners settle with the Patent Owner, Kyocera will not submit any separate filings to the PTO unless it disagrees with the positions of the current petitioners. Kyocera's coordination and cooperation with the '525 IPR Petitioners on briefing, discovery, and filings will therefore simplify the proceedings addressing the

validity of the challenged claims of the '212 patent for both the Patent Owner and the Board.

IV. Conclusion

For the foregoing reasons, Kyocera respectfully requests that the Board join the Kyocera Petition with *Sony Mobile Communications (USA) Inc. et al. v. Adaptix, Inc.*, Case IPR2014-01525. Although it is believed that no fee is required for this Motion, the Commissioner is hereby authorized to charge any additional fees that may be required for this Motion to Deposit Account No. 505708.

Respectfully submitted,

Kyocera Corporation and Kyocera Communications Inc.,
Petitioners

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CERTIFICATE OF SERVICE

Under 37 C.F.R. §§ 42.6 and 42.105, the undersigned certifies that on the 8th day of May 2015, a complete and entire copy of the MOTION FOR JOINDER TO RELATED INTER PARTES REVIEW (37 C.F.R. § 42.122(b)) was provided, via electronic mail, to the Patent Owner's designated lead and back-up counsel of record: Amedeo F. Ferraro (Reg. No. 37,129) as Patent Owner's lead counsel (aferraro@martinferraro.com); and Wesley C. Meinerding (Reg. No. 57,925) and Alfred Y. Chu (Reg. No. 62,317) as Patent Owner's backup counsel (docketing@martinferraro.com)

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