

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

In the Patent of: **Yang, Xiu Zheng**, Shulin (TW);
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U.S. Patent No: 8,265,096

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Filing Date: July 7, 2008

Title: METHOD FOR CONSTRUCTING FRAME STRUCTURES

**PETITIONER'S MOTION FOR JOINDER UNDER 35 U.S.C.
§ 315(c), 37 C.F.R. § 42.22, AND 42.122(b)**

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b), ZyXEL Communications Corporation (“Petitioner”) moves for joinder with the *Inter Partes* Review of U.S. Patent No. 8,265,096 (“the ’096 patent”), *Qualcomm Incorporated v. UNM Rainforest Innovations*, IPR2021-00375, Paper 2 (Dec. 28, 2020) (“the Qualcomm IPR”), for which the petition for *inter partes* review was filed on December 28, 2020 (“the Qualcomm Petition”) and is currently pending. IPR2021-00375, Paper 2. This motion is timely because it is filed “no later than one month after the institution date” of the Qualcomm IPR. 37 C.F.R. § 42.122(b); *Central Security Group – Nationwide, Inc. v. Ubiquitous Connectivity, LP*, IPR2019-01609, Paper 11, at 8-9 (P.T.A.B. Feb. 26, 2020) (stating that § 42.122(b) is “[t]he only timing requirement for a motion for joinder”); *Dell Inc. v. Neodron Ltd.*, IPR2020-00731, Paper 9, at 5 (P.T.A.B. July 31, 2020) (granting motion for joinder to an IPR proceeding that was not instituted until after the motion for joinder was filed). Petitioner requests that action on this motion be held in abeyance until, and only in the event of, institution of the Qualcomm IPR. Petitioner understands that Qualcomm, the petitioner in the Qualcomm IPR, does not oppose Petitioner’s request for joinder.

ZyXEL’s Petition relies on the references cited and follows the arguments raised in the Qualcomm Petition, and is essentially a copy of the Qualcomm Petition.

Petitioner here asserts that the same claims are invalid based on substantially the same arguments presented in the Qualcomm IPR. Moreover, Petitioner's declaration is substantively identical to the declaration in the Qualcomm IPR. ZyXEL's Petition includes the identical grounds presented in the Qualcomm Petition and therefore would create no additional burden for the Board, Qualcomm, or UNM Rainforest Innovations if joined. Joinder would therefore lead to an efficient resolution of the validity of the '096 patent.

Moreover, the undersigned counsel is also the counsel of record for Qualcomm. ZyXEL stipulates that if joinder is granted, it will cooperate with Qualcomm in the joined proceeding, whether at hearings, at depositions, in filings, or otherwise, as outlined below. Unless Qualcomm is terminated from the proceedings, ZyXEL will proceed in a limited "understudy" role. Joinder will not impact the trial schedule because the proceeding based on the Qualcomm Petition is in its early stages.

The Board has granted joinder in other proceedings when presented with this fact pattern and procedural history. For example, in *Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11 (P.T.A.B. Oct. 30, 2018), the petitioner, Celltrion, filed a petition with a motion for joinder to Pfizer's pending petition IPR2017-01923. *Id.* at 13. Celltrion had agreed to take an understudy role to Pfizer and no deadlines in the original IPR were changed. *Id.* at 14. The Board therefore granted

joinder, finding that doing so did not increase the burden on either the alleged patent owner or the Board, and the timing of petition supported joinder. *Id.* The Board reached the same conclusion in *Pfizer, Inc. v. Genentech, Inc.*, IPR2017-02063, Paper 25 (P.T.A.B. Feb. 21, 2018), where Pfizer took “understudy” role to earlier filed and not-yet-instituted Celltrion petition.

Here, ZyXEL agrees to let Qualcomm take a lead role with ZyXEL taking the understudy role. Under these circumstances, like those in IPR2017-01063, there is no undue prejudice to UNM Rainforest Innovations (“UNM”), an assignee indicated as on the Patent Office’s record as an alleged patent owner , and therefore the Board should institute IPR and grant ZyXEL’s Motion for Joinder. *See* IPR2017-01063, Paper 25 at 3-5.

Accordingly, and for the reasons discussed below, joinder should be granted.

II. BACKGROUND AND RELATED PROCEEDINGS

UNM Rainforest Innovations which was formerly named STC.UNM, has asserted certain claims of the ’096 patent in the following pending district-court lawsuits: *UNM Rainforest Innovations v. ASUSTek Computer, Inc.*, No. 6:20-cv-00142 (W.D. Tex.); *UNM Rainforest Innovations v. Dell Techs. Inc. et al.*, No. 6:20-cv-00468 (W.D. Tex.); *UNM Rainforest Innovations v. D-Link Corp.*, No. 6:20-cv-00143 (W.D. Tex.); *UNM Rainforest Innovations v. TP-Link Techs. Co.*, No. 6:19-

cv-00262 (W.D. Tex.); and *UNM Rainforest Innovations v. ZyXEL Commc'ns Corp.*, No. 6:20-cv-00522 (W.D. Tex.).

On December 28, 2021, Qualcomm filed a petition for *inter partes* review of this patent. See *Qualcomm Incorporated v. UNM Rainforest Innovations*, IPR2021-00375, Paper 2 (Dec. 28, 2020) (“the Qualcomm IPR”). ZyXEL files this motion concurrently with a petition for *inter partes* review of the ’096 patent. ZyXEL has not filed any other petitions for *inter partes* review of the ’096 patent.

III. ARGUMENT

The Board may join any person who properly files a petition for *inter partes* review to a separate IPR proceeding. 35 U.S.C. § 315(c). A motion for joinder should “(1) set forth the 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.” *Macronix Int’l Co., Ltd. v. Spansion LLC*, IPR2014-00898, Paper 15 at 4 (P.T.A.B. Aug. 13, 2014) (citing *Kyocera Corp. v. SoftView LLC*, IPR2013-00004, Paper 15 at 4 (P.T.A.B. Apr. 24, 2013)).

ZyXEL’s motion is timely, and the Board should grant joinder because consideration of the foregoing factors weighs in favor of joinder.

A. ZyXEL’s Motion for Joinder Is Timely

Joinder may be requested “no later than one month after the institution date of any *inter partes* review for which joinder is requested.” 37 C.F.R. § 42.122(b). Qualcomm’s petition was filed on December 28, 2020 and has not yet been instituted as of filing of this motion. Accordingly, ZyXEL’s motion is timely as it is being filed within the time set by 37 C.F.R. § 42.122(b). *Central Security Group – Nationwide, Inc. v. Ubiquitous Connectivity, LP*, IPR2019-01609, Paper 11, at 8-9 (P.T.A.B. Feb. 26, 2020) (stating that § 42.122(b) is “[t]he only timing requirement for a motion for joinder”); *Dell Inc. v. Neodron Ltd.*, IPR2020-00731, Paper 9 at 5 (P.T.A.B. July 31, 2020) (granting motion for joinder to an IPR proceeding that was not instituted until after the motion for joinder was filed).

B. The Kyocera Factors Weigh in Favor of Joinder

Each of the four factors that the Board considers in motions for joinder favor granting of ZyXEL’s motion. As shown below, joinder will not add further complication to the proceedings or cause prejudice to the parties. Moreover, joinder will significantly simplify briefing, discovery and trial associated with review of the ’096 patent.

1. Joinder of ZyXEL is Appropriate Because It Will Promote an Efficient Determination of the Validity of the ’096 Patent Without Prejudice to Any Party

If ZyXEL is joined as a party, the validity of the grounds raised in the Qualcomm Petition and ZyXEL’s Petition can be determined in a single proceeding.

ZyXEL's Petition challenges the validity of the same claims of the '096 patent on identical grounds to those in the Qualcomm Petition. There are no substantive differences between ZyXEL's and Qualcomm's petitions. *See Qualcomm*, IPR2021-00375, Paper 2 (Dec. 28, 2020). ZyXEL also relies on substantially the same supporting evidence in its Petition as is relied on in the Qualcomm Petition.¹ A consolidated proceeding, including both ZyXEL and Qualcomm, will therefore be more efficient and less wasteful, as only a single trial on these common grounds would be required. *See, e.g., Oracle America*, IPR2016-01672, Paper 13 at 7 (PTAB Mar. 7, 2017) (noting that "joining Oracle's identical challenges to those in the 1002 IPR will lead to greater efficiency while reducing the resources necessary from both Realtime and the Board"). In addition, since the parties will be presenting, and the Board will be determining, the same issues in both IPRs, joinder is the most efficient and economical manner to proceed. *See, e.g., Kingston Tech.*, 2020 WL 1480468, at *8 (granting joinder of "me too" petition); *Mylan Pharmaceuticals Inc. v. Almirall*, No. IPR2019-01095, 2019 WL 6443934, at *4 (P.T.A.B. Nov. 27, 2019) (same); *Ariosa Diagnostics*, 2013 WL 6514079, at *1 (granting motion for joinder where the

¹ ZyXEL submits a copycat declaration from Dr. Sumit Roy. The supporting declaration submitted by ZyXEL does not differ substantively from that filed by Qualcomm.

second petition involved the same parties, the same patent, and much of the same prior art).

Joining ZyXEL as a party to the Qualcomm IPR also would not cause any prejudice to either UNM or Qualcomm. UNM must respond to the common invalidity grounds identified in Qualcomm's and ZyXEL's Petitions regardless of joinder. Thus, UNM bears no additional burden. For both UNM and Qualcomm, ZyXEL's Petition has been filed sufficiently early so that joinder would affect neither the potential schedule of the *inter partes* review, nor the costs associated with a full trial. *See Oracle America*, IPR2016-01672, Paper 13 at 7.

Accordingly, this factor favors joinder.

2. ZyXEL's Petition Does Not Raise Any New Grounds of Unpatentability and Therefore Does Not Add Additional Complexity to the Grounds in Qualcomm's Petition

ZyXEL's Petition challenges the validity of the '096 patent on identical grounds to those in the Qualcomm Petition. *See Qualcomm*, IPR2021-00375, Paper 29 (Dec. 28, 2020). ZyXEL's supporting materials, including its supporting expert declaration, are also substantially the same as those presented by Qualcomm. *See, supra*, n.1. Therefore, consolidation of this proceeding with Qualcomm's via joinder of ZyXEL's Petition will not raise any new issues of unpatentability and will not impose any additional burden on the Board or add additional complexity to the case. The Board has granted joinder in similar situations. *See, e.g., Hyundai Motor Co. v.*

Am Vehicular Scis. LLC, IPR2014-01543, Paper 11 at 2-4 (PTAB Oct. 24, 2014); *Sony Corp. of Am. v. Network-1 Sec Solutions, Inc.*, IPR2013-00495, Paper 13 at 5-9 (PTAB Sept. 16, 2013); *Dell Inc. v. Network-1 Solutions, Inc.*, IPR2013- 00385, Paper 17 at 6-10 (PTAB July 29, 2013); *Motorola Mobility*, IPR2013- 00256, Paper 10 at 4-10 (PTAB June 20, 2013).

Accordingly, this factor favors joinder.

3. Joinder Would Not Affect the Schedule in the Qualcomm IPR

Given that the Board has not yet instituted review of the Qualcomm petition, joinder of ZyXEL would not affect the schedule in any forthcoming trial. In addition, joining Petitioner's proceeding will not add any procedural complications or delay the progress of resolving the substantive issues pending in the Qualcomm IPR because it will not introduce any new prior art, expert opinions, or grounds of unpatentability into the Qualcomm IPR. ZyXEL's participation would result in no changes to the schedule or otherwise unfairly prejudice the UNM.

Accordingly, this factor favors joinder.

4. Joinder Will Simplify Briefing and Discovery Because ZyXEL Has Agreed to Consolidated Filings and an Understudy Role

To further prevent joinder from imposing any burden on Qualcomm or UNM and to further ensure that there are no changes in the potential trial schedule, ZyXEL agrees, as long as Qualcomm remains a party to the review, to (1) coordinate any

communications with Qualcomm; (2) not produce its own testifying witnesses; and (3) not file substantive papers (except for those associated with Board-approved motions that do not affect Qualcomm or Qualcomm's position).

ZyXEL also will confer and cooperate with Qualcomm on the consolidated filings but, as long as Qualcomm is a party to the review, Qualcomm will make all final decisions and will retain responsibility for oral argument (including telephone hearings and appeals). ZyXEL will not seek or receive separate time and will not separately argue during oral argument, including telephone hearings and appeals, except when addressing Board-approved motions that do not affect Qualcomm or Qualcomm's position.

ZyXEL also will coordinate the discovery and testimony relating to witnesses with Qualcomm but, as long as Qualcomm is a party to the review, Qualcomm will make all final decisions. In particular, as long as Qualcomm is a party to the review, ZyXEL will not separately file or serve objections or discovery requests, will not receive separate cross examination or redirect time, will not separately cross examine or redirect any witness, and agrees that cross examinations will occur within the timeframe normally allotted to one party without a need for extension in light of the joinder.

Thus, for briefing and document submissions, as long as Qualcomm remains a party to the *inter partes* review, the Board may order petitioners to consolidate

filings such that Qualcomm would submit papers on behalf of petitioners and ZyXEL would not be allowed additional filings. Moreover, for depositions, no adjustments to the schedule would be required and, indeed, no additional depositions would be necessary. ZyXEL will not rely on expert testimony beyond that submitted by Qualcomm unless Qualcomm is terminated from the case prior to any necessary depositions. Absent termination of Qualcomm from the proceedings, ZyXEL will participate only in a secondary “understudy” role. However, if Qualcomm is no longer a party, ZyXEL will be free to rely on the opinions and testimony of Dr. Roy.

As a result of the foregoing, by consolidating filings with Qualcomm, UNM will only need to respond to one principal set of papers. No further time to address additional arguments will be required by any party, and the consolidated trial can thus proceed at the same pace as if ZyXEL was not joined. *Torrent Pharm Ltd, v. UCB Pharma GMBH*, IPR2016-01636, Paper 10 at 5 (PTAB Dec. 7, 2016); *Amerigen Pharm Ltd, v. UCB Pharma GMBH*, IPR2016-01665, Paper 8 at 6 (PTAB Dec. 7, 2016).

Accordingly, this factor favors joinder.

C. The Board Has Granted Joinder under these Circumstances, Finding No Undue Burden or Prejudice

As discussed above, the Board has granted joinder in other petitions, with facts that mirror those here. ZyXEL has agreed to take an understudy role and no deadlines

in the Qualcomm IPR will not be affected. Therefore, the Board should institute IPR and grant ZyXEL's Motion for Joinder.

IV. CONCLUSION

For the foregoing reasons, ZyXEL respectfully requests that the Board grant its concurrently filed Petition for *inter partes* review of the '096 patent and join the grounds of invalidity therein raised with Qualcomm IPR2021-00375.

Dated: March 29, 2021

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that true copies of the foregoing Motion for Joinder has been served this 29th day of March, 2021, by UPS® mail delivery service on UNM at the correspondence address for the attorney of record for the '096 Patent shown in USPTO PAIR:

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