

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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Title: METHOD FOR CONSTRUCTING FRAME STRUCTURES

PTAB Case No. IPR2021-00734

Patent No. 8,265,096 B2

**PETITIONER ZYXEL COMMUNICATIONS CORPORATION'S REPLY
IN SUPPORT OF ITS 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. INTRODUCTION

ZyXEL Communications Corporation (“ZyXEL” or “Petitioner”) files this reply in support of Petitioner’s Motion for Joinder Under 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22, and 42.0122, Paper No. 3 (“Motion”) and in response to “Patent Owner UNM Rainforest Innovations’ Opposition to Petitioner’s Motion for Joinder” (“Opposition” or “Opp”), Paper 7. ZyXEL’s Petition for *Inter Partes* Review of U.S. Patent No. 8,265,096, IPR2021-00734, Paper 1 (“ZyXEL’s Petition”) does not raise any issues for the Board to decide beyond those raised in *Qualcomm Incorporated v. UNM Rainforest Innovations*, IPR2021-00375, Paper 1 (December 28, 2020) (“Qualcomm’s Petition”), which also seeks *inter partes* review of U.S. Patent No. 8,265,096 (“the ’096 patent”). Importantly, and contrary to the primary argument in the Opposition, ZyXEL’s Motion does not seek to have the Board decide the issue of ownership of the ’096 patent, and ZyXEL’s Petition does not raise any additional grounds of unpatentability of the ’096 patent. Rather, the grounds for invalidity and discussion of those grounds in ZyXEL’s Petition are exactly the same as those in Qualcomm’s Petition. Nevertheless, UNM opposes joinder, asserting that ZyXEL’s Petition raises an issue of ownership that was not raised in Qualcomm’s Petition and would be improper before the Board. Opp. at 1. This argument is unfounded, because ZyXEL, in its position as a joined petitioner,

does not attempt and will not attempt to introduce the issue of ownership into Qualcomm's IPR.¹ See Opp. at 2.

UNM also urges the Board to deny the Motion as premature, because the Board has not yet made an institution decision on the Qualcomm IPR. Opp. at 5. This argument fares no better. ZyXEL's Motion was filed within the regulatory deadline set forth under 37 C.F.R. § 42.122(b), and that is all that is necessary.

II. JOINDER WOULD NOT RAISE A NEW OR IMPROPER ISSUE INTO THE QUALCOMM IPR

As stated in ZyXEL's Motion and as is apparent from a comparison of ZyXEL's Petition with Qualcomm's Petition, ZyXEL's Petition relies on the exact same prior art references, arguments, and expert as those in Qualcomm's Petition.

In an attempt to create an issue where one does not exist, UNM has latched onto the fact that ZyXEL's Petition does not refer to UNM as "the patent owner." Opp. at 1. This is of no moment. Indeed, UNM did not – and cannot – identify a single statement, argument, or request in ZyXEL's Petition that asks the Board to decide the issue of ownership of the '096 patent, because ZyXEL does not seek to have Board do so in this proceeding. ZyXEL asks the Board to decide only the same issues of invalidity of the '096 patent as those raised in the Qualcomm Petition.

¹ ZyXEL reserves all rights to challenge ownership of the '096 patent in the ongoing district court litigation between UNM and ZyXEL.

UNM's reliance on *Unified Patents Inc., v. C-Cation Technologies, LLC*, IPR2015-01045, Paper 15 at 7, is misplaced. There, although Unified Patents' petition asserted the same invalidity grounds and presented the same arguments as a petition previously filed by a third party, C-Cation argued in its preliminary response that Unified Patents had failed to identify all of the real parties in interest. When Unified Patents sought to join the earlier filed petition, C-Cation argued that joinder was improper because Unified Patents' petition introduced an additional issue beyond that in the earlier-filed petition – one concerning the issue of the identities of the real parties in interest. The Board agreed with C-Cation and concluded that introducing the real parties in interest issue into the previously-filed petition would shift “the focus away from the substantive issue to be addressed” and therefore denied Unified Patents' motion for joinder.

By contrast, ZyXEL's Petition has not introduced any real party in interest issue, and the *Unified Patents* decision is simply inapposite. To be sure, UNM's attempt to apply the rationale of the *Unified Patents* decision here fails in any event because, as noted above, ZyXEL's has not introduced ownership as an issue either. Therefore, ZyXEL's petition does not raise any issue that would shift “the focus away from the substantive issue to be addressed--the patentability” of claims 1-4 and 6-8 of the '096 patent, and ZyXEL's Motion is proper. See *Unified Patents Inc., v. C-Cation Technologies, LLC*, IPR2015-01045.

III. ZYXEL'S MOTION IS NOT PREMATURE

UNM argument that the Motion is premature likewise fails. Opp. at 5-6. ZyXEL's motion is timely because it was 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* is instructive. There, the Board rejected the same argument that UNM makes here and granted a motion for joinder to an IPR proceeding that was not instituted until after the motion for joinder was filed, explaining that § 42.122(b) is "[t]he only timing requirement for a motion for joinder." *Central Security Group – Nationwide, Inc. v. Ubiquitous Connectivity, LP*, IPR2019-01609, Paper 11, at 8–9 (P.T.A.B. Feb. 26, 2020); see also *Dell Inc. v. Neodron Ltd.*, IPR2020-00731, Paper 9, at 5 (P.T.A.B. July 31, 2020). UNM does not cite any Board decisions denying a conditional motion for joinder as premature. Accordingly, UNM's argument is meritless.

IV. CONCLUSION

For the foregoing reasons, ZyXEL respectfully requests that the Board grant its Motion for Joinder.

Dated: May 25, 2021

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4) and 42.25(b), the undersigned certifies that on May 25, 2021, a complete copy of *Petitioner's Reply In Support Of Its Motion For Joinder Under 35 U.S.C. § 315(c), 37 C.F.R. § 42.22, and 42.122(b)* was filed electronically through the Patent Trial and Appeal Board's PTABE2E System and provided, via electronic service, to UNM Rainforest Innovations by serving the correspondence address of record as follows:

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