

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QORVO, INC.,

Petitioner,

v.

CORNELL RESEARCH FOUNDATION, INC.,

Patent Owner.

Case No. IPR2024-00758

U.S. Patent No. 7,250,360

**PETITIONER'S CONTINGENT MOTION FOR JOINDER WITH
IPR2024-00609 UNDER 35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122**

I. Statement Of Relief Requested

Qorvo, Inc. (“Petitioner”) respectfully submits this Contingent Motion for Joinder concurrently with a Petition for *Inter Partes* Review of U.S. Patent No. 7,250,360 (the “’360 patent” and “Qorvo Petition”). As set forth in the Qorvo Petition, the ’360 Patent has been asserted against it in District Court.

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner contingently moves for joinder with any *inter partes* review that is instituted as to the ’360 patent in *IQE PLC v. Cornell Research Foundation, Inc.*, IPR2024-00609 (the “IQE IPR”) in accordance with the Petition filed by IQE PLC on March 1, 2024 therein (“IQE Petition”). Petitioner requests that action on this motion be held in abeyance until the Board issues an institution decision in the IQE IPR. If the IQE IPR is instituted, Petitioner requests this motion be considered and granted. Alternatively, should the IQE IPR be terminated prior to any institution decision, or otherwise not instituted for any reason, Petitioner submits this motion would be moot, and requests the Board consider Qorvo’s Petition on its own merits. This motion is timely under 37 C.F.R. § 42.22 and 42.122(b) because it is being filed before the Board has made an institution decision in the IQE IPR. *Blue Coat Systems, Inc. v. Finjan, Inc.*, IPR2016-00480, Paper 9 at 7 (PTAB June 24, 2016) (granting motion for joinder and rejecting patent owner’s contention that joinder motion filed before institution was premature).

The Qorvo Petition is substantively the same as the IQE Petition. It challenges the same claims on the same grounds as the IQE Petition. It relies on the same prior art as the IQE Petition. And it is supported by substantially the same expert declaration by the same expert, Dr. Shanfield, as the IQE Petition. Accordingly, no additional burden would be created for the Board, IQE, or Patent Owner if Qorvo were joined to the IQE IPR. Indeed, Joinder would lead to an efficient resolution of the invalidity of the '360 patent.

Petitioner stipulates that, if joinder is granted, IQE will maintain the lead role in the IQE IPR and Petitioner will act as an “understudy” unless IQE ceases to participate in the proceeding. Only at that time would Petitioner take on the lead role. Unless IQE ceases to participate in the proceeding, Petitioner will not seek additional depositions or deposition time beyond what IQE would be entitled to by rule. Accordingly, the proposed joinder will neither unduly complicate the IQE IPR nor delay its schedule.

Joinder will not unduly prejudice any party. Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or increase needless filings, any additional costs on the Patent Owner would be minimal. On the other hand, denial of joinder would prejudice Petitioner. Petitioner’s interests may not be adequately protected in the IQE IPR, particularly if IQE settles with the

Patent Owner. Petitioner should be allowed to join in a proceeding affecting a patent that has been asserted against it.

Accordingly, both the IQE Petition and Qorvo Petition warrant institution under 35 U.S.C. § 314 for the reasons set forth therein, and 35 U.S.C. § 315(c) permits Petitioner's joinder to the IQE IPR (if instituted).

II. Statement of Reasons for the Relief Requested

A. Legal Standards and Applicable Rules

The Board has discretion to join a properly filed IPR petition to an existing IPR proceeding. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); *see also Sony Mobile Commc'ns AB v. Ancora Techs., Inc.*, IPR2021-00663, Paper 17, at 29-33; *Dell Inc. v. Network-1 Sec. Solutions, Inc.*, IPR2013-00385, Paper 19, at 4-6; *Sony Corp. v. Yissum Res. & Dev. Co. of the Hebrew Univ. of Jerusalem*, IPR2013-00326, Paper 15, at 3-4; *Microsoft Corp. v. Proxyconn, Inc.*, IPR2013-00109, Paper 15, at 3-4; *Mercedes-Benz Grp. AG v. Neo Wireless, LLC.*, No. IPR2023-00079, Paper No. 11 at 6-14.

“The Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations.” *Dell*, IPR2013-00385, Paper 19, at 3. The movants bear the burden of proof in establishing entitlement to the requested relief. 37 §§ 42.20(c), 42.122(b). 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.

Dell, IPR2013-00385, Paper 19, at 4.

Here, all factors weigh in favor of granting this motion.

B. Joinder Is Appropriate

The Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.” *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper No. 12 at 9 (Aug. 24, 2016) (emphasis added) (internal quotations and citations omitted). *See also Sony*, IPR2015-01353, Paper No. 11 at 5-6 (granting institution of IPR and motion for joinder where petitioners relied “on the same prior art, same arguments, and same evidence, including the same expert and a substantively identical declaration”).

Here, in the event the IQE IPR is instituted, joinder is appropriate because the Qorvo Petition involves the same patent, challenges the same claims, relies on substantively the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the IQE Petition. Indeed, the Qorvo Petition is substantively identical to the IQE Petition as to all technical issues, differing

only in statements related to formalities of a different party filing the petition and party-based differences in its discretionary denial section. Because these proceedings introduce identical unpatentability arguments and the same grounds, good cause exists for joinder, so that the Board, consistent with 37 C.F.R. § 42.1(b), can efficiently “secure the just, speedy, and inexpensive resolution” of this proceeding and the IQE IPR.

C. Joinder Will Not Add Any New Grounds of Unpatentability or Impact the Trial Schedule

The Qorvo Petition is based on exactly the same grounds and combinations of prior art in the IQE Petition. Indeed, Petitioner has copied the substance of the IQE Petition and its accompanying expert declaration in this regard. Petitioner does not seek to introduce grounds or claims not currently in the IQE IPR and seeks only to join the proceeding if, and as, instituted.

D. Joinder Will Not Impact the Trial Schedule

The Qorvo Petition is being filed only a few weeks after the IQE Petition and, as discussed above, is based on exactly the same grounds and combinations of prior art advanced in the IQE Petition. The Qorvo Petition does not seek to broaden the scope of any instituted IQE IPR. Patent Owner will not be required to provide any additional analysis or arguments addressing patentability when responding to the Qorvo Petition beyond what it will already provide in responding to the IQE

Petition. Moreover, Patent Owner should not require any discovery beyond that which it may need in the IQE IPR.

While it may be the case that Patent Owner will advance different discretionary denial arguments between the IQE and Qorvo Petitions that the Board may have to consider pre-institution, this would not affect the trial schedule for any IPR instituted in accordance with IQE's Petition.

Accordingly, joinder with the IQE IPR does not unduly burden or negatively impact the trial schedule.

E. Procedures to Simplify Briefing and Discovery

Petitioner agrees to take an “understudy” role, which will simplify briefing and discovery. Specifically, Petitioner agrees, upon joining the IQE IPR, that the following conditions, as previously approved by the Board in similar circumstances, shall apply so long as IQE remains an active party in the IQE IPR (and absent other agreement between Patent Owner, IQE, and Petitioner):

- A. all filings by Petitioner in the IQE IPR shall be consolidated with the filings of IQE, unless a filing concerns issues solely involving Petitioner;
- B. Petitioner shall not be permitted to raise any new grounds not instituted by the Board in the IQE IPR, or introduce any argument or discovery not introduced by IQE;

- C. Petitioner shall be bound by any agreement between Patent Owner and IQE concerning discovery and depositions; and
- D. Petitioner at deposition shall not receive any direct, cross examination, or redirect time beyond that permitted under either 37 C.F.R. § 42.53 or any agreement between Patent Owner and IQE.

See Noven Pharms., Inc. v. Novartis AG, IPR2014-00550, Paper No. 38 at 5 (Apr. 10, 2015); *see also Mercedes-Benz Grp. AG v. Arigna Tech. Ltd.*, No. IPR2022-00776, Paper No. 8 at 1S1 (P.T.A.B. Sept. 8, 2022).

Unless and until IQE ceases to participate in the IQE IPR, Petitioner will not assume an active role in the IQE IPR. Petitioner will not rely on expert testimony beyond that submitted by IQE unless IQE is terminated from the case prior to any necessary depositions.

By Petitioner accepting an “understudy” role, the parties can comply with the trial schedule assigned to the IQE IPR without needing any duplicative efforts by the Board or the Patent Owner. These steps minimize the possibility of any complication or delay from joinder. *See LG*, IPR2015-01353, Paper No. 11 at 6-7 (granting IPR and motion for joinder because “joinder would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board” where petitioners agreed to an

“understudy” role). Petitioner is further willing to agree to any other reasonable conditions the Board deems necessary.

III. Conclusion

Joinder will not affect the substance, procedure, or scheduling of the IQE IPR. Petitioner files this motion under the statutory joinder provisions as contemplated by the AIA. Joinder will simplify the issues and promote efficiency, justice, and speed.

For the foregoing reasons, Petitioner respectfully requests *inter partes* review of U.S. Patent No. 7,250,360 and joinder with *IQE PLC v. Cornell Research Foundation, Inc.*, IPR2024-00609 if it is instituted.

Dated: April 17, 2024

Respectfully submitted,

/s/ Robert M. Masters

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing *Petitioner's Contingent Motion for Joinder* was served in its entirety on April 17, 2024, on the Patent Owner at the following addresses of record as listed in the Patent Center, via Priority Mail Express® or Express Mail:

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Patent Owner Correspondence Address

The undersigned certifies that on April 17, 2024, a true and correct copy of the foregoing *Petitioner's Contingent Motion for Joinder* was also sent via electronic mail to the attorneys of record for Plaintiff in the concurrent litigation matter:

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