

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QORVO, INC.,
Petitioner

v.

CORNELL RESEARCH FOUNDATION, INC.,
Patent Owner

Case: IPR2024-00758
U.S. Patent No. 7,250,360

**PATENT OWNER'S RESPONSE TO PETITIONER'S CONTINGENT
MOTION FOR JOINDER WITH IPR2024-00609**

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I. INTRODUCTION

Petitioner contingently moves for joinder with another *inter partes* review proceeding related U.S. Patent No. 7,250,360 (the “360 Patent”): *IQE PLC v. Cornell Research Foundation, Inc.*, IPR2024-00609 (P.T.A.B.) (filed March 1, 2024) (the “IQE IPR”). Paper 3 at 1. As will be explained in its upcoming Patent Owner Preliminary Response, Patent Owner believes that the Board should deny institution of the IQE IPR. For that reason, Patent Owner also believes that the Board should deny institution of Petitioner’s present *inter partes* review. However, to the extent the Board does institute the IQE IPR, Patent Owner believes joinder would be appropriate if Petitioner is given the “understudy” role laid out in *Noven Pharms., Inc. v. Novartis AG*, IPR2014-00550, Paper No. 38 at 5 (P.T.A.B. Apr. 10, 2015).

II. ARGUMENT

A. If the IQE IPR is Denied Institution, Joinder is Moot and this Petition Should Also be Denied.

Petitioner acknowledges that “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,” but goes on to request that the Board “consider Qorvo’s Petition on its own merits.” Paper No. 3 at 1. As will be explained in its upcoming Patent Owner Preliminary Response, the Board should deny institution of the IQE IPR. For that reason, Patent Owner also believes that the Board should deny

institution of Petitioner's present *inter partes* review. To the extent the IQE IPR resolves before an institution decision, Patent Owner will explain in its Patent Owner Preliminary Response why Patent Owner believes that the Board should deny institution of Petitioner's present *inter partes* review. Regardless, joinder would be moot if the IQE IPR is not instituted—there would be nothing to join Petitioner's present Petition to.

B. If the IQE IPR is Instituted, Petitioner Should be Joined as the Limited “Understudy.”

Petitioner acknowledges that its 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.” Paper No. 3 at 2. Petitioner further acknowledges that, if joinder occurs, it will take on the “understudy” role described in *Noven Pharms., Inc. v. Novartis AG*, IPR2014-00550, Paper No. 38 at 5 (P.T.A.B. Apr. 10, 2015). Paper No. 3 at 2, 6-7. To the extent the Board does institute the IQE IPR, Patent Owner believes joinder would be appropriate if Petitioner is given the “understudy” role laid out in *Noven Pharms., Inc. v. Novartis AG*, IPR2014-00550, Paper No. 38 at 5 (P.T.A.B. Apr. 10, 2015).

III. CONCLUSION

Patent Owner believes that the Board should deny institution of the IQE IPR. For that reason, Patent Owner also believes that the Board should deny institution of Petitioner's present *inter partes* review. However, to the extent the Board does institute the IQE IPR, Patent Owner believes joinder would be appropriate if Petitioner is given the "understudy" role laid out in *Noven Pharms., Inc. v. Novartis AG*, IPR2014-00550, Paper No. 38 at 5 (P.T.A.B. Apr. 10, 2015).

Dated: May 17, 2024

Respectfully submitted,

/s/ John B. Campbell

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that a copy of this **PATENT OWNER'S Response to Contingent Motion for Joinder** has been served on Petitioner via email on the following counsel of record for Petitioner:

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Dated: May 17, 2024

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