UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NXP USA, INC.,
Petitioner,

v.

PARKERVISION, INC.,
Patent Owner.

IPR2024-01066
Patent No. 7,865,177

CONDITIONAL MOTION FOR JOINDER TO *INTER PARTES* REVIEW IPR2024-00935

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

NXP USA, Inc. ("Petitioner" or "NXP") submits this Conditional Motion for Joinder ("Motion") concurrently with a Petition for *Inter Partes* Review ("Petition") of U.S. Patent No. 7,865,177 ("the '177 patent") (Ex. 1001) under 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b).

At present, one other IPR challenging the '177 patent has been filed: IPR2024-00935, *Texas Instruments Inc. v. ParkerVision, Inc.*, filed May 18, 2024 (the "TI IPR"). NXP's Petition was filed after the TI IPR, but the Board has yet to issue its Decision on institution of the TI IPR. Accordingly, this Motion for Joinder is ***conditional***—NXP respectfully requests that the Board hold NXP's Motion in abeyance until the Board has decided whether to institute the TI IPR or it has been terminated, whichever comes first.

NXP seeks party joinder to the TI IPR if the TI IPR has been instituted and is still pending when the Board reaches this Motion. As will be discussed below, NXP will remain in an "understudy" role as long as TI remains as a party in the proceeding.

If the TI IPR is not pending when the Board reaches NXP's Motion and Petition, this Motion is moot and NXP asks the Board to consider the Petition on its merits.

This Motion for Joinder and the currently filed Petition are being filed no later than one month after institution, pursuant to 37 C.F.R. 42.122(b). TI does not oppose NXP's joinder to the TI IPR. NXP's petition challenges the same claims on the same grounds, relies on the same prior art, and includes the exact same substantive arguments as the TI IPR, and therefore, would create no additional burden for the Board, Petitioner TI, or Patent Owner if joined. Joinder would therefore lead to an efficient resolution of the patentability of the '177 patent.

II. STATEMENT OF MATERIAL FACTS

1. The '177 patent is at issue in an infringement action against NXP in the Western District of Texas: *ParkerVision, Inc. v. NXP Semiconductors NV et al*, 6-23-cv-00389 (WDTX) filed May 19, 2023.

2. The '177 patent is at issue in other civil actions: *ParkerVision, Inc. v. Texas Instruments Incorporated,* 6:23-cv-00384 (WDTX) filed May 18, 2023, *ParkerVision, Inc. v. Realtek Semiconductor Corp.*, 6-23-cv-00374 (WDTX) filed May 16, 2023, *ParkerVision, Inc. v. MediaTek, Inc. et al.*, 6-23-cv-00375 (WDTX) filed May 16, 2023, *ParkerVision, Inc. v. Qualcomm Incorporated*, 22-1755 (CAFC) filed May 4, 2022, and *ParkerVision, Inc. v. Qualcomm Incorporated et al.*, 6-14-cv-00687 (MDFL) filed May 2, 2014.

3. The '177 patent is the subject of the following Board proceeding: *Texas Instruments Inc. v. ParkerVision, Inc.*, IPR2024-00935, filed May 18, 2024. The

Petition in IPR2024-00935 ("TI Petition") challenges the patentability of claim 14 of the '177 patent. The Board has not yet determined whether to institute trial on the TI Petition.

4. The Petition in this proceeding and the TI Petition are substantively identical: they contain the same grounds (based on the same prior art combinations and supporting evidence) against the same claims, using substantially the same evidence and arguments.

III. ARGUMENT

A. Legal Standard

"Section 315(c) authorizes the Director to 'join as a party to [an IPR] any person who' meets certain requirements, i.e., who properly files a petition the Director finds warrants the institution of an IPR under § 314." *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1334 (Fed. Cir. 2020). The Board thus has discretion under 35 U.S.C. § 315(c) to join a properly filed *inter partes* review petition that warrants institution to an instituted inter partes review proceeding. *See* 35 U.S.C. § 315(c). A motion for joinder must be filed 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). In deciding whether to exercise its discretion and permit joinder, the Board considers several factors, including: (1) the 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. *See Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (April 24, 2013); Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), 76-78.

B. The Petition and This Motion for Joinder are Timely

This Motion for Joinder is timely because it is filed no later than one month after the institution date of the TI IPR. 37 C.F.R. § 42.122(b); *see also Blue Coat Sys., Inc. v. Finjan, Inc.*, IPR2016-00480, Paper 9 at 7 (PTAB Jun. 24, 2016) ("The plain language of the rule does not forbid a request for joinder that is filed before the [first] inter partes review is instituted."). In addition, Petitioner has made this Motion conditional, with action requested only upon institution of the TI IPR. *See Central Security Grp. Nationwide Inc. v. Ubiquitous Connectivity, LP*, IPR2019-01609, Paper 11 at 9 (PTAB Feb. 26, 2020) ("The Motion for Joinder, which was filed *before* institution of the [first] IPR, complies with [Rule 42.122(b)]. Moreover, the Motion for Joinder was filed *conditionally*, with Petitioner expressly requesting 'action on this motion be held in abeyance until, and . . . only if, an IPR is instituted in the [first IPR].'") (emphasis in original).

Further, the one-year bar set forth in 35 U.S.C. § 315(b) and 37 C.F.R. § 42.101(b) does not apply to the concurrently-filed Petition because it is accompanied by this Motion for Joinder. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b).

C. All Considerations Weigh in Favor of Joinder

1. Texas Instruments Does Not Oppose Joinder

Petitioner has conferred with Texas Instruments, Inc. ("TI"), the petitioner in the TI IPR to which joinder is sought, and TI does not oppose Petitioner's joinder to the TI IPR.

2. The Petition Warrants Institution

For the reasons explained in the Petition, there is at least a reasonable likelihood that claim 14 of the '177 patent is unpatentable, and discretionary denial of institution is not appropriate. The Petition therefore "warrants the institution of an *inter partes* review." 35 U.S.C. § 315(c). In addition, to the extent that the Board has already decided to institute trial in IPR2024-00935, the present Petition warrants institution for the same reasons, as both petitions advance substantively identical grounds and arguments.

3. The Four Efficiency Standards Favor Joinder

The four efficiency factors that are routinely considered by the Board when considering requests for joinder are all present here.

First, there are several reasons why 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. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (PTAB Aug. 24, 2016) (internal quotations and citations omitted); *see also STMicroelectronics, Inc. v. Lone Star Silicon Innovations, LLC*, IPR2018-00436, Paper 7 at 5 (PTAB May 4, 2018) (granting joinder and reasoning, "[w]e rely in particular, on Petitioner's representation that its Petition is 'substantially identical'" and "challenges the same claims based on the same prior art and the same grounds of unpatentability.").

In addition, NXP seeks to join the TI IPR in order to ensure that an accused infringer with an active interest in the proceeding remains a party to this IPR if Petitioner TI's participation is terminated prior to completion. Thus, joining NXP to the TI IPR is the most practical way to secure the just, speedy, and inexpensive resolution of the challenge to the '177 Patent. See 37 C.F.R. § 42.1(b).

Finally, joinder of NXP to the TI IPR promotes efficiency, by determining the patentability challenges against claim 14 of the '177 patent in a single proceeding, rather than NXP prosecuting a second, independent proceeding potentially involving different grounds of unpatentability. Multiple proceedings against the same patent risk inconsistent decisions by the Board and inefficient use of Board resources. *See,*

e.g., Oracle America Inc. v. Realtime Data LLC, 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").

Second, the concurrently-filed Petition does not present any new grounds of unpatentability beyond those advanced in the TI IPR. NXP's Petition challenges the patentability of claim 14 of the '177 Patent on identical grounds to those in the TI IPR and relies on substantively identical supporting materials, including a declaration by the same expert witness retained by TI in the TI IPR. As such, granting joinder here would not involve the joinder of new issues to the TI IPR. *See Windy City Innovations*, 973 F.3d at 1333 (holding that § 315(c) "does not authorize the joinder of new issues.").

Third, joinder would have no impact on the trial schedule for the TI IPR. Because both petitions advance identical grounds based on identical arguments and evidence, Patent Owner will not be required to present any additional responses or arguments. *See LG v. Memory Integrity, LLC*, IPR2015-01353, Paper 11 at 6 (PTAB Oct. 5, 2015) (joinder appropriate where it would "not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the first IPR]."). And because this Petition and Motion are being filed prior to the Board instituting trial in the TI IPR, joinder can be granted promptly after institution of the

TI IPR, well before any filings are due in that case. Finally, because NXP agrees to adhere to all applicable deadlines set forth in any Scheduling Order issued by the Board in the TI IPR, joinder of NXP will not affect the schedule in any way.

Fourth, briefing and discovery will be simplified by granting joinder. To reduce the burden on the Board and the parties to the TI IPR, and to simplify briefing and discovery, Petitioner has agreed that as long as TI remains a party to the TI IPR, NXP will take an "understudy" role. In this role, NXP agrees to the following conditions:

(a) NXP shall not make any substantive filing and shall be bound by the filings of TI, unless a filing concerns termination and settlement, or issues solely involving NXP;

(b) NXP shall not present any argument or make any presentation at oral argument unless an issue solely involves NXP, or when addressing Board-approved motions that do not affect TI or its respective position;

(c) NXP shall be bound by any past or future agreement between Patent Owner and TI concerning discovery and/or depositions;

(d) NXP shall not receive any direct, cross examination, or redirect time beyond that permitted for TI alone under either 37 C.F.R. § 42.53 or any agreement between Patent Owner and TI;

(e) NXP shall not seek discovery from Patent Owner separate from TI, except on issues solely involving NXP;

Similar conditions have been approved or ordered by the Board in past decisions granting joinder of "understudy" petitioners. *See ecobee Techs. ULC v. Ollnova Techs. Ltd.,* IPR2024-00131, Paper 11 at 19–20 (PTAB May 21, 2024); *Apple Inc. v. DoDots Licensing Solns LLC*, IPR2024-00143, Paper 9 at 10 (PTAB May 6, 2024).

Accordingly, because Petitioner will take an "understudy" role, Patent Owner will not suffer any prejudice from the grant of Petitioner's joinder motion. Patent Owner will only need to respond to one principal set of papers and will not require additional time to address additional arguments beyond those already raised by TI. These conditions will minimize or eliminate any potential complications or delay that could potentially result from joinder, and the Board can thus proceed with the existing trial schedule. *See Sony Corp. v. Memory Integrity, LLC.*, IPR2015-01353, Paper No. 11 at 6-7 (PTAB Oct. 5, 2015) (granting understudy joinder petition where conditions "would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board.").

IV. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that its Petition for *Inter Partes* Review of the ’177 patent be instituted, its Motion for Joinder be granted, and that Petitioner be joined as a party to IPR2024-00935.

Respectfully submitted,

Dated: June 20, 2024

/s/ Michael Chibib

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) *et seq.* and 42.105(b), the undersigned certifies that on June 20, 2024, a complete and entire copy of this Motion for Joinder was provided by Federal Express, to the Patent Owner, by serving the correspondence address of record as follows:

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The undersigned further certifies that courtesy copies of the foregoing documents were served via electronic mail upon Patent Owner's counsel of record in IPR2023-00935 as follows:

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