

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED,
Petitioner

v.

NETWORK SYSTEM TECHNOLOGIES, LLC,
Patent Owner

Case: IPR2024-_____
U.S. Patent No. 7,373,449

**MOTION FOR JOINDER TO
INTER PARTES REVIEW IPR2024-00338**

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35 U.S.C. § 315(c)	1, 6
37 C.F.R. § 42.122(b)	5, 6
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I. STATEMENT OF PRECISE RELIEF REQUESTED

Petitioner Qualcomm Incorporated (“Qualcomm”) hereby moves for joinder of Qualcomm’s contemporaneously-filed Petition for *Inter Partes* Review (“IPR”) of claims 2, 6 and 9-16 of U.S. Patent No. 7,373,449 (the “’449 Patent”) with IPR2024-00338 (*Samsung Electronics Co., Ltd. v. Network System Technologies, LLC*, “Samsung IPR”). Qualcomm moves for joinder with the Samsung IPR pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b).

The Samsung IPR was filed on December 18, 2023. The Petition and supporting evidence filed contemporaneously with this Motion for Joinder is substantively identical to the petition and supporting evidence filed in the Samsung IPR. Qualcomm challenges the same claims, on the same grounds, based on the same arguments and evidence, including the same expert testimony. If joined, Qualcomm also agrees to take an “understudy” role and to adhere to the same schedule set out in the Samsung IPR, unless and until Samsung is no longer a party to the Samsung IPR. Therefore, it would create no additional burden for the Board, Samsung, or Patent Owner Network System Technologies (“PO”) if joined. Joinder would lead to efficient resolution of the validity of challenged claims of the ’449 patent.

Qualcomm has conferred with the Samsung (the Samsung IPR petitioner) and Samsung opposes joinder but has not provided a reason. For so long as

Samsung remains in the proceeding, Qualcomm has agreed that Samsung will maintain the lead role.

PO will not be prejudiced by joinder. Given Qualcomm's agreement to take an "understudy" role so long as Samsung remains in the proceeding, joinder will not add any new substantive issues, will not delay the schedule, will not burden deponents, and will not needlessly increase filings. Any additional costs on PO will be minimal. Denial of joinder would, however, prejudice Qualcomm. Qualcomm's interests may not be adequately protected in the Samsung IPR, particularly if Samsung ceases to participate in the Samsung IPR prior to its resolution.¹

Qualcomm should also be allowed to join an IPR concerning a patent that is currently asserted against it. Qualcomm is currently named as a defendant in *Network System Technologies, LLC v. Qualcomm Inc. et al.*, No. 1:22-cv-01331

¹ Petitioner Qualcomm is aware that the parties in the Samsung district court case filed a motion on May 24, 2024 to stay all deadlines for 30 days because that case has been "settled in principle." *Network System Technologies, LLC v. Samsung Electronics Co., Ltd. et al.*, Case No. 2-22-cv-00481, Dkt. 152 at 1 (E.D. Tex. May 24, 2024). However, Qualcomm does not know what, if any, effect the district court "settle[ment] in principle" may have on the Samsung IPR.

(W.D. Tex). Qualcomm has been accused of infringing claims 10-16 of the '449 patent. Qualcomm has not previously filed a petition for IPR challenging the validity of the '449 patent.

Given the near identical nature of the proceedings, the lack of undue prejudice to PO, and the potential benefit to the public and Board in the event Samsung's participation in the Samsung IPR ceases, Qualcomm respectfully requests that the Board institute Qualcomm's IPR and grant Qualcomm's Motion for Joinder.

II. FACTUAL BACKGROUND

1. The District Court Lawsuits

NST purportedly owns the '449 Patent and has asserted it against various defendants, including joinder Petitioner Qualcomm. The following lawsuits involving the '449 patent are pending:

- *Network System Technologies, LLC v. Qualcomm Inc. et al.*, Case No. 1-22-cv-01331 (W.D. Tex.)
- *Network System Technologies, LLC v. Texas Instruments Inc. et al.*, Case No. 2-22-cv-00482 (E.D. Tex.)
- *Network System Technologies, LLC v. Samsung Electronics Co., Ltd. et al.*, Case No. 2-22-cv-00481 (E.D. Tex.)

- *Network System Technologies, LLC v. Lenovo Group Limited*, Case No. 2-23-cv-00167 (E.D. Tex.)
- *Network System Technologies, LLC v. OnePlus Technologies (Shenzhen) Co., Ltd.*, Case No. 2-23-cv-00520 (E.D. Tex.)

2. The Samsung IPR

Samsung filed the Samsung IPR (IPR2024-00338) on December 18, 2023, challenging claims 1-6 and 9-16 of the '449 Patent. PO then statutorily disclaimed claims 1, 3, 4, and 5 on March 25, 2024. Ex-2062, 3. The Board instituted the Samsung IPR as to the remaining challenged claims (claims 2, 6, and 9-16) on June 21, 2024.

3. Petitioner Qualcomm's Motion for Joinder

With this Motion, Qualcomm seeks to join the Samsung IPR. Qualcomm has simultaneously filed a Petition for *inter partes* review that demonstrates the same claims of the '449 Patent are obvious over the same grounds, and based on the same evidence, as set out in the Samsung IPR. The Petition is also supported by the expert declaration of Dr. Todd Mowry. The declaration submitted by Dr. Mowry is the same one Dr. Mowry submitted in support of the Samsung IPR.

In view of PO's decision to disclaim four of the challenged claims, the Final Written Decision will only need to address the remaining non-disclaimed

challenged claims (claims 2, 6, and 9-16) in the Samsung IPR. And given that PO has disclaimed claims 1, 3, 4, and 5, there is no need to challenge them in the joinder Petition. However, many of the elements in the disclaimed claims are the same as elements in non-disclaimed claims, and therefore the petition in the Samsung IPR did not repeat the same analysis for the same element when that element appeared in a different (later) claim. To facilitate the Board's review and to ensure this Petition can be efficiently joined with the Samsung IPR, Qualcomm files both a Petition and supporting evidence that is substantively the same as the petition and supporting evidence that was filed in the Samsung IPR prior to PO's disclaimer. That is, while the petition in the Samsung IPR and the matching Petition in the instant IPR both address now-disclaimed claims (in addition to the remaining non-disclaimed claims), the Board need only decide the challenges to the non-disclaimed claims.

III. ARGUMENT

A. Legal Standards and Rules

A petitioner may request joinder without prior authorization up to one month after the institution date of the proceeding to which joinder is requested. 37 C.F.R. § 42.122(b); *Taiwan Semiconductor Mfg. Co., Ltd. v. Zond LLC*, IPR2014-00781 and IPR2014-00782, Paper 5 at 3 (PTAB May 29, 2014).

The Board has discretion to grant a motion for joinder. *See* 35 U.S.C. § 315(c). In determining whether to exercise its discretion to grant a motion for joinder, the Board considers: (1) reasons why joinder is appropriate; (2) any new grounds of unpatentability asserted in the petition; (3) what impact (if any) joinder would have on the trial schedule for the existing review; and (4) specifically how briefing and discovery may be simplified. *See Dell, Inc. v. Network-I Security Solutions, Inc.*, IPR201300385, Paper 17 at 3 (July 29, 2013).

B. Joinder is Timely

The Motion for Joinder is timely because it is filed within one month after the institution date of the Samsung IPR. *See* 37 C.F.R. § 42.122(b).

C. The Four Factors Favor Joinder

The four factors weigh in favor of granting Qualcomm's Motion for Joinder. Qualcomm's Petition is substantively the same as the petition in the Samsung IPR, as it challenges the same claims using the same evidence and presents no new grounds of unpatentability. Therefore, joinder will not impact the schedule of the pending Samsung IPR and will further promote efficiency by resolving both challenges in a single proceeding.

**D. Joinder Is Appropriate Because It Will Promote Efficient
Determination of the Validity of the Remaining Challenged
Claims of the '449 Patent Without Prejudice to Any Party**

Qualcomm requests joinder with the Samsung IPR so as to ensure a party accused of infringing the '449 patent remains a party to this IPR if Samsung's participation in the instituted Samsung IPR ends prior to that IPR reaching completion. Joining Qualcomm to the existing Samsung IPR would ensure a just, speedy, and efficient resolution of the meritorious challenge to the validity of claims that PO is asserting against various defendants.

Joinder is also appropriate here because the Petition challenges the same claims, asserts the same grounds, and relies on the same evidence for unpatentability presented in the Samsung IPR. Moreover, the same expert, Dr. Todd Mowry, has submitted the same supporting declaration in both IPRs. Thus, the arguments and evidence in both petitions are the same. Accordingly, the Petition will not add new issues to the Samsung IPR. Because both proceedings concern the same issues, joinder is the most efficient and economical manner to proceed. *See, e.g., Dell Inc. v. Alacritech, Inc.*, IPR2018-01307, Paper No. 8 (PTAB Jan. 11, 2019) (granting motion for joinder where the petition challenged the same claims on the same grounds); *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”). 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 12 at 9 (PTAB Aug. 24, 2016).

Joinder is also appropriate because this is Qualcomm’s first challenge of the ’449 Patent. Accordingly, in the instant case there is no “potential for abuse of the review process by repeated attacks on patents.” *Apple Inc. v. Uniloc 2017, LLC*, IPR2020-00854, Paper 9 at 5 (PTAB Oct. 28, 2020) (precedential) (quoting *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16–17 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i)). Instead, allowing joinder would enable an efficient and appropriate use of the review process.

Finally, joining Qualcomm will promote the public interest in ensuring the full adjudication of the meritorious challenge to claims of the ’449 patent raised by the Samsung IPR, while not causing any undue prejudice to PO. PO currently must respond to one IPR concerning the ’449 patent, and by joining Qualcomm to the existing Samsung IPR PO would continue to respond to only one IPR.

E. The Petition Does Not Raise Any New Grounds of Patentability and Therefore Does Not Add Any Complexity to the Samsung IPR

As explained above, the Petition challenges the same claims, asserts the same grounds, and relies on the same evidence for unpatentability presented in the Samsung IPR. Qualcomm also uses the same expert as the petitioner in the Samsung IPR—Dr. Todd Mowry. In addition, the Petition and supporting evidence maintains unity of exhibits and exhibit numbering with the Samsung IPR. Accordingly, no new grounds are being introduced.

F. Joinder Will Not Impact Any Trial Schedule

Qualcomm's concurrently-filed IPR relies on the same arguments and evidence as the petitioner Samsung in the Samsung IPR, and Qualcomm agrees to take an "understudy" role in the joined proceeding, so long as Samsung remains an active party in the joint proceedings. Qualcomm also consents to the current schedule in the Samsung IPR and will not request any alterations to that schedule, so long as Qualcomm remains in the understudy role in the Samsung IPR. Accordingly, joinder will not impact the IPR schedule or otherwise prejudice the PO.

G. Joinder Will Simplify Briefing and Discovery Because Qualcomm Has Agreed to an Understudy Role So Long as Samsung Remains in the Samsung IPR

To further prevent any burden on the Board or the existing parties to the Samsung IPR, Qualcomm agrees to take an understudy role, so long as Samsung remains an active party in the joined proceeding. In this role, Qualcomm agrees to the following, so long as Samsung remains an active party to the Samsung IPR:

- (a) Petitioner Qualcomm will not make any substantive filing and will be bound by the filings of the Samsung IPR petitioner, unless the filing concerns termination and settlement or issues solely involving Petitioner Qualcomm;
- (b) Petitioner Qualcomm will not present any argument or make any presentation at oral hearing unless the issue solely involves Petitioner Qualcomm, or calls for the separate position of each of Petitioner Qualcomm and the Samsung IPR petitioner, or concerns a motion that does not affect the Samsung IPR petitioner;
- (c) Petitioner Qualcomm will not seek to cross-examine or defend any witness, unless the subject of the testimony concerns issues solely involving Petitioner Qualcomm;

(d) Petitioner Qualcomm will not seek discovery from PO on issues that do not solely involve Petitioner Qualcomm.

Qualcomm would take over the primary role, including the primary role for filings, discovery, and hearings, should Samsung cease to participate in the IPR.

Qualcomm's agreement removes any potential "complication or delay" caused by joinder, while providing the parties an opportunity to address all issues that may arise and avoiding any undue burden on PO, Samsung, and the Board. *See, e.g., Motorola Mobility LLC v. SoftView LLC*, IPR2013-00256, Paper 10 at 8–10 (PTAB June 20, 2013); *see also, e.g., Apple Inc. v. INVT SPE LLC*, IPR2019-00958, Paper 9 at 5–8 (PTAB May 30, 2019) (granting IPR where petitioners requested an "understudy" role). Therefore, briefing and discovery would be significantly simplified if joinder was granted.

IV. CONCLUSION

For the foregoing reasons, Qualcomm respectfully requests that the Board institute its Petition for *Inter Partes* Review of U.S. Patent No. 7,373,449 and join this proceeding to the Samsung IPR (*Samsung Electronics Co., Ltd., v. Network System Technologies, LLC*, IPR2024-00338).

Respectfully submitted,

Dated: June 21, 2024

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CERTIFICATE OF SERVICE

I certify that on June 21, 2024, I caused a true and correct copy of the foregoing Motion for Joinder to *Inter Partes* Review IPR2024-00338 to be served via overnight delivery on the Patent Owner at the following correspondence address of record as listed on PAIR:

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