

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED,
Petitioner

v.

NETWORK SYSTEM TECHNOLOGIES, LLC
Patent Owner

Patent No. 7,373,449

Inter Partes Review No. IPR2024-01081

RESPONSE TO PETITIONER'S MOTION FOR JOINDER

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Patent Owner Network System Technologies, LLC (“NST” or “Patent Owner”) submits this Response to the Motion filed by Qualcomm Incorporated (“Qualcomm” or “Petitioner”) to join *Samsung Electronics. Co., Ltd. v. Network Sys. Techs., LLC*, IPR2024-00338 (hereinafter, the “Samsung IPR”).

I. INTRODUCTION

The Board should deny Qualcomm's Motion (Paper 3) to join the Samsung IPR. Qualcomm glosses over the fact that it cannot seek review of the '449 Patent on its own because its petition is time-barred. Nor does Qualcomm acknowledge that it joined Samsung as a co-petitioner in two other IPRs challenging patents asserted against Qualcomm and Samsung in related district court litigation. For reasons Qualcomm does not explain, Qualcomm chose not to join Samsung as a co-petitioner in the Samsung IPR. The most reasonable inference is that Qualcomm did not desire review of the '449 Patent.

Qualcomm apparently changed its mind when it caught wind of a settlement between NST and Samsung through a public filing in the district court and rushed to file a carbon copy of the Samsung's petition and evidence. NST and Samsung jointly moved to terminate the Samsung IPR once the district court litigation had been dismissed. *See Samsung Elecs. Co., Ltd. v. Network Sys. Techs., Inc.*, IPR2024-00338, Paper 14 (PTAB July 8, 2024). Qualcomm's suggestion that it will take on a “silent understudy” role if joined is disingenuous because it knows that the Samsung

IPR will be terminated unless the Board allows it take over for Samsung. The Board should not allow Qualcomm to circumvent the time-bar and avoid its deliberate decision not to challenge the '449 Patent when it had the chance.

II. FACTUAL BACKGROUND

On December 23, 2022, Qualcomm was served with a complaint alleging infringement of the '449 Patent and other patents, including U.S. Patent Nos. 7,594,052 (the "'052 Patent") and 8,072,893 (the "'893 Patent"). EX2063. NST also asserted these three patents against Samsung. *Network Sys. Techs., LLC v. Samsung Elecs. Co., Ltd. et al.*, No. 2:22-cv-00481-JRG, Dkt 1 (E.D. Tex.).

On December 18, 2023, Samsung, as sole petitioner, filed an IPR petition challenging the '449 Patent. Samsung IPR, Paper 1. On December 20, 2023, Qualcomm and Samsung, together as co-petitioners, filed IPR petitions challenging the '052 and '893 Patents. *Qualcomm Inc. et al. v. Network Sys. Techs., LLC*, IPR2024-00343; *Qualcomm Inc. et al. v. Network Sys. Techs., LLC*, IPR2024-00355.

As reflected on the public docket, on May 24, 2024, NST and Samsung jointly moved to stay all deadlines in the district court in light of a settlement. *Network Sys. Techs., LLC v. Samsung Elecs. Co., Ltd. et al.*, No. 2:22-cv-00481-JRG, Dkt. 152 (E.D. Tex.). Following completion of the parties' settlement obligations, the Court dismissed the district litigation on July 1, 2024. *Id.*, Dkt. 158. On July 8, 2024, the Board authorized NST and Samsung to jointly file a motion to terminate the

Samsung IPR. EX2064. On that same day, the parties jointly moved to terminate. *See* Samsung IPR, Paper 14. After learning of the settlement between NST and Samsung, Qualcomm filed its own petition challenging the '449 Patent and the instant Motion on June 21, 2024. Paper 1; Paper 2 at p. 2, n. 1; Paper 3.

III. LEGAL STANDARD

“[T]he Director, in his or her discretion, may join as a party to” an instituted IPR “any person who properly files a petition under section 311 that the Director . . . determines warrants the institution of an inter partes review under section 314.” 35 U.S.C. § 315(c). The “decision to grant joinder is discretionary.” *Code200, UAB v. Bright Data Ltd.*, IPR2021-01502, Paper 13 at 8 (PTAB Mar. 14, 2022). Joinder requires “two different decisions,” first “whether the joinder applicant’s petition for IPR ‘warrants’ institution under § 314,” and then whether “to exercise . . . discretion to decide whether to ‘join as a party’ the joinder applicant.” *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020).

Qualcomm bears the burden to show that joinder is appropriate. *See* 37 C.F.R. §§ 42.20(c), 42.112(b). “A motion for joinder should: (1) set forth the reasons 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) addresses specifically how briefing and/or discovery

may be simplified.” *Kingston Tech. Co. v. SecureWave Storage Solutions, Inc.*, IPR2020-00139, Paper 12 at 12 (PTAB Mar. 23, 2020).

When the party requesting joinder is otherwise time-barred, the Board has held that joinder is appropriate only in “limited circumstances where fairness requires it and to avoid undue prejudice to a party.” *Proppant Express Investments, LLC v. Oren Techs., LLC*, IPR2018-00914, Paper 38 at 16 (PTAB Mar. 13, 2019) (precedential), *overruled on other grounds, Facebook*, 973 F.3d at 1333. Facts “which may justify this narrow exercise of discretion” include “actions taken by a patent owner in a co-pending litigation such as the late addition of new asserted claims.” *Id.* “[T]he Board does not generally expect fairness and prejudice concerns to be implicated, for example, where a petitioner merely corrects its mistakes or omissions.” *Id.*

“Under *General Plastic*, the Board may deny a petition based on the Director’s discretionary authority of § 314(a).” *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 at 5 (PTAB Oct. 28, 2020) (precedential); *see also General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16 (PTAB Sept. 6, 2017) (precedential). In “determining whether to join [a petitioner] as a party to [an IPR],” the Board must “first determine whether application of the *General Plastic* factors warrants the exercise of discretion to deny the Petition under § 314(a).” *Apple*, IPR2020-00854, Paper 9 at 5.

IV. THE BOARD SHOULD DENY QUALCOMM'S JOINDER MOTION

A. Qualcomm Does Not Show That Joinder is Appropriate

Qualcomm argues that joinder is appropriate because (1) it timely filed its motion and (2) “allowing joinder would enable an efficient and appropriate use of the review process.” Paper 3 at 7-8. Neither reason is sufficient to show that joinder is appropriate here. Qualcomm conspicuously failed to disclose that its petition is time-barred under 35 U.S.C. § 315(b). *Network Sys. Techs., LLC v. Qualcomm Inc. et al.*, 1:22-cv-1331-DAE, Dkt. 1 (W.D. Tex. Dec. 22, 2022). Qualcomm also failed to address the Board's *Proppant* decision, which provides that “the Board will exercise this discretion [to allow joinder] only in limited circumstances *where fairness requires it and to avoid undue prejudice to a party.*” *Proppant*, IPR2018-00914, Paper 38 at 16.¹ The Board explained that “[t]he one-year time limitation of § 315(b) is important to ensure ‘quiet title to patent owners’ and to prevent inter partes review from being ‘used as a tool for harassment’” and recognized that broadly allowing joinder “could effectively circumvent the time limitation in § 315(b) in many cases.” *Id.* at 18 (citations omitted); *see also* Consolidated Trial Practice Guide (“CTPG”) at 77 (“The conduct of the parties and attempts to game the system may also be considered”).

¹ All emphasis in case and evidence cites is added.

1. Fairness Does Not Require Joinder

Fairness does not require joinder, and Qualcomm does not claim otherwise. Qualcomm fails to identify a circumstance that could justify joinder, nor does it claim that NST has taken a position in district court, such as asserting new claims, that would prejudice Qualcomm if joinder was denied. Indeed, this is a case in which joinder would be unfair. Qualcomm's only way to challenge the '449 Patent in an IPR is via Samsung's Petition; however, NST and Samsung have jointly moved to terminate the Samsung IPR. The Samsung IPR is still in its early stages, thus, NST expects that the Board will grant that motion. CTPG at 86 ("The Board expects that a proceeding will terminate after the filing of a settlement agreement") (citing 35 U.S.C. §§ 317(a), 327).

Qualcomm cannot assume an "understudy" role because Samsung will be terminated from the Samsung IPR. Paper 3 at 1, 2, 9, 10. The Board has rejected a similar "understudy" argument because the joining party would be allowed to run afoul of the one-year bar and "stand in to continue a proceeding that would otherwise be terminated." *Apple*, IPR2020-00854, Paper 9 at 13; *see also T-Mobile USA, Inc. v. Voip-Pal.com, Inc.*, IPR2023-00638, Paper 11 (PTAB July 28, 2023) (denying joinder because original parties settled and party seeking joinder "would stand in to continue proceedings that would otherwise have been terminated").

Qualcomm had an opportunity to file a petition challenging the '449 Patent within the statutory timeframe, but chose not to. In fact, Qualcomm, as a co-petitioner with Samsung, filed petitions challenging the '052 and '893 Patents, which like the '449 Patent, were asserted against Qualcomm and Samsung in district court. Qualcomm presumably knew that Samsung was preparing a petition to challenge the '449 Patent, yet Qualcomm chose not to join that petition until it learned that NST and Samsung had reached a settlement. But despite its own decisions, joinder would provide Qualcomm with a chance for an undeserved do-over. This is not the fair outcome. *See Proppant*, IPR2018-00914, Paper 38 at 20 (“Because Petitioner’s own conduct created the need for it to request joinder, this case does not involve one of the limited circumstances in which the Board will exercise its discretion to allow ... joinder. ... [A]llowing joinder in cases such as this could effectively vitiate the time limitation of § 315(b)"); *see also Micro Motion, Inc. v. Invensys Sys.*, IPR2014-01409, Paper 14 at 15 (PTAB Feb. 18, 2015) (when movant’s petition “is admittedly time-barred under 35 U.S.C. § 315(b),” it “weighs against joinder”).

2. Denying Joinder Will Not Unduly Prejudice Qualcomm

Qualcomm claims that its “interests may not be adequately protected in the Samsung IPR” if it is not allowed to take over the Samsung IPR. Paper 3 at 2. That is a problem of Qualcomm’s own making. Qualcomm was apparently content not to

file its own petition challenging the '449 patent until after institution and the settlement. Qualcomm could have protected its interests by joining Samsung as a co-petitioner as it did for other NST patents. *Qualcomm Inc. et al. v. Network Sys. Techs., LLC*, IPR2024-00343, Paper 1 (PTAB Dec. 20, 2023); *Qualcomm Inc. et al. v. Network Sys. Techs., LLC*, IPR2024-00355, Paper 1 Paper 1 (PTAB Dec. 20, 2023). Alternatively, Qualcomm could have filed the “copycat” petition and joinder motion before Samsung and NST filed the notice of settlement. Indeed, Qualcomm's decision to join Samsung as a co-petitioner in the '052 and '893 IPRs, but not the Samsung IPR for the '449 Patent, undermines Qualcomm's claim of prejudice. Moreover, denying joinder will not affect Qualcomm's ability to pursue an invalidity defense in the district court litigation.

3. Granting Joinder Will Unduly Prejudice NST

Granting joinder will unduly prejudice NST by forcing it to proceed through an IPR of the '449 Patent after it settled with the only party that filed a timely petition. The Board recognizes that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” CTPG at 86. In most cases, parties enter into settlements to avoid the cost and uncertainty of litigation. Allowing Qualcomm—who is otherwise time-barred from seeking review of the '449—to join the Samsung IPR after the NST-Samsung settlement undermines NST's bargained for exchange by subjecting it to the same cost and uncertainty the settlement sought

to avoid. Given that Qualcomm cannot explain its failure to timely file its own petition, the Board should not allow joinder.

Qualcomm's attempt to join the Samsung IPR also prejudices Samsung. The Board has indicated that it will not act on NST and Samsung's motion to terminate the Samsung IPR until deciding Qualcomm's joinder motion. EX2067.² NST's response in the Samsung IPR is currently due on Sept. 12, 2024. Qualcomm's reply in support of its motion for joinder is not due until Aug. 12, 2024. Under this timeframe, NST will need to schedule depositions of Samsung's declarants, work with its own expert(s), and prepare its response for the Samsung IPR before the Board can resolve the pending motions. In other words, NST and Samsung will be forced to incur significant costs litigating the Samsung IPR against their will. This is manifestly unfair to NST and Samsung and contrary to the Board's stated policy of encouraging settlement. CTPG at 86.

² The fact that Qualcomm filed its motion for joinder before the motion to terminate "is not determinative." *ZTE (USA) LLC v. Seven Networks, LLC*, IPR2019-00460, Paper 18 at 5-9 (PTAB June 6, 2019); *see also LG Elecs. Inc. v. Jawbone Innovations, LLC*, IPR2023-01248, Paper 9 at 2 (PTAB Jan. 19, 2024) (denying motion to join IPR that was terminated pursuant to settlement).

Qualcomm's argument that joinder will not prejudice NST is expressly conditioned on "Samsung remain[ing] in the proceeding." Paper 3 at 2. But Qualcomm knows that Samsung will not remain in the proceeding and does not allege that NST would not be prejudiced in that case. *Id.* at 2, n. 1. Qualcomm's suggestion that "[a]ny additional costs on PO will be minimal" is disingenuous because absent joinder, the Samsung IPR would be terminated. Likewise, Qualcomm's argument that "joinder is the most efficient and economical manner to proceed" could not be further from the truth – it is the least efficient and economical way to proceed. Paper 3 at 7.

B. Joinder Will Impact the Schedule And Will Not Simplify The Briefing

Joinder will impact the schedule. Qualcomm represents that it "consents to the current schedule in the Samsung IPR . . . *so long as Qualcomm remains in the understudy role* in the Samsung IPR." Paper 3 at 9. However, Qualcomm knows that it will not remain in an "understudy role." Qualcomm does not argue that the schedule will not be impacted if it joins the Samsung IPR and becomes the sole petitioner. *Id.*

Qualcomm has represented to the district court that the schedule will be adjusted if the Board allows joinder. Specifically, Qualcomm represented that "the PTAB will likely adjust the IPR schedule" resulting in "the final written decision [being] pushed back a few months." EX2065, 3, n.4. This weighs against joinder.

Mylan Pharms. Inc. v. Janssen Oncology, Inc., IPR2016-01332, Paper 21 at 11 (PTAB Jan. 10, 2017) (denying joinder because it “would require adjusting the schedule” and “delay[] the due dates in the [original] IPR”).

Similarly, joinder would not simplify briefing. For example, Qualcomm argues that it will not participate in the proceeding “*so long as Samsung remains an active party to the Samsung IPR*” and “unless the filing concerns . . . issues solely involving Petitioner Qualcomm.” Paper 3 at 10. This argument is disingenuous because Qualcomm knows that it will be the sole Petitioner in the Samsung IPR. Briefing in the Samsung IPR will be eliminated (and therefore simplified) if the Board denies Qualcomm’s motion and grants the motion to terminate. *ZTE*, IPR2019-00460, Paper 18 at 8 (denying joinder because petitioner “fails to explain sufficiently how briefing . . . would have been simplified by joinder” where joinder petitioner “could not have assumed an ‘understudy’ role” because original Petitioner was “no longer participating in the case.”).

V. QUALCOMM’S PETITION DOES NOT ‘WARRANT’ INSTITUTION UNDER § 314

General Plastic identified seven non-exclusive factors for the Board to consider as to whether it should invoke its discretion to deny institution under § 314(a). These factors include:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;

2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;

3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;

4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;

5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;

6. the finite resources of the Board; and

7. the requirement to issue a final written determination not later than 1 year after the date on which the Director notices institution of review.

General Plastics, IPR2016-01357, Paper 19 at 9-10 (citations omitted).

Under factor 1, while this is Qualcomm's first petition challenging the '449 patent, it had a "significant relationship" to Samsung, which did file a petition. *See Valve Corp. v. Electronic Scripting Products, Inc.*, IPR2019-00062, Paper 11 at 10 (PTAB Apr. 2, 2019) (precedential) (finding that "significant relationship" existed where successive petitioners were "co-defendants in the District Court litigation and were accused of infringing" the challenged patent). Qualcomm and Samsung were

both defendants in related district court litigation and co-petitioners on the asserted '052 and '893 Patent IPRs, and thus, have a "significant relationship." Accordingly, factor 1 weighs against institution and joinder.

Factor 2 weighs against institution and joinder because Qualcomm was aware of the art asserted in the Samsung IPR as of at least September 22, 2023. EX2066.

Factor 3 weighs against institution and joinder because Qualcomm had the benefit of NST's preliminary response and the Board's institution decision in the Samsung IPR before filing its own Petition.

Under factors 4 and 5, the latest Qualcomm could have learned of the asserted art is September 22, 2023. EX2066. Qualcomm provides no explanation for why it failed to join Samsung as a co-petitioner in the Samsung IPR, like it did for the '052 and '893 Patent IPRs, or why it failed to file its own petition prior to being time-barred. Accordingly, factors 4 and 5 weigh against institution and joinder.

Under factor 6, joinder would needlessly expend the finite resources of the Board. The Samsung IPR will be terminated unless Qualcomm is allowed to join. The finite resources of the Board should not be used for a time-barred petitioner that deliberately chose not to file a petition challenging the '449 patent. Qualcomm attempts to justify its expenditure of the Board's resources by arguing that NST "currently must respond to one IPR concerning the '449 patent, and by joining Qualcomm to the existing Samsung IPR [NST] would continue to respond to only

one IPR.” Paper 3 at 8. But Qualcomm’s argument is based on a false premise because NST and Samsung have settled. Accordingly, factor 6 weighs against institution and joinder.

Factor 7 appears neutral in relation to denying institution and joinder.

Considering the *General Plastic* factors, institution and joinder in this case should be denied.

VI. THE STATUTE DOES NOT PERMIT JOINDER OF AN OTHERWISE TIME-BARRED PARTY

While the Board has, in some cases, allowed an otherwise time-barred party like Qualcomm to join an existing IPR, the Federal Circuit has not squarely addressed this issue.³ Whether §§ 315(b) and (c) allow joinder in these circumstances is at issue in *VLSI Tech. LLC v. Patent Quality Assurance LLC*, Nos. 23-2298, 23-2354, which is currently pending before the Federal Circuit. NST respectfully submits that §§ 315(b) and (c) bar joinder in the present case.

A party may join an instituted IPR only if that party “*properly files* a petition under section 311.” 35 U.S.C. § 315(c). Section 311(c) provides that a petition must be filed “[s]ubject to the provisions of this chapter.” *Id.*, § 311(c). In turn, Section

³ The Director has confirmed that “the Federal Circuit has not yet squarely determined the proper application of Section 315(b) and (c) to these circumstances” and that prior cases addressed the issue only in dicta. EX2068, 20.

315(b) requires that the petition be filed within “1 year after the date on which the petitioner . . . is served with a complaint alleging infringement of the patent.” *Id.*, § 315(b). A petition that is not filed within the 1-year deadline is not “properly file[d]” and cannot serve as basis for a joinder request. *See, e.g., Pace v. DiGuglielmo*, 544 U.S. 408, 417 (2005) (holding that the phrase “properly filed” encompasses “time limits”). This reading is also consistent with the legislative history. *See Joe Matal, A Guide to the Legislative History of the AIA: Part II of II*, 21 Fed. Cir. B.J. 539, 613–14 (2012) (indicating that a “properly filed” petition must be timely).

While § 315(b) provides that the “time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c),” that exception only applies to the joinder request itself. 35 U.S.C. § 315(b). In other words, § 315(b) allows a party to file a request for joinder after the 1-year deadline for filing an IPR but does not exempt the underlying petition from the 1-year deadline. This limited exception allows for joinder in situations where, for example, a first properly filed petition is instituted after a second substantively identical and properly filed petition is filed, promoting efficiency by combining identical petitions into one proceeding.

VII. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Board deny Petitioner's Motion for Joinder.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **Patent Owner's Response to Petitioner's Motion for Joinder** and exhibits thereto were served on July 22, 2024, by email:

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