UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

REALTEK SEMICONDUCTOR CORP.,
Petitioner,

v.

PARKERVISION, INC.,
Patent Owner.

Case No. IPR2025-00325

Patent No. 9,118,528

MOTION FOR JOINDER TO *INTER PARTES* REVIEW IPR2024-00936

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I. INTRODUCTION

Realtek Semiconductor Corp. (collectively, "Realtek" or Petitioner") respectfully submits this Motion for Joinder, concurrently with a Petition ("Realtek's Petition") for *inter partes* review of U.S. Patent No. 9,118,528 (the "Challenged Patent").

Pursuant to 35 U.S.C. ¶ 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b), Realtek requests institution of *inter partes* review and joinder with IPR2024-00935 ("TI IPR"), which was instituted on November 26, 2024. *Texas Instruments, Inc. v. Parkervision, Inc.*, IPR2024-00936, Paper 9 (P.T.A.B. Nov. 26, 2024). The instant Petition is substantially identical to the TI IPR; it involves the same claims of the same patent, the same grounds of unpatentability, and the same supporting evidence. This Motion for Joinder and Realtek's Petition are timely because they are being filed less than one month after the November 26, 2024 decision instituting trial in the TI IPR. *See* 37 C.F.R. § 42.122(b).

Realtek's Petition and Motion for Joinder are being filed to ensure that a Petitioner remains to complete the trial if Texas Instruments, Inc. ("TI") reaches a settlement with the Patent Owner or is otherwise terminated from the proceeding. Upon joining the TI IPR proceeding, Realtek will act as an "understudy" and will not assume an active role unless TI ceases to participate. No new grounds are being raised by Realtek, and no alteration of the TI IPR schedule will be necessary due to

the joinder of Realtek. The joinder will promote judicial efficiency in determining the patentability of the Challenged Patent without prejudice to the Patent Owner.

On December 19, 2024, Realtek notified counsel for TI and counsel for Patent Owner regarding the subject of this motion. Counsel for TI indicated that TI will not oppose this motion. On December 20, 2024, TI's expert Dr. Ian Galton confirmed that he was available and willing to continue to support this Petition if Realtek steps into TI's place.

Considering the similarities of the proceedings, the potential benefit to the public and the Board that would accrue by Realtek's participation in the TI IPR proceeding in the event that TI's participation terminates unexpectedly, and the lack of prejudice to Patent Owner, Petitioner respectfully requests that the Board join Realtek as a party to the TI IPR.

II. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

Per 35 U.S.C. § 315(c), the Board may grant a motion for joining a petitioner for *inter partes* review to another *inter partes* review proceeding. *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-1 Security Solutions, Inc.*, IPR2013-00385, Paper 17 at 3 (P.T.A.B. July 29, 2013). Realtek addresses each of these points below.

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). Realtek's Petition and this motion are being filed within one month of the Board's decision instituting trial in the TI IPR on November 29, 2022. This motion is therefore timely. *See, e.g.*, *Biotronik, Inc. v. Atlas IP LLC*, IPR2015-00534, Paper 10 (PTAB Feb. 25, 2015) (granting motion for joinder filed concurrently with institution of IPR review).

B. The Four Factors Favor Joinder

Each of the four factors weigh in favor of granting Realtek's Motion for Joinder. Realtek's Petition is substantively identical to the petition in the TI IPR. Realtek's Petition does not present any new grounds of unpatentability. And because Realtek agrees to take on an "understudy" role in the TI IPR proceeding, joinder will have minimal or no impact on the pending schedule of the TI IPR. *See Sony Corp. v. Memory Integrity, LLC.*, IPR2015-01353, Paper No. 11 at 6-9 (PTAB Oct. 5, 2015) (granting motion for joinder where petitioner agreed to an

"understudy" role). Moreover, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

1. Reasons Why Joinder is Appropriate

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

Joinder is appropriate because Realtek's Petition does not raise any new grounds of unpatentability and does not create any issues that might complicate or delay the TI IPR proceeding. The Board "routinely grants motions for joinder where the party seeking joinder introduces <u>identical</u> arguments and the <u>same</u> grounds raised in the existing proceeding." *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (PTAB Aug. 24, 2016) (internal quotations and citations omitted). Here, joinder with the TI IPR is appropriate because Realtek's Petition includes identical arguments and the same grounds raised in the existing TI IPR proceeding (*i.e.*, challenges the same claims of the same patent, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the TI Petition). Therefore, good cause exists for joining

Realtek to the TI IPR proceeding so that the Board can efficiently "secure the just, speedy, and inexpensive resolution" of Realtek's and TI's petitions in a single proceeding. *See* 37 C.F.R. § 42.1(b).

2. Petitioners Do Not Propose New Grounds of Unpatentability

Realtek's Petition is substantially identical to the petition in the TI IPR. Realtek challenges the same claims of the Challenged Patent, based on the same invalidity grounds, and the same arguments. The same expert declarant is used, and the expert's declarations in the two cases are identical. Further, unity of exhibits and exhibit numbering with the TI IPR has also been maintained. Accordingly, no new grounds are being introduced and no disruption to the TI IPR schedule is necessary to resolve the issues raised in Realtek's Petition. *See Sony Corp. v. Memory Integrity, LLC.*, IPR2015-01353, Paper No. 11 at 5-6 (PTAB Oct. 5, 2015) (granting 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").

3. Joinder Will Not Negatively Impact the TI IPR Schedule

This motion is being filed within one month of the institution of the TI IPR, and Realtek agrees to adhere to all applicable deadlines set forth in the TI IPR Scheduling Order. The Patent Owner's Response will not be negatively impacted because the issues in Realtek's Petition are identical to the issues presented in the

TI IPR petition. Patent Owner will thus not be required to provide any additional analysis or arguments beyond what it will already provide in response to the petition in the TI IPR proceeding. Realtek is introducing no additional evidence or witnesses. Thus, no additional depositions will be needed. Accordingly, the trial schedule for the TI IPR should not be adversely impacted by Realtek's joinder.

4. Discovery and Briefing Can Be Simplified

Petitioner agrees to take an "understudy" role, which will simplify briefing and discovery. In this "understudy" role, Realtek agrees to the following conditions upon joining the TI IPR proceeding so long as TI remains an active party in that proceeding:

(a) Realtek 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 Realtek;

(b) Realtek shall not present any argument or make any presentation at oral hearing on issues not solely involving Realtek;

(c) Realtek shall not seek to cross-examine or defend the cross-examination of any witness, unless the topic of cross-examination concerns issues solely involving Realtek; and

(d) Realtek shall not seek discovery from Patent Owner on issues not solely involving Realtek.

See, e.g., *Noven Pharm., Inc. v. Novartis AG*, IPR2014-00550, Paper 38 at 5 (PTAB April 10, 2015). Unless and until the current petitioner in IPR2022-01126 ceases to participate in the instituted TI IPR proceeding, Realtek will not assume an active role therein.[1]

Accordingly, due to Realtek taking only an "understudy" role, Patent Owner and TI can comply with the existing trial schedule without needing any duplicative efforts by the Board or the Patent Owner. These steps will minimize or eliminate any potential complications or delay that could potentially result from joinder. *See Sony Corp. v. Memory Integrity, LLC.*, IPR2015-01353, Paper No. 11 at 6-7 (PTAB Oct. 5, 2015) (granting motion 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 second petitioner agreed to "understudy" role). Realtek will also abide by any additional conditions the Board deems appropriate for an "understudy" role.

5. Joinder Will Result in No Prejudice to Patent Owner

As noted above, Realtek's joining of the TI IPR proceeding should not result

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[1] For clarity, should TI's participation in this IPR proceeding terminate, Realtek would take over primary responsibility for subsequent filings and discovery.

in any prejudice to Patent Owner.[2] No additional grounds or arguments are being introduced, no new evidence or issues are being added, and no additional briefing should be necessary as a result of Realtek's joinder. Thus, the Patent Owner would not need to expend any additional resources above and beyond those required in the current TI IPR proceeding.

III. CONCLUSION

For the reasons given above, Realtek respectfully requests that its Petition for *Inter Partes* Review of the Challenged Patent be instituted and that Realtek be joined to the TI IPR proceeding IPR2024-00936.

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[2] Any argument that joinder may frustrate settlement between TI and Patent Owner would not be a basis to deny joinder because the same possibility would exist in any joinder situation. *Global Foundries U.S. Inc. v. Godo Kaisha IP Bridge 1*, IPR2017-00925 and IPR2017-00926, Paper 13 at 10 (PTAB Jun. 9, 2017).

Respectfully submitted,

Dated December 24, 2024 /Jeffrey Johnson/

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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. §§ 42.6(e) and 42.105, the undersigned certifies that on December 24, 2024, a complete and entire copy of Petitioner's **MOTION FOR JOINDER TO *INTER PARTES* REVIEW IPR2024-00936** was served on Patent Owner via FedEx overnight at the correspondence address of record for the subject patent, as included below:

Workman Nydegger
60 East South Temple, Suite 1000
Salt Lake City, UT
United States

And a courtesy copy is also being forwarded to Patent Owner's Litigation Counsel via electronic mail to:

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