

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASUSTEK COMPUTER INC.,
Petitioner,

v.

NOKIA TECHNOLOGIES OY
Patent Owner.

Case IPR2025-01279
Patent 8,050,321

**PETITIONER’S MOTION FOR JOINDER UNDER
35 U.S.C. § 315(c), 37 C.F.R. § 42.22, AND § 42.122(b)**

I. STATEMENT OF PRECISE RELIEF REQUESTED

ASUSTeK Computer Inc. (“ASUS” or “Petitioner”) respectfully submits this Motion for Joinder concurrently with a Petition for *inter partes* review of U.S. Patent No. 8,050,321 (“the ’321 patent”).

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b), ASUS requests institution of an *inter partes* review and joinder with IPR2025-01068 (*Element TV Company, LP, and Element Television Company, LLC v. Nokia Technologies Oy* “Element IPR”), filed on June 4, 2025. Element does not oppose ASUS’s joinder to the Element IPR.

ASUS’s petition is substantively the same as the Element IPR petition. It challenges the same claims, on the same grounds, relies on the same prior art, and includes the exact same substantive arguments as the Element IPR and therefore would create no additional burden for the Board, the Element IPR Petitioner, or Patent Owner if joined. Joinder would therefore lead to an efficient resolution of the validity of the ’321 patent. ASUS is currently named as a defendant in *Nokia Technologies Oy v. ASUSTeK Computer Inc. et al.*, 2-25-cv-03053 (CDCA), filed April 07, 2025.

ASUS has not previously filed a petition for IPR challenging the validity of the ’321 patent. ASUS stipulates that if joinder is granted, it will act as an

“understudy” and will not assume an active role unless the Element IPR Petitioner ceases to participate in the proceeding.

The Element IPR Petitioner will maintain the lead role in the proceeding so long as it remains in the proceeding. These limitations will avoid lengthy and duplicative briefing. ASUS also will not seek additional depositions or deposition time. Joinder will not impact the trial schedule because ASUS agrees to be bound by the scheduling order in the Element IPR proceeding. In fact, joinder will help efficiently resolve the disputes among the parties. By joinder, a single Board decision may dispose of the issues raised in the Element IPR for all interested parties. Joinder will not unduly prejudice any party. Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or needlessly increase filings, any additional costs on Patent Owner will be minimal. On the other hand, denial of joinder would prejudice ASUS.

ASUS’s interests may not be adequately protected in the Element IPR, particularly if the Element IPR Petitioner settles with Patent Owner and ceases to participate. ASUS should be allowed to join in a proceeding affecting a patent asserted against it. Given the similarities of the proceedings, the lack of undue prejudice to Patent Owner, and the potential benefit to the public and to the Board that would accrue by ASUS’s cooperative participation, in an understudy role, in

the Element IPR in the event that the Element IPR Petitioner's participation terminates, the Board should institute IPR and grant ASUS's Motion for Joinder.

II. ARGUMENT

A. Legal Standards and Applicable 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 of 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.*, IPR201300385, Paper 17 at 3 (July 29, 2013).

B. ASUS's Motion for Joinder is Timely

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). The Element IPR was filed on June 4, 2025, and is expected to be instituted on or before December 25, 2025, Paper 03, IPR2025-01068. ASUS's current motion is timely as it is being filed prior to the institution date.

C. Petitioner Element Does Not Oppose Joinder

ASUS has conferred with Petitioner Element, and Element does not oppose ASUS's joinder to the Element IPR.

D. The Factors Favor Joinder

Each of the factors weighs in favor of granting ASUS's Motion for Joinder. ASUS's Petition is substantively identical to the petition in the Element IPR; it presents no new grounds of unpatentability. Joinder will have no impact on the pending schedule of the Element IPR. Moreover, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

1. Joinder of ASUS Is Appropriate Because It Will Promote an Efficient Determination of the Validity of the '321 patent Without Prejudice to Any Party

ASUS seeks to join the Element IPR in order to ensure that an accused infringer with an active interest in the proceeding remains a party if the Element IPR Petitioner's participation is terminated prior to completion. Thus, joining ASUS to the Element IPR is the most practical way to secure the just, speedy, and inexpensive resolution of the challenge to the '321 patent. *See* 37 C.F.R. § 42.1(b).

If ASUS is joined as a party, the validity of the grounds raised in the Element IPR can be determined in a single proceeding. Joinder is also appropriate because ASUS's petition challenges the validity of the same claims of the '321 patent on identical grounds to those in the Element IPR. There are no substantive differences between ASUS's and the Element IPR Petitioner's Petition, IPR2025-01068, Paper 1 (June 4, 2025). ASUS also relies on the same supporting evidence in its Petition as is relied on in the Element IPR. A consolidated proceeding, including ASUS and the Element IPR Petitioner, will therefore be more efficient and less wasteful, as only a single trial on these common grounds would be required. *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"). 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) (internal quotations and citations omitted). Joining ASUS as a party to the Element IPR would promote the public interest relating to the unpatentability of the '321 patent and not cause any undue prejudice to Patent Owner or the Element

IPR Petitioner. The Patent Owner must respond to the common invalidity grounds identified in the Element and ASUS Petitions, regardless of joinder.

2. ASUS's Petition Does Not Raise Any New Grounds of Unpatentability and Therefore Does Not Add Additional Complexity to the Grounds in the Element IPR

ASUS's Petition challenges the validity of the '321 patent on identical grounds to those in the Element IPR. *See* IPR2025-01068, Paper 1 (June 4, 2025). ASUS's supporting materials—including its supporting expert declaration, exhibits, and exhibit numbering—are identical to those presented in the Element IPR. *See supra* n.2. Accordingly, no new grounds are being introduced. *See Intel Corp. v. Memory Integrity, LLC*, IPR2015-01353, Paper No. 11 at 5-6 (PTAB Oct. 5, 2015). Therefore, consolidation of this proceeding with Element's via joinder of ASUS's Petition will not raise any new issues of unpatentability and will not impose any additional burden on the Board or Patent Owner, or add additional complexity to the case.

3. Joinder Will Not Affect the Schedule in the Element IPR

Given that the Board has not yet instituted the Element IPR, joinder of ASUS would not affect the schedule in any potential forthcoming trial. ASUS's participation should result in no changes to the schedule. ASUS agrees to adhere to all applicable deadlines set forth in the Element IPR Scheduling Order, if instituted.

4. Joinder Will Simplify Briefing Because ASUS Has Agreed to Consolidated Filings and an Understudy Role if the Element Petitioner Remains

To further prevent joinder from imposing any burden on the Element IPR Petitioner, Patent Owner, or the Board and to further ensure that there are no changes in the potential trial schedule, ASUS has agreed, as long as the Element IPR Petitioner remains a party to the Element IPR, to take an understudy role, which will simplify briefing and discovery. In this role, ASUS agrees to the following conditions: (a) ASUS shall not make any substantive filing and shall be bound by the filings of the Element IPR Petitioner, unless a filing concerns termination and settlement, or issues solely involving ASUS; (b) ASUS shall not present any argument or make any presentation at oral hearing unless an issue solely involves ASUS, or when addressing Board-approved motions that do not affect the Element IPR Petitioner, or its respective position; (c) ASUS shall not seek to cross-examine or defend the cross-examination of any witness, unless the topic of cross-examination concerns issues solely involving ASUS; (d) ASUS shall not seek discovery from Patent Owner on issues not solely involving ASUS; (e) ASUS will not rely on expert testimony beyond that submitted by the Element IPR Petitioner unless the Element IPR Petitioner is terminated from the case. If the Element IPR Petitioner is not terminated from the case, ASUS agrees to rely entirely on, and be bound by, the expert declarations and depositions in the

Element IPR. Unless and until the current petitioner in IPR2025-01068 ceases to participate in the Element IPR, ASUS will not assume an active role. Accordingly, due to ASUS taking only an “understudy” role, Patent Owner and the Element IPR Petitioner will only need to respond to one principal set of papers, will not require additional time to address additional arguments raised by ASUS, and can thus proceed with the existing trial schedule. These steps will minimize or eliminate any potential complications or delay that could potentially result from joinder. *See Intel*, Paper No. 11 at 6-7 (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). ASUS 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, ASUS’s joining of the Element IPR proceeding should not result in any prejudice to Patent Owner. No additional grounds or arguments are being introduced, no new evidence or issues are being added, and no additional discovery or briefing or oral argument should be necessary as a result of ASUS’s joinder. Thus, Patent Owner would not need to expend any additional resources beyond those required in the current Element IPR.

III. CONCLUSION

For the foregoing reasons, ASUS respectfully requests that its Petition for *inter partes* review of the '321 patent be instituted and that ASUS be joined to the Element IPR proceeding, numbered IPR2025-01068.

Respectfully submitted,

Dated July 16, 2025

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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 July 16, 2025, a complete and entire copy of this Motion for Joinder provided via Federal Express, to the Patent Owner by serving the correspondence address of record as follows:

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