UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INC.,
Petitioner,

v.

BANDSPEED, INC.,
Patent Owner.

Case IPR2015-00531,
Case IPR2015-01582
Patent 8,542,643 B2

Before BART A. GERSTENBLITH, DAVID C. McKONE, and

McKONE, Administrative Patent Judge.

DECISION

Institution of Inter Partes Review and Grant of Motion for Joinder
37 C.F.R. § 42.108
37 C.F.R. § 42.122(b)
INTRODUCTION


While the parties were briefing the Motion for Joinder, the MediaTek petitioners settled with Patent Owner and the parties to IPR2015-00531 filed a Motion toTerminate (Paper 17) on August 5, 2015. On September 17, 2015, we granted the Motion to Terminate as to the MediaTek petitioners, but not as to Patent Owner. Paper 20, 4. We vacated the Scheduling Order (Paper 13) and stated that we would revisit the Motion to Terminate as to Patent Owner after ruling on the pending Motion for Joinder. *Id.* at 3–4.

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\(^1\) Unless otherwise noted, citations to papers and exhibits are to those filed in IPR2015-00531.
On October 28, 2015, Patent Owner purported to file a Preliminary Response to Qualcomm’s Petition (IPR2015-01582, Paper 11, “Prelim. Resp.”). Upon inspection, the Preliminary Response does not respond to any of the arguments and evidence presented in the Qualcomm Petition, aside from indicating that absent joinder, Qualcomm would be barred from filing a petition under 35 U.S.C. § 315(b). The majority of Patent Owner’s Preliminary Response introduces new arguments in opposition to the Motion for Joinder. In other words, Patent Owner used the Preliminary Response as an unauthorized sur-reply to the Motion for Joinder. Because Patent Owner did not seek, nor did we grant authorization for additional briefing on the Motion for Joinder, we do not consider Patent Owner’s joinder arguments presented in the Preliminary Response. See 37 C.F.R. §§ 42.20(b) (“Prior authorization. A motion will not be entered without Board authorization.”); 42.23–24 (setting forth the requirements for oppositions and replies, but not authorizing sur-replies).²

For the reasons described below, we institute an inter partes review of all the challenged claims and grant Qualcomm’s Motion for Joinder.

ANALYSIS

Institution on the same grounds as those asserted in the MediaTek Petition

Qualcomm represents that its Petition “is in all material respects the same as the petition in” IPR2015-00531. Mot. for Joinder 1. Qualcomm further represents that it “relies on the same expert declaration relied on by” MediaTek in IPR2015-00531. Id. The Ding Declaration submitted in

² As it was, we extended Patent Owner’s deadline to file its Opposition to the Motion for Joinder. IPR2015-01582, Paper 7.
IPR2015-00531, IPR2015-01582
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IPR2015-01582 (Ex. 1002) appears to be a copy of the declaration filed in IPR2015-00531 (also Ex. 1002). As explained above, while Patent Owner filed a paper styled a “Preliminary Response,” that paper did not address any of the challenges presented in Qualcomm’s Petition.

In view of the identity of the challenges in the Qualcomm Petition and those of the MediaTek Petition, we institute an *inter partes* review in IPR2015-01582 on the same grounds as those on which we instituted in IPR2015-00531. We do not institute *inter partes* review on any other grounds.

*Joinder with IPR2015-00531*

The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA") permits the joinder of like proceedings. *See* 35 U.S.C. § 315(c). Under Section 315(c), the Board, acting on behalf of the Director, has the discretion to join an *inter partes* review with another *inter partes* review:

If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

Qualcomm’s Petition was accorded a filing date of July 13, 2015, and therefore satisfies the joinder requirement of being filed within one month of our institution of trial in IPR2015-00531. *See* 37 C.F.R. § 42.122(b); *see also* 37 C.F.R. § 1.7(a); 37 C.F.R. § 42.1(a). 35 U.S.C. § 315(b) further establishes a one-year bar from the date of service of a complaint alleging
infringement for requesting *inter partes* review, but specifies that the bar does not apply to a request for joinder under § 315(c). Although Qualcomm filed its Petition more than one year from the date of a complaint alleging infringement, that Petition nevertheless is timely if we grant Qualcomm’s Motion for Joinder.

Previous panels of this Board have listed factors that should be addressed in a motion for joinder. For example:

A motion for joinder should: (1) set forth the reasons why 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) address specifically how briefing and discovery may be simplified.


As explained above, Qualcomm’s Petition includes no new grounds of unpatentability. Qualcomm agreed in its Motion for Joinder to abide by the Scheduling Order existing at the time its Motion for Joinder was filed. Mot. for Joinder 6. Qualcomm also agreed to rely primarily on MediaTek to prosecute the case in order to simplify discovery and minimize the impact of joinder on IPR2015-00531. *Id.* Because the MediaTek petitioners have settled, there are no longer issues of cooperation and duplication among petitioners.

Patent Owner opposes Qualcomm’s Motion for Joinder, arguing that granting it would discourage early settlement. PO Opp. 7–8. According to Patent Owner,
A contrary decision would mean far fewer settlements will occur in multi-defendant cases until at least one month after institution of an IPR (possibly several months after institution if the original petitioner and patent owner must wait to see if another defendant is permitted to join after that defendant files a motion to join) because the patent owner will always be concerned that even if it settles with the original petitioner, another defendant will seek to join or be permitted to join the instituted IPR that would otherwise likely be terminated, depriving the patent owner of much of the value of its settlement with the original petitioner.

Id. Patent Owner’s contention is speculative attorney argument unsupported by evidence and, therefore, is unpersuasive. Cf. Nintendo of Am., Inc. v. Babbage Holdings, LLC, Case IPR2015-00568, slip op. at 4–5 (PTAB Mar. 8, 2015) (Paper 12). We note that, in IPR2015-00531, the MediaTek petitioners did not oppose joinder, Mot. for Joinder 5 n.3, and Patent Owner was able to reach settlement with MediaTek despite the possibility of joinder.

Patent Owner cites Google Inc. v. Personal Web Technologies, LLC, Case IPR2014-00977 (PTAB Oct. 30, 2014) (Paper 10), as an example in which the Board terminated an inter partes review while a motion for joinder was pending, rendering that motion moot. PO Opp. 5–6. Google, however, simply included the termination of the inter partes review as an alternative ground for denying a motion for joinder as moot (the panel denied the motion as untimely); the Google panel did not provide any reasoning to support Patent Owner’s argument that joinder would dissuade settlement. Case IPR2014-00977, slip op. at 5–6 (Paper 10).

Patent Owner also argues that joinder would create scheduling issues. In particular, Patent Owner contends that Dr. Ding, the declarant on whom Qualcomm relies, is located in China and “it is unclear whether [Qualcomm]
has also engaged Dr. Ding as an expert in IPR2015-01582 or whether it will be able to exert control over him to bring him to the United States prior to the current patent owner response deadline.” PO Opp. 9. In Reply, Qualcomm represents that it has engaged Dr. Ding and is able to present him for deposition. Reply 4. Such cross-examination is part of routine discovery. See 37 C.F.R. § 42.51(b)(1)(ii); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,761 (Aug. 14, 2012).

Patent Owner also contends that joinder would require significant adjustment to the schedule and would compromise our ability to meet the deadline of 35 U.S.C. § 316(a)(11). PO Opp. 9–10. The Enzymotec panel noted “a policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding.” Case IPR2014-00556, slip op. at 6 (Paper 19) (citing 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (“The Office anticipates that joinder will be allowed as of right – if an inter partes review is instituted on the basis of a petition, for example, a party that files an identical petition will be joined to that proceeding, and thus allowed to file its own briefs and make its own arguments.”)).

In this proceeding, Qualcomm stated a willingness to cooperate with the MediaTek petitioners and follow the schedule originally set in IPR2015-00531. Mot. for Joinder 5–6. To that effect, Qualcomm filed an identical petition and agreed to follow the MediaTek petitioners’ lead. Id. at 6. Qualcomm took the steps our cases counsel to minimize the impact of joinder on our goal of securing a just, speedy, and inexpensive resolution. But for settlement between the MediaTek petitioners and Patent Owner, IPR2015-00531 presumably would have followed the originally ordered
schedule, joinder notwithstanding. Paper 20, 4. In any case, 35 U.S.C. § 316(11) permits us to adjust the time period for a final written decision in the case of joinder. See also 37 C.F.R. § 42.100(c).

In sum, we are not persuaded that joinder in this case will, as a policy matter, discourage settlement. Nor are we persuaded that joinder will undermine our ability to secure a just, speedy, and inexpensive resolution of the parties’ dispute. Qualcomm has persuaded us that joinder is appropriate in this case. In consideration of the above, we institute an *inter partes* review in IPR2015-01582 and grant Qualcomm’s motion to join that proceeding to IPR2015-00531.

As to the Motion to Terminate (Paper 17), 35 U.S.C. § 317(a) states “[i]f no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a).” Because Qualcomm remains a petitioner, we do not terminate IPR2015-00531.

ORDER

ORDERED that IPR2015-01582 is instituted and joined with IPR2015-00531;

FURTHER ORDERED that the grounds on which IPR2015-00531 was instituted are unchanged and no other grounds are instituted in the joined proceeding;

FURTHER ORDERED that IPR2015-01582 is terminated under 37 C.F.R. § 42.72 and all further filings in the joined proceeding are to be made in IPR2015-00531;
FURTHER ORDERED that the case caption in IPR2014-00531 shall be changed to reflect joinder with this proceeding in accordance with the attached example; and

FURTHER ORDERED that the Motion to Terminate (Paper 17) is denied as to Patent Owner.
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1 Case IPR2015-01582 has been joined with this proceeding.