

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE CORPORATION, ZTE (USA) INC.,
and T-MOBILE USA INC.,
Petitioner,

v.

ADAPTIX, INC.,
Patent Owner.

Case IPR2015-01184
Patent 7,454,212 B2

Before HOWARD B. BLANKENSHIP, TREVOR M. JEFFERSON, and
JUSTIN BUSCH, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION

Denial of Institution of *Inter Partes* Review
37 C.F.R. § 42.108

Denial of Motion for Joinder
37 C.F.R. § 42.122

I. BACKGROUND

ZTE Corporation, ZTE (USA) Inc., and T-Mobile USA Inc. (collectively, “Petitioner”) filed a petition requesting *inter partes* review of claims 1, 8–13, 15, 16, 18–21, and 23–30 of U.S. Patent No. 7,454,212 B2 (“the ’212 patent”) (Ex. 1001) under 35 U.S.C. §§ 311–319. Paper 1 (“Petition” or “Pet.”). With the Petition, Petitioner filed a motion for joinder (Paper 2, “Mot. Join.”), seeking to join with *Sony Mobile Communications (USA) Inc.* (“Sony”) *v. Adaptix, Inc.*, Case IPR2014-01525 (“IPR ’1525”). The motion for joinder was filed within one month of institution of trial in IPR ’1525. *See* 37 C.F.R. § 42.122(b). Patent Owner Adaptix, Inc. filed an opposition to the motion for joinder. Paper 8 (“Opp.”). Petitioner filed a reply to Patent Owner’s opposition to the motion for joinder. Paper 9 (“Reply”). We have jurisdiction under 35 U.S.C. § 314.

For the reasons that follow, we deny the motion for joinder. We also deny the current petition and do not institute an *inter partes* review.

A. Related Proceedings

According to Petitioner, the ’212 patent is involved in the following lawsuits: *Adaptix, Inc. v. AT&T, Inc.*, No. 6:12-cv-00017 (E.D. Tex.); *Adaptix, Inc. v. Pantech Wireless, Inc.*, Nos. 6:12-cv-00020 and ’778 (E.D. Tex.); *Adaptix, Inc. v. Cellco Partnership*, No. 6:12-cv-00120 (E.D. Tex.); *Adaptix, Inc. v. Blackberry Limited*, Nos. 5:14-cv-01380, ’386, and ’387 (N.D. Cal.); *Adaptix, Inc. v. Kyocera Corp.*, Nos. 3:14-cv-02894 and ’2895 (N.D. Cal.); *Adaptix, Inc. v. Apple, Inc.*, Nos. 5:13-cv-01776, ’1777, and ’2023 (N.D. Cal.); *Adaptix, Inc. v. AT&T, Inc.*, No. 5:13-cv-01778 (N.D. Cal.); *Adaptix, Inc. v. Cellco Partnership*, No. 5:13-cv-01844 (N.D. Cal.);

Adaptix, Inc. v. Dell, Inc., No. 5:14-cv-01259 (N.D. Cal.); *Adaptix, Inc. v. Amazon.com, Inc.*, No. 5:14-cv-01379 (N.D. Cal.); *Adaptix, Inc. v. Sony Mobile Commc'ns, Inc.*, No. 5:14-cv-01385 (N.D. Cal.); *Adaptix, Inc. v. ASUSTek*, No. 5:14-cv-03112 (N.D. Cal.); *Adaptix, Inc. v. HTC Corp.*, Nos. 5:14-cv-02359 and '2360 (N.D. Cal.); and *Adaptix, Inc. v. ZTE Corp.*, Nos. 5:15-cv-00165, '00166, '00167, and '00168. Pet. 2.

B. Asserted Prior Art

Ritter	DE 19800953 C1	July 29, 1999	Ex. 1004 ¹
Kapoor	US 6,795,424 B1	Sept. 21, 2004	Ex. 1006

C. Asserted Ground of Unpatentability

Petitioner asserts a ground of unpatentability under 35 U.S.C. § 103(a) over the combination of Kapoor and Ritter against claims 1, 8–13, 15, 16, 18–21, and 23–30. Pet. 19–40.

II. ANALYSIS

A. Joinder Motion

35 U.S.C. § 315 provides in pertinent part (emphasis added):

(c) JOINDER.—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.*

¹ Exhibit 1005 is an English translation of the German patent document.

The decision to grant joinder is discretionary, with Petitioner, as the moving party, bearing the burden to show that joinder is appropriate. 35 U.S.C. § 315(c); 37 C.F.R. § 42.20(c).

Petitioner seeks to join as a party to the IPR '1525 proceeding. In IPR '1525, the Board instituted *inter partes* review of the '212 patent on Sony's asserted ground of unpatentability of claims 1, 8–13, 15, 16, 18–21, and 23–30 as being obvious over Kapoor and Ritter. IPR '1525, slip op. at 13 (PTAB Apr. 8, 2015) (Paper 15). In this proceeding, Petitioner challenges the same claims of the '212 patent based on the same ground of obviousness over Kapoor and Ritter. Petitioner argues that joinder should be granted “as a matter of right” because Petitioner has filed the “identical petition” with respect to the instituted ground in IPR '1525. Mot. Join. 6.

To the contrary, Petitioner has not filed an “identical petition.” The petition in IPR '1525 relied on the proffered expert testimony of Professor Robert Akl. *See* IPR '1525 Paper 5 (corrected petition) *passim*; Ex. 1007 (Akl Decl.). In this proceeding, Petitioner does not file as an exhibit and rely on the Akl Declaration, or a similar declaration by Professor Akl, instead relying on the testimony of Dr. Tim A. Williams. *See* Petition *passim*; Ex. 1003 (Williams Decl.). Petitioner's motion does not address that substantive difference between the petitions.

Petitioner submits that, in the event of being joined as a party to the IPR '1525 trial, it “will rely upon Sony's expert, and will not offer additional expert testimony unless Sony terminates its involvement in the IPR.” Mot. Join. 8. Petitioner neglects to mention, however, that in this proceeding Petitioner relies on a different declarant in support of the proposed ground of unpatentability. Routine discovery in an *inter partes* review includes cross

examination of affidavit testimony. 37 C.F.R. § 42.51(b)(1)(ii). If we were to determine that the instant Petition meets the “reasonable likelihood” threshold required by 35 U.S.C. § 314(a), Patent Owner should have the opportunity to cross-examine Petitioner’s proffered expert. In this regard, Patent Owner argues that the new declaration “necessarily introduces a new expert declarant and potentially raises additional issues, and ‘the exact same evidence’ is not relied upon by Petitioners.” Opp. 5 (quoting Mot. Join. 4). Petitioner’s Motion does not explain why a declaration from a different proffered expert was thought to be necessary for its Petition.

As Patent Owner also notes,” the deposition of Sony’s expert declarant in the [IPR ’1525 trial] has already occurred” (Opp. 7). Indeed, the patent owner response in the IPR ’1525 proceeding (Paper 27) was filed on June 23, 2015. We agree with Patent Owner that the new issues raised by reliance on the different declarant in the instant Petition would adversely impact the IPR ’1525 trial. Opp. 7–8.

We agree also with Patent Owner (Opp. 6) that we cannot deny Petitioner’s motion but grant the instant Petition; thus, contrary to Petitioner’s allegation (Mot. Join. 4–5), there could be no inefficiency due to “duplication of effort” in two trials based on the same ground of unpatentability. Absent joinder, Petitioner is barred from *inter partes* review of the ’212 patent because it was served with a complaint alleging infringement of the patent on May 28, 2013, more than one year prior to the filing of the instant Petition (May 8, 2015). Opp. 6; Mot. Join. 2. *See* 35 U.S.C. § 315(b) (setting forth that an *inter partes* review may not be instituted if the petition requesting the proceeding is filed more than one

year after the date on which the petitioner is served with a complaint alleging infringement of the patent).

Petitioner provides insufficient reasons in its Motion for joinder with IPR '1525. The only reason alleged in the Motion that might weigh in support of joinder is that Petitioner would “be forced to litigate validity in the district court proceeding under the more demanding burden of clear and convincing evidence” in the event that “Sony settles its case” and the IPR '1525 proceeding might “not reach a final written decision.” Mot. Join. 5. The possibility that Sony might withdraw from the IPR '1525 proceeding, along with the possibility that Sony might have otherwise prevailed in its challenge with respect to the '212 patent, is weighed against the virtual certainty of having to reschedule the '1525 trial proceeding should Petitioner join as a party. Moreover, Petitioner does not indicate why the fact that Sony (or any other party charged with infringement) might withdraw from a challenge of the '212 patent seemingly went unappreciated for more than a year after Petitioner was served with a complaint alleging infringement of the patent.

Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b). When exercising that discretion, the Board is mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. 37 C.F.R. § 42.1(b). As indicated in the legislative history, the Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case. *See* 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (when determining whether and when to allow joinder, the Office

may consider factors including the breadth or unusualness of the claim scope, claim construction issues, and consent of the patent owner).

In view of the facts and circumstances of this case, Petitioner, as movant, has not met its burden to show why joinder is appropriate, consistent with the goal of securing the just, speedy, and inexpensive resolution of every proceeding. Petitioner's motion for joinder is, thus, *denied*.

B. Denial of Inter Partes Review

Petitioner admits that it was served with a complaint alleging infringement of the '212 patent more than one year prior to the date of filing of the instant Petition. Mot. Join. 2. Accordingly, in view of the denial of the requested relief of joinder with IPR '1525, institution of an *inter partes* review as requested by Petitioner is barred by statute. 35 U.S.C. § 315(b); *see also* 37 C.F.R. § 42.101(b).

III. CONCLUSION

For the foregoing reasons, we deny Petitioner's motion for joinder. Because Petitioner is barred by 35 U.S.C. § 315(b) from an *inter partes* review of the '212 patent, we do not institute review as to any of the challenged claims.

IV. ORDER

In view of the foregoing, it is

ORDERED that Petitioner's motion for joinder is *denied*; and

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FURTHER ORDERED that the petition is *denied* and no trial is instituted.

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