
**United States Court of Appeals
for the Federal Circuit**

CYWEE GROUP LTD.,
Appellant

v.

ZTE (USA), INC. AND LG ELECTRONICS INC.,
Appellees

KATHERINE K. VIDAL, Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent and Trademark Office,
Intervenor

2021-1855

**Appeal from the United States Patent and Trademark Office,
Patent Trial and Appeal Board in IPR2019-00143 and IPR2019-01203**

**APPELLANT'S CORRECTED COMBINED PETITION
FOR REHEARING *EN BANC* AND PANEL REHEARING**

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**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF INTEREST

Case Number 2021-1855

Short Case Caption CYWEE GROUP LTD. v. ZTE (USA), INC.

Filing Party/Entity CYWEE GROUP LTD.

Instructions: Complete each section of the form. In answering items 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance. **Please enter only one item per box; attach additional pages as needed and check the relevant box.** Counsel must immediately file an amended Certificate of Interest if information changes. Fed. Cir. R. 47.4(b).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 04/28/2021

Signature: /s/ Jay P. Kesan

Name: Jay P. Kesan

<p>1. Represented Entities. Fed. Cir. R. 47.4(a)(1).</p>	<p>2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).</p>	<p>3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3).</p>
<p>Provide the full names of all entities represented by undersigned counsel in this case.</p>	<p>Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>	<p>Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>
<p>CyWee Group Ltd.</p>		

Additional pages attached

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

None/Not Applicable Additional pages attached

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5. Related Cases. Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

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CyWee Group Ltd. v. Samsung Electronics Co. Ltd., No. 2:17-cv-00140(E.D. Tex.)		

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

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**STATEMENT OF COUNSEL PURSUANT TO
FEDERAL CIRCUIT RULE 35(b)**

Based on my professional judgment, I believe this appeal requires an answer to the following precedent-setting questions of exceptional importance:

1. Whether the Panel erred in upholding joinder of a party under 35 U.S.C. 315(c), where the joined party did not “properly file a petition” for *inter partes* review within the statutory time limit.
2. Whether the Panel erred in failing to hold a time-barred joined petitioner estopped from renegeing on the very conditions it voluntarily assumed to attain joinder.

Based on my professional judgment, I believe the Panel’s decision is contrary to the following statutes and decisions of this Court and the Supreme Court:

- 35 U.S.C. § 315(c) (the Director may join as a party to that *inter partes* review any person who properly files a petition under section 311);
- *Artuz v. Bennett*, 531 U.S. 4, 8 (2000) (a document is “properly filed” when “its delivery and acceptance are in compliance with the applicable laws and rules governing filings,” including “the time limits upon its delivery.”);
- *Pace v. DiGuglielmo*, 544 U.S. 408, 413 (2005) (“In common understanding, a petition filed after a time limit, and which does not fit within any exceptions to that limit” is not properly filed);

- *Taylor v. Sturgell*, 553 U.S. 880 (2008) (a “person who agrees to be bound by the determination of issues in an action between others is bound in accordance with the terms of his agreement.”); and
- *New Hampshire v. Maine*, 532 U.S. 742 (2001) (prohibiting parties from deliberately changing positions as best serves that party at a given time).

Dated: February 23, 2024

/s/ Jay P. Kesan

Jay P. Kesan

Attorney of Record for Appellant

I. INTRODUCTION

This Court’s decision will determine (1) if there are *any* limits to the joinder of time-barred infringers and, if joined, (2) whether they will be allowed to renege on the promises they made to obtain joinder. Despite ZTE’s continued participation in the IPR, LG simply renounced its passive understudy role. ZTE accomplished its IPR goals by invalidating the original claims and blocking the first amendments. It did not abandon the IPR.

LG’s IPR rights lapsed. Regardless, the Panel ignored the language and intent of the enabling statute and allowed LG to join and even take over. The PTAB’s stated purpose that “the regulations governing trial practice and procedure before the Board, *including the rules for joinder*, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding” was simply ignored. *Great West Casualty Co. v. Intellectual Ventures*, IPR2016-01534, Paper 13 (Feb 15, 1017) (*citing* 37 C.F.R. § 42.1(b)) (emphasis added). Instead, this IPR was unjust, massively delayed, and incredibly expensive.

Here, a split PTAB Panel allowed an unprecedented expansion of the role of the time-barred, passively joined petitioner to raise new issues and new prior art that the original petitioner had intentionally foregone. This resulted in a final written decision issued nearly 2½ years after the original petition, and nearly 4 years after LG’s time bar. The Panel allowed LG to submit a substantively different challenge

of amended claim 22, in addition to the original substantive challenge of unchanged claim 22 by ZTE. This is the epitome of Judge Gorsuch’s concerns regarding unprecedented rulings favoring a highly sophisticated “frequent user of the IPR process”—such as LG here. *United States v. Arthrex, Inc.*, 141 S. Ct. 1970, 1993 (2021) (Gorsuch, J., dissenting in part).

The Panel misapprehended 35 U.S.C. Section 315(c) and ignored binding Supreme Court precedent. The plain text of the AIA prevents time-barred parties from joining an *inter partes* review initiated by another party: “the Director . . . may join as a party . . . 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 Supreme Court has left no doubt that a petition that is not timely filed is not “properly filed.” Congress intentionally included the word “properly” in the statute, which the Panel’s interpretation simply ignores. The Panel thus ran “afoul of the ‘cardinal principle’ of interpretation that courts ‘must give effect, if possible, to every clause and word of a statute.’” Notably, this precise issue has been presented to the Supreme Court in *VirnetX v. Mangrove Partners et al.*, S. Ct. petition for *cert. pending*, No. 23-315 (filed September 20, 2023); *see also id.*, Brief For The Biotechnology Innovation Organization As Amicus Curiae In Support Of Petitioner.

II. POINTS OF LAW OR FACT OVERLOOKED OR MISAPPREHENDED BY THE PANEL

A. The Board Misapprehended Section 315(c) And Binding Supreme Court Precedents And Improperly Allowed Joinder Of A Party That Could Not File A Proper Petition

The Panel misapprehended 35 U.S.C. Section 315(c), which does not allow for joinder of time-barred parties and ignored binding Supreme Court precedent.

1. The Plain Text Of Section 315(c) Prevents Joinder Of Time-Barred Parties

“The starting point for interpreting a statute is the language of the statute itself.” *Consumer Prod. Safety Comm’n v. GTE Sylvania, Inc.*, 447 U.S. 102, 108, (1980). The plain text of the AIA prevents time-barred parties from joining an *inter partes* review initiated by another. Section 315(c) unambiguously provides that the Director may join a party to an already existing *inter partes* review only if that party “properly file[d]” a petition for review: “the Director * * * may join as a party to [an instituted] *inter partes* review 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). By the plain language of 315(c), the joining party must properly file its own petition for review. It is undisputed that LG is time-barred and never properly filed a petition.

The Supreme Court has been clear; a document is “properly filed” when “its delivery and acceptance are in compliance with the applicable laws and rules

governing filings.” *Artuz v. Bennett*, 531 U.S. 4, 8 (2000). In *Artuz*, Justice Scalia, writing for a unanimous court, as a renowned textualist, stated:

An application is “filed,” as that term is commonly understood, when it is delivered to, and accepted by, the appropriate court officer for placement into the official record. *See, e.g., United States v. Lombardo*, 241 U.S. 73, 76, 60 L. Ed. 897, 36 S. Ct. 508 (1916) (“A paper is filed when it is delivered to the proper official and by him received and filed”); Black’s Law Dictionary 642 (7th ed. 1999) (defining “file” as “to deliver a legal document to the court clerk or record custodian for placement into the official record”).

Id. at 8. In contrast,

an application is ‘properly filed’ when its delivery and acceptance are in compliance with the applicable laws and rules governing filings. These usually prescribe, for example, the form of the document, the time limits upon its delivery, the court and office in which it must be lodged, and the requisite filing fee.

Id. The Court has further confirmed that “properly filed” specifically includes, “the time limits upon its delivery.” *Id.*; *see also Pace v. DiGuglielmo*, 544 U.S. 408, 413 (2005) (Chief Justice Rehnquist writing for a unanimous court and observing that “[i]n common understanding, a petition filed after a time limit, and

which does not fit within any exceptions to that limit” is not properly filed); *see also* 154 Cong. Rec. S9988 (daily ed., Sept. 27, 2008) (statement of Senator Kyl) (referring to *Artuz* and *Pace* by name).

The AIA statute also unambiguously defines the proper time to file a petition for *inter partes* review: “An *inter partes* review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner * * * is served with a complaint alleging infringement of the patent.” 35 U.S.C. § 315(b). LG was served with a complaint alleging infringement in June of 2017, yet it filed its Petition and Joinder Motion only in June 2019, *a year too late*. Therefore, the petition was not “properly file[d]” under § 315(c), and consequently, LG should not have been joined to an already instituted *inter partes* review.

This conclusion honors the AIA’s purpose “to minimize burdensome overlap between *inter partes* review and patent-infringement litigation.” *Thryv, Inc. v. Click-To-Call Technologies, LP*, 590 U.S. ___, 140 S. Ct. ___, 1374-75 (2020). Further, Congress recognized “the importance of quiet title to patent owners.” H.R. Rep. No. 112-98, at 48 (2011). LG’s ability to join cases more than a year after service of a complaint created precisely the “burdensome overlap” the AIA sought to avoid. The AIA did not intend for alleged infringers to have multiple bites at the apple, first in district court, and, almost two years later, by joining a third-party’s IPR.

The Panel’s mistake stems from its misreading of the second sentence of § 315(b). After stating that a “petition requesting the proceeding” is untimely if filed by a petitioner more than a year after that petitioner is served with a complaint, the statute clarifies that “[t]he time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).” 35 U.S.C. § 315(b) (emphasis added). The Panel took this sentence to mean that even a time-barred petition, if filed contemporaneously with a request for joinder, suddenly becomes “properly file[d]” under § 315(c), even though that sentence in § 315(b) applies only to the IPR petition itself. That is an incorrect reading of the statute.

Section 315(b) explicitly references a “request for joinder,” *i.e.*, a separate motion that is distinct from the petition itself. *See* 37 C.F.R. § 42.122 (stating a request for joinder “must be filed, as a motion.”); 37 C.F.R. § 42.22 (noting requirements of each “petition or motion”) (emphasis added). In referring to joinder in 315(b), Congress intentionally did not refer to the “petition,” despite using it in the previous sentence, underscoring that the second sentence does not also refer to the petition. *See Russello v. United States*, 464 U.S. 16, 23 (1983). The Panel ignored this key distinction, and so undermined Congressional intent. *Cf. Gallardo v. Marstiller*, 596 U.S. 420, 431 (2022) (“[W]e must give effect to, not nullify, Congress’ choice to include limiting language in some provisions but not others[.]”).

Notably, Congress could easily have explicitly allowed even untimely petitions to serve as a predicate for a motion for joinder, simply by removing the word “properly” in § 315(c). But it did not do so. The Panel thus ran “afoul of the ‘cardinal principle’ of interpretation that courts ‘must give effect, if possible, to every clause and word of a statute.’” *Loughrin v. United States*, 573 U.S. 351, 358 (2014) (quoting *Williams v. Taylor*, 529 U.S. 362, 404 (2000)). Thomas M. Cooley, *A Treatise on the Constitutional Limitations Which Rest upon the Legislative Power of the States of the American Union* 58 (1868) (“one part is not to be allowed to defeat another, if by any reasonable construction the two can be made to stand together.”). These words [about the time-bar] cannot be meaningless, else they would not have been used.” *United States v. Butler*, 297 U.S. 1, 65 (1936) (Roberts, J.).

This interpretation is supported by good reason and common sense. Statutes of limitations are “fundamental to a well-ordered judicial system,” *Artis v. District of Columbia*, 583 U.S. 71, 91 (2018) (quotation marks omitted), and “generally serve[] the interests of all concerned,” *United States v. Briggs*, 141 S. Ct. 467, 471 (2020). The unfettered ability to indefinitely join and commandeer IPRs deprives patent holders of their right to quiet title. *Leachman v. Beech Aircraft Corp.*, 694 F.2d 1301, 1309 (D.C. Cir. 1982). The plain text of § 315(c) provides patent holders with potential repose. By nullifying this time bar, the Panel has turned the IPR

process into a never-ending story—that is—until the joined petitioner gets a favorable result.

The Supreme Court decision in *Thryv*, 140 S. Ct. ___, does not support a different conclusion. The Supreme Court in *Thryv* held that the AIA bars judicial review of a decision on whether to institute *inter partes* review of a patent, based on the application of the one-year bar in 35 U.S.C. 315(b). The Supreme Court’s *dicta* in *Thryv* (stating that “the § 315(b)-barred party can join a proceeding initiated by another petitioner,” 140 S. Ct. at 1374) is inapposite. Such *dicta* is not binding, especially when “more complete argument demonstrate[s] that the *dicta* is not correct.” *Kirtsaeng v. John Wiley & Sons, Inc.*, 568 U.S. 519, 548 (2013). Although *Thryv*’s *dicta* is not binding, lower courts often “unabashedly defer to Supreme Court *dicta*.” Randy J. Kozel, *The Scope of Precedent*, 113 Mich. L. Rev. 179, 182 (2014).

Indeed, the Federal Circuit has relied on that *dicta* in a pivotal case allowing joinder from a party who filed an “otherwise * * * time-barred” petition. *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1328, 1334 (Fed. Cir. 2020). But *Thryv* did not hold that otherwise time-barred parties could join an existing *inter partes* review, and its reasoning is consistent with the position that time-barred petitioners cannot join a properly instituted *inter partes* review. First, *Thryv*’s holding, regarding § 314(d), is not applicable here. Second, *Thryv* reasoned that *post hoc* judicial review of § 315(b)’s time bar would undermine the ability of the PTAB

to “weed out bad patent claims efficiently.” 140 S. Ct. at 1374. But joinder, unlike instituting a review, is not necessary to weed out bad claims; a timely petitioner can fully proceed on the merits. Preventing untimely joinder would simply avoid costly overlapping litigation without interfering with the PTAB’s work. Congress recognized the importance of weeding out bad patents, but also recognized the needs for patent holders’ right to repose and prevent wasteful overlapping litigation and serial abuse of the patent system. H.R. Rep. No. 112-98 (2011), at 48. Those goals are furthered by enforcing the plain text of § 315(c), without any commensurate loss in the ability to challenge bad patents. This is also reflected in the legislative history of § 315, which makes clear that the one-year bar was an intentional compromise balancing the interests of patent owners and petitioners. *See, e.g.*, 157 Cong. Rec. S5402, S5429 (Sept. 8, 2011).

Notably, the Panel completely failed to address these issues and improperly dismissed CyWee’s arguments based on §§ 315(b) and (c) in passing without analysis. Dkt. 81 at 8-9.

2. Allowing Untimely Parties to Join Existing *Inter Partes* Review Encourages Abusive and Wasteful Litigation

Numerous instances demonstrate the pernicious effect of the joinder loophole. In the *VirnetX* matter, Apple was sued in 2010, but litigation continues thirteen years later. Even though time-barred through a district court case Apple lost, Apple joined another’s IPR, even after its own petition was not instituted. Apple thus got the

benefit of multiple hearings, full trials, and several appeals. Pet. 8–10. *See VirnetX Inc. v. Apple Inc.*, No. 6:12-CV-00855-RWS (E.D. Tex.) and related appeals and IPRs.

Numerous other examples exist of large, well-funded petitioners using the loophole to prolong and exacerbate the costs of litigation. These include: *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper No. 102, at 9 (P.T.A.B. Oct. 4, 2022) (“OpenSky Order”); *Patent Quality Assurance, LLC v. VLSI Tech. LLC*, IPR2021-01229, Paper No. 102, at 53 (P.T.A.B. Dec. 22, 2022); *Netflix, Inc. v. Convergent Media Solutions, LLC*, IPR2016-01814, Paper No. 14 (P.T.A.B. May 10, 2017); *AT&T Servs., Inc. v. Convergent Media Sols., LLC*, IPR2017-01237, Paper No. 9 (P.T.A.B. May 3, 2017); *Mylan Pharmaceuticals Inc. v. Research Corp. Technologies, Inc.*, 914 F.3d 1366, 1373 (Fed. Cir. 2019) (dragging out litigation); *Palo Alto Networks, Inc. v. Centripetal Networks, Inc.*, IPR2022-00182, Paper No. 39 (P.T.A.B. Jan. 4, 2023); *ZTE Corp. v. Cellular Commc’ns Equip.*, IPR2017-01079, Paper No. 10 (P.T.A.B. Oct. 4, 2017); *Aurobindo Pharma USA, Inc. v. AstraZeneca AB*, IPR2016-01117, Paper No. 12 (P.T.A.B. Oct. 21, 2016); *Qualcomm Inc. v. Bandspeed, Inc.*, IPR2015-00314, Paper No. 21 (P.T.A.B. Nov. 16, 2015); *Zhongshan Broad Ocean Motor Co., Ltd. v. Nidec Motor Corp.*, IPR2015-00762, Paper No. 16 (P.T.A.B. Oct. 5, 2015); *Mylan Pharmaceuticals Inc., v. Janssen Oncology, Inc.*, IPR2016-01332, Paper No. 21 (P.T.A.B. Jan. 10, 2017)

(ten(!) additional time-barred parties moved for joinder); *Actavis Laboratories FL, Inc. v. Janssen Oncology, Inc.*, IPR2017-00853, Paper No. 19 (P.T.A.B. Apr. 12, 2017).

Joinder abuse is commonplace and pernicious. Even the threat of the sheer number of belated joinder motions deters patent holders from pursuing meritorious claims because each additional party presents additional expenses and efforts.

B. Even If Joined, Under Binding Supreme Court Precedents, LG Should Be Held To Its Voluntarily Adopted Passive Role

1. LG made Numerous Strong Concessions To Gain Joinder

LG made numerous concessions to gain joinder as “understudy.” It explicitly promised that “the proposed joinder will neither unduly complicate the ZTE IPR nor delay its schedule.” Appx5453; *see also* Appx5453-5454; Appx5454 (“[LG] will assume the primary role only if ZTE ceases to participate in the IPR”); Appx5456 (“[LG] shall not . . . raise any new grounds . . . or introduce any argument or discovery.”); and Appx5458. As APJ Boucher noted in his dissent: “no one asked LGE to make such a strong and unilateral concession; it voluntarily chose to do so, presumably to increase its chances of participating in the proceeding despite the statutory time bar against it.” Appx1446. Most critically, ZTE never stopped participating.

2. Binding Supreme Court Precedent Requires That LG Be Held To Its Prior Position

LG's blatant about-face violated Supreme Court precedents by (1) ignoring the positions taken by original Petitioner ZTE in violation of *Taylor v. Sturgell*, 553 U.S. 880 (2008), and (2) reneging on the explicit covenants it made to secure joinder in violation of *New Hampshire v. Maine*, 532 U.S. 742 (2001).

Taylor specifically requires that a “person who agrees to be bound by the determination of issues in an action between others is bound in accordance with the terms of his agreement.” *Taylor*, 553 U.S. at 893-94. Therefore, LG —by its own agreement—is bound to the positions taken by ZTE because it was “adequately represented by someone with the same interests who [wa]s a party.” *Id.*; see also 77 Fed. Reg. 157 (August 14, 2012) at 48617 (*citing Taylor*). This is particularly true here where the Board expressly noted that “ZTE remains an active participant with respect to ZTE’s and LG’s joint challenge to the original claims.” *Id.* LG became ZTE’s privy when it ceded control of the IPR to ZTE, and thus became bound by ZTE’s decisions—all of them. 77 Fed. Reg. 157, at 48617 (Aug. 14, 2012); 553 U.S. at 895. LG must therefore be so bound because it was “adequately represented by someone with the same interests who [wa]s a party.” *Taylor*, 553 U.S. at 896 (*citing Richards v. Jefferson Cnty., Ala.*, 517 U.S. 793, 798 (1996)). If a time-barred party can simply commandeer an existing IPR because it does not agree with the strategic

choices of a still active original IRP petitioner, there is no limit to a time-barred joined party's participation.

New Hampshire prevents parties like LG from playing fast and loose with the proceedings to suit the exigencies of their self-interest. *New Hampshire v. Maine*, 532 U.S. 742 (2001). This doctrine serves to preserve the integrity of the judicial process by prohibiting parties from deliberately changing positions as best serves that party at a given time. LG meets the three prong test of *New Hampshire* (which the Board adopted, *see, e.g., Unified Patents Inc. v. Textile Computer Sys., Inc.*, No. IPR2017-00296, 2018 WL 2298307, at *4 (PTAB, May 18, 2018) (*citing New Hampshire to hold Petitioner to a prior inconsistent position*).

First, LG's voluntary assumption of the understudy role is inconsistent with its request for active participation, as APJ Boucher recognized. Appx1446. Second, the Board and CyWee explicitly relied on LG's position. Appx5454; Appx1301. Third, LG's about-face provided a grossly unfair advantage by absolving it of its failure to file an IPR within the statutory time limit set by § 315(b).

3. The Panel Ignored Other Federal Circuit And Board Decisions

There is no precedent to allowing LG's active participation to the extent allowed here. First, the history of § 315 makes clear that the one-year bar was an intentional compromise balancing the interests of patent owners and petitioners. *See, e.g.,* 157 Cong. Rec. S5402, S5429 (Sept. 8, 2011). A contrary interpretation

would allow time-barred parties to simply join and commandeer an existing IPR, as LG has done here, thereby rendering the time bar meaningless.

Second, this Court’s jurisprudence underscores that the time-barred joining petitioner “could not have raised with its joinder any additional invalidity challenges.” *Network-1 Techs., Inc. v. Hewlett-Packard Co.*, 981 F.3d 1015, 1027 (Fed. Cir. 2020). In *Networks-1*, time-barred HP was allowed to join only after it relinquished the additional issues it had attempted to introduce, and instead assumed a passive understudy role. *Id.* (denying first joinder motion raising additional issues; granting second joinder motion as passive understudy). Similarly, this Court has found that joinder of a party under § 315(c) “does not authorize the joined party to bring new issues . . . into the existing proceeding.” *Facebook*, 973 F.3d at 1335.

Third, LG intentionally and explicitly agreed to take an understudy role in order to secure joinder. Appx5455. LG consciously assumed the risk that it might disagree with ZTE’s decisions as to which arguments to assert and which to forego. This is precisely the type of “strategy choice” that this Court has confirmed that parties must live by after the fact. *Id.* at 1338.

Indeed, the Board’s own precedent is in direct contravention to its decision in this matter. That precedent specifically denies joinder motions from *non-time barred* petitioners who would not agree to take a “silent understudy” role, *see, e.g., Famy Care Limited v. Allergan, Inc.*, IPR2017-00566, -00567, -00568, -00569, and

-00570, Paper 12 (Jul. 12, 2017); and IPR2017-00571, Paper 13 (Jul. 12, 2017); routinely limits joining petitioners to an understudy role, *even when the primary petitioner has already settled and is no longer participating in the IPR, see, e.g., Major Data UAB v. Bright Data Ltd. f/k/a Luminati Networks Ltd.*, IPR2022-00916, Paper 14 at 6 (Jul. 29, 2022) (the Board denied joinder because although “[joining] Petitioner has agreed to an ‘understudy’ role, . . . [the original Petitioner] to be joined, has been terminated from that proceeding due to a settlement. Therefore, Petitioner would not be acting in the role of an understudy but would immediately assume the leading role if joinder were granted.”); and denies joinder when a “Petitioner provides no explanation for not filing for review when it could have earlier done so in the one-year window,” *Code200, UAB et al v. Bright Data Ltd.*, IPR2021-01503, Paper 13 (Mar. 14, 2022).

LG’s participation in this IPR should therefore be limited to the understudy role to primary actively participating petitioner ZTE—even when LG does not like those decisions at the eleventh hour, as in regard to ZTE’s position regarding the revised motion to amend.

C. *En Banc* Review Is Appropriate Because The Panel Misapprehended And Ignored Binding Supreme Court Precedents

This important matter should not be decided by a roll of the dice, unmoored from § 315(c) and Supreme Court precedent. Unquestionably, decisionmakers are

split, rendering *en banc* review necessary. CyWee’s original favorable opinion (IPR2019-00143, Paper 43 (denying LG participation)) was overturned by a split panel decision, with APJ Boucher dissenting (*Id.*, Paper 50), allowing an unprecedented expansion of LG’s role to raise new issues and new art that ZTE had intentionally foregone. This only encourages frequent IPR uses like LG to keep pushing the limits—a viable concern Justice Gorsuch anticipated in *Arthrex*. 141 S. Ct., at 1993 (Gorsuch dissenting).

Even recently retired Judge O’Malley commented about these travesties:

[T]he statute does say that the time-bar doesn’t apply to joinder, but if the party that’s time-barred then is the only man left standing, if the other party either settles out or . . . is sanctioned out, then the joined person, . . . they don’t become all the sudden not time-barred. They should not be allowed to stay. . . I frankly don’t think they should be allowed to participate, but that is a separate question.

Hon. Kathleen O’Malley (CAFC, ret.), *Can the PTAB Be Fixed? Three Perspectives on Institution Practice*, available at <https://www.youtube.com/watch?v=-8AP8ekR3Ds>. Thus, this issue is ripe for *en banc* review.

III. CONCLUSION

For the foregoing reasons, Panel rehearing or rehearing *en banc* is necessary and appropriate to address points of fact and law overlooked or misapprehended by the Panel. LG failed to properly file a petition under Section 315(b) and was therefore ineligible to be joined as a party. Even if this failure is excused, at a minimum, LG should be held to its voluntarily assumed passive understudy role.

Dated: February 23, 2024

Respectfully submitted,

/s/ Jay P. Kesan

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**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

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Case Number: 2021-1855

Short Case Caption: CyWee Group Ltd. v. ZTE (USA), Inc. and LG Electronics, Inc.

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