

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC., and
SAMSUNG TELECOMMUNICATIONS AMERICA, LLC,
Petitioner,

v.

ARENDI S.A.R.L.,
Patent Owner.

Case IPR2014-01144
Patent 7,496,854 B2

Before HOWARD B. BLANKENSHIP, SALLY C. MEDLEY, and
TREVOR M. JEFFERSON, *Administrative Patent Judges*.

JEFFERSON, *Administrative Patent Judge*.

DECISION
Denying *Inter Partes* Review and Joinder
37 C.F.R. §§ 42.108 and 42.122(b)

I. INTRODUCTION

A. Background

Samsung Electronics Co. Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (collectively, “Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–12 and 36–49 of U.S. Patent No. 7,496,854 B2 (Ex. 1101, “the ’854 patent”) under 35 U.S.C. §§ 311–319. Pet 1. Petitioner also filed a motion for joinder (Paper 3, “Mot.”), seeking to join with *Apple Inc. v. Arendi S.A.R.L.*, Case IPR2014-00207 (PTAB) (“IPR2014-00207”).

Arendi S.A.R.L. (“Patent Owner”) filed an Opposition to Petitioner’s motion for joinder (Paper 7, “Opp.”). Per our Order setting an expedited date for filing the Preliminary Response (Paper 9, “Order”), Patent Owner filed a Preliminary Response (Paper 10, “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314.

For the reasons set forth below, we deny Petitioner’s motion for joinder and do not institute an *inter partes* review as to the challenged claims of the ’854 patent.

B. Related Matters

Patent Owner sued Petitioner for infringement of the ’854 patent in *Arendi S.A.R.L. v. Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC*, 1:2012-cv-01598 (D. Del.). Pet. 1; Paper 5, 3. The ’854 patent is also subject to *inter partes* review in *Apple Inc. v. Arendi S.A.R.L.*, Case IPR2014-00206 (PTAB) and IPR2014-00207. Pet. 1; Paper 5, 3.

Petitioner also filed a Petition for *inter partes* review of the '854 patent in IPR2014-01143. Paper 5, 3.

C. References Relied Upon

Petitioner relies upon the following prior art references (Pet. 4):

References	Exhibit
U.S. Patent No. 6,085,206 (“Domini”)	Ex. 1104
U.S. Patent No. 6,377,965 (“Hachamovitch”)	Ex. 1105

D. The Alleged Grounds of Unpatentability

Petitioner contends that the challenged claims are unpatentable based on the following grounds (Pet. 4):

References	Basis	Claims Challenged
Domini	§ 102(e)	1–12, 36–38, 40–45, and 49
Hachamovitch	§ 102(e)	1–12 and 36–49
Hachamovitch	§ 103(a)	3–5, 9–11, 38–41, and 45–48

II. ANALYSIS

A. Motion for Joinder

We first address Petitioner’s Motion for Joinder under 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) as a party to IPR2014-00207. Petitioner timely filed its motion for joinder within one month of the institution of *inter partes* review in IPR2014-00207. *See* 37 C.F.R. § 42.122(b).

The standard for joinder of parties in related review proceedings is set forth in 35 U.S.C. § 315(c), which provides:

(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.

Although 35 U.S.C. § 315(b) bars *inter partes* review when a petition is filed more than one year after the petitioner (or the petitioner's real party-in-interest or privy) is served with a complaint alleging infringement of the patent (*see* 37 C.F.R. § 42.101(b)), the one-year time bar does not apply to a request for joinder. 35 U.S.C. § 315(b) (stating that "[t]he time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c)" of 35 U.S.C. § 315); 37 C.F.R. § 42.122(b).

In the present case, Petitioner was served with a complaint asserting infringement of the '854 patent more than one year prior to filing the Petition in this proceeding. Mot. 2. Thus, absent joinder of this proceeding with IPR2014-00207, the Petition would be barred.

As a moving party, Petitioner has the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b). 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) specifically address how briefing and discovery may be simplified. *See e.g.*, *Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15); FAQ H5 on the Board's website at <http://www.uspto.gov/ip/boards/bpai/prps.jsp>.

Petitioner's motion asserts that joinder with IPR2014-00207 is appropriate because the instant Petition "involves the same patent, the same claims, the same

prior art, and the same single instituted ground (the Domini Ground)” as involved in IPR2014-00207. Mot. 6. Petitioner also submits that the claim charts in the instant Petition are “substantially identical” to the claim charts contained in the IPR2014-00207 Petition with respect to the Domini ground of unpatentability. Mot. 3, 6. Petitioner submits, further, that the instant Petition “adopts the reasoning and rationale of the Board” and the IPR2014-00207 Petition with respect to the Domini ground. Mot. 6. Petitioner alleges that it presents no new issues that might complicate or delay the IPR2014-00207 proceeding. *Id.*

Petitioner’s motion for joinder fails to specify the differences between its Petition and the Petition in IPR2014-00207. Petitioner also fails to state what is meant by “substantially identical” claim charts to those in the IPR2014-00207 Petition. *See* Mot. 3, 6. Despite Petitioner’s allegations that no new issues are presented in its Petition, the Petition relies on the testimony of Dr. Paul Clark (Ex. 1107), which introduces argument and evidence that was not presented in IPR2014-00207 (Pet. 5–9, 12–14). Opp. 3–4. Thus, joinder of the present Petition with IPR2014-00207 would introduce new evidence and argument into the joint proceeding.

Petitioner’s motion makes no specific changes or suggestions regarding the schedule in IPR2014-00207. Petitioner alleges that “there appears to be no discernable impact on the trial schedule for” IPR2014-00207 because of the “specific ways” Petitioner proposes to simplify briefing and discovery. Mot. 8. Petitioner fails to set forth how briefing and discovery are simplified, other than suggesting seven additional pages be allotted to Petitioner and Patent Owner to address separate issues. *Id.* at 8–9. In addition, the cases Petitioner relies on to support its proposed seven additional pages for briefing did not introduce a new expert or arguments into the proceeding. *See* Mot. 9; Opp. 3 n.4, 4–5 (discussing

Dell Inc. v. Network-1 Security Solutions, Inc., Case IPR2013-00385 (PTAB July 29, 2013) (Paper 17) and *Motorola Mobility LLC v. SoftView LLC*, Case IPR2013-00256 (PTAB June 20, 2013) (Paper 10)).

Petitioner also states that it will work with the petitioner in IPR2014-00207 to “coordinate on expert testimony to minimize redundancy” (Mot. 9) and “to manage the questioning at depositions, and presentations at the hearing, to manage within the time normally allotted, and to avoid redundancy” (Mot. 8). Petitioner is silent as to whether the petitioner in IPR2014-00207 has agreed to work together or supports Petitioner’s proposed additional pages for briefing.

Petitioner indicates that “absent joinder, the joint stipulation and corresponding stay ordered [in the related District Court action] will preclude Petitioner from raising in the District Court an invalidity challenge based on the Domini Ground instituted in [IPR2014-00207].” Mot. 6. Petitioner has not provided a supporting exhibit containing the terms of “the joint stipulation and corresponding stay.” Petitioner has not demonstrated sufficiently that the circumstances of this case support joinder.

In addition, Petitioner was served with a complaint by Patent Owner alleging infringement of the ’854 patent on December 4, 2012. Prelim. Resp. 1 (citing Ex. 2001 (Complaint); Ex. 2002 (Proof of Service)). Assuming that Petitioner was not served with a complaint based on alleged infringement of the patent earlier than December 4, 2012, Petitioner could have filed a petition for *inter partes* review of the ’854 patent, prior to the expiration of the one-year time under 35 U.S.C. § 315(b), but did not do so.

Petitioner submits that it is presenting declaration evidence from its own expert “in the event that the petitioners in [IPR2014-00207] settle with the patent owner, and terminate out of the joined proceeding prior to a final written decision.”

Mot. 6 n.3, 8. Petitioner does not indicate, however, why another expert might be required in the event of settlement by the petitioner in IPR2014-00207. Petitioner argues, further, that it is submitting declaration evidence from its own expert “to present non-redundant rationale further supporting the instituted ground.” *Id.* Petitioner does not explain what might constitute “non-redundant rationale,” nor does it indicate why such may be needed with respect to IPR2014-00207.

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, we find that Petitioner has not met its burden to show that 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 ’854 patent more than one year prior to the date of filing of the instant Petition. Mot. 2. Accordingly, in view of the denial of the requested relief of

joinder with IPR2014-00207, institution of an *inter partes* review as requested by Petitioner is barred by statute. 35 U.S.C. § 315(b); *see* 37 C.F.R. § 42.101(b).

III. CONCLUSION

For the foregoing reasons, we deny Petitioner's motion for joinder. Because Petitioner is barred under 35 U.S.C. § 315(b) from *inter partes* review of the '854 patent, we do not institute review as to any of the challenged claims.

IV. ORDER

For the reasons given, it is
ORDERED that Petitioner's Motion for Joinder is denied; and
FURTHER ORDERED that the Petition is denied as to all challenged claims and all grounds and that no trial is instituted.

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