

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC. AND
SAMSUNG ELECTRONICS CO., LTD.,
Petitioner

v.

SMARTFLASH LLC,
Patent Owner

Case CBM2015-00059
Patent 8,336,772

**PETITIONER'S MOTION FOR JOINDER
UNDER 35 U.S.C. § 325(c) AND 27 C.F.R. § 42.222(b)**

I. RELIEF REQUESTED

Samsung Electronics America, Inc. and Samsung Electronics Co., Ltd.

(“Petitioner” or “Samsung”) hereby moves for joinder, pursuant to 35 U.S.C. § 325(c) and 37 C.F.R. § 42.222(b), of its earlier-filed CBM2015-00059 Petition (“Samsung Petition”) for Covered Business Method (“CBM”) review of U.S. Patent No. 8,336,772 (“the ’772 Patent”) with each of the CBM reviews CBM2015-00031, 00032, and 00033 (hereinafter jointly referred to as the “Apple CBM Proceedings”), which were instituted by the Board on May 28, 2015. *See* CBM2015-00031, 00032, and 00033, Pap. 11.

Joinder is appropriate because, among other reasons discussed in Section III below, it will promote efficient resolution of the validity of the ’772 Patent. The Board has consolidated the schedules of the Apple CBM Proceedings, since each of those Proceedings challenge a subset of the ’772 Patent claims under only 35 U.S.C. § 101. *See* CBM2015-00031, 00032, and 00033, Pap. 11. As explained in more detail below, the Samsung Petition is similarly limited to 35 U.S.C. § 101, and it challenges fewer than all claims collectively challenged in the Apple CBM Proceedings. Thus, this case is ideal for joinder, as joinder could be granted without introducing any new grounds against any new claims.

In fact, because the Apple CBM Proceedings are at an early stage, joinder would also have, at most, a minimal impact on the consolidated schedules of the

proceedings.

II. STATEMENT OF MATERIAL FACTS

1. On November 25, 2014, Apple filed three petitions for CBM review of the '772 Patent ("Apple Petitions"). As a whole, these three petitions asserted grounds of unpatentability of claims 1, 5, 8, 10, 14, 19, 22, 25, 26, 30, and 32 of the '772 Patent under each of 35 U.S.C. §§ 101 and 103.

2. On March 6, 2015, Patent Owner filed its preliminary responses in the Apple CBM Proceedings.

3. On May 28, 2015, the Board instituted CBM review in each of the Apple CBM Proceedings, determining that Apple had shown that it is more likely than not that claims 1, 5, 8, 10, 14, 19, 22, 25, 26, 30, and 32 are invalid under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. *See* CBM2015-00031, 00032, 00033, Pap. 11. The Board declined to institute Apple's proposed grounds of rejection under 35 U.S.C. § 103. *See id.*

4. On January 15, 2015, Samsung filed the Samsung Petition for review of the '772 Patent. The Samsung Petition asserted that claims 5, 10, 14, 26, and 32 of the '772 Patent are invalid under 35 U.S.C. § 101. CBM 2015-00059, Pap. 2.

5. On May 11, 2015, Patent Owner filed its preliminary response in CBM2015-00059.

6. As the table below indicates, the claims challenged in the Samsung

Petition are only a subset of the claims challenged in each of the three Apple CBM Proceedings, making it possible to comprehensively join grounds proposed by Samsung with grounds proposed by Apple by joining the Samsung Petition to the Apple CBM Challenges, with claims divided among the instituted proceedings in the manner set forth by the Apple Petitions.

| | CBM2015-00031 | CBM2015-00032 | CBM2015-00033 |
|--|-----------------|----------------|--------------------|
| Claims challenged under 35 U.S.C. § 101 in Apple CBM Proceedings | 1, 5, 8, and 10 | 14, 19, and 22 | 25, 26, 30, and 32 |
| Claims challenged under 35 U.S.C. § 101 in Samsung Petition | 5 and 10 | 14 | 26 and 32 |

7. Based upon the institution date of May 28, 2015 for the Apple CBM Proceedings, the one-month-from-institution date under 37 C.F.R. § 42.222(b) falls on June 28, 2015, a Sunday. The present motion for joinder is therefore timely under 35 U.S.C. § 21(b)

III. DISCUSSION

The requested joinder will serve to secure the just, speedy, and inexpensive resolution of these proceedings, consistent with Congressional intent. Indeed, under 35 U.S.C. § 325(c), the Director was provided authority to consolidate review proceedings involving petitions challenging the same patent:

If more than 1 petition for a post-grant [or covered business method] review under this chapter is properly filed against the same patent and the Director determines that more than 1 of these petitions warrants the institution of a post-grant review under section 324, the Director may consolidate such reviews into a single post-grant [or covered business method] review.

Similarly, 37 C.F.R. § 42.222(b) provides that:

Joinder may be requested by a patent owner or petitioner. Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any post-grant [or covered business method] review for which joinder is requested.”

The Board has further provided that 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 of the existing proceeding; and (4) address specifically how briefing and discovery may be simplified. *See, e.g., Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (Apr. 24, 2013). These factors are addressed below

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