

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

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

Case IPR2014-01518
Patent 6,323,853 B1

Before MICHAEL R. ZECHER, NEIL T. POWELL, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and
Granting Petitioner's Motion for Joinder
37 C.F.R. §§ 42.108 and 42.122

I. INTRODUCTION

On September 19, 2014, Petitioner, Samsung Electronics Co., Ltd. (“Samsung”), filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–79 of U.S. Patent No. 6,323,853 B1 (“the ’853 patent,” Ex. 1001). Paper 1. Samsung filed its Petition along with a Motion for Joinder requesting that we join Samsung as a party with *Google Inc. v. Arendi S.A.R.L.*, Case IPR2014-00452 (“Google IPR”). Paper 3, “Samsung Mot.” We previously instituted an *inter partes* review in the Google IPR on August 20, 2014. *See* Google IPR, Paper 10 (“Google IPR Dec. to Inst.”). The Petition in this proceeding raises the same grounds of unpatentability over the same claims that we instituted in the Google IPR. *Compare* Google IPR Dec. to Inst., *with* Pet. 4, 16–46. Patent Owner, Arendi S.A.R.L. (“Arendi”), filed a Preliminary Response, which includes arguments opposing Samsung’s Motion for Joinder.¹ Paper 7, “Prelim. Resp.” We then authorized Samsung to file a Reply addressing Arendi’s arguments opposing Samsung’s Motion for Joinder. Paper 9, “Samsung Reply.” We have jurisdiction under 35 U.S.C. § 314.

¹ Pursuant to 37 C.F.R. § 42.25(a)(1), “[a]n opposition is due one month after service of the motion.” In this case, Samsung’s Motion for Joinder was served on September 19, 2014. Samsung Mot. 11 (Certificate of Service). Although Arendi did not file an Opposition to Samsung’s Motion for Joinder by October 19, 2014, it nonetheless included arguments opposing Samsung’s Motion for Joinder in its Preliminary Response filed on December 31, 2014. We exercise our discretion under 37 C.F.R. § 42.5(b) to waive the one month requirement for filing an opposition to a motion as set forth in 37 C.F.R. § 42.25(a)(1). As a result, we will consider the belated arguments opposing Samsung’s Motion for Joinder presented by Arendi in its Preliminary Response.

For the reasons discussed below, we institute an *inter partes* review of claims 1–79 of the ’853 patent and grant Samsung’s Motion for Joinder.

II. INSTITUTION OF INTER PARTES REVIEW

In the Google IPR, we instituted an *inter partes* review of claims 1–79 of the ’853 patent based on the following grounds of unpatentability:

(1) claims 1–9, 11, 13–29, 38–45, 57–64, 66, 68–75, 77, and 79 as unpatentable under 35 U.S.C. § 103(a) over Goodhand;² and (2) claims 6, 10, 12, 21, 27, 30–37, 42, 46–56, 61, 65, 67, 72, 76, and 78 as unpatentable under 35 U.S.C. § 103(a) over the combination of Goodhand and Padwick.³ Google IPR Dec. to Inst. 23. As we indicated previously, the Petition filed in this proceeding asserts the same grounds of unpatentability over the same claims. Pet. 4; *see also* Samsung Mot. 2 (“The Samsung petition . . . includes only the two grounds of unpatentability that were instituted in the Google IPR.”).

In the Preliminary Response filed in this proceeding, Arendi asserts that it presents new patentability arguments that were not considered previously in the Google IPR. *See* Prelim. Resp. 7. Despite Arendi’s assertion, we are not convinced that the arguments presented by Arendi in the Preliminary Response filed in the Google IPR differ substantially from the arguments presented in the Preliminary Response filed in this proceeding. Instead, upon reviewing both sets of arguments, we are unable to discern a notable difference.

² Goodhand et al, U.S. Patent No. 5,923,848, issued July 13, 1999 (Ex. 1003, “Goodhand”).

³ Gordon Padwick et al., USING MICROSOFT OUTLOOK 97 (Que® Corp. 1997) (Ex. 1004, “Padwick”).

For instance, in the Preliminary Response filed in this proceeding, Arendi presents the following arguments: (1) the broadest reasonable interpretation of “analyzing the document to determine if the first information is contained therein,” as recited in independent claim 1, must take into account the prosecution history of the ’853 patent, during which a clear disavowal of user text selection occurred (Prelim. Resp. 12–21); and (2) based on Arendi’s proposed construction, which was informed by the purported disclaimer discussed above, Goodhand does not teach the aforementioned limitation because it requires the user to identify text as the contact information to be searched by entering it in the “To” field of an e-mail template (*id.* at 21–25). These same arguments also were presented in the Preliminary Response filed in the Google IPR. *See* Google IPR, Paper 8 (Patent Owner Preliminary Response), 9–14 (prosecution history disclaimer), 23–27 (same claim construction applied). Therefore, for the same reasons discussed in the Decision to Institute filed in the Google IPR, the arguments presented by Arendi in the Preliminary Response filed in this proceeding are not persuasive. *See* Google IPR Dec. to Inst. 10, 13–15, 19.

Taking into account the arguments presented in the Preliminary Response filed in this proceeding, we conclude that the information presented in the Petition establishes that there is reasonable likelihood that Samsung will prevail in challenging claims 1–79 of the ’853 patent as unpatentable under 35 U.S.C. § 103(a). Pursuant to 35 U.S.C. § 314, we authorize an *inter partes* review to be instituted as to these claims of the ’853 patent based on the same grounds of unpatentability instituted in the Google IPR.

III. GRANTING SAMSUNG'S MOTION FOR JOINDER

Based on authority delegated to us by the Director, we have discretion to join an *inter partes* review with another *inter partes* review under 35 U.S.C. § 315(c). The regulatory provisions governing an *inter partes* review address the appropriate timeframe for filing a motion for joinder. 37 C.F.R. § 42.122(b) provides, in relevant part, “[a]ny request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested.”

The Petition, and the accompanying Motion for Joinder, were both filed on September 19, 2014. *See* Paper 4, 1. As such, Samsung’s Motion for Joinder was filed timely because joinder was requested no later than one month after August 20, 2014—the institution date of the Google IPR.

In its Motion for Joinder, Samsung contends that the Petition filed in this proceeding sets forth the same grounds and combinations of prior art, the same expert Declaration, and substantially the same arguments considered by the Board when instituting an *inter partes* review in the Google IPR. Samsung Mot. 2, 6. In response, Arendi contends that we should not exercise our discretion to join this proceeding with the Google IPR because it would disrupt the schedule in the Google IPR by introducing additional depositions and redundant filings, as well as require the parties to incur additional expenses. Prelim. Resp. 25–28.

In its Reply to Arendi’s arguments opposing Samsung’s Motion for Joinder, Samsung attempts to alleviate Arendi’s concerns by agreeing to take a limited understudy role in the Google IPR without a separate opportunity to participate actively, similar to the role undertaken by the Petitioners in *Sony Corp. of America v. Network-1 Security Solutions, Inc.*, Case IPR2013-

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.