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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

PATENT: 8,135,398

TRIAL NO: IPR2014-00557

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HALAL

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TITLE: METHOD AND  
APPARATUS FOR MULTIMEDIA  
COMMUNICATIONS WITH  
DIFFERENT USER TERMINALS

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**MOTION FOR JOINDER TO RELATED  
INTER PARTES REVIEW OF U.S. PATENT NO. 8,135,398  
(CASE NO. IPR2013-00571) UNDER 37 C.F.R. § 42.122(b)**

Motion for Joinder to Related Instituted *Inter Partes* Review of  
U.S. Patent No. 8,135,398 Under 37 C.F.R. § 42.122(b)

Petitioner Samsung Electronics Co., Ltd. (“Petitioner”) files this Motion for Joinder of the Petition for *Inter Partes* Review of Claims 58 and 63 of U.S. Patent No. 8,135,398 (the “Second ’398 Petition”) with the instituted *inter partes* review titled *Samsung Electronics v. Virginia Innovation Sciences, Inc.*, Case No. IPR2013-00571, pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b).

### **I. APPLICABLE RULE**

Petitioner relies on 37 C.F.R. § 42.122(b), which states:

*Request for joinder.* 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 *inter partes* review for which joinder is requested. The time period set forth in §42.101(b) shall not apply when the petition is accompanied by a request for joinder.

### **II. RELIEF REQUESTED**

Petitioner requests that the Second ’398 Petition be joined with IPR2013-00571.

### **III. STATEMENT OF MATERIAL FACTS**

1. On October 23, 2012, Petitioner was served with a complaint for infringement of U.S. Patent Nos. 7,899,492, 8,050,711, 8,145,268, 8,224,381, 7,957,733, and 8,135,398 (“the ’398 patent”).

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2. On September 5, 2013, Petitioner filed a Petition for *Inter Partes* Review challenging claims 15, 55, 57, 58 and 60-63 of the '398 patent (“the First '398 Petition”).

3. On March 6, 2014, a decision instituting *inter partes* review of claims 15, 55, 57, 60-62 of the '398 patent was entered in IPR2013-00571, now styled *Samsung Electronics v. Virginia Innovation Sciences, Inc.*, Case No. IPR2013-00571. In that same decision, the Board declined to institute *inter partes* review of claims 58 and 63.

4. Concurrently with this Motion for Joinder, Petitioner is filing its Second '398 Petition, challenging claims 58 and 63 of the '398 patent.

#### IV. ARGUMENT

The Board has authority under 35 U.S.C. § 315(c) to join a properly-filed second *inter partes* review petition to an instituted *inter partes* review proceeding. This Motion for Joinder is timely and the time periods set forth in 37 C.F.R. § 42.101(b) do not apply to the Second '398 Petition because it is accompanied by this Motion for Joinder. 37 C.F.R. § 42.122(b).

The Second '398 Petition involves the same parties, the same patent, overlapping claims, and the same prior art presented in the First '398 Petition submitted in IPR2013-00571. In the Second '398 Petition, Petitioner argues a

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single new ground for the unpatentability of claims 58 and 63, based in part on the Board's decision in Case No. IPR2013-00571. In the Second '398 Petition, Petitioner relies on the same three prior art references submitted with the First '398 Petition<sup>1</sup>, but is now asserting these three references in a different combination with respect to claims 58 and 63. Specifically, the First '398 Petition challenged claims 58 and 63 on the grounds of obviousness over Palin in view of Seaman. The Second '398 Petition challenges claims 58 and 63 on the grounds of obviousness over Karaoguz in view of Palin and Seaman. Joinder is particularly appropriate here because the Board instituted *inter partes* review in IPR2013-00571 based on grounds that include anticipation by Karaoguz of claims 15, 55 (from which claim 58 depends) and claims 15, 62 (from which claim 63 depends). Therefore, the Second '398 Petition is very closely related to IPR2013-00571.

Petitioner has shown good cause for joining this proceeding with IPR2013-00571. The two proceedings involve the same parties, the same patent,

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<sup>1</sup> The three references are: U.S. Patent No. 8,028,093 (“Karaoguz”); U.S. Patent No. 7,580,005 (“Palin”); and U.S. Patent Publication No. 2004/0223614 (“Seaman”).

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overlapping claims and overlapping prior art.<sup>2</sup> The declaration evidence submitted with the Second '398 Petition is from the same expert witness and substantially overlaps the declaration evidence in Case No. IPR2013-00571. Thus, joinder of two additional dependent claims will not unduly complicate these proceedings – in fact, joinder of the proceedings will simplify briefing and discovery and “secure the just, speedy, and inexpensive resolution” of these proceedings. *See* 37 C.F.R. § 42.1(b).

Joinder will not unduly delay the proceedings or otherwise prejudice Patent Owner in any discernable way. Petitioner has acted expeditiously in filing the Second '398 Petition concurrently with this joinder motion and informed the Board and the Patent Owner in a March 24, 2014 conference call in Case No. IPR2013-00571 that this filing was forthcoming. Indeed, Patent Owner itself has requested

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<sup>2</sup> Karaoguz and Palin are common to both Case No. IPR2013-00571 and the Second '398 Petition. Seaman was submitted with the First '398 Petition, but not relied on by the Board in its March 6, 2014 Decision instituting trial in Case No. IPR2013-00571. The Board did rely on Seaman, however, in instituting trials on the same day in the separate but related Case Nos. IPR2013-00569 and IPR2013-00570, which are assigned to the same PTAB panel and involve the same Patent Owner.

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