

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.

Petitioner

v.

VIRGINIA INNOVATION SCIENCES, INC.

Patent Owner

Case IPR2014-00557

Patent 8,135,398

**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION FOR
JOINER**

I. INTRODUCTION

Pursuant to the Order Authorizing Filing of Opposition to Motion for Joinder (Paper No. 4) entered by the PTAB on April 7, 2014, Patent Owner Virginia Innovation Sciences, Inc. ("Virginia Innovation Sciences") submits this Opposition and requests that Petitioner's Motion for Joinder ("Joinder Motion") be denied, for at least the reasons discussed below. Patent Owner does not waive its right to file a Preliminary Response in this proceeding, and intends to file its Preliminary Response within three months of the Notice of Filing Date (which has not been issued yet) set forth by 37 C.F.R. § 42.107(b) and the Office Patent Trial Practice Guide. (Federal Register / Vol. 77, No. 157, 48757.)

Petitioner, Samsung, does not demonstrate good cause for why the Board should exercise its discretion to join the late-filed IPR to IPR2013-00571. Samsung already has an active IPR instituted against U.S. Patent 8,135,398 ("the '398 patent"), but now tries again, 18 months after being served with a Complaint in concurrent litigation, to institute yet another IPR and join it to IPR2013-00571. Without any good cause shown, the Joinder Motion should be denied.

II. PROCEDURAL HISTORY

Virginia Innovation Sciences filed suit against Petitioner Samsung for infringement of the '398 patent in U.S. District Court for the Eastern District of Virginia on October 4, 2012, and served its Complaint on Samsung on October 23,

2012. Samsung filed a defective petition for *inter partes* review of the '398 patent on September 5, 2013 and a corrected petition on September 16, 2013. In the corrected petition, Samsung alleged that claims 15, 57-58, and 60-63 are anticipated and obvious based on art referred to as "Palin," "Karaoguz", and "Seaman," submitted as Exhibits 1002-1004, respectively, in IPR2013-00571. Samsung's Exhibit 1008 in IPR2013-00571 summarizes the application of the references:

Ground No.:	1	2	3	4
Prior Art:	Palin	Karaoguz	Palin+Karaoguz	Palin+Seaman
Claims				
15 (Indep.)	X	X	X	
57	X	X	X	
58				X
60	X		X	
61	X	X	X	
62	X	X	X	
63				X

(IPR2013-00571, Exh. 1008. See also, IPR2013-00571, Paper 14 at 7.)

The Board instituted review of claims 15, 57, and 60-62 on March 6, 2014, finding that Samsung had demonstrated a reasonable likelihood of succeeding in its

challenge of claims 15, 55, 57, 61 and 62 as allegedly anticipated by Karaoguz and its challenge of claims 15, 55, 57, and 60-62 as allegedly being rendered obvious by Palin in view of Karaoguz. (IPR2013-00571, Paper 14 at 15; 22.) The Board found that Samsung did not demonstrate a reasonable likelihood with respect to Claims 15, 55, 57, and 60-62 as allegedly anticipated by Palin and with respect to claims 58 and 63 as allegedly being rendered obvious by Palin combined with Seaman (IPR2013-00571, Paper 14 at 19; 23.)

Samsung now alleges that claims 15, 55, 58, 62, and 63 are render obvious by Karaoguz in view of Palin, and further in view of Seaman, as shown in Exhibit 1010 accompanying Samsung's late-filed IPR petition (reproduced below):

Prior Art:	Karaoguz + Palin+Seaman
Claims	
15 (Indep.)	X
55	X
58	X
62	X
63	X

(Exh. 1010.)

III. ARGUMENT

A. Joinder is at the Board's discretion

Joinder is at the Board's discretion. "[T]he 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...." 35 U.S.C. § 315(c). The Board is charged with securing the just, speedy, and inexpensive resolution of every proceeding, and has the discretion to join parties to ensure that objective is met. 37 C.F.R. §§ 42.1(b), 42.122. As the moving party, Petitioner has the burden of demonstrating that joinder is justified and that the Board should exercise its discretion. 37 C.F.R. § 42.20(c).

The Board should only grant joinder if the Petitioner demonstrates good cause. For example, if a patent owner asserts new claims in the co-pending litigation and the petitioner is "diligent and timely in filing the motion" for joinder after the changed circumstance, such changed circumstance and diligence may justify the exception (*e.g.*, to allow the new claims to be included in an IPR). *See, e.g.*, IPR2013-00109 Paper 15 at 4; *id.* at 3 (granting motion for joinder in part because "Petitioner proceeded expeditiously in filing a second Petition after learning that additional claims were being asserted by Patent Owner in concurrent district court litigation.") Patent Owner submits that if there is no justification for a petitioner's delay – *e.g.*, the petitioner simply delayed presenting additional

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