IN THE 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 No. IPR2014-01142
Patent No. 7,917,843

SAMSUNG'S REPLY TO ARENDI'S OPPOSITION TO MOTION FOR JOINDER UNDER 35 U.S.C. § 315(C) AND 37 C.F.R. §§ 42.22 AND 42.122(B)

The Board authorized Arendi to file "an opposition to the motion for joinder, ***not to exceed*** the page limit of the motion for joinder." Paper 6, p. 2 (emphasis added). Because Arendi's Opposition ***exceeds*** the page limit of Samsung's Motion for Joinder by four pages, the Board should strike the non-compliant Opposition, or, at a minimum, disregard the last four pages.

Arendi argues that "[b]y virtue of using Dr. Paul Clark instead of Dr. Daniel A. Menascé for its expert, the Samsung IPR includes evidence that is outside of the scope of the Apple IPR." Opposition, p. 8. However, the substantive issues in IPR2014-00208 would not be unduly complicated because joinder would not introduce any new claims or grounds of unpatentability. Moreover, neither 35 U.S.C. § 311 nor § 315(c) ***requires*** a petition in a joinder situation to be limited to ***identical*** issues, much less ***identical*** evidence. *See, e.g.,* IPR2013-00282 Paper 15, p. 4 (joinder granted where second petition introduced two ***new*** pieces of prior art ***evidence*** (emphasis added)). The proper question is the impact of any additional issues or evidence. The impact of Dr. Clark's declaration on the existing proceeding is demonstrably minimal for at least four reasons.

First, Arendi's own admissions and actions show that the impact of Dr. Clark's declaration at most is likely nothing more than a single day deposition of Dr. Clark, and can perhaps be avoided altogether based on the declaration's substantive similarity to that of Dr. Menascé. Arendi effectively concedes this point in asserting

in its Opposition in IPR2014-01143 and IPR2014-01144 that Dr. Clark's declarations in those proceedings are "redundant with the declaration of Dr. Menascé." Paper 7, p. 5 in each proceeding. The alleged "redundant" nature of Dr. Clark's declarations in the other two proceedings will correspondingly minimize any impact on Arendi in the present proceeding, and confirms there is sufficient time to complete the deposition of Dr. Clark in a single day, as with Dr. Menascé. *See* Opposition, p. 11; Paper 7, p. 5 in IPR2014-01143 and Paper 7, p. 5 in IPR2014-01144.

Second, contrary to Arendi's assertion on page 10, no additional testimony from Arendi's witnesses would be required. Samsung has agreed to a process with the petitioners ("Apple/Google") by which Apple/Google will ask questions first in any deposition of Arendi's expert(s), and Samsung would ask questions only if any time remained within the allotted timeframe. Thus, there will be very little if any additional testimony required.

Third, Arendi cannot be prejudiced by evidence it contends "falls outside the scope of *inter partes* review." Opposition, p. 5. Arendi contends that "Ground I relies upon the purported personal knowledge of Samsung's expert, Dr. Paul Clark." *Id.* If Arendi's contention is correct, then they have no need to depose Dr. Clark on the alleged impermissible testimony, and no prejudice arises. Arendi has a full and fair opportunity to present its arguments about any alleged improper ground in the Patent Owner Preliminary Response, a proposition with which Arendi apparently

agrees given its assertion that such a response will be filed by August 11, 2014. Opposition, pp. 2-3. Thus, the question of the "purported personal knowledge" of Dr. Clark goes not to prejudice from joinder, but to whether Samsung has demonstrated a reasonable likelihood of prevailing. *Id.*

Fourth, Samsung has agreed to a process with Apple/Google to file consolidated papers for which Apple/Google will have primary responsibility. With the exception of motions which do not involve Apple/Google, Samsung will limit individual filings solely to points of disagreement with Apple/Google, if any, or additional points not pertinent to the issues in Apple/Google's filings, if any. And any such filings will not exceed seven pages. Thus, there will be very little if any additional briefing papers for Arendi or the PTAB to review and act upon.

Finally, Arendi's argument about "exhibit numbering" is misplaced at best. In the cited *Arthrex* case (IPR2013-00632; Opposition, pp. 3, 12-13), the petitions in the two proceedings were filed by the ***same petitioner***, which is clearly not the case here. Samsung respectfully submits that should the Board request that its exhibits be renumbered to match those in the Apple/Google proceedings, it will do so.

Joinder to IPR2014-00208 will introduce no new grounds of unpatentability, and will not unduly complicate or delay that proceeding. Therefore, joinder is appropriate, and Samsung requests that its Motion be granted and trial instituted.

Date: August 11, 2014

Respectfully submitted,

By _____

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