

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC., and
SAMSUNG TELECOMMUNICATIONS AMERICA, LLC,
Petitioner,

v.

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

Case IPR2014-01142
Patent 7,917,843 B2

Before HOWARD B. BLANKENSHIP, SALLY C. MEDLEY, and
TREVOR M. JEFFERSON, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION

Denying *Inter Partes* Review and Joinder
37 C.F.R. §§ 42.108 and 42.122(b)

I. BACKGROUND

Samsung Electronics Co. Ltd., Samsung Electronics America, Inc.,
and Samsung Telecommunications America, LLC (collectively,

IPR2014-01142
Patent 7,917,843 B2

“Petitioner”) filed a petition requesting *inter partes* review of claims 1, 2, 8, 14–17, 20, 21, 23, 24, 30, 36–39, 42, and 43 of U.S. Patent No. 7,917,843 B2 (“the ’843 patent”) (Ex. 1001) under 35 U.S.C. §§ 311–319. Paper 1 (Petition, or “Pet.”). With the Petition, Petitioner filed a motion for joinder (Paper 3, “Mot.”), seeking to join with *Apple Inc. v. Arendi S.A.R.L.*, Case IPR2014-00208. Arendi S.A.R.L. (“Patent Owner”) filed a preliminary response (Paper 10, “Prelim. Resp.”), as permitted by 37 C.F.R. § 42.107, and an opposition to the motion for joinder (Paper 7, “Opp.”). Petitioner filed a reply to the motion for joinder. Paper 8, “Reply.” We have jurisdiction under 35 U.S.C. § 314.

For the reasons that follow, we deny the motion for joinder and do not institute an *inter partes* review as to any of the challenged claims of the ’843 patent.

Related Proceeding

According to Petitioner, the ’843 patent is involved in the following lawsuit: *Arendi S.A.R.L. v. Samsung Electronics Co.*, No. 12-1598 (D. Del.). Pet. 1. The ’843 patent has also been challenged in the following case: *Apple Inc. v. Arendi S.A.R.L.*, Case IPR2014–00208 (PTAB).

Prior Art

Pandit	US 5,859,636	Jan. 12, 1999	(Ex. 1005)
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Asserted Ground of Unpatentability

Petitioner asserts the following ground of unpatentability (Pet. 4):

Reference	Basis (35 U.S.C.)	Claims
Pandit	§ 103(a)	1, 2, 8, 14–17, 20, 21, 23, 24, 30, 36–39, 42, and 43

II. ANALYSIS

Decision on Motion for Joinder

Petitioner submits a motion for joinder, under 37 C.F.R. § 42.122, with IPR2014-00208. The Motion for Joinder was filed within one month after institution of a trial in IPR2014-00208, as required by 37 C.F.R. § 42.122(b).

The AIA permits joinder of parties in like review proceedings. The statutory provision governing joinder of *inter partes* review proceedings is 35 U.S.C. § 315(c), which provides:

(c) JOINDER.—If the Director institutes an inter partes review, the 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 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

35 U.S.C. § 315(b) bars institution of an *inter partes* review when the petition is filed more than one year after the petitioner (or the petitioner's real party-in-interest or privy) is served with a complaint alleging infringement of the patent. 35 U.S.C. § 315(b); 37 C.F.R. § 42.101(b).

However, the one-year time bar does not apply to a request for joinder. 35

U.S.C. § 315(b) (final sentence) (“The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).”); 37 C.F.R. § 42.122(b). Petitioner was served with a complaint asserting infringement of the ’843 patent more than one year prior to filing the Petition. Mot. 2. Thus, absent joinder of this proceeding with IPR2014-00208, the Petition would be barred.

As a moving party, Petitioner has the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b). 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 for the existing review; and (4) specifically address how briefing and discovery may be simplified. *See e.g., Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15); FAQ H5 on the Board’s website at <http://www.uspto.gov/ip/boards/bpai/prps.jsp>.

In its Motion, Petitioner asserts that joinder with IPR2014-00208 is appropriate because the instant Petition “involves the same patent, the same claims, the same prior art, and the same single instituted ground (the Pandit Ground)” as involved in IPR2014-00208. Mot. 5. Petitioner submits that the claim charts in the instant Petition are “substantially identical” to the claim charts contained in the IPR2014-00208 Petition with respect to the Pandit ground of unpatentability. *Id.* Petitioner submits, further, that the instant Petition “adopts the reasoning and rationale of the Board” and the IPR2014-00208 Petition such that no new issues are presented that might complicate or delay an existing proceeding. *Id.*

Petitioner in its Motion does not specify the differences in its Petition with respect to the Petition in IPR2014-00208. Nor does Petitioner indicate what it means by “substantially” identical claim charts. Further, arguments in the Petition (e.g., Pet. 22–23) rely on the testimony of Dr. Paul C. Clark (Ex. 1007), who did not offer testimony in IPR2014-00208, thus, introducing arguments that are not present in IPR2014-00208. This new evidence (and new arguments) would be introduced into a joint proceeding.

Petitioner in its Motion does not suggest any specific changes to the schedule in IPR2014-00208. Petitioner, instead, merely alleges that “there appears to be no discernable impact on the trial schedule” with respect to the other proceeding. Mot. 7. Nor does Petitioner set forth how briefing and discovery may be simplified, other than suggesting that it have seven additional pages for papers filed. *Id.* at 8. Petitioner, further, submits no evidence that the petitioner in IPR2014-00208 has agreed to, or will, “work together” with Petitioner “to manage the questioning at depositions, and presentations at the hearing, to manage within the time normally allotted, and to avoid redundancy.” *Id.*

Petitioner was served with a complaint by Patent Owner alleging infringement of the ’843 patent on December 4, 2012. Prelim. Resp. 9; Ex. 2002 (Complaint); Ex. 2003 (Proof of Service). Assuming that Petitioner was not served with a complaint based on alleged infringement of the patent earlier than December 4, 2012, Petitioner could have filed a petition for *inter partes* review of the ’843 patent, prior to the expiration of the one-year time under 35 U.S.C. § 315(b), but did not do so. Rather, Petitioner filed its Petition on July 11, 2014. Petitioner indicates that “absent joinder, the joint stipulation and corresponding stay” ordered in the related district court

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