
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD

Petitioner

v.

DSS TECHNOLOGY MANAGEMENT, INC.

Patent Owner

Case IPR2014-01493

U.S. Patent No. 5,652,084

Title: METHOD FOR REDUCED PITCH LITHOGRAPHY

Inter Partes Review No. IPR2014-01493

**PETITIONER'S MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c) AND
37 C.F.R. § 42.22 AND § 42.122(b)**

I. INTRODUCTION

Samsung Electronics Co., Ltd. (“Samsung”) has filed **IPR2014-01493** (“the Samsung IPR”) requesting *inter partes* review of U.S. Patent No. 5,652,084 (“the ’084 patent”) and hereby moves for joinder of the Samsung IPR with **IPR2014-01030** (“the TSMC IPR”), which was filed by Taiwan Semiconductor Manufacturing, Ltd. (“TSMC”) for the same patent, and which the Board instituted on December 31, 2014. In a scheduling conference call held on January 28, 2015 for the TSMC IPR, the Board authorized Samsung to file this motion by January 30, 2015.

The present motion for joinder was discussed by all parties during the scheduling conference call, and during the call, all parties—Samsung, TSMC, and DSS Technology Management, Inc. (“Patent Owner” or “DSS”)—agreed to having the two proceedings joined. The present motion is exactly consistent with what was discussed and agreed to on the conference call.

In support of its motion, Samsung stipulates and agrees to the following: (1) the joined proceeding will be limited to the same grounds upon which the Board has instituted review in the TSMC IPR, and Samsung will withdraw challenges set forth in the Samsung IPR based on additional grounds; (2) filing and discovery will be consolidated in the joined proceeding, with TSMC filing papers for both Samsung and TSMC as consolidated filings in accordance with the Board’s

established rules regarding page limits for a single Petitioner (except for motions that do not involve the other party—e.g., for TSMC to withdraw because of settlement); and (3) any cross-examination of any given witness produced by Patent Owner in the joined proceeding and any redirect of any given witness produced by Samsung or TSMC will be conducted within the timeframe normally allotted by the rules for one cross-examination or redirect examination. Further, because Samsung does not wish to prejudice TSMC or Patent Owner by delaying the TSMC IPR, Samsung's request for joinder and the aforementioned stipulations are expressly conditioned on the scheduling order for the TSMC IPR applying to the joined proceeding. And to ensure that this joinder request does not result in inefficient consumption of the Board's limited resources in the event TSMC settles, Samsung expressly conditions its request for joinder and the stipulations stated herein on Samsung having the ability to take over for TSMC and prosecute the IPR (and any appeals related thereto) without altering the scheduling order set forth in the TSMC IPR.

In short, joining the Samsung IPR with the TSMC IPR subject to these conditions and stipulations will raise no new issues and will streamline the proceedings, thereby reducing the costs and burdens on the parties and the Board. Indeed, TSMC and Patent Owner indicated they support this motion during the scheduling conference call for the TSMC IPR held on January 28, 2015.

Accordingly, Samsung respectfully requests that the Board grant its request to join the TSMC IPR.

II. BACKGROUND AND RELATED PROCEEDINGS

Patent Owner filed a complaint alleging infringement of the '084 patent in the United States District Court for the Eastern District of Texas against Samsung and TSMC¹ on March 10, 2014. *See DSS Tech. Mgmt., Inc. v. Taiwan Semiconductor Mfg. Co., Ltd., et al.*, Case No. 2-14-cv-00199 (E.D. Tex.). Both the Samsung defendants and the TSMC defendants subsequently waived service of the complaint and summons. The TSMC IPR was filed on June 24, 2014, and the Samsung IPR was filed on September 12, 2014, with a corrected petition filed on October 3, 2014. The Samsung IPR was accorded a filing date of September 12, 2014. IPR2014-01493, Paper 4, at 1. Thus, the Samsung IPR and TSMC IPR were both timely filed as prescribed by 35 U.S.C. § 315(b). Both the Samsung IPR and TSMC IPR challenged all claims (claims 1-16) of the '084 patent.

The TSMC IPR includes challenges based on one primary reference: Japanese Patent Appl. No. H04-71222 (“Jinbo”). On December 31, 2014, the Board instituted review of claims 1-8, 12, 15, and 16 as anticipated by Jinbo; claim 9 as obvious over Jinbo and U.S. Patent No. 4,931,351 (“McColgin”); and claims 10

¹ Several Samsung and TSMC entities as well as a third defendant, NEC Corporation of America, were also named in the complaint.

and 11 as obvious over Jinbo and U.S. Patent No. 4,548,688 (“Matthews”). IPR2014-01030, Paper 7, at 19. The first three challenges in Samsung’s IPR raise the same reference combinations against the same claims. *See* Corrected Petition for *Inter Parties* Review by Samsung Electronics Co. Ltd., IPR2014-01493, filed October 3, 2014, at 26-40. The Samsung IPR also includes challenges based on U.S. Patent No. 5,667,940 (“Hsue”) as a primary reference; however, in support of its joinder request, Samsung will agree to limit its challenges to the same grounds upon which the Board has instituted review in the TSMC IPR and will withdraw additional challenges set forth in the Samsung IPR.

On January 9, 2015, the defendants in the district court litigation filed a motion to stay pending the outcome of the TSMC IPR *inter partes* review. *See DSS Tech. Mgmt., Inc. v. Taiwan Semiconductor Mfg. Co., Ltd., et al.*, Case No. 2-14-cv-00199 (E.D. Tex.), Dkt. 109.

On January 28, 2015, a scheduling conference call was held for the TSMC IPR, during which counsel for Patent Owner and TSMC indicated they support this motion. The Board authorized Samsung to file this motion by January 30, 2015.

III. DISCUSSION

Samsung respectfully requests that the Board exercise its discretion to grant joinder of Samsung and TSMC IPR proceedings pursuant to 35 U.S.C. § 315(c), 37 C.F.R. § 42.22, and 37 C.F.R. § 42.122(b). Here, joinder is appropriate

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