

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
Patent 5,652,084

Before, JACQUELINE WRIGHT BONILLA, JO-ANNE M. KOKOSKI, and
KRISTINA M. KALAN *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and Grant of Motion for Joinder

37 C.F.R. § 42.108

37 C.F.R. § 42.122(b)

Introduction

Samsung Electronics Co., Inc. (“Samsung”) filed a Petition (“Petition”) for *inter partes* review of U.S. Patent No. 5,652,084 (Ex. 1001, “the ’084 Patent”), which Petition was accorded a filing date of September 12, 2014. Paper 1, Paper 4, *see also* Paper 7 (Corrected Petition for Inter Partes Review filed October 3, 2014).

On January 29, 2015, Samsung filed a Motion for Joinder (“Mot.”) to join this proceeding with *Taiwan Semiconductor Mfg. Co., Ltd. v. DSS Tech. Mgmt., Inc.*, Case IPR2014-01030. Paper 10. IPR2014-01030 concerns the same patent at issue here, namely, the ’084 Patent. We instituted trial in IPR2014-01030 on December 31, 2014. We have not yet instituted trial in IPR2014-01493.

Samsung indicates that Taiwan Semiconductor Manufacturing Company, Ltd. (“TSMC”) and DSS Technology Management, Inc. (“Patent Owner”) agree to have the two proceedings joined. Mot. 1. For the reasons below, we (1) institute an *inter partes* review on certain grounds asserted in the Petition, and (2) grant Samsung’s Motion for Joinder, subject to the conditions detailed herein.

Institution of Inter Partes Review

The Petition in IPR2014-01493 asserts the same grounds as those asserted in IPR2014-01030, and adds additional grounds based on U.S. Patent No. 5,667,940 (“Hsue”). Petition 26–60. In IPR2014-01030, we instituted trial on the following grounds: (1) claims 1–8, 12, 15, and 16 as anticipated by Japanese Patent Appl. No. H04-71222 (“Jinbo”); (2) claim 9 as obvious over Jinbo and U.S. Patent No. 4,931,351 (“McColgin”); and (3) claims 10 and 11 as obvious over Jinbo and U.S. Patent No. 4,548,688 (“Matthews”). Case IPR2014-01030, Paper 7 (PTAB December 31, 2014) at 19.

Samsung agrees to limit its Petition to the same grounds on which we instituted trial in IPR2014-01030; to withdraw its challenges to claims 13 and 14;

and to withdraw its challenges of claims 1–8, 12, 15, and 16 based on grounds other than those instituted in IPR2014-01030, i.e. grounds based on Hsue. Mot. 5–6. With respect to the grounds on which trial was instituted in IPR2014-01030, Patent Owner’s Preliminary Response in IPR2014-01493 (Paper 9) did not raise substantial additional arguments or present substantially different evidence than what we considered in the course of instituting trial on IPR2014-1030. In other words, institution of trial in IPR2014-01493 is based upon consideration of the same issues, arguments, and oppositions raised with respect to the IPR2014-01030.

In view of the similarity of the challenges in the Petition and the arguments in the Preliminary Response, and in view of Samsung’s agreement to limit its Petition to the same grounds on which we instituted trial in IPR2014-01030, we institute an *inter partes* review in this proceeding on the same grounds as those on which we instituted trial in IPR2014-01030. We do not institute an *inter partes* review on any other grounds.

Joinder of Inter Partes Reviews

An *inter partes* review may be joined with another *inter partes* review, subject to the provisions 35 U.S.C. § 315(c), which governs joinder of *inter partes* review proceedings:

(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.

As the moving party, Samsung bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder should: (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of

unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *See* Frequently Asked Question H5, <http://www.uspto.gov/patents-application-process/appealing-patent-decisions/trials/patent-review-processing-system-prps-0>.

Samsung requested authorization to file a motion for joinder on January 28, 2015, and, as authorized, filed its Motion on January 29, 2015. Papers 10 and 11. Both of those actions were taken within one month of the IPR2014-01030 trial institution date of December 31, 2014, as required by 37 C.F.R. § 42.122(b).

As noted above, in its Motion, Samsung agrees to limit its Petition to grounds upon which we instituted trial in IPR2014-01030. Mot. 5. Samsung agrees to consolidated filings and discovery with TSMC, wherein TSMC will submit the filings, and agrees to rely on the same expert as TSMC, Dr. Richard Blanchard. *Id.* at 6–7. Samsung agrees that any cross-examination of witnesses produced by Patent Owner will be conducted within the timeframe normally allotted by the rules for one party. *Id.* at 7. Samsung requests that, in the event of joinder, we proceed as outlined in the Scheduling Order in IPR2014-01030. *Id.* at 7–8. Samsung summarizes that joinder will provide reliability during the review process, and that Patent Owner will not be prejudiced by joining IPR2014-01493 to IPR2014-01030. *Id.* at 8–9.

We agree with Samsung that joinder would be appropriate under the circumstances. Based on the record before us, we institute an *inter partes* review in IPR2014-01493 and grant Samsung’s motion to join IPR2014-01493 to IPR2014-01030.

Order

Accordingly, it is

ORDERED that trial is instituted in IPR2014-01493 as to claims 1–12, 15,

and 16 of the '084 patent on the following grounds only:

1. Whether claims 1–8, 12, 15, and 16 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Jinbo;
2. Whether claim 9 is unpatentable under 35 U.S.C. § 103(a) as obvious over Jinbo and McColgin; and
3. Whether claims 10 and 11 are unpatentable under 35 U.S.C. § 103(a) as obvious over Jinbo and Matthews;

FURTHER ORDERED that the Samsung's Motion for Joinder is granted and that this proceeding is joined with IPR2014-01030;

FURTHER ORDERED that IPR2014-01493 is terminated under 37 C.F.R. § 42.72 and all further filings in the joined proceeding are to be made in IPR2014-01030;

FURTHER ORDERED that the Scheduling Order in IPR2014-01030 remains unchanged and applies to the joined proceeding;

FURTHER ORDERED that TSMC will file all papers in the joined proceeding jointly on behalf of TSMC and Samsung, except in the case of motions that do not involve the other party;

FURTHER ORDERED that the case caption in IPR2014-01030 shall be changed to reflect joinder with this proceeding in accordance with the attached example; and

FURTHER ORDERED that a copy of this Decision be entered into the file of IPR2014-01030.

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