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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

REMBRANDT WIRELESS TECHNOLOGIES, LP
Patent Owner

Case No. IPR2015-00114
Patent 8,023,580

**PATENT OWNER'S OPPOSITION TO MOTION FOR JOINDER TO
RELATED *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,023,580
(IPR2014-00518)**

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STATUTES

35 U.S.C. § 315(b)4, 6, 7, 11

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I. INTRODUCTION

Petitioner filed the present petition (“the ‘114 IPR”) for *inter partes* review more than a year after it was served with a complaint alleging infringement of the ‘580 patent. The request challenges claims 2, 19, 49, 52, 53, and 59 of the ‘580 patent, for which the Board previously denied institution in IPR2014-00518 (“the ‘518 IPR”), and is based on the same prior art that Petitioner unsuccessfully advanced in the ‘518 IPR.

Petitioner seeks to join this request with the ‘518 IPR, a proceeding to which it is already a party. The joinder petition, therefore, is fundamentally flawed, because 35 U.S.C. §315(c) does not permit a party to “join” a proceeding in which it is already a party. Moreover, the joinder request flies in the face of numerous decisions of the Board denying joinder under similar circumstances:

- *Medtronic, Inc. et al. v. Endotach LLC.*, IPR2014-00695, Paper 18 at 3 (PTAB Sept. 25, 2014) (“This case represents a ‘second bite at the apple’ for Petitioner, who has received the benefit of seeing our Decision to Institute in the prior case involving the same parties and patent claims.”)
- *Butamax Advanced Biofuels v. Gevo, Inc.*, IPR2014-00581, Paper 8 at 12-13 (PTAB Oct. 14, 2014) (“More significantly, we observe that the obviousness grounds asserted in the present Petition are expressly intended to squarely address[] the alleged deficiencies identified by the Board in the 539 IPR. In other words, the four obviousness grounds are ‘second bites at the apple,’ which use our prior decision to as a roadmap to remedy Butamax’s prior, deficient challenge.”)

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