

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

E-WATCH, INC. and E-WATCH CORPORATION,

Patent Owner.

Case IPR2015-00543
Patent 7,643,168 B2

Before JAMESON LEE, GREGG I. ANDERSON, and
MATHEW R. CLEMENTS, *Administrative Patent Judges*.

ANDERSON, *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., Ltd. and Samsung Electronics America, Inc. (“Samsung” or “Petitioner”) filed a Petition requesting *inter partes* review of U.S. Patent No. 7,643,168 B2 (Ex. 1001, “the ’168 patent”). Paper 1 (“Pet.”). Concurrently with its Petition, Petitioner filed a Motion for Joinder. Paper 3 (“Mot.”). The Motion for Joinder seeks to join this proceeding with *HTC Corp. v. e-Watch, Inc.*, IPR2014-00989 (hereinafter “HTC IPR”). Mot. 1. (“Mot.”). E-Watch, Inc. and e-Watch Corporation (“Patent Owner”) indicates that it does not oppose the Motion for Joinder. Paper 9. Patent Owner did not file a Preliminary Response.

Petitioner in the HTC IPR, HTC Corporation and HTC America, Inc. (“HTC”) filed a Notice in Response to Motion for Joinder stating HTC did not oppose joinder based on the representation from Petitioner that it would have limited participation in the HTC IPR. HTC IPR, Paper 13.

For the reasons explained below, we institute an *inter partes* review of claims 1–6, 8, 10, 11, 13–18, 21–29, and 31 of the ’168 patent and grant Petitioner’s Motion for Joinder.

INSTITUTION OF INTER PARTES REVIEW

The Petition asserts the same grounds as those on which we instituted review in the HTC IPR. Pet. 1; Mot. 5–6. On December 9, 2014, we instituted an *inter partes* review under 35 U.S.C. § 103 of: (1) claims 1–6, 8, 10, 11, 13–15, 21–29 and 31 as obvious over Morita¹ and Sarbadhikari²; (2) claims 16–18 as obvious over Morita, Sarbadhikari and Longginou³; (3)

¹ JP H06-133081, published May 13, 1994 (Ex. 1002, “Morita”).

² US 5,477,264, issued Dec. 19, 1995 (Ex. 1003, “Sarbadhikari”).

³ WO 95/23485, published Aug. 31, 1995 (Ex. 1004, “Longginou”).

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claims 1–6, 8, 10, 11, 16–18, 21, 22, 24, 26, 27 and 29 as obvious over Wilska⁴ and Yamagishi-992⁵; and (4) claims 13–15, 23, 25, 28, and 31 as obvious over Wilska, Yamagishi-992, and McNelley⁶.

In view of the challenges in the instant Petition and the petition in the HTC IPR, we institute an *inter partes* review in this proceeding on the same grounds as those on which we instituted in the HTC IPR.

GRANT OF MOTION FOR JOINDER

The Petition in this proceeding has been accorded a filing date of January 7, 2015, and, thus, satisfies the requirement that joinder be requested no later than one month after the institution date of the HTC IPR. *See* 37 C.F.R. § 42.122(b); Paper 6 (Notice of Filing Date Accorded to Petition).

The Petition in this proceeding sets forth the same ground and combination of prior art, the same witness declaration, and the same arguments considered by the Board in instituting trial in the HTC IPR. Mot. 5–6. Per our Order dated February 4, 2015 (Paper 8), Petitioner filed a redline identifying all differences between the Petition in the instant proceeding and the Petition in the HTC IPR. Ex. 1012. Petitioner represents that the Petitions differ only in that the Petition in this case applies claim constructions adopted by the Board in the Decision on Institution (“Dec. Inst.”) in the HTC IPR. Mot. 4, n.3 (citing Ex. 1010 at 6–8). We reviewed the redlined copy of the Petition (Exhibit 1012) and confirmed that the differences between the two Petitions do not introduce new issues.

⁴ GB 2289555A, published Nov. 22, 1995 (Ex. 1005, “Wilska”)

⁵ EP 0 594 992 A1, published May 4, 1994 (Ex. 1006, “Yamagishi-992”).

⁶ Us 5,550,754, issued Aug. 27, 1996 (Ex. 1007, “McNelley”).

Petitioner represents in its Motion for Joinder that it “is willing to be limited to separate filings, if any, of a reasonable number of pages (e.g., seven pages) directed only to points of disagreement with HTC with the understanding that it will not be permitted any separate arguments in furtherance of those advanced in HTC’s consolidated filings.” Mot. 7. Petitioner represents that “no additional depositions will be needed and depositions will be completed within ordinary time limits.” *Id.* Petitioner represents that it will “coordinate with HTC to consolidate filings, manage questioning at depositions, manage presentations at the hearing, ensure that briefing and discovery occur within the time normally allotted, and avoid redundancies.” HTC does not oppose Samsung’s Motion for Joinder of this proceeding with the HTC IPR “based on the agreement made by Samsung to the Board during a conference call on February 3, 2015 for limited participation by Samsung in the IPR2014-00987 proceeding.” HTC IPR, Paper 13, 1.

Under the circumstances, we conclude Samsung has demonstrated that joinder will not unduly complicate or delay the HTC IPR, and therefore, we grant Samsung’s Motion for Joinder to join this proceeding with the HTC IPR.

ORDER

Accordingly, it is

ORDERED that IPR2015-00543 is instituted and joined with IPR2014-00989;

FURTHER ORDERED that the ground on which IPR2014-00989 was instituted is unchanged, and no other grounds are instituted in the joined proceeding;

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FURTHER ORDERED that the Scheduling Order in place for IPR2014-00989 (Paper 7) shall govern the joined proceedings;

FURTHER ORDERED that, if Patent Owner requires a Supplemental Response to address the Petition filed in IPR2015-00543, Patent Owner must request a conference call with the Board within five days of this Order;

FURTHER ORDERED that, throughout the joined proceeding, HTC and Samsung will file any paper, except for a motion that does not involve the other party, as a single, consolidated filing on behalf of Petitioner, and HTC will identify each such filing as a consolidated filing;

FURTHER ORDERED that for any consolidated filing made by HTC, Samsung may file an additional paper, not to exceed three pages, which may address only points of disagreement with HTC;

FURTHER ORDERED that HTC will conduct the deposition of any Patent Owner witness taken on behalf of HTC and Samsung, collectively, and Samsung may not participate in the questioning absent prior approval from the Board;

FURTHER ORDERED that any requests by any party for additional deposition time must be brought before the Board;

FURTHER ORDERED that IPR2015-00543 is terminated under 37 C.F.R. § 42.72, and all further filings in the joined proceeding are to be made in IPR2014-00989;

FURTHER ORDERED that a copy of this Decision will be entered into the record of IPR2014-00989; and

FURTHER ORDERED that the case caption in IPR2014-00989 shall be changed to reflect joinder with this proceeding in accordance with the attached example.

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