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Paper 9
Entered: July 10, 2015

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.,
Patent Owner.

Case IPR2015-00611
Patent 7,643,168 B2

Before JAMESON LEE, GREGG I. ANDERSON, and MATTHEW 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)

I. 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 (Ex. 1001, "the '168 patent")("Pet.," Paper 2). On May 7, 2015, e-Watch, Inc. ("Patent Owner"), filed a Preliminary Response ("Prelim. Resp.," Paper 7). We have jurisdiction under 35 U.S.C. § 314.

Concurrently with its Petition, Samsung filed a Motion for Joinder ("Motion" or "Mot.," Paper 3). The Motion seeks to join this proceeding with *Apple Inc. v. e-Watch, Inc.*, IPR2015-00414 (hereinafter "Apple IPR" or "Apple" when the petitioner is referenced). Mot. 1. Patent Owner did not file an opposition to the Motion.

For the reasons explained below, we institute an *inter partes* review of claims 1–31 of the '168 patent and grant Petitioner's Motion for Joinder.

II. INSTITUTION OF INTER PARTES REVIEW

A. Analysis

1. 35 U.S.C. § 325(d)

Patent Owner asserts, as it did in the Apple IPR, that there are a total of eight IPR petitions filed asserting unpatentability of the claims of the '168 patent. Prelim. Resp. 1–3. Patent Owner also alleges the prior art relied on in this Petition was cited in parallel district court litigation. *Id.* at 3, 6–8. Patent Owner asks us to exercise our discretion under 35 U.S.C. 325(d) and deny institution of this petition. *Id. at 3.*

Each of the proceedings includes a different petitioner and includes additional grounds to those asserted here. We need to be cognizant of the

interests of other petitioners as well as those of Patent Owner. Accordingly, we decline to exercise our discretion under § 325(d) to reject this Petition.

2. Effective Filing Date of '168 Patent–Claim of Priority

The Petition asserts the same ground as the one on which we instituted review in the Apple IPR. Pet. 3; Mot. 5–7. On July 1, 2015, in our Decision on Institution (Paper 13, "Dec.") in the Apple IPR we instituted *inter partes* review of claims 1–31 of the '168 patent under 35 U.S.C. §102(b) as anticipated by Monroe.[1] Institution of trial in the Apple IPR was based on our determination that the '168 patent was not entitled to the January 12, 1998, filing date of an earlier application. Dec. 13.

Specifically, the '168 patent issued from patent application No. 11/617,509, filed December 28, 2006 (the '509 application). Ex. 1001, at [21], [22]. The '509 application is a continuation of application 10/336,470, filed on January 3, 2003 ("the '470 application").[2] *Id.* at [63]. The '470 application is a divisional application of application 09/006,073 ("the '073 application"), filed on January 12, 1998. Ex. 1009, at [62].

In the Apple IPR, on the record presented, we determined the claims of the '168 patent are not entitled to the effective filing date of the '073 application (January 12, 1998). Dec. 13. The '168 patent ('509 application) states the '509 application is a division of the '073 application, which is a misstatement of the relationship between the '509 application and the '073 application. *Id.* This misstatement violates 37 C.F.R. § 1.78(a)(2)(i) (pre-AIA), which requires a reference indicating the relationship between the

[1] Int. Pub. Pat. App. WO 99/035818, to Monroe, published July 15, 1999 (Ex. 1006, "Monroe").
[2] The '470 application issued as the '871 patent. Ex. 1001, at[63]; Ex. 1009.

prior-filed application and the application seeking to claim the benefit of the prior-filed application. *Id.* Without the benefit of the filing date of the earlier-filed '073 application, Monroe is prior art to the claims of the '168 patent. *Id.* Based on Monroe, we instituted *inter partes* review of claims 1–31 of the '168 patent under 35 U.S.C. §102(b) as anticipated by Monroe. *Id.* at 14.

Petitioner here makes the same argument using the same record as the Apple IPR. The issue of priority has been raised in the first instance by Petitioner. Patent Owner's Preliminary Response does not respond to the issue and, necessarily, does not show that the '168 patent is entitled to the earlier filing date of the '073 application. *See, e.g.*, *Focal Therapeutics, Inc. v. SenoRx, Inc.*, Case IPR2014-00116, 2014 WL 1651257, at *6 (PTAB Apr. 22, 2014) (Paper 8); *Polaris Wireless, Inc. v. TruePosition, Inc.*, Case IPR2013-00323, 2013 WL 8563953, at *27 (PTAB Nov. 15, 2013) (Paper 9).

The challenge in the instant Petition is identical to the challenge in the petition in the Apple IPR. We are persuaded, on this record, Petitioner has shown sufficiently a reasonable likelihood that claims 1–31 of the '168 patent are anticipated under 35 U.S.C. §102(b) by Monroe.

3. Effective Filing Date of '168 Patent–Intentional Abandonment

Petitioner makes an additional argument, not present in the Apple IPR, for why Monroe is prior art. The additional ground alleges that the'073 application was intentionally abandoned. Pet. 10. The Patent Office revived the '073 application based on a statement by Applicant that abandonment was unintentional. Pet. 12–13. Petitioner contends the abandonment was

intentional and the '073 application should not have been revived. *Id.* at 10. Thus, according to Petitioner, the '168 patent is not entitled to the filing date of the '073 application because neither the '470 application nor the '509 application were co-pending with the '073 application. *Id.* at 10. Petitioner indicates, however, that it is willing to "drop [this] argument" if this case is joined to the Apple IPR. Mot. 7.

Patent Owner argues that Petitioner's position on intentional abandonment extends beyond the jurisdiction for these proceedings set forth in 35 U.S.C. §311 permits. Prelim. Resp. 8–11.

As discussed above, we are proceeding on the same argument presented in the Apple IPR that the '168 patent is not entitled to the filing date of the '073 application and, because Petitioner has agreed not to pursue this argument, we need not address this separate argument.

III. GRANT OF MOTION FOR JOINDER

In a conference call on June 26, 2015, both Patent Owner and Apple stated they do not oppose the Motion so long as the conditions Petitioner proposed in the Motion are incorporated into the joinder. Paper 8; Apple IPR, Paper 13. Agreement to joinder was also conditional upon institution of the Apple IPR. *Id.* On July 1, 2015, we instituted *inter partes* review of claims 1–31 of the '168 patent in the Apple IPR.

The Petition in this proceeding has been accorded a filing date of January 23, 2015, and, thus, satisfies the requirement that joinder be requested no later than one month after the institution date of the Apple IPR. *See* 37 C.F.R. § 42.122(b); Paper 6 (Notice of Filing Date Accorded to Petition).

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