

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

United States Patent No.: 8,532,641	§	Attorney Docket No.:
Inventors: Russell W. White,	§	110797-0004-658
Kevin R. Imes	§	Customer No. 28120
Formerly Application No.: 13/673,391	§	Petitioners:
Issue Date: Sept. 10, 2013	§	Samsung Electronics Co., Ltd.;
Filing Date: Nov. 9, 2012	§	Samsung Electronics America, Inc.
Priority Date: March 28, 2000	§	
	§	
Former Group Art Unit: 2646	§	
Former Examiner: Erika Washington	§	
	§	
	§	

For: SYSTEM AND METHOD FOR MANAGING MEDIA

MAIL STOP PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
Post Office Box 1450
Alexandria, Virginia 22313-1450

**PETITIONERS' MOTION FOR JOINDER
UNDER 35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b) AND
REQUEST FOR SHORTENED RESPONSE TIME FOR PATENT
OWNER'S PRELIMINARY RESPONSE**

I. RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioners Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (“Petitioners”) hereby move for joinder of the limited grounds raised in their new Petition for *Inter Partes* Review (“IPR”) of United States Patent No. 8,532,641 (“the ‘641 patent”)—filed concurrently with this Motion—with the already-instituted IPR for the ‘641 patent, *Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. v. Affinity Labs of Texas, LLC* (“*Affinity*”), IPR2014-01184, which involve the same patent, same parties, and overlapping prior art references.

In conjunction with this request for joinder, Petitioners respectfully request that the Board specify a shortened response period of six (6) weeks (until April 10, 2015) in which Patent Owner Affinity (“Patent Owner”) may file a Preliminary Response to the Petition.

II. STATEMENT OF MATERIAL FACTS

1. On July 28, 2014, Petitioners filed a petition for *inter partes* review of the ‘641 patent for claims 1-3 and 5-14 based on the Ohmura reference in view of the Ahn, Nokia, and/or Galensky references. See IPR2014-01184, Paper 2.¹

¹ On July 28, 2014, Petitioners also filed two other petitions for *inter partes* review of the ‘641 patent challenging claims 1-3 and 5-14 (IPR2014-01181 and IPR2014-01182) based on different grounds and different prior art references. The Board instituted

2. On January 30, 2015 the Board instituted trial in that proceeding on claims 8, 11, 13 and 14. See IPR2014-01184, Paper 10 at 15.

3. The prior art relied on for the grounds instituted in IPR2014-01184 is Ohmura in view of Ahn and/or Nokia. See IPR2014-01184, Paper 10 at 15.

4. The same patent, Petitioners, and Patent Owner are involved in the already-instituted IPR2014-01184 and the new Petition filed concurrently with this Motion, and it is Petitioners' understanding that the same counsel for each party from the already-instituted IPR will represent Petitioners and Patent Owner in the new Petition proceedings.

5. The new Petition challenges claims 1-3, 5-7, 9-10 and 12 ("Challenged Claims") on prior art grounds. Claims 1-3, 5-7, 9-10 and 12 were challenged in the earlier petition in IPR2014-01184 but were not instituted for trial. See IPR2014-01184, Paper 10 at 13.

6. In particular, the new Petition asserts grounds based on 35 U.S.C. § 103 for the Challenged Claims using a combination of a new reference, Hu, in view of the

for trial in IPR2014-01181, claims 8 and 11-14 (based on the primary prior art reference "Ito") and in IPR2014-01182, claims 1-3 and 5-14 (based on the primary prior art reference "Abecassis"). See IPR2014-01181, Paper 10 and IPR2014-01182, Paper 10. Petitioners are also concurrently filing a new Petition for *inter partes* review of claims 1-3, 5-7, 9 and 10 of the '641 patent based on the Ito reference.

secondary prior art references Ahn, Nokia, and/or Galensky (which were previously cited in combination with the Ohmura reference and, as discussed above, Ahn and Nokia form grounds on which trial is instituted in IPR2014-01184). Petitioners were not aware of the Hu reference at the time the earlier IPR2014-01184 petition was filed, and instead located that reference only after the institution decision in IPR2014-01184.

7. Petitioners rely in their new Petition on a supporting declaration from the same expert who submitted a declaration in the already-instituted IPR2014-01184.

III. DISCUSSION

The requested joinder will serve to secure the just, speedy, and inexpensive resolution of these proceedings. Under 35 U.S.C. § 315(c):

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.

In addition, 37 C.F.R. § 42.122(b) provides that:

Joinder may be requested by a patent owner or petitioner. Any request for joinder must be filed, as a motion under §42.22, no later than one month after the institution date of any inter partes review for which joinder is requested. The time period set forth in § 42.101(b) shall not apply when the petition is accompanied by a request for joinder.

This Motion is timely under § 42.122(b) because Petitioners are filing it within

one month after the January 30, 2015 institution date for IPR2014-01184.

The Board has further provided that a motion for joinder should: (1) set forth the reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule of the existing proceeding; and (4) address specifically how briefing and discovery may be simplified. *See, e.g., Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (Apr. 24, 2013). Analysis of these factors here warrants the Board's use of its discretion to grant the requested joinder.

The existence of several significant similarities between the already-instituted IPR2014-01184 and the new Petition supports application of joinder. The same patent, parties, and counsel are involved in both proceedings. The same expert for Petitioners is involved in both proceedings—and, presumably, Patent Owner may use a common expert in both proceedings. Patent Owner has already responded to, and the Board has already analyzed for institution, prior petitions challenging every claim now at issue in the new Petition, which contain overlapping subject matter with claims already instituted for trial. And Petitioners assert here the same secondary prior art references as in the original petition for which trial has been instituted (IPR2014-01184).

Petitioners believed, in submitting their original petitions, that they had made the required showing to invalidate claims 1-3, 5-7, 9-10 and 12 of the '641 patent. In its January 30, 2015 Institution Decision, however, the Board determined that

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