

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC., TOSHIBA
CORPORATION, AND VIZIO, INC.
Petitioners

v.

STRAIGHT PATH IP GROUP, INC.
Patent Owner

INTER PARTES REVIEW OF U.S. PATENT NO. 6,009,469
Case IPR No.: *To Be Assigned*

MOTION FOR JOINDER TO INSTITUTED *INTER PARTES* REVIEW
(35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b))

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), LG Electronics, Inc. (“LGE”), Toshiba Corporation (“Toshiba”), and VIZIO, Inc. (“VIZIO”) move for joinder with the *Inter Partes* Review of U.S. Patent No. 6,009,469, *Samsung Elecs. Co. v. Straight Path IP Grp., Inc.*, IPR2014-01367 (“the Samsung IPR”), which was instituted on March 6, 2015. This motion is timely because it is filed within one month of institution of the Samsung IPR. 37 C.F.R. § 42.122(b).

Petitioners request institution of their concurrently filed Petition for *Inter Partes* Review. The Petition is a carbon copy of the original Samsung IPR petition in all material respects. The only changes are in the mandatory notices under 37 C.F.R. § 42.8(b) (Section II.A.), and in matters of form. The concurrently filed Petition and the Samsung IPR petition challenge the same claims of the ’469 patent on the same grounds relying on the same prior art and evidence, including declarations identical in substance from the same declarants and expert.¹

Petitioners request that the institution of their Petition be limited solely to the grounds instituted in the Samsung IPR filed by the original petitioners in the Samsung IPR (“the Samsung Petitioners”). Petitioners agree to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the instituted Samsung

¹ The declarations have been updated only to reflect retention by Petitioners and are otherwise identical to the declarations submitted in the Samsung IPR.

IPR. Thus, the Petition warrants institution under 35 U.S.C. § 314, and 35 U.S.C. § 315(c) permits LGE's, Toshiba's, and VIZIO's joinder to the Samsung IPR.

Further, if joined, Petitioners agree to adhere to all applicable deadlines in the Samsung IPR and coordinate all filings with the Samsung Petitioners and each other. No Petitioner will submit a separate filing unless its position differs from the position of the Samsung Petitioners, in which case the Petitioner will limit any additional filing to seven (7) pages or less.² Also, Petitioners will not seek additional depositions or deposition time, and will coordinate deposition questioning and hearing presentations with the Samsung Petitioners and each other.

Joinder will help efficiently resolve the disputes among the parties. By joinder, a single Board decision may dispose of the issues raised in the Samsung IPR for all parties. Further, the Patent Owner has asserted the '469 patent in district court actions against LGE, Toshiba, and VIZIO. Joinder will estop LGE, Toshiba, and VIZIO from asserting in district court those issues resolved in a final written decision in the Samsung IPR, thus narrowing the issues in the district court actions. *See* 35 U.S.C. § 315(e)(2). Finally, joinder would not complicate or delay the Samsung IPR, and would not adversely affect any schedule set in that proceeding. In sum, joinder would promote efficient adjudication in multiple forums.

² Each Petitioner will continue on this basis unless and until the Samsung IPR is terminated as to the Samsung Petitioners and the other Petitioners.

Joinder will not unduly prejudice any party. The Samsung Petitioners consent to LGE's, Toshiba's, and VIZIO's joinder.³ Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or increase needless filings, any additional costs on the Patent Owner would be minimal. On the other hand, denial of joinder would prejudice LGE, Toshiba, and VIZIO. Their interests may not be adequately protected in the Samsung IPRs, particularly if the Samsung Petitioners settle with the Patent Owner. LGE, Toshiba, and VIZIO should be allowed to join in a proceeding affecting a patent asserted against them.

II. BACKGROUND AND RELATED PROCEEDINGS

Straight Path IP Group, Inc. (the "Patent Owner") is the owner of the '469 Patent. The Patent Owner asserted the '469 Patent against LGE, Toshiba, and VIZIO, among others, in an ITC investigation captioned *Certain Point-to-Point Network Communication Devices and Products Containing Same*, Inv. No. 337-TA-892 (U.S.I.T.C., filed Aug. 1, 2013), which was terminated by the ITC in response to Patent Owner's motion to withdraw the complaint and terminate the investigation shortly before the scheduled trial, and in pending district court actions—*Straight Path IP Grp., Inc. v. VIZIO, Inc.*, 1:13-cv-00934-AJT-IDD (E.D. Va.), which consolidated *Straight Path IP*

³The Patent Owner opposes "on at least the grounds that the real party in interest is not named and is statutorily barred." As explained in Section III. E. below, this argument is without merit.

Grp., Inc. v. LG Elecs. Inc., 1:13-cv-00933-CMH-TRJ (E.D. Va.) and *Straight Path IP Grp., Inc. v. Toshiba Corp.*, 1:13-cv-01070-AJT-IDD (E.D. Va.). The Patent Owner has asserted the '469 patent, and/or related U.S. Patent Nos. 6,108,704 (“the '704 patent”) and 6,131,121 (“the '121 patent”) in numerous district court actions against other parties in the Eastern District of Virginia (1:13-cv-00935, 1:13-cv-00936, 1:13-cv-01071, 2:12-cv-00007; 2:12-cv-00009; 2:14-cv-00233; 2:13-cv-00427; 3:13-cv-00503), Eastern District of Texas (6:13-cv-00604; 6:13-cv-00605; 6:13-cv-00606; 6:13-cv-00607, 6:14-cv-00405; 6:14-cv-00534), Northern District of California (3:14-cv-04302; 3:14-cv-04309; 3:14-cv-04312; 5:14-cv-04561), Southern District of New York (1:14-cv-07798); District of New Jersey (2:06-cv-02469); and Western District of Arkansas (4:10-cv-04090).

A number of IPR petitions have been filed against the '469 patent. Setting aside Samsung's IPR2014-01367 challenging claims 1-3, 5-6, 9-10, 14, and 17-18, LGE, Toshiba, VIZIO, and Hulu, LLC (“Hulu”) filed a joint IPR petition challenging the same claims (Case No. IPR2015-00198). The Board had not yet decided whether to institute IPR2015-00198 (accorded a filing date of October 31, 2014) at the time the Petitioners filed the present motion. Other IPR challenges to the '469 patent include IPR2014-00231 (settled before institution) and IPR2014-01225 (settled).

Additionally, there have been a number of IPR challenges against the '704 and the '121 patents, which are related to the '469 patent. The Board held that claims 1-7 and 32-42 of the '704 patent were unpatentable in IPR2013-00246. The Patent

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