

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORP., SONY ELECTRONICS INC.,
SONY MOBILE COMMUNICATIONS AB,
SONY MOBILE COMMUNICATIONS (USA) INC.,
LG ELECTRONICS, INC., LG ELECTRONICS USA, INC., and
LG ELECTRONICS MOBILECOMM USA, INC.,
Petitioner,

v.

MEMORY INTEGRITY, LLC,
Patent Owner.

Case IPR2015-01353
Patent 7,296,121 B2

Before JENNIFER S. BISK, NEIL T. POWELL, and KERRY BEGLEY,
Administrative Patent Judges.

BISK, *Administrative Patent Judge.*

DECISION

Institution of *Inter Partes* Review, Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. §§ 42.108, 42.122

Sony Corp., Sony Electronics Inc., Sony Mobile Communications AB, Sony Mobile Communications (USA) Inc. (collectively, “Sony”), LG Electronics, Inc., LG Electronics USA, Inc., and LG Electronics Mobilecomm USA, Inc. (collectively, “LG”) filed a Petition requesting *inter partes* review of claims 4–6, 11, 12, and 19–24 of U.S. Patent No. 7,296,121 B2 (Ex. 1001, “the ’121 patent”). Paper 1 (“Pet.”). Along with the Petition, Sony and LG filed a motion for joinder with IPR2015-00163, *Apple Inc. v. Memory Integrity, LLC*, a pending *inter partes* review involving the ’121 patent. Paper 4 (“Mot.”).¹

Memory Integrity, LLC (“Patent Owner”), with prior authorization from the Board, filed a notice that it seeks to rely on its Preliminary Response filed in IPR2015-00163. Paper 10. We treat Patent Owner’s Preliminary Response in IPR2015-00163 as having been filed in this case. *See* IPR2015-00163, Paper 13 (“Prelim. Resp.”).

Patent Owner has not filed an opposition to the Motion for Joinder. Sony and LG represent in the Motion that the petitioners in IPR2015-00163 have no objection to the requested joinder. *See* Mot. 7.

For the reasons set forth below, we conclude that Sony and LG have shown that the Petition warrants institution of *inter partes* review of claims 4–6, 11, 12, and 19–24 of the ’121 patent. This conclusion is

¹ We note that the one-year time bar of 35 U.S.C. § 315(b) and 37 C.F.R. § 42.101(b) does not apply to Sony and LG’s request for joinder with IPR2015-00163. *See* Mot. 3; 35 U.S.C. § 315(b) (“The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).”); 37 C.F.R. §§ 42.101(b), 42.122(b) (“The time period set forth in § 42.101(b) shall not apply when the petition is accompanied by a request for joinder.”).

consistent with our institution decision in IPR2015-00163 (as modified on rehearing). *See* Paper 22, 6. We exercise our discretion to join Sony and LG as petitioners in IPR2015-00163.

I. BACKGROUND

Sony and LG indicate that Patent Owner has asserted the '121 patent in numerous cases filed in the U.S. District Court for the District of Delaware. Pet. 2–3. In addition, the '121 patent is the subject of pending *inter partes* review proceedings, including IPR2015-00163 as well as IPR2015-00158 and IPR2015-00159. *Id.* at 3. The '121 patent also was the subject of IPR2015-00161 and IPR2015-00172, in which *inter partes* review was not instituted. *Id.*

In IPR2015-00163, filed by Apple Inc., HTC Corporation, HTC America, Inc., Samsung Electronics Co. Ltd., Samsung Electronics America, Inc., and Amazon.com, Inc. (collectively, “IPR2015-00163 Petitioners”), we instituted *inter partes* review of claims 4–6, 11, 12, and 19–24 of the '121 patent on the grounds of unpatentability asserted in the present Petition. *Apple Inc. v. Memory Integrity, LLC*, Case IPR2015-00163 (PTAB May 8, 2015) (Paper 18) (“IPR2015-00163 Inst. Dec.”); IPR2015-00163 Paper 22 (“IPR2015-00163 Reh’g Dec.”).

II. PETITION FOR *INTER PARTES* REVIEW

In the Petition, Sony and LG assert the same grounds of unpatentability on which we instituted review in IPR2015-00163 (Pet. 5):

Ground	References	Challenged Claims
§ 102	Koster ²	4–6, 11, and 12

² U.S. Patent No. 7,698,509 B1 (Ex. 1009) (“Koster”).

Ground	References	Challenged Claims
§ 103	Koster and Smith ³	19–24

Sony and LG support these assertions with the same arguments and evidence proffered by the IPR2015-00163 Petitioners, including a substantively identical Declaration of Dr. Horst. *Compare* Pet. 5–42, with IPR2015-00163, Paper 1 (“IPR2015-00163 Pet.”), 4–38, 51–56; *compare* Ex. 1014, with IPR2015-00163, Ex. 1014.

We incorporate our analysis from our institution decision and rehearing decision in IPR2015-00163. IPR2015-00163 Inst. Dec. 3–24, 26–27; IPR2015-00163 Reh’g Dec. 2–6. For the same reasons, we determine that Sony and LG have demonstrated that the present Petition warrants institution of *inter partes* review on the asserted grounds that claims 4–6, 11, and 12 of the ’121 patent are anticipated by Koster and that claims 19–24 of the ’121 patent would have been obvious over Koster and Smith. IPR2015-00163 Inst. Dec. 3–24, 26–27; IPR2015-00163 Reh’g Dec. 2–6.

III. MOTION FOR JOINDER

In the Motion for Joinder, Sony and LG seek to be joined “as a party” to IPR2015-00163. Mot. 7. Sony and LG filed the present Motion on June 8, 2015, within one month of our decision instituting *inter partes* review in IPR2015-00163, which issued on May 8, 2015. *See* IPR2015-00163 Inst. Dec.; Mot. Therefore, the Motion is timely under 37 C.F.R. § 42.122(b). *See* 37 C.F.R. § 42.122(b) (“Any request for joinder must be

³ MICHAEL JOHN SEBASTIAN SMITH, APPLICATION-SPECIFIC INTEGRATED CIRCUITS (1997) (Ex. 1008) (“Smith”).

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 Board, acting on behalf of the Director, has the discretion to join a party to a pending *inter partes* review where the conditions of 35 U.S.C. § 315(c) are met. *See* 35 U.S.C. § 315(c); *see also* 37 C.F.R. § 42.4(a) (“The Board institutes the trial on behalf of the Director.”). Specifically, 35 U.S.C. § 315(c) provides:

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.

As noted above, we have instituted *inter partes* review of claims 4–6, 11, 12, and 19–24 of the ’121 patent in IPR2015-00163. *See generally* IPR2015-00163 Reh’g Dec. In addition, we determine above that Sony and LG properly filed a Petition that warrants institution of *inter partes* review of the same claims. Accordingly, the conditions of 35 U.S.C. § 315(c) are satisfied, and we must consider whether to exercise our discretion to join Sony and LG as petitioners in IPR2015-00163.

We agree with Sony and LG that joinder would not impact the substantive issues presented in IPR2015-00163. The grounds asserted in Sony and LG’s Petition that we determine above warrant institution of *inter partes* review are identical to the grounds on which we instituted review in IPR2015-00163—relying on the same prior art, same arguments, and same evidence, including the same expert and a substantively identical

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