

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.
Petitioner

v.

ATI TECHNOLOGIES ULC
Patent Owner

Case: IPR2015-01620

Patent 7,095,945

REPLY IN SUPPORT OF PETITIONER'S MOTION FOR JOINDER

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<i>Samsung Electronics Co. Ltd. et al. v. Affinity Labs of Texas, LLC</i> , IPR2015-00820, Paper 12, at 2 (May 15, 2015)	3
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37 C.F.R. § 42.23(a)	1
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I. INTRODUCTION

Both parties acknowledge there is a split between Board panels regarding joinder of the same party to an instituted IPR. The case-by-case basis on which the Board evaluates joinder, however, weighs in LGE's favor. ATI does not dispute that the current petition uses the same base reference as the IPR2015-00321 Petition, nor does it dispute the current petition adds only two new references to support an obviousness analysis for one claim—Claim 21. Indeed, ATI's opposition did not oppose any of LGE's "Statement of Material Facts." *See* Paper 7. As such, those facts "stand as admitted." *See Ariosa Diagnostics v. Isis Innovation Ltd.*, IPR2013-00250, Paper 25, at 2 ("Ariosa II"); 37 C.F.R. § 42.23(a). While claims 18 and 21 are different, the subject matter of those claims has substantial overlap. Moreover, ATI cannot show any real prejudice; its increased costs argument for responding to two new references and one claim is belied by ATI's scorched earth response in another instituted IPR pending between the parties. For the additional reasons discussed below, Petitioner respectfully requests that the Board exercise its discretion under § 315(c) and grant Petitioner's motion for joinder.

II. ARGUMENT

A. Joinder Will Result in a Just and Speedy Resolution of the '945 Patent

Joinder is discretionary and evaluated on a case-by-case basis.¹ In view of the admitted material facts in this case, the Board should grant Petitioner's motion for joinder because it will result in a "minimal amount of work" for Patent Owner and the Petitions involve "the same patent and parties... substantially the same exhibits... [and] substantial overlap in the asserted references." *See Samsung v. Virginia*, IPR2014-00557, Paper 10, (Kim, McNamara, Clements, J.), at 18; *Sony v. Yisum*, IPR2013-00327, Paper 15, (Medley, Easthom, Arpin, J.) at 5. As such, joinder will result in the just and speedy resolution of the '945 Patent.

Contrary to ATI's assertion, there is no "Board precedent" on this issue. Indeed, both parties cite cases on opposite sides of the split regarding joinder of issues under § 315(c). As such, ATI's case law presents only one side of the split and it is also distinguishable. For example, in *Butamax Advanced Biofuels LLC. v. Gevo, Inc.*, IPR2014-00581, Paper 8, at 2 (Oct. 14, 2014), the Board did not rule on

¹ ATI cites no rules or precedent requiring petitioners to identify new circumstances or prohibiting a second petition on a patent following an institution decision.

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