

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS, CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC., and
SAMSUNG SEMICONDUCTOR, INC.,
Petitioner,

v.

RAYTHEON COMPANY,
Patent Owner.

Case IPR2016-00962
Patent 5,591,678

Before JO-ANNE M. KOKOSKI, JENNIFER MEYER CHAGNON, and
JEFFREY W. ABRAHAM *Administrative Patent Judges.*

CHAGNON, *Administrative Patent Judge.*

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108
Petitioner's Motion for Joinder
37 C.F.R. § 42.122(b)

I. INTRODUCTION

Samsung Electronics, Co., Ltd., Samsung Electronics America, Inc., and Samsung Semiconductor, Inc. (collectively, “Petitioner” or “Samsung”) filed a Petition for *inter partes* review of claims 1–18 (“the challenged claims”) of U.S. Patent No. 5,591,678 (Ex. 1001, “the ’678 patent”). Paper 1 (“Pet.”). Concurrently with its Petition, Samsung filed a Motion for Joinder with *Sony Corp. v. Raytheon Co.*, Case IPR2016-00209 (“the Sony 209 IPR”). Paper 3 (“Mot.”). Raytheon Company (“Patent Owner”) filed an Opposition to Samsung’s Motion for Joinder (Paper 9 (“Opp.”)) and Samsung filed a Reply (Paper 10 (“Reply”)). Patent Owner also filed a Preliminary Response to the Petition. Paper 11 (“Prelim. Resp.”).

For the reasons explained below, we institute an *inter partes* review of claims 1–18 of the ’678 patent and grant Samsung’s Motion for Joinder.

II. RELATED PROCEEDINGS

The ’678 patent has been asserted in *Raytheon Co. v. Samsung Electronics Co.*, No. 2:15-cv-00341 (E.D. Tex.), and *Raytheon Co. v. Sony Corp.*, No. 2:15-cv-00342 (E.D. Tex.). Pet. 2–3; Paper 8, 2.

Sony Corporation (“Sony”) has challenged the ’678 patent in the Sony 209 IPR. Pet. 1; Paper 8, 2. In the Sony 209 IPR, we instituted *inter partes* review of claims 1–18 of the ’678 patent on the following grounds:

Reference(s)	Basis	Claim(s) Challenged
Liu ¹	§ 102	1–4, 6, 7, 10, 11
Liu and Black ²	§ 103	2–4, 11
Liu and Riseman ³	§ 103	5, 12–16

¹ U.S. Patent No. 4,422,091, issued Dec. 20, 1983 (Ex. 1003)

² U.S. Patent No. 4,426,768, issued Jan. 24, 1984 (Ex. 1007)

³ U.S. Patent No. 4,106,050, issued Aug. 8, 1978 (Ex. 1009)

Reference(s)	Basis	Claim(s) Challenged
Liu and Oldham ⁴	§ 103	8
Liu and Wen ⁵	§ 103	10
Liu, Wen, and Ying ⁶	§ 103	9
Liu, Riseman, and Kusunoki ⁷	§ 103	17
Liu, Riseman, and Oldham	§ 103	18

See IPR2016-00209, slip op. at 23–24 (PTAB Mar. 29, 2016) (Paper 12) (“Sony 209 Dec.”).

Sony also has challenged the ’678 patent in *Sony Corp. v. Raytheon Co.*, Case IPR2015-01201 (*inter partes* review instituted as to claims 1–18). Pet. 3; Paper 8, 2. Samsung also has challenged the ’678 patent in *Samsung Electronics, Co. v. Raytheon Co.*, Case IPR2016-00739 (decision pending). Paper 8, 2.

III. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same grounds of unpatentability as those on which we instituted review in the Sony 209 IPR. Compare Pet. 3–4, 21–60, with Sony 209 Dec. 23–24. Indeed, as Samsung notes, the Petition filed in this proceeding is “substantively identical to the Sony [209] Petition, containing only minor differences related to formalities of a different party filing the petition.” Mot. 5. Samsung further asserts that “there are no changes to the facts, citations, evidence, or arguments presented in the Sony [209] Petition.” *Id.* Patent Owner’s Preliminary Response does not substantively address the asserted grounds, but reiterates

⁴ U.S. Patent No. 4,681,718, issued July 21, 1987 (Ex. 1005)

⁵ U.S. Patent No. 3,846,198, issued Nov. 5, 1974 (Ex. 1004)

⁶ U.S. Patent No. 3,864,819, issued Feb. 11, 1975 (Ex. 1006)

⁷ JP Appl. Pub. 3-108776, published May 8, 1991 (Kusunoki is a Japanese-language reference (Ex. 1014); citations to Kusunoki are to the certified English translation submitted by Petitioner (Ex. 1008))

the arguments presented in its Opposition to Petitioner's Motion for Joinder, discussed below.

For the same reasons set forth in our institution decision in the Sony 209 IPR, we determine that the information presented in Samsung's Petition shows a reasonable likelihood that Petitioner would prevail in showing that (a) claims 1–4, 6, 7, 10, and 11 are anticipated by Liu, (b) claims 2–4 and 11 would have been obvious in view of Liu and Black, (c) claims 5 and 12–16 would have been obvious in view of Liu and Riseman, (d) claim 8 would have been obvious in view of Liu and Oldham, (e) claim 10 would have been obvious in view of Liu and Wen, (f) claim 9 would have been obvious in view of Liu, Wen, and Ying, (g) claim 17 would have been obvious in view of Liu, Riseman, and Kusunoki, and (h) claim 18 would have been obvious in view of Liu, Riseman, and Oldham. *See* Sony 209 Dec. 11–23. Accordingly, we institute an *inter partes* review on the same grounds as those on which we instituted review in the Sony 209 IPR. We do not institute *inter partes* review on any other grounds.

IV. GRANT OF MOTION FOR JOINDER

The Petition and Motion for Joinder in this proceeding were accorded a filing date of April 28, 2016. *See* Paper 6. Thus, Petitioner's Motion for Joinder is timely because joinder was requested no later than one month after the institution date of the Sony 209 IPR, i.e., March 29, 2016. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); Mot. 3; *see also* 35 U.S.C. § 315(b) (indicating that the time limitation set forth therein “shall not apply to a request for joinder under subsection (c)”).

The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads:

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.

A motion for joinder should (1) set forth 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 for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

As noted, the Petition in this case asserts the same grounds of unpatentability on which we instituted review in the Sony 209 IPR. *See* Mot. 2–5; Pet. 3–4, 21–60; Sony 209 Dec. 23–24. Samsung also relies on the same prior art analysis and expert testimony submitted by Sony. *See* Mot. 4–6. Indeed, the Petition is nearly identical to the petition filed by Sony with respect to the grounds on which review was instituted in the Sony 209 IPR. *See id.* at 2–3. Thus, this *inter partes* review does not present any ground or matter not already at issue in the Sony 209 IPR.

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