

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION, HTC AMERICA, INC.,
and LG ELECTRONICS, INC.
Petitioners,

v.

PARTHENON UNIFIED MEMORY ARCHITECTURE LLC
Patent Owner.

Case IPR2016-00847
U.S. Patent No. 5,812,789

PETITIONERS' SECOND MOTION FOR JOINDER

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I. Introduction

Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc. filed a petition for *inter partes* review of U.S. Patent No. 5,812,789 (“the 789 patent”), in IPR2015-01944 (the “Samsung 789 IPR”), which was instituted on March 30, 2016. On April 7, 2016, HTC Corporation, HTC America, Inc., and LG Electronics, Inc. (“Petitioners”) filed a petition for *inter partes* review of the 789 patent, IPR2016-00847 (the “HTC+LG 789 IPR”). On April 20, 2016, Apple Inc. (“Apple”) also filed its own petition for *inter partes* review of the 789 patent, IPR2016-00923 (the “Apple 789 IPR”). Both Petitioners and Apple sought joinder to the Samsung 789 IPR, presented unpatentability grounds that are substantively identical to the grounds instituted in the Samsung 789 IPR, and relied on the same evidence and the same expert testimony as Samsung. On May 25, 2016, the Board terminated the Samsung 789 IPR pursuant to a settlement agreement. On June 8, 2016, the Board issued an order in this case (Paper 11) authorizing Petitioners to file a second motion for joinder, this time to the Apple 789 IPR.

Petitioners hereby move under 35 U.S.C. § 315(c) to join the pending HTC+LG 789 IPR to the Apple 789 IPR if and when it is instituted. Counsel for Petitioners have conferred with counsel for Apple, and Apple does not oppose Petitioners' motion. Patent Owner has previously indicated that it does plan on opposing Petitioners' motion. Ex. 1041 at 15:3-5.

II. Background and Related Proceedings

The HTC+LG 789 IPR and Apple 789 IPR relate to a patent being asserted by Parthenon Unified Memory Architecture LLC (“PUMA”) against Petitioners in the United States District Court for the Eastern District of Texas. *See Parthenon Unified Memory Architecture LLC v. HTC Corporation and HTC America Inc.*, Case No. 2:14-cv-00690 (E.D.Tx. 2014) (lead case). The complaint in that case was filed on June 12, 2014 alleging infringement of nine patents. *See id.* A later complaint was filed against Apple by PUMA, alleging infringement of some of the same patents. *See Parthenon Unified Memory Architecture LLC v. Apple Inc.*, Case No. 2:15-cv-00621 (E.D.Tx. 2015). Apple timely filed *inter partes* review petitions relating to several of the Patents-in-Suit, including the Apple 789 IPR referenced above. The Apple 789 IPR has not yet been instituted, but is substantively identical to the instituted Samsung 789 IPR. *Samsung Electronics Co., LTD et al v. Parthenon Unified Memory Architecture LLC*, Case IPR2015-01944, Paper 7 (PTAB March 30, 2016).

III. Discussion

Petitioners respectfully request that the Board exercise its discretion to grant joinder of the HTC+LG 789 IPR with the Apple 789 IPR if and when instituted, pursuant to 35 U.S.C. § 315(c), 37 C.F.R. § 42.22, and 37 C.F.R. § 42.122(b). As noted above, the HTC+LG 789 IPR is substantively identical to the Apple 789 IPR.

The HTC+LG 789 IPR challenges the same claims on the same grounds, includes the same claim constructions and the same arguments, relies on the same exhibits, and uses the same expert and the same expert declaration. Petitioners therefore seek (1) a determination that the HTC+LG 789 IPR warrants institution on the same grounds on which the Board may institute trial in the Apple 789 IPR; and (2) joinder of the instituted HTC+LG 789 IPR into the Apple 789 IPR if and when instituted. That would result in Petitioners joining the Apple 789 IPR without any change to the scope or schedule. In support of this motion, Petitioners propose consolidated filings and other procedural accommodations designed to streamline the proceedings.

A. Reasons Why Joinder is Appropriate

Joinder is appropriate because it is the most expedient way to secure the just, speedy and inexpensive resolution of the related proceedings. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b). The HTC+LG 789 IPR is substantively identical to the corresponding Apple 789 IPR, and thus would avoid multiplication of issues before the Board. Given the duplicative nature of these petitions, joinder of the related proceedings is appropriate. Further, Petitioners agree to consolidated filings and discovery.

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