

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

---

APPLE INC.,  
Petitioner,

v.

PARTHENON UNIFIED MEMORY ARCHITECTURE LLC,  
Patent Owner

---

U.S. Patent No. 5,812,789  
Case No: IPR2016-00923

---

**PETITIONER'S MOTION FOR JOINDER  
UNDER 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22, and 42.122(b)**

**TABLE OF CONTENTS**

I. STATEMENT OF RELIEF REQUESTED .....1

II. STATEMENT OF MATERIAL FACTS .....2

III. STATEMENT OF REASONS FOR REQUESTED RELIEF .....3

    A. Legal Standards ..... 3

    B. Apple’s Motion for Joinder is Timely ..... 4

    C. Joinder is Appropriate ..... 4

        1. No New Grounds of Unpatentability in the Petition..... 6

        2. No Impact on the Schedule for the Existing IPR Proceeding..... 7

        3. Briefing and Discovery Will be Simplified ..... 8

        4. No Prejudice to Patent Owner ..... 9

IV. CONCLUSION.....10

**I. STATEMENT OF RELIEF REQUESTED**

Petitioner Apple Inc. (“Apple”) respectfully submits this Motion for Joinder together with a Petition for *Inter Partes* Review of U.S. Patent No. 5,812,789 (“Apple’s Petition”). Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Apple requests *inter partes* review and joinder with *Samsung Elecs. Co., Ltd., et al. v. Parthenon Unified Memory Architecture, LLC*, IPR2015-01944 (“the Samsung IPR”), which was instituted on March 30, 2016. Apple’s Petition is substantively identical to the petition in the Samsung IPR—challenging the same claims of the ’789 Patent on the same grounds while relying on the same prior art, arguments, and evidence. Additionally, if joined, Apple will assume an “understudy” role, only materially participating in the event Samsung is dismissed from the proceeding. The instant Motion for Joinder and accompanying Petition are being filed within one month of the decision instituting trial in the Samsung IPR, and are therefore timely. Counsel for Apple has conferred with counsel for Samsung, and Samsung does not oppose joinder.

Joinder is appropriate here because (i) Apple’s Petition is substantively identical to the petition in the Samsung IPR, (ii) Apple will assume an understudy role in the joined trial, eliminating any impact on the existing trial schedule, and (iii) Apple agrees to consolidated filings and relies upon the same expert

declaration as relied upon in the Samsung IPR, simplifying briefing and discovery. Accordingly, joinder will provide for a just, speedy, and inexpensive determination of related proceedings.

Apple is filing this petition and joinder motion to ensure that the instituted Samsung IPR reaches a final decision in the event Samsung settles with Patent Owner. In that regard, if a Motion to Terminate is filed in the Samsung IPR and is considered before the Board considers this joinder motion, Apple respectfully requests that the Board dismiss *only* the petitioner, at least until the instant motion can be considered. Doing so lowers the likelihood that the Board will have to reconsider the same issues in a subsequent trial.

Accordingly, Apple respectfully requests that the Board grant this motion for joinder.

## **II. STATEMENT OF MATERIAL FACTS**

1. The owner of the '789 Patent, Parthenon Unified Memory Architecture LLC ("Parthenon"), has filed suit against nine different companies—including Apple and Samsung—alleging infringement of the '789 Patent in the United States District Court for the Eastern District of Texas (the "Concurrent Litigation").

2. On June 5, 2015, Apple was served with a complaint captioned

*Parthenon Unified Memory Architecture LLC v. Apple Inc.*, 2:15-cv-00621

alleging infringement of the '789 Patent.

3. On September 22, 2015, Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively "Samsung") timely filed a Petition for *Inter Partes* Review challenging claims 1, 3-6, 11, and 13 of the '789 Patent. See *Samsung Elecs. Co., Ltd., et al. v. Parthenon Unified Memory Architecture, LLC*, IPR2015-01944, Paper 2 (PTAB Sept. 22, 2015).

4. On March 30, 2016, the Board entered a Decision instituting an *inter partes* review of claims 1, 3-6, 11, and 13 of the '789 Patent. See *Samsung*, IPR2015-01944, Paper 7.

5. Apple's Petition and this motion for joinder are being filed within one month of the institution date of the Samsung IPR.

### **III. STATEMENT OF REASONS FOR REQUESTED RELIEF**

#### **A. Legal Standards**

The Board has authority under 35 U.S.C. § 315(c) to join a party who files a proper *inter partes* review petition to a previously-instituted *inter partes* review proceeding. This authority is discretionary. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. The moving party has the burden of proof and should: (1) set forth the 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

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.