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Paper 9
Entered: May 24, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.,
Petitioner,

v.

PAPST LICENSING GMBH & CO. KG,
Patent Owner.

Case IPR2017-00672
Patent 8,966,144 B2

Before JONI Y. CHANG, JENNIFER S. BISK, and MIRIAM L. QUINN, *Administrative Patent Judges.*

CHANG, Administrative Patent Judge.

Institution of *Inter Partes* Review and Grant of Motion for Joinder
37 C.F.R. §§ 42.108 and 42.122(b)

I. INTRODUCTION

Apple Inc. ("Petitioner") filed a Petition requesting an *inter partes* review of claims 1–36, 38–56, 58–65, 67–74, and 77–87 of U.S. Patent No. 8,966,144 B2 ("the '144 patent"). Paper 1 ("Pet."). Petitioner also concurrently filed a Motion for Joinder, seeking to join this proceeding with *Panasonic Corp. et al., v. Papst Licensing GmbH & Co., KG*, Case IPR2016-01225 ("the Panasonic IPR"). Paper 3 ("Mot."). Patent Owner did not file a Preliminary Response; nor does it oppose Petitioner's Motion for Joinder. Paper 8.

For the reasons set forth below, we institute an *inter partes* review of claims 1–36, 38–56, 58–65, 67–74, and 77–87 of the '144 patent, and grant Petitioner's Motion for Joinder.

II. INSTITUTION OF *INTER PARTES* REVIEW

On December 15, 2016, we instituted a trial in IPR2016-01225 on the ground that claims 1–36, 38–56, 58–65, 67–74, and 77–87 are unpatentable under § 103(a) as obvious over the combination of McNeill, the SCSI Specification, and the Admitted Prior Art. Panasonic IPR, slip. op. at 35 (PTAB Dec. 15, 2016) (Paper 10). The instant Petition presents the same grounds of unpatentability, the same prior art, and the same declarant testimony as the petition in the Panasonic IPR. Pet. 11–13; Mot. 5–6. In view of the identity of the grounds in the instant Petition and in the Panasonic IPR petition, and for the same reasons stated in our Decision on Institution in the Panasonic IPR, we institute *inter partes* review in this proceeding on the same grounds discussed above and for the claims we instituted *inter partes* review in the Panasonic IPR.

III. GRANT OF MOTION FOR JOINDER

Joinder in *inter partes* review is subject to the provisions of 35 U.S.C. § 315(c):

> (c) JOINDER.—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 parties review under section 314.

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder should: (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *See* Frequently Asked Question H5, https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/ptab-e2e-frequently-asked-questions.

Petitioner asserts it has grounds for standing because, in accordance with 35 U.S.C. § 315(c), Petitioner filed a Motion for Joinder concurrently with the Petition and not later than one month after institution of the Panasonic IPR. Mot. 6. Patent Owner does not oppose Petitioner's Motion for Joinder based on the condition that the instant proceeding follows the same schedule of the Panasonic IPR. Paper 8. We find that the Motion for Joinder is timely.

We also find that Petitioner has met its burden of showing that joinder is appropriate. The Petition here is substantively identical to the petition in

the Panasonic IPR. Mot. 11–13. The evidence also is identical, including the reliance on the same Declaration of Paul F. Reynolds, Ph.D. *Id.* at 11.

Petitioner further has shown that the trial schedule will not be affected by joinder. Mot. 11–12. No changes in the schedule are anticipated or necessary, and the limited participation, if at all, of Petitioner will not impact the timeline of the ongoing trial. We limit Petitioner's participation in the joined proceeding such that Petitioner shall require prior authorization from the Board before filing *any* further paper. This arrangement promotes the just and efficient administration of the ongoing trial and the interests of Petitioner and Patent Owner.

IV. ORDER

In view of the foregoing, it is

ORDERED that IPR2017-00672 is hereby instituted for the ground that claims 1–36, 38–56, 58–65, 67–74, and 77–87 are unpatentable under § 103(a) as obvious over the combination of McNeill, the SCSI Specification, and the Admitted Prior Art.

FURTHER ORDERED that Petitioner's Motion for Joinder with IPR2016-01225 is *granted*;

FURTHER ORDERED that the grounds on which trial in IPR2016-01225 were instituted are unchanged and no other grounds are included in the joined proceeding;

FURTHER ORDERED that the Scheduling Order entered in IPR2016-01225 (Paper 11) and schedule changes agreed-to by the parties in IPR2016-01225 (pursuant to the Scheduling Order) shall govern the schedule of the joined proceeding;

FURTHER ORDERED that, throughout the joined proceeding, all filings in IPR2016-01225 will be consolidated and no filing by Petitioner Apple alone will be allowed without prior authorization by the Board;

FURTHER ORDERED that a copy of this Decision will be entered into the record of IPR2016-01225;

FURTHER ORDERED that IPR2017-00672 is terminated under 37 C.F.R. § 42.72 and all further filings in the joined proceeding are to be made in IPR2016-01225; and

FURTHER ORDERED that the case caption in IPR2016-01225 shall be changed to reflect joinder with this proceeding in accordance with the attached example.

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