

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 IPR2017-01038
Patent 9,189,437 B2

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

BISK, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review, Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. §§ 42.108, 42.122

Petitioner, LG Electronics USA, Inc., filed a Petition requesting *inter partes* review of claims 1–45 of U.S. Patent No. 9,189,437 B2 (Ex. 1003, “the ’437 patent”). Paper 1 (“Pet.”). Along with the Petition, LG filed a motion for joinder with IPR2016-01733, *Samsung Electronics Co., LTD. v. Papst Licensing GMBH & Co. KG*, a pending *inter partes* review involving the ’437 patent. Paper 3 (“Mot.”).¹

Patent Owner, Papst Licensing GMBH & Co. KG, filed a response to the Motion for Joinder indicating that it does not oppose the motion “on the condition that the consolidated proceeding is limited to the instituted grounds of IPR2016-01733, and subject to the conditions agreed to by LG in its motion.” Paper 6 (“Resp. to Mot.”). Patent Owner also indicated it waives its right to file a Preliminary Response in this proceeding in the event that we grant the Motion for Joinder. *Id.*

For the reasons set forth below, we conclude that LG has shown that the Petition warrants institution of *inter partes* review of claims 1–45 of the ’437 patent. This conclusion is consistent with our institution decision in IPR2015-01733. *See* Case No. IPR2016-01733, Paper 7. We exercise our discretion to join LG as a petitioner in IPR2016-01733.

¹ We note that the one-year time bar of 35 U.S.C. § 315(b) and 37 C.F.R. § 42.101(b) does not apply to LG’s request for joinder with IPR2016-01733. *See* Mot. 3; 35 U.S.C. § 315(b) (“The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).”); 37 C.F.R. §§ 42.101(b), 42.122(b) (“The time period set forth in § 42.101(b) shall not apply when the petition is accompanied by a request for joinder.”).

I. BACKGROUND

LG indicates that Patent Owner has asserted the '437 patent in a suit filed in the U.S. District Court for the Eastern District of Texas. Resp. to Mot. 6–7. In addition, the '437 patent is the subject of a pending *inter partes* review proceeding—IPR2016-01733. *Id.* at 5.

In IPR2016-01733, filed by Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc. (collectively, “IPR2016-01733 Petitioners”), we instituted *inter partes* review of claims 1–45 of the '437 patent on the grounds of unpatentability asserted in the present Petition. *Samsung Electronics Co., LTD. v. Papst Licensing GMBH & Co. KG*, Case IPR2016-01733 (PTAB Feb. 8, 2017) (Paper 7) (“IPR2016-01733 Inst. Dec.”).

II. PETITION FOR *INTER PARTES* REVIEW

LG’s Petition is substantively the same as that filed in IPR2016-01733 (Mot. 5). We incorporate our analysis from our institution decision in IPR2016-01733. IPR2016-01733 Inst. Dec. 2–40. For the same reasons, we determine that LG has demonstrated that the present Petition warrants institution of *inter partes* review of claims 1–45 based on the following grounds:

Challenged Claim(s)	Basis	References
1, 4–16, 18–31, 33–37, 41, 43, and 45	§ 103(a)	Aytac, the SCSI Specification, and Admitted Prior Art
2, 3, 17, 39, 40, 42, and 44	§ 103(a)	Aytac, the SCSI Specification, Admitted Prior Art, and Adaptec

Challenged Claim(s)	Basis	References
13 and 45	§ 103(a)	Aytac, the SCSI Specification, Admitted Prior Art, and TI Data Sheet
32	§ 103(a)	Aytac, the SCSI Specification, Admitted Prior Art, and Muramatsu
38	§ 103(a)	Aytac, the SCSI Specification, Admitted Prior Art, TI Data Sheet, and TI Patent
40	§ 103(a)	Aytac, the SCSI Specification, Admitted Prior Art, Adaptec, and TI Data Sheet

III. MOTION FOR JOINDER

In the Motion for Joinder, LG seeks to be joined as a party to IPR2016-01733. Mot. 5. LG filed the present Motion on March 6, 2017, within one month of our decision instituting *inter partes* review in IPR2016-01733. See IPR2016-01733 Inst. Dec.; Mot. Therefore, the Motion is timely under 37 C.F.R. § 42.122(b). See 37 C.F.R. § 42.122(b) (“Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested.”).

We agree with LG that joinder would not impact the substantive issues presented in IPR2016-01733. The grounds asserted in LG’s Petition that we determine above warrant institution of *inter partes* review are identical to the grounds on which we instituted review in IPR2016-01733—relying on the same prior art, evidence, and same arguments. See Mot. 11–14.

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In addition, based on LG's representations related to scheduling and discovery, we are persuaded that joinder would have minimal impact on the procedural aspects of IPR2016-01733. *Id.* Therefore, we are persuaded that joinder would not require any adjustment to or delay in the existing schedule of IPR2016-01733, and would not prevent the trial in IPR2016-01733 from being completed within one year of institution.

We conclude that LG has demonstrated that joinder would not unduly complicate or delay IPR2016-01733. We, likewise, are persuaded that joinder would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board.

Accordingly, we exercise our discretion to join LG as a petitioner in IPR2016-01733 subject to the representations made in the Motion for Joinder and the order below.

IV. ORDER

Accordingly, it is:

ORDERED that LG's Motion for Joinder with IPR2016-01733 is *granted*;

FURTHER ORDERED that LG Electronics, Inc. is joined as a petitioner in IPR2016-01733;

FURTHER ORDERED that, pursuant to 37 C.F.R. § 42.71, the Petition is dismissed;

FURTHER ORDERED that the instant proceeding, IPR2017-01038, is terminated under 37 C.F.R. § 42.72, and all further filings shall be made only in IPR2016-01733;

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