

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

EVOLVED WIRELESS LLC,
Patent Owner.

Case IPR2017-00106
Patent 8,218,481 B2

Before CHRISTOPHER L. CRUMBLY, PETER P. CHEN, and
TERRENCE W. McMILLIN, *Administrative Patent Judges*.

McMILLIN, *Administrative Patent Judge*.

DECISION
Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b)

I. INTRODUCTION

Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc., (collectively, “Samsung”) filed a Petition requesting an *inter partes* review of claims 1–4, 6, 8–11, and 13 of U.S. Patent No. 8,218,481 B2 (Ex. 1001, “the ’481 patent”). Paper 1 (“Pet.”). Concurrently with its Petition, Samsung filed a Motion for Joinder with *ZTE (USA) Inc., HTC Corporation, and HTC America, Inc. v. Evolved Wireless, LLC*, Case IPR2016-00758. Paper 2. On December 30, 2016, Samsung filed Petitioners’ Motion Requesting Partial Dismissal of Petition which states:

Petitioners hereby request partial dismissal of the instant IPR2017-00106 Petition as to those claims on which trial was not instituted in IPR2016-00758. Specifically, Petitioners request partial dismissal of the instant Petition *only* as to claims 4 and 11. Patent Owner Evolved Wireless, LLC does not oppose this request.

In light of the foregoing, Petitioners respectfully request that the Board institute an IPR on the remaining grounds in the instant Petition and grant their Motion for Joinder (Paper 2) with the IPR2016-00758 proceeding with respect to the instituted grounds.

Paper 13, 1.

Patent Owner, Evolved Wireless, LLC (“Evolved Wireless”), has not filed a preliminary response to the Petition.¹ Evolved Wireless filed an opposition to the Motion for Joinder (Paper 7) but since has withdrawn its opposition. For the reasons explained below, we grant the Motion for Joinder.

¹ The preliminary response was due on January 31, 2017. Paper 6, 1–2.

II. THE PETITION WARRANTS INSTITUTION OF *INTER PARTES* REVIEW

According to Samsung, the Petition in this proceeding “substantively copies the petition in co-pending IPR2016-00758” (Pet. 1.) and “raises the same grounds of unpatentability for which the 758 Proceeding was instituted, challenges the same claims, and relies of the same prior art, arguments and evidence.” Paper 2, 1–2. For the reasons set forth in our institution decision, Paper 12, in IPR2016-00758, we determine that the information presented in the Petition establishes there is a reasonable likelihood that Samsung will prevail in showing claims 1–3, 6, 8–10, and 13 of the ’481 patent are unpatentable.

III. GRANT OF MOTION FOR JOINDER

The Petition and Motion for Joinder in this proceeding were accorded a filing date of October 17, 2016. *See* Paper 6. Thus, the Motion for Joinder was timely because joinder was requested no later than one month after the institution date of IPR2016-00758, i.e., September 16, 2016.² *See* 37 C.F.R. § 42.122(b).

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.

² October 16, 2016, was a Sunday.

By regulation, the Director's discretion has been delegated to the board. 37 C.F.R. § 42.4(a). A motion for joinder should generally (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.

As noted, the Petition herein asserts the same unpatentability grounds on which we instituted trial in IPR2016-00758. Paper 2, 1–2. Samsung also relies on the same prior art analysis and expert testimony submitted by the Petitioner in IPR2016-00758. *Id.* Indeed, the instant Petition is nearly identical to the Petition in IPR2016-00758 with respect to the grounds on which trial was instituted. *Id.* Thus, this *inter partes* review does not present any ground or matter not already at issue in IPR2016-00758.

If joinder is granted, Samsung anticipates participating in the proceeding in a limited capacity. *Id.* at 2, 5, 8. Samsung agrees to:

(1) consolidate filings with ZTE and HTC; (2) refrain from raising any new grounds not already considered by the Board in the 758 Proceeding; (3) be bound by any agreement between Patent Owner and ZTE and HTC concerning discovery and/or depositions; (4) limit any direct, cross-examination or redirect time beyond that permitted for ZTE and HTC under either 37 C.F.R. § 42.53 or any agreement between ZTE and HTC and the Patent Owner, such that Petitioner's participation in the 758 Proceeding does not result in any additional time being required for any deposition; and (5) limit any presentation at oral hearing to unused time previously allocated to ZTE and HTC.

Id.

With regard to the trial schedule, joinder will require modification of the schedule entered in IPR2016-00758 (*see* Paper 13 (Scheduling Order) as

modified (*see* Papers 15, 21, 22, and 23). The Board has the authority to modify the schedule including the 1 year final determination time period. *See* 35 U.S.C. § 316(a)(11). We note that Evolved Wireless has withdrawn its opposition to joinder and that all the parties to this proceeding and IPR2016-00758 have agreed to a modified schedule which we adopt in the Revised Scheduling Order being entered on the same day as this Decision.

On the record before us, in particular the agreement between the parties, and having weighed the factors related to joinder, we exercise our discretion to grant the Motion for Joinder.

IV. ORDER

It is hereby:

ORDERED that the Motion for Joinder with IPR2016-00758 is granted;

FURTHER ORDERED that Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. are joined as petitioners in IPR2016-00758;

FURTHER ORDERED that the grounds for trial in IPR2016-00758 remain unchanged;

FURTHER ORDERED that the case caption in IPR2016-00758 shall be changed to reflect joinder of Samsung as a petitioner;

FURTHER ORDERED that the Revised Scheduling Order entered in the consolidated IPR2016-00758 shall replace the original Scheduling Order (Paper 13) as modified (Papers 15, 21, 22, and 23) and IPR2016-00758 shall proceed in accordance with the Revised Scheduling Order; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2016-00758.

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