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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS COMPANY, LTD.,
Petitioner,

v.

DANIEL L. FLAMM,
Patent Owner.

Case IPR2017-01746
Patent 6,017,221

Before CHRISTOPHER L. CRUMBLEY, JO-ANNE M. KOKOSKI, and KIMBERLY McGRAW, *Administrative Patent Judges.*

KOKOSKI, *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 Company, Ltd. ("Samsung") filed a Petition (Paper 1, "Pet.") to institute an *inter partes* review of claims 1–7 of U.S. Patent No. 6,017,221 (Ex. 1001, "the '221 patent"). Concurrently with its Petition, Samsung filed a Motion for Joinder (Paper 3, "Motion" or "Mot."), seeking to join, as a Petitioner, with *Micron Technology, Inc. v. Daniel L. Flamm*, Case IPR2017-00391 ("the Micron IPR"). Patent Owner Daniel L. Flamm ("Flamm") did not file an opposition to Samsung's Motion. Micron Technology, Inc., Intel Corporation, and GLOBALFOUNDRIES U.S. Inc. (collectively, "the Micron Petitioners"), the petitioners in the Micron IPR, filed a Partial Opposition to Samsung's Motion (Paper 7, "Opposition" or "Opp."), and Samsung filed a Reply (Paper 8, "Reply"). On September 12, 2017, Flamm filed a Notice electing to waive a preliminary response to the Petition. Paper 9.

For the reasons set forth below, we grant Samsung's Motion for Joinder.

II. DISCRETION TO GRANT JOINDER

The controlling statute regarding joinder of *inter partes* reviews is 35 U.S.C. § 315(c), which reads as follows:

> (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 partes review under section 314.

By regulation, the Director's discretion has been delegated to the Board. 37 C.F.R. § 42.4(a). We, therefore, have discretion to join Samsung to the instituted Micron IPR if we determine that Samsung's Petition warrants institution of an *inter partes* review.

The grounds of unpatentability asserted in the instant Petition are the same as those presented in the Micron IPR. *Compare* Pet. 5–7, *with* IPR2016-00391, Paper 1, 6–9; *see also* Ex. 1034, 28–30[1] (comparison document showing redlined differences between the Micron IPR Petition and Samsung's Petition). Samsung states that its Petition includes the same grounds and arguments as those in the Micron IPR, and notes that it challenges the same claims of the same patent, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the Micron IPR Petition. Mot. 4.

We previously determined, upon consideration of the Micron IPR Petition and Flamm's Preliminary Response, that the record in the Micron IPR established a reasonable likelihood that the Micron Petitioners would prevail with respect to all challenged claims on all presented grounds. IPR2017-00391, Paper 10, 28–30. Given the identical grounds and evidence presented in the present proceeding, we likewise determine that Samsung's Petition warrants institution on all presented grounds. We rely on, and hereby incorporate by reference, the reasoning set forth in our Decision on Institution in the Micron IPR. *See id*. at 7–28.

[1] The cited page numbers in Ex. 1034 refer to the numbers added by Samsung in the bottom left corner of the page.

III. GRANT OF MOTION FOR JOINDER

Having determined that Samsung's Petition warrants institution, we must determine whether to exercise our discretion to join Samsung as a party to the Micron IPR. As the moving party, Samsung bears the burden of showing that joinder is appropriate. 37 C.F.R. §§ 42.20(c), 42.122(b). A motion for joinder should: (1) set forth the reasons why joinder is appropriate; (2) identify any new grounds of unpatentability; (3) explain what impact (if any) joinder would have on the trial schedule; and (4) address specifically how briefing and discovery may be simplified. *See* Frequently Asked Question ("FAQ") H5 on the Board's website at https://go.usa.gov/xRHCf.

As noted, Samsung's Petition asserts the same grounds of unpatentability on which we instituted review in the Micron IPR. *See* Mot. 4; Pet. 5–7; Ex. 1034, 28–30; IPR2017-00391, Paper 10, 28–30. Samsung also relies on the same prior art analysis and expert testimony submitted by the Micron Petitioners. *See* Mot. 4. Indeed, Samsung's Petition is identical to the Micron IPR Petition with respect to the grounds on which review was instituted in the Micron IPR. *See id.*; Ex. 1034, 28–99. Thus, this *inter partes* review does not present any ground or matter not already at issue in the Micron IPR.

If joinder is granted, "Samsung explicitly agrees to take an 'understudy' role" in the joined proceeding, so long as any of the Micron Petitioners remains an active party. Mot. 6. In particular, Samsung agrees that, in the joined proceeding,

> a) all filings by Samsung in the joined proceeding be consolidated with the filings of [the Micron Petitioners], unless a filing concerns issues solely involving Samsung; b) Samsung

> shall not be permitted to raise any new grounds not already instituted by the Board in the Micron IPR, or introduce any argument or discovery not already introduced by [the Micron Petitioners]; c) Samsung shall be bound by any agreement between [Flamm] and [the Micron Petitioners] concerning discovery and/or depositions; and d) Samsung at deposition shall not receive any direct, cross examination or redirect time beyond that permitted under either 37 C.F.R. § 42.53 or any agreement between [Flamm] and [the Micron Petitioners].

Id. at 7 (citing *Noven Pharmas., Inc. v. Novartis AG*, Case IPR2014-00550, slip. op. at 5 (PTAB April 10, 2015) (Paper 38)). Because Samsung will not assume an active role in the Micron IPR "[u]nless and until [the Micron Petitioners] cease to participate" in the Micron IPR, Samsung submits that joinder will not impact the trial schedule for the Micron IPR. *Id.*

The Micron Petitioners state that they "do not object to joinder if Samsung is limited to a truly passive role, but they do object to the extent Samsung's terms go beyond a truly passive role or would prompt [Flamm] to attempt to raise a privity challenge based on any required coordination." Opp. 3. In particular, the Micron Petitioners argue that "Samsung's motion appears to require coordination with" the Micron Petitioners, and "seeks at least some deposition examination time." *Id.* at 3–4 (citing Mot. 7). According to the Micron Petitioners, this "would create additional and unnecessary work" for them, and would increase the complexity and cost of the Micron IPR. *Id.* at 4. Additionally, the Micron Petitioners argue that, due to Samsung's earlier bar date, they "have taken great care not to coordinate or work with Samsung" on the Micron IPR "in order to avoid any argument by [Flamm] regarding privity." *Id.* The Micron Petitioners further argue that "[t]hey should not be forced to do so now in the absence of either"

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