

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.
Petitioner,

v.

FASTVDO LLC
Patent Owner.

Case IPR2017-00683
Patent 5,850,482

**PATENT OWNER'S OPPOSITION TO PETITIONER'S REQUEST
TO JOIN THE CURRENT PROCEEDING WITH IPR2016-01203**

Because Petitioner would otherwise be statutorily time-barred from filing a petition for *inter partes* review of U.S. Patent No. 5,850,482, Petitioner asks the Board to join the current proceeding with IPR2016-01203 pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b). However, while Petitioner proposes to take an “understudy role,” the actual concessions proposed by Petitioner’s joinder request contradict the “understudy” characterization and permit Petitioner to take a much more active role in the proceedings. Additionally, any prejudice that inures to Petitioner if the Board denies its joinder request is a result of Petitioner’s decision not to file its petition within the statutorily authorized time. Accordingly, Patent Owner FastVDO LLC opposes Petitioner’s request for joinder of the current proceeding with IPR2016-01203.

I. Petitioner’s Proposed Concessions for Joinder Unfairly Complicate the Proceedings for Patent Owner

As non-binding support for its motion to join this proceeding with IPR2016-01203, Petitioner cites to *Nintendo of America, Inc. and Nintendo Co., Ltd. v. Babbage Holdings, LLC*, IPR2015-00568, in which petitioner Nintendo represented that it would take an “understudy” role. Paper 4 at 3. While Petitioner LG Electronics Inc. (“LGE”) also offers to take an “understudy” role, the concessions proposed here give Petitioner a much more substantial role in the

proceeding (*see* Paper 4 at 8, ¶a.) and unfairly prejudice Patent Owner. One concession among those proposed by Petitioner is the following:

[Petitioner LG Electronics, Inc.] will coordinate with counsel for Apple in the ‘1203 IPR regarding the consolidation of all filings and will not submit any separate filings unless, after consultation with Apple, LGE needs to preserve a position for the record, in which case LGE would limit any additional filing to five (5) pages or less;

See Paper 4 at 2. This term does not relegate Petitioner to an “understudy” role in this proceeding but rather gives Petitioner the benefit of Apple’s and Petitioner’s consolidated filing *plus* Petitioner’s own substantive submission of up to five pages into the record. Further, in the contradictory statement that follows this proposed concession, Petitioner asserts that allowing it to file its own five-page brief on any issue, above and beyond the consolidated filing, would “greatly simplify briefing.” *Id.* at 3. To the contrary, Petitioner’s proposed concession greatly complicates briefing and increases Patent Owner’s burden to untangle Petitioner’s position as presented in the two separate filings.

Other Board decisions have implemented more restrictive limitations when joining proceedings. For example, in *Torrent Pharmaceuticals Ltd. v. UCB Pharma GMBH*, IPR2016-01636 (PTAB Dec. 7, 2016) (Paper 10), the Board

accepted the following concessions from the moving petitioner seeking joinder with an earlier-filed case:

In its Motion for Joinder, Petitioner asserts that it “will maintain a secondary, ‘understudy’ role in the joined proceeding.” Mot. 7. In that regard, Petitioner represents that it will “coordinate with Mylan to provide consolidated filings within the page limits and will not submit any separate filings unless and until Mylan settles with [Patent Owner] or the Mylan IPR is otherwise terminated.” *Id.* at 8. Petitioner also represents that it will not “seek additional time for depositions or oral argument.” *Id.*

Id. at 5. Here, Petitioner LGE offers to coordinate with Apple, and even raises the risk of Apple’s settlement as the reason that Petitioner filed its Petition and motion. Paper 4 at 9 (“LGE is filing this petition and joinder Request to ensure that the trial is completed in the event that the current petitioners in the ‘1203 IPR reach settlement with the Patent Owner.”). But Petitioner does not condition its right to submit its own filing if (and only if) Apple settles with Patent Owner or is otherwise terminated. Petitioner also does not condition its own filing in the event that it disagrees with a position taken by Apple in IPR2016-01203, or

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if its filing raises an issue unique to Petitioner. The condition for Petitioner's own five-page submission on any issue in the proceeding is satisfied if Petitioner in its own discretion "needs to preserve a position for the record." Paper 4 at 2.

In *Torrent Pharmaceuticals*, even under the more restrictive concessions proposed by the movant seeking joinder, the Board ordered the movant to "seek authorization from the Board to file a separate paper," and only permitted such a request where the "filing involves an issue unique to Petitioner or states a point of disagreement related to the consolidated filing." *Torrent Pharmaceuticals Ltd. v. UCB Pharma GMBH*, IPR2016-01636, slip op. at 5-6 (PTAB Dec. 7, 2016) (Paper 10); see also *Amerigen Pharmaceuticals Ltd. v. UCB Pharma GMBH*, IPR2016-01665, slip op. at 6 (PTAB Dec. 7, 2016) (Paper 8). Here, Petitioner LGE does not seek to limit itself so, and does not propose to alleviate any unfair prejudice to Patent Owner in having to address both the consolidated petitioner submission and LGE's separate submission. For example, Petitioner LGE's concessions do not preclude Petitioner LGE from using its own expert in support of any future filings. This would have the effect of duplicating Patent Owner's cross-examination burden, and would be particularly prejudicial to Patent Owner during the shortened period available for cross-examination of any reply declarant.

Further distinguishing itself from *Torrent Pharmaceuticals*, Petitioner LGE also does not restrict its right to seek additional time for depositions or oral

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