

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OLYMPUS CORPORATION and OLYMPUS AMERICA INC.,
Petitioner,

v.

PAPST LICENSING GMBH & CO. KG,
Patent Owner.

Case IPR2017-01617
Patent 6,895,449 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 and Grant of Motion for Joinder
37 C.F.R. §§ 42.108 and 42.122(b)

I. INTRODUCTION

Olympus Corporation and Olympus America Inc. (collectively, “Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–10, 12, 13, and 15–18 of U.S. Patent No. 6,895,449 B2 (“the ’449 patent”). Paper 2 (“Pet.”). Petitioner also concurrently filed a Motion for Joinder, seeking to join this proceeding with *LG Electronics, Inc., and ZTE (USA) Inc., v. Papst Licensing GmbH & Co., KG*, Case IPR2017-00415 (“the LG IPR”). Paper 3 (“Mot.”). Patent Owner did not file a Preliminary Response; nor does it oppose Petitioner’s Motion for Joinder.

For the reasons set forth below, we institute an *inter partes* review of claims 1–10, 12, 13, and 15–18 of the ’449 patent, and grant Petitioner’s Motion for Joinder.

II. INSTITUTION OF *INTER PARTES* REVIEW

On May 17, 2017, we instituted a trial in IPR2017-00415 based on the following grounds of unpatentability (the LG IPR, slip op. at 18–19 (PTAB May 17, 2017) (Paper 8)):

Challenged Claim(s)	Basis	References
1–3, 6–10, 12, 13, and 15–18	§ 103(a)	Murata, Schmidt, and MS-DOS Encyclopedia
4 and 5	§ 103(a)	Murata, Schmidt, MS-DOS Encyclopedia, and Beretta

This Petition presents the same grounds of unpatentability, the same prior art, and the same declarant testimony as the petition in the LG IPR. Pet. 8–9; Mot. 5–6. In view of the identity of the grounds in this Petition and in the LG IPR petition, and, for the same reasons stated in our Decision

on Institution in the LG IPR, we institute *inter partes* review in this proceeding on the same grounds discussed above and for the same claims we instituted *inter partes* review in the LG 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 LG IPR. Mot. 5–6. Patent Owner did not file any opposition to Petitioner’s Motion for Joinder. 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 LG IPR. Mot. 5–6. The evidence also is identical, including the reliance on the same Declaration of Kevin C. Almeroth, Ph.D. *Id.* at 6.

Petitioner further has shown that the trial schedule will not be affected by joinder. Mot. 5–6. 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 panel 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, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted for the following grounds of unpatentability:

Challenged Claim(s)	Basis	References
1–3, 6–10, 12, 13, and 15–18	§ 103(a)	Murata, Schmidt, and MS-DOS Encyclopedia
4 and 5	§ 103(a)	Murata, Schmidt, MS-DOS Encyclopedia, and Beretta

FURTHER ORDERED that Petitioner’s Motion for Joinder with IPR2017-00415 is *granted*;

FURTHER ORDERED that the ground on which trial in IPR2017-00415 was instituted is unchanged, and no other grounds are included in the joined proceeding;

IPR2017-01617
Patent 6,895,449 B2

FURTHER ORDERED that the Scheduling Order entered in IPR2017-00415 (Paper 9) and schedule changes agreed-to by the parties in IPR2017-00415 (pursuant to the Scheduling Order) shall govern the schedule of the joined proceeding;

FURTHER ORDERED that, throughout the joined proceeding, all filings in IPR2017-00415 will be consolidated, and no filing by Petitioner Olympus alone will be considered without prior authorization by the Board;

FURTHER ORDERED that a copy of this Decision will be entered into the record of IPR2017-00415;

FURTHER ORDERED that IPR2017-01617 is terminated under 37 C.F.R. § 42.72 and all further filings in the joined proceeding are to be made in IPR2017-00415; and

FURTHER ORDERED that the case caption in IPR2017-00415 shall be changed to reflect joinder with this proceeding in accordance with the attached example.

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