

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASUS COMPUTER INTERNATIONAL, INC.,
Petitioner,

v.

JAMES GOODMAN
Patent Owner.

Case IPR2018-00047
Patent 6,243,315 B1

Before BRIAN J. McNAMARA, PATRICK M. BOUCHER, and
KIMBERLY McGRAW, *Administrative Patent Judges*.

McGRAW, *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

On October 12, 2017, ASUS Computer International (“ACI” or “Petitioner”) filed a Petition requesting *inter partes* review of claims 1–20 of U.S. Patent No. 6,243,315 (Ex. 1001, “the ’315 patent”). Paper 2 (“Pet.”). Concurrently with its Petition, ACI filed a Motion for Joinder with *Samsung Electronics America, Inc. v. James B. Goodman*, Case IPR2017-02021 (“the 2021 IPR”). Paper 3 (“Mot.”). James B. Goodman (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

For the reasons explained below, we institute an *inter partes* review of claims 1–20 of the ’315 patent and grant ACI’s Motion for Joinder.

II. RELATED PROCEEDINGS

ACI identifies the following pending judicial matters in which Patent Owner asserted the ’315 patent: *James B. Goodman v. ASUS Computer International, Inc.*, Case No. 4:16-cv-03232 (S.D. Tex., filed November 2, 2016), transferred to the Northern District of California, Case No. 17-cv-05542-JD; *Goodman v. Hewlett-Packard Co.*, Case No. 4:16-cv-03195 (S.D. Tex.); and *Goodman v. Samsung Electronics America, Inc.*, Case No. 1:17-cv-05539-VSB (S.D.N.Y.). Pet. 5. Patent Owner also identifies *Goodman v. Lenovo (United States) Inc.*, Case No. 17-cv-06782 (N.D. Ca.) and *Goodman v. Acer American Corporation*, Case No. 17-cv-07297 (N.D. Ca) as currently pending cases in which the ’315 patent is asserted. Prelim. Resp. 3.

The ’315 patent has also been the subject of three additional petitions for *inter partes* review. In *SMART Modular Technologies, Inc. v. Goodman*, Case IPR2015-01675 (PTAB February 11, 2016) (Paper 6), the Board instituted *inter partes* review, and subsequently granted the parties’ joint

motion to terminate (Paper 20). The Board also instituted *inter partes* review in *HP, Inc. v. James B. Goodman*, Case IPR2017-01994 (PTAB March 9, 2018) (Paper 6) and in *Samsung Electronics America, Inc. v. James B. Goodman*, Case IPR2017-02021 (PTAB March 9, 2018) (Paper 7, the “2021 IPR Decision on Inst.”), which are both currently pending.

III. INSTITUTION OF *INTER PARTES* REVIEW

On March 9, 2018, we instituted a trial in *Samsung Electronics America, Inc. v. James B. Goodman*, Case IPR2017-02021 (the “2021 IPR”) on the following asserted grounds of unpatentability:

- (a) claims 1 and 5 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Dell;
- (b) claims 10 and 16 are unpatentable under 35 U.S.C. § 103(a) over Dell and Abe;
- (c) claims 2–4 and 6–9 are unpatentable under 35 U.S.C. § 103(a) over Dell and JESD21-C;
- (d) claims 11–15 and 17–20 are unpatentable under 35 U.S.C. § 103(a) over Dell, Abe, and JESD21-C;
- (e) claims 1 and 5 are unpatentable under 35 U.S.C. § 103(a) over Ooishi and Palaniswami; and
- (f) claims 10 and 16 are unpatentable under 35 U.S.C. § 103(a) over Ooishi, Palaniswami, and Abe.

2021 IPR Decision on Inst. 20. The instant Petition is nearly identical to the petition filed in the 2021 IPR and presents the same grounds of unpatentability, the same prior art, and the same declarant testimony as the petition in the 2021 IPR. *Compare* Pet., with IPR2017-02021, Paper 2. The arguments presented in Patent Owner’s Preliminary Response opposing

IPR2018-00047
Patent 6,243,315 B1

institution are nearly identical to the arguments presented in Patent Owner's preliminary response filed in the 2021 IPR. *Compare* Prelim. Resp. with IPR2017-02021, Paper 6.

In view of the identity of the grounds in the instant Petition and in the 2021 IPR petition, and the already-considered arguments from Patent Owner proffered in the 2021 IPR, we institute *inter partes* review in this proceeding on the grounds presented in the Petition for the same reasons stated in our Decision on Institution in the 2021 IPR. We do not institute *inter partes* review on any other grounds.

IV. 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 partes* 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>; *see also* *Kyocera Corp. v. SoftView LLC*, Case IPR2013–00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15) (representative)

(stating that the motion for joinder should also specifically address how briefing and discovery may be simplified).

ACI asserts its Motion for Joinder is timely under 35 U.S.C. § 315(c) and 37 C.F.R § 42.122(b) because it was filed (1) within one year of its waiver of service of the complaint in *James B. Goodman v. ASUS Computer International, Inc.*, Case No. 4:16-cv-03232 (S.D. Tex., filed November 2, 2016), which was executed on November 28, 2016, and (2) before the Board issued an institution decision in the 2021 IPR. Mot. 8.

ACI also states that joinder is appropriate because its Petition challenges the same patent claims on the same grounds as the 2021 IPR petition and relies on the same legal theories and expert declaration relied on by the 2021 IPR petitioner, Samsung Electronics America, Inc. (“Samsung”). *Id.* at 4–5, 8–9. ACI states that unless Samsung settles with Patent Owner, “ACI will take an understudy role” and “will not submit separate filings to the PTO unless it disagrees with the positions of the current petitioner.” *Id.* at 10. ACI offers, in the event of such disagreement, to limit any such separate filing to not exceed seven pages. *Id.* ACI further states that ACI and Samsung will address the same prior art using the same expert, resulting in no additional expert discovery, that ACI will cooperate with counsel for Samsung on all briefing and discovery, that ACI agrees to all applicable deadlines in the 2021 IPR Scheduling Order, and that the trial schedule will not be affected by joinder. *Id.* at 9–10. ACI also states that Samsung does not oppose ACI’s motion for joinder. *Id.* at 7.

Patent Owner opposes the joinder motion and queries whether ACI’s Petition “enable[s] Samsung to have the proverbial ‘two bites from the apple’ in the arguments presented to the PTAB.” Prelim. Resp. 3. Patent

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