

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG Electronics, Inc., LG Electronics U.S.A. Inc.,
LG Electronics Mobilecomm U.S.A. Inc., LG Electronics Mobile Research U.S.A.
LLC, and LG Electronics Alabama, Inc.
Petitioner,

v.

Fundamental Innovation Systems International LLC,
Patent Owner.

Case IPR2018-00460
Patent No. 8,624,550

**PATENT OWNER'S OPPOSITION
TO PETITIONERS' JOINDER MOTION**

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Patent Owner Fundamental Innovation Systems International LLC ("Fundamental") opposes the motion for joinder filed by LG Electronics, Inc., LG Electronics U.S.A. Inc., LG Electronics Mobilecomm U.S.A. Inc., LG Electronics Mobile Research U.S.A. LLC, and LG Electronics Alabama, Inc. (collectively "LG" or "Petitioners"). In particular, no trial has been instituted in IPR2018-00110, the proceeding that LG now seeks to join. LG's motion is therefore premature and its request that the Board considers its joinder motion before deciding whether to terminate IPR2018-00110 (should Petitioners in IPR2018-00110 so request) contradicts the Board's prior rulings. *E.g.*, *Fifth Third Bank v. Stambler*, IPR2014-00244, Paper 4 (PTAB, Dec. 17, 2003) (denying motion to join a proceeding that is terminated before trial was instituted); *Amneal Pharmaceuticals LLC v. Hospira, Inc.*, IPR2017-01054, Paper 9 (PTAB, Sept. 6, 2017) (terminating original IPRs before deciding the joinder's motion even though the motion was filed after institution and 2.5 months before the termination decision).

Additionally, although LG alleges that its petition is substantively similar to the IPR2018-00110 petition, LG petition would add significant complexity. For example, LG admits at least five entities are real parties in interest in its petitions, but given LG's opaque and complicated corporate structures, discovery will be needed to determine whether LG has named all the entities along the corporate chains between and among those parties.

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Amazon.com, Inc. v. Appistry, Inc., IPR2015-00480 paper no. 18 (PTAB Jul. 13, 2015) (failing to name two entities on the corporate chain between Amazon and AWS constitutes a failure to name all real parties in interest). Adding LG will therefore require significant discovery. *Unified Patents Inc. v. C-Cation Technologies, LLC*, IRP2015-01045, Paper 15 (PTAB, Oct. 7, 2015) (denying joinder motion because "the real party-in-interest issue potentially could sidetrack the joined proceeding, shifting the focus away from the substantive issue to be addressed). Furthermore, adding LG would require Patent Owner to coordinate with three different sets of attorneys for conference calls, discovery and depositions, making things inherently more complicated.

For at least the above reasons, LG's motion for joinder should be denied.

I. Legal Standards

Pursuant to 35 U.S.C. § 315(c), the Board has the discretion, but not the obligation, to grant a joinder motion. As LG concedes, it bears "the burden of proof and should: (1) set forth the 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." Mot. 3.

The Board's past decisions on joinder motions make clear that a joinder motion should be denied when "there is no pending proceeding for Petitioner to

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join." *Amneal Pharms. LLC v. Hospira, Inc.*, IPR2017-01054, Paper 9 (PTAB, Sep. 6, 2017) (denying Fresenius' joinder motion as moot because the IPR it seeks to join has terminated after institution). The Board also makes clear that even when the patentability grounds are allegedly substantively the same, other issues, such as real parties-in-interest, may justify denying a joinder motion because granting the motion "could complicate, rather than simplify, briefing and discovery in the" original IPR. *Unified Patents Inc. v. C-Cation Technologies, LLC*, IRP2015-01045, Paper 15 at 7 (PTAB, Oct. 7, 2015). Moreover, when more than one party is already involved in a proceeding, such as in this case where ZTE and Samsung jointly filed the petition, the need for an additional "understudy" is lessened. *Id.*

II. LG's Joinder Motion Should Be Denied

A. LG's Joinder Motion Is Premature

LG admits that its motion was "filed before a decision on institution of the ZTE/Samsung IPR." Mot. 2. In the ZTE/Samsung IPR, the patent owner's preliminary response is not due until February 13, 2018, and the Board's decision is not due until May 13, 2018. Thus, there will be no instituted proceedings for LG to join for another three months. LG's motion is therefore premature.

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B. The Board Should Not Grant LG's Request That Its Motion Be Decided Before the Board Determines Whether to Terminate the ZTE/Samsung IPR

LG requests that "if ZTE/Samsung moves to terminate the ZTE/Samsung IPR and is dismissed before the Board decides this Motion for Joinder, LGE respectfully requests that the Board exercise its discretion and decline to terminate the Patent Owner at least until the Board considers this motion." Mot. 4-5. LG cites no authority for this request. To the contrary, the Board has denied similar requests in the past. In *Fifth Third Bank v. Stambler*, IPR2014-00244, Paper 4 (PTAB, Dec. 17, 2003), Fifth Third Bank attempted to join IPR2013-00341 when the original petitioner and the patent owner were discussing settlement. The Board subsequently terminated IPR2013-00341 and denied Fifth Third Party's joinder motion as a result. *Id.*

Similarly, in *Amneal Pharmaceuticals LLC v. Hospira, Inc.*, IPR2017-01054, Paper 9 (PTAB, Sept. 6, 2017), Fresenius Kabi USB, LLC filed a motion to join the proceeding. Fresenius filed its motion on March 8, 2017, within one month that the Board instituted the underlying *inter partes* proceeding. The Board terminated the underlying proceeding on May 19, 2017. *See* IPR2016-01577, Paper 19 (PTAB, May 19, 2017). Thereafter, on September 6, 2017, the Board denied Fresenius' motion as moot.

Hence, there is no reason for the Board to base its termination decisions on LG's pending motion. Had LG really wanted to join the proceeding, it

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