

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GARMIN INTERNATIONAL, INC., GARMIN USA, INC.,  
AND GARMIN LTD.

Petitioner

v.

PHILIPS NORTH AMERICA LLC,  
Patent Owner

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Case No. IPR2020-00910

U.S. Patent No. 7,088,233

**MOTION FOR JOINDER UNDER  
35 U.S.C. § 315(c) AND 37 C.F.R. §§ 42.22 AND 42.122(b)  
TO RELATED *INTER PARTES* REVIEW IPR2020-00783**

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## I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Garmin International, Inc., Garmin USA, Inc., and Garmin Ltd. (collectively “Petitioner” or “Garmin”) respectfully submit this Motion for Joinder with a concurrently-filed Petition for *Inter Partes* Review of U.S. Patent No. 7,088,233 (the “Garmin IPR” or the “Garmin Petition”). Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner requests institution of an *inter partes* review and joinder with the *inter partes* review in *Fitbit, Inc. v. Philips North America LLC*, IPR2020-00783 (the “Fitbit IPR” or the “Fitbit Petition”), which is currently awaiting a decision on institution. Petitioner’s request for joinder is timely under 37 C.F.R. §§ 42.22 and 42.122(b), as it is submitted no later than one month after the institution date of the Fitbit IPR. The Garmin IPR is also narrowly tailored to the same claims, prior art, and grounds for unpatentability that are the subject of the Fitbit IPR. In addition, Petitioner is willing to streamline discovery and briefing.

Petitioner submits that joinder is appropriate because it will not unduly burden or prejudice the parties to the Fitbit IPR while efficiently resolving the question of the ’233 Patent’s validity in a single proceeding.

## II. STATEMENT OF MATERIAL FACTS

1. On April 8, 2020, Fitbit filed a petition for *inter partes* review challenging claims 1, 7-10, 13-16, 22 and 24-26 (“the Challenged Claims”) of the ’233

Patent. *See Fitbit IPR*, IPR2020-00783, Paper 1 at 2-3. A decision on institution has not yet been entered.

2. The '233 Patent is subject to the following district court litigation:

- *Philips North America LLC v. Garmin International, Inc., Garmin USA, Inc., and Garmin LTD.*, Case No. 2:19-cv-6301 (C.D. Cal. 2019); and
- *Philips North America LLC v. Fitbit, Inc.*, Case No. 1:19-cv-11586-IT (D. Mass.).

### III. STATEMENT OF THE PRECISE RELIEF REQUESTED

#### A. Legal Standard

The Board has the authority under 35 U.S.C. § 315(c) to join a properly filed *inter partes* review petition to an instituted *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). A motion for joinder must be filed within one month of the Board instituting an original *inter partes* review. 37 C.F.R. § 42.122(b). In deciding whether to exercise its discretion and permit joinder, the Board considers factors, including: (1) the reasons why joinder is appropriate; (2) whether the new petition presents any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

## **B. Petitioner’s Motion for Joinder Is Timely**

This Motion for Joinder is timely because it is filed within one month of the institution decision of the Fitbit IPR (no institution has been entered as of the filing date of the Garmin IPR). *See* 37 C.F.R. § 42.122(b). Although not applicable to an IPR filed with a timely motion for joinder, Garmin is within the one-year statutory deadline for filing an IPR, as Garmin was served with a complaint asserting the ’233 Patent no earlier than July 23, 2019.

## **C. Each Factor Weighs in Favor of Joinder**

Each of the four factors considered by the Board weighs in favor of joinder here. Specifically, the Garmin Petition does not present any new grounds of unpatentability; rather it is substantively identical to the Fitbit Petition. Further, joinder will have minimal, if any, impact on the trial schedule, as all issues are substantively identical and Petitioner will accept an “understudy” role. *See Sony Corp., et al. v. Memory Integrity, LLC*, IPR2015-01353, Paper 11 at 5-6 (PTAB Oct. 15, 2015) (granting IPR where petitioners requested an “understudy” role); *see also id.* at Paper 4 at 5-7 (Motion for Joinder discussing “understudy” role). Lastly, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

Accordingly, joinder is appropriate here. *See id.* at Paper 11 at 5-6 (granting institution of IPR and motion for joinder where petitioners relied “on the same prior

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