

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.; AND
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner

v.

NEODRON LTD.
Patent Owner.

Case IPR2020-01119
Patent No. 7,821,425

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

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, “Petitioner”) move for joinder with the *Inter Partes* Review of U.S. Patent No. 7,821,425 (“the ’425 Patent”), *Apple Inc. et al. v. Neodron Ltd.*, IPR2020-00778 (“the Apple IPR”), for which the petition for *Inter Partes* Review was filed on April 16, 2020, and is currently pending. IPR2020-00778, paper 4. This motion is timely because it is filed “no later than one month after the institution date” of the Apple IPR. 37 C.F.R. § 42.122(b); *Central Security Group – Nationwide, Inc. v. Ubiquitous Connectivity, LP*, IPR2019-01609, Paper 11, at 8-9 (P.T.A.B. Feb. 26, 2020) (stating that § 42.122(b) is “[t]he only timing requirement for a motion for joinder”). Petitioner requests that action on this motion be held in abeyance until, and only if, an IPR is instituted in the Apple IPR. Petitioner understands that the petitioners in the Apple IPR (Apple Inc. and Microsoft Corporation, collectively, “the Apple Petitioners”) do not oppose Petitioner’s requests for joinder.

Petitioner requests institution of this Petition for *Inter Partes* Review filed on June 17, 2020. The Petition is a carbon copy of the original Apple IPR petition in all material respects. The only substantive changes are in the introduction to identify the correct Petitioner and the mandatory notices under 37 C.F.R. § 42.8(b). The Petition here and the Apple IPR petition challenge the same claims of the ’425 patent

on the same grounds relying on the same prior art and evidence, including a declaration identical in substance from the same expert.¹

Petitioner agrees to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the Apple IPR as instituted. Thus, the Petition warrants institution under 35 U.S.C. § 314, and 35 U.S.C. § 315(c) permits Petitioner's joinder to the Apple IPR.

Further, if joined, Petitioner agrees to adhere to all applicable deadlines in the Apple IPR and coordinate all filings with the Apple Petitioners in the Apple IPR. The Apple Petitioners will maintain the lead role in the proceedings so long as they are parties to the proceedings and are not estopped under § 315(e)(1). Petitioner will only assume the lead role in the proceedings if the Apple Petitioners are no longer parties to the proceedings or unable to advance arguments for one or more claims, or grounds, for example, because of § 315(e)(1). Petitioner agrees to consolidated filings for all substantive papers in the proceeding. The Apple Petitioners and Petitioner will be jointly responsible for the consolidated filings. Absent a Board order precluding the Apple Petitioners from making arguments that would otherwise be available to Petitioner, Petitioner will not advance any arguments separate from

¹ The declaration has been updated only to reflect retention by Petitioner and is otherwise identical to the declaration submitted in the Apple IPR.

those advanced by the Apple Petitioners in the consolidated filings. These limitations will avoid lengthy and duplicative briefing. Also, Petitioner will not seek additional depositions or deposition time, and will coordinate deposition questioning and hearing presentations with the Apple Petitioners. Petitioner agrees to the foregoing conditions even in the event that other IPRs filed by other, third-party petitioners are joined with the Apple IPR.

Joinder will help efficiently resolve the disputes among the parties. By joinder, a single Board decision may dispose of the issues raised in the Apple IPR for all interested parties. Further, the Patent Owner has asserted the '425 patent in district court against Petitioner. Joinder will estop Petitioner from asserting in district court those issues resolved in a final decision from the Apple IPR, thus narrowing the issues in the district court actions. *See* 35 U.S.C. § 315(e)(2). Finally, joinder would not complicate or delay the Apple IPR, and would not adversely affect any schedule set in that proceeding. In sum, joinder would promote efficient adjudication. On the other hand, if instituted, maintaining the Petitioner's IPR proceeding separate from that of the Apple IPR would entail needless duplication of effort.

Joinder will not unduly prejudice any party. Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or increase needless filings, any additional costs on the Patent Owner would be minimal. On the other

hand, denial of joinder would prejudice Petitioner. Their interests may not be adequately protected in the Apple IPR proceedings, particularly if the Apple Petitioners settle with the Patent Owner. Petitioner should be allowed to join in a proceeding affecting a patent asserted against them.

II. BACKGROUND AND RELATED PROCEEDINGS

Neodron Ltd. (the “Patent Owner”) is the owner of the ’425 patent. The Patent Owner asserted the ’425 Patent against Petitioner in *Capacitive Touch-Controlled Mobile Devices, Computer, and Components Thereof*, 337-TA-1193 (Feb. 13, 2020 ITC) (the “ITC investigation”) and *Neodron Ltd. v. Samsung Electronics Co., Ltd. et al*, 6-20-cv-00121 (Feb. 14, 2020 WDTX) (the “district court litigation”). The district court litigation is stayed under 28 U.S.C. § 1659 pending the resolution of the ITC investigation. On April 16, 2020, Apple Inc. and Microsoft Corporation filed their IPR petition, IPR2020-00778, against the ’425 patent. Petitioner here timely moves for joinder with the Apple IPR.

III. STATEMENT OF REASONS FOR THE REQUESTED RELIEF

A. Legal Standards and Applicable Rules

The Board has discretion to join a properly filed IPR petition to an IPR proceeding. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); *see also Dell Inc. v. Network-1 Sec. Solutions, Inc.*, IPR2013-00385, Paper 19, at 4-6; *Sony Corp. v. Yissum Res. & Dev. Co. of the Hebrew Univ. of Jerusalem*, IPR2013- 00326, Paper 15, at 3-4; *Microsoft Corp. v. Proxyconn, Inc.*, IPR2013-00109, Paper 15, at 3-4.

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