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Paper 10
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

AFFINITY LABS OF TEXAS, LLC,
Patent Owner.

Case IPR2015-00821
Patent 8,532,641 B2

Before KEVIN F. TURNER, LYNNE E. PETTIGREW, and JON B. TORNQUIST, *Administrative Patent Judges.*

TORNQUIST, *Administrative Patent Judge.*

DECISION
Denying Petitioner's Motion for Joinder
37 C.F.R. § 42.122
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, "Petitioner") filed a Petition (Paper 2, "Pet." or "current Petition") requesting *inter partes* review of claims 1–3, 5–7, 9, and 10 of U.S. Patent No. 8,532,641 ("the '641 patent"). Petitioner also filed a Motion for Joinder (Paper 3, "Motion for Joinder"), requesting that the current Petition be joined with IPR2014-01181. The Motion for Joinder was filed within one month after institution of trial in IPR2014-01181. *See* 37 C.F.R. § 42.122(b). Patent Owner filed an Opposition to Petitioner's Motion for Joinder (Paper 8, "Opp."), and Petitioner filed a Reply (Paper 9, "Reply").

For the reasons that follow, we deny Petitioner's Motion for Joinder. We also deny the current Petition and do not institute an *inter partes* review.

II. BACKGROUND

Petitioner previously filed three petitions requesting *inter partes* review of claims 1–3 and 5–14 of the '641 patent. In IPR2014-01181 we instituted review of claims 8 and 11–14; in IPR2014-01182 we instituted review of claims 1–3 and 5–14; and in IPR2014-01184 we instituted review of claims 8, 11, 13, and 14. Thus, we have instituted review of every challenged claim of the '641 patent in at least one proceeding and, for some claims, in three different proceedings.

Petitioner now requests *inter partes* review of claims 1–3, 5–7, 9, and 10 of the '641 patent using two new references, Ushiroda and Bork, in combination with references Ito, Haartsen, Rydbeck, Nokia, and Galensky, previously relied upon in IPR2014-01181. Pet. 14–46; Motion for Joinder 2–3. Institution of *inter partes* review is barred under 35 U.S.C. § 315(b) when a petition is filed "more than 1 year after the date on which the

petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent." Petitioner concedes that it was served with a complaint asserting infringement of the '641 patent "more than one year" before the filing date of the current Petition, but contends that the current Petition is timely in view of its Motion for Joinder. Pet. 7–8; 35 U.S.C. § 315(b) (noting that the time limitation set forth in § 315(b) does not apply to a request for joinder under § 315(c)).

The decision to grant joinder is discretionary, with Petitioner, as the moving party, bearing the burden to show that joinder is appropriate. 35 U.S.C. § 315(c); 37 C.F.R. § 42.20(c).

III. ANALYSIS

Petitioner contends that joinder is appropriate in this case because IPR2015-00821 and IPR2014-01181 involve the same patent, parties, and counsel, and "Patent Owner has already responded to, and the Board has already analyzed for institution, prior petitions challenging every claim now at issue in the new Petition." Motion for Joinder 4. Petitioner further contends that it was not aware of Ushiroda at the time the petition in IPR2014-01181 was filed and, in combination with Bork, the two references resolve any concerns the Board had with respect to the references cited in IPR2014-01181. *Id.* at 3, 5–6; Reply 5.

Patent Owner presents two arguments against joinder. First, Patent Owner asserts that the statute does not permit the same party to join a proceeding to which it is already a party. Opp. 2–3 (citing *Skyhawk Techs. LLC v. L&H Concepts, LLC*, Case IPR2014–01485, slip op. at 3–4 (PTAB Mar. 21, 2015) (Paper 13)). Second, Patent Owner contends that the Motion for Joinder should be denied because Petitioner simply is seeking a "second

bite at the apple," without providing any reasonable explanation as to why it did not make its arguments with respect to the Ushiroda and Bork references in an earlier, timely-filed petition. Opp. 5–12.

With respect to same party joinder, we recognize that different Board panels have come to contrary positions on this issue. *See, e.g.*, *Target Corp. v. Destination Maternity Corp.*, Case IPR2014–00508 (PTAB Feb. 12, 2015) (Paper 31); *Skyhawk*, slip op. at 3–4. We need not address the issue here, however, because, even if same party joinder is permissible, we are not persuaded that joinder is appropriate in this case.

With respect to the substance of the joinder request, we agree with Patent Owner that Petitioner provides no reasoned justification for the delay in asserting the grounds based on Ushiroda and Bork. In particular, Petitioner articulates no persuasive reason why, using reasonable efforts, the Ushiroda reference could not have been identified and relied upon in the earlier, timely-filed petitions. *See* Pet. 18–19 (noting that Ushiroda issued on April 3, 2001 as U.S. Patent No. 6,212,403); Opp. 12 (asserting that "Ushiroda is an easily located and accessible U.S. patent" and "Petitioners were clearly aware of the Bork reference . . . because they relied on Bork in other proceedings against the Patent Owner"). Thus, we do not consider this to be a case of changed circumstances—such as new claims being asserted during district court litigation or new threats of infringement—that would make joinder an equitable remedy. *See, e.g.*, *Micro Motion, Inc. v. Invensys Sys., Inc.*, Case IPR2014-01409, slip op. at 14 (PTAB Feb. 18, 2015) (Paper 14) (citing *Microsoft Corp. v. Proxyconn, Inc.*, Case IPR2013-00109, slip op. at 3, 5 (PTAB Feb. 25, 2014) (Paper 15)).

This appears, instead, to be a case where Petitioner seeks to use our Decision to Institute in IPR2014-01181 as a guide to remedy deficiencies in the earlier filed petition, i.e., a "second bite at the apple." *See* Motion for Joinder 3 (noting that the Ushiroda reference was located "only after the institution decision in IPR2014-01181"). Interpreting our rules to allow Petitioner another chance to argue the unpatentability of the challenged claims would not lead to the just, speedy, and inexpensive resolution of the proceedings. *See* 37 C.F.R. § 42.1(b). To the contrary, joinder of the current proceeding would require Patent Owner to address new arguments and evidence, and potentially require additional declarations and witness depositions, all under a compressed schedule made necessary to accommodate the more advanced stage of the proceeding in IPR2014–01181. Petitioner's desire to present additional grounds directed to claims already the subject of three prior *inter partes* review petitions, and directed to claims currently under review in IPR2014-01182, does not justify the additional burden on Patent Owner, the additional costs, or the use of judicial resources.

Based on the foregoing, we are not persuaded that Petitioner has demonstrated that joinder is appropriate. Accordingly, we exercise our discretion and deny joinder of IPR2015-00821 with IPR2014-01181. The current Petition is, therefore, time-barred under 35 U.S.C. § 315(b).

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Motion for Joinder is *denied*;

FURTHER ORDERED that the Petition is *denied* and no trial is instituted.

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