

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

PAPST LICENSING GMBH & CO. KG,
Patent Owner.

Case IPR2017-00670
Patent 8,966,144 B2

Before JONI Y. CHANG, JENNIFER S. BISK, and MIRIAM L. QUINN,
Administrative Patent Judges.

CHANG, Administrative Patent Judge.

Institution of *Inter Partes* Review and Grant of Motion for Joinder
37 C.F.R. §§ 42.108 and 42.122(b)

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 7, 9, 11, 12, 17–21, 23–26, 41, 50, 51, 56–58, 66–76, 78, and 79 of U.S. Patent No. 8,966,144 B2 (“the ’144 patent”). Paper 1 (“Pet.”). Petitioner also concurrently filed a Motion for Joinder, seeking to join this proceeding with *Canon Inc. et al., v. Papst Licensing GmbH & Co., KG*, Case IPR2016-01216 (“the Canon IPR”). Paper 2. Patent Owner did not file a Preliminary Response, but filed a Response to Petitioner’s Motion for Joinder in which Patent Owner states that it does not oppose Petitioner’s Motion for Joinder. Paper 8.

For the reasons set forth below, we institute an *inter partes* review of claims 7, 9, 11, 12, 17–21, 23–26, 41, 50, 51, 56–58, 66–76, 78, and 79 of the ’144 patent, and grant Petitioner’s Motion for Joinder.

II. INSTITUTION OF *INTER PARTES* REVIEW

On December 15, 2016, we instituted a trial in IPR2016-01216 on the following asserted grounds of unpatentability:

Challenged Claim(s)	Basis	Reference(s)
7, 9, 11, 12, 17–21, 23–25, 41, 50, 51, 56–58, 66–76, 78, and 79	§ 103(a)	Kawaguchi, Matsumoto, the SCSI Specification, and Admitted Prior Art
26	§ 103(a)	Kawaguchi, Matsumoto, the SCSI Specification, and Admitted Prior Art, with or without Takahashi
57, 68–70, 75, and 76	§ 103(a)	Kawaguchi, Matsumoto, DASM-AD14, the SCSI Specification, and Admitted Prior Art

Challenged Claim(s)	Basis	Reference(s)
41, 50, 51, 56, 78, and 79	§ 103(a)	Kawaguchi, Matsumoto, Saito, the SCSI Specification, and Admitted Prior Art
66	§ 103(a)	Kawaguchi, Matsumoto, Muramatsu, the SCSI Specification, and Admitted Prior Art

Canon IPR, slip. op. at 47–48 (PTAB Dec. 15, 2016) (Paper 12). The instant Petition presents the same grounds of unpatentability, the same prior art, and the same declarant testimony as the petition in the Canon IPR. Pet. 6–9; Mot. 5–6. In view of the identity of the grounds in the instant Petition and in the Canon IPR petition, and for the same reasons stated in our Decision on Institution in the Canon IPR, we institute *inter partes* review in this proceeding on the same grounds discussed above and for the claims we instituted *inter partes* review in the Canon IPR.

III. 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>.

Petitioner asserts it has grounds for standing because, in accordance with 35 U.S.C. § 315(c), Petitioner filed a Motion for Joinder concurrently with the Petition and not later than one month after institution of the Canon IPR. Mot. 5. Patent Owner does not oppose Petitioner's Motion for Joinder based on the condition that the instant proceeding follows the same schedule of the Canon IPR. Paper 8. We find that the Motion for Joinder is timely.

We also find that Petitioner has met its burden of showing that joinder is appropriate. The Petition here is substantively identical to the petition in the Canon IPR. Mot. 5–7. The evidence also is identical, including the reliance on the same Declaration of Paul F. Reynolds, Ph.D. *Id.* at 7.

Petitioner further has shown that the trial schedule will not be affected by joinder. Mot. 6–7. No changes in the schedule are anticipated or necessary, and the limited participation, if at all, of Petitioner will not impact the timeline of the ongoing trial. We limit Petitioner's participation in the joined proceeding such that Petitioner shall require prior authorization from the Board before filing *any* further paper. This arrangement promotes the just and efficient administration of the ongoing trial and the interests of Petitioner and Patent Owner.

IV. ORDER

In view of the foregoing, it is
ORDERED that IPR2017-00670 is hereby instituted on the following
grounds:

Challenged Claim(s)	Basis	Reference(s)
7, 9, 11, 12, 17–21, 23–25, 41, 50, 51, 56– 58, 66–76, 78, and 79	§ 103(a)	Kawaguchi, Matsumoto, the SCSI Specification, and Admitted Prior Art
26	§ 103(a)	Kawaguchi, Matsumoto, the SCSI Specification, and Admitted Prior Art, with or without Takahashi
57, 68–70, 75, and 76	§ 103(a)	Kawaguchi, Matsumoto, DASM-AD14, the SCSI Specification, and Admitted Prior Art
41, 50, 51, 56, 78, and 79	§ 103(a)	Kawaguchi, Matsumoto, Saito, the SCSI Specification, and Admitted Prior Art
66	§ 103(a)	Kawaguchi, Matsumoto, Muramatsu, the SCSI Specification, and Admitted Prior Art

FURTHER ORDERED that Petitioner’s Motion for Joinder with
IPR2016-01216 is *granted*;

FURTHER ORDERED that the grounds on which trial in
IPR2016-01216 were instituted are unchanged and no other grounds are
included in the joined proceeding;

FURTHER ORDERED that the Scheduling Order entered in
IPR2016-01216 (Paper 13) and schedule changes agreed-to by the parties in

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