

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD,
SAMSUNG ELECTRONICS AMERICA, INC., and
HUAWEI DEVICE USA, INC.,
Petitioner,

v.

RYUJIN FUJINOMAKI,
Patent Owner.

Case IPR2017-01017
Patent 6,151,493

Before DAVID C. MCKONE, BARBARA A. PARVIS, and
DANIEL N. FISHMAN, *Administrative Patent Judges*.

MCKONE, *Administrative Patent Judge*.

Institution of *Inter Partes* Review and
Order Granting Petitioner's Motion
for Joinder of IPR2017-01017 with IPR2016-01522
37 C.F.R. 42.108
37C.F.R. § 42.122(b)

I. INTRODUCTION

On March 6, 2017, Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Huawei Device USA, Inc. (collectively, “Petitioner”) filed a Petition (Paper 3, “Pet.”) for *inter partes* review of claims 1–6 and 8–10 of U.S. Patent No. 6,151,493 (Ex. 1001, “the ’493 patent”). With its Petition, Petitioner filed a Motion for Joinder (Paper 4, “Mot.”) with *Google Inc. v. Fujinomaki*, Case No. IPR2016-01522 (“the Google IPR”). Patent Owner filed a Combined Preliminary Response and Response to Petitioner’s Motion for Joinder (Paper 8, “Opp.”). We conducted a teleconference on May 18, 2017, among the panel and counsel for the petitioners in this proceeding, the petitioners in the Google IPR, and Patent Owner, to discuss cooperation among the petitioners to minimize the impact of joinder on the Google IPR should we grant joinder. On the teleconference, the petitioners in the Google IPR indicated that they do not oppose joinder, as long as steps are taken to minimize any impact on the Google IPR. For the reasons given below, we institute an *inter partes* review of claims 1–6 and 8–10 of the ’493 patent and grant Petitioner’s Motion for Joinder.

II. ANALYSIS

A. *Applicability of the 35 U.S.C. § 315(b) Statutory Bar*

Patent Owner contends that the Petition was filed after the one-year statutory time period set forth in 35 U.S.C. § 315(b). Opp. 6–8. According to the statute, “[a]n *inter partes* review may not be instituted if the petition requesting the proceeding 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

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complaint alleging infringement of the patent.” 35 U.S.C. § 315(b). Section 315(b) further states “[t]he time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).” According to our rules, the time bar of Section 315(b) does not apply if the petition is accompanied by a request for joinder and joinder is granted. *See* 37 C.F.R. § 42.122(b) (“The time period set forth in § 42.101(b) shall not apply when the petition is accompanied by a request for joinder.”).

Patent Owner contends that the time bar of Section 315(b) applies regardless of joinder. *Opp.* 8. Specifically, Patent Owner argues that, by its plain language, the statute only permits a request for joinder to be filed after the one-year deadline and does not suspend the time period for filing a petition. *Id.* at 8–10. According to Patent Owner, 35 U.S.C. § 315(c) gives the Director discretion to join parties to an instituted proceeding only for a person who properly files a petition, which Patent Owner argues carries with it a requirement that the time bar is met. *Id.* at 9. As to our rules, Patent Owner contends that Rule 42.122(b) is not valid because it is contrary to Section 315(b). *Id.* at 10. For the reasons stated in the Board’s prior decisions, we are persuaded that our rules are consistent with the statute and, therefore, we reject Patent Owner’s argument. *See, e.g., Microsoft Corp. v. Proxyconn Inc.*, IPR2013–00109, slip op. at 4 (PTAB Feb. 25, 2013) (Paper 15).

B. The Motion for Joinder Was Authorized

Patent Owner contends that the Motion for Joinder was unauthorized and, thus, must be denied. *Opp.* 12–13. According to our rules, “[a] motion will not be entered without Board authorization. Authorization may be provided in an order of general applicability or during the proceeding.”

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37 C.F.R. § 42.20(a). Nevertheless, as our Trial Practice Guide counsels, “[e]xceptions include motions where it is impractical for a party to seek prior Board authorization, and motions for which authorization is automatically granted.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,762 (Aug. 14, 2012); *see also* Final Rule, Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions, 77 Fed. Reg. 48,612, 48,632 (Aug. 14, 2012) (“Authorization is required for the filing of each motion either through Board order or as specified by rule, e.g., a motion to seal (§ 42.54(a)) and a motion to expunge confidential information (§ 42.56).”). A motion for joinder is one such motion for which authorization is granted automatically. *See* 37 C.F.R. § 42.122(b) (“Joinder may be requested by a patent owner or petitioner. Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any inter partes review for which joinder is requested.”). Because permission to file a motion for joinder is granted automatically by Rule 42.122(b), Petitioner was not required to seek authorization before filing its Motion for Joinder.

C. Petitioner Has Shown that Joinder Is Appropriate

Other panels of this Board have counseled that a motion for joinder should (1) set forth 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. *See, e.g., Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15). Nevertheless, we “routinely grant[]

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motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.”

Samsung Electronics Co., Ltd. v. Raytheon Co., Case IPR2016-00962, slip op. at 9 (PTAB Aug. 24, 2016) (Paper 12) (emphases in original).

Petitioner represents that:

The challenged claims and grounds of Petitioner’s petition are substantively identical to claims and grounds presented in the petition filed by Google and LG (IPR2016-01522). The same prior art, and even the same expert and expert declaration, are used in both proceedings. Petitioner proposes no new grounds of unpatentability.

Mot. 4. Patent Owner “concedes that Petitioners’ IPR petition is duplicative of the grounds, evidence, and arguments presented by [the petitioners] in IPR2016-01522” and “is aware of previous Board decisions permitting institution of copy-cat petitions that would otherwise be time-barred when a request for joinder to an instituted trial is filed with the copy-cat petition.”

Opp. 3. Thus, this proceeding falls into the category of cases for which we grant joinder routinely.

Furthermore, Petitioner represents that, “if joined, Petitioner agrees to take an ‘understudy’ role as petitioners in other similarly joined proceedings have taken.” Mot. 4 (quoting *Sony Corp. v. Memory Integrity, LLC*, Case IPR2015-01353, slip op. at 6 (PTAB Oct. 5, 2015) (Paper 11)). To that end, Petitioner represents that

all filings by Petitioner in the joined proceeding will be consolidated with the filings of Google and LG, unless a filing solely concerns issues that do not involve Google or LG; Petitioner will not introduce any argument or discovery not introduced by Google or LG; and Petitioner assents to Google and LG leading any depositions associated with the joined proceeding.

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