

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC

Petitioner

v.

IRON OAK TECHNOLOGIES, LLC

(record) Patent Owner.

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Case IPR2019-00111

Patent No. 5,699,275

**MOTION FOR JOINDER**

*35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b)*

## I. STATEMENT OF RELIEF REQUESTED

Google LLC (“Joinder Petitioner”) respectfully moves for joinder under 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) of its petition for *inter partes* review in this proceeding (“Joinder Petition”) with the instituted *inter partes* review petition in *Samsung Electronics Co., Ltd. v. Iron Oak Technologies*, Case No. IPR2018-01553 (“Samsung Petition”).

The Joinder Petition is substantively identical to the Samsung Petition, relying on the same grounds and the same evidence in challenging the same claim of the same patent as the Samsung Petition. Moreover, Joinder Petitioner expressly agrees to adhere to the Board’s schedule in IPR2018-01553 upon institution and to take an “understudy” role in the joined proceedings. Accordingly, joinder is appropriate because it will promote efficient resolution of the validity of the involved patent, will not cause any undue delay, and will not prejudice or burden the parties in IPR2018-01553.

This motion for joinder is timely under 37 C.F.R. §§ 42.22 and 42.122(b) because it is being filed not more than 1 month after institution of the Samsung Petition in IPR2018-01553 (instituted Feb. 27, 2019).

## II. STATEMENT OF MATERIAL FACTS

On August 21, 2018, Samsung Electronics Co., Ltd. (“Samsung”) filed a petition for *inter partes* review (IPR2018-01553) of claim 1 of U.S. Patent No.

5,699,275 (“the ‘275 patent”), citing two grounds of unpatentability. A notice according filing date was mailed on September 11, 2018. A preliminary response to the Samsung Petition was filed on December 11, 2018.

On October 24, 2018, Joinder Petitioner filed its Joinder Petition in the instant IPR2019-00111 proceeding challenging the same claim of the ‘275 patent on the same grounds as the Samsung Petition. *Compare* Joinder Petition at 3-65, *with* Samsung Petition at 3-65. Accordingly, as noted above, the Joinder Petition is substantially identical to the Samsung Petition, with only formal matters (such as the caption, mandatory notices, signature of counsel and certificate of service) changed. A preliminary response to the Joinder Petition was filed on February 15, 2019. That preliminary response, according to Patent Owner, is “substantively identical” to Patent Owner’s preliminary response in IPR2018-01553. POPR at 1.

On February 27, 2019, the Board instituted the Samsung Petition in IPR2018-01553 as to all grounds set forth in the Samsung Petition.

### **III. STATEMENT OF REASONS FOR REQUESTED RELIEF**

#### **A. Legal Standard**

The Leahy-Smith America Invents Act (“AIA”) explicitly provides for joinder of *inter partes* review (“IPR”) proceedings. The statutory provision governing joinder of IPR proceedings is 35 U.S.C. § 315(c) that reads as follows:

(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.

“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.” 37 C.F.R. § 42.122(b).

In exercising its discretion to grant joinder, the Board considers the impact of substantive and procedural issues on the proceedings, as well as other considerations, while being “mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” *See Dell Inc. v. Network-1 Security Solutions, Inc.*, Case IPR2013-00385, Paper No. 17 at 3 (PTAB July 29, 2013). The Board should “also take into account the policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding.” *Id.* at 10.

As the Board has explained, “A motion for joinder should: (1) set forth the 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.” *Id.* at 4. Each of these four factors is addressed in turn below.

## **B. Analysis**

### **1. Factor 1: Joinder Is Appropriate**

The Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.” *Samsung Elecs. et al. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (Aug. 24, 2016) (internal quotations and citations omitted); *Enzymotec Ltd. et al. v. Neptune Techs. & Bioresources, Inc.* IPR2014-00556, Paper No. 19 at 6 (July 9, 2014) (The Board is “mindful of a policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding.”).

Here, joinder is appropriate because the Joinder Petition relies on identical arguments and the same grounds raised in the Samsung Petition. Specifically, the Joinder Petition involves the same patent, the same challenged claim, the same prior art, the same exhibits, the same declarations from the same experts, and the same grounds that were instituted in IPR2018-01553. *Compare* Joinder Petition at 3-65, *with* Samsung Petition at 3-65.

Accordingly, because the Joinder Petition and the Samsung Petition are substantially identical, good cause exists for joining the proceedings so that the

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