

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

BELL NORTHERN RESEARCH, LLC,
Patent Owner.

IPR2020-00697
Patent 7,039,435 B2

Before BRYAN F. MOORE, STACY B. MARGOLIES, and
SCOTT E. BAIN, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

Samsung Electronics Co., Ltd (“Petitioner”) filed a Petition pursuant to 35 U.S.C. §§ 311–319 requesting *inter partes* review of claims 1–3, 6 of U.S. Patent No. 7,039,435 B2 (“the ’435 patent”). Paper 1 (“Pet.”). Petitioner also filed a Motion for Joinder seeking to join Petitioner as a party to *ZTE (USA) Inc. v. Bell Northern Research, LLC*, IPR2019-01365 (PTAB) (“1365 IPR”). Paper 4 (“Mot.”). Bell Northern Research, LLC (“Patent Owner”) filed a “Non-Opposition to Petitioner’s Motion for Joinder.” Paper 8 (“Non-Opp.”). In its Non-Opposition, Patent Owner requested additional conditions be included in any order granting joinder and stated it waives its right to a preliminary response if we grant Petitioner’s joinder motion. Non-Opp., 2–3. Petitioner filed a Reply to Patent Owner’s Non-Opposition. Paper 9 (“Reply”).

For the reasons set forth below, we grant Petitioner’s request and institute an *inter partes* review of all challenged claims. We further grant Petitioner’s Motion for Joinder.

I. BACKGROUND

A. *Related Proceedings*

Petitioner and Patent Owner identify the following district court litigation involving the ’435 patent: *Bell Northern Research, LLC v. Samsung Electronics Co., Ltd.*, Case No. 2:19-cv-00286 (E.D. Tex.); *Bell Northern Research, LLC v. LG Electronics Inc., et al.*, Case No. 3:18-cv-02864 (S.D. Cal.); and *Bell Northern Research, LLC v. ZTE Corporation*, Case No. 3:18-cv-01786 (S.D. Cal.). See Pet. 1–2; Paper 7, 1. The parties further identifies the following PTAB proceeding involving the ’435 patent: the 1319 IPR; *LG Electronics, Inc. v. Bell Northern Research, LLC*, IPR2020-00319 (PTAB) (filed December 19, 2019); *Samsung Electronics Co., Ltd. v. Bell Northern Research, LLC*, IPR2020-00698 (PTAB) (filed

IPR2020-00697
Patent 7,039,435 B2

Mar. 10, 2020). Petitioner further identifies the patent was at issue in *Huawei Technologies Co., Ltd. v. Bell Northern Research, LLC*, IPR2019-01186 (PTAB) (filed June 11, 2019, terminated December 13, 2019). *See* Pet. 2.

B. Real Parties in Interest

Petitioner identifies Samsung Electronics America, Inc., as an additional real party in interest. Pet. 1. Patent Owner identifies that it is a wholly owned subsidiary of Hilco Patent Acquisition 56, LLC, which is owned by both Hilco IP Merchant Capital, LLC, and Hilco, Inc. Paper 7, 1.

II. ANALYSIS

A. Institution of Inter Partes Review

Petitioner challenges the same claims on the same grounds of unpatentability as the grounds on which we instituted review in the 1365 IPR. *Compare* Pet. 3, *with* 1365 IPR, Paper 13, 4, 39. Petitioner asserts the Petition in this proceeding is substantially identical and is based on the same prior art combinations and supporting evidence as the Petition in the 1365 IPR. Pet. 1; Mot. 1–2. Petitioner further asserts that the declaration submitted in support of its contentions is a verbatim copy of the declaration submitted in the 1365 IPR. Pet. iii n.1. Patent Owner asserts that if we grant Samsung’s joinder motion, Patent Owner waives its right to a preliminary response in this proceeding. Non-Opp. 3.

We have reviewed the Petition and agree with Petitioner that it is substantially identical to the 1365 Petition. *Compare* Pet. 3–69, *with* 1365 IPR, Paper 1, 2–66. For the reasons discussed in our Decision on Institution in the 1365 IPR, we determine Petitioner has demonstrated a reasonable likelihood of prevailing in showing at least one claim of the ’435 patent is

unpatentable. *See* 1365 IPR, Paper 13. We, therefore, institute *inter partes* review of all challenged claims on all grounds set forth in the Petition.

B. Motion for Joinder

The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which states:

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.

A motion for joinder must be filed “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) (2019). Moreover, as suggested in *Kyocera Corp. v. SoftView LLC*, IPR2013-00004, Paper 15, 4 (PTAB Apr. 24, 2013), 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.

Petitioner contends joinder is appropriate because the Petition in this proceeding challenges the same claims of the same patent, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the 1365 IPR proceeding. Mot. 4–5. Petitioner further asserts joinder will have minimal impact on the trial schedule because Petitioner consents to the existing schedule and there are no new issues for the Board or Patent Owner to address. *Id.* at 5–6. Petitioner states that it explicitly

agrees to take an “understudy” role, which will simplify briefing and discovery; Petitioner sets forth explicit conditions regarding briefing that it agrees will apply provided at least one of the current Petitioners in IPR2019-01365 remains an active party. *See id.* at 6–8. Petitioner further states it is willing to agree to any other reasonable conditions the Board deems necessary before joining Petitioner as a party to the 1365 IPR. *Id.* at 8.

In view of Petitioner’s agreement to abide by the conditions set forth in its Motion, Patent Owner does not oppose Petitioner’s motion to join as a party to the 1365 IPR proceeding. Non-Opp 2. However, Patent Owner requests that several additional conditions, similar to those ordered in a previous proceeding involving Petitioner, be included in any order granting joinder. *See id.* at 2–3. Petitioner consents to the conditions provided that the original petitioner in the 1365 IPR proceeding (ZTE) continues to actively participate in the proceeding. Reply 2.

We agree with Petitioner that joinder with the 1365 IPR is appropriate under the circumstances. Accordingly, we grant Petitioner’s Motion for Joinder, subject to the requirements set forth in the Order below.

III. ORDER

It is

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review of the ’435 patent is hereby instituted on all grounds set forth in the Petition:

- (1) Anticipation of claims 1–3 by Baiker;
- (2) Obviousness of claims 1–3 and 6 over Baiker and Werling;

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