

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.
Petitioner

v.

ATI TECHNOLOGIES ULC
Patent Owner

Case: IPR2015-01620

Patent 7,095,945

**MOTION FOR JOINDER PURSUANT TO 35 U.S.C. § 315(c)
AND 37 C.F.R. § 42.122(b)**

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I. STATEMENT OF THE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), petitioner LG Electronics, Inc. (“Petitioner” or “LGE”) seeks to have its Petition for *Inter Partes* Review of Claim 21 of U.S. Patent No. 7,095,945, filed contemporaneously herewith, joined with the instituted *inter partes* review, *LG Electronics, Inc. v. Advanced Micro Devices, Inc.*, IPR2015-00321 (the “IPR2015-00321”).

This Motion is timely and the time periods set forth in 37 C.F.R. §42.101(b) do not apply to LGE’s petition because it is accompanied by this request for joinder. *See* 35 U.S.C. §315(c); 37 C.F.R. § 42.122(b); *see also Taiwan Semiconductor Mfg. Co. v. Zond, LLC*, IPR2014-00781, -00782, Paper 5 (May 29, 2014) at 3.

II. STATEMENT OF MATERIAL FACTS

1. On March 5, 2014, ATI Technologies ULC (“ATI” or “Patent Owner”) filed a complaint in the United States District Court for the Northern District of California accusing Petitioner of infringement (hereinafter, “the Underlying Litigation”).

2. LG Electronics, Inc. (“LGE”) filed a petition for *inter partes* review of the ’945 Patent on December 10, 2014 (the “IPR2015-00321 Petition”). *See* IPR2015-00321, Paper 2.

3. The IPR2015-00321 Petition included the following grounds for invalidity:

Ground 1: Claims 18 and 21 Are Unpatentable Under 35 U.S.C. §102(e) As Being Anticipated By Barton.

Ground 2: Claim 18 Is Unpatentable Under 35 U.S.C. §103(a) As Being Obvious Over Hatanaka.

Ground 3: Claim 21 Is Unpatentable Under 35 U.S.C. §102(e) As Being Anticipated By Hatanaka.

Ground 4: Claim 18 Is Unpatentable Under 35 U.S.C. §103(a) As Being Obvious Over Hatanaka In View of O'Connor.

Ground 5: Claim 21 Is Unpatentable Under 35 U.S.C. §103(a) As Being Obvious Over Fujinami

See id. at i.

4. On June 26, 2015, the Board instituted IPR2015-00321 on Grounds 2 and 4 and issued a scheduling order.

5. The primary reference for Grounds 2 and 4 is Hatanaka.

6. Hatanaka discloses “digital signal recording devices, digital signal recording/playback devices, and digital signal receiving/recording/playback devices, for receiving/recording/playing back a digital signal.” Ex. 1006, at 1:8-11.

7. The secondary reference for Ground 4 is O'Connor. O'Connor discloses a system for time shifting that concurrently records and plays back a

video stream. Ex. 1007, at Title.

8. The concurrent petition is being filed within one month of institution of the IPR2015-00321 Petition.

9. The concurrent petition uses the same base reference as Grounds 2 and 4, Hatanaka, to support an obviousness analysis of claim 21.

10. The concurrent petition adds only two new references— U.S. Patent No. 5,517,250 to Hoogenboom and U.S. Patent 6,275,507 to Anderson. Hoogenboom discloses a system for efficiently acquiring data, such as video data, from a packetized data stream. Ex. 1009, at 1:7-10. Anderson discloses “[a] transport demultiplexor for demultiplexing an MPEG-2 compliant transport stream into a system data stream, a video data stream, and an audio data stream” and a system for reducing the load on the application processor. Ex. 1010, at Abstract, 11:57-65.

11. Patent Owner’s Response in IPR2015-00321 is due September 28, 2015. IPR2015-00321, Paper 21.

12. Petitioner’s reply is due December 28, 2015. *Id.*

13. Oral argument is scheduled for March 22, 2016. *Id.*

III. LEGAL STANDARDS AND APPLICABLE RULES

The Board has discretion to join a properly filed IPR petition to a previously instituted IPR proceeding. 35 U.S.C. § 315(c); 37 C.F.R. §42.122(b); *see also Dell Inc. v. Network-1 Security Sols., Inc.*, IPR2013-00385. When

considering joinder, the Board takes into account “the particular facts of each case, substantive and procedural issues, and other considerations,” while remaining “mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” *Dell*, IPR2013-00385, Paper No. 17 (July 29, 2013) at 3.

“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.

IV. ARGUMENT

A. Joinder is Appropriate For Multiple Reasons

Joinder is appropriate here for several reasons including efficiency and consistency as discussed in detail below.

1. Joinder will promote efficiency and not impact the Board’s ability to complete the review in a timely manner

Joinder will not impact the Board’s ability to complete its review of IPR2015-00321 within the statutorily prescribed timeframe. First, this *inter partes* review proceeding involves the same parties and subject matter as IPR2015-00321. For example, the Hatanaka reference, asserted in Grounds 1 and 2 of the current proceeding, is the primary reference for the instituted grounds in IPR2015-00321.

Petitioner’s arguments herein regarding the Hatanaka reference overlap with the arguments in IPR2015-00321. *Compare* IPR2015-00321, Grounds 2 and 4 *with* IPR2015-01620, Grounds 1 and 2. Moreover, the technical expert supporting IPR2015-00321 is the same individual supporting this petition. Exhibits supporting each respective petition are the same, and the instant petition only adds three new exhibits (Exhibits 1009-1011). Thus, while claims 18 and 21 are different, the subject matter of those claims and the issues in this proceeding are nearly identical to those already before the Board in IPR2015-00321, and this weighs in favor of joinder. *See, e.g., Dell Inc. v. Network-1 Security Sols., Inc.*, IPR2013-00385, Paper 17 (July 29, 2013) at 7, 10 (granting joinder where unpatentability grounds identical and noting “policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding”); *Sony Corp. of Am. and Hewlett-Packard Co. v. Network-1 Security Sols., Inc.*, IPR2013-00495, Paper 13 (Sept. 16, 2013) at 5 (same); *SAP Am. Inc. v. Clouding IP, LLC*, IPR2014-00306, Paper 13 (May 19, 2014) at 4.

Joinder also promotes efficiency by avoiding duplicative reviews and filings of similar unpatentability issues across multiple PTAB proceedings. Joinder will also eliminate any risk of inconsistent results and piecemeal review.

2. Joinder will not prejudice ATI

Permitting joinder will not prejudice ATI. The instituted grounds overlap in subject matter with the two grounds proposed in this petition, and therefore,

joinder will not impact the scope or timing of IPR2015-00321. Both petitions are relying on similar testimony of the same technical expert to support the respective petitions, further avoiding any potential delay.

Moreover, joinder is more convenient and efficient because a single trial on the '945 Patent will occur on only claims 18 and 21. By allowing all grounds of unpatentability to be addressed in a single proceeding, the interests of all parties and the Board will be well served.

Further, where, as here, petitions and not parties are being joined, there will be no need to modify procedures such as the Board has done when it has granted joinder of parties. *See, e.g., Dell Inc.*, IPR2013-00385, Paper 17 at 11, and *SAP America Inc.*, IPR2014-00306, Paper 13 at 5.

For these reasons, joinder will not prejudice any party, but rather will promote the just, speedy, and inexpensive resolution of these proceedings involving the '945 Patent.

3. Joinder of petitions is permitted.

Joinder of LGE's petitions is appropriate here because of the substantial overlap in subject matter of claims 18 and 21, the overlap in prior art for challenging claims 18 and 21, the overlap in expert testimony, and the overlap in exhibits. Indeed, courts have joined petitions from the same party in circumstances similar to these. For example, in *Samsung v. Virginia*, IPR2014-00557, the Board permitted joinder when a petitioner added subject matter that had relevance to the

instituted claims, such that “the minimal amount of work required on the part of Patent Owner... is strongly outweighed by the public interest in having consistency of outcome concerning *similar sets of claimed subject matter* and prior art.” *Samsung v. Virginia*, IPR2014-00557, Paper 10, (Kim, McNamara, Clements, J.), at 18. The Board has also granted motions for joinder when petitions “involved the same patent and parties... substantially the same exhibits... [and] substantial overlap in the asserted references.” *Sony v. Yissum*, IPR2013-00327, Paper 15, (Medley, Easthom, Arpin, J.) at 5. In that case, the Board dismissed Patent Owner’s argument that joinder would allow petitioners to undergo serial filings as an attempt to delay the resolution of a proceeding noting that “only very limited new grounds for unpatentability are introduced by the petition in this proceeding.” *See id* at 3. Moreover, in *Target Corporation v. Destination Maternity Corporation*, IPR2014-00508, the Board found that joinder of issues is appropriate under §315(c) particularly when issues overlap and joinder could decrease litigation costs and conserve judicial resources. Paper 28, at 13-15. As with *Target*, *Sony*, and *Samsung*, the Board should join LGE’s petition because the petition involves the same patent, the same parties, substantially the same exhibits, substantial overlap in prior art, and claims covering similar subject matter.

LGE advances only two additional grounds of unpatentability based on the same primary reference as the instituted grounds, challenging a claim with similar

subject matter to the claim already under review. *See, e.g., Oxford Nanopore Technologies Ltd. v. University of Washington*, IPR2015-00057, Paper 10, at 21 (finding joinder proper where “the instant case involves only a single additional ground, involving a single claim already under challenge”).

Finally, joinder of LGE’s petitions will promote the just, speedy, and inexpensive resolution of proceedings on the ’945 Patent. That is, Petitioner does not seek to “delay the resolution of a proceeding” by undergoing serial filings. *See Target Corporation v. Destination Maternity Corporation*. Instead, LGE’s advancement of the Hoogenboom and Anderson references are relevant to the instituted claim and reviewing this ground with the challenge of claim 18 promotes the “just, speedy, and inexpensive” resolution of proceedings, does not substantially expand the scope of subject matter or references, and does not harass or prejudice the Patent Owner. There is also a strong public interest in advancing claims 18 and 21 together, for consistency in the outcome of the claims, that outweighs any minor inconveniences to the Patent Owner because the claims are of the same subject matter and challenged on substantially the same references.

B. Joinder Would Minimally Impact the Current Trial Schedule

Joinder would minimally impact the schedule in IPR2015-00321 because the Board can adopt a procedure similar to the one used in *Samsung* and *Sony* to put both ’945 IPRs on the same schedule. For example, in *Samsung* the Board

accelerated the due date on which Patent Owner's preliminary response was due and contemporaneously issued a revised scheduling order in the IPR to be joined *See, e.g., Samsung v. Virginia*, IPR2014-00557, Paper 9, at 2-3; *see also Sony v. Yissum*, IPR2013-00327, Paper 7, at 2. The Board then issued its decisions within a month of the patent owner's preliminary response. *See Sony v. Yissum*, IPR2013-00327, Paper 14. With this approach, following the institution and joinder decisions on the second petition, the patent owner response to both petitions were due on the same day based on only a minimally altered scheduling order. A similar procedure here would also only minimally impact the current schedule.

IV. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that its Petition for *Inter Partes* Review of U.S. Patent No. 7,095,945 be instituted and that this proceeding be joined with IPR2015-00321.

Although Petitioner believes that no fee is required for this Motion, the Commissioner is hereby authorized to charge any additional fees that may be required for this Motion to Deposit Account No. **130019**.

Dated: July 24, 2015

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that, on this 24th day of July, 2015, a true and correct copy of the foregoing MOTION FOR JOINDER PURSUANT TO 35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b) was served by UPS on the attorney of record for the patent owner, with a courtesy copy being sent by electronic mail to the attorneys of record in IPR2015-00321, at the following addresses:

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