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

REPLY IN SUPPORT OF PETITIONER'S MOTION FOR JOINDER

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I. INTRODUCTION

Both parties acknowledge there is a split between Board panels regarding joinder of the same party to an instituted IPR. The case-by-case basis on which the Board evaluates joinder, however, weighs in LGE's favor. ATI does not dispute that the current petition uses the same base reference as the IPR2015-00321 Petition, nor does it dispute the current petition adds only two new references to support an obviousness analysis for one claim—Claim 21. Indeed, ATI's opposition did not oppose any of LGE's "Statement of Material Facts." *See* Paper 7. As such, those facts "stand as admitted." *See Ariosa Diagnostics v. Isis Innovation Ltd.*, IPR2013-00250, Paper 25, at 2 ("Ariosa II"); 37 C.F.R. § 42.23(a). While claims 18 and 21 are different, the subject matter of those claims has substantial overlap. Moreover, ATI cannot show any real prejudice; its increased costs argument for responding to two new references and one claim is belied by ATI's scorched earth response in another instituted IPR pending between the parties. For the additional reasons discussed below, Petitioner respectfully requests that the Board exercise its discretion under § 315(c) and grant Petitioner's motion for joinder.

II. ARGUMENT

A. Joinder Will Result in a Just and Speedy Resolution of the '945 Patent

Joinder is discretionary and evaluated on a case-by-case basis.[1] In view of the admitted material facts in this case, the Board should grant Petitioner's motion for joinder because it will result in a "minimal amount of work" for Patent Owner and the Petitions involve "the same patent and parties… substantially the same exhibits… [and] substantial overlap in the asserted references." *See Samsung v. Virginia*, IPR2014-00557, Paper 10, (Kim, McNamara, Clements, J.), at 18; *Sony v. Yissum*, IPR2013-00327, Paper 15, (Medley, Easthom, Arpin, J.) at 5. As such, joinder will result in the just and speedy resolution of the '945 Patent.

Contrary to ATI's assertion, there is no "Board precedent" on this issue. Indeed, both parties cite cases on opposite sides of the split regarding joinder of issues under § 315(c). As such, ATI's case law presents only one side of the split and it is also distinguishable. For example, in *Butamax Advanced Biofuels LLC. v. Gevo, Inc.*, IPR2014-00581, Paper 8, at 2 (Oct. 14, 2014), the Board did not rule on

[1] ATI cites no rules or precedent requiring petitioners to identify new circumstances or prohibiting a second petition on a patent following an institution decision.

the merits of the joinder motion but instead denied the joinder motion as moot. In that case, the Board denied institution under 35 U.S.C. § 325(d) because the petition presented substantially the same prior art and arguments already before the Board. *Id*. at 7-8. That is not the case here. Indeed, Petitioner demonstrated why §325(d) does not apply on pages 8-9 of its Petition. Additionally, *Samsung Electronics Co. Ltd. et al. v. Affinity Labs of Texas, LLC,* IPR2015-00820, Paper 12, at 2 (May 15, 2015), is distinguishable because the Petitioner in *Samsung* challenged claims in a second petition which were all already subject to review based on institution of three prior petitions. Here, claim 21 is not the subject of an already pending IPR. As a third example, in *Toyota Motor Corp. v. American Vehicular Sciences LLC*, IPR2015-00262, Paper 10, at 5 (Jan. 29, 2015), joinder was denied because the proceeding to which joinder was sought was terminated as a result of settlement. Here, the proceeding to which joinder is sought is still pending. Thus, ATI cites distinguishable case law and simply highlights the split on whether § 315(c) applies to joinder of issues.

B. The Statute Permits Joinder Of Issues

Contrary to ATI's assertion, and as other panels have found, the proper interpretation of 35 U.S.C. §315(c) permits joinder of a party to an IPR of which it is already a party. *Target Corporation v. Destination Maternity Corporation*, IPR2014-00508, Paper 28, at 13-15.

In *Oxford Nanopore Techs., Ltd. v University of Washington, et al.*, IPR2015-00057, at 20, the Board acknowledged cases where joinder has been denied for follow-on petitions by the same party. The Board also acknowledged that the Board has declined to deny petitions in similar circumstances and noted that the decision is discretionary. *Id*. at 21. Considering the totality of the circumstances, the Board in *Oxford* granted Petitioner's joinder motion. Like *Oxford*, Petitioner's petition also involves the same patent and overlapping prior art. The Board in *Oxford* also agreed that the statute permitted self joinder. *Id*. at 22-24. Thus, other panels have found that § 315(c) permits joinder of issues.

Additionally, contrary to ATI's assertion, the Board has allowed joinder where the petition would otherwise be barred under 315(b) absent joinder. *See, e.g.*, *Microsoft Corp. v. Proxyconn, Inc.*, IPR2013-00109, Paper 15, at 4. In granting joinder, the Board explained that "[t]he same patents and parties are involved in both proceedings. There is an overlap in the cited prior art. There is no discernible prejudice to either party. Petitioner has been diligent and timely in filing the motion." *Id*. For similar reasons, and based on the admitted material facts, Petitioner respectfully requests that the Board grant its joinder motion.

C. ATI Will Not Be Prejudiced

ATI's argument that it will be prejudiced and that will incur increased costs should be rejected because the overlap in subject matter and prior art will result in

minimal additional work for ATI. *See, e.g., Samsung v. Virginia*, IPR2014-00557, Paper 10, at 18. ATI argues that it would have to review "new arguments for new references." However, ATI would not be prejudiced because while there are two new references, the primary reference, Hatanaka, is already a reference in the instituted IPR. Thus, any additional resources needed to review two secondary references will be minimal in comparison to the work already being done for the primary reference, Hatanaka.

ATI's claim of increased costs is also belied by its scorched earth response in pending IPR2015-00325, involving five claims of U.S. Patent No. 7,742,053. There, ATI's response to the Petition included four new declarations and over one hundred exhibits. Clearly cost is not a substantial burden for ATI to respond to two additional references directed at *one* claim with subject matter overlap with an already instituted claim.

ATI's complaints regarding a proposed accelerated schedule are also unwarranted. As discussed in Petitioner's motion, other cases have found that the accelerated schedule provided the Patent Owner adequate time for review.

III. 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.

Dated: September 24, 2015

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that, on this 24th day of September, 2015, a true and correct copy of the foregoing PETITIONER'S REPLY IN SUPPORT OF MOTION FOR JOINDER was served via electronic mail to the attorneys of record at the following addresses:

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