UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. and SAMSUNG ELECTRONICS AMERICA, INC.,

Petitioners

v.

SPEAKWARE, INC.,

Patent Owner

Case IPR2019-01146

U.S. Patent No. 6,397,186

PETITIONERS' MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22 AND 42.122(b)

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I. STATEMENT OF RELIEF REQUESTED

Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. ("Samsung") respectfully request to join, pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), the concurrently filed petition for *inter partes* review ("IPR") of U.S. Patent No. 6,397,186 ("the '186 patent") ("Samsung's Petition") with the previously instituted and currently pending IPR captioned *Google LLC v. SpeakWare Inc.*, No. IPR2019-00340 ("Google 340 IPR").

Samsung only seeks an understudy role in the proceedings and so files a Petition that is substantively identical to the Google 340 IPR. This motion and accompanying petition are timely, being filed within one month of the decision instituting trial in the Google 340 IPR (Paper 12 issued May 14, 2019).

Under these circumstances (as discussed further below), joinder would create no additional burden for the Board, Google, or SpeakWare, Inc. ("SpeakWare" or "Patent Owner") and would provide for "the just, speedy, and inexpensive resolution" of the validity of the '186 patent. *See* 37 C.F.R. § 42.1(b).

Accordingly, Samsung respectfully requests that the Board grant this motion.

II. STATEMENT OF MATERIAL FACTS

1. On July 26, 2018, SpeakWare filed a Complaint against Samsung in the United States District Court for the Central District of California alleging infringement of the '186 patent.

2. Samsung was served with SpeakWare's Complaint on August 9, 2018. *See SpeakWare, Inc., v. Samsung Electronics Co., Ltd., et al.*, C.A. No. 8:18-cv-01300 (C.D. Cal. filed July 26, 2018) (dkt. 13).

3. On November 30, 2018, Google filed a petition for IPR challenging claims 1-20 of the '186 patent ("Google's Petition"). *See Google LLC v. SpeakWare Inc.*, IPR2019-00340, Paper 2 (PTAB Nov. 30, 2018).

4. On May 14, 2019, the Board instituted Google's Petition. *See id.*, Paper 12 (PTAB May 14, 2019).

5. Samsung's Petition and this motion are being filed within one month of the decision instituting the Google 340 IPR. *See id.*, Paper 12 (PTAB May 14, 2019).

6. Samsung's petition has also been filed less than one year after SpeakWare served its complaint on Samsung.

III. STATEMENT OF REASONS FOR REQUESTED RELIEF

A. Legal Standards

The Leahy-Smith America Invents Act ("AIA") permits joinder of IPR proceedings. Joinder is governed by 35 U.S.C. § 315(c), which states:

> (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.

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. *Everlight Elecs. Co., Ltd., v. Document Security Sys., Inc.*, IPR2018-01244, Paper 15 at 5-6 (PTAB Sept. 27, 2018) (citing *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013)).

B. Samsung's Motion For Joinder Is Timely

A motion for joinder is timely if the moving party files within one month of institution of the IPR for which joinder is requested. 37 C.F.R. §42.122(b). Google's petition was instituted on May 14, 2019. *Google*, IPR2019-00340, Paper 12 (PTAB May 14, 2019). Samsung's current motion is thus timely as it is being filed within one month of the institution date. Moreover, while not pertinent, Samsung notes that 35 U.S.C. § 315(b) is not at issue here since the present petition was filed prior to the one-year bar after the service of SpeakWare's Complaint alleging infringement.

C. Joinder Is Appropriate Because It Will Promote An Efficient Determination Of The Validity Of The '186 Patent Without Prejudice To Any Party

Samsung's Petition is nearly identical to the Google Petition, challenging the same claims of the '186 patent with the same prior art, on the same grounds and

relying on a substantially identical expert declaration. The only differences between Samsung's Petition and Google's Petition are the sections regarding Real Party-in-Interest, Related Matters, and Counsel (which have been appropriately updated) as well as the section identifying the non-redundancy of Samsung's Petition and updates related to the declaration.[1] Accordingly, Samsung's Petition does not raise any new grounds and does not present any issues that would complicate or delay the Google 340 IPR. Therefore a consolidated proceeding, including both Samsung and Google, will be more efficient and less wasteful, as only a single trial on these identical grounds would be required.

Joining Samsung as a party to the Google 340 IPR would also not cause any prejudice to either Google or SpeakWare. SpeakWare, as the alleged patent owner, must respond to the common invalidity grounds identified in Google's (and Samsung's) Petition regardless of joinder. Thus, SpeakWare bears no additional burden. Also, as Samsung would merely be an understudy, there would be no prejudice to Google. *See, e.g.*, *Everlight,* IPR2018-01244, Paper 15 (PTAB Sept. 27, 2018) (granting motion for joinder where petitioner, albeit using a different

[1] Samsung submits a declaration from Dr. Polish, which is substantially identical to Dr. Lipoff's declaration filed by Google. As noted, Samsung will only rely on the declaration/Dr. Polish if Google is terminated from the proceedings. In particular, the supporting declaration submitted by Google differs from the declaration filed by Samsung in that it has been updated to list the qualifications and personal experience of Dr. Polish.

expert, acted as an understudy); *Celltrion, Inc., v. Genentech, Inc.*, IPR2018-01019, Paper 11 (PTAB Oct. 30, 2018) (same).

D. Samsung's Petition Does Not Raise Any New Grounds Of Unpatentability

Samsung's Petition does not assert any new grounds of unpatentability. It challenges the same claims (1-20) of the '186 patent based on the same prior art, arguments, evidence, and grounds of unpatentability as the Google 340 IPR.

E. Joinder Would Not Affect The Schedule In The Google 340 IPR

Given that Samsung timely filed its Petition with this motion, that Samsung seeks an understudy role, and that Samsung's Petition raises no new grounds of unpatentability, joinder of Samsung would not affect the schedule in the IPR.

Samsung, for example, seeks no change to the Scheduling Order for the trial in the Google 340 IPR. *Google*, IPR2019-00340, Paper 13 (PTAB May 14, 2019). Moreover, even though Samsung's Petition relies on a declaration from an expert different than Google, no additional expert discovery will be needed. In particular, Samsung's expert (Dr. Polish) reviewed and agreed with the expert declaration from Dr. Lipoff supporting Google's Petition (now instituted). As a result, Dr. Polish's declaration is substantially the same as Google's expert declaration. Assuming Google does not move to terminate its IPR before its expert is deposed, Samsung

agrees to rely entirely on, and be bound by, the expert declaration and deposition of Dr. Lipoff.

Further, as a silent understudy, Samsung will file no separate briefs outside of the consolidated filings and will not request separate oral hearing time.[2] As long as Google is a party, Google will retain responsibility for oral argument (including telephone hearings and appeals). In addition, as long as Google is a party, Samsung will not separately file or serve objections or discovery requests, will not receive separate cross examination or redirect time, will not separately cross examine or redirect any witness, and agrees that cross examinations will occur within the timeframe normally allotted to one party without a need for extension in light of the joinder. Only in the event that the Google 340 IPR is terminated with respect to Google does Samsung intend to "step into the shoes" of the dismissed petitioner and materially participate in the joined proceedings.

Thus, the consolidated trial can proceed at the same pace as if Samsung were not joined and so Samsung's joinder will not affect the Board's ability to complete its review and final decision within the statutory time limits under 35 U.S.C. § 316(a)(11) and 37 C.F.R. § 42.100(c).

[2] Except for Board-approved motions (if any), or to address said Board-approved motions, that do not affect Google or Google's position.

F. Briefing and Discovery Will Be Simplified

As stated in Section II.F, ***supra***, Samsung agrees to an "understudy" role and does not raise any issues that are not already before the Board. In particular, Samsung agrees that, if joined, the following conditions will apply so long as Google remains an active party, as previously approved by the Board in similar circumstances:

(a) all filings by Samsung in the joined proceeding be consolidated with the filings of Google, unless a filing solely concerns issues that do not involve Google;

(b) Samsung shall not be permitted to raise any new grounds not instituted by the Board in the Google 340 IPR, or introduce any argument or discovery not already introduced by Google;

(c) Samsung shall be bound by any agreement between SpeakWare and Google concerning discovery and/or depositions;

(d) for depositions, Samsung shall not receive any direct examination, cross examination, or redirect time beyond that permitted for Google in this proceeding alone under 37 C.F.R. § 42.53 or any agreement between SpeakWare and Google; and

(e) Samsung agrees to be bound by the expert deposition and declaration of Google's expert, unless Google terminates its IPR prior to its expert's deposition or reply declaration.

Samsung would therefore only assume a primary role if Google ceased to participate in the proceedings. Briefing and discovery will be simplified in that there will be no need for redundant depositions, briefings, or hearings.

G. Joinder Will Create No Prejudice To SpeakWare

Joinder of Samsung to the Google 340 IPR will not create any additional burden on SpeakWare. As noted above, as Samsung will be a silent understudy and the issues are identical, Samsung's joinder will not affect SpeakWare. In particular, SpeakWare can merely proceed as it would have had to in any event to respond to the issues in the already instituted Google 340 IPR. In addition, joinder eliminates the need for SpeakWare to respond to parallel IPR proceedings on identical grounds of unpatentability.

IV. CONCLUSION

For the foregoing reasons, Samsung respectfully requests that the Board grant its concurrently filed petition for IPR of the '186 patent and that the proceedings be joined.

Date: May 31, 2019

Respectfully submitted,

s/*Jeffrey Miller/*

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CERTIFICATE OF SERVICE

I undersigned hereby certifies that a copy of the foregoing Motion for Joinder was served on May 31, 2019, via FedEx Overnight delivery on the address of record for the subject patent, counsel of record for the Patent Owner in IPR2019-00340, and counsel of record for Petitioner in IPR2019-00340 at the following addresses:

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