

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.,
Petitioner,

v.

FASTVDO LLC,
Patent Owner.

Case IPR2017-00683
Patent 5,850,482

Before KARL D. EASTHOM, JEFFREY S. SMITH, and
PATRICK M. BOUCHER, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION
Granting Joinder; Terminating *Inter Partes* Proceeding
37 C.F.R. §§ 42.108, 42.122

I. INTRODUCTION

Petitioner LG Electronics, Inc. (“LGE”) filed a Petition for *inter partes* review of claims 1–3, 5–14, 16, 17, 22–26, 28, and 29 of U.S. Patent No. 5,850,482 (Ex. 1001, “the ’482 patent”). Paper 2 (“Petition”). Petitioner also filed a Motion for joinder with *Apple, Inc. v. FastVDO LLC*, IPR2016-01203. Paper 4 (“Motion”). Patent Owner filed an Opposition to the Motion for joinder. Paper 10 (“Opposition”). Petitioner filed a Reply to the Opposition. Paper 11 (“Reply”).

Upon consideration of the Petition, Motion, Opposition, and Reply, we grant the Motion for joinder.

II. JOINDER

A party may be joined to an *inter partes* review, subject to the provisions of 35 U.S.C. § 315(c), which governs joinder of *inter partes* review proceedings:

(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.

As the moving party, LGE bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder should (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing

review. *Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, slip. op. at 4 (PTAB April 24, 2013) (Paper 15).

LGE filed its Motion on January 13, 2017. Paper 4. The Board instituted *inter partes* review in IPR2016-01203 on December 16, 2017. IPR2016-01203, Paper 14. Accordingly, the filing date of the Motion for Joinder satisfies the joinder filing requirement, as set forth in 37 C.F.R. § 42.122. *See id.* (“Any request for joinder must be filed . . . no later than one month after the institution date of any *inter partes* review for which joinder is requested”). The Petition asserts the same grounds as those on which the Board instituted review in IPR2016-01203. *Compare* Pet. 19–66 with IPR2016-01203 at 44 (Paper 14); *see also* Motion 1 (“LGE’s Petition in all material respects presents the same grounds as the petition in [IPR2016-01203] – no new arguments, no new claims and no new grounds of unpatentability are added by LGE’s Petition.”)

The Board instituted a trial in IPR2016-01203 on the following grounds:

Reference(s)	Basis	Challenged Claims
Kato ¹	§ 103	1–3, 5–14, 16, 17, 22–26, 28, and 29
Fiala, ² Fazel, ³ and Fazel ’622 ⁴	§ 103	1–3, 5–14, 16, 17, 22–26, 28, and 29

¹ US 5,392,037, Feb. 21, 1995.

² Fiala et al., *Data Compression with Finite Windows*, Communications of the ACM, Vol. 32, No. 4, 490–505 (1989).

³ Fazel et al., *Application of Unequal Error Protection Codes on Combined Source-Channel Coding of Images*, International Conference on Communications, Including SuperComm Technical Sessions (IEEE), Atlanta, Vol. 3, 898–903 (April 15–19, 1990).

⁴ US 5,218,622, June 8, 1993.

IPR2016-01203, Paper 14 at 44.

In its Motion, LGE agreed to take an understudy role to Petitioner Apple, Inc. (“Apple”), and agreed to adhere to the existing trial schedule in IPR2016-01203. Motion 8. LGE also demonstrates sufficiently that joinder will promote efficiency. *See* Motion 1–3.

In its Opposition, Patent Owner contends that the Motion (1) does not limit Petitioner’s right to submit its own filing on the condition that Apple settles with Patent Owner or is otherwise terminated; (2) does not require Petitioner to seek authorization from the Board to file a separate paper, and only where the filing involves an issue unique to Petitioner or states a point of disagreement related to the consolidated filing; (3) does not preclude Petitioner from using its own expert in support of future filings; and (4) does not restrict Petitioner’s right to seek additional time for depositions or oral argument. Opp. 2–5. In Reply, Petitioner states that it has no objection to seeking permission of the Board before filing an alternative pleading. Reply. Petitioner also states that it will submit to whatever procedures the Board requires. *Id.*

Given the following: 1) the challenges in the instant Petition are identical to the grounds instituted in IPR2016-01203; 2) joinder will not impact the existing trial schedule in IPR2016-01203; and 3) joinder will promote efficiency, we determine the Petition warrants institution on the same grounds as those on which the Board instituted *inter partes* review in IPR2016-01203 and join LGE to IPR2016-01203.

After considering Patent Owner’s Opposition and Petitioner’s Reply, we limit Petitioner’s right to submit its own filing on the condition that Apple settles with Patent Owner or is otherwise terminated; we require

Petitioner to seek authorization from the Board to file a separate paper, and only where the filing involves an issue unique to Petitioner or states a point of disagreement related to the consolidated filing; we preclude Petitioner from using its own expert in support of future filings; we preclude Petitioner from seeking additional time for depositions or oral argument; and we bind Petitioner to the Scheduling Order already of record in IPR2016-01203.

LGE is bound by any discovery agreements, including any deposition arrangements, between Patent Owner and Apple in IPR2016-01203, and LGE shall not seek any discovery beyond that sought by Apple. Patent Owner shall not be required to provide any additional discovery or deposition time as a result of the joinder. Apple in the joined proceeding shall designate attorney(s) to conduct the collective cross-examination of any witness produced by Patent Owner and the collective redirect examination of any other witness within the timeframes set forth in 37 C.F.R. § 42.53(c) or as otherwise agreed by Patent Owner and Apple. No individual party will receive any additional cross-examination or redirect examination time. Moreover, if an oral hearing is requested and scheduled, Apple in the joined proceeding shall designate attorney(s) to present a consolidated argument at the oral hearing.

The Board expects LGE, Apple, and Patent Owner to meet and confer regarding any disputes between them and to contact the Board only if such matters cannot be resolved.

Under these circumstances, it is likely that joining Petitioner as a party to IPR2016-01203 will not unduly delay or detrimentally affect IPR2016-01203. We exercise our discretion to join the instant proceeding to IPR2016-01203. Accordingly, the Motion is granted.

III. ORDER

It is

ORDERED that LGE's Motion for Joinder is *granted*;

FURTHER ORDERED that IPR2016-00683 is instituted and LGE is joined with IPR2016-01203;

FURTHER ORDERED that the grounds on which IPR2016-01203 were instituted remain unchanged and no other grounds are included in the joined proceeding;

FURTHER ORDERED that the Order (Paper 9) and Stipulated Schedule (Paper 22) in IPR2016-01203 shall govern the trial schedule of the joined proceeding;

FURTHER ORDERED that, throughout the joined proceeding, Apple shall file all papers as a single, consolidated filing;

FURTHER ORDERED that LGE is bound by any discovery agreements between Patent Owner and Apple in IPR2016-01203 and that LGE shall not seek any discovery beyond that sought by Apple;

FURTHER ORDERED that Apple in the joined proceeding shall designate attorney(s) to conduct collective cross-examination, redirect examination, and any other discovery within the timeframes set forth by the rules, including 37 C.F.R. § 42.53(c), or as the parties otherwise agree upon;

FURTHER ORDERED that Apple in the joined proceeding shall designate attorney(s) to present argument at the oral hearing, if requested and scheduled, in a consolidated argument;

FURTHER ORDERED that IPR2017-00683 is terminated under 37 C.F.R. § 42.72 and all further filings in the joined proceedings will be in IPR2016-01203;

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FURTHER ORDERED that a copy of this Decision will be entered into the record of IPR2016-01203; and

FURTHER ORDERED that the case caption in IPR2016-01203 shall be changed to reflect joinder of the instant proceeding in accordance with the attached example.

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PETITIONER:

David Makous
dmakous@lhlaw.com

DAVID L. FERRMAN
MARTIN M. NOONEN
dferman@mofo.com
10684-FastVDO-IPR@mofo.com

PATENT OWNER:

Neil Rubin
nrubin@raklaw.com

Wayne Helge
whelge@dbjg.com

Amir Naini
anaini@raklaw.com

Walter Davis
wdavis@davidsonberquist.com

Example Case Caption for Joined Proceeding

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC., and
LG ELECTRONICS, INC.,
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v.

FASTVDO LLC,
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Case IPR2016-01203⁵
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⁵ LG Electronics, Inc. filed a petition in (now terminated) IPR2017-00683 and has been joined to the instant proceeding.