

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.
Petitioner,

v.

ADVANCED CODING TECHNOLOGIES LLC,
Patent Owner.

Case IPR2023-00910
Patent No. 9,445,041

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

I. STATEMENT OF PRECISE RELIEF REQUESTED

Samsung Electronics Co., Ltd. (“Samsung”) respectfully submits this Motion for Joinder, concurrently with a Petition (“Samsung Petition”) for *inter partes* review of U.S. Patent No. 9,445,041 (“the ’041 Patent”).

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b), Samsung requests institution of an *inter partes* review and joinder with IPR2022-01548 (“TikTok IPR”), which was instituted on April 13, 2023 (*TikTok Inc. v. Advanced Coding Technologies LLC*, IPR2022-01548, Paper 7 (PTAB April 13, 2023)). Samsung’s Petition is substantively the same as the TikTok IPR petition. It challenges the same claims, on the same grounds, relies on the same prior art as instituted in the TikTok IPR, and relies on the same expert declaration. Therefore, joinder would create no additional burden for the Board, the TikTok IPR Petitioner (“TikTok”), or Patent Owner. Joinder would therefore lead to an efficient resolution of the validity of the ’041 patent.

Samsung is currently a defendant in a district court litigation in the Eastern District of Texas, *Advanced Coding Technologies LLC v. Samsung Electronics Co., Ltd. et al.*, 2-22-cv-00499 (EDTX). In that proceeding, Samsung has been accused of infringing the ’041 patent. Samsung has not previously filed a petition for IPR challenging the validity of the ’041 patent.

Samsung stipulates that if joinder is granted, it will act as an “understudy” and

will not assume an active role unless TikTok ceases to participate in the proceeding. TikTok will maintain the lead role in the proceeding so long as it remains in the proceeding. These limitations will avoid lengthy and duplicative briefing. Samsung also will not seek additional depositions or deposition time. Joinder will not impact the IPR trial schedule because the proceeding based on the TikTok IPR is in its early stages having just instituted on April 13, 2023.

In fact, joinder will help efficiently resolve the disputes among the parties. By joinder, a single Board decision may dispose of the issues raised in the TikTok IPR for all interested parties.

Joinder will not unduly prejudice any party. Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or needlessly increase filings, any additional costs on Patent Owner will be minimal. On the other hand, denial of joinder would prejudice Samsung. Samsung's interests may not be adequately protected in the TikTok IPR, particularly if TikTok settles with Patent Owner and ceases to participate. Samsung should be allowed to join in a proceeding affecting a patent asserted against it.

Given the similarities of the proceedings, the lack of undue prejudice to Patent Owner, and the potential benefit to the public and to the Board that would accrue by Samsung's cooperative participation in the TikTok IPR in the event that TikTok's participation terminates, the Board should institute IPR and grant Samsung's Motion

for Joinder.

II. ARGUMENT

A. Legal Standards and Applicable Rules

A petitioner may request joinder, without prior authorization, no later than one month after the institution date of the proceeding to which joinder is requested. 37 C.F.R. § 42.122(b); *Taiwan Semiconductor Mfg. Co., Ltd. v. Zond LLC*, IPR2014-00781 and IPR2014-00782, Paper 5 at 3 (PTAB May 29, 2014).

The Board has discretion to grant a motion for joinder of a petitioner for *inter partes* review to another *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). In determining whether to exercise its discretion to grant a motion for joinder, the Board considers: (1) reasons why joinder is appropriate; (2) any new grounds of unpatentability asserted in the petition; (3) what impact (if any) joinder would have on the trial schedule for the existing review; and (4) specifically how briefing and discovery may be simplified. *See Dell, Inc. v. Network-I Security Solutions, Inc.*, IPR201300385, Paper 17 at 3 (July 29, 2013).

B. Samsung's Motion for Joinder is Timely

Joinder may be requested “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). The TikTok IPR was instituted on April 13, 2023. IPR2022-01548, Paper 7 (PTAB April 13, 2023). Samsung's current motion is timely as it is being filed

within one month of the institution date.

C. The Four Factors Favor Joinder

Each of the four factors weighs in favor of granting Samsung's Motion for Joinder. Samsung's Petition is substantively identical to the petition in the TikTok IPR; it presents no new grounds of unpatentability. Joinder will have no impact on the pending schedule of the TikTok IPR. Moreover, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

1. Joinder of Samsung Is Appropriate Because It Will Promote an Efficient Determination of the Validity of the '041 Patent Without Prejudice to Any Party

Samsung seeks to join the TikTok IPR in order to ensure that an accused infringer with an active interest in the proceeding remains a party to this IPR if TikTok's participation is terminated prior to completion. Thus, joining Samsung to the TikTok IPR is the most practical way to secure the just, speedy, and inexpensive resolution of the challenge to the '041 patent. *See* 37 C.F.R. § 42.1(b).

If Samsung is joined as a party, the validity of the grounds raised in the TikTok IPR can be determined in a single proceeding. Joinder also is appropriate because Samsung's petition challenges the validity of the same claims of the '041 patent on identical grounds to those in the TikTok IPR. There are no substantive differences between Samsung's Petition and the TikTok IPR Petition. Samsung also relies on the same substantive evidence in its Petition as is relied on in the

TikTok IPR. A consolidated proceeding, including Samsung and TikTok, will therefore be more efficient and less wasteful, as only a single trial on these common grounds would be required. *See, e.g., Oracle America Inc. v. Realtime Data LLC*, IPR2016-01672, Paper 13 at 7 (PTAB Mar. 7, 2017) (noting that “joining Oracle’s identical challenges to those in the 1002 IPR will lead to greater efficiency while reducing the resources necessary from both Realtime and the Board”). The Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.” *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016- 00962, Paper 12 at 9 (PTAB Aug. 24, 2016) (internal quotations and citations omitted).

Joining Samsung as a party to the TikTok IPR would promote the public interest relating to the unpatentability of the ’041 patent and not cause any undue prejudice to Patent Owner or TikTok. The Patent Owner must respond to the common invalidity grounds regardless of joinder.

2. Samsung’s Petition Does Not Raise Any New Grounds of Unpatentability and Therefore Does Not Add Additional Complexity to the Grounds in the TikTok IPR

Samsung’s Petition challenges the validity of the ’041 patent on identical grounds to those in the TikTok IPR. *See* IPR2022-01548, Paper 2 (September 16, 2022). Samsung’s supporting materials—including its supporting expert declaration and substantive exhibits—are identical to those presented in the

TikTok IPR. *See supra*. Further, unity of exhibits and exhibit numbering with the TikTok IPR has been maintained. Accordingly, no new grounds are being introduced. *See Sony Corp. v. Memory Integrity, LLC*, IPR2015-01353, Paper No. 11 at 5-6 (PTAB Oct. 5, 2015) (granting motion for joinder where petitioners relied “on the same prior art, same arguments, and same evidence, including the same expert and a substantively identical declaration”).

Therefore, consolidation of this proceeding with TikTok’s via joinder of Samsung’s Petition will not raise any new issues of unpatentability and will not impose any additional burden on the Board or Patent Owner, or add additional complexity to the case.

3. Joinder Will Not Affect the Schedule in the TikTok IPR

Given that the Board recently instituted review of the TikTok IPR, joinder of Samsung would not affect the schedule in any forthcoming trial. Samsung’s participation should result in no changes to the schedule.

Samsung agrees to adhere to all applicable deadlines set forth in the TikTok IPR Scheduling Order. The Patent Owner’s Response will not be affected because the issues in Samsung’s Petition are identical to those in the TikTok IPR petition. Patent Owner will thus not be required to provide any additional analysis or arguments.

4. Joinder Will Simplify Briefing Because Samsung Has Agreed to Consolidated Filings and an Understudy Role if TikTok Remains

To further prevent joinder from imposing any burden on TikTok, Patent Owner, or the Board and to further ensure that there are no changes in the potential trial schedule, Samsung has agreed, as long as TikTok remains a party to the TikTok IPR, to take an understudy role, which will simplify briefing and discovery. In this role, Samsung agrees to the following conditions:

(a) Samsung shall not make any substantive filing and shall be bound by the filings of TikTok, unless a filing concerns termination and settlement, or issues solely involving Samsung;

(b) Samsung shall not present any argument or make any presentation at oral hearing unless an issue solely involves Samsung, or when addressing Board-approved motions that do not affect TikTok, or its respective position;

(c) Samsung shall not seek to cross-examine or defend the cross-examination of any witness, unless the topic of cross-examination concerns issues solely involving Samsung;

(d) Samsung shall not seek discovery from Patent Owner on issues not solely involving Samsung;

(e) Samsung will not rely on expert testimony beyond that submitted by TikTok. If TikTok is not terminated from the case prior to any necessary

depositions, Samsung agrees to rely entirely on, and be bound by, the expert declarations and depositions in the TikTok IPR. Samsung's expert declaration of Mr. David Lett is identical to the declaration filed in the TikTok IPR petition. *See, e.g., Noven Pharm., Inc. v. Novartis AG*, IPR2014-00550, Paper 38 at 5 (PTAB April 10, 2015). Unless and until the current petitioner in IPR2022-01548 ceases to participate in the instituted TikTok IPR, Samsung will not assume an active role.¹

Accordingly, due to Samsung taking only an "understudy" role, Patent Owner and TikTok will only need to respond to one principal set of papers, will not require additional time to address additional arguments, and can thus proceed with the existing trial schedule. These steps will minimize or eliminate any potential complications or delay that could potentially result from joinder. *See Sony*, Paper No. 11 at 6-7 (granting motion because "joinder would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board" where second petitioner agreed to "understudy" role). Samsung will also abide by any additional conditions the Board deems appropriate for an "understudy" role.

¹ For clarity, should TikTok's participation in the TikTok IPR terminate, Samsung would take over primary responsibility for subsequent filings and discovery.

5. Joinder Will Result in No Prejudice to Patent Owner

As noted above, Samsung's joining of the TikTok IPR proceeding should not result in any prejudice to Patent Owner. No additional grounds or arguments are being introduced, no new evidence or issues are being added, and no additional discovery or briefing or oral argument should be necessary as a result of Samsung's joinder. Thus, Patent Owner would not need to expend any additional resources beyond those required in the current TikTok IPR.

III. INSTITUTION IS APPROPRIATE UNDER *GENERAL PLASTIC*

General Plastic does not apply here because Samsung has not previously challenged the '041 patent and seeks to join the TikTok IPR in an understudy role. *See General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 15-19 (PTAB Sept. 6, 2017); *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00224, Paper 10 at 4-5 (PTAB Apr. 6, 2020).

Factor 1: Under *General Plastic*, factor 1 considers “whether the same petitioner previously filed a petition directed to the same claims of the same patent.” *General Plastic* at 16. Here, Samsung has not previously filed a petition against the '041 patent.

Samsung and TikTok are separate, unrelated petitioners, and are not similarly situated for purposes of Factor 1. While the '041 Patent was originally

asserted against TikTok in district court litigation, TikTok was not accused of infringing the '041 Patent based on the same products as Samsung. Nor has Samsung or TikTok provided any products or technology to the other leading to an allegation of infringement of the '041 Patent. This factor weighs in favor of institution and against discretionary denial.

Factors 2, 4 and 5: As to the timing examined in these factors, Samsung did not previously file a first petition prior to its current petition, and while Samsung became aware of the prior art references after the '041 patent was asserted against it, it made no serial attack on the '041 patent and has filed this petition for IPR within the one-month time period under 37 C.F.R. § 42.122(b). These factors weigh in favor of institution and against discretionary denial.

Factor 3: As Samsung did not previously file a first petition, this factor weighs in favor of institution and against discretionary denial.

Factors 6 and 7: As stated above, Samsung seeks to join the TikTok IPR and is not raising arguments beyond those raised by the TikTok petition. These factors thus weigh in favor of institution, as there should be no material impact on the Board's finite resources or its ability to issue a final determination on the TikTok petition within one year.

IV. CONCLUSION

For the foregoing reasons, Samsung respectfully requests that its Petition for

inter partes review of the '041 Patent be instituted and that Samsung be joined to the TikTok IPR proceeding IPR2022-01548.

Respectfully submitted,

Dated May 12, 2023

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on May 12, 2023, a complete and entire copy of this Petitioner's Motion for Joinder was provided by USPS Priority Mail Express, to the Patent Owner by serving the correspondence address of record as follows:

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