

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GARMIN LTD.,
Petitioner

v.

SLYDE ANALYTICS, LLC,
Patent Owner

Inter Partes Review Case No. IPR2024-00765
U.S. Patent No. 8,588,033

**MOTION FOR JOINDER UNDER
35 U.S.C. § 325(c) AND 37 C.F.R. § 42.122(b)
TO RELATED *INTER PARTES* REVIEW IPR2024-00006**

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Garmin Ltd. (“Petitioner” or “Garmin”) respectfully submits this Motion for Joinder with a concurrently-filed copycat Petition for *Inter Partes* Review of U.S. Patent No. 8,588,033 (the “Garmin IPR” or the “Garmin Petition”). Pursuant to 35 U.S.C. § 325(c) and 37 C.F.R. § 42.122(b), Petitioner requests institution of a *inter partes* review and joinder with the *inter partes* review in *Samsung Electronics Co., Ltd., et al. v. Slyde Analytics, LLC*, IPR2024-00006 (the “Samsung IPR” or the “Samsung Petition”), which has been instituted.

Joinder will promote efficiency and consistent resolution of substantively identical challenges to the same patent. The Garmin IPR is narrowly tailored to the same claims and grounds for unpatentability that are the subject of the Samsung IPR. In addition, Petitioner is willing to streamline discovery and briefing by serving in an understudy role unless and until Samsung is terminated from the Samsung IPR, at which point Garmin will step into Samsung’s shoes and proceed with the IPR as if it were the original filer. *See Dell Inc. v. Network-1 Sec. Sols., Inc.*, IPR2013-00385, Paper 17 at 4-6 (PTAB Jul. 29, 2013) (“*Dell*”).

II. STATEMENT OF MATERIAL FACTS

1. The ’033 Patent issued on November 19, 2013. Patent Owner filed suit against Samsung on February 29, 2023. *Slyde Analytics, LLC v. Samsung*

Electronics Co., Ltd., et al., Case No. 2-23-cv-00083, D.I. 1 (E.D. Tex. Feb. 28, 2023).

2. On October 16, 2023, Samsung filed a petition for *inter partes* review challenging claims 1-19 (“the Challenged Claims”) of the ’033 Patent. *Samsung IPR*, IPR2024-00006, Paper 3 at 1. A decision on institution was granted on March 22, 2024. IPR2024-00006, Paper 13. The Board assessed Samsung’s patentability challenges and concluded “a reasonable likelihood of success in proving that at least one claim of the ’033 patent is unpatentable as obvious over the combination of Mooring and Satoshi.” *Id.* at 35.

3. Garmin has conferred with counsel for Samsung and confirmed that it does not oppose this motion.

4. Garmin sent an email to counsel for Slyde Analytics, LLC seeking its position on this motion. At the time of filing, Slyde had not responded to Garmin’s email.

III. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

A. Legal Standard

The Board has discretion to join a party that properly files an *inter partes* review petition to an existing instituted proceeding addressing the same patent. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); *see also Dell* at 4-6; *Sony Corp. v. Yissum Res. & Dev. Co. of the Hebrew Univ. of Jerusalem*, IPR2013-00326, Paper 15 at

3- 4 (PTAB Sep. 24, 2013); *Microsoft Corp. v. Proxyconn, Inc.*, IPR2013-00109, Paper 15 at 3-4 (PTAB Feb. 25, 2013). A motion for joinder must be filed within one month of the Board instituting an original *inter partes* review. 37 C.F.R. § 42.122(b). “The Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations.” *Dell* at 3. The movants bear the burden of proof in establishing entitlement to the requested relief. 37 §§ 42.20(c), 42.122(b). A motion for joinder should:

[A] set forth the reasons why joinder is appropriate; [B] identify any new grounds of unpatentability asserted in the petition; [C] explain what impact (if any) joinder would have on the trial schedule for the existing review; and [D] address specifically how briefing and discovery may be simplified.

Dell at 4.

B. Petitioner’s Motion for Joinder is Timely

This Motion for Joinder is timely because it was filed within one month of the institution decision of the Samsung IPR. 37 C.F.R. § 42.122(b). Further, the one-year bar set forth in 37 C.F.R. § 42.101(b) does not apply to the Garmin Petition because it is accompanied by this request for joinder. 37 C.F.R. §42.122(b).

C. Each Factor Weighs in Favor of Joinder

Each of the four factors considered by the Board weighs in favor of joinder here. Specifically, the Garmin Petition does not present any new grounds of

unpatentability; rather, it is substantively identical to the Samsung Petition. Further, joinder will have minimal, if any, impact on the trial schedule, as all issues are substantively identical, and Petitioner will accept an “understudy” role unless and until Samsung is terminated from the proceeding. *See Sony Corp. v. Memory Integrity, LLC*, IPR2015-01353, Paper 11 at 5-6 (PTAB Oct. 15, 2015) (granting joinder where petitioners requested an “understudy” role).

1. Joinder Is Appropriate with the Samsung IPR

Joinder with the Samsung IPR is appropriate because the Garmin Petition involves the same patent, challenges the same claims, relies on the same expert declaration, and is based on the same grounds submitted in the Samsung Petition. The Garmin Petition is substantially identical to the Samsung Petition, containing only immaterial differences related to the formalities of a different party filing the petition.

Other than the minor differences related to formalities, there are no changes in the Garmin Petition relative to the facts, citations, evidence, or arguments presented in the Samsung IPR. Thus, the Garmin Petition presents the same grounds of unpatentability as the Samsung Petition and does not present any new theories/arguments. 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) (cleaned up) (emphasis added). Because these proceedings are substantively identical, good cause exists for joining this proceeding with the Samsung IPR so that the Board can efficiently resolve all grounds in both the Garmin and Samsung IPRs in a single proceeding.

2. *Petitioner Proposes No New Grounds of Unpatentability*

As noted above, the Garmin Petition does not present any new grounds of unpatentability. For simplicity and efficiency, Petitioner has copied the substance of the Samsung Petition and its accompanying expert declaration, making the Garmin Petition substantively identical to the Samsung Petition. Notably, Petitioner does not seek to introduce grounds or claims not currently in the Samsung Petition and seeks only to join the proceeding as instituted. Patent Owner should not require any discovery beyond what it may need in the Samsung Petition—nor should the Board permit any. The Garmin Petition presents the unpatentability of the same claims of the same patent in the same way as the Samsung Petition.

3. *Joinder Will Not Unduly Burden or Negatively Impact the Samsung IPR Trial Schedule*

Because the Garmin Petition is substantively identical to the Samsung Petition, with the same grounds rejecting the same claims, there are no new issues for Patent Owner to address. Due to the same issues presented in the Garmin Petition, Patent Owner will not be required to present any additional responses or arguments. *See Sony Corp.*, IPR2015-01353, Paper 11 at 6 (granting IPR and motion for joinder

where “joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR].”).

The Patent Owner Response (yet to be filed in the Samsung IPR) will not be negatively impacted because the issues presented in both Petitions are identical, and the Patent Owner Response is not due in the Samsung IPR until June 14, 2024. Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in response to the Samsung Petition. Also, because the Garmin Petition relies on the same expert, Benjamin B. Bederson, and an identical declaration, only a single deposition is needed for Patent Owner to prepare its Response in the joined proceeding.

Joinder of the Garmin IPR with the Samsung IPR does not unduly burden or negatively impact the trial schedule in any meaningful way. Further, even if a small adjustment of the trial schedule was necessary, this is already provided for in the rules and is a routine undertaking by parties in IPR proceedings. *See* 37 C.F.R. § 42.200(c). Thus, a slight adjustment in the trial schedule, should one be needed, is not enough reason to deny joining the present Garmin IPR with the Samsung IPR.

4. Procedures to Simplify Briefing and Discovery

The Samsung Petition and Garmin Petition present substantively identical grounds for rejection, including the same art combinations against the same claims. Petitioner explicitly agrees to take a passive “understudy” role, as described by the

Board:

“(a) *all* filings by [Petitioner] in the joined proceeding be consolidated with [the filings of the petitioner in the Samsung IPR], unless a filing solely concerns issues that do not involve [the petitioner in the Samsung IPR]; (b) [Petitioner] shall not be permitted to raise any new grounds not already instituted by the Board in the [Samsung IPR], or introduce any argument or discovery not already introduced by [the petitioner in the Samsung IPR]; (c) [Petitioner] shall be bound by any agreement between [Patent Owner] and [the petitioner in the Samsung IPR] concerning discovery and/or depositions; and (d) [Petitioner] at deposition shall not receive any direct, cross-examination or redirect time beyond that permitted for [the petitioner in the Samsung IPR] alone under either 37 C.F.R. § 42.53 or any agreement between [Patent Owner] and [the petitioner in the Samsung IPR].”

See Noven Pharmaceuticals, Inc. v. Novartis AG, IPR2014-00550, Paper 38 at 5 (PTAB Apr. 10, 2015). Unless and until the current petitioner ceases to participate, Garmin will not assume an active role in the Samsung Proceeding.

By Petitioner accepting an “understudy” role, Patent Owner and Petitioner Samsung can comply with any current trial schedule set by the Board and avoid any duplicative efforts by the Board or the Patent Owner. These steps will minimize any potential complications or delays that result from joinder. *See Sony Corp.*, IPR2015-01353, Paper 11 at 6-7 (granting IPR and motion for joinder 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 petitioners agreed to an “understudy” role.); *see also id.* at Paper 4 at 6-7.

IV. GENERAL PLASTICS IS INAPPLICABLE

Petitioner respectfully submits that *General Plastic* analysis is inapplicable here. In *General Plastic*, the Board set forth a series of factors that may be analyzed for follow-on petitions to help conserve the finite resources of the Board. Here, both Samsung and Garmin submitted separate, independent petitions. In the current motion, Garmin merely seeks to join Samsung’s petition and does not present any new grounds. As such, Garmin respectfully submits that *General Plastic* does not apply because Garmin would be taking an understudy role, and the Board’s finite resources would not be impacted.

Moreover, a joinder petition in these circumstances is not the type of serial petition to which *General Plastic* applies, especially as Garmin has not previously filed an IPR against the ’033 Patent. The PTAB has previously stated that a joinder petition “effectively neutralizes” a *General Plastic* analysis. *See Apple Inc. v. Uniloc 2017 LLC*, IPR2018-00580, Paper 13 at 10 (PTAB Aug. 21, 2018) (instituting a joinder petition where joinder petitioner previously filed a non-instituted IPR, stating joinder petitioner’s joinder motion agreeing to a passive understudy role “effectively neutraliz[es] the *General Plastic* factors”); *see also Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11 at 10 (PTAB Oct. 30, 2018) (instituting a joinder petition

where joinder petition previously filed a non-instituted IPR, stating the joinder motion “effectively obviates any concerns of serial harassment and unnecessary expenditure of resources”). Therefore, *General Plastic* analysis is inapplicable.

V. CONCLUSION

Based on the abovementioned factors, Petitioner Garmin respectfully requests that the Board grant the Garmin Petition for *Inter Partes Review* of U.S. Patent No. 8,588,033 (IPR2024-00765) and then grant joinder with the Samsung IPR (IPR2024-00006).

Date: April 22, 2024

Respectfully submitted,
ERISE IP, P.A.

BY: /s/ Adam P. Seitz
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COUNSEL FOR PETITIONER

CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that a true and correct copy of the Motion for Joinder has been served on the Patent Owner on April 22, 2024, via Federal Express or by means at least as fast and reliable as Federal Express on the below date, at the following address:

Blank Rome LLP
1858 Eye Street NW
Washington, DC 20006

Further, a courtesy copy of this Motion for Joinder under 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b) was sent via electronic mail to Patent Owner's litigation counsel:

Alfred R. Fabricant (ffabricant@fabricantllp.com)
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Finally, Petitioner has sent email to the Board and parties listed in IPR2024-00006 notifying them of the filing of the Motion for Joinder and Petition for *Inter Partes* Review as follows:

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