

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GARMIN LTD.,
Petitioner,

v.

SLYDE ANALYTICS, LLC,
Patent Owner.

IPR2024-00765
Patent 8,588,033

Before LEE JAMESON, ST. JOHN COURTENAY III, and
JOHN F. HORVATH, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314
Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

On April 22, 2024, Petitioner, GARMIN LTD. (“GARMIN”), filed a Petition requesting an *inter partes* review (“IPR”) of claims 1–19 of U.S. Patent No. 8,588,033 (Ex. 1001, “the ’033 patent”). Paper 1 (“Petition” or “Pet.”). GARMIN filed its Petition along with a Motion for Joinder requesting that we join GARMIN as a party to *Samsung Electronics Co., Ltd., et al. v. Slyde Analytics, LLC*, IPR2024-00006 (“Samsung IPR”). Paper 3 (“Mot. for Joinder”).

On March 22, 2024, we entered a Decision on Institution in the Samsung IPR, in which we instituted an IPR as to claims 1–19 of the ’033 patent. *See* Samsung IPR, paper 13 (“Samsung IPR Dec. on Inst.”). As discussed further *infra*, the Petition and supporting evidence filed in this proceeding are substantially identical to the petition and supporting evidence filed in the Samsung IPR. *Compare* Samsung IPR, paper 3 (“Samsung IPR Petition”), 1–108, *and* Exs. 1001–1050, *with* Pet. 1–104, *and* Exs. 1001–1050.

GARMIN timely filed its Motion for Joinder within one month of the institution of the Samsung IPR, as required by 37 C.F.R. §42.122(b). Mot. for Joinder. Paper 3. *Slyde Analytics* (“Patent Owner”) filed its Opposition to Petitioner’s Motion for Joinder. Paper 7 (“Opp.”). GARMIN filed its Reply to Patent Owner’s Opposition. Paper 8 (“Reply”).

GARMIN represents that it is willing to limit the asserted grounds of unpatentability (“grounds”) to the “same claims and grounds for unpatentability that are the subject of the Samsung IPR.” Mot. for Joinder 1. GARMIN also represents that, if it is allowed to join the Samsung IPR, it

will assume an “understudy” role (i.e., a passive role) and will assume an active role only in the event that Samsung Electronics, Inc. and Samsung Electronics U.S.A., Inc. (collectively, “Samsung”), the petitioner in the Samsung IPR, ceases to participate in the Samsung IPR, and the Samsung IPR terminates with respect to Samsung. Mot. for Joinder 1, 7.

We have the authority to determine whether to join a party to another instituted IPR under 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122. The standard for joinder is set out in 35 U.S.C. § 315(c), requiring a petitioner to file a petition that “warrants the institution of an inter partes review.”

Under 35 U.S.C. § 314(a), an IPR may not be instituted unless the information presented in the Petition shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons set forth below, we determine: (1) GARMIN has shown a reasonable likelihood that it would prevail in establishing the unpatentability of at least one challenged claim in the ’033 patent; and, (2) GARMIN has satisfied the threshold requirement to warrant joinder.

II. WHETHER TO INSTITUTE *INTER PARTES* REVIEW

In the Samsung IPR2024-00006, we instituted review of claims 1–19 of the ’033 patent based upon all the asserted grounds of unpatentability as set forth in the table below. Samsung IPR, Dec. on Inst. 35–36.

Grounds	Challenged Claim(s)	35 U.S.C. §	References
1	1, 11–14	103(a)	Mooring, ¹ Satoshi ²
2	2, 3, 17, 19	103(a)	Mooring, Satoshi, Lee ³
3	13–16	103(a)	Mooring, Satoshi, Louch ⁴
4	4, 5	103(a)	Mooring, Satoshi, Inoue, ⁵ Tam ⁶
5	6–10, 13	103(a)	Mooring, Satoshi, Tam, Ruchonnet ⁷
6	18	103(a)	Mooring, Satoshi, Lee, Tam, Inoue, Ruchonnet

As noted above, the “copycat” GARMIN Petition and the supporting evidence filed in this proceeding are substantially identical to the Samsung IPR Petition and the supporting evidence filed in the Samsung IPR, and GARMIN challenges the same claims on the same grounds asserted in the Samsung IPR. Pet. 3–4. Mot. for Joinder 1, 3–6, 8.

Based upon our review of the record, we find the Patent Owner’s Preliminary Response in instant IPR2024-00765 (Paper 9) is substantially identical to the Patent Owner’s response in the Samsung IPR (paper 19). To

¹ Mooring, US 2009-0196124 A1 (published Aug. 6, 2009).

² Sugihara, Satoshi JP 2005/242456 A (published Sept. 8, 2005).

³ Lee, US 2008/0186808 A1 (published Aug. 7, 2008).

⁴ Louch, US 2008/0168368 A1 (published July 10, 2008).

⁵ Inoue, US 2008/0151700 A1 (published June 26, 2008).

⁶ Tam, et al., “Physical-Based Simulations of Mechanical Watches and Clocks,” Proceedings of ASME Int’l Mech. Engr. Congress and Exposition, Nov. 11–15, 2007.

⁷ Ruchonnet, US 2005/0122844 A1 (published June 9, 2005).

the extent there may be some differences between the Patent Owner’s preliminary response in the Samsung IPR (paper 7) and the Patent Owner’s Preliminary Response in instant IPR2024-00765 (Paper 9), we will address all substantive arguments from both parties in the Samsung IPR, which GARMIN seeks to join in an understudy role.⁸

Given the “copycat” GARMIN petition in instant IPR2024-00765, our finding is unchanged that the Petitioner (here, GARMIN) has established a reasonable likelihood that it would prevail in showing that at least the subject matter of independent claim 1 would have been obvious over the combination of Mooring and Satoshi (Ground 1), for the same reasons discussed in the Samsung IPR Dec. on Inst. (Papers 13, 15–33).

A. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314(a)

Institution of an *inter partes* review under 35 U.S.C. § 314(a) is discretionary. *See Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) (citing § 314(a) and stating “the agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion”); *see also Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (explaining

⁸ To be clear, to the extent GARMIN refers to a “consolidated” proceeding and its presumed “understudy” role, GARMIN ***may not*** file any paper or exhibit in the Samsung IPR separate and apart from Samsung, ***unless and until Samsung settles or otherwise withdraws from the trial***. Also, GARMIN will be bound by Samsung’s filings and representations, except for matters relating to settlement between Samsung and Patent Owner. As GARMIN expressly states: “Unless and until the current petitioner [Samsung] ceases to participate, Garmin will not assume an active role in the Samsung [IPR2024-00006] Proceeding.” Mot. for Joinder 7.

that under § 314(a), “the PTO is permitted, but never compelled, to institute an IPR proceeding”).

Here, Patent Owner requests that we exercise the Board’s discretion under 35 U.S.C. § 314(a) to deny institution of an *inter parties* review in the particular circumstances of this proceeding. Opp. 1–6. Patent Owner argues the *General Plastic* factors favor denial of institution, which would preclude joinder, in opposition to GARMIN’s Motion for Joinder. Opp. 3–6.

1. General Plastic Factors

In *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, the Board enumerated seven non-exhaustive factors to consider in determining whether to exercise its discretion under § 314(a) to deny institution when a party files multiple “follow-on” petitions challenging the same patent as challenged previously in an *inter partes* review. Case IPR2016-01357, slip op. at 15–16 (PTAB Sept. 6, 2017) (Paper 19) (§ II.B.4.i precedential); *see also* Office Trial Practice Guide, August 2018 Update, 83 Fed. Reg. 39989 (Aug. 13, 2018) (Notice of update); Trial Practice Guide Update (August 2018), 3, 9–10 (Considerations in Instituting a Review (discussing *General Plastic*)).

The non-exhaustive *General Plastic* factors are:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the

- first petition or received the Board’s decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
 5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
 6. the finite resources of the Board; and
 7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

General Plastic, slip op. at 9–10.4

The *General Plastic* factors have generally been used to analyze situations in which *the same party files multiple petitions challenging the same patent*.

That is not the case here. GARMIN persuasively argues: “[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*.” Mot. for Joinder 8 (emphasis added).

Patent Owner does not specifically address *General Plastic* factor 1 (“whether the *same petitioner previously filed a petition directed to the same claims of the same patent*”). Opp. 4 (emphasis added). Patent Owner instead only addresses *General Plastic* factors 2–7. Opp. 4–6.

In reply, GARMIN again argues that *General Plastic* “is applicable where “**the same petitioner** files ‘follow-on petitions’ against the same patents, after a first set of petitions was denied on the merits.” Reply 1 (citing *Mercedes-Benz USA v. Carucel Investments*, IPR2019-01644, Paper 9 at 12 (PTAB Mar. 26, 2020) (citing *General Plastic*, Paper 19 at 2-3)).

GARMIN emphasizes: “it is undisputed that Garmin has **not previously** filed an IPR against the ’033 Patent.” Reply 1.

Although GARMIN is correct that a *General Plastic* analysis is generally applicable when the **same party** files multiple petitions challenging the same patent, the Board has extended *General Plastic* factor 1 to include a third-party subsequent petitioner who has a “significant relationship” with the prior petitioner, as discussed below.

2. *There is No Significant Relationship between GARMIN and Samsung*

In *Valve Corporation*, the Board extended *General Plastic* analysis to a situation in which a subsequent petition was filed by a different petitioner. *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, paper 11 (PTAB Apr. 2, 2019) (precedential) (hereinafter “*Valve*”). Specifically, the two petitioners in *Valve* were **co-defendants** in a District Court litigation, had a licensing relationship concerning a product, and were accused of infringing based upon the **same product**. *Valve* at 9–10. In *Valve*, The Board considered whether there was a “**significant relationship**” between the two different parties filing the two petitions, such that the second petitioner should be regarded as the same petitioner under *General Plastic* factor 1. *Valve* at 2, 10 (emphasis added).

Here, Patent Owner asks the Board to exercise its discretion under § 314(a) to deny institution under *General Plastic* (Opp. 3–6). But Patent Owner has not established under *General Plastic* factor 1 that GARMIN itself (or its privy) has filed multiple “follow-on” petitions challenging the

same patent as challenged previously in an *inter partes* review. Nor has Patent Owner established, also under *General Plastic* factor 1, that GARMIN (as the subsequent petitioner) and *Samsung*, have a ***significant relationship***, in the sense contemplated by *Valve* (i.e., as co-defendants accused of infringing based upon the ***same product***). *Valve* at 9–10.

Director Vidal has instructed the Board that *General Plastic* factor 1 should not be expanded beyond *Valve* to apply to parties that do not have a ***significant relationship***. See *Videndum Production Solutions, Inc. v. Rotolight Limited*, IPR2023-01218, paper 12 at 6 (Director Vidal, April 19, 2024) (“The majority’s Decision in this proceeding improperly expanded the discretionary principles set forth in *General Plastic* and *Valve* to apply to petitioners that are not the same and do not have a ‘significant relationship.’”). Moreover, Director Vidal has instructed that where “the first and second petitioners are neither the same party, nor possess a significant relationship under *Valve*, *General Plastic* factor one necessarily outweighs the other *General Plastic* factors.” *Id.*

For the foregoing reasons, we decline Patent Owner’s request to exercise our discretion to deny institution under 35 U.S.C. § 314(a). See Opp. 3–6.

3. *Conclusion as to Institution*

After considering the arguments presented in the Petition, the Preliminary Response, and the evidence of record, we determine that GARMIN has demonstrated 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.

Accordingly, we institute an *inter partes* review of all challenged claims (i.e., claims 1–19) on all grounds set forth in the Petition. Our determinations at this stage of the proceeding are based on the evidentiary record currently before us. This decision to institute trial is not a final decision as to the patentability of any claim for which we have instituted an *inter partes* review. *See TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016) (noting that “there is a significant difference between a [P]etitioner’s burden to establish a ‘reasonable likelihood of success’ at institution, and actually proving invalidity by a preponderance of the evidence at trial.”). We will base any final decision on the full record developed during trial.

III. WHETHER TO GRANT JOINDER

Based on authority delegated to us by the Director, we have discretion to join a petitioner requesting an IPR as a party to another IPR, subject to certain exceptions not present here. *See* 35 U.S.C. § 315(c). For the reasons explained below, we find GARMIN has met the standard for joinder as set forth in 35 U.S.C. § 315(c), by filing a petition that “warrants the institution of an *inter partes* review.”

The regulatory provisions governing an IPR address the appropriate timeframe for filing a motion for joinder. 37 C.F.R. 42.122(b) provides, in pertinent part, “[a]ny request for joinder must be filed, as a motion under

§ 42.22, no later than one month after the institution date of any inter partes review for which joinder is requested.”

Here, the GARMIN Petition was accorded a filing date of April 22, 2024 (Papers 4, 1), and the Motion for Joinder was filed on the same day as the Petition. As such, GARMIN’s Motion for Joinder was timely because joinder was requested no later than one month after the March 22, 2024 institution date of the Samsung IPR. *See* Samsung IPR Dec. on Inst. (paper 13). Therefore, we find GARMIN timely filed its Motion for Joinder in accordance with 37 C.F.R. § 42.122(b).

As the moving party, GARMIN bears the burden of proving that it is entitled to the requested relief. *See* 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*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

On this record, we find GARMIN has met its burden of showing that joinder is appropriate, at least because, as set forth above, the Petition here: (1) is substantively identical to the petition filed in the Samsung IPR; (2) contains the same grounds for the same claims based upon the same evidence; and, (3) relies upon the same Declaration of Dr. Benjamin B. Bederson, Ph.D. *See* Mot. for Joinder 6; Ex. 1002. GARMIN also represents that it “will accept an ‘understudy’ role unless and until Samsung is terminated from the proceeding.” Mot. for Joinder 4. For what constitutes “understudy role,” see footnote 8, *supra*. And GARMIN clarifies: “Unless

and until the current petitioner ceases to participate, Garmin will not assume an active role in the Samsung Proceeding.” Mot. for Joinder 7.

In its Motion for Joinder, GARMIN summarizes that joinder is appropriate because this proceeding and the Samsung IPR are substantively identical (i.e., they involve the same claims, the same patent, the same prior art references, the same expert declaration, and the same arguments and evidence). *See* Mot. for Joinder 3–6. Stated differently, GARMIN asserts that the Petition and supporting evidence filed in this proceeding do not raise any new substantive or procedural issues. *See id.* GARMIN further contends that joinder will not “unduly burden or negatively impact the trial schedule [of the Samsung IPR] in any meaningful way,” thereby allowing us to complete a single joined proceeding in a timely manner. *Id.* at 6. GARMIN also asserts that granting joinder will not affect the issues, briefing, or discovery in the Samsung IPR, as they will remain the same. *Id.* at 5–6.

On this record, we find GARMIN has satisfied the requirements for joinder, as described above, and has demonstrated that joinder will not unduly complicate or delay the Samsung IPR. *See* 37 C.F.R. § 42.1(b) (providing for “the just, *speedy*, and inexpensive resolution *of every proceeding*” (emphases added)). We, therefore, grant GARMIN’s Motion for Joinder and, as a result, join GARMIN as a party to the Samsung IPR.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a) and 37 C.F.R. § 42.4, an IPR is instituted as to claims 1–19 of the '033 patent on the following grounds:

Grounds	Challenged Claim(s)	35 U.S.C. §	References
1	1, 11–14	103(a)	Mooring, Satoshi
2	2, 3, 17, 19	103(a)	Mooring, Satoshi, Lee
3	13–16	103(a)	Mooring, Satoshi, Louch
4	4, 5	103(a)	Mooring, Satoshi, Inoue, Tam
5	6–10, 13	103(a)	Mooring, Satoshi, Tam, Ruchonnet
6	18	103(a)	Mooring, Satoshi, Lee, Tam, Inoue, Ruchonnet

FURTHER ORDERED that GARMIN's Motion for Joinder to IPR2024-00006 (the Samsung IPR) is *granted*, and GARMIN is joined as a party to IPR2024-00006, pursuant to 37 C.F.R. § 42.122(b);

FURTHER ORDERED that all future filings in the joined proceeding are to be made only in IPR2024-00006;

FURTHER ORDERED that the grounds on which an IPR was instituted in IPR2024-00006 remain unchanged, and no other new grounds are instituted in the joined proceedings;

FURTHER ORDERED that the Scheduling Order currently in place in IPR2024-00006 (Paper 14) shall govern the schedule of the joined proceeding;

FURTHER ORDERED that, unless and until Samsung is terminated from IPR2024-00006, GARMIN is bound by all filings by Samsung without a separate opportunity to be heard, whether orally or in writing (except for filings regarding termination or settlement and filings where GARMIN receives permission from the Board to file an independent paper);

FURTHER ORDERED that GARMIN must obtain prior Board authorization to file any paper or take any action on its own in IPR2024-00006 (except a motion to modify these provisions on the ground that Samsung is no longer an active party);

FURTHER ORDERED that the case caption in IPR2024-00006 for all further submissions shall be changed to add GARMIN as a named petitioner, and to indicate by footnote the joinder of Petitioner GARMIN to that proceeding, as indicated in the attached sample case caption; and

FURTHER ORDERED that GARMIN's participation in the briefing, depositions, and oral argument shall be subject to Samsung's acquiescence to GARMIN's participation and, absent our express authorization, GARMIN shall not file papers or exhibits separate and apart from Samsung;

FURTHER ORDERED that the roles of Samsung and Slyde Analytics in the joint proceeding remain unchanged;

FURTHER ORDERED that a copy of this Decision be entered into the file of IPR2024-00006.

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS
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v.

SLYDE ANALYTICS TECHNOLOGIES PTE. LTD.,
Patent Owner.

IPR2024-00006¹
Patent 8,588,033

¹ GARMIN, INC. filed a petition in IPR2024-00765 and was joined as petitioner in this proceeding.