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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

MOLECULAR REBAR DESIGN, LLC,
Patent Owner.

IPR2025-00358
Patent 10,608,282 B2

Before GRACE KARAFFA OBERMANN, AVELYN ROSS, and JULIA HEANEY, *Administrative Patent Judges.*

HEANEY, *Administrative Patent Judge*.

DECISION

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

I. INTRODUCTION

A. Background

On December 23, 2024, Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, "Petitioner") filed a Petition (Paper 4, "Pet.") requesting *inter partes* review of claims 1–16 ("the challenged claims") of U.S. Patent No. 10,608,282 B2 (Ex. 1001, "the '282 patent"). Concurrently with the Petition, Petitioner filed a Motion for Joinder (Paper 5, "Mot."), requesting that we join it with *LG Energy Solution, Ltd. v. Molecular Rebar Design, LLC*, IPR2024-01012 ("1012 IPR" or "LGES IPR"), in which we instituted trial on December 16, 2024. Mot. 1. Molecular Rebar Design, LLC ("Patent Owner") filed a Waiver of Preliminary Response and indicated that it does not oppose Petitioner's Motion for Joinder. Paper 9.

On April 30, 2025, the clerk referred this case to the Board "to consider the merits and non-discretionary considerations." Paper 10, 1–2.

For the reasons discussed below, we institute an *inter partes* review and grant Petitioner's Motion for Joinder.

B. Related Proceedings and Asserted Grounds of Unpatentability

In the 1012 IPR, we instituted an *inter partes* review of the '282 patent on all challenged claims and on all grounds set forth in the Petition filed by LG Energy Solution, Ltd. ("LGES" and "the LGES Petition"). *See* 1012 IPR, Paper 8, 7–8.

Petitioner in this proceeding represents that its Petition challenges the same claims on identical grounds of unpatentability, and relies on the same evidence, as presented in the LGES Petition. *See* Pet. 1; Mot. 6–7. Patent Owner does not contest those facts. Instead, Patent Owner acknowledges

that the present "Petition does not present any new grounds of unpatentability; rather it is substantively identical to" the LGES Petition. Paper 9, 1.

We agree with the parties that the LGES Petition "involves the same patent, challenges the same claims, relies on the same expert declaration, and is based on the same grounds and combinations of prior art." Paper 9, 1 (Patent Owner's admission); *see* Mot. 3 (Petitioner, averring that its Petition and the LGES Petition are "substantively identical"). Under these circumstances, our reasons for instituting review based on the LGES Petition apply with equal force to the "substantively identical" present Petition. *Id*.

Accordingly, for the same reasons set forth in the Institution Decision filed in the 1012 IPR, we institute review on all claims and all grounds asserted in the Petition. *See generally* 1012 IPR, Paper 8.

II. ANALYSIS

A party in an *inter partes* review may be joined as a party in another *inter partes* review, subject to certain statutory provisions:

> (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 parties review under section 314.

35 U.S.C. § 315(c); *see also* 37 C.F.R. § 42.122 ("Any 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."). "To join a party to an instituted [*inter partes* review (IPR)], the plain

language of § 315(c) requires two different decisions." *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). "First, the statute requires that the Director (or the Board acting through a delegation of authority) . . . determine whether the joinder applicant's petition for IPR 'warrants' institution under § 314." *Id.* "Second, to effect joinder, § 315(c) requires the Director to exercise [] discretion to decide whether to 'join as a party' the joinder applicant." *Id.*

A. Whether the Petition Warrants Institution

As we note above, the Petition challenges the same claims on the same grounds of unpatentability, and relies on the same evidence, including the same declarant testimony, as presented in the 1012 IPR. Pet. 1; Mot. 6–7. In other words, the Petition is virtually identical to the petition filed in the 1012 IPR. We incorporate our analysis from the 1012 IPR regarding the asserted grounds of unpatentability and determine that Petitioner has demonstrated sufficiently under 35 U.S.C. § 315(c) that institution of an *inter partes* review is warranted under 35 U.S.C. § 314(a).

B. Whether to Join Petitioner as a Party to the 1012 IPR

Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. 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. *See, e.g.*, *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 (PTAB April 24, 2013). As the moving party, Petitioner

bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c).

As an initial matter, the Motion for Joinder meets the requirements of 37 C.F.R. § 42.122(b) because Petitioner filed it within one month after the 1012 IPR was instituted on December 16, 2024. Mot. 1, 3.

Petitioner asserts that the *Kyocera* factors favor joinder here because the Petition "does not present any new grounds of unpatentability; rather it is substantively identical to the LGES Petition", "joinder will have minimal, if any, impact on the trial schedule, as all issues are substantively identical", "Petitioner will accept an 'understudy' role unless and until LGES is terminated from the proceeding", and "the briefing and discovery will be simplified by resolving all issues in a single proceeding." Mot. 3–4. Petitioner explains that "[b]y Petitioner accepting an 'understudy' role, Patent Owner and Petitioner can comply with the current trial schedule and avoid any duplicative efforts by the Board or the Patent Owner." *Id.* at 8. Petitioner further provides the following conditions it would abide by as long as LGES remains an active party:

> (a) all filings by [Petitioner] in the joined proceeding be consolidated with [the filings of the petitioner in the LGES IPR], unless a filing solely concerns issues that do not involve [the petitioner in the LGES IPR]; (b) [Petitioner] shall not be permitted to raise any new grounds not already instituted by the Board in the [LGES IPR], or introduce any argument or discovery not already introduced by [the petitioner in the LGES IPR]; (c) [Petitioner] shall be bound by any agreement between [Patent Owner] and [the petitioner in the LGES 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 LGES IPR] alone

> under either 37 C.F.R. § 42.53 or any agreement between [Patent Owner] and [the petitioner in the LGES IPR].

Id. (bracketed modifications in original). Based on these conditions, Petitioner contends that it "will assume the primary role only if LGES ceases to participate in the LGES IPR." *Id.*

Based on the facts and circumstances discussed above, we determine Petitioner has established good cause for joining the 1012 IPR. Specifically, we find that joining Petitioner to the 1012 IPR is unlikely to require any delay or modification to the scheduling order already in place for the 1012 IPR. We also determine that Patent Owner will not be prejudiced unduly by the joinder of this proceeding. Thus, we determine that granting the Motion for Joinder under these circumstances would help "secure the just, speedy, and inexpensive resolution" of these proceedings. *See* 37 C.F.R. § 42.1(b). For the above reasons, we grant Petitioner's Motion for Joinder and join Petitioner as a party to the 1012 IPR.

III. ORDER

For the reasons given, it is

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted as to claims 1–16 of the '282 patent on the grounds set forth in the Petition;

FURTHER ORDERED that Petitioner's Motion for Joinder is *granted*, and Petitioner is joined as a petitioner in IPR2024-01012;

FURTHER ORDERED that Petitioner shall have an "understudy" role in IPR2024-01012 under the conditions reproduced above (*see* Mot. 8);

FURTHER ORDERED that all further filings in the joined proceeding shall be made in IPR2024-01012, and that IPR2025-00358 is terminated and no further filings shall be made in IPR2025-00358;

FURTHER ORDERED that the Scheduling Order in IPR2024-01012 remains unchanged, and shall govern the joined proceeding;

FURTHER ORDERED that a copy of this Decision shall be entered in IPR2024-01012; and

FURTHER ORDERED that the case caption in IPR2024-01012 shall be modified to reflect Petitioner's joinder in accordance with the attached example.

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Example Caption for Joined Proceeding

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Patent Owner.

IPR2024-01012[1]
Patent 10,608,282 B2

[1] Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc., which filed a petition in IPR2025-00358, have been joined as petitioners in this proceeding.