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.

Case: IPR2025-00357

U.S. Patent No. 8,968,924

MOTION FOR JOINDER TO *INTER PARTES* REVIEW IPR2024-01011

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Samsung Electronics Corporation, Ltd. and Samsung Electronics America, Inc. ("Petitioner") respectfully submits this Motion for Joinder ("Motion") together with a Petition for *Inter Partes* Review of U.S. Patent No. 8,968,924 (the "Samsung Petition") filed contemporaneously herewith. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner requests institution of an *inter partes* review and joinder with the *inter partes* review in *LG Energy Solution, Ltd. v. Molecular Rebar Design, LLC et al.*, IPR2024-01011 (the "LGES IPR") in view of the Patent Trial and Appeal Board's (the "Board") decision to institute trial on December 16, 2024. (LGES IPR, Paper 9). Counsel for Petitioner has conferred with counsel for LG Energy Solution, Ltd. ("LGES"), and counsel for LGES does not object to Petitioner joining IPR2024-01011.

Petitioner's request for joinder is timely under 37 C.F.R. § 42.122(b) as it is submitted no later than one month after the December 16, 2024 institution date of the LGES IPR. The Samsung Petition is also narrowly tailored to the same claims, prior art, and grounds for unpatentability that are the subject of the LGES IPR. In addition, Petitioner is willing to streamline discovery and briefing, as well as follow the LGES IPR Scheduling Order.

Petitioner submits that joinder is appropriate because it will not unduly burden or prejudice the parties to the LGES IPR while efficiently resolving whether the

claims of U.S. Patent No. 8,986,924 (the "'924 Patent") are valid and in a single proceeding.

II. STATEMENT OF MATERIAL FACTS

1. On June 12, 2024, LGES filed a petition for *inter partes* review in IPR2024-01011 requesting cancellation of claims 1-5 of the '924 Patent.

2. On February 16, 2024, Molecular Rebar Design, LLC and Black Diamond Structures, LLC filed a civil action against Petitioner, Case No. 2:24-cv-00108, in the United States District Court for the Eastern District of Texas, which was later consolidated with Case No. 2:24-cv-00107 ("the Eastern District Case").

3. On December 16, 2024, the Board instituted LGES's petition for *inter partes* review in IPR2024-01011, finding that Petitioner has established a reasonable likelihood of prevailing on its challenge that the Challenged Claims are "unpatentable as obvious in view of" the cited references. *See* LGES IPR, Paper 9 at 35-36.

III. STATEMENTS OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Board has the authority under 35 U.S.C. § 315(c) to join a properly filed *inter partes* review petition to an instituted *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). 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). In deciding whether to exercise its discretion and permit joinder, the Board considers several

factors, including: (1) the reasons why joinder is appropriate; (2) whether the new petition presents any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (April 24, 2013); Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), 76–78.

B. Petitioner's Motion for Joinder is Timely

This Motion for Joinder is timely because it is filed within one month of the December 16, 2024 institution decision of the LGES IPR. 37 C.F.R. § 42.122(b). Further, the one-year bar set forth in 35 U.S.C. § 315(b) and 37 C.F.R. § 42.101(b) does not apply to the Samsung Petition because this Motion for Joinder is filed concurrently with the Samsung Petition. 37 C.F.R. § 42.122(b).[1]

C. Each Factor Weighs in Favor of Joinder

As explained in detail below, each of the four factors considered by the Board weighs in favor of joinder. Specifically, the Samsung Petition does not present any new grounds of unpatentability; rather it is substantively identical to the LGES

[1] In any event, the Samsung Petition is being filed less than one year after the earliest date that the Complaint was served in the Eastern District Case (February 22, 2024). *See* 35 U.S.C. § 315(b); 37 C.F.R. § 42.101(b).

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 LGES is terminated from the proceeding. Lastly, the briefing and discovery will be simplified by resolving all issues in a single proceeding. Accordingly, joinder is appropriate here.

Moreover, the Board routinely grants motions for joinder in view of pending litigations involving the same patent and the same parties. *See, e.g., Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00224, Paper 10 at 2–7 (P.T.A.B. April 6, 2020) (granting motion for joinder of a copycat petition in view of co-pending lawsuit); *Apple Inc. v. INVT SPE LLC*, IPR2019-00958, Paper 9 at 2–13 (P.T.A.B. May 30, 2019) (same); *Celltrion, Inc. v. Genentech, Inc*., IPR2018-01019, Paper 11 at 2–15 (P.T.A.B. Oct. 30, 2018) (same); *Huawei Device Co., Ltd. v. Uniloc Luxembourg S.A*., IPR2017-02090, Paper 9 at 2–12 (P.T.A.B. March 6, 2018) (same); *Pfizer, Inc. v. Genentech, Inc*., IPR2017-02063, Paper 25 at 4–8 (P.T.A.B. Feb. 21, 2018) (same); *General Motors LLC v. Neo Wireless LLC*, IPR2023-00963, Paper 10 at 2–20 (P.T.A.B. Dec. 6, 2023) (same); *T-Mobile USA, Inc. v. Dali Wireless, Inc*., IPR2023-00830, Paper 7 at 2–11 (P.T.A.B. Oct. 11, 2023) (same); *Cooler Master Co., Ltd. v. Asektek Danmark A/S*, IPR2023-00667, Paper 6 at 2–13 (P.T.A.B. Aug. 28, 2023) (same).

1. Joinder is Appropriate With the LGES IPR

Joinder with the LGES IPR is appropriate because the Samsung 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 submitted in the LGES Petition. The Samsung Petition is substantively identical to the LGES Petition, containing only minor differences unrelated to the merits of the proposed grounds. There are no changes to the facts, citations, evidence, or arguments presented in the LGES Petition in relation to the grounds of the LGES Petition. Because these proceedings are substantively identical, good cause exists for joining this proceeding with the LGES IPR so that the Board can efficiently resolve all grounds in both the Samsung and LGES Petitions in a single proceeding.

2. Petitioner Proposes No New Grounds of Unpatentability

The Samsung Petition does not present any new grounds of unpatentability. The Samsung Petition is substantively identical to the LGES Petition. The Samsung Petition presents the unpatentability of the same claims of the same patent in the same way as the LGES Petition. 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. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (P.T.A.B. Aug. 24, 2016) (internal quotations and citations omitted) (emphasis original); *see also STMicroelectronics, Inc. v. Lone Star Silicon*

Innovations, LLC, IPR2018-00436, Paper 7 at 5 (P.T.A.B. May 4, 2018) (granting joinder and reasoning, "[w]e rely in particular, on Petitioner's representation that its Petition is 'substantially identical'…challenges the same claims based on the same prior art and the same grounds of unpatentability…."); *eBay, Inc. v. Lexos Media IP, LLC*, IPR2024-00336, Paper 11 at 11 (P.T.A.B. Feb. 23, 2024) (granting joinder where "[t]he Petition (1) is substantially identical to the [already existing] IPR petition, (2) contains the same grounds based on the same evidence, and (3) relies on the same [expert] declaration").

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

Because the Samsung Petition is substantively identical to the LGES Petition, with the same grounds applied to the same claims as instituted by the Board in the LGES IPR, there are no new issues for Patent Owner to address. Due to the same issues being presented in the LGES Petition, Patent Owner will not be required to present any additional responses or arguments. *LG v. Memory Integrity, LLC*, IPR2015-01353, Paper 11, at 6 (Oct. 5, 2015) (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]."); *see also id.*, Paper 4 at 5–7.

The Patent Owner Response will also not be negatively impacted because the issues presented in the LGES Petition are identical to the issues presented in the

Samsung Petition. Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in responding to the LGES Petition. Also, because the Samsung Petition relies on the same expert and a substantively identical declaration, only a single deposition is needed for the proposed joined proceeding.[2] *eBay*, IPR2024-00336, Paper 11 at 11 (granting joinder where "[t]he Petition (1) is substantially identical to the [already existing] IPR petition, (2) contains the same grounds based on the same evidence, and (3) relies on the same [expert] declaration").

Joinder of this proceeding with the LGES IPR would 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. § 42.100(c). Thus, a slight adjustment in the trial schedule, should one be needed, is not enough of a reason to deny joining the present Samsung Petition with the LGES IPR.

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[2] Petitioner has engaged Dr. Zhu, LGES's expert for the LGES IPR. Petitioner has submitted Dr. Zhu's declaration from the LGES IPR with the Samsung Petition in unaltered form, except for exhibit labeling.

4. Procedures to Simplify Briefing and Discovery

The LGES Petition and the Samsung Petition present substantively identical grounds of rejection, including the same art combinations against the same claims. Additionally, Petitioner explicitly agrees to take an "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 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]."

See IPR2014-00550, Paper 38 at 5 (Apr. 10, 2015).

Petitioner will assume the primary role only if LGES ceases to participate in the LGES IPR. Counsel for Petitioner has conferred with counsel for LGES, and LGES does not object to Petitioner joining IPR2024-01011 in an "understudy" role. By 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. These steps will minimize any potential complications or delay that may result due to joinder. *See, e.g., Garmin Int'l, Inc. v. Philips North Am. LLC*,

IPR2020-00910, Paper 8 at 45, 47-50 (P.T.A.B. Nov. 19, 2020) (granting joinder where petitioners agreed to accept an "understudy" role); *STMicroelectronics*, IPR2018-00436, Paper 7 at 5 (similar); *eBay*, IPR2024-00336, Paper 11 at 15 (similar).

IV. *GENERAL PLASTIC* IS GENERALLY INAPPLICABLE AND FAVORS PETITIONER

In *General Plastic*, the Board sets forth a series of factors that may be analyzed for follow-on petitions to help conserve the finite resources of the Board. However, Petitioner respectfully submits that the *General Plastic* analysis is inapplicable here. In the current motion, Petitioner merely seeks to join LGES's proceeding in an understudy rule and do not present any new grounds. The Board has previously found that such circumstances "effectively neutralize[]" a *General Plastic* analysis. *See Apple Inc. v. Uniloc 2017 LLC*, IPR2018-00580, Paper 13 at 10 (P.T.A.B. Aug. 21, 2018) (instituting a joinder copycat petition where petitioner agreed to assume a passive understudy role, and noting such circumstances "effectively neutraliz[es] the *General Plastic* factors"); *see also Celltrion, Inc. v. Genetech, Inc*., IPR2019-01019, Paper 11 at 10 (P.T.A.B. Oct. 30, 2018) (noting the joinder motion "effectively obviates any concerns of serial harassment and unnecessary expenditures of resources"); *Code200 v. Bright Data Ltd*., IPR2022-00861, Vidal Remand (Paper 18) (finding road-mapping and other *General Plastic* concerns generally inapplicable or of limited relevance when a motion for joinder

presents a copycat petition); *eBay, Inc. v. Lexos Media IP, LLC*, IPR2024-00336, Paper 11 at 13 (P.T.A.B. Feb. 23, 2024) (granting motion for joinder, noting that the "*General Plastic* factors are not an issue" because the Petitioner did not file the petition "as a follow-on to prior petitions filed by Petitioner challenging claims of the same patent.").

In any event, the *General Plastic* factors counsel heavily against discretionary denial, *i.e.*, in favor of instituting the present IPR and joining it with the LGES IPR. *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, slip op. at 16 (P.T.A.B. Sept. 6, 2017) (Paper 19) (precedential as to § II.B.4.i).

The first three *General Plastic* factors all strongly favor Petitioner. Petitioner has not previously filed an IPR challenge to the '924 patent, Petitioner has stipulated that, if the present IPR is instituted, Petitioner will not seek resolution in the district court of the same grounds presented in the Samsung Petition, and there are no road-mapping concerns as Petitioner has simply filed a copycat version of the LGES Petition. These factors all counsel against discretionary denial. *Code200*, Vidal Remand (Paper 18) at 4-6.

The fourth, fifth and seventh *General Plastic* factors have limited relevance when a motion for joinder with a copycat petition is presented. *Code200*, Vidal Remand (Paper 18) at 6. In any event, those factors favor Petitioner as the instant

Motion is being filed within seven days of institution of the LGES IPR and there should be no delay in the LGES IPR if Petitioner's Motion is granted.

The sixth factor also favors Petitioner as it is "the Board's 'mission to improve patent quality and restore confidence in the presumption of validity that comes with issued patents'" which "outweighs the impact on Board resources needed to evaluate the merits of a petition." *Code200*, Vidal Remand (Paper 18) at 6, citing *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 272 (2016); *eBay*, Paper 11 at 15 (noting "'the Board's mission to improve patent quality and restore confidence in the presumption of validity that comes with issued patents' and 'the benefits to the patent system of improving patent quality by reviewing the merits of the challenges raised in . . . petitions.'" (quoting *Code200 v. Bright Data Ltd.*, IPR2022-00861, Paper 17 at 6 (P.T.A.B. July 25, 2022))).

Accordingly, all of the *General Plastic* factors counsel against discretionary denial and in favor granting of Petitioner's Motion. Indeed, any "concerns of fairness are outweighed by the benefits to the patent system of improving patent quality by reviewing the merits of the challenges raised in the petition[], which have not been addressed to date." *Code200*, Vidal Remand (Paper 18) at 6, citing *General Plastic* at 16 (citing H.R. Rep. No. 112-98, pt. 1, at 40 (2011)); *see also Samsung Elecs. Am., Inc. v. Uniloc Lux. S.A.*, IPR2017-01797, Paper 8 at 33 (P.T.A.B. Feb. 6, 2018) ("Patent Owner's complaint about the multiple [IPR] petitions filed against [its]

patent is not persuasive when the volume appears to be a direct result of its own litigation activity.”).

V. CONCLUSION

For all of the foregoing reasons, Petitioner respectfully requests that the Board institute the Samsung Petition for *Inter Partes* Review of U.S. Patent No. 8,968,924 and grant joinder with the proceeding pending in *LG Energy Solution, Ltd. v. Molecular Rebar Design, LLC et al.*, IPR2024-01011.

Dated: December 23, 2024

Respectfully submitted,

/Andrew R. Sommer/

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e), the undersigned certifies that on December 23, 2024, I caused a true and correct copy of the Motion for Joinder has been served on the Patent Owner by EXPRESS MAIL on the Patent Owner at the correspondence address of record for U.S. Patent No. 8,968,924 as follows:

Jackson Walker L.L.P.
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I further certify that a courtesy copy of the above-identified materials were served on litigation counsel by electronic means upon the foregoing individuals:

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