

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NXP SEMICONDUCTORS N.V.,

Petitioner,

v.

HARBOR ISLAND DYNAMIC, LLC,

Patent Owners.

Case: IPR2025-00954
U.S. Patent No. 7,745,886

MOTION FOR JOINDER TO IPR2024-01402

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I. STATEMENT OF PRECISE RELIEF REQUESTED

Petitioner NXP Semiconductors N.V. (“Petitioner” or “NXP”) moves for joinder of its contemporaneously-filed Petition for *Inter Partes* Review (“IPR”) of claims 1-19 of U.S. Patent No. 7,745,886 (“the ’886 Patent”) with a pending IPR, *Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. v. Harbor Island Dynamic, LLC*, IPR2024-01402 (“the Samsung IPR”), which the Board instituted on April 4, 2025.

The Samsung IPR concerns the same patent and the same claims as NXP’s Petition. NXP’s Petition is substantively identical to the petition and expert declaration submitted in the Samsung IPR, and both are supported by the same declaration. Petitioner here asserts that the same claims are obvious over the same prior art based on the same arguments supported by the same expert as in the Samsung IPR.

Petitioner agrees to take an “understudy” role if joined. Joinder will not cause any delay in the resolution of the Samsung IPR. Joinder, therefore, is appropriate because it will resolve the same patentability issues of the same patent, it will not delay the schedule that the Board has issued in the Samsung IPR, and the parties in the Samsung IPR will not be prejudiced.

II. STATEMENT OF MATERIAL FACTS

1. Harbor Island Dynamic, LLC (“Patent Owner”) purports to own the ’886 Patent.

2. Patent Owner has asserted the ’886 Patent against Petitioner and the Samsung IPR petitioners in lawsuits in the Eastern District of Texas: *Harbor Island Dynamic, LLC v. Samsung Electronics Co., Ltd. et al.*, No. 2:24-cv-00140 (E.D. Tex., filed February 27, 2024); *Harbor Island Dynamic, LLC v. NXP Semiconductors N.V. et al.*, No. 2:24-cv-00717 (E.D. Tex., filed August 30, 2024)

3. On September 24, 2024, Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (“Samsung”) filed the Samsung IPR, requesting cancellation of claims 1-19 of the ’886 Patent. IPR2024-01402, Paper 1. On January 10, 2025, Patent Owner filed a Preliminary Response. IPR2024-01402, Paper 7.

4. On April 4, 2025, the Board instituted the Samsung IPR and entered a Scheduling Order. IPR2024-01402, Papers 9 and 10.

5. Along with this Motion for Joinder, Petitioner simultaneously files the Petition, which argues, among other things, that the same claims of the ’886 Patent are obvious based on the same grounds and for the same reasons as set forth in the Samsung IPR petition. The Petition is supported by the same expert declaration of Scott Emmet Thompson, Ph.D., that was submitted in support of the Samsung IPR petition.

6. The grounds proposed in the Petition are identical to those described in the Samsung IPR petition. Outside of replacing Samsung with the NXP Petitioner, the only changes in the present Petition relative to the petition in IPR2024-01402 are the corresponding updates to the Mandatory Notices (Section VII) and the deletion of Discretionary Denial (Section VI). A redline illustrating the limited differences between the Samsung IPR petition and the Petition here is submitted herewith. *See* Ex. 1026. The Petition does not contain any different or additional arguments or evidence in support of the unpatentability of claims 1-19 of the '886 Patent.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Joinder is timely

This request is being submitted within the time period set forth in 37 C.F.R. § 42.122(b). The one-month period ends on Sunday, May 4, and the Petition and this Motion are therefore timely filed on Friday, May 2.

B. The applicable factors support joinder

The Board has discretion to join this IPR with the Samsung IPR. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); *HTC v. Parthenon Unified Memory Architecture LLC*, IPR2017-00512, Paper 12 at 6 (PTAB June 1, 2017). In considering a motion for joinder, the Board considers the following factors: (1) the reasons why joinder is appropriate; (2) whether the petition raises any new grounds of unpatentability; (3) any impact joinder would have on the cost and trial schedule for the existing

review; and (4) whether joinder will add to the complexity of briefing or discovery. *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013); Consolidated Trial Practice Guide 76 (Nov. 2019). These factors weigh in favor of joinder. Thus, the Board should exercise its discretion to allow joinder here.

1. Joinder is appropriate because Petitioner proposes no new grounds of unpatentability (factors 1 and 2)

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 (PTAB Aug. 24, 2016) (internal quotations and citations omitted) (emphasis original). Joinder is appropriate here because the Petition asserts the same grounds and relies on the same evidence for unpatentability presented in the Samsung IPR. Specifically, the Petition and the Samsung IPR petition rely on the same grounds. Moreover, the Petition and the Samsung IPR petition rely on the same declaration of Scott Emmet Thompson, Ph.D. The arguments in both petitions are identical; there are no new arguments or grounds of unpatentability asserted in the Petition.

As the same issues will be addressed in both proceedings, joinder makes sense. *See, e.g., HTC*, IPR2017-00512, Paper 12 at 7 (granting motion for joinder where the second petition involved “the same claims, the same patent, the same prior art references, the same expert declaration, and the same arguments and rationales”);

STMicroelectronics, Inc. v. Lone Star Silicon Innovations, LLC, IPR2018-00436, Paper 7 at 5 (PTAB May 4, 2018) (similar).

2. Joinder will not impact the trial schedule or cost of the joined proceeding (factor 3)

Joinder will not prejudice the parties to the Samsung IPR. Unless the Samsung IPR is settled at a time that would necessitate adjustments, Petitioner will not request any alterations to the trial schedule that the Board issued in the Samsung IPR (IPR2024-01402, Paper 10), leaving that schedule unchanged.

Petitioner also agrees to adopt a secondary, “understudy” role in the Samsung IPR, if joined. *See, e.g., Garmin Int’l, Inc. v. Philips North Am. LLC*, IPR2020-00910, Paper 8 at 45, 47-50 (PTAB Nov. 19, 2020) (granting joinder where petitioners agreed to accept an “understudy” role); *STMicroelectronics*, IPR2018-00436, Paper 7 at 5 (similar). Petitioner will assume a primary role only if the Samsung IPR petitioner ceases its participation in that proceeding. Petitioner’s agreement to take an “understudy” role removes any potential complication or delay caused by joinder, while providing the parties an opportunity to address all issues that may arise. *See, e.g., Mylan Pharms. Inc. v. Novartis AG*, IPR2014- 00550, Paper 38 at 5-6 (PTAB Apr. 10, 2015). Counsel for the Samsung IPR petitioner indicated that the Samsung IPR petitioners will not oppose this motion. Counsel for Patent Owner indicates that it intends to oppose this motion. However, because the NXP

Petitioner will be in the understudy role, joinder will not affect the cost of the Samsung IPR for Patent Owner, the Samsung IPR petitioner, or the Board.

3. *Joinder will not complicate briefing and discovery (factor 4)*

This factor favors joinder. If joinder is granted, Petitioner agrees to take on an understudy role. Accordingly, joinder will not affect briefing and discovery. Those activities will proceed in the same way with or without joinder. In either case, the Samsung IPR petitioner will file briefing and conduct discovery, and Petitioner will not be involved. Petitioner will take an active role only if the Samsung IPR petitioner exits the proceeding.

IV. CONCLUSION

For the foregoing reasons, Petitioner respectfully asks the Board to institute its Petition for *Inter Partes* Review of U.S. Patent No. 7,745,886 and join this proceeding with *Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. v. Harbor Island Dynamic, LLC*, IPR2024-01404.

Date: May 2, 2025

Respectfully submitted,

/Eagle H. Robinson/
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Lead Counsel for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§42.6(e), the undersigned hereby certifies that a true and correct copy of this MOTION FOR JOINDER TO IPR2024-01404 was served by USPS Priority Mail Express® on the correspondence address of record indicated in the Patent Office's public Patent Center system for U.S. Patent No. 7,745,886:

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