

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RINGCONN LLC
Petitioner

v.

OURARING, INC.,
Patent Owner

Case No. IPR2025-00412
U.S. Patent No. 11,868,178

**PETITIONER'S MOTION FOR JOINDER OR CONSOLIDATION UNDER
37 C.F.R. §§ 42.22 42.122(a) AND 42.222(a), (b)**

Table of Contents

I.	STATEMENT OF RELIEF REQUESTED	2
II.	STATEMENT OF MATERIAL FACTS.....	3
III.	STATEMENT OF REASONS FOR REQUESTED RELIEF	4
	A. Legal Standards	4
	B. RingConn’s Motion is Timely	5
	C. Joinder/Consolidation is Appropriate.....	5
	1. No New Grounds of Unpatentability in the Petition	6
	2. No Impact on the Schedule for the Existing PGR Proceeding...6	
	3. Briefing and Discovery Will be Simplified	7
	4. No Prejudice to Patent Owner.....	8
IV.	CONCLUSION.....	9

I. STATEMENT OF RELIEF REQUESTED

RingConn LLC (“RingConn” or “Petitioner”) respectfully requests to join or consolidate, pursuant to 35 U.S.C. §§ 325(c), (d) and 37 C.F.R. §§ 42.122(a), 42.222(a), (b), the concurrently filed Petition for *Inter Partes* Review of U.S. Patent No. 11,868,178 (the ’178 patent) (“RingConn’s Petition”) with pending post-grant review, *Samsung Electronics Co., Ltd. et al. v. Ouraring, Inc.*, PGR2024-00030 (“the Samsung PGR”), which was filed on May 31, 2024. RingConn’s Petition is substantively identical to Grounds 1-4 of the petition in the Samsung PGR¹ – challenging the same claims of the ’178 patent on the same grounds while relying on the same prior art, arguments, and evidence in those grounds. Institution was granted in PGR2024-00030 on December 6, 2024 (Paper No. 9). This Motion for Joinder/Consolidation and accompanying Petition are timely, being filed less than one month after a decision instituting trial in the Samsung PGR No. PGR2024-00030.

Joinder or consolidation is appropriate here because (i) RingConn’s Petition is substantively identical to Grounds 1-4 of the petition in the Samsung PGR and (ii) RingConn agrees to an “understudy role” and relies upon the same expert declaration

¹ Petitioner RingConn understands that prior to institution of PGR2024-00030, Patent Owner disclaimed claim 11. In order to maintain synchronicity with the PGR2024-00030 proceedings, challenges to claim 11 are retained in the presently filed copycat Petition. But to the extent that Patent Owner’s disclaimer of claim 11 is effective, Petitioner RingConn does not challenge claim 11 here.

as relied upon in the Samsung PGR, simplifying briefing and discovery. Joinder or consolidation will thus provide for a just, speedy, and inexpensive determination of related proceedings.

Accordingly, RingConn respectfully requests that the Board grant this Motion for Joinder/Consolidation.

II. STATEMENT OF MATERIAL FACTS

1. The owner of the '178 patent, Ouraring, Inc. (“Ouraring” or “Patent Owner”), sued RingConn alleging infringement of the '178 patent in the District of Delaware on September 10, 2024.

2. On May 31, 2024, Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, “Samsung”) timely filed a petition for post-grant review challenging claims 1-18 of the '178 patent. *See Samsung Electronics Co., Ltd. et al. v. Ouraring, Inc.*, PGR2024-00030, Paper 3 (PTAB May 31, 2024).

3. RingConn’s Petition and this Motion are being filed less than one month after the December 6, 2024 decision to institute the Samsung PGR.²

² On January 3, 2025, RingConn filed a petition for Post-Grant Review of the '178 Patent. A motion to withdraw that petition in favor of the present Petition is forthcoming.

III. STATEMENT OF REASONS FOR REQUESTED RELIEF

A. Legal Standards

The Leahy-Smith America Invents Act (AIA) permits joinder of post-grant review (PGR) proceedings. Joinder in post-grant review is governed by 35 U.S.C. § 325(c), which states:

(c) JOINDER. – If more than 1 petition for a post-grant review under this chapter is properly filed against the same patent and the Director determines that more than 1 of these petitions warrants the institution of a post-grant review under section 324, the Director may consolidate such reviews into a single post-grant review.

Section 325(d) governs consolidation:

(d) MULTIPLE PROCEEDINGS. – Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of any post-grant review under this chapter, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the post-grant review or other proceeding or matter may proceed, including providing for the stay, transfer, consolidation, or termination of any such matter or proceeding.

A motion for joinder should “(1) set forth the 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 Dell*

Inc. v. Network-1 Sec. Solutions, Inc., IPR2013-00385, Paper 17 (PTAB July 29, 2013).³

B. RingConn’s Motion is Timely

A Motion for Joinder is timely if the moving party files within one month of institution of the post-grant review for which joinder is requested. 37 C.F.R. § 42.222(b). Because RingConn files this motion less than one month after a decision on the institution of the Samsung PGR, this motion is timely. *See Samsung Electronics Co., Ltd. et al. v. Ouraring, Inc.*, PGR2024-00030, Paper 9 (PTAB December 6, 2024).

C. Joinder/Consolidation is Appropriate

Joinder or consolidation is appropriate because RingConn’s Petition does not raise any new grounds of unpatentability and does “not present issues that might complicate or delay” the Samsung PGR. *See Enzymotec Ltd. v. Neptune Techs & Bioresources, Inc.*, IPR2014-00556, Paper 19 (PTAB July 9, 2014). RingConn’s Petition is substantially identical to Grounds 1-4 of the petition in the Samsung PGR, challenging the same claims of the ’178 patent on the same grounds and relying on the same expert declaration. The only difference between RingConn’s Petition and the petition filed in the Samsung PGR are the sections on Real Party-In-Interest,

³ The rules regarding joinder of IPRs, 37 C.F.R. § 42.122(b), and PGRs, 37 C.F.R. § 42.222(b), are functionally the same such that decisions regarding IPR joinder are equally applicable to PGR joinder.

Related Matters, and Counsel, and Discretionary Denial (*Fintiv*) sections which have been appropriately updated. RingConn has also re-filed the same declaration of Dr. Brian W. Anthony. Joinder or consolidation would therefore have little, if any, impact on the Samsung PGR because no new grounds would be added, the schedule would not be affected, no additional briefing or discovery would be required, and no additional burdens would be placed on the Patent Owner, as detailed below.

Accordingly, joinder or consolidation is appropriate because it eliminates the possibility of duplicate efforts and ensures a just, speedy, and inexpensive resolution of these proceedings.

1. No New Grounds of Unpatentability in the Petition

RingConn's Petition does not assert any new grounds of unpatentability. It challenges the same claims (1-18) of the '178 patent based on the same arguments, evidence, and grounds of unpatentability as Grounds 1-4 of the Samsung PGR.

2. No Impact on the Schedule for the Existing PGR Proceeding

Because RingConn's Petition raises no new grounds of unpatentability, and because a Scheduling Order has been established for the Samsung PGR less than one month ago, joinder/consolidation should have no impact on the schedule of the Samsung PGR. RingConn will adhere to all applicable deadlines set in the Scheduling Order for the Samsung PGR. Additionally, no additional expert discovery will be needed because RingConn's Petition relies upon the same

declaration testimony from the same expert as relied upon by the petition in the Samsung PGR.

Additionally, if joined/consolidated, RingConn will not file additional briefs outside of the consolidated filings, will not request any additional deposition time, and will not request any additional oral hearing time. In the event that the Samsung PGR is terminated with respect to the petitioner, RingConn intends to “step into the shoes” of the dismissed petitioner and materially participate in the joined/consolidated proceedings.

Accordingly, for the reasons stated above, joinder of RingConn to the Samsung PGR via joinder or consolidation will not affect the Board’s ability to complete its review and final decision within the statutory time limits under 35 U.S.C. § 326(a)(11) and 37 C.F.R. § 42.200(c).

3. Briefing and Discovery Will be Simplified

RingConn agrees to an “understudy” role and does not raise any issues that are not already before the Board. In particular, RingConn agrees that, if joined/consolidated, the following conditions will apply so long as Samsung remains an active party, as previously approved by the Board in similar circumstances:

(a) all filings by RingConn in the joined/consolidated proceeding be consolidated with the filings of Samsung, unless a filing solely concerns issues that do not involve Samsung;

(b) RingConn shall not be permitted to raise any new grounds not instituted by the Board in the Samsung PGR, or introduce any argument or discovery not already introduced by Samsung;

(c) RingConn shall be bound by any agreement between the Patent Owner and Samsung concerning discovery and/or depositions; and

(d) RingConn at deposition shall not receive any direct, cross examination or redirect time beyond that permitted for Samsung in this proceeding alone under 37 C.F.R. § 42.53 or any agreement between the Patent Owner and Samsung.

See Mylan Pharms. Inc. v. Novartis AG, IPR2015-00268, Paper 17 at 5-6 (PTAB Apr. 10, 2015) (finding the same proposed limitations “are consistent with the ‘understudy’ role that Petitioner agrees to assume, as well as Petitioner’s assertion that its presence would not require introducing any additional arguments, briefing, or discovery.”) RingConn would assume a primary role only if Samsung ceased to participate in the proceeding. Briefing and discovery will be simplified in that there will be no need for redundant depositions, briefing, or hearings.

4. No Prejudice to Patent Owner

Joinder of Petitioner to the Samsung PGR or consolidation of the matters will not create any additional burden on the Patent Owner. The Patent Owner need not expend any additional resources above and beyond those required in the current Samsung PGR. Moreover, joinder/consolidation eliminates the need for the Patent

Owner to participate in parallel post-grant proceedings instituted upon identical grounds of unpatentability.

IV. CONCLUSION

For the foregoing reasons, RingConn respectfully requests that its Petition be granted and that the proceedings be joined or consolidated with PGR2024-00030.

Dated: January 6, 2025

Respectfully submitted,
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