

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION
Petitioner,

v.

YISSUM RESEARCH DEVELOPMENT COMPANY
OF THE HEBREW UNIVERSITY OF JERUSALEM
Patent Owner.

Cases IPR2013-00218 (Patent 6,665,003 B1) (SCM)
IPR2013-00219 (Patent 7,477,284 B2)¹

Before SALLY C. MEDLEY, KARL D. EASTHOM, and JAMES B. ARPIN,
Administrative Patent Judges.

MEDLEY, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On July 2, 2013, the following individuals participated in a conference call:

¹ This order addresses a single issue raised in both cases. We exercise discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in subsequent papers since doing so may cause confusion.

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- (1) Mr. Walter Hanley and Ms. Michelle Carniaux, counsel for Sony;
- (2) Mr. David McCombs, Mr. William Nelson, and Mr. Robert Gerrity, counsel for Yissum; and
- (3) Sally Medley, Karl Easthom, and James Arpin, Administrative Patent Judges.

The purpose of the conference call was for Sony to seek authorization to file two motions for joinder. Counsel for Sony explained that Sony intends to file a petition requesting an *inter partes* review of claims 4, 5, and 34 of Patent No. US 6,665,003 B1 and a petition requesting an *inter partes* review of claims 4, 7, and 38 of Patent No. US 7,744,284 B2. The Board understands that Sony would seek joinder under 35 U.S.C. § 315(c) when filing the additional petitions. As such, Sony seeks authorization to file motions for joinder under 37 C.F.R. § 42.122(b) in the additional proceedings. Yissum opposes.

The Board appreciates Sony's arrangement of the conference call to inform the Board and Yissum of its intentions, however, based on the facts presented, prior authorization to file the motions for joinder accompanying the additional petitions is not necessary. *See, e.g.*, FAQ H5 on the Board's website page at <http://www.uspto.gov/ip/boards/bpai/prps.jsp>. Nonetheless, general guidance was provided regarding a motion for joinder. As explained, a motion for joinder should explain why joinder is appropriate, identify any new grounds of unpatentability asserted in the additional petition, and explain what impact joinder would have on the scheduling of events. The Board explained that, if Sony filed the additional petitions and motions for joinder, the Board would provide Yissum opportunity to

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file an opposition to the motions for joinder. The Board also explained that, depending on the issues raised in the additional petitions, the Board may expedite the time for filing a patent owner preliminary response.

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