

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION

Petitioner

Patent No. 7,477,284

Issue Date: Jan. 13, 2009

Title: SYSTEM AND METHOD FOR CAPTURING AND VIEWING
STEREOSCOPIIC PANORAMIC IMAGES

**MOTION FOR JOINDER TO RELATED
INTER PARTES REVIEW IPR2013-000219**

No. IPR2013-00327

I. Relief Requested

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), petitioner Sony Corporation (“Sony” or “Petitioner”), hereby moves for joinder of the petition for *inter partes* review of claims 4, 7 and 38 of U.S. Patent No. 7,477,284 (the “’284 Patent,” Sony-1101) filed on even date herewith with *inter partes* review IPR2013-00219 filed by Petitioner on March 29, 2013 and not yet instituted.

II. Statement of Material Facts

1. On March 28, 2012, HumanEyes Technologies Ltd. (“HumanEyes”) filed a Complaint against Sony in the International Trade Commission (“ITC”), in which it asserted that Sony was infringing claims 1, 2, 3, 10, 20, 27, 28, 29, 36, and 37 of the ’284 Patent.

2. On March 29, 2012, HumanEyes filed a Complaint against Sony in the District of Delaware also alleging that Sony infringed the ’284 Patent. *See HumanEyes Technologies Ltd. v. Sony Electronics Inc. et al.*, 1-12-CV-00398 (D. Del.).

3. On September 25, 2012, the ITC investigation was terminated, pursuant to an unopposed motion filed by HumanEyes.

4. On March 29, 2013, Sony filed a petition for *inter partes* review requesting cancellation of the claims of the ’284 patent that HumanEyes had asserted against Sony in the ITC investigation. *Sony Corp. v. HumanEyes Technologies Ltd.*, IPR2013-00219 (P.T.A.B.) (“First Petition”).

5. On April 19, 2013, Sony filed a motion in the Delaware action for a stay pending IPR2013-00219.

6. On May 6, 2013, in response to the stay motion, HumanEyes contended that Sony was infringing additional claims of the '284 Patent that were not asserted in the ITC Complaint nor otherwise previously asserted against Sony, namely claims 4, 7, and 38. *See* Answering Brief in Opposition to Sony's Motion to Stay Pending the Outcome of Inter Partes Review of the Patents-In-Suit, *HumanEyes Technologies Ltd. v. Sony Electronics Inc. et al.*, 1-12-CV-00398, D.I. 34, at 13-14 (D. Del. May 6, 2013) (Sony-1102).

7. On June 27, 2013, the undersigned counsel for Sony notified David McCombs, counsel for patent owner in IPR2013-00219, that Sony intended to file a petition for *inter partes* review of claims 4, 7 and 38 of the '284 Patent and to accompany the petition with a request for joinder with IPR2013-00219 pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b).

8. On July 2, 2013, the Board held a telephone conference with the parties to IPR2013-00219, at Sony's request, to discuss the present motion. On even date herewith, the Board issued an Order (Paper 15) relating to the matters discussed in the telephone conference.

9. On even date herewith, Sony filed a second petition for *inter partes* review of the '284 Patent, IPR2013-00327 ("Second Petition"), requesting cancellation of the additional asserted claims 4, 7 and 38.

10. Each of claims 4 and 7 of the '284 patent is dependent on claim 3, which is dependent on claim 1. Sony challenges the patentability of each of claims 1 and 3 in the First Petition. Claim 38 is an independent claim.

11. In the Second Petition, Sony's grounds for challenging the patentability of claims 4 and 7 of the '284 patent include one additional prior art reference (Allen) that was not included in the First Petition. Sony relies on Allen with respect to the limitations that claims 4 and 7 add to claims 1 and 3.

12. Sony's grounds for challenging the patentability of claim 38 in the Second Petition are based on prior art references that are included in the First Petition.

III. **Governing Rule(s)**

§ 42.122 Multiple proceedings and Joinder.

(b) *Request for Joinder.* Joinder may be requested by a patent owner or petitioner. 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. The time period set forth in § 42.101(b) shall not apply when the petition is accompanied by a request for joinder.

IV. **Discussion**

The Leahy-Smith America Invents Act (AIA) permits the Patent Trial and Appeal Board ("the Board") to join of *inter partes* review proceedings at its discretion. *See* 35 U.S.C. § 315(c). A motion for joinder must be filed no later than one month after the institution date of any *inter partes* review for which joinder is requested. *See*

37 C.F.R. § 42.122(b). This joinder motion is timely as IPR2013-000219 has not yet been instituted.

In its Order of July 3, 2013 (Paper 15), the Board stated that 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.

First, joinder is appropriate because Sony will be unduly prejudiced if joinder is denied, since its Second Petition will be time barred. Sony filed its First Petition within one year of the service of HumanEyes' Complaint in the ITC, and Sony's First Petition challenged all claims that HumanEyes' had asserted against Sony up to that time. After Sony filed the First Petition and after the expiration of one year from service of the ITC Complaint, HumanEyes asserted three additional claims in the '284 Patent (claims 4, 7 and 38) against Sony. *See* Sony-1102, at 13-14. In order to challenge the newly asserted claims in an *inter partes* review, the only option available to Sony was to file the Second Petition and simultaneously request joinder pursuant to 37 C.F.R. § 42.122(b). The Board has stated that, absent joinder, a petition filed more than one year after service of a complaint alleging infringement by the petitioner is time barred. *See* IPR2013-00109, Paper No. 15, at 4 (P.T.A.B. Feb. 25, 2013) ("This is an important consideration" because "absent joinder of this proceeding . . . the second Petition would be barred."). Therefore, according to the Board's statement in

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