

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PNY Technologies, Inc.,
Petitioner

v.

Phison Electronics Corp.,
Patent Owner

Case IPR2014-00150
Patent 7,518,879

**JOINT MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c) AND
37 C.F.R. § 42.122(b)**

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Phison Electronics Corp. (“Patent Owner”) and PNY Technologies, Inc. (“Petitioner”) file this Joint Motion for Joinder of the petition for *inter partes* review of U.S. Patent No. 7,518,879 (“the ’879 patent”) filed by Petitioner on November 14, 2013 (“the Petition”) with the instituted *inter partes* review proceeding on the ’879 patent (“the Pending IPR”). Patent Owner and Petitioner (“the Parties”) assert that such joinder will promote the “just, speedy, and inexpensive resolution” of both proceedings without prejudice to the Parties. 37 C.F.R. § 42.1(b).

II. STATEMENT OF MATERIAL FACTS

On July 29, 2013, Petitioner filed a first petition for *inter partes* review of the ’879 patent, which is assigned to Patent Owner. *See* Case IPR2013-00472, Paper 2. The Board instituted the Pending IPR based on this first petition on February 4, 2014. *See id.*, Paper 10.

On November, 14, 2013, Petitioner filed a second petition for *inter partes* review of the ’879 patent (the Petition).

On February 25, the Board authorized the parties to file a joint motion for joinder with IPR2014-00150, and indicated that such joint motion may be accompanied by a proposed revised scheduling order. *See id.*, Paper 14. The proposed schedule included herein is based on these indications.

III. DISCUSSION

A. Joinder

The Board has authority under 35 U.S.C. § 315(c) to join a second *inter partes* review petition to an already instituted *inter partes* review proceeding.

While the decision to grant joinder is discretionary, the rules for joinder should be “construed to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b).

Granting joinder in the present instance would promote “just, speedy, and inexpensive resolution” of both the Petition and the Pending IPR without prejudice to the Parties. By allowing common issues across both proceedings to be briefed and considered together, both proceedings can be resolved efficiently and quickly, while providing significant cost and time savings to the Parties and the Board by avoiding the need to revisit the same issues multiple times in separate proceedings. Further, the Patent Owner has indicated their intent to rely on the same expert in both proceedings. Accordingly, granting joinder will allow significant time and cost savings during discovery through consolidation of the expert depositions.

B. Proposed Schedule

The Parties have developed and agreed to the following proposed schedule for a proceeding joining the Pending IPR and the Petition. Additionally, the Parties have agreed to reset Deadline 1 and Deadline 2 in IPR2013-00472 to allow

the Board time to act on this motion. The table below shows the current schedule for the Pending IPR, as well as the proposed schedule for the joined proceeding.

The proposed schedule is contingent upon the Board ruling on this Motion for Joinder and the Petition in IPR2014-00150 by April 7, 2014, one month before Deadline 1 proposed below. Notably, the Parties and the proposed schedule take into account the unavailability of Patent Owner's expert, who will be traveling abroad from April 27, 2014 through June 3, 2014.

Date	Current Schedule For IPR2013-00472	Proposed Schedule for Joined IPR2013-00472 and IPR2014-00150
DATE 1 – Patent Owner response / motion to amend	April 4, 2014, moved to May 5, 2014 by agreement	May 5, 2014
DATE 2 – Petitioner reply / opposition	June 4, 2014, moved to July 7, 2014 by agreement	July 7, 2014
DATE 3 – Patent Owner reply to opposition	July 7, 2014	August 8, 2014
DATE 4 – Petitioner motion for observation / exclude evidence / request for oral argument	July 25, 2014	August 25, 2014
DATE 5 – Patent Owner response to observation / opposition to motion to exclude	August 8, 2014	September 8, 2014
DATE 6 – Petitioner reply to opposition to motion to exclude	August 15, 2014	September 15, 2014
DATE 7 – Oral argument	September 8, 2014	October 3, 2014

If the Board is unable to rule on the joint motion by April 7, 2014, the Parties request the opportunity to negotiate and submit a new proposed stipulated schedule.

IV. CONCLUSION

Accordingly, joining the Pending IPR with the Petition would promote “just, speedy, and inexpensive resolution” of both proceedings without prejudice to the Parties. Thus, for at least the reasons presented, the Parties requests joinder of the Pending IPR with the Petition.

Respectfully submitted,

Dated: 3/19/2014

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