

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

Before KEVIN F. TURNER, STEPHEN C. SIU, and
RAMA G. ELLURU, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION
Joint Motion for Joinder
37 C.F.R. § 42.122

Introduction

The parties, PNY Technologies, Inc. (Petitioner, “PNY”) and Phison Electronics Corp. (Patent Owner, “Phison”), filed a joint motion for joinder with Case IPR2013-00472 (Paper 7, “Mot.”) on March 19, 2014. For the reasons that follow, the joint motion for joinder is *granted*.¹

Analysis

The America Invents Act (AIA) created new administrative trial proceedings, including *inter partes* review, as an efficient, streamlined, and cost-effective alternative to district court litigation. The AIA permits the joinder of like proceedings. The Board, acting on behalf of the Director, has the discretion to join an *inter partes* review with another *inter partes* review. 35 U.S.C. § 315. Section 315(c) provides (emphasis added):

JOINDER. – If the Director institutes an *inter partes* review, *the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.*

The AIA also establishes a one-year bar from the date of service of a complaint alleging infringement for requesting *inter partes* review, but specifies that the bar does not apply to a request for joinder under Section 315(c). Section 315(b) reads (emphasis added):

¹ In a decision entered concurrently, PNY’s Petition is granted and a trial is instituted on the different grounds than in Case IPR2013-00472.

PATENT OWNER'S ACTION. – An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent. *The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).*

Thus, the Board has the discretion to adjust the time period for issuing a final determination in an *inter partes* review. 35 U.S.C. § 316(a)(11); 37 C.F.R. § 42.100(c).

Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. The Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations. *See* 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (when determining whether and when to allow joinder, the Office may consider factors including “the breadth or unusualness of the claim scope” and claim construction issues). When exercising its discretion, the Board is mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b).

As a joint motion, the parties have the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b). 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

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schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See* Mot. 1; *see also* IPR2013-00004, Paper 15 at 4; Frequently Asked Question (“FAQ”) H5 on the Board’s website at <http://www.uspto.gov/ip/boards/bpai/prps.jsp>.

As provided in the joint motion, the parties argue that:

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.

Mot. 2. We agree that these are benefits to joinder that make it appropriate and address how briefing and discovery may be simplified. We also acknowledge that the parties provided a proposed schedule, but indicated that it was contingent upon the Board ruling on the Motion by April 7, 2014. As that deadline has passed, we have provided a Revised Scheduling Order that provides additional time to the parties, and still allows for the joined proceeding to issue a final written decision within a year of the institution of the proceeding in Case IPR2013-00472, or in keeping with 35 U.S.C. § 316(a)(11). Based on the above factors, we find joinder to be appropriate and grant the joint motion.

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Order

In consideration of the foregoing, it is hereby:

ORDERED that the joint motion for joinder with Case IPR2013-00472 is *granted*;

FURTHER ORDERED that this proceeding is joined with Case IPR2013-00472;

FURTHER ORDERED that the grounds on which a trial was instituted in Case IPR2013-00472 are altered based on the new grounds of unpatentability discussed in the Decision on Institution (IPR2014-00150, Paper 8) and the ground of unpatentability removed in the Decision on Request for Rehearing (IPR2013-00472, Paper 16);

FURTHER ORDERED that the Revised Scheduling Order entered in Case IPR2013-00472 (Paper 19) shall govern the schedule of the joined proceedings;

FURTHER ORDERED that Case IPR2014-00150 is instituted, joined, and terminated under 37 C.F.R. § 42.72 and all further filings in the joined proceedings shall be made in Case IPR2013-00472;

FURTHER ORDERED that the case caption in Case IPR2013-00472 shall be changed to reflect the joinder with this proceeding in accordance with the attached example; and

FURTHER ORDERED that a copy of this Decision be entered into the file of Case IPR2013-00472.

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