

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SkyHawke Technologies, LLC,

Petitioner,

v.

L&H Concepts, LLC,

Patent Owner.

Case No. IPR2014-_____

Patent 5,779,566

**MOTION FOR JOINDER TO RELATED
INTER PARTES REVIEW IPR2014-00438
UNDER 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b)**

I. RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner SkyHawke Technologies, LLC (“SkyHawke” or “Petitioner”) hereby moves for joinder of the concurrently filed petition for *inter partes* review of claims 6, 15, and 16 of U.S. Patent No. 5,779,566 (“the ‘566 patent”) with the instituted *inter partes* review styled *SkyHawke Technologies, LLC v. L&H Concepts, LLC*, Case No. IPR2014-00438 concerning the same patent (“the ‘438 IPR”).

II. STATEMENT OF MATERIAL FACTS

1. On March 6, 2013, L&H Concepts, LLC (“L&H”) filed a complaint against SkyHawke in the United States District Court for the Eastern District of Texas alleging that SkyHawke infringed the ‘566 patent.

2. On May 23, 2013, SkyHawke moved to transfer the case from the Eastern District of Texas to the Southern District of Mississippi. SkyHawke’s motion was granted on February 19, 2014. The litigation between L&H and SkyHawke is currently styled *L&H Concepts, LLC v. SkyHawke Technologies, LLC*, C.A. No. 3:14-cv-00224-HTW-LRA (S.D. Miss.).

3. On August 1, 2013—before the litigation was transferred to the Southern District of Mississippi—L&H filed infringement contentions under the Eastern District of Texas’s Local Patent Rules. L&H’s infringement contentions

asserted that SkyHawke infringed claims 1-5, 8-11, 13-14, and 17-18, of the '566 patent.

4. On February 14, 2014, SkyHawke filed two petitions for *inter partes* review collectively targeting all asserted claims of the '566 patent. The first petition, Case No. IPR2014-00437 ("the '437 IPR"), challenged method claims 8-11, 14, and 18. The second petition, the '438 IPR, challenged apparatus claims 1-5, 13, and 17.

5. On May 13, 2014, before an initial status conference was held in the Southern District of Mississippi, SkyHawke moved to stay the litigation pending the outcome of the '437 and '438 IPRs.

6. On May 23, 2014, L&H supplemented its interrogatory responses to contend that SkyHawke was infringing claims 6 and 16 of the '566 patent. L&H had not asserted these claims in its infringement contentions filed in the Eastern District of Texas.

7. On June 20, 2014, a telephonic hearing was held on SkyHawke's motion to stay before Magistrate Judge Anderson. During that hearing (and in SkyHawke's corresponding briefing on the issue), SkyHawke notified counsel for L&H that it intended to file a supplemental petition for *inter partes* review against claims 6 and 16 of the '566 patent, and to accompany the petition with a request for joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b).

8. During the telephonic motion hearing, Magistrate Judge Anderson determined to grant SkyHawke's request for a stay, temporarily staying the case until further order of the Court. Based upon that Order, the parties are to inform the Court of the status of SkyHawke's IPR proceedings by September 30, 2014. The stay shall remain in place until further Order of the Court.

9. On August 21, 2014, the Board instituted trial on claims 1-5, 8-11, 13-14, and 17-18 of the '566 patent. *See* Case IPR2014-00437, Paper 7 and Case IPR2014-00438, Paper 7. Specifically, the Board found that SkyHawke had demonstrated a reasonable likelihood of prevailing and demonstrating that claims 1-5, 8-11, 13-14, and 17-18 are unpatentable over the specified combinations of Palmer (WO 92/04080), Osamu (GB 2 249 202 A), and Vanden Heuvel et al. (US 5,426,422). *See* Case IPR2014-00437, Paper 7 at 20 and Case IPR2014-00438, Paper 7 at 23.

10. On even date herewith, SkyHawke filed a third petition for *inter partes* review of the '566 patent ("Third Petition") requesting cancellation of the additional asserted claims 6 and 16, as well as claim 15, which is materially identical to claim 16.

11. SkyHawke's grounds for challenging the patentability of claims 6, 15, and 16 are based on the same prior art references and grounds upon which the '437 and '438 IPRs were instituted.

12.SkyHawke’s Third Petition argues that claims 6, 15, and 16 are unpatentable in view of Palmer, Vanden Heuvel, and Osamu. The same arguments set forth by SkyHawke in the ‘437 and ‘438 IPRs apply equally to claims 6, 15, and 16, as these claims do not introduce new features outside of those challenged in the ‘437 and ‘438 IPRs. For example, claim 6 of the ‘566 patent states that the claimed apparatus includes “game-interactive golf advice information screens,” which is redundant to presently challenged claim 8 reciting, in part, “one or more game-interactive advice/feedback information screens.”

13.Claims 15 and 16 of the ‘566 patent are materially identical to challenged claims 8 and 14, except for the limitations in claims 15 and 16 reciting that “the [pre-game or game-interactive, respectively] information screens are provided with means for selecting non-sequential option screens.” These limitations are redundant to challenged claims 2 and 3, which recite, *inter alia*, “...choice means for non-sequential selection or changing of information screens,” and “...wherein the choice means is screen-dependent to provide a customized set of screen-changing options for a displayed information screen.”

For the reasons set forth above, SkyHawke considers the filing of the Third Petition to be necessary and appropriate.

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