

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HARMONIX MUSIC SYSTEMS, INC. AND
KONAMI DIGITAL ENTERTAINMENT INC.,
Petitioner,

v.

PRINCETON DIGITAL IMAGE CORPORATION,
Patent Owner.

Case IPR2015-00271
Patent 5,513,129

Before BENJAMIN D. M. WOOD, MICHELLE R. OSINSKI, and
TRENTON A. WARD, *Administrative Patent Judges*.

OSINSKI, *Administrative Patent Judge*.

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

I. INTRODUCTION

Harmonix Music Systems, Inc.¹ and Konami Digital Entertainment Inc. (collectively “Petitioner”) filed a Petition for *Inter Partes* Review (Paper 1) of claims 1–23 of U.S. Patent No. 5,513,129 (Ex. 1001, “the ’129 patent”), and concurrently filed a Motion for Joinder (Paper 5, “Mot.”). In the Motion for Joinder, Petitioner seeks to join challenges against the ’129 patent in this proceeding (“the ’271 IPR”) to a proceeding previously instituted against the ’129 patent, *Ubisoft Entertainment SA v. Princeton Digital Image Corporation*, Case IPR2014-00635 (“the ’635 IPR”). Mot. 1. Princeton Digital Image Corporation (“Patent Owner”) timely filed an Opposition to the Motion for Joinder (Paper 8, “Opp.”). Petitioner filed a Reply to Patent Owner’s Opposition (Paper 9, “Reply”) and a Corrected Petition (Paper 11, “Pet.”). On March 17, 2015, Patent Owner filed a Preliminary Response (Paper 13, “Prelim. Resp.”).

For the reasons that follow, we determine that Petitioner has not shown that joinder is warranted in this instance and Petitioner’s Motion is denied.² Furthermore, in a decision entered concurrently, the Petition is denied.

¹ We note that Harmonix Music Systems, Inc. also filed a separate Petition to institute *inter partes* review of claims 1, 5, 6, 8–13, 15–19, and 21–23 of the ’129 patent on November 15, 2013. *See* Case IPR2014-00155 (“the ’155 IPR”), Paper 1. On May 9, 2014, we granted the Petition and instituted an *inter partes* review of claims 10, 11, 22, and 23. ’155 IPR, Paper 11, 2. An oral hearing was held on January 15, 2015, and a Final Written Decision was entered May 6, 2015. ’155 IPR, Papers 25, 26.

² The Petition was filed on November 17, 2014, more than one year after Petitioner was served with a complaint alleging infringement of the

II. PRINCIPLES OF LAW

Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. *See* 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).

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

'129 patent. Pet. 55; '155 IPR, Paper 11, 2. Petitioner Konami Digital Entertainment Inc. was added as a party on December 10, 2012. Mot. 5. When a Petition is filed more than one year after Petitioner was served with a complaint alleging infringement of the patent, an *inter partes* review ordinarily may not be instituted. *See* 35 U.S.C. § 315(b); 37 C.F.R. § 42.101(b). An exception to this one-year time bar exists in the case of a request for joinder that is filed within one month of institution of the proceeding sought to be joined. *See* 35 U.S.C. § 315(b) (final sentence); 37 C.F.R. § 42.122(b). The '635 IPR was instituted on October 17, 2014, and Petitioner filed its Motion for Joinder on November 17, 2014. Consequently, we may consider whether joinder is appropriate in this case. Absent joinder of this proceeding with the '635 IPR, the Petition would be barred.

schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See* 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>.

III. ANALYSIS

A. *New Grounds of Unpatentability*

The Petition seeks review of three claims, claims 14, 19, and 20, that were denied institution in the ’635 IPR and of claims for which review was instituted in the ’635 IPR. Mot. 1; ’635 IPR, Paper 9 (Decision on Institution), 2.³ In particular, the Petition includes a new challenge to both a claim not instituted in the ’635 IPR, claim 14, and claims instituted in the ’635 IPR, claims 5–7 and 16–18, based on a new combination of references considered in the ’635 IPR. Additionally, Petitioner adds claims 19 and 20 to a ground on which we instituted in the ’635 IPR. Mot. 1; ’635 IPR, Paper 9, 2. Petitioner points out that claim 14 (which Petitioner is challenging based on a combination of Adachi and Tsumura) depends from claim 12, and the Board has already instituted *inter partes* review of claim 12 based on Adachi. Mot. 10–11. Petitioner further points out that claims 19 and 20 (which Petitioner is challenging based on Lytle) depends from claim 16, and the Board has already instituted *inter partes* review of claim 16 based on Lytle. *Id.* at 11.

³ The Petition also seeks review of the same claims 1–13, 15–18, and 21–23 upon which we instituted an *inter partes* review in the ’635 IPR, and does not include any challenges rejected by the Board. Mot. 1; Reply 1; ’635 IPR, Paper 9, 2.

As compared to the grounds of unpatentability raised in the '635 IPR, the Petition asserts the following grounds of unpatentability.

Claims challenged in '635 IPR	Claims instituted in '635 IPR	Claims not instituted in '635 IPR	References in '635 IPR and/or '271 IPR	Claims challenged in '271 IPR
1, 5-7, 10-15, 21	10, 11	1, 5-7, 12-15, 21	Tsumura ⁴	10, 11
5-7, 9-12, 16-18, 22, 23	5-7, 9-12, 16-18, 22, 23	N/A	Lytle ⁵	5-7, 9-12, 16-20, 22, 23
1, 12, 13, 15, 21	1, 12, 13, 15, 21	N/A	Adachi ⁶	1, 12, 13, 15, 21
1, 8, 12, 13, 15, 21	1, 8, 12, 13, 15, 21	N/A	Lytle and Adachi	1, 8, 12, 13, 15, 21
1-6, 8, 9, 12, 13, 15-19, 21	1-4, 12, 13, 15, 21	5, 6, 8, 9, 16-19	Thalmann ⁷ and Williams ⁸	1-4, 12, 13, 15, 21
10, 11, 22, 23	N/A	10, 11, 22, 23	Williams	N/A
16-20	N/A	16-20	Tsumura and Williams	N/A
N/A	N/A	N/A	Adachi and Tsumura	5-7, 14, 16-20

Compare Pet. 2 with '635 IPR, Paper 9, 6-7, 24-25.

⁴ Tsumura et al., US 5,208,413 (iss. May 4, 1993) ("Tsumura," Ex. 1002).

⁵ Wayne T. Lytle, *Driving Computer Graphics Animation from a Musical Score*, SCIENTIFIC EXCELLENCE IN SUPERCOMPUTING, THE IBM 1990 CONTEST PRIZE PAPERS 643-86 (Keith R. Billingsley et al. ed., 1992) ("Lytle," Ex. 1003).

⁶ Adachi et al., US 5,048,390 (iss. Sept. 17, 1991) ("Adachi," Ex. 1004).

⁷ Daniel Thalmann, *Using Virtual Reality Techniques in the Animation Process*, PROC. VIRTUAL REALITY SYSTEMS, BRITISH COMPUTER SOCIETY 1-20 (1992) ("Thalmann," Ex. 1006).

⁸ Williams et al., US 5,430,835 (iss. July 4, 1995) ("Williams," Ex. 1005).

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