

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIRIUS XM RADIO INC.,
Petitioner,

v.

DRAGON INTELLECTUAL PROPERTY, LLC
Patent Owner.

Case IPR2015-01735
Patent 5,930,444

Before NEIL T. POWELL, STACEY G. WHITE, and J. JOHN LEE,
Administrative Patent Judges.

WHITE, *Administrative Patent Judge.*

DECISION

Institution of *Inter Partes* Review and Grant of Motion for Joinder
37 C.F.R. § 42.108
37 C.F.R. § 42.122(b)

I. INTRODUCTION

Sirius XM Radio Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–10, 13 and 14 (“the challenged claims”) of U.S. Patent No. 5,930,444 (Ex. 1001, “the ’444 patent”), and concurrently filed a Motion for Joinder (Paper 3, “Mot.”). The Motion for Joinder seeks to join this proceeding with *DISH Network L.L.C. v. Dragon Intellectual Property, LLC*, IPR2015-00499 (the “DISH IPR”). Mot. 1. Patent Owner filed a Partial Opposition to the Motion for Joinder (Paper 7, “Opp.”). For the reasons described below, we institute an *inter partes* review of all the challenged claims and grant Petitioner’s Motion for Joinder.

II. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same grounds as those on which we instituted review in the DISH IPR. On July 17, 2015, we instituted a trial in the IPR2015-00499 on the following grounds:

| References | Basis | Claims Challenged |
|--|-------|-------------------|
| Goldwasser ¹ and Yifrach ² | § 103 | 1, 7–10, and 14 |
| Goldwasser, Yifrach, and Vogel ³ | § 103 | 2–4 and 13 |

DISH Network L.L.C. v. Dragon Intellectual Prop., LLC, Case IPR2015-00499, slip. op. at 19 (PTAB July 17, 2015) (Paper 7) (“499 Decision”).

¹ US 5,241,428, filed Mar. 12, 1991, issued Aug. 31, 1993 (“Goldwasser”) (Ex. 1005).

² US 5,126,982, filed Sept. 10, 1990, issued June 30, 1992 (“Yifrach”) (Ex. 1003).

³ PCT Pub. WO 90/15507, published Dec. 13, 1990 (“Vogel”) (Ex. 1004).

In addition, Petitioner conditionally asserts grounds that were subject to a Request for Rehearing, which was still pending at the time the Petition and Joinder Motion were filed. Pet. 4 n.1; *DISH Network, LLC v. Dragon Intellectual Prop. LLC.*, IPR2015-00499 (PTAB) (Paper 9) (the “DISH Rehearing Request”). Petitioner “agree[d] to be bound by the Board’s decision in the DISH Rehearing Request and [] withdraw any grounds the Board does not institute.” Pet. 4 n.1; *see also id.* at 8 n.2 (repeating same statement). Patent Owner’s Partial Opposition focuses only on issues related to the conditionally asserted grounds. Opp. 1. On October 20, 2015, we denied the DISH Rehearing Request. *DISH Network, LLC v. Dragon Intellectual Prop. LLC.*, IPR2015-00499 (PTAB) (Paper 14). Thus, we treat the conditionally asserted grounds as withdrawn from this Petition, and we find Patent Owner’s Opposition to be moot. As such, the only challenges remaining in this Petition are the same as those instituted in the DISH IPR.

In view of the identity of the challenge in the instant Petition and in the petition in the IPR2015-0499, we institute an *inter partes* review in this proceeding on the same grounds as those on which we instituted *inter partes* review in IPR2015-0499. We do not institute *inter partes* review on any other grounds.

III. GRANT OF MOTION FOR JOINDER

An *inter partes* review may be joined with another *inter partes* review, subject to the provisions of 35 U.S.C. § 315(c), which governs joinder of inter partes review proceedings:

(c) 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

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preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter parties review under section 314.

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder should: (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *See* Frequently Asked Question H5, *available at* <http://www.uspto.gov/patentsapplication-process/appealing-patentdecisions/trials/patent-reviewprocessing-system-prps-0>.

The Petition in this proceeding has been accorded a filing date of August 14, 2015 (Paper 4), which is within one month the date of institution in IPR2015-0499, which was instituted on July 17, 2015. The Petition, therefore, was filed timely. 37 C.F.R. § 42.122.

In its Motion for Joinder, Petitioner contends that the grounds asserted in the instant Petition “present[] the same claims, prior art combinations and grounds of unpatentability that are the subject of the DISH IPR.” Mot. 1. Petitioner seeks to join the DISH IPR “as an ‘understudy’ to Dish Network L.L.C. [], only assuming an active role to support the DISH IPR as necessary or in the event DISH settles with Dragon Intellectual Property, LLC.” *Id.* Petitioner asserts that it “is not seeking to alter the schedule.” *Id.* at 11. In addition, the identity of its grounds with those in the DISH IPR means that Patent Owner will not be prejudiced because the joinder of Petitioner to the DISH IPR will not require Patent Owner to perform any additional analysis, and no additional depositions will be necessary because Petitioner and Dish rely upon the same declarations. *Id.* Petitioner “further submits that it is

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willing to agree to consolidated filings already set on the schedule in the DISH IPR and to designate DISH as the lead petitioner in the joint proceedings.” *Id.* at 12. On this record, we find that joinder is appropriate and we grant Petitioner’s Motion for Joinder.

IV. ORDER

In view of the foregoing, it is

ORDERED that Petitioner’s Motion for Joinder is granted;

FURTHER ORDERED that IPR2015-01735 is hereby instituted and joined with IPR2015-00499;

FURTHER ORDERED that the grounds on which IPR2015-0499 was instituted are unchanged and no other grounds are included in the joined proceeding;

FURTHER ORDERED that the Scheduling Order entered in IPR2015-00499 (Paper 8) remains unchanged and shall govern the schedule of the joined proceedings;

FURTHER ORDERED that, throughout the joined proceeding, Dish Network LLC and SIRIUS XM Radio Inc. will file all papers jointly in the joined proceeding as consolidated filings, and will identify each such paper as “Consolidated,” except that papers filed on behalf of a single party need not be marked Consolidated;

FURTHER ORDERED that IPR2015-01735 is terminated under 37 C.F.R. § 42.72 and all further filings in the joined proceedings are to be made in IPR2015-00499;

FURTHER ORDERED that a copy of this Decision will be entered into the record of IPR2015-0499; and

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