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
U.S. PATENT NO. 5,930,444

REPLY IN SUPPORT OF MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22 AND 42.122(b) TO RELATED *INTER PARTES* REVIEW IPR2015-00499

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I. SIRIUS XM'S MOTION FOR JOINDER SEEKS TO JOIN THE DISH IPR ON THE SAME GROUNDS INSTITUTED BY THE BOARD

Dragon does not oppose Sirius XM's request for joinder based on what the Board has already instituted with respect to the DISH IPR. Instead, Dragon's opposition misconstrues Sirius XM's motion and the Sirius XM IPR by claiming that Sirius XM seeks to expand the scope of the DISH IPR by purportedly raising new issues and grounds of unpatentability. That is not true.

More particularly, the scope of the DISH IPR is currently subject to DISH's Request for Rehearing Pursuant to 37 C.F.R. § 42.71(d) (the "Rehearing Request"). Notably, and a point entirely ignored by Dragon's opposition, Sirius XM has represented to the Board that "it will proceed on the grounds presented in the DISH Rehearing Request to the extent the Board institutes them. In the event the Board denies in whole or in part the DISH Rehearing Request, Sirius XM agrees to be bound by such decision and will withdraw any grounds the Board does not institute." IPR2015-01735, Paper 3 at 8, n.2 ("Sirius XM's Motion"). Accordingly, if the Board institutes the DISH IPR on the additional grounds identified in the Rehearing Request (such as with respect to the Truog reference), then Sirius XM seeks to join those additional grounds and include the two declarations that it has submitted with the Sirius XM IPR.[1] If the Board denies the

[1] The two declarations Sirius XM offers provide evidence to address the Board's

Rehearing Request, then Sirius XM seeks to join (and Dragon does not oppose) the more limited scope of the DISH IPR, which make the two declarations moot. Either way, and contrary to Dragon's contentions, Sirius XM seeks invalidation on the same grounds presented in the DISH IPR and Sirius XM has raised no new issues or grounds for unpatentability.

Moreover, Dragon's repeated refrain that "the new evidence that Sirius seeks to add to the DISH IPR is not relevant to any ground on which review had been instituted" misunderstands Sirius XM's joinder request and associated IPR. As explained above, Sirius XM has limited its request to join the DISH IPR based on the current grounds the Board has instituted, and any additional grounds that may be instituted in response to the Rehearing Request.

II. THE BOARD ROUTINELY GRANTS JOINDER REQUESTS WHEN ADDITIONAL EVIDENCE IS PRESENTED

The Board routinely grants motions for joinder where the moving party intends to present limited additional evidence. For example, in *T-Mobile USA v. Mobile Telecomm. Techs., LLC*, the Board granted joinder where the petitioner introduced new evidence – including a new expert declaration – to support the

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concerns and make it clear and unequivocal that Truog was a printed publication "'sufficiently accessible to the public interested in the art.'" DISH IPR, Paper 7 at 10-11 (citations omitted).

prior art and invalidity theories presented in the instituted petition. *See* IPR2015-00015, Paper 13 (April 8, 2015); *see also id.*, Paper 12 at 3-4 (March 9, 2015) (discussing additional declaration). The Board noted that "to the extent there are differences in Petitioner's evidence and arguments regarding . . . the substantive application of the prior art to the claims, resolving these differences in a single proceeding is *the most efficient course of action*." *Id.*, Paper 13 at 5 (emphasis added); *see also Samsung Electronics Co. v. Virginia Innovation Sciences, Inc.*, IPR2014-00557, Paper 10 at 18 (June 13, 2014) (granting motion for joinder for an IPR challenging new, but related claims, with a "substantially overlapping" declaration more than a year after the filing of the complaint in the underlying action); *Ariosa Diagnostics v. Isis Innovation, Ltd.*, IPR2013-00250, Paper 25 at 5 (September 3, 2013) (granting motion for joinder despite differences in the prior art presented where there was "an overlap in the cited prior art").

Dragon's opposition, however, relies on inapposite authority. In several of the cases Dragon relies upon, the party seeking joinder raised entirely new arguments (e.g., new prior art, different combinations of prior art, or unrelated issues of standing) that would have required extensive modifications to the IPR schedule. For example, in *Sony Corp. of America v. Network-1 Security Solutions, Inc.*, a motion for joinder was denied where the moving party challenged a new claim, asserted several new grounds of unpatentability, and introduced five new

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