

Paper No. ____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NISSAN NORTH AMERICA, INC.

Petitioner

V.

SIGNAL IP, INC.

Patent Owner

Case No.: IPR2016-00113

Patent No.: 6,012,007

REPLY TO PATENT OWNER'S OPPOSITION TO MOTION FOR

JOINDER TO RELATED *INTER PARTES* REVIEW

IPR2015-01004

I. INTRODUCTION

The Board routinely grants motions for joinder where the party seeking joinder presents identical arguments to those raised in the existing proceeding and agrees to reasonable limits on its role in the joined proceeding. *See, e.g., Perfect World Entertainment, Inc., v. Uniloc USA, Inc. and Uniloc Luxembourg S.A.*, IPR2015-01026, Paper 10, (PTAB Aug. 3, 2015); *ION Geophysical Corporation and Ion International S.A.R.L. v. WesternGeco LLC*, IPR2015-00567, Paper 14, (PTAB Apr. 23, 2015); *Fujitsu Semiconductor Limited v. Zond, LLC*, IPR2014-00845, Paper 14 (PTAB Oct. 2, 2014); *Enzymotec Ltd. V. Neptune Technologies & Bioresources, Inc.*, IPR2014-00556, Paper 19 (PTAB Jul. 9, 2014). This is the exact situation here and joinder should be granted consistent with the Board's "policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding." *Enzymotec*, Paper 19, p. 6 *citing* 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) ("The Office anticipates that joinder will be allowed as of right – if an *inter partes* review is instituted on the basis of a petition, for example, a party that files an *identical petition* will be joined to that proceeding, . . .") (emphasis added).

Joinder has been routinely granted where the petitioner files a petition and joinder motion within 30 days of the institution of trial in the existing proceeding. *See Nintendo Co. et al. v. Babbage Holdings, LLC*, IPR2014-00568, Paper 12

(PTAB Mar. 18, 2015); *Apotex Corp. et al. v. Mitsubishi Pharmaceutical Corp. & Novartis AG*, IPR2015-00518, Paper 8 (PTAB Feb. 17, 2015). In fact joinder has been routinely granted in over 210 PTAB proceedings to date and there is nothing unusual about this case.

During a conference with the Board on December 4, 2015, counsel for the Patent Owner indicated that new arguments will be filed in its Preliminary Response given the Institution Decision in IPR2015-01004 (“Honda IPR”). However, counsel failed to identify, even in general terms, any new argument that allegedly may be raised. Nor did counsel explain why any such new arguments could not be raised in the pending Honda IPR proceeding. Since the Petition in IPR2016-00113 (“Nissan IPR”) is substantively identical to the Petition in the Honda IPR, any new arguments can be addressed in the Patent Owner’s Response in the Honda IPR and will be applied with respect to Petitioner in the joined proceeding.

II. ARGUMENTS

A. PETITIONER’S REQUEST FOR JOINDER RAISES NO NEW ISSUES AND JOINDER WOULD NOT COMPLICATE EXISTING PROCEEDING

The Board has frequently granted joinder in cases where, as here, the Petition of the party seeking joinder “asserts identical grounds of unpatentability, challenging the same claims of the” challenged patent. *Fujitsu*, Paper 14, p. 4.

The proposed grounds in the Nissan IPR Petition are substantively identical to the grounds on which the Board instituted the Honda IPR, and it even asserts “the same prior art, same arguments, and same evidence, including the same expert and a substantively identical declaration” (save only minor differences related to formalities of a different party filing the Petition). *Sony Corp., et al. v. Memory Integrity, LLC*, IPR2015-01353, Paper 11 (PTAB Oct. 15, 2015), pp. 5-6. Thus, Petitioner asks the Board to simply “institute the instant trial based on the same grounds for which [it] instituted trial in” the Honda IPR, as the Board has done in similar cases. *Fujitsu*, Paper 14, p. 4.

Furthermore, in its Motion for Joinder, Petitioner unequivocally indicates that it does not seek to delay the existing schedule of the Honda IPR, and, to that end, states that it will accept an “understudy” role. *See Nissan North America, Inc. v. Signal IP, Inc.*, IPR2016-00113, Paper 1 (Nissan Oct. 30, 2015), p. 6. Petitioner reiterated this position and stated its willingness to file consolidated papers during the aforementioned December 4, 2015 conference with the Board. Petitioner has no intention to revisit the already conducted discovery. Rather, Petitioner simply seeks to join the ongoing Honda IPR, adopting its status upon the grant of joinder.

B. PATENT OWNER CAN RAISE ANY NEW ARGUMENTS AS TO THE MERITS IN ITS PATENT OWNER RESPONSE IN THE HONDA IPR.

The Patent Owner's "new arguments" contention is illusory. Patent Owner has had over a full month to review Petitioner's petition, and over eight months to review the substantively identical petition in the Honda IPR proceeding. Since the Nissan IPR Petition is substantively identical to the Honda IPR Petition, the Patent Owner can raise any new arguments as to the merits of the Nissan IPR Petition in its Patent Owner Response in the Honda IPR proceeding and the same will be applied with respect to Petitioner in the joined proceeding.

C. PATENT OWNER'S PRELIMINARY RESPONSE IN THE NISSAN IPR COINCIDES WITH THE PATENT OWNER'S RESPONSE IN THE HONDA IPR

The Patent Owner contends that "joinder at this late stage would require delaying the schedule in '1004 IPR [the Honda IPR] proceeding if trial were instituted on the present petition" as the Patent Owner's response in the Honda IPR proceeding will be "filed fully one month before Patent Owner's Preliminary Response is due in the present proceeding." *Nissan*, Paper 6, pp. 2-3. Without admitting any delay would have been caused, Petitioner points out that by Order dated December 7, 2015, the Board has changed the due date of Patent Owner's Preliminary Response in the Nissan IPR such that it coincides with the due date for the Patent Owner's Response in the Honda IPR. *See id.*, Paper 7, p. 2.

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