

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION,
Petitioner

v.

RAYTHEON COMPANY,
Patent Owner

Case IPR2016-00209

Patent 5,591,678

**PATENT OWNER'S RESPONSE TO PETITIONER'S
MOTION FOR JOINDER**

Raytheon Company (“Patent Owner”), owner of U.S. Patent No. 5,591,678 (“678 Patent”), respectfully submits this response to Petitioner’s Motion for Joinder (Paper No. 3, referred to as “Motion” herein). The Petition in the present proceeding is the second that Petitioner has filed against the 678 Patent, challenging the very claims that are already at issue -- under six different grounds - - in a pending IPR proceeding. For the reasons that will be stated in Patent Owner’s preliminary response, the Board should deny institution of an IPR in the present proceeding.¹ To the extent, however, that the Board decides to institute an IPR in the present proceeding, Patent Owner does not oppose joinder provided that the schedule is adjusted to (1) allow Patent Owner sufficient time and opportunity to address the numerous issues raised by Petitioners and (2) provide for a single Patent Owner Response to achieve the efficiencies of joinder.

I. RELATED MATTERS

A. District Court Litigation

Patent Owner asserted the 678 Patent against Petitioner and several other defendants in *Raytheon Company v. Sony Corporation, et al.*, C.A. No. 2:15-cv-

¹ Patent Owner’s Response is due to be filed on February 24, 2016. Paper No. 4. Patent Owner, however, intends to file its preliminary response early.

342, (E.D. Tex.) and *Raytheon Company v. Samsung Electronics Co., Ltd. et al.*, C.A. No. 2-15-cv-00341 (E.D. Tex.). Both cases were filed March 6, 2015 and remain pending.

B. IPR 2015-01201

On May 14, 2015, Petitioner filed a Petition for *inter partes* review of claims 1-18 of the 678 Patent, alleging six separate grounds based on eleven different references. IPR2015-01201, Paper 2, at 2, 36. On December 3, 2015, the Board instituted review of claims 1-18 based on six grounds and numerous references. *Id.*, Paper 6, at 23-24 (referred to herein as the “1201 IPR”). Pursuant to a joint stipulation, Patent Owner’s response is due March 7, 2016. IPR 2015-01201, Paper 13.

C. Present Proceeding

Petitioner filed the Petition in the present proceeding on November 18, 2015, over six months after the Petition in the 1201 IPR. Paper 2 (referred to herein as the “0209 IPR”). The Petition alleges unpatentability of claims 1-18 of the 678 Patent based on eight separate grounds and seven references. *Id.*, at 2-3. With the Petition, Petitioner also filed a motion to join the 0209 IPR proceedings with the 1201 IPR, asserting that the two IPRs involve common issues and that joinder will conserve resources by simplifying briefing and allowing for a single deposition of

its expert. Paper 3, at 5, 8. In addition, Petitioner recognized that joinder would require modification of the schedule in the 1201 IPR and pledged to accommodate reasonable scheduling requests of Patent Owner to facilitate joinder. The parties met and conferred regarding Petitioner's joinder motion and scheduling, and Petitioner did not oppose a joinder schedule that provided for a single Patent Owner response to be filed on May 25, 2016.² The parties informed the Board that they had reached an agreement with respect to a potential schedule in the event of joinder. Paper 8, at 2.

II. PATENT OWNER'S RESPONSE TO PETITIONER'S JOINDER MOTION

For the reasons that will be stated in Patent Owner's preliminary response, the Board should deny institution in the 0209 IPR. To the extent, however, that the Board decides to institute in the 0209 IPR, Patent Owner does not oppose joinder provided that the schedule is adjusted to (1) allow Patent Owner sufficient time to address the numerous issues raised by Petitioners and (2) to provide for a single Patent Owner Response to simplify briefing and allow for a single deposition of

² Petitioner also indicated that it would not object to reasonable modifications to briefing page limits and deposition time necessitated by joinder.

Petitioner's expert. While Patent Owner acknowledges that joinder can simplify issues for the parties and the Board, joinder should not occur unless it (1) does not prejudice Patent Owner's ability to properly respond to Petitioner's challenges and (2) achieves the efficiencies attendant to a single proceeding.

A. The Petitions Raise a Substantial Number of Issues

Although Petitioner asserts that the petitions in the 1201 IPR and 0209 IPR involve overlapping issues, it does not deny that the two petitions assert a substantial number of grounds based on a large number of references. Paper 3, at 2-3. Indeed, the two petitions include 14 separate alleged grounds based on numerous references. In addition, with the 1201 IPR Petitioners submitted a 127 page expert declaration, and with the 0209 IPR Petitioners submitted a 85 page expert declaration. IPR 2015-01201, Ex. 1002; IPR 2016-00209, Ex. 1002. There can be no doubt that Patent Owners require sufficient time to respond to the substantial number of issues raised by Petitioners. Absent sufficient time to respond, Patent Owners will be prejudiced by joinder and joinder should be denied.

B. A Single Patent Owner Response Will Simplify Briefing and Discovery

In addition to sufficient time to respond to the issues raised by Petitioner, in the event that the Board joins the two IPR proceedings, it should modify the schedule to allow for the filing of a single Patent Owner Response. In its motion

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