Trials@uspto.gov
571-272-7822

Paper No. 14
Entered: March 29, 2016

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

Before JO-ANNE M. KOKOSKI, JENNIFER MEYER CHAGNON, and JEFFREY W. ABRAHAM *Administrative Patent Judges*.

CHAGNON, *Administrative Patent Judge*.

DECISION
Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b)

I. INTRODUCTION

Sony Corporation ("Petitioner") filed a Petition requesting an *inter partes* review of claims 1–18 of U.S. Patent No. 5,591,678 (Ex. 1001, "the '678 patent"). Paper 2 ("Pet."). With the Petition, Petitioner filed a

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

Motion for Joinder (Paper 3, "Mot."), seeking to join this proceeding with *Sony Corp. v. Raytheon Co.*, Case IPR2015-01201 ("the 1201 IPR"). Raytheon Company ("Patent Owner") filed a Response to Petitioner's Motion for Joinder. Paper 9 ("Resp."). In a separate decision, entered concurrently, we institute an *inter partes* review in the instant proceeding as to claims 1–18 of the '678 patent. Paper 12. Upon consideration of the Motion and the Response, and for the reasons explained below, Petitioner's Motion for Joinder is *denied*.

II. BACKGROUND

Petitioner filed its Petition and Motion for Joinder on November 18, 2015, prior to the institution date of the 1201 IPR. The instant Petition asserts that claims 1–18 of the '678 patent are unpatentable under 35 U.S.C. § 102(b) as anticipated by Liu[1] and/or under 35 U.S.C. § 103(a) as obvious over Liu in combination with various other references. Pet. 3, 20–58. In the 1201 IPR, trial was instituted on December 2, 2015 as to claims 1, 5–7, and 9–13 as being unpatentable under 35 U.S.C. § 102(e) as anticipated by Bertin[2] or under 35 U.S.C. § 103(a) as obvious over Bertin in combination with various other references; and as to claims 1, 2–5, 8, 10, and 13–18 as being unpatentable under 35 U.S.C. § 103(a) as obvious over Morimoto[3] in combination with various other references. *See* 1201 IPR, slip op. at 23–24 (PTAB Dec. 2, 2015) (Paper 6).

[1] U.S. Patent No. 4,422,091, issued Dec. 20, 1983 ("Liu").
[2] U.S. Patent No. 5,202,754, issued Apr. 13, 1993 ("Bertin").
[3] JP Appl. Pub. No. 64-18248, published Jan. 23, 1989 ("Morimoto").

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

III. ANALYSIS

An *inter partes* review may be joined with another *inter partes* review, subject to the provisions 35 U.S.C. § 315(c),[4] which governs joinder of *inter partes* review proceedings:

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

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

---

[4] Petitioner cites to *Target Corp. v. Destination Maternity Corp.*, Case IPR2014-00508, slip op. at 10 (PTAB Feb. 12, 2015) (Paper 28) (Decision Granting Request For Rehearing), and asserts that the Board has discretion under 35 U.S.C. § 315(c) to allow joinder of a person to an ongoing *inter partes* review when, as here, that person is already a party to the ongoing *inter partes* review. We need not address this issue, however, because we are not persuaded that the circumstances in this proceeding warrant joinder, regardless of whether same party joinder is permissible.

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

and inexpensive resolution of every proceeding. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b).

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: set forth the reasons joinder is appropriate; identify any new grounds of unpatentability asserted in the petition; explain what impact (if any) joinder would have on the trial schedule for the existing review; and address specifically how briefing and discovery may be simplified. *See Kyocera Corp. v. Softview, LLC,* Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15) (representative); *see also* "Frequently Asked Questions H5," http://www.uspto.gov/ip/boards/bpai/prps.jsp.

Petitioner argues that joinder is appropriate because the instant Petition and the 1201 IPR involve the same parties, the same patent, certain common issues, and overlapping prior art. Mot. 4–7. Petitioner further notes that joinder is not required to avoid a time-bar under 35 U.S.C. § 315(b) in this case. *Id.* at 7. Petitioner additionally asserts that, "because the present IPR petition challenges the same claims and presents overlapping prior art and similar issues, joining the two petitions will greatly simplify briefing, discovery, and other scheduling issues." *Id.* at 8. According to Petitioner, "joining the petitions would serve to conserve the parties' and the Board's resources." *Id.* Finally, Petitioner argues that joinder would not prejudice Patent Owner because Petitioner "is prepared to accommodate any reasonable logistical or scheduling request of Patent Owner." *Id.* at 8–9.

In its Response to Petitioner's Motion, Patent Owner indicates that it "does not oppose joinder provided that the schedule is adjusted to (1) allow Patent Owner sufficient time and opportunity to address the numerous issues

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

raised by Petitioners and (2) provide for a single Patent Owner Response to achieve the efficiencies of joinder." Resp. 1.

Based on the particular facts and circumstances of this proceeding, we are not persuaded that joinder is appropriate. As noted above, the instant Petition raises numerous substantive issues that are not before the Board in the 1201 IPR, i.e., the asserted grounds are based, at least in part, on different prior art references than those at issue in the 1201 IPR. Further, the 1201 IPR is already well underway. In fact, Patent Owner already filed its Patent Owner Response in the 1201 IPR. *See* 1201 IPR, Paper 22 (PO Resp.), Paper 23 (redacted version), filed March 11, 2016. Joinder would require delaying the upcoming due dates in the 1201 IPR and extending the overall schedule by several months. Additionally, because Patent Owner has already filed its Patent Owner Response in the 1201 IPR, Patent Owner would no longer benefit from many of the efficiencies that potentially could be achieved through joinder.

Having considered both Petitioner's Motion for Joinder and Patent Owner's Response thereto, we determine that Petitioner has not established persuasively that joinder is appropriate in this instance.

Accordingly, it is

ORDERED that Petitioner's Motion for Joinder is *denied*.

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.