

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Sony Corporation

Petitioner

v.

Raytheon Company

(record) Patent Owner

**Case: IPR2016-00209**

**Patent No. 5,591,678**

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**MOTION FOR JOINDER WITH RELATED *INTER PARTES*  
REVIEW OF U.S. PATENT NO. 5,591,678**

## **I. RELIEF REQUESTED**

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner Sony Corporation (“Sony”) moves for joinder of its today-filed petition for *inter partes* review (“IPR”) of claims 1-18 of U.S. Patent No. 5,591,678 (“the ’678 patent”) with a previously filed IPR styled *Sony Corporation v. Raytheon Company*, Case No. IPR2015-01201.

## **II. APPLICABLE LEGAL STANDARD**

The statutory provision governing joinder of IPR proceedings is 35 U.S.C. § 315(c), which provides as follows:

(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 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.

Relatedly, 37 C.F.R. § 42.122 provides in relevant part:

Multiple proceedings and Joinder. (b) Request for Joinder. Joinder may be requested by a patent owner or petitioner. Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested. The time period set forth in § 42.101(b) shall not apply when the petition is accompanied by a request for joinder.

35 U.S.C. § 315(c) authorizes joinder of issues to a proceeding involving the same parties. *Target Corp. v. Destination Maternity Corp.*, IPR2014-00508, Decision Granting Request For Rehearing, Paper 28, at 10 (PTAB Feb. 12, 2015).

“A motion for joinder should: (1) set forth the reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified.” *Dell Inc. v. Network-1 Security Solutions, Inc.*, IPR2013-00385, Decision Granting Motion For Joinder, Paper 17, at 4 (PTAB July 29, 2013).

### **III. STATEMENT OF MATERIAL FACTS**

1. On May 14, 2015, Sony filed a petition for IPR of claims 1-18 of the '678 patent, which was assigned Case No. IPR2015-01201.
2. As of this motion, the Board has not issued its decision whether to institute review of IPR2015-01201.
3. IPR2015-01201 raised six grounds of unpatentability of the '678 patent: (1) claims 1, 6, 7, 10, and 11 are anticipated by U.S. Pat. No. 5,202,754 (“Bertin”); (2) claims 5 and 12-13 are obvious over Bertin as in Ground 1 in view of Japanese Unexamined Patent Application Publication No. 64-18248, published January 23, 1989 (“Morimoto”); (3) claim 9 is obvious over Bertin as in Ground 1

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in further view of U.S. Pat. No. 4,982,266 (“Ying”); (4) claims 1-2, 4-5, 10, 13-14 and 16-17 are obvious over Morimoto in view of a set of primarily U.S. patent references known as the “CMP / Etching references”, including U.S. Pat. No. 5,189,500 (“Kusunoki”); (5) claims 8 and 18 are obvious as in Ground 4 in view of U.S. Pat. No. 4,681,718 (“Oldham”); and (6) claims 3 and 15 are obvious as in Ground 4 in view of Bertin.

4. This motion is filed concurrently with Sony’s second petition for IPR of the ’678 patent, which raises eight grounds of unpatentability involving several of the same prior art references as IPR2015-01201: (1) claims 1-4, 6-7, and 10-11 are anticipated by U.S. Pat. No. 4,422,091 (“Liu”); (2) claims 2-4 and 11 are obvious over Liu in view of U.S. Pat. No. 4,426,768 (“Black”); (3) claims 5 and 12-16 are obvious over Liu in view of U.S. Patent No. 4,106,050 (“Riseman”); (4) claim 8 is obvious over Liu in view of Oldham, (5) claim 10 is obvious over Liu in view of U.S. Pat. No. 3,846,198 (“Wen”); (6) claim 9 is obvious over Liu and Wen, in further view of Ying; (7) claim 17 is obvious over Liu and Riseman, in further view of Japanese Unexamined Patent Application Publication No. 03-108776, published May 8, 1991, which is an earlier published version of Kusunoki; and (8) Claim 18 is obvious over Liu and Riseman, in further view of Oldham.

5. The primary reference in the second petition, Liu, was filed on January 19, 1981, and issued on December 20, 1983, and is therefore prior art under

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35 U.S.C. § 102(b). One of the two primary references in the first petition, Bertin, was filed on September 13, 1991, and issued on April 13, 1993, and is therefore prior art under 35 U.S.C. § 102(e). In the first petition, several claims (claims 3, 6, 7, 9, 11, 12, and 15) are challenged only in grounds that depend in some way on Bertin.

6. The primary reference in Sony’s second petition, Liu, was not known to Sony at the time Sony’s first petition was filed. Petitioner first became aware of Liu in late August/early September, 2015.

7. The ’678 patent has been asserted against Sony in *Raytheon Company v. Sony Corporation, et al.*, C.A. No. 2:15-cv-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 on March 6, 2015—less than one year before the filing of this motion and of Sony’s concurrently filed second petition—and remain pending.

#### **IV. DISCUSSION**

##### **A. Joinder Is Timely**

This motion is made “no later than one month after the institution date” of the IPR2015-01201 as required by Rule 42.122(b). Trial has not yet been instituted in IPR2015-01201.

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