

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GAMELOFT, S.A.
Petitioner,

v.

ROTHSCHILD DIGITAL MEDIA INNOVATION, LLC
Patent Owner.

Case No. IPR2016-00472
Patent 6,101,534

PETITIONER'S MOTION FOR JOINDER
UNDER 35 U.S.C. 315(C), 37 C.F.R. §42.22 and 37 C.F.R. § 42.122(B)

I. STATEMENT OF RELIEF REQUESTED

Petitioner Gameloft, S.A. ("Petitioner") hereby respectfully requests joinder pursuant to 35 U.S.C. §315(c) and 37 C.F.R. 42.122(b) of the above-captioned *inter partes* review with the pending *inter partes* review concerning the same patent brought by Petitioner Sony Computer Entertainment America, LLC, Case No. IPR2015-01364 ("Sony IPR"), which was instituted on December 15, 2015 (Paper 8). Joinder is appropriate because it will promote efficient resolution of the validity of the U.S. Patent No. 6,101,534 ("the '534 Patent"), and it will not prejudice the parties to the Sony IPR.

This Motion for Joinder is timely filed under 37 C.F.R. §§ 42.22 and 42.122(b) as it is submitted no later than one month after the December 15, 2015 institution date of the Sony IPR.

II. STATEMENT OF MATERIAL FACTS

1. On June 9, 2015, petitioner in the Sony IPR requested *inter partes* review of claims 1, 6-9, and 21-24 of the '534 Patent. Sony IPR, Paper 3.

2. The Patent Owner, Rothschild Digital Media Innovation, LLC ("Rothschild"), submitted a preliminary response on September 17, 2015. *Id.*, Paper 7.

3. On December 15, 2015 the Board issued a decision instituting trial on claims 1, 6-9 and 21-24 in the Sony IPR. Specifically, the Board instituted *inter*

partes review on two requested grounds: (1) claims 1, 6-9, 21, 23 and 24 as obvious over Mages in view of Batchelor; and, (2) claim 22 as obvious over Mages, Batchelor and Hughes.

4. Today, Petitioner filed a Petition for *inter partes* review (“Joinder Petition”) that only challenges the same claims under the same grounds as those instituted in the Sony IPR. The claim charts and expert declaration in the Joinder Petition are substantially, if not completely, identical to the claim charts contained in the Sony IPR petition, with the exception that the grounds that were not instituted in the Sony IPR have been removed from the Joinder Petition.

III. STATEMENT OF REASONS FOR REQUESTED RELIEF

A. LEGAL STANDARD

The Leahy-Smith America Invents Act (“AIA”) explicitly provides for joinder of *inter partes* review (“IPR”) proceedings. The statutory provision governing joinder of *inter partes* review proceedings is 35 U.S.C. § 315(c) that reads 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.

In this case of joinder, the Board has the discretion to adjust the time period for issuing a final determination in an *inter partes* review. 35 U.S.C. § 316(a)(11); 37 C.F.R. § 42.100(c).

In exercising its discretion to grant joinder, the Board considers the impact of substantive and procedural issues on the proceedings, as well as other considerations, while being “mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” *See Dell Inc. v. Network-1 Security Solutions, Inc.*, Case IPR2013-00385, Paper No. 17, July 29, 2013 at 3. The Board should “also take into account the policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding.” *Id.* at 10.¹ Under this framework, joinder of the Joinder Petition with the Sony IPR is

¹ *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, and thus allowed to file its own briefs and make its own arguments.”) (emphasis added).

appropriate.

“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.” *Id.* at 4. Each of these four factors is addressed in turn below.

B. FACTOR (1): JOINDER IS APPROPRIATE IN ACCORDANCE WITH THE STATUTORY FRAMEWORK

The Board has authority under 35 U.S.C. § 315(c) to join a properly-filed second *inter partes* review petition to an instituted *inter partes* review proceeding. The present Motion for Joinder is timely filed under § 42.122(b).²

First, this request for joinder is timely. 37 C.F.R. § 42.122(b). Trial was instituted on December 15, 2015 and the instant motion and the Joinder Petition were filed on or before January 15, 2016. Therefore, this motion is made no later one month after the date the trial was instituted in IPR2015-01364 as required by 37 C.F.R. § 42.122(b).

Not only is joinder procedurally proper, but it is also substantively appropriate under the circumstances. First, the Joinder Petition involves the same

² The complaint alleging infringement of the ‘534 Patent against Gameloft was served on December 21, 2015.

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