

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANON U.S.A., INC.,
Petitioner,

v.

CELLSPIN SOFT, INC.,
Patent Owner.

Case IPR2019-00127 (Patent 9,258,698 B2)

GOPRO, INC., GARMIN INTERNATIONAL, INC., AND GARMIN USA,
INC.,
Petitioners,

v.

CELLSPIN SOFT, INC.,
Patent Owner.

Case IPR2019-01107 (Patent 9,258,698 B2)

Before GREGG I. ANDERSON, DANIEL J. GALLIGAN, and
STACY B. MARGOLIES, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding-37 C.F.R. § 42.5

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INTRODUCTION

A telephone conference was held on June 11, 2019, regarding a “Motion for Joinder Under 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b) to Related *Inter Partes* Review IPR2019-00127” (“Motion for Joinder”) filed by Petitioners GoPro, Inc. (“GoPro”), Garmin Int’l, Inc. and Garmin USA, Inc. (collectively “Garmin”) in IPR2019-01107 (“’1107 IPR”). ’1107 IPR, Paper 4. Counsel for Petitioner Canon U.S.A., Inc. (“Canon”) in IPR2019-00127 (“’127 IPR”), counsel for GoPro, Inc. and Garmin in the ’1107 IPR, counsel for Cellspin Soft, Inc. (“Patent Owner”) in both *inter partes* review proceedings, and Judges Anderson, Galligan, and Margolies participated in the call.

The call was requested by Canon for the purpose of discussing a schedule for briefing the Motion for Joinder. Canon and Patent Owner both oppose joinder.

A second question regarding *pro hac vice* admission of Karineh Khachatourian as back-up counsel for GoPro was also raised. Patent Owner stated its intention to oppose *pro hac vice* admission of Ms. Khachatourian.

DISCUSSION

The ’1107 IPR is at an early stage. Patent Owner’s Preliminary Response is currently due September 11, 2019. Although the Petition in the ’1107 IPR was represented as all but identical to that in the ’127 IPR, Patent Owner argued there may be different issues and it might file a different Preliminary Response than it filed in the ’127 IPR. At this time, there is no reason to expedite briefing on the Motion for Joinder.

The parties opposing the Motion for Joinder, Canon and Patent

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Owner, have one month from service of the Motion for Joinder or until June 28, 2019, to file their oppositions. 37 C.F.R. § 42.25(a)(1). Any reply by GoPro and Garmin is due one month after filing the opposition or until July 29, 2019, whichever is later. 37 C.F.R. § 42.25(a)(2).

Because Canon is not a party to the '1107 IPR, Canon shall file its opposition in the '127 IPR and send an email to Trials@uspto.gov for entry of the opposition in the '1107 IPR. Canon shall also file a copy of the Motion for Joinder as an exhibit of Petitioner in the '127 IPR.

Concerning GoPro's proposed motion for *pro hac vice* admission of Ms. Khachatourian in the '1107 IPR, GoPro will file the motion following the time set forth in *Unified Patents, Inc. v. Parallel Iron LLC*, Case IPR2013-00639 of no sooner than twenty one (21) days after service of the Petition. Patent Owner shall file any opposition by July 12, 2019, or one week after filing of the motion, whichever is later.

ORDER

It is

ORDERED that Canon shall file the Motion for Joinder as an exhibit of Petitioner in the '127 IPR by no later than June 28, 2019;

FURTHER ORDERED that Canon and Patent Owner are each authorized to file an opposition to the Motion for Joinder by no later than June 28, 2019;

FURTHER ORDERED that GoPro and Garmin are authorized to file a single reply in support of the Motion for Joinder by no later than July 29, 2019;

FURTHER ORDERED that no sur-reply is authorized at this time;

FURTHER ORDERED that the opposition and reply to the Motion

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for Joinder are subject to the page limits set forth in 37 C.F.R. § 42.24;

FURTHER ORDERED that the parties in the '1107 IPR shall meet and confer regarding whether Patent Owner is amenable to accelerating the deadline for its Preliminary Response and shall send a joint email to Trials@uspto.gov by no later than July 10 reporting on the results of the meet and confer;

FURTHER ORDERED that GoPro may file its motion for *pro hac vice* of Karineh Khachatourian on or after June 18, 2019, and Patent Owner shall file any opposition by July 12, 2019, or one week after filing of the motion, whichever is later; and

FURTHER ORDERED that the motion for *pro hac vice* is limited to eight (8) pages, exclusive of the declaration of Ms. Khachatourian, and the opposition is also limited to eight (8) pages.

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PETITIONER in '127 IPR:

Jared Newton

QUINN EMANUEL URQUHART & SULLIVAN

jarednewton@quinnemanuel.com

PETITIONERS in '1107 IPR:

David Xue

RIMÔN LAW

David.xue@rimonlaw.com

Jennifer Bailey

Adam Seitz

ERISE IP, P.A.

Jennifer.bailey@eriseip.com

Adam.seitz@eriseip.com

PATENT OWNER:

John Edmonds

Eric Carr

Stephen Schlather

COLLINS EDMONDS & SCHLATHER, PLLC

Pto-edmonds@ip-lit.com

ecarr@ip-lit.com

sschlather@ip-lit.com