

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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CANON U.S.A., INC.  
Petitioner

v.

CELLSPIN SOFT, INC.  
Patent Owner

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U.S. Patent No. 9,258,698  
*Inter Partes Review* No. 2019-00127

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**CANON'S SUR-REPLY IN SUPPORT OF  
ITS OPPOSITION TO  
GOPRO AND GARMIN'S MOTION FOR JOINDER  
FILED IN IPR2019-01107**

**As Authorized by the Board via Email Dated August 6, 2019**

As authorized by the Board, *see* Ex. 1034, Canon respectfully submits this Sur-Reply to respond to two arguments raised in GoPro/Garmin's Reply in support of their Motion for Joinder.

First, GoPro/Garmin argue that the Board granted joinder under "similar facts" in *Priceline.com LLC & Booking.com B.V. v. DDR Holdings LLC*, IPR2019-00440. Reply at 2. This argument is incorrect. In *Priceline*, the original petitioner did *not* oppose joinder. *Priceline*, Paper 4 at 2-3 (Dec. 14, 2018). The Board considered only whether the *Phillips* standard would adversely impact the *patent owner* and determined it would not. *Id.*, Paper 9 at 9 n.3. In the present case, Canon *does* oppose joinder and has identified specific reasons why different claim construction standards would lead to increased complexity, uncertainty, and prejudice to Canon. Opp. at 5-11. Although GoPro/Garmin argue that new claim construction issues under the *Phillips* standard are only a possibility, they do not dispute the complexity, uncertainty, and prejudice that would result if such issues arise.<sup>1</sup> Reply at 1-4. Nor do they propose any mechanism for dealing with such

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<sup>1</sup> Patent Owner has not represented that it will refrain from raising new claim constructions in its preliminary response to GoPro/Garmin's petition, and in any event, new constructions could arise later in the proceeding. *See* 77 Fed. Reg. 48680, 48700 (Comment 40 and Response to same).

issues, in order to maintain the current briefing and procedural schedule. *Id.* Thus, they have failed to meet their burden to show joinder is appropriate. Opp. at 5-8.

Second, Canon is not advocating for a “*per se* rule” against joinder when there are different claim construction standards at issue. Reply at 4-5. Canon is asking the Board to deny joinder based on the facts of this case, where there is a legitimate risk of joinder complicating the proceeding, and where GoPro/Garmin created that risk by failing to comply with the one-year bar date under 35 U.S.C. § 315(b). Opp. at 10-11. Canon had no control over GoPro/Garmin’s decision to file after the one-year bar date, and Canon should not have to suffer the prejudice that could result from that decision. GoPro/Garmin’s Motion and Reply do not set forth an explanation to justify the delay. Nor do they make any effort to show that the proceedings in the graph on page five of the Reply involved the same delay by the party seeking joinder (or even that the proceedings involved different claim construction standards). Reply at 5. Accordingly, the Board should reject GoPro/Garmin’s “*per se* rule” argument.<sup>2</sup>

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<sup>2</sup> Even if Canon were advocating for a *per se* rule, the rule would apply only in the narrow circumstances where the first petition was filed before November 13, 2018, and the second petition was filed on or after that date. Moreover, the rule would have no applicability after June 12, 2019, the deadline to join a BRI petition.

Respectfully submitted,

Date: August 13, 2019

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**CERTIFICATE OF SERVICE**

I hereby certify that on August 13, 2019, a copy of the foregoing sur-reply was served by filing this document through the PTAB's E2E Filing System as well as delivery a copy via electronic mail to the following:

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