

UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners,

v.

CELLSPIN SOFT, INC.

Patent Owner.

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U.S. Patent No. 9,258,698  
*Inter Partes* Review No. IPR2019-01107

**REPLY TO MOTION FOR JOINDER  
TO RELATED *INTER PARTES* REVIEW IPR2019-00127**

## I. INTRODUCTION

The sole basis for Canon U.S.A., Inc.’s opposition to the Motion for Joinder is the different claim constructions standards due to the timing of filing Canon’s Petition for IPR (IPR2019-00127 or the “Canon IPR”) versus present Petition. Canon hypothesizes the Canon IPR may be impacted by the different claim construction standards. Paper 13, 5-6. Importantly, Canon provides no actual evidence regarding the different claim construction standards will affect the Canon IPR nor does Canon identify any tangible prejudice to Canon. Because the Board has refused to preclude joinder in similar situations, and because Canon’s alleged prejudice is hypothetical at best, joinder is appropriate.

## II. THE DIFFERENT CLAIM CONSTRUCTION STANDARDS WILL HAVE NO MATERIAL IMPACT ON THE CANON IPR

### A. Canon Speculates the Different Standards Will Impact the Canon IPR Without Identifying Actual Harm

In the GoPro/Garmin IPR Petition, Petitioners GoPro, Inc., Garmin International, Inc., and Garmin USA, Inc., noted the different claim construction standards applicable to the Canon IPR (filed before November 13, 2018) and the present IPR (filed after November 13, 2018). Paper 1, 18. GoPro/Garmin stated: “Petitioners submit that any proposed constructions are at least included within the scope of either standard, and as such, the applicable standard does not affect any proposed claim constructions.” *Id.*; see also Paper 4, *Motion for Joinder*, at 4

(“Regarding the claim construction standards (i.e., *BRI vs. Phillips*), any proposed constructions in the Canon IPR are at least included within the scope of either standard. Therefore, the difference in standards should not have any material effect on whether joinder is appropriate.”)

Canon complains that due to the different standards “the issues in this proceeding *may* have to be decided under both standards . . . .” Paper 13, 1 (emphasis added). Canon does not identify any claim term that would have different constructions under the different standards. Nor does Canon identify any actual harm that would result from the different standards. Canon merely speculates that the different claim construction standards may complicate the proceedings. *Id.*; see also *id.*, 2 (referring to the “possibility” of Patent Owner Cellspin presenting new arguments under the *Phillips* standard). Canon’s own argument that the issues in the proceeding *may* have to be decided under both standards make clear the hypothetical nature of Canon’s complaint. Canon cannot point to any claim term that would be impacted by the different construction standards, let alone how any alleged difference would result in different unpatentability analyses.

Under similar facts, the Board previously found joinder appropriate. *Priceline.com LLC and Booking.com B.V. v. DDR Holdings, LLC*, IPR2019-0040, Paper 9 at 8-9, n. 3 (P.T.A.B. Jun. 10, 2019). In *Priceline*, the original petition was filed under the BRI standard, whereas the joinder Petition was filed under the

*Phillips* standard. *Id.* Joinder petitioner submitted the different claim construction standards would not change the outcome of the original IPR. *Id.* The Board agreed and instituted the joinder IPR and joined with the original related IPR. *Id.*

The same analysis applies in the present IPR. Any proposed constructions are at least included within the scope of either standard. Paper 4, 4. Therefore, the different claim construction standards will have no material impact on the IPR.

Joinder is also appropriate because Canon does not identify any claim construction that would be impacted by the different standards. In the Canon IPR, Canon did not propose any claim constructions in the Petition. *Canon U.S.A., Inc. v. Cellspin Soft, Inc.*, IPR2019-00127, Paper 1, 17-18 (P.T.A.B. Oct. 30, 2018). In the Preliminary Response, Patent Owner Cellspin construed two terms, “paired” and “cryptographically authenticating.” *Id.*, Paper 6, 13-16. In the Institution Decision, the Board noted Canon did not expressly construe any claim, stating “[w]e proceed on the understanding that Petitioner [Canon] did not identify any dispute regarding claim construction and relies on the plain and ordinary meaning of the claim terms to a person of ordinary skill in the art.” *Id.*, Paper 7, 10. The Board determined it did not need to construe “paired” for purposes of institution. *Id.* For the term “cryptographically authenticating,” the Board provided a construction. *Id.*, 12.

At this juncture in the Canon IPR, Canon, Cellspin, and the Board have all had an opportunity to weigh in on any desired claim constructions. Even for the

single claim construction presented by the Board (i.e., “cryptographically authenticating”), Canon does not indicate in its Opposition that the construction would be different under *Phillips*. Canon merely speculates about “the possibility” that Cellspin will present a new construction. Paper 13, 6. Although this is doubtful given the constructions proposed to-date, GoPro/Garmin reiterate that any proposed or adopted constructions in the Canon IPR are at least included within the scope of either standard. Therefore, application of the *Phillips* standard does not materially impact the Canon IPR.

**B. Canon Proposes a *Per Se* Rule Against Joinder if Different Claim Construction Standards Apply**

Canon is advocating for a per se rule that for any IPR filed after November 13, 2018, and seeking joinder with an IPR filed before such date, joinder should automatically be denied due to the different construction standards. *See* Paper 13, 6-7. This is inconsistent with the Board’s joinder practice since the claim construction rule change. Based on a search of joinder motions filed since the November 13, 2018 rule change (using Docket Navigator), counsel for GoPro/Garmin identified 36 joinder motions, with 25 of the motions being granted or partially granted. This alone shows that the Board routinely grants joinder even though the joinder IPR is filed under a different claim construction standard.

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