

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC.,
Petitioner,

v.

JAWBONE INNOVATIONS, LLC,
Patent Owner.

IPR2023-00559
Patent 8,503,691 B2

Before GEORGIANNA W. BRADEN, STEVEN M. AMUNDSON, and
JASON M. REPKO, *Administrative Patent Judges*.

REPKO, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b)

I. INTRODUCTION

Amazon.com, Inc. (“Petitioner”) filed a petition requesting *inter partes* review of claims 1–22 and 29–40 of U.S. Patent No. 8,503,691 B2 (Ex. 1001, “the ’691 patent”). Paper 1 (“Pet.”). Jawbone Innovations, LLC (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”).

Petitioner also filed a Motion for Joinder to join as a petitioner in IPR2022-01060. Paper 2 (“Mot.” or “Motion”). Patent Owner did not file an opposition to the Motion for Joinder.

We determine institution is warranted on the same grounds as instituted in IPR2022-01060, and we grant Petitioner’s Motion for Joinder. Our reasoning follows.

A. *Related Proceedings*

The parties identify the following proceedings as related: *Jawbone Innovations, LLC v. Amazon.com Inc.*, 3:22-cv-06727 (N.D. Cal. filed Nov. 29, 2021), IPR2022-01060, and IPR2022-01061. Pet. 84; Paper 7, 2. Patent Owner also identifies *Jawbone Innovations, LLC v. Google LLC*, 3:23-cv-00466 (N.D. Cal.) and IPR2023-00561. Paper 7, 2. Petitioner also identifies the following related proceedings: *Jawbone Innovations, LLC v. Apple Inc.*, No. 6:21-cv-00984 (W.D. Tex. filed Sept. 23, 2021), *Jawbone Innovations, LLC v. Google LLC*, No. 6:21-cv-00985 (W.D. Tex. filed Sept. 23, 2021), *Jawbone Innovations, LLC v. Samsung Elecs.*, No. 2:21-cv-00186 (E.D. Tex. filed May 27, 2021), IPR2022-01322, and IPR2022-01323. Pet. 84.

B. Claims

Claims 1 and 29 are independent. Claims 2–22 depend directly or indirectly from claim 1. Claims 30–40 depend directly or indirectly from claim 29. Claim 1 is reproduced below.

1. A microphone array comprising:

a first virtual microphone comprising a first combination of a first microphone signal and a second microphone signal, the first virtual microphone having a first linear response to speech and a first linear response to noise, the first linear response to speech being substantially similar across a plurality of frequencies for a speech source located at an angle relative to an axis of the microphone array, wherein the first microphone signal is generated by a first physical microphone and the second microphone signal is generated by a second physical microphone; and

a second virtual microphone comprising a second combination of the first microphone signal and the second microphone signal, the second virtual microphone having a second linear response to speech and a second linear response to noise, the second linear response to noise being substantially similar to the first linear response to noise, and the second linear response to speech being substantially dissimilar to the first linear response to speech,

wherein at least one of the first linear response to noise and the second linear response to [noise]¹ is being non-zero in a direction towards a source of noise.

Ex. 1001, 34:27–50.

¹ In a Certificate of Correction dated August 6, 2013, the word “noise” was added between “response to” and “is being non-zero” at column 34, line number 49. Ex. 1002, 319.

C. IPR2022-01060

In a petition for *inter partes* review, Google LLC challenged claims 1–22 and 29–40 of the ’691 patent. IPR2022-01060, Paper 1 (“Google IPR”). After considering the Petition and Patent Owner’s Preliminary Response, the Board instituted review of the claims challenged in that case on the grounds in the table below. *Id.*, Paper 12 at 9 (“Google Inst.”).

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–22, 29–40	103(a) ²	Kanamori, ³ McCowan ⁴

Google LLC also relied on the Declaration of Jeffrey S. Vipperman, Ph.D. *See id.* (citing Ex. 1003).

II. ANALYSIS

In an *inter partes* review (IPR), joinder is governed by 35 U.S.C. § 315(c), which states:

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

² Congress amended section 103 when it passed the Leahy-Smith America Invents Act (AIA). Pub. L. No. 112–29, § 3(c), 125 Stat. 284, 287 (2011). The amendment was effective March 16, 2013. The ’691 patent has a filing date earlier than March 16, 2013. *See* Ex. 1001, code (22). Thus, the pre-AIA version of § 103 applies.

³ U.S. Patent Application No. 2004/0185804 A1, published Sept. 23, 2004 (Ex. 1005, “Kanamori”).

⁴ Iain A. McCowan et al., *Near-Field Adaptive Beamformer for Robust Speech Recognition*, 12(1) Digital Signal Processing, (2002), 87–106 (Ex. 1006, “McCowan”).

such a response, determines warrants the institution of an inter parties review under section 314.

This has been interpreted to mean that joining a party to an instituted IPR requires two different decisions: (1) “whether the joinder applicant’s petition for IPR ‘warrants’ institution under § 314” and (2) “whether to ‘join as a party’ the joinder applicant.” *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020) (citing 35 U.S.C. § 315(c)).

A. Whether Amazon’s Petition Warrants Institution

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless the information presented in the Petition shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” The patentability challenges in the Google IPR met the “reasonable likelihood” standard of § 314(a). Google Inst. 38.

According to Petitioner, its Petition is “substantively identical to Google’s petition,” and “the facts, citations, evidence, or arguments presented in the grounds for unpatentability” are the same as those in Google’s petition. Mot. 4. Petitioner asserts that the differences between the Petitions are minor, relating to “(a) the procedural formalities of having a different Petitioner file the Petition, and (b) changes to arguments regarding discretionary denial under § 314(a) that result from a different co-pending litigation.” *Id.*

Patent Owner does not address whether Petitioner’s assertions are accurate. *See generally* Prelim. Resp. Rather, Patent Owner makes the same substantive arguments as in the Google IPR. *Compare* Prelim. Resp., *with* IPR2022-01060, Paper 7.

From our comparison of the Petition in this proceeding to the one filed in the Google IPR, we agree with Petitioner that they are “substantially identical” with only minor differences. *Compare* Pet., with IPR2022-01060, Paper 1. Also, from our comparison of Patent Owner’s preliminary responses filed in this proceeding and the Google IPR, we see no material difference between the arguments raised in those respective preliminary responses. *Compare* Prelim. Resp. 7–14 (addressing merits of Petitioner’s unpatentability challenges), with IPR2022-01060, Paper 7, 6–12 (addressing merits of unpatentability challenges in the Google IPR). Thus, for the reasons in our Decision Instituting Review in IPR2022-01060, we find that the Petition in this proceeding also warrants institution of *inter partes* review. *See* Google Inst. 18–38.

B. Whether the Motion for Joinder Should be Granted

“The statute makes clear that the joinder decision is made *after* a determination that a petition warrants institution, thereby affecting the manner in which an IPR will proceed.” *Facebook*, 973 F.3d at 1332 (citing 35 U.S.C. § 315(c)).

Here, Patent Owner did not file an opposition to Petitioner’s Motion for Joinder. Even so, as the moving party, Petitioner has the burden of proof to show that it is entitled to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b) (2023).

Petitioner argues that its Motion is timely and should be granted. Mot. 1. Petitioner asserts that it does not propose any new ground of unpatentability and challenges the same claims. *Id.* at 5. According to Petitioner, joinder is appropriate because “the Board can efficiently resolve identical challenges in a single proceeding.” *Id.* at 4. Petitioner argues that,

because its petition is “substantively identical to Google’s, there are no new issues for Patent Owner to address and therefore no reason joinder will unduly burden or negatively affect the schedule in that proceeding in any way.” *Id.* at 5. Petitioner argues that joinder will simplify briefing and discovery because “Petitioner agrees to take an ‘understudy’ role” by adhering to the restrictions that the Board has approved in other cases. *Id.* at 5–6 (citing *Mylan Pharms. Inc. v. Novartis AG*, IPR2015-00268, Paper 17 at 5 (PTAB Apr. 10, 2015)).

Under the present circumstances, we agree with Petitioner that joinder is appropriate and will not unduly impact the ongoing trial in IPR2022-01060. Still, we impose the following restrictions to ensure minimal impact on the trial schedule, cost, discovery, and potential briefing:

(1) Google LLC alone is responsible for all petitioner filings in the joined proceeding until such time that it is no longer an entity in the joined proceeding;

(2) Amazon.com, Inc. is bound by all Google LLC’s filings in the joined proceeding, except for (a) filings regarding termination or settlement and (b) filings where Amazon.com, Inc. receives permission to file an independent paper; and

(3) Amazon.com, Inc. must obtain prior Board authorization to file any paper or to take any action on its own in the joined proceeding while Google LLC remains as a non-terminated petitioner in the joined proceeding.

This arrangement promotes the just and efficient administration of the ongoing trial in IPR2022-01060 and protects the interests of Patent Owner and of Google LLC as the original petitioner in IPR2022-01060. Thus,

Petitioner's Motion for Joinder is *granted* with the restrictions discussed above.

III. ORDER

It is:

ORDERED that *inter partes* review is *instituted* as to all challenged claims and all grounds in the Petition;

FURTHER ORDERED that Petitioner's Motion for Joinder is *granted*;

FURTHER ORDERED that IPR2023-00559 is *joined* with IPR2022-01060 ("the joined proceeding");

FURTHER ORDERED that all future filings in the joined proceeding must be made only in IPR2022-01060;

FURTHER ORDERED that Amazon, Inc.'s participation in the joined proceeding will be limited by the conditions set forth in this Order unless Google LLC ceases to participate as a petitioner;

FURTHER ORDERED that the Scheduling Order in place for IPR2022-01060 (Paper 13) will govern the joined proceeding;

FURTHER ORDERED that the case caption in IPR2022-01060 for all further submissions must add Amazon.com, Inc. as a named Petitioner after Google LLC and must indicate by footnote the joinder of Amazon.com, Inc. as a party;⁵ and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2022-01060.

⁵ An example case caption is appended to this Decision.

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Sample Case Caption

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⁶ Amazon.com, Inc., which filed a petition in IPR2023-00559, has been joined as a party to this proceeding.