

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY ELECTRONICS INC.,

Petitioner,

v.

JAWBONE INNOVATIONS, LLC,

Patent Owner.

Patent No. 10,779,080

Filing Date: July 22, 2013

Issue Date: September 15, 2020

Inventor: Gregory C. Burnett

Title: DUAL OMNIDIRECTIONAL MICROPHONE
ARRAY (DOMA)

**PATENT OWNER'S
OPPOSITION TO PETITIONER'S MOTION FOR JOINDER**

Case No. IPR2023-01065

EXHIBIT LIST

Exhibit No.	Description of Document
2001	Scheduling Order, Paper No. 13, <i>Google LLC v. Jawbone Innovations, LLC</i> , Case No. IPR2022-01059, entered December 7, 2022

TABLE OF CONTENTS

	<u>Page(s)</u>
I. INTRODUCTION	1
II. ARGUMENT	2
A. Legal Standard.....	2
B. Granting Joinder to the Amazon IPR Is Inappropriate Because It Will Be Ineffective	3
C. Joinder Is Not Appropriate Because Sony’s Motion Is Far Outside the One-Month Window to Join the Google IPR	4
D. Granting Joinder Will Not Simplify the Briefing or Discovery in the Google IPR	5
E. Granting Joinder Will Frustrate Settlement Negotiations.....	6
F. Patent Owner Will Address Whether Petitioner’s Petition Warrants Institution in its Preliminary Response	6
III. CONCLUSION.....	7

I. INTRODUCTION

On June 15, 2023, Petitioner Sony Electronics Inc. (“Petitioner”) filed a Petition for *Inter Partes* Review (Paper 1, “Petition”) against U.S. Patent No. 10,779,080 (Ex. 1001, the “’080 Patent”). At the same time, Petitioner filed a “Motion For Joinder To And Consolidation With Related *Inter Partes* Review IPR2023-00284 Pursuant To 35 U.S.C. § 315(c) And 37 C.F.R § 42.122(b)” seeking to join IPR2023-00284 (the “Amazon IPR”). Paper No. 3 (“Motion”).

However, Sony is actually attempting to join another, third, IPR (IPR2022-01059 (the “Google IPR”)) that was instituted on December 7, 2022, far outside the one-month joinder window under the Board’s Rules. 37 C.F.R. § 42.122(b) (“Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested.”). Indeed, Amazon itself in the Amazon IPR timely requested to join the Google IPR as a party. The Board granted Amazon’s Motion on May 15, 2023. Amazon IPR, Paper No. 12 (P.T.A.B. May 15, 2023). Amazon is now a party to the Google IPR, and no further filings are permitted in the Amazon IPR. *Id.*, 11-12.

The Board should thus deny Petitioner’s Motion because it violates the Board’s one-month deadline for joinder, without providing good cause for the Board to suspend its rules, and because the Amazon IPR—to which Sony seeks to join—will not be active.

II. ARGUMENT

A. Legal Standard

“To join a party to an instituted IPR, the plain language of § 315(c) requires two different decisions.” *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). The first decision is “whether the joinder [to] applicant’s petition for IPR ‘warrants’ institution under § 314.” The second is “whether to ‘join as a party’ the joinder applicant.” *Id.* “Joinder may be authorized when warranted, but the decision to grant joinder is discretionary.” *Sony Corp. of Am. v. Network-1 Sec. Sols., Inc.*, IPR2013-00386, Paper 16, 3 (P.T.A.B. Jul. 29, 2013). “The fact that the [Director or his delegate the] Board has the *discretion* to join a party does not mean that joinder is automatic, particularly given the need to complete proceedings in a just, speedy, and inexpensive manner.” *Dell Inc. v. Network-1 Sec. Sols., Inc.*, IPR2013-00385, Paper 17, 6 (P.T.A.B. July 29, 2013).

As the moving party, Petitioner has the burden of proof to establish that joinder is appropriate. 37 C.F.R. §§ 42.20(c), 42.122(b). When considering a motion for joinder, the Board examines factors including: (1) reasons why joinder is appropriate; (2) any new grounds of unpatentability asserted in the petition; (3) what impact (if any) joinder would have on the trial schedule for the existing review; and (4) specifically how briefing and discovery may be simplified. *See Dell Inc.*, IPR2013-00385, Paper 17 at 3.

**B. Granting Joinder to the Amazon IPR Is Inappropriate
Because It Will Be Ineffective**

The Board granted Amazon’s Motion to join it as a party to the Google IPR on May 15, 2023. Amazon IPR, Paper No. 12. When it did so, it specifically ordered that all further filings should be made only in the Google IPR. *Id.* at 12 (“FURTHER ORDERED that all future filings in the joined proceeding shall be made only in IPR2022-01059”).

Amazon did not request, and the Board did not order, for the Amazon IPR to be consolidated with the Google IPR pursuant to 35 U.S.C. § 315(d). As the Federal Circuit has held, the joinder statute, § 315(c) does not permit two *proceedings* to be joined. *Facebook, Inc.*, 973 F.3d at 1334 (“the unambiguous language of § 315(c) does not provide for two proceedings to be joined”). In other words, the Board’s decision granting Amazon’s Motion did not combine the Amazon and Google IPRs. The Board’s sample case caption provided in the Order reflects this. Amazon IPR, Paper No. 12 at 15 n.6 (“Amazon.com, Inc., which filed a petition in IPR2023-00284, has been joined as a party to this proceeding.”).

Thus, the Amazon IPR is quiescent, and joining Sony to that proceeding would be ineffective. The Board should, therefore, deny Sony’s Motion because joinder is not appropriate.

C. Joinder Is Not Appropriate Because Sony’s Motion Is Far Outside the One-Month Window to Join the Google IPR

The Google IPR is extremely advanced, with Patent Owner’s sur-reply filed on July 7, 2023. Oral argument, if requested, will be held on September 5, 2023. Ex. 2001 at 11. The deadline to join the Google IPR as a party was one month after its December 7, 2022 institution date—January 7, 2023. Sony waited until June 15, 2023, five months after the deadline, to file the instant Motion.

The Board has previously held that attempts to daisy-chain earlier joinders, like Sony’s Motion, are untimely. *E.g., Sony Corp. of Am. v. Network-1 Sec. Sols., Inc.*, IPR2013-00495, Paper No. 13 at 4 (P.T.A.B. Sept. 16, 2013). There, Petitioners sought to join a proceeding that was itself joined to an earlier instituted IPR. The Board rejected that argument. *Id.* (“We agree with Network-1 and Avaya that Petitioners’ request for joinder was filed after the one-month period set forth in 37 C.F.R. § 42.122(b).”). While the Board allowed joinder to the earliest proceeding in the *Sony* case, it noted that there were specific circumstances that made it proper, such as that “Petitioners attempted previously—within the one-month time period—to be joined to” the earliest IPR. *Id.* at 7. *See also Apple Inc. v. RFCyber Corp.*, PGR2022-00003, Paper No. 10 at 6 (P.T.A.B. Mar. 24, 2022) (distinguishing *Sony Corp.* because “In *Sony Corp.*, the Board determined that the fact that the petitioners had attempted previously—within the one-month period—to be joined to the

proceeding weighed in favor of considering the joinder request outside the one-month period.”). Accordingly, Sony’s Motion is untimely.

Sony has not set forth any good cause to suspend the Board’s rules and allow a late joinder. There is no such good cause. *See id.* at 6 (noting the “unique facts” in *Sony* that justified suspending the one-month window). By joining at this late stage, after nearly all substantive work is complete, Sony seeks to free ride on the work done by Patent Owner and the Petitioners in the Google and Amazon IPRs. Indeed, when drafting the Rules, the Board rejected a proposal to allow joinder at any point before a Final Written Decision. *See* 77 Fed. Reg. 48680, 48707 (Aug. 14, 2012) (noting comment that “suggested that the Office permit joinder and replacement until the time of a final written decision” and responding that “[j]oinder may be requested . . . within one month of the date that the trial is instituted”). Accordingly, joinder is not appropriate and the Board should deny Sony’s Motion as untimely. *Apple*, PGR2022-00003, Paper No. 10 at 8.

D. Granting Joinder Will Not Simplify the Briefing or Discovery in the Google IPR

As discussed above, the Google IPR is in an advanced state, with all substantive briefing completed. No further discovery is allowable under the Google IPR Scheduling Order. Ex. 2001. Thus, allowing joinder will not simplify any briefing or discovery. *Id.* “Joinder may be authorized when warranted, but the

decision to grant joinder is discretionary.” *Sony Corp.*, IPR2013-00386, Paper 16, 3.

E. Granting Joinder Will Frustrate Settlement Negotiations

The statute, as well as the Board, prioritizes settlement. For example, the IPR statute governing settlement states that IPRs “shall be terminated” upon a motion to terminate based on settlement. Similarly, the Board’s Trial Practice Guide states that “There are strong public policy reasons to favor settlement between the parties to a proceeding.” Patent Trial and Appeal Board Consolidated Trial Practice Guide at 86 (Nov. 2019) (“TPG”). Accordingly, the “Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” *Id.*

Here, allowing joinder would disincentivize settlement because the parties currently expect that the Amazon and Google IPRs would terminate if an agreement is reached with those parties. It would be unfair to allow Sony to belatedly join those IPRs, without making any substantive input to them, and thus frustrate the expectations of the actual parties. Thus, the Board should deny joinder in its discretion.

F. Patent Owner Will Address Whether Petitioner’s Petition Warrants Institution in its Preliminary Response

Patent Owner is preparing its Patent Owner Preliminary Response which will

address whether Petitioner's Petition warrants institution. A Petition that does not warrant institution cannot join another proceeding. *Facebook, Inc.*, 973 F.3d at 1332 ("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.").

III. CONCLUSION

Sony's Motion is untimely, and Sony has not requested or provided any reason for the Board to suspend its rules and allow the untimely request. Moreover, allowing joinder will not simplify any briefing or discovery. Accordingly, the Board should deny the Motion.

Respectfully submitted,

Dated: July 17, 2023

By: /Vincent J. Rubino, III /
Vincent J. Rubino, III (Reg. No. 68,594)
FABRICANT LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580
Tel. 212-257-5797
Fax. 212-257-5796
Email: vrubino@fabricantllp.com

CERTIFICATE OF SERVICE

A copy of the foregoing Patent Owner's Opposition To Petitioner's Motion For Joinder and Exhibit 2001 has been served on Petitioner's counsel of record as follows:

Gregory S. Gewirtz
Email: ggewirtz@lernerdavid.com
Email: litigation@lernerdavid.com
Russell W. Faegenburg
Email: rfaegenburg@lernerdavid.com
LERNER DAVID LLP
20 Commerce Drive
Cranford, New Jersey 07016

Attorneys for Sony Electronics Inc.

July 17, 2023

By: /Vincent J. Rubino, III /
Vincent J. Rubino, III (Reg. No. 68,594)
FABRICANT LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580
Tel. 212-257-5797
Fax. 212-257-5796
Email: vrubino@fabricantllp.com