UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY ELECTRONICS INC.,
Petitioner,

v.

JAWBONE INNOVATIONS, LLC,
Patent Owner.

IPR2023-01153
U.S. Patent No. 11,122,357

MOTION FOR JOINDER TO AND CONSOLIDATION WITH RELATED *INTER PARTES* REVIEW IPR2023-00251 PURSUANT TO 35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)

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I. INTRODUCTION

Sony Electronics Inc. ("Petitioner" or "Sony") respectfully submits this Motion for Joinder, together with a Petition for *Inter Partes* Review ("IPR") of U.S. Patent No. 11,122,357 ("the '357 Patent") filed contemporaneously herewith. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner requests institution of this IPR, and joinder and consolidation with IPR2023-00251 ("the Amazon IPR"). That IPR challenges the same claims and was instituted on June 1, 2023.

Joinder here would be consistent with the overarching policy of securing "the just, speedy, and inexpensive resolution" of every IPR proceeding. 37 C.F.R. § 42.1(b). Petitioner's Petition and the Amazon petition are substantively identical—they contain the same grounds, based on the same prior art combinations against the same claims. Thus, joinder would not unduly complicate the Amazon IPR, nor delay the schedule of that proceeding.

To streamline discovery and briefing, Petitioner agrees to take an understudy role, as Amazon did in its now-granted motion for joinder. Petitioner will not actively participate substantively in the Amazon IPR unless Amazon terminates its involvement and thus is unavailable to take the lead in that proceeding.

Because joinder would promote judicial efficiency in determining patentability without prejudicing Patent Owner, the Board should grant this Motion.

II. STATEMENT OF FACTS

Patent Owner filed suit against Samsung on May 27, 2021, asserting seven patents. (Case No. 2:21-cv-00186, E.D. Tex.) Patent Owner filed suits against Apple and Google on September 23, 2021, and asserted nine patents against each of them, including the seven patents also asserted against Samsung. (Case Nos. 6:21-cv-00985 and 6:21-cv-00984, W.D. Tex.) Patent Owner filed suit against Amazon on Nov. 29, 2021, and asserted the same nine patents. (Case No. 2:21-cv-00435, E.D. Tex., transferred to Case No. 5:22-cv-06727, N.D. Cal.).

On February 28, 2023, Patent Owner filed suit against Petitioner, asserting eight of the nine patents included in the suit against Amazon, including the ’357 Patent. (Case No. 2:23-cv-01161-CCC-LDW, D.N.J., ECF No. 1.) Petitioner was served with the complaint on March 16, 2023. (*Id.*, ECF No. 5, at 2.)

Samsung, Apple, Google and Amazon have filed IPR Petitions against each of the patents asserted against them. Amazon filed a petition for IPR challenging the ’357 Patent on November 21, 2022. The Board instituted Amazon’s IPR on June 1, 2023. IPR2023-00251, Paper 7, at 2 (PTAB June 1, 2023). Petitioner is filing a substantively identical petition to that previously filed by Amazon, and is seeking joinder to Amazon’s now-instituted IPR.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Board has the authority to join Petitioner as a party to the Amazon IPR. 35 U.S.C. § 315(c); *see also* 35 U.S.C. § 315(d) (Board also has the authority to consolidate proceedings). Whether a request for joinder should be granted is discretionary. *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15, at 4 (PTAB, Apr. 24, 2013).

B. Petitioner's Motion for Joinder is Timely

A petitioner may request joinder "no later than one month after the institution date of any *inter partes* review for which joinder is requested." 37 C.F.R. § 42.122(b). This is the "only timing requirement for a motion for joinder." *Cent. Sec. Grp.-Nationwide, Inc. v. Ubiquitous Connectivity, LP*, IPR2019-01609, Paper 11, at 8-9 (PTAB Feb. 26, 2020).

This Motion for Joinder is timely. Amazon's IPR was instituted June 1, 2023, and Petitioner brings this motion within one month of that institution. Thus, although Sony is not otherwise time-barred pursuant to 37 C.F.R. § 42.101(b), Petitioner is filing its motion for joinder within the time limit set forth in 37 C.F.R. § 42.122(b).

C. The Board Should Permit Joinder

In deciding whether to exercise its discretion and permit joinder, the Board considers: (1) why joinder is appropriate; (2) whether the new petition presents any

new grounds of unpatentability; (3) any impact joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *Kyocera*, IPR 2013-00004, Paper 15, at 4 (Apr. 24, 2013). Here, each of the four factors weighs in favor of joinder.

1. Joinder is Appropriate

Joinder is appropriate here because the concurrently filed Petition involves the same patent, challenges the same claims, relies on the same exhibits, and is based on the same grounds and combinations of prior art submitted in the Amazon IPR. The concurrently filed Petition is substantively identical to the Amazon petition, containing only minor differences 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. There are no changes to the facts, citations, evidence, or arguments presented in the grounds for unpatentability set forth in the Amazon petition. Because the proceedings are substantively identical, good cause exists for joining Petitioner as a party to the Amazon IPR and consolidating with the proceedings in that IPR, so that the Board can efficiently resolve identical challenges in a single proceeding. *Cent. Sec. Grp.*, IPR2019-01609, Paper 11, at 8; *ZyXEL*, IPR2021-00739, Paper 17, at 20.

This efficiency gain extends to the litigation. In the Petition, Petitioner stipulates that, if Petitioner's Petition is instituted, then Petitioner will not pursue the

grounds identified in its Petition in the district court. Thus, joinder will ensure that the grounds presented in the Amazon IPR are not inefficiently and unnecessarily adjudicated in another forum (*e.g.*, the district court litigation involving Petitioner).

Because joinder will increase efficiency and reduce duplicative proceedings involving the same patentability challenges, this factor favors joinder.

2. Petitioner Proposes No New Grounds Of Unpatentability

The concurrently filed Petition presents the same grounds of unpatentability as the Amazon petition and challenges the same claims. Therefore, Petitioners do not propose any new grounds of unpatentability and this factor also favors joinder.

3. Joinder Will Not Unduly Burden Or Negatively Impact The Amazon IPR Trial Schedule

Because Petitioner's Petition is substantively identical to the Amazon Petition—presenting the same grounds and challenging the same claims using the same evidence—there are no new issues for Patent Owner to address. Further, joinder with the Amazon IPR will not unduly burden or negatively impact the schedule in that proceeding in any way. Thus, this factor also favors joinder. *Sony Corp. v. Memory Integrity, LLC*, IPR2015-01353 Paper 11, at 6 (granting motion where joinder does "not necessitate any additional briefing or discovery from Patent Owner beyond that already required [by the original IPR]").

4. How Briefing and Discovery May Be Simplified

The concurrently filed Petition and the Amazon petition present substantively identical grounds of unpatentability, including the same combinations of art against the same claims. Additionally, if this motion for joinder is granted, Petitioners agree to take an "understudy" role, adhering to the same restrictions that the Board imposed on Amazon as a condition to joinder in another IPR involving another patent of the Patent Owner directed to related subject matter. (*See* IPR2023-00284 Paper No. 12, at 11-12.) Thus, Petitioners agree that:

> (1) [Amazon] 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, and (2) [Sony] is bound by all filings by [Amazon] in the joined proceeding, except for (a) filings regarding termination or settlement and (b) filings where [Sony] receives permission to file an independent paper. [Sony] must obtain prior Board authorization to file any paper or to take any action on its own in the joined proceeding, so long as [Amazon] remains as a non-terminated petitioner in the joined proceeding.

(*Id.* at 11.)

Sony also agrees that if it is joined as a party to the Amazon IPR, it will be bound by any agreements between the Patent Owner and Amazon regarding discovery and/or depositions in the IPR, and Sony will not seek additional depositions or deposition time. *See Mylan Pharms. Inc. v. Novartis AG*, IPR2015-00268, Paper 17, at 5 (PTAB April 10, 2015) (emphasis in original); *Sony*,

IPR2015-01353, Paper 11, at 6 (granting joinder where petitioners requested an "understudy" role). Sony will assume the primary role only if Amazon terminates its involvement in the proceeding.

By joining Petitioner in the Amazon IPR and allowing Petitioner to take on an understudy role, both briefing and discovery will be simplified because Patent Owner can maintain its current trial schedule and avoid duplicative efforts. The understudy role will minimize any potential complications or delay that potentially could result by joinder, including duplicative discovery and filings. *Sony*, IPR2015-01353, Paper 11, at 6-7 ("joinder would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board" where petitioners sought an "understudy" role). Thus, this factor also favors joinder.

For the foregoing reasons, each of the factors that the Board considers in evaluating potential joinder weighs in favor of granting this Motion.

D. ***General Plastic* Is Inapplicable**

The *General Plastic* analysis is inapplicable to this joinder motion and concurrently filed Petition. In *General Plastic*, the Board set forth factors for analyzing follow-on petitions with a view toward conserving the Board's resources. *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017).

Here, Petitioner is not filing a follow-on petition that raises any new issue. Rather, Petitioner seeks to join the Amazon IPR as an understudy and does not present any new grounds. The Board has found that the *General Plastic* factors are "not particularly relevant" in this situation, *i.e.*, where a different petitioner files a "me-too" petition with a timely motion for joinder. *Cent. Sec. Grp.*, IPR2019-01609, Paper 11, at 8; *Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11, at 9-11 (PTAB Oct. 30, 2018).

Unlike in *Apple v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (PTAB Oct. 28, 2020) (precedential) ("*Uniloc*"), where joinder was denied, this is Sony's first IPR petition challenging the '357 Patent, and Sony's "me-too" petition is not otherwise time-barred, because it has until March 2024 to file an IPR petition. Accordingly, the factors that influenced the Board's application of the *General Plastic* factors in *Uniloc*—where the petitioner had already filed a previous petition, was time-barred from filing a second petition and sought to bring a second petition through joinder after denial of the first petition (*id.* at 4, 7)—are not present. In summary, the *General Plastic* factors do not apply in the present circumstances.

Even if the Board were to consider the *General Plastic* factors, they would weigh in favor of institution. With respect to factor 1, Petitioner has not previously filed a petition against the '357 Patent. Petitioner and the prior petitioners are not the

same party and have no significant relationship. They are competitors accused of infringement—in different actions pending in different courts—based on sales of different products. This weighs against denial. *NetNut Ltd. v. Bright Data Ltd.*, IPR2021-00465, Paper 11, at 9 (PTAB Aug. 12, 2021) (declining to extend *General Plastic* and *Valve* to different petitioner with no relationship to previous petitioners); *Mercedes-Benz USA, LLC v. Carucel Invs. L.P.*, IPR2019-01404, Paper 12, at 11-12 (PTAB Jan. 22, 2020); *Toshiba Am. Info. Sys., Inc. v. Walletex Microelecs. Ltd.*, IPR2018-01538, Paper 11, at 20 (PTAB Mar. 5, 2019).

The second through fifth factors relate to timing issues that are largely irrelevant here. These factors are designed "to assess and weigh whether a petitioner should have or could have raised the new challenges earlier." *Google LLC v. Express Mobile, Inc.*, IPR2022-00597, Paper 17, at 8-9 (PTAB Aug. 19, 2022). But Petitioner does not bring any new challenges. Thus, when Petitioner learned of the prior art, whether Petitioner received Patent Owner's preliminary response or an institution decision, and the length of time between the filing of the petitions, are all irrelevant. Petitioner has substantively duplicated the Amazon IPR, alleging the same facts, grounds, and prior art, and has agreed to take an understudy role. Thus, factors two through five weigh against the Board's exercise of discretion to deny institution.

The sixth factor considers the Board's resources and the seventh factor relates to the Board's ability to meet the one-year statutory deadline. Allowing joinder here would not impact the Board's resources (beyond those dedicated to deciding this Motion), and would not impact the Board's ability to meet the one-year statutory deadline.

For the foregoing reasons, the *General Plastic* factors do not weigh against institution and joinder of Petitioner to the Amazon IPR.

IV. CONCLUSION

Petitioner respectfully requests that the Board institute Petitioner's concurrently filed IPR Petition, and then join Petitioner as a party to the Amazon IPR.

Respectfully submitted,

LERNER DAVID LLP

Dated: June 30, 2023

By: /Gregory S. Gewirtz/
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **MOTION FOR JOINDER TO AND CONSOLIDATION WITH RELATED *INTER PARTES* REVIEW IPR2023-00251 PURSUANT TO 35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)** was served in its entirety by filing these documents through the PTAB E2E System, as well as by Priority Overnight to the following correspondence address of record for Patent Owner on June 30, 2023, as follows.

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