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. 8,503,691
Filing Date: June 13, 2008
Issue Date: August 6, 2013

Inventor: Gregory C. Burnett
Title: VIRTUAL MICROPHONE ARRAYS USING DUAL OMNIDIRECTIONAL MICROPHONE ARRAY (DOMA)

PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION FOR JOINDER TO AND CONSOLIDATION WITH RELATED *INTER PARTES* REVIEW IPR2023-00559 PURSUANT TO 35 U.S.C. § 315(c) AND 37 C.F.R § 42.122(b)

Case No. IPR2023-01228

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I. INTRODUCTION

On July 20, 2023, Petitioner Sony Electronics Inc. ("Petitioner") filed a Petition for *Inter Partes* Review (Paper 1, "Petition") against U.S. Patent No. 8,503,691 (Ex. 1001, the "'691 Patent"). At the same time, Petitioner filed a "Motion For Joinder To And Consolidation With Related *Inter Partes* Review IPR2023-00559 Pursuant To 35 U.S.C. § 315(c) And 37 C.F.R § 42.122(b)" seeking to join IPR2023-00559 (the "Amazon IPR"). Paper No. 3 ("Motion").

The Board should deny Petitioner's Motion because the Amazon IPR has been terminated; thus, there is no proceeding to join. Even if the Board were inclined to join Sony to a terminated IPR, it would disrupt the Amazon's IPR schedule for no benefit.

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. Sony Cannot Join the Amazon IPR Because It Has Been Terminated

On August 10, 2023, the Board issued an Order terminating the Amazon IPR. *Amazon.com, Inc. v. Jawbone Innovations, LLC*, IPR2023-00559, Paper 13 (P.T.A.B. Aug. 10, 2023). Accordingly, since the Amazon IPR is no longer pending, "there is no proceeding for [Sony] to join." *ZTE (USA) LLC v. Seven Networks, LLC*, IPR2019-00460, Paper 18, 7 (P.T.A.B. Jun. 6, 2019). The Board should therefore deny the Motion. *Id.* at 5 ("Given that the Samsung IPR is no longer pending, it cannot serve as a proceeding to which this proceeding may be joined.").

C. Granting Joinder Would Disrupt the Amazon IPR Schedule

Even if the Board chose to join Sony to the terminated Amazon IPR, the Amazon IPR would suffer an unduly long delay. No discovery was conducted during the Amazon IPR. Thus joinder would require a new scheduling order, which weighs against joinder. *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (P.T.A.B. April 24, 2013).

Jawbone's Preliminary Response in this proceeding is due on October 24, 2023. "Generally, we decide whether joinder is appropriate 'after receiving a preliminary response under section 313,' when we determine whether institution of an *inter partes* review is warranted." *ZTE*, IPR2019-00460, Paper 18, 7. The Board often takes up to three months to issue an institution decision; thus an institution decision may not issue until January 2024. The resulting delay in the Amazon IPR would prevent the Board from concluding the proceeding within one year of institution. Accordingly, the key factor of whether joinder will impact the trial schedule weighs heavily against granting Petitioner's Motion. *Id.*, Paper 18, 7-8.

D. 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*, 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.") (citation omitted).

E. The *Gen. Plastic* Factors Weigh Against Joinder

The Board has clarified that discretionary factors must be considered before determining a joinder motion. *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9, 5 (P.T.A.B. Oct. 28, 2020) (precedential) ("Uniloc") ("before determining whether to join . . . even though the Petition is a 'me-too petition,' we first determine whether application of the *General Plastic* factors warrants the exercise of discretion to deny the Petition under §314(a)."); *see also Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, 15-19 (P.T.A.B. Sept. 6, 2017) (precedential). The *Gen. Plastic* factors weigh in favor of exercising discretion to deny the petition and joinder.

As to Factor 2, Petitioner refuses to indicate when it first learned of the references in the Petition. Motion at 11. Given Petitioner's failure to provide this information, it should be presumed that Petitioner was aware of the references long before filing this Petition. In any case, it was Petitioner's responsibility to explain when it learned of the references. This factor, accordingly, weighs in favor of denial. *Uniloc*, IPR2020-00854, Paper 9, at 9 ("Because of the lack of explanation, we

conclude that this second *General Plastic* factor weighs in favor of denying institution of the proceeding.”).

As to Factor 3, “whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition;” (*id.* at 7). Petitioner cannot deny that it had Patent Owner’s Preliminary Response in the Amazon IPR at the time it filed the Instant Petition. This factor, accordingly, weighs in favor of denial.

With respect to Factor 4, as discussed above, Petitioner does not state when it first learned of the references in the Petition. Motion at 11. Petitioner makes no substantive argument as to this factor and, accordingly, this factor weighs in favor of denial.

As to Factor 5, “whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent,” Petitioner makes no explanation for the elapsed time. *Uniloc*, IPR2020-00854, Paper 9, at 7.

Finally, Factors 6 and 7 weigh in favor of denial for the reasons stated above as to the increased complexity from joinder.

III. CONCLUSION

The Amazon IPR was terminated August 10, 2023; this alone justifies denial

of the Motion. Further, allowing joinder would needlessly disrupt and delay the proceedings in the Amazon IPR, and result in duplicative proceedings. Moreover, the *Gen. Plastic* factors favor denial of Petitioner's Petition and Motion. Accordingly, the Board should deny the Petitioner's Motion.

Respectfully submitted,

Dated: August 21, 2023 By: /*Peter Lambrianakos* /

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CERTIFICATE OF SERVICE

A copy of the foregoing Patent Owner's Opposition to Petitioner's Motion for Joinder to and Consolidation with Related *Inter Partes* Review IPR2023-00559 Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R § 42.122(b) has been served on Petitioner's counsel of record as follows:

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