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Paper No. 11
Entered: February 6, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY ELECTRONICS INC. and LG ELECTRONICS INC.,
Petitioner,

v.

JAWBONE INNOVATIONS, LLC,
Patent Owner.

IPR2023-01222
IPR2023-01248
Patent 8,467,543 B2

Before GEORGIANNA W. BRADEN, NORMAN H. BEAMER, and JASON M. REPKO, *Administrative Patent Judges.*

BEAMER, *Administrative Patent Judge*.

ORDER
Consolidation of Proceedings
35 U.S.C. § 315(d); 37 C.F.R. § 42.122(a)

In separate decisions, the Board instituted *inter partes* review in the above-listed proceedings. *See* IPR2023-01222, Paper 11 (PTAB Dec. 19, 2023); IPR2023-01248, Paper 9 (PTAB Dec. 19, 2023). The proceedings involve the same patent, same prior art, and largely the same arguments. Sony Electronics, Inc. ("Sony") and LG Electronics, Inc. ("LG") are Petitioners in the above-listed proceedings.

The Petitioners challenge the same patent and rely on the same prior art and arguments. In fact, each petition was accompanied by a motion for joinder arguing that joinder was proper because the asserted challenges to patentability were substantively identical to those presented in IPR2023-00275, the proceeding sought to be joined. *See* IPR2023-01222, Paper 3 at 5; IPR2023-01248, Paper 2 at 5.[1]

In the scheduling orders for each proceeding, we directed the parties "to contact the Board within a month of this Order to discuss consolidation and coordination among the petitioners." E.g., IPR2023-01222, Paper 12, 2 (emphasis removed). Both proceedings follow the same schedule.

On January 24, 2024, we held a conference call with the parties in the proceedings to discuss consolidation. During that call, Petitioners represented that the petitions in IPR2023-01222 and IPR2023-01248 are substantively the same. The Petitioners agreed to submit a Consolidation Plan acceptable to all parties.

In an email on February 2, 2024, the parties jointly proposed a Consolidation Plan. IPR2023-01222, Ex. 3002; IPR2023-01248, Ex. 3001.

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[1] The Board denied each motion for joinder as moot because IPR2023-00275 terminated. *See* IPR2023-01222, Paper 11; IPR2023-01248, Paper 9.

According to the Consolidation Plan,

(1) "[T]he LG IPR proceeding (IPR2023-01248) will be consolidated into the Sony IPR proceeding (IPR2023-01222),"

(2) "Counsel for . . . Sony and LG will form a joint petitioners' group and will submit joint filings,"

(3) Sony will lead the joint petitioners' group, and

(4) LG will take an "understudy" role.

Id.

We find the joint Consolidation Plan submitted by the parties reasonable and fair. Thus, to secure a just, speedy, and inexpensive resolution to the proceedings, and to administer the proceedings efficiently, we exercise our authority to consolidate IPR2023-01248 with IPR2023-01222. *See* 37 C.F.R. §§ 42.1(b), 42.122(a).

The Consolidation Plan does not expressly define the scope of the understudy role. Petitioner Sony, though, agreed to an understudy role defined in its Motion for Joinder. IPR2023-01222, Paper 3 at 6. Likewise, Petitioner LG agreed to a similar understudy role in its motion. *See* IPR2023-01248, Paper 2 at 6.

We define the understudy role consistent with the agreed upon roles from the motions for joinder. That is, for the Consolidated Proceeding, we define the understudy role such that (1) Sony alone is responsible for all petitioner filings in the consolidated proceeding until such time that it is no longer an entity in the proceeding, (2) understudy petitioner LG is bound by all filings by Sony in the Consolidated Proceeding, except for termination or settlement filings and filings in which the understudy petitioner receives

permission to file an independent paper, (3) LG shall not be permitted to raise any new grounds not already instituted by the Board in the Consolidated Proceeding and may not introduce any argument or discovery not already not already introduced by Sony, (4) LG shall be bound by any agreement between Patent Owner and Sony concerning discovery and/or depositions, and (5) LG at deposition shall not receive any direct, cross-examination, or redirect time beyond that permitted for Sony alone under either 37 C.F.R. § 42.53 or any agreement between Patent Owner and Sony. LG must obtain prior Board authorization to file any paper or to take any action on their own in the Consolidated Proceeding, as long as Sony remains as a non-terminated petitioner.

LG must file its petition (IPR2023-01248, Paper 3) in the Consolidated Proceeding within ten (10) business days of the entry of this Order. In the conference call and in their Motions for Joinder, Petitioners represented that their petitions are substantively identical. *See* IPR2023-01222, Paper 3 at 5; IPR2023-01248, Paper 2 at 5. Even so, for clarity of the record, the parties must at least cite to the Petition in IPR2023-01222 when discussing the asserted challenges to patentability in their briefing. Additional citations to the other petition is permitted if helpful or necessary.

ORDER

It is

ORDERED that, IPR2023-01248 is consolidated with IPR2023-01222;

FURTHER ORDERED that all future filings in the Consolidated

Proceeding are to be made only in IPR2023-01222;

FURTHER ORDERED that Petitioners from the proceedings will collectively be a joint Petitioner's group led by counsel for Sony;

FURTHER ORDERED that LG will take an understudy role, as defined in this Order;

FURTHER ORDERED that the Consolidated Proceeding will be on all asserted challenges to patentability presented in IPR2023-01222 and IPR2023-01248;

FURTHER ORDERED that, in future briefing, citations to the asserted challenges to patentability must be to the petition in IPR2023-01222;

FURTHER ORDERED that the case caption in IPR2023-01222 is changed to reflect its consolidation with IPR2023-01248 (sample caption appended to this Order); and

FURTHER ORDERED that, within ten (10) business days from the entry of this Order, LG must file, in IPR2024-01222, (1) its Petition from IPR2023-01248 and (2) a new Power of Attorney for the Consolidated Proceeding.

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