

Paper No. \_\_\_\_\_

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SONY CORPORATION  
Petitioner

v.

Patent of YISSUM RESEARCH DEVELOPMENT COMPANY OF THE  
HEBREW UNIVERSITY OF JERUSALEM  
Patent Owner

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Case IPR2013-00326  
Patent 6,665,003

Title: SYSTEM AND METHOD FOR GENERATING AND DISPLAYING  
PANORAMIC IMAGES AND MOVIES

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**PATENT OWNER'S OPPOSITION TO JOINDER**

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## **I. INTRODUCTION**

Patent Owner Yissum Research Development Company of the Hebrew University of Jerusalem (“Yissum”) respectfully opposes Sony Corporation’s (“Sony’s”) Motion for Joinder of its petition for inter partes review of claims 4, 5, and 34 of U.S. Patent No. 6,665,003 (the “Second Petition”) with the pending inter partes review, IPR2013-00218. Yissum opposes joinder because of Sony’s lack of diligence in pursuing the Second Petition, which is now being sought some 16 months after Sony was served with two complaints alleging infringement. Within the one year time bar allotted by Congress for filing its first petition, Sony chose to challenge only a few claims, when it could have challenged substantially more, and even now its Second Petition does not address all of the claims in dispute between the parties. Sony’s piecemeal approach and delayed filing under the present facts is counter to the policies behind inter partes review of a just, speedy and inexpensive resolution of proceedings, and unduly prejudices Yissum.

## **II. STATEMENT OF MATERIAL FACTS**

1. On March 29, 2012, Yissum’s real party in interest HumanEyes Technology Ltd. (“HumanEyes”) filed suit against Sony Corporation, Sony Corporation of America, Sony Electronics Inc., Sony Mobile Communications (USA) Inc., and Sony Mobile Communications AB (individually and collectively,

“Sony”) in the U.S. District Court for the District of Delaware, *HumanEyes Techs., LTD. v Sony Elecs, Inc., Sony Corp., Sony Corp. of America, Sony Mobile Comms, AB, Sony Mobile Comms. (USA), Inc.*, Case No. 1:12-cv-00398-GMS, alleging infringement of U.S. Patent Nos. 6,665,003 and 7,744,284 (“District Court Litigation” or “Litigation”). See, Declaration of Robert L. Gerrity In Support of Opposition To Joinder (“Gerrity Decl.”) at ¶ 3 (Exhibit YRD-2001).

2. On March 29, 2013, Sony filed petitions for inter partes review of U.S. Patent Nos. 6,665,003 (IPR2013-00218) and 7,477,284 (IPR2013-00219) challenging 14 of the 155 claims of the patents.

3. On April 19, 2013, Sony filed a Motion to Stay Litigation Pending Outcome of Inter Partes Review of the Patents-In-Suit (“Sony’s Motion to Stay”). Gerrity Decl. ¶ 4 (Exhibit YRD-2001).

4. On May 6, 2013, HumanEyes filed its Answering Brief in Opposition to Sony’s Motion to Stay (“HumanEyes Answering Brief”). Exhibit Sony-1102. The court has not ruled on Sony’s Motion to Stay. Gerrity Decl. ¶¶ 5, 8 (Exhibit YRD-2001).

5. On July 3, 2013, Sony filed second petitions for inter partes review of U.S. Patent Nos. 6,665,003 (IPR2013-00326) and 7,477,284 (IPR2013-00327) challenging an additional 6 of the 155 claims of the patents.

### **III. ARGUMENT**

#### **A. Legal Standard**

The Leahy-Smith America Invents Act (AIA) permits joinder of inter partes review proceedings under 35 U.S.C. § 315(c), which reads as follows:

(c) 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 such a response, determines warrants the institution of an inter partes review under section 314.

Normally, a petition for inter partes review filed more than one year after the service of a complaint alleging infringement of the patent is barred. 35 U.S.C. § 315(b), as amended; 37 C.F.R. § 42.101(b). The one-year time bar, however, does not apply to a request for joinder. 35 U.S.C. § 315(b) (final sentence); 37 C.F.R. § 42.122(b). Yet, the statute makes clear that joinder is entirely discretionary with the Director. 35 U.S.C. § 315(c). Absent discretionary joinder of this proceeding with IPR2013-00218, the Second Petition in this case would be barred.

#### **B. Sony Did Not Act Diligently**

Joinder should be denied because Sony did not act diligently. The statute encourages early filings bounded by a one year time bar when litigation is involved so that Patent Office proceedings do not become a moving target. Sony had ample

opportunity to seek review of the claims identified in the Second Petition within the one year period of section 315(b), but chose not to do so. Because nothing has changed in the litigations between the parties since that time, Patent Office policy dictates against authorizing joinder under these circumstances. “The rules are to be construed so as to ensure a just, speedy, and inexpensive resolution of a proceeding . . . .” Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48758 (Aug. 14, 2012). The filing of multiple petitions spread over a 16 month period as a tactic to potentially stay or otherwise delay the co-pending litigation is not conducive to Patent Office policy and allowing Sony to do so will only incentivize the same behavior from future petitioners. The present situation is not one in which circumstances have changed since the inception of the Litigation that would indicate the need for additional petitions being filed. All 155 claims of U.S. Patent Nos. 6,665,003 and 7,477,284 remain pending in the litigation; there has been no claim construction order; and there have been no rulings that otherwise limit the number or scope of claims that may be asserted as infringed. Gerrity Decl. ¶ 10 (Exhibit YRD-2001). Although the HumanEyes’ Answering Brief in connection with Sony’s motion to stay the litigation mentions additional claims as examples that could apply to Sony, the litigation has not been limited to those or any other particular claims.

Referring to the legislative history, Senator Kyl commented on the time limit for allowing joinder and pointed out that USPTO discretion should be exercised in a manner that encourages early filings, not late ones. See, “*A Guide to the Legislative History of the America Invents Act: Part II of II*,” The Federal Circuit Bar Journal, Vol. 21, No. 4, pages 539, 612-614 (2012), citing 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl). Specifically, Senator Kyl noted that “[t]he Office has made clear that it intends to use this authority to encourage early requests for joinder and to discourage late requests.” *Id.* Late petitioning without any special circumstances, as is the case here, should be discouraged by denying Sony’s motion. Allowing joinder here invites additional, subsequent requests for joinder three months, six months, or nine months from now, whenever Sony unilaterally decides it wants to challenge additional claims before the Office. Under these circumstances Sony would have no incentive to exercise its burden to reasonably investigate which claims it would like to challenge within the one year period—nor would any other future petitioner for inter partes review. The broader consideration for the Board is the likely encouragement of multiple, segmented petition filings after the one year time bar as a matter of routine practice.

**C. Yissum Will Be Prejudiced if Joinder is Granted**

If the Board grants Sony's motion and expedites the three month due date for filing a patent owner preliminary response on the issues raised in the additional petitions, Yissum may be prejudiced to the extent it is not given a full and fair opportunity to respond. 37 C.F.R. § 42.107(b); 37 C.F.R. § 42.5(c).

More importantly, Yissum will be prejudiced if joinder influences the district court to grant Sony's pending motion to stay litigation pending outcome of inter partes review of the patents-in-suit. In its answering brief opposing Sony's motion to stay litigation, Yissum's real party in interest HumanEyes articulates factors that weigh heavily against a litigation stay. Gerrity Decl. ¶ 7 (Exhibit YRD-2001) and Exhibit Sony-1102. Among them is that Sony's petitions for inter partes review will not resolve all issues because the petitions only address 14 of the 155 claims at issue in the litigation. *Id.* Sony's Second Petition adds just 3 additional claims and thus also will not resolve all issues. Accordingly, stay should be denied. Nonetheless, Sony's joinder motion appears to be a last ditch effort to exert influence on the District Court in favor of stay—as well as an effort to join claims to this proceeding at a time of its choosing rather than according to the time-table set by Congress. Sony should not now be rewarded by the Office through the grant of a discretionary joinder that could serve to deny Yissum's real party-in-interest, HumanEyes, access to the District Court. The joinder motion is

yet another among repeated efforts undertaken by Sony to delay the resolution of its dispute with Yisum.

Any delay to these proceedings caused by this (or any future attempts at joinder)—especially any stay of the District Court proceeding—would be prejudicial to Yisum's real party-in-interest, HumanEyes. See, Declaration of Vered Levy-Ron, Chief Executive Officer of HumanEyes. (Exhibit YRD-2002). HumanEyes is a 15-employee small business that has been striving to defend its intellectual property rights against Sony's infringement for more than a year, at great expense relative to its available resources as compared with Sony, a global conglomerate. Levy-Ron Decl. ¶¶ 10, 11 (Exhibit YRD-2002). Delay in resolving Sony's ongoing infringement and use of HumanEyes' patented technology continues to harm HumanEyes' business. Levy-Ron Decl. ¶ 9 (Exhibit YRD-2002). For example, the continued perceived uncertainty in the market regarding the strength and value of HumanEyes' intellectual property is harming HumanEyes' ability to find licensing partners as well as HumanEyes' ability to raise capital. *Id.* The greater the delay in resolving the dispute regarding Sony's infringement, the greater this uncertainty becomes. *Id.* These considerations, as well as the future incentive effects for Sony and other petitioners, should be taken into account as part of the discretionary evaluation performed by the Board, and weigh against granting Sony's motion.

**D. Sony Will Not Be Prejudiced If Joinder is Denied**

Joinder will not resolve the issues of infringement and validity pending before the district court concerning the more than 100 claims of the patents at issue that are not part of any of Sony's four pending petitions. Prior to expiration of the one-year time bar, Sony was not precluded from conducting its own reasonable evaluation of the patents and filing petitions for inter partes review directed to all of the claims it believed to be invalid. Sony made a conscious choice to petition only a handful of claims based, by Sony's own admission, on a terminated previous ITC investigation involving the parties, rather than based on Sony's own reasonable investigation of the claims for which it was put on notice in the March 29, 2012 Delaware District Court Complaint. Denial of joinder with respect to the few additional claims Sony seeks to challenge now through its Second Petition will not materially change Sony's posture in the litigation because this new round of piecemeal petitions still fail to address all of the claims potentially at issue in that litigation. Sony will not be prejudiced if the Second Petition is not joined in the pending proceeding.

**IV. CONCLUSION**

For all of the foregoing reasons, the Board should deny Sony's motion for joinder of the Second Petition with IPR2013-00218.

Respectfully submitted,

/David L. McCombs/

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Attorney Docket No.: 50519.5

Dated: July 12, 2013

**EXHIBIT LIST**

**IPR2013-00326**

*Sony Corp.*

v.

*Yissum Research Development Company of the Hebrew University of Jerusalem*

**Yissum Research Development Company's Exhibit List**

July 12, 2013

- |                 |   |
|-----------------|---|
| <b>YRD-2001</b> | Declaration of Robert Gerrity In Support of Opposition To Joinder |
| <b>YRD-2002</b> | Declaration of Vered Levy-Ron                                     |

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**CERTIFICATE OF SERVICE**

The undersigned certifies, in accordance with 37 C.F.R. § 42.205, that  
service was made on the Petitioner as detailed below.

*Date of service* July 12, 2013

*Manner of service* Electronic Mail (Sony-HumanEyes@kenyon.com)

*Documents served* Patent Owner's Opposition To Joinder, including Yissum's  
Exhibit List; and Exhibits: YRD-2001; YRD-2002

*Persons served* Kenyon & Kenyon LLP  
One Broadway  
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