UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION

Petitioner

Patent No. 6,665,003
Issue Date: Dec. 16, 2003
Title: SYSTEM AND METHOD FOR GENERATING AND DISPLAYING PANORAMIC IMAGES AND MOVIES

MOTION FOR JOINDER TO RELATED *INTER PARTES* REVIEW IPR2013-000218

No. IPR2013-00326

I. Relief Requested

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), petitioner Sony Corporation ("Sony" or "Petitioner"), hereby moves for joinder of the petition for *inter partes* review of claims 4, 5, and 34 of U.S. Patent No. 6,665,003 (the "'003 Patent," Sony-1101) filed on even date herewith with *inter partes* review IPR2013-00218 filed by Petitioner on March 29, 2013 and not yet instituted.

II. Statement of Material Facts

1. On March 28, 2012, HumanEyes Technologies Ltd. ("HumanEyes") filed a Complaint against Sony in the International Trade Commission ("ITC"), in which it asserted that Sony was infringing claims 1, 2, 3, and 22 of the '003 Patent.

2. On March 29, 2012, HumanEyes filed a Complaint against Sony in the District of Delaware also alleging that Sony infringed the '003 Patent. *See HumanEyes Technologies Ltd. v. Sony Electronics Inc. et al.*, 1-12-CV-00398 (D. Del.).

3. On September 25, 2012, the ITC investigation was terminated, pursuant to an unopposed motion filed by HumanEyes.

4. On March 29, 2013, Sony filed a petition for *inter partes* review requesting cancellation of the claims of the '003 patent that HumanEyes had asserted against Sony in the ITC investigation. *Sony Corp. v. HumanEyes Technologies Ltd.*, IPR2013-00218 (P.T.A.B.) ("First Petition").

5. On April 19, 2013, Sony filed a motion in the Delaware action for a stay pending IPR2013-00218.

6. On May 6, 2013, in response to the stay motion, HumanEyes contended that Sony was infringing additional claims of the '003 Patent that were not asserted in the ITC Complaint nor otherwise previously asserted against Sony, namely claims 4, 5, and 34. *See* Answering Brief in Opposition to Sony's Motion to Stay Pending the Outcome of Inter Partes Review of the Patents-In-Suit, *HumanEyes Technologies Ltd. v. Sony Electronics Inc. et al.*, 1-12-CV-00398, D.I. 34, at 13-14 (D. Del. May 6, 2013) (Sony-1102).

7. On June 27, 2013, the undersigned lead counsel for Sony notified David McCombs, lead counsel for patent owner in IPR2013-00218, that Sony intended to file a petition for *inter partes* review of claims 4, 5, and 34 of the '003 Patent and to accompany the petition with a request for joinder with IPR2013-00218 pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b).

8. On July 2, 2013, the Board held a telephone conference with the parties to IPR2013-00218, at Sony's request, to discuss the present motion. On even date herewith, the Board issued an Order (Paper 14) relating to the matters discussed in the telephone conference.

9. On even date herewith, Sony filed a second petition for *inter partes* review of the '003 Patent, IPR2013-00326 ("Second Petition"), requesting cancellation of the additional asserted claims 4, 5 and 34.

10. Each of claims 4 and 5 of the '003 patent is dependent on claim 1, which Sony challenged in the First Petition. Claim 34 is an independent claim.

11. Sony's grounds for challenging the patentability of claims 4, 5, and 34 in the Second Petition are based on prior art references that are included in the First Petition.

III. Governing Rule(s)

§ 42.122 Multiple proceedings and Joinder.

(b) *Request for Joinder*. Joinder may be requested by a patent owner or petitioner. 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. The time period set forth in § 42.101(b) shall not apply when the petition is accompanied by a request for joinder.

IV. Discussion

The Leahy-Smith America Invents Act (AIA) permits the Patent Trial and Appeal Board ("the Board") to join of *inter partes* review proceedings at its discretion. *See* 35 U.S.C. § 315(c). A motion for joinder must be filed no later than one month after the institution date of any *inter partes* review for which joinder is requested. *See* 37 C.F.R. § 42.122(b). This joinder motion is timely as IPR2013-000218 has not yet been instituted.

In its Order of July 3, 2013 (Paper 14), the Board stated that motion for joinder should explain why joinder is appropriate, identify any new grounds of unpatentability asserted in the additional petition, and explain what impact joinder would have on the scheduling of events.

First, joinder is appropriate because Sony will be unduly prejudiced if joinder is denied, since its Second Petition will be time barred. Sony filed its First Petition within one year of the service of HumanEyes' Complaint in the ITC, and Sony's First Petition challenged all claims that HumanEyes' had asserted against Sony up to that time. After Sony filed the First Petition and after the expiration of one year from service of the ITC Complaint, HumanEyes asserted three additional claims in the '003 Patent (claims 4, 5, and 34) against Sony. *See* Sony-1102, at 13-14. In order to challenge the newly asserted claims in an *inter partes* review, the only option available to Sony was to file the Second Petition and simultaneously request joinder pursuant to 37 C.F.R. § 42.122(b). The Board has stated that, absent joinder, a petition filed more than one year after service of a complaint alleging infringement by the petitioner is time barred. *See* IPR2013-00109, Paper No. 15, at 4 (P.T.A.B. Feb. 25, 2013) ("This is an important consideration" because "absent joinder of this proceeding . . . the second Petition would be barred."). Therefore, according to the Board's statement in IPR2013-00109, absent joinder, Sony's petition for *inter partes* review of the three newly asserted claims of the '003 patent will be barred.

Joinder is also appropriate because there will be no discernible prejudice to the Patent Owner from joining the two proceedings. Sony filed its Second Petition and the instant motion well before issuance of a decision regarding whether to institute trial with respect to any of the grounds set forth in the First Petition, and within two months of learning of the Patent Owner's assertion that Sony is infringing the claims

to which the Second Petition is directed. If the First Petition is instituted, the Board will issue a final determination within one year (or 18 months for good cause) of the date of its institution. *See* 35 U.S.C. § 316(a)(11). Accordingly, the Patent Owner will not be delayed in receiving a timely final written decision on the patentability of the challenged claims of the '003 Patent. Further, Sony will accommodate any reasonable logistical or scheduling requests of Patent Owner in order to accommodate joinder of the proceedings.

Second, all of the prior art references being presented in the Second Petition challenging claims 4, 5, and 34 have been presented in the First Petition. Independent claim 34 is similar in many respects to claim 1, which was challenged in the First Petition. The two dependent claims challenged in the Second Petition, claims 4 and 5, depend on claim 1, and are related to claims 2 and 3, which were all challenged in the First Petition. Claims 2 and 3 are respectively directed to an imaging apparatus providing a stereoscopic image of a scene as recorded over a "curved arc" and a "straight line." Similarly, claims 4 and 5 are directed to providing a stereoscopic image of the scene over positions that define a "translation" and a "change in angular orientation" relative to the scene. Accordingly, the four grounds of invalidity set forth

in the Second Petition each have a related ground in the First Petition and all grounds are based on anticipation under 35 U.S.C. § 102(a),(b).[1]

Third, joinder will have no significant impact on the scheduling of events. The decision regarding whether to institute *inter partes* review with respect to any of the grounds set forth in the First Petition has not issued and is not due for almost three months, and, therefore, no schedule has been set with respect to the proceeding post-institution. Because the Second Petition differs in only limited respects from the First Petition (and relying on the same references), the Patent Owner should be in a position to submit any preliminary response to the Second Petition in less than the three months that are allotted by 37 C.F.R. § 42.107(b), *i.e.*, well before early October 2013. The one year deadline to complete *inter partes* review (or 18 months for good cause) on the First Petition would not be triggered until September 27, 2013, provided that the Board does not issue an earlier decision. Therefore, any effect on the post-institution schedule that the Board might otherwise adopt in the absence of the Second Petition should be minimal.

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[1] Grounds A, B, C, and D in the Second Petition contain arguments related to those in grounds A, C, E, and F in the First Petition, respectively.

V. Conclusion

For the forgoing reasons, Sony respectfully requests that the Board join the instant proceeding with IPR2013-00218.

Dated: July 3, 2013 _/s/ Walter Hanley__

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