

Paper No. _____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SDI TECHNOLOGIES, INC.,

Petitioner

v.

BOSE CORPORATION,

Patent Owner

Patent No. 8,364,295

Filing Date: December 7, 2006

Issue Date: January 29, 2013

Title: Interactive Sound Reproducing

Inter Partes Review No. [UNASSIGNED]

PETITIONER'S MOTION
FOR JOINDER UNDER 37 C.F.R. § 42.122(B)

RELIEF REQUESTED

Petitioner SDI Technologies, Inc. (“SDI”) hereby moves for joinder of (A) the Petition for *Inter Partes* Review of claims 25, 26, 51, 52, 53, 55-59, 60-62, 75, and 76 of U.S. Patent No. 8,364,295 (the “’295 Patent”) filed on even date herewith and (B) the instituted *Inter Partes* Review styled *SDI Technologies, Inc. v. Bose Corporation*, Case No. IPR2012-00465 (the “465 IPR”).

STATEMENT OF MATERIAL FACTS

1. On July 25, 2013, SDI filed a Petition for *Inter Partes* Review requesting review of claims 1-21, 24, 27, 29- 47, 50, 63, 64, 68-70, 73, 74, 77, and 78 of the ’295 Patent.

2. On December 13, 2013, the Board issued a decision instituting trial on claims 1-21, 24, 27, 29- 47, 50, 63, 64, 68-70, 73, 74, 77, and 78 in IPR2012-00465 (the “465 IPR”).

3. Patent Owner Bose Corporation has asserted in co-pending litigation that SDI infringes claims 25, 26, 51, 52, 53, 55-59, 60-62, 75, and 76, in addition to claims already being addressed in the 465 IPR.

4. On even date herewith, Petitioner filed a Petition for *Inter Partes* review that challenges claims 25, 26, 51, 52, 53, 55-59, 60-62, 75, and 76 of the ’295 Patent, which are addressed primarily to one feature (the speaker responding to signals from the computer) in addition to those already being addressed in the

465 IPR.

5. The grounds of invalidity presented in the second petition are premised upon the same prior art adopted by the Board in the Decision in the 465 IPR. In particular, for two of the four grounds in the 465 IPR, the references already teach the new limitation that is addressed in the second petition. For the other two of the four grounds, only one additional reference is necessary to treat the new limitation. Thus, the second petition relies on just one reference that is not already being considered in the 465 IPR.

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.

DISCUSSION

This motion is made within one month of the date the trial in the 465 IPR was instituted, as required by Rule 42.122(b). Trial was instituted on December 13, 2013, and the instant motion has been filed on or before January 13, 2013.

The second petition raises a limited number of new issues in that the grounds of invalidity presented in the second petition are premised upon the same prior art

that forms the grounds adopted in the Decision. For two of the four grounds, no additional reference is needed to address the new feature; for the other two, just one new reference is needed. The only significant new issues presented in the second petition are (a) whether the two references that are the basis for grounds 3-4 of the 465 IPR also teach the feature that is the subject of the claims addressed in the second petition and (b) whether it would have been obvious to modify the combination that forms the basis for grounds 1-2 to add that same feature.

Many of the claims addressed in the second petition depend from claims already being addressed in the first petition, and the independent claims in the second petition that are not already being addressed in the 465 IPR differ in subject matter only in the addition of the one feature that is also the subject of the dependent claims.

Petitioner is willing to forfeit a reasonable portion of its response period to the extent that is deemed necessary to provide Patent Owner sufficient time to address the additional issues raised in the second petition. Petitioner will also accommodate any reasonable logistical or scheduling request of Patent Owner in order to accommodate joinder of the proceedings.

Because joinder of the second petition to IPR2012-00465 would not cause any undue prejudice or hardship to the Patent Owner, and because the interests of efficiency strongly favor joinder, the second petition should be joined to IPR2012-

00465 under Rule 42.122(b).

Respectfully submitted,

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