

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KYOCERA CORPORATION and KYOCERA COMMUNICATIONS INC.,

Petitioner

v.

ADAPTIX, INC.,

Patent Owner

Case IPR2015-00318

U.S. Patent No.: 7,454,212

Issue Date: November 18, 2008

OFDMA WITH ADAPTIVE SUBCARRIER-CLUSTER
CONFIGURATION AND SELECTIVE LOADING

**PATENT OWNER OPPOSITION TO
PETITIONERS' MOTION FOR JOINDER**

I. Introduction.

Petitioners Kyocera Corp. and Kyocera Communications Inc. (“Petitioners”) filed on November 26, 2014 a Petition for Inter Partes Review (“Petition”) of U.S. Patent No. 7,454,212 (“’212 patent”). A Motion for Joinder (“Motion for Joinder”) was filed by Petitioners on May 8, 2015 seeking to join the Petition with Inter Partes Review No. IPR2014-01525 requested by Sony Mobile Communications (USA) Inc., Sony Mobile Communications AB, Sony Mobile Communications, Inc., Sony Electronics, Inc., Sony Corp. of America, and Sony Corp. Inter Partes Review No. IPR2014-01525 (“Sony IPR”) was instituted on April 8, 2015 with respect to a single ground of rejection.

Patent Owner respectfully opposes the Motion for Joinder. Patent Owner has a substantial interest in the just, speedy, and inexpensive resolution of the Sony IPR. Patent Owner submits that joinder would prejudicially complicate the schedule in the Sony IPR, and prejudicially complicate the number of issues in the Sony IPR.

In addition to the complexity arising from adding via joinder five new proposed grounds of rejection raised in the Petition, the Board is unlikely to decide the Motion for Joinder prior to the deadline for Patent Owner’s Response on June 23, 2015 in the Sony IPR. Furthermore, the deposition of Sony’s expert declarant

in the Sony IPR has already occurred and Patent Owner's briefing is nearly complete. As such, if the Motion for Joinder were to be granted, the schedule for combined proceedings would necessarily have to be reset. Such a reset would unfairly delay the outcome of the Sony IPR, thereby depriving Patent Owner of a just, speedy, and inexpensive resolution of the Sony IPR proceeding.

Moreover, Petitioners appear to be stacking their attempts to challenge the '212 patent. In their pending Petition, Petitioners submitted five counts in attacking the '212 patent – essentially taking “five bites at the apple.” Being time-barred under 35 U.S.C. § 315(b) and 37 C.F.R. § 42.101, Petitioners by way of joinder are now seeking a “sixth bite at the apple” by injecting themselves into the Sony IPR. Patent Owner's rebuttal of the single ground of rejection in the Sony IPR should not be burdened with the need to rebut Petitioners' multiplicitous grounds of rejections. If the single ground of rejection instituted in the Sony IPR is as important to Petitioners as is now contended, Petitioners could have and should have included that same ground of rejection in their Petition. There is no indication that Petitioners could not have included such an additional ground of rejection at the time they filed their Petition. Petitioners' “me too” strategy should not be rewarded with the granting of the Motion for Joinder.

Patent Owner respectfully requests that the Board deny the Motion for Joinder.

II. Discretion of Board to Deny Motion for Joinder to the Sony IPR.

The Board has discretion to join together two inter partes reviews under 35 U.S.C. § 315. Specifically, 35 U.S.C. § 315(c) provides the following:

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.

As such, joinder is discretionary and is not a requirement. The Board, in exercising its discretion to grant joinder, considers the impact of substantive and procedural issues on the proceedings, as well as other considerations, while being “mindful that patent trial regulations, including the rules for joinder, must be construed to secure just, speedy, and inexpensive resolution of every proceeding.” (Inter Partes Review 2013-00385 (Paper 17, page 3).) According to IPR-00385, “[a] motion for joinder should: (1) set forth reasons why joinder is appropriate; (2)

identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified.” (Inter Partes Review No. 2013-00385 (Paper 17, page 4).)

The Board has manifested “the policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding.” (Inter Partes Review No. 2013-00385 (Paper 17, page 10).) Furthermore, as the moving party, the Petitioners have the burden of proof in establishing that joinder is appropriate under 37 C.F.R. § 42.20(d). Patent Owner submits that Petitioners have failed to meet their burden justifying joinder under 35 U.S.C. § 315. As discussed below, contrary to Petitioners’ position, granting of the Motion for Joinder will prejudicially complicate the schedule in the Sony IPR, and prejudicially complicate the number of issues in the Sony IPR.

III. Granting of the Motion for Joinder Will Adversely Impact the Schedule of the Sony IPR.

Under the “Minimal Impact to Schedule” subheading of the Motion for Joinder, Petitioners argue that “[g]iven the close timing between the filing of Kyocera’s Petition and the [Sony IPR], granting joinder will minimally impact the current trial schedule for the [Sony IPR].” (Motion for Joinder at page 7.) Patent

Owner disagrees. The Sony IPR was instituted on April 8, 2015, while the Board has not ruled on the institution of Petitioners' Petition.

As discussed above, the work in the Sony IPR is already underway and is nearing completion. Patent Owner's Response in the Sony IPR is due June 23, 2015, and the deposition of Sony's expert declarant has already been taken. Patent Owner has invested significant effort to prepare and nearly complete Patent Owner's Response directed to the issues raised in the Sony IPR. Patent Owner has engaged its own expert declarant to address the challenges raised in the Sony IPR, and to address testimony by Sony's expert declarant set forth in his declaration and resulting from his cross-examination during the deposition on May 20, 2015. Patent Owner is on track for a timely submission of the Patent Owner Statement on or before the deadline of June 23, 2015.

It is likely that the Board may not have the opportunity to decide on the Motion for Joinder until after the June 23, 2015 deadline. Given the additional issues (i.e., the five new proposed grounds of rejection) raised by the Petition, Patent Owner will require additional time to respond thereto. Patent Owner will require additional time to further consider the five new proposed grounds of rejection, require additional time for discovery to depose Petitioners' expert declarant, require additional time for further collaboration with Patent Owner's

own expert, and require additional time for the drafting of the Patent Owner's Response directed to the five new proposed grounds of rejection.

The consequences of granting joinder would have a significant impact on the Sony IPR and require the rescheduling of the deadlines therein. Petitioners' only provide a conclusory statement that granting joinder will "minimally impact" the schedule in the Sony IPR. Such a statement is unrealistic and is insufficient to justify joinder. The Motion for Joinder provides no detail as to how the schedule in the Sony IPR will be minimally impacted. In contrast, if joinder is granted, Patent Owner submits that the deadlines in the Sony IPR would need to be completely reset to provide additional time for Patent Owner to rebut any of the five new proposed grounds of rejection. Thus, the ultimate outcome of the Sony IPR will be unnecessarily delayed accordingly. Patent Owner has a substantial interest in the just, speedy, and inexpensive resolution of the Sony IPR, and granting of the Motion for Joinder would interfere with such interest by prejudicially complicating the schedule in the Sony IPR.

IV. Granting of the Motion for Joinder Will Adversely Impact the number of issues in the Sony IPR.

As discussed above, the Sony IPR was instituted with respect to a single ground of rejection, while the Petition sought to be joined includes five new proposed grounds of rejection. The single ground of rejection instituted in the

Sony IPR is directed to a combination under 35 U.S.C. § 103(a) of German Patent No. DE19800953 to Ritter (“Ritter”) in view of U.S. Patent No. 6,795,424 to Kapoor et al. (“Kapoor”).

In comparison, Petitioners request institution on the following five counts set forth in the Petition sought to be joined:

1. Claims 1, 8, 11-13, 18, 19, 23, and 26-28 are allegedly invalid under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,726,978 to Frodigh et al. (“Frodigh”) in view of U.S. Patent No. 6,052,594 to Chuang et al. (“Sollenberger”);

2. Claims 1, 8-13, 15, 18, 19, 23-27, and 29 are allegedly invalid under 35 U.S.C. § 103(a) as being obvious over Frodigh in view of Sollenberger and Ritter;

3. Claims 1, 8, 11, 12, 18, 23, and 26-28 are allegedly invalid under 35 U.S.C. § 103(a) as being obvious over Frodigh in view of “A Pilot Based Dynamic Channel Assignment Scheme For Wireless Access TDMA/FDMA Systems” to Chuang et al. (“Chuang”);

4. Claims 1, 8-12, 15, 18, 23-27, and 29 are allegedly invalid under 35 U.S.C. § 103(a) as being obvious over Frodigh in view of Chuang and Ritter; and

5. Claims 1, 8-13, 15, 18, 19, 23-26, and 29 are allegedly invalid under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,933,421 to Alamouti et al. in view of U.S. Patent No. 6,072,988 to Minegishi and Ritter.

As can be seen from the listing of the five counts above, Ritter is used as a tertiary reference in three of the five new proposed grounds of rejection in the Petition. That is the only overlap between the Petition and the single ground of rejection instituted in the Sony IPR.

Because the Patent Owner's Response is due June 23, 2015, Patent Owner already has expended significant effort in preparing the same. Adding the five new proposed grounds of rejection via joinder would require a significant rewrite of the Patent Owner's Response prepared for the Sony IPR. At the very least, adding any plurality of the five new proposed grounds of rejection via joinder would significantly cut into the page count already used for the Patent Owner's Response in the Sony IPR. Again, Patent Owner has a substantial interest in the just, speedy,

and inexpensive resolution of the Sony IPR, and granting of the Motion for Joinder would interfere with such interest by prejudicially complicating number of issues in the Sony IPR.

V. Conclusion.

For the foregoing reasons, Patent Owner respectfully requests Petitioners' Motion for Joinder be denied.

Respectfully submitted,

Dated: June 8, 2015

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The undersigned hereby certifies that copies of the PATENT OWNER
OPPOSITION TO PETITIONERS' MOTION FOR JOINDER were served in
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