UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Abiomed, Inc., Abiomed R&D, Inc., and Abiomed Europe GmbH
Petitioner

v.

Maquet Cardiovascular, LLC
Patent Owner

Case No. IPR2017-02151
Patent No. 9,327,068

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

I. RELIEF REQUESTED

Petitioners Abiomed, Inc., Abiomed R&D, Inc., and Abiomed Europe GmbH (collectively, "Petitioner") hereby moves for joinder of the petition for *inter partes* review ("Petition") of claims 10, 13-15, and 20 of U.S. Patent No. 9,327,068 (the "'068 patent") submitted concurrently with this motion, with a pending *inter partes* review submitted by Petitioner in IPR2017-01029.

II. APPLICABLE RULES

37 C.F.R. § 42.122(b)

(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.

III. STATEMENT OF MATERIAL FACTS

On May 19, 2016, Abiomed Inc. filed a declaratory judgment action against Maquet Cardiovascular LLC ("Maquet" or "Patent Owner") for non-infringement of the '068 patent in the District of Massachusetts. Case No. 1:16-cv-10914 ("Concurrent Litigation")

On September 22, 2016, Maquet has filed its Answer and Counterclaims in Concurrent Litigation asserting infringement of claims 1, 10 and 20 of the '068 patent by Petitioner's products.

On March 11, 2017, Petitioner has filed a petition for *inter partes* review of claims 10-22 of the ’068 patent now styled *Abiomed Inc., et al v. Maquet Cardiovascular, LLC,* Case No. IPR2017-01029.

On May 25, 2017, Maquet served its preliminary infringement contentions in Concurrent Litigation identifying claims 1, 5, 7, 9, 10, 13-15, and 20 of the ’068 patent.

On September 8, 2017, Petitioner served its invalidity contentions in Concurrent Litigation for claims 1, 5, 7, 9, 10, 13-15, and 20 of the ’068 patent.

On September 20, 2017, the Board issued a decision denying institution in IPR2017-01029[1].

Petition presents new grounds for invalidity relying on the new prior art, Sammler.

IV. DISCUSSION

The Board has authority under 35 U.S.C. § 315(c) to join a properly-filed second *inter partes* review petition to an instituted *inter partes* review proceeding.

A request for joinder must be filed “no later than one month after the institution date of any inter partes review for which joinder is requested.” 37 C.F.R. § 42.122(b). The Board has found that a motion for joinder is timely if filed prior to institution under this standard. *See Blue Coat Systems, Inc. v. Finjan, Inc.*,

[1] Petitioner reserves the right to request rehearing of IPR2017-01029.

IPR2016-00480, Paper 9 at *7 (PTAB June 24, 2016) (finding a "Petition and Motion for Joinder" filed prior to institution of the case for which joinder was requested was "not untimely"); *Taiwan Semiconductor Manufacturing Company, LTD. v. Zond, LLC*, IPR2014-00781, Paper 5 at *3 (PTAB May 29, 2014) (finding that petitioner may file a motion seeking joinder to an *inter partes* review petition that had not yet been instituted).

The one-year time bar of 35 U.S.C. § 315(b) does not apply to a request for joinder. 35 U.S.C. § 315(b) (final sentence) ("[t]he time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c)"); 37 C.F.R. § 42.122(b).

Although the Board issued a decision denying institution in IPR2017-01029, the present Motion is still permitted under 37 C.F.R. § 42.122(b) and not untimely because the Petitioner has the right to request a rehearing.

Joinder is appropriate when it results in the just, speedy, and inexpensive resolution of proceedings. 37 C.F.R. § 42.1(b). In particular, the Board typically grants joinder where the "same patents and parties are involved in both proceedings," there is "overlap in the cited prior art," there is "no discernible prejudice to either party," petitioner is "diligent and timely in filing the motion," and there is no "undue delay." *Microsoft Corp. v. Proxyconn, Inc.*, IPR2013-00109, Paper 15, at *3-4 (PTAB Feb. 25, 2013). *See also ABB Inc. v. ROY-G-BIV*

Corp., IPR2013-00282, Paper 15, at *3 (PTAB Aug. 9, 2013) and IPR2013-00286, Paper 14, at *3 (PTAB Aug. 9, 2013) (granting joinder because the cases "involve[] the same parties, the same patent, and much of the same prior art" and the "prior art references . . . substantially overlap"); *LaRose Indus. v. Capriola Corp.*, IPR2013-00121, Paper 11, at *23-24 (PTAB Jun. 28, 2013) (granting joinder in part because the cases "involve[d] the same patent and parties, and there is some overlap in the asserted prior art . . . [and t]here also is no discernible prejudice to either party"); *Cardiocom, LLC v. Robert Bosch Healthcare Sys., Inc.*, IPR2013-00469, Paper 21, at *13-15 (PTAB Jan. 28, 2014) (granting joinder in part because the cases "involve[d] the same patent, parties, and prior art[, and t]here also is no discernible prejudice to either party").

This Motion is filed by the same Petitioner, and Petition relies on substantially overlapping prior art to challenge the same '068 patent as in IPR2017-01029. Further, this Motion presents no discernable prejudice to Patent Owner because this timely filed Petition relies only on the previously-identified prior art references and involves a narrowed subset of the claimed subject matter in IPR2017-01029, allowing Patent Owner to efficiently prepare briefs and engage in discovery without significant burden, expense, or delay.

V. CONCLUSION

Based on the foregoing, the Petitioner respectfully requests that the above-captioned review proceeding be instituted and joined with IPR2017-01029. Any fees due in connection with this motion may be charged to Deposit Account No. 50-3672.

Respectfully Submitted,

___/David M. Tennant/_____

David M. Tennant
Registration No. 48,362

CERTIFICATE OF SERVICE

I, Daniel Shults, hereby certify that I am a resident of the State of Maryland and over the age of eighteen years, and not a party to the within action; my business address is 701 13th Street NW, #600, Washington, DC, 20005. On September 22, 2017, I caused the within documents:

- Petitioner's Motion for Joinder Under 37 C.F.R. § 42.122(B)

to be served via FedEx on the attorney of record with the following correspondence address as listed on PAIR:

Getinge US Legal Shared Services

1300 MacArthur Boulevard

Mahwah NJ 07430

and to be served via FedEx on the designated representative of patent owner with the following correspondence address:

Michael S. Connor

Alston & Bird LLP

Bank of America Plaza

101 South Tryon Street, Suite 4000

Charlotte, NC 28280-4000

I declare that I am employed in the office the above captioned attorney at whose direction the service was made.

__/s/ *Daniel Shults*
Daniel Shults