

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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**Abiomed, Inc., Abiomed R&D, Inc., and Abiomed Europe GmbH,**  
*Petitioners*

**v.**

**Maquet Cardiovascular, LLC**  
*Patent Owner*

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**Case IPR2017-02151**  
**U.S. Patent No. 9,327,068**

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**PATENT OWNER'S OPPOSITION TO PETITIONERS'**  
**MOTION FOR JOINDER UNDER 37 C.F.R. § 42.122(B)**

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## **I. INTRODUCTION**

Patent Owner Maquet Cardiovascular, LLC (“Patent Owner”) opposes the motion filed by Abiomed, Inc., Abiomed R&D, Inc., and Abiomed Europe GmbH (collectively, “Petitioners”) that seeks joinder of the instant petition for *inter partes* review with prior IPR2017-01029. At the time Petitioners filed the joinder motion on September 22, 2017, Petitioners had already had approximately three months to review and consider Patent Owner’s Preliminary Response in IPR2017-01029; moreover, the Board had already issued its Decision, on September 20, 2017, denying institution of IPR2017-01029 and stating the grounds for its determination. Because the Board had already denied institution of IPR2017-01029 when this motion was filed, there is no prior, pending IPR to which the instant petition could be joined. This begs the question of why Petitioners have chosen to bring the instant motion to join a terminated petition in the first place, if not merely to continue to harass Patent Owner. Petitioners should not be allowed to file a new IPR petition and seek to join it to a prior IPR petition with full knowledge of Patent Owner’s Preliminary Response and the Board’s decision denying institution. Such gamesmanship should not be condoned.

The instant motion and its related petition reflect a larger pattern of conduct by Petitioners in an attempt to circumvent applicable rules and to drain the resources of Patent Owner and the Board. In March and April 2017, Petitioners

filed 14 petitions for *inter partes* review concerning six of Patent Owner's patents. All six patents are related and are currently at issue in the litigation in the District of Massachusetts. To date, the Board has substantively reviewed twelve of these petitions. In all twelve instances, the Board has denied institution. Petitioners, having repeatedly failed to secure institution of their petitions and having succeeded securing institution of none, evidently studied Patent Owner's preliminary responses and the Board's Decisions on institution, and raced to file a further six petitions. The petition to which this opposition relates is one of these.

Petitioners' improper conduct is not limited to proceedings before the Board. In the co-pending infringement action in the District of Massachusetts, the Court has already found that Petitioners improperly withheld technical documents by imposing an arbitrary cut-off date (Order on Discovery Motions at 10, *Abiomed Inc. v. Maquet Cardiovascular LLC*, No. 1:16-cv-10914-FDS (D. Mass. Oct. 6, 2017), D.I. 160). The District Court also denied Petitioners' attempt to add Patent Owner's foreign parent company as a party (Motion Hr'g Tr. at 19:10-14, *Abiomed Inc.*, No. 1:16-cv-10914-FDS, D.I. 164 (describing such efforts as improper "fishing around.")) and rejected Petitioners' request to depose the parent company's general counsel (*see* Order on Discovery Motions at 6, *Abiomed Inc.*, No. 1:16-cv-10914-FDS, D.I. 160). Recently, for purposes of claim construction, Petitioners proposed a surprising 33 terms for construction and alleged that another

47 terms are indefinite. The recent petitions—which should not be allowed to go forward—and the instant motion—which lacks a meaningful purpose—continue Petitioners’ ongoing pattern of burdensome conduct.

Petitioners have filed motions to join five of their new petitions, including this one, with prior IPR petitions. *See* IPR2017-02135 (Paper 3), -02150 (Paper 3), -02151 (Paper 3), -02152 (Paper 3), and -01253 (Paper 3). All of Petitioners’ joinder motions characterize the recent petitions as containing “substantially overlapping prior art” with the prior petitions and assert that the new petitions are based “only on [] previously-identified prior art references” (Motion for Joinder at 4). Petitioners’ comments constitute admissions that the new petitions, including this one, are precisely the type that the PTAB regularly characterizes as abusive and dismisses as improper, and for which joinder should be denied.

## **II. § 315(c) Joinder is Not Applicable When There is No Instituted IPR To Join**

The text of the statutes and rules relied upon by Petitioners are clear: Joinder is only appropriate when there is an instituted proceeding to join. *See* 35 U.S.C. § 315(c) (“*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.*”)

(emphasis added); 37 C.F.R. § 42.122(b) (“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.”) (emphasis added).

With respect to § 315(c), it is clear that the joinder provision is applicable only *if* an IPR is instituted. This is the only reasoning that makes practical sense; if an IPR is not instituted, there is nothing to join. Further still, this “if this then that” relationship is corroborated by the text of § 42.122(b), which provides for a deadline for filing requests for joinder that is based upon an institution date of an IPR for which joinder is requested. Again, this makes clear that an IPR must be instituted before the rules allow for a request for joinder to be filed.

The Board has consistently ruled that § 315(c) joinder requires an instituted IPR with which to join. For instance, in *Oracle Corp. v. Crossroads Sys. Inc.*, Oracle requested joinder with IPR2015-00776 in a motion for joinder filed concurrently with IPR2015-01066 on April 17, 2015. Motion for Joinder, *Oracle Corp. v. Crossroads Sys. Inc.*, IPR2015-01066 (PTAB Apr. 17, 2015) Paper No. 3. Several months later, on September 8, 2015, the Board denied institution of IPR2015-00776 and shortly thereafter, on October 7, 2015, held that Oracle’s motion for joinder must be denied. Decision at \*2, *Oracle Corp.*, IPR2015-01066 (PTAB Oct. 7, 2015), Paper No. 11. The Board’s reasoning was simple: “no *inter*



*partes* review was instituted in the 776 IPR. As a result, the present case cannot be joined with the 776 IPR, and the Motion for Joinder must be denied.” *Id.* Indeed, even the above case differs from Petitioners’ Joinder Motion in that at the time the motion for joinder was filed, an institution decision was still pending. In the present case, Petitioners have chosen to file a motion for joinder with an IPR that was already denied, and thus, it is even clearer that the motion was inappropriate and joinder would be improper.

This Board’s jurisprudence is replete with instances where it has found that joinder with a proceeding that is no longer pending or has been terminated is improper. *See, e.g.*, Order at \*2-5, *Fifth Third Bank v. Stambler*, IPR2014-00244 (PTAB Dec. 17, 2013), Paper 4 (“As joinder with a terminated proceeding is not permitted, Petitioner’s request is denied . . . [a]s is apparent from the statute, joinder is possible only if a review is instituted . . . 35 U.S.C. § 315(c) only permits joinder to a previously instituted case . . . .”); Decision at \*5, *Ubisoft, Inc., v. Uniloc USA, Inc.*, IPR2016-00414 (PTAB June 2, 2016) Paper 16 (“Because IPR2015- 01207 is no longer pending, it cannot serve as a proceeding to which another proceeding may be joined. We, therefore, must deny Petitioner’s Motion for Joinder.”); Decision at \*4-5, *Amneal Pharm. LLC. v. Hospira, Inc.*, IPR2017-01054 (PTAB Sept. 6, 2017), Paper 9 (“Petitioner seeks joinder with the Amneal IPR. The Amneal IPR has been terminated. Hence, there is no pending proceeding

for Petitioner to join. Accordingly, we dismiss the Motion for Joinder as moot.”) (internal citations omitted).

Petitioners acknowledge that their motion is improper by their citation to decisions that are entirely distinct from and inapplicable to their case. For one, Petitioners cite to *Blue Coat Systems* purportedly to support that their motion was “not untimely.” However, *Blue Coat Systems* concerned a petition and motion for joinder that were filed *before* any institution decision had yet been made in the proceeding for which joinder was requested, and institution was ultimately granted. In the instant case, Petitioners waited until after institution was denied in IPR2017-01029 before bringing the present motion. *See* Decision at \*7, *Blue Coat Sys., Inc. v. Finjan, Inc.*, IPR2016-00480 (PTAB June 24, 2016), Paper 9. Indeed, the Board in *Blue Coat Systems* expressly distinguished itself from circumstances where “at the time of decision of the request for joinder, there was no institution of the inter partes review for which joinder had been requested.” *Id.* (citing Decision at \*4, *Linear Tech. Corp. v. In-Depth Test LLC*, IPR2015-01994 (PTAB Oct. 20, 2015), Paper No. 7. Petitioners’ reliance on *Taiwan Semiconductor Manufacturing Company* is similarly misplaced, as that case also concerned a motion for joinder to a proceeding before an institution decision was made, and where the Petitioner took a reasoned approach and requested authorization to file their motion for

joinder. Order at \*3, *Taiwan Semiconductor Mfg. Co., LTD v. Zond, LLC*, IPR2014-00781 (PTAB May 29, 2014), Paper 5.

More notable than Petitioners' continued citations to non-analogous cases, however, is the complete lack of support for the critical sentence on which their entire motion depends. Namely, the assertion that "[a]lthough 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" suspiciously lacks any support (Motion for Joinder at 3).<sup>1</sup> Indeed, Patent Owner is not aware of any authority or decision supporting Petitioners' conclusory self-serving statement. The statutes, rules, and cases are clear; there cannot be joinder to a proceeding that was not instituted. Petitioners' unsupported protestation otherwise is of no moment.

It is therefore clear that Petitioners' Joinder Motion pursuant to § 315(c) and § 42.122(b) is improper and should be denied. Petitioners request that this Board join their newly filed IPR to a Petition that this Board has already denied. This is contrary to the law: "[i]t is clear from both the statute and the rule that a request for

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<sup>1</sup> At the time Petitioners filed their motion, no rehearing request had been filed. Since that time, on Friday, October 20, 2017, Petitioners filed a motion for rehearing. IPR2017-01029 (Paper 10). That motion has not been granted.

joinder is appropriate only if a decision granting institution has been entered in the *inter partes* review for which joinder is requested.” Decision at 4, *Linear Tech.*, IPR2015-01994, Paper 7.

### **III. Even if § 315(c) Joinder is Applicable, Petitioners’ Motion is Premature**

If, however, this Board determines that Petitioners’ Joinder Motion pursuant to § 315(c) is not improper on the basis of the proceeding for which joinder is requested having been denied, Patent Owner submits that the Motion is premature. Petitioners assert (again, without support), that the fact that “Petitioner has the right to request a rehearing” permits the present Joinder Motion. The filing of a request for rehearing is of no moment as this Board has found that such Joinder Motions relying on a decision in a request for rehearing are premature nonetheless. *See* Order at \*2, *Intermix Media, LLC v. Bally Gaming, Inc.*, CBM2015-00154 (PTAB Feb. 19, 2016), Paper 11 (“After considering the parties’ positions, we do not authorize Petitioner to file a motion for joinder at this time. In the event that the rehearing request is granted and a covered business method patent review is instituted in this proceeding, Petitioner may again seek authorization to file a motion for joinder.”). Indeed, even in *Intermix Media*, the Petitioner filed a request for rehearing concurrently with a request for a conference call to seek authorization to file a motion for joinder. Faced with a similarly unorthodox posture, Petitioners

instead chose not to seek authorization for their current motion that was filed roughly a month before a request for rehearing.

Petitioners' gamesmanship is illuminated when the procedure they elected to utilize is compared with that in *Intermix Media*. Rather than file the present Petition and Joinder Motion before an institution decision was handed down in IPR2017-01029, as was the situation in many of the cases they relied upon in their Joinder Motion, Petitioners instead chose to wait until a decision was issued, presumably to allow the second petition to use the earlier "Decision to Institute. . . as a guide to remedy deficiencies in the First Petition." Decision at \*10, *LG Elecs., Inc. v. ATI Techs. ULC*, IPR2015-01620 (PTAB Feb. 2, 2016), Paper 10. Such "second chances" are often denied on the grounds that allowance "without constraint undermines judicial efficiency by expending [the Board's] resources on issues that were not adequately presented the first time." *Id.*

After institution was denied in IPR2017-01029, Petitioners brought the present Petition and Motion, ostensibly to file before the alleged one-year time bar of 35 U.S.C. § 315(b). Then again, if Petitioners believed their Joinder Motion was validly brought, adherence to the one-year time bar would not be necessary, begging the question of why Petitioners chose to file the present Petition before filing a request for rehearing in IPR2017-01029. *See* 35 U.S.C. § 315(b). Once again, Petitioners' strategic considerations for their own benefit flouts the typical

procedures employed by parties before this Board to allow for “the just, speedy, and inexpensive resolution of every proceeding.” *See* 37 C.F.R. § 42.1 (b). Instead, Petitioners have created a situation where Patent Owner is forced to oppose a Joinder Motion seeking joinder to a proceeding that has been denied because Petitioners claim their right to request a rehearing allows such a motion. In essence, Petitioners’ Joinder Motion was brought both too late and too soon. In the present instance, where Petitioners claim their right for a request for rehearing renders their Joinder Motion timely, the motion must be denied as premature. *See, e.g.,* Decision at 4, *Linear Tech.*, IPR2015-01994, Paper 7 (“As no decision on the request for *inter partes* review has been entered in IPR2015-01627, Petitioner’s Motion for Joinder is premature. We, therefore, deny Petitioner’s Motion for Joinder . . . .”); Order at \*2, *Intermix Media*, CBM2015-00154, Paper 11 (denying authorization for Petitioner to file a motion for joinder unless a concurrently made rehearing request was granted and a proceeding was instituted).

**IV. Petitioners Have Failed to Meet their Burden Under 37 C.F.R. § 42.20(c)**

Even if Petitioners’ Joinder Motion is proper and timely made, Petitioners have failed to meet their burden as the movant under 37 C.F.R. § 42.20(c) to show that joinder is appropriate. Indeed, from the text of their motion it is unclear why Petitioners even brought a joinder motion.

“A motion for joinder should: (1) set forth the 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) specifically address how briefing and discovery may be simplified.” Decision at \*4-5, *Ubisoft*, IPR2016-00414, Paper 16, *citing* Order Authorizing Third Party Apple, Inc. to File Motion for Joinder under 37 C.F.R. § 42.122(b) at \*4, *Kyocera Corp. v. Softview LLC*, IPR2013-00004 (PTAB Apr. 24, 2013), Paper 15. Petitioners have not attempted to meet this standard.

There is no right to joinder. Petitioners’ single conclusory paragraph arguing in favor of joinder contains no application of the four factors outlined in *Kyocera*. Thus, it is clear that Petitioners have not met their burden of proof in establishing entitlement to joinder.

Moreover, the behavior of Petitioners is precisely the type of “abuse of the review process by repeated attacks on patents” that the Board has sought to discourage by limiting unfairness to patent owners and curbing the inefficient user of *inter partes* review process. Decision at \*16-17, *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357 (PTAB Sept. 6, 2017), Paper No. 19 (PTAB “Precedential”). As alluded to above, this is Petitioners’ 18<sup>th</sup> petition for IPR against Patent Owner, and the 4<sup>th</sup> against the ’068 Patent. *See* IPR2017-01028,

-01029, -02151. The often used phrase “second bite at the apple” loses its application where, as here, Petitioners are engaging in their third or even fourth.

Thus, in stark contrast to Petitioners’ say-so allegation that no prejudice would befall Patent Owner, Patent Owner is forced to respond to yet another Petition filed by Petitioners in response to their failure to garner a favorable institution decision, along with an opposition to a baseless and improperly brought Joinder Motion. *See* Decision at \*8-9, *Atoptech, Inc. v. Synopsys Inc.*, IPR2015-00760 (PTAB July 21, 2015), Paper 14 (“[P]ermitting second chances without constraint undermines judicial efficiency by expending the Board’s limited resources on issues that were not presented adequately the first time around.”); Decision at \*12, *LG Elecs. Inc. v. Core Wireless Licensing S.A.R.L.*, IPR2016-00986 (PTAB Aug. 22, 2016), Paper 12 (“The Board’s resources would be more fairly expended on first petitions rather than on a follow-on petition like the Petition in this case.”).

Indeed, the Board has taken into account the harassing nature of serial petitions in deciding motions for joinder. *See, e.g.*, Decision at \*12-13, *Butamax Advanced Biofuels LLC v. Gevo, Inc.*, IPR2014-00581 (PTAB Oct. 14, 2014), Paper 8 (“Allowing similar, serial challenges to the same patent, by the same petitioner, risks harassment of patent owners and frustration of Congress’s intent in enacting the Leahy Smith America Invents Act.” (citing H.R. Rep. No. 112-98, pt.



1, at 48 (2011))). Additionally, the Board has exercised their discretion under 35 U.S.C. § 315(c) and declined to grant joinder particularly “where our Decision to Institute has been used as a roadmap to remedy deficiencies in an earlier petition.” Decision at \*7-8, *LG Elecs., Inc. v. ATI Techs. ULC*, IPR2015-01620 (PTAB Feb. 2, 2016), Paper 10; *see also* Decision at \*4, *Samsung Elecs. Co. Ltd. v. Affinity Labs of Tex, LLC*, IPR2015-00820 (PTAB May 15, 2015), Paper 12 (denying Petitioner’s motion for joinder on the basis that Petitioner had used prior institution decisions as a road map to present new challenges).

Further still, Petitioners characterize their new petitions as containing “substantially overlapping prior art” and that they are based “only on [] previously-identified prior art references.” (Motion for Joinder at 4). The Board has denied motions for joinder in instances where, as here, no showing has been made as to why the challenges made using “substantially overlapping prior art” could not have been brought earlier. Decision at \*9, *Atoptech, Inc.*, IPR2015-00760, Paper 14 (denying joinder where “[t]he instant Petition simply present[ed] arguments that reasonably could have been made in IPR2014-001145, but were not”); Decision at \*14, *Micro Motion, Inc. v. Invensys Sys., Inc.*, IPR2014-01409 (PTAB Feb. 18, 2015), Paper 14 (“We exercise our discretion and deny joinder of this proceeding. . . In [the first petition], Petitioner neglected to include an analysis . . . and offers now the analysis it could have offered then. . . . This is not a case where

circumstances have changed that would make joinder an equitable remedy for Petitioner.”).

Petitioners have offered no justification as to why they have delayed until the 11<sup>th</sup> hour to bring the present follow-on petition and accompanying Joinder Motion. Moreover, they have entirely failed to meet their burden in demonstrating that joinder is appropriate pursuant to 37 C.F.R. § 42.20(c). Rather than a recitation of the *Kyocera* factors and allegations of the propriety of joinder supported by argument, Petitioners chose instead to make a single conclusory assertion that Patent Owner would suffer no prejudice. This is belied by the record and the nature of the many proceedings Petitioners have brought, as well as the dubious timing of them. Patent Owner respectfully submits that the present instance is precisely the circumstance of harassment, gamesmanship, and prejudice, which the Board regularly employs its discretion and denies.

## **V. CONCLUSION**

Based on the foregoing, Patent Owner respectfully requests that Petitioners’ Motion for Joinder under 37 C.F.R. § 42.122(B) be denied.

Dated: October 23, 2017

Respectfully submitted,

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## **CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that, on October 23, 2017, a true copy of the foregoing “PATENT OWNER’S OPPOSITION TO PETITIONER’S MOTION FOR JOINDER UNDER 37 C.F.R. § 42.122(B)” was served upon the following via email:

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