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
Petitioner

v.

Maquet Cardiovascular, LLC
Patent Owner

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

# PETITIONER'S REPLY IN SUPPORT OF MOTION FOR JOINDER UNDER 37 C.F.R. § 42.122(B)

## I. INTRODUCTION

On September 22, 2017 Petitioners Abiomed, Inc., Abiomed R&D, Inc., and Abiomed Europe GmbH (collectively, "Petitioner") filed a petition for *inter partes* review of claims 10, 13-15 and 20 of U.S. Patent No. 9,327,068 (the "'068 patent") in IPR2017-02151 and a Motion for Joinder ("Motion") with an *inter partes* review submitted by Petitioner in IPR2017-01029. Patent Owner Maquet Cardiovascular, LLC ("Patent Owner") filed its Opposition to Petitioner's Motion for Joinder ("Opposition") on October 23, 2017, but fails to demonstrate any reasons why the Board should not exercise its discretion under 35 U.S.C. § 315(c) and join the proceedings in IPR2017-01029 and IPR2017-02151 if and when they are instituted. A motion for joinder with the pending proceeding for which the request for rehearing has been filed is appropriate and not untimely under the Rules. Petitioner's Motion also complies with 37 C.F.R. § 42.122(b) and 37 C.F.R. § 42.20, and granting it would result in the just, speedy, and inexpensive resolution of proceedings. 37 C.F.R. § 42.1(b).

## II. JOINDER IS APPROPRIATE

Patent Owner asserts that joinder is not appropriate when Petitioner has not requested a rehearing. Opposition at 5. This point is now moot as Petitioner filed such a Request for Rehearing under 37 C.F.R. § 42.71(d) on October 20, 2017.

Patent Owner argues unsuccessfully that the Motion is inappropriate when

the proceeding to join has not yet been instituted (Opposition at 2-6), but its analysis misinterprets the Board's jurisprudence. Patent Owner particularly relies on the Board's denial of joinder in *Oracle Corp. v Crossroads Systems, Inc*., IPR2015-01066 where Oracle sought to join the IPR filed by a different petitioner, NetApp Inc. Opposition at 3-4. In *Oracle* the original petitioner, NetApp, elected not to request a rehearing within 30 days of the denial of institution on September 8, 2015 pursuant to § 42.71(d). *NetApp Inc. v. Crossroads Systems, Inc*., IPR2015-00776 (PTAB Sep. 8, 2015), Paper 12. Notably, the Board postponed its decision on Oracle's motion until the 30-day period to request a rehearing ran out on October 7, 2015. *Oracle*, IPR2015-01066 (PTAB Oct. 7, 2015), Paper No. 11.

Patent Owner's reliance on the Board's other decisions denying joinder with already *terminated proceedings* is equally misplaced. In *Fifth Third Bank v. Stambler*, the Board denied joinder by a new petitioner with the proceeding that has been terminated by the joint request of the original petitioners and the patent owner. IPR2014-00244 (PTAB Dec. 17, 2013), Paper 4 at *2. Similarly, in *Ubisoft, Inc., v. Uniloc USA, Inc*. the Board denied joinder with the proceeding when the judgment terminating it has already been entered. IPR2016-00414 (PTAB June 2, 2016), Paper 16 at *5. Finally, in *Amneal Pharm. LLC v. Hospira, Inc*., the joinder was denied when the previous proceeding was terminated due to the settlement between the parties. IPR2017-01054 (PTAB Sept. 6, 2017), Paper 9

at *2, 4-5. The above decisions are inapplicable to a joinder with a proceeding that has not been terminated and for which a rehearing decision is pending, and the Motion is appropriate. *See* Motion at 3-4.

## III. MOTION FOR JOINDER IS NOT UNTIMELY

Patent Owner further asserts, without support, that the Motion is premature because it was brought prior to the institution in IPR2017-01029. Opposition at 5-6. Again, Patent Owner misinterprets the Board's jurisprudence and the rules. Indeed, the only decision Patent Owner relies on, *Intermix Media, LLC v. Bally Gaming, Inc*., is inapplicable. In *Intermix*, the petitioner sought the Board's authorization to file a motion for joinder together with a motion for rehearing, because presumably it was not a party in the other proceeding to which it sought to join and could not file such motion in the other proceeding as a matter of right.[1] 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b). These circumstances are different from this proceeding where the rules expressly permit Petitioner to file a motion for joinder. *See* Motion at 2-4; Section II, *supra*.

Patent Owner's untimeliness argument also directly contradicts the Board's practice. *See, e.g*., *Blue Coat Systems, Inc. vs. Finjan, Inc*., IPR2016-00480

[1] The record is unclear as to the CBM Intermix sought to join, but the only other proceeding for the patent at issue was CBM2015-00155 instituted by a different party, Worldwinner.com.

(January 24, 2016), Paper 9 at *7 ("Patent Owner argues that a request for joinder cannot be filed before the date of institution of the *inter partes* review for which joinder is requested. We are not persuaded by this argument.") (citations omitted). In *Blue Coat* the Board found that filing a motion for joinder prior to the institution is not untimely: "[t]he plain language of the rule does not forbid a request for joinder that is filed before the *inter partes* review is instituted." *Id*.

As the Board further explained in *Blue Coat*, the decision in *Linear Technology Corp. v. In-Depth Test LLC*, IPR2015-01994 (PTAB Oct. 20, 2015), Paper 7 (another decision Patent Owner relies on) is inapposite because it denied joinder when "there was no institution of the *inter partes* review" "at the time of decision of the request for joinder." *Blue Coat*, IPR2016-00480 (January 24, 2016), Paper 9 at *7. In this proceeding the Board can exercise its discretion to grant joinder at a later time, if and when the review in IPR2017-01029 is instituted.

## IV. PETITIONER MET ITS BURDEN UNDER 37 C.F.R. § 42.20

In its Motion Petitioner met its burden by explaining that the motion is filed by the same Petitioner and challenges the subset of the claims of the same '068 Patent relying on the substantially overlapping prior art. Motion at 4. Granting this motion would not be prejudicial or present additional burden to either party. *Id*.

## V. ALLEGATIONS OF GAMESMANSHIP ARE UNFOUNDED

Petitioner filed its petition in IPR2017-02151 and Motion on September 22, 2017, only two days after the Board's decision in IPR2017-01029, and it could not have been based on that decision or used it as a guide. Instead, this proceeding involves asserting new grounds for unpatentability against a subset of the claims challenged originally. Tellingly, Patent Owner is unable to articulate any reason why joining the proceedings, if instituted, would prejudice Patent Owner or impede its ability to efficiently prepare briefs and engage in discovery. Patent Owner does not even attempt to show any prejudicial effect or additional burden from the joinder. Opposition at 8-9. In fact, joinder will promote judicial economy. Although Patent Owner claims it is "forced" to oppose the Motion for Joinder (Opposition at 7), nothing requires Patent Owner to oppose the joinder which would become moot if the Board does not institute proceeding in IPR2017-01029.

## VI. CONCLUSION

Based on the foregoing, the Petitioner respectfully requests that the review proceeding in IPR2017-02151 be instituted and joined with IPR2017-01029.

Respectfully Submitted,

___/David M. Tennant/_____

David M. Tennant
Registration No. 48,362

## CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that, on November 22, 2017, the true and correct copies of the within document:

- PETITIONER'S REPLY IN SUPPORT OF MOTION FOR JOINDER UNDER 37 C.F.R. § 42.122(B)

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