

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HARMONIX MUSIC SYSTEMS, INC. AND  
KONAMI DIGITAL ENTERTAINMENT INC.,  
Petitioner,

v.

PRINCETON DIGITAL IMAGE CORPORATION,  
Patent Owner.

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Case IPR2015-00271  
Patent 5,513,129

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Before BENJAMIN D. M. WOOD, MICHELLE R. OSINSKI, and  
TRENTON A. WARD, *Administrative Patent Judges*.

OSINSKI, *Administrative Patent Judge*.

DECISION  
Motion for Joinder  
*37 C.F.R. § 42.122*

## I. INTRODUCTION

Harmonix Music Systems, Inc.<sup>1</sup> and Konami Digital Entertainment Inc. (collectively “Petitioner”) filed a Petition for *Inter Partes* Review (Paper 1) of claims 1–23 of U.S. Patent No. 5,513,129 (Ex. 1001, “the ’129 patent”), and concurrently filed a Motion for Joinder (Paper 5, “Mot.”). In the Motion for Joinder, Petitioner seeks to join challenges against the ’129 patent in this proceeding (“the ’271 IPR”) to a proceeding previously instituted against the ’129 patent, *Ubisoft Entertainment SA v. Princeton Digital Image Corporation*, Case IPR2014-00635 (“the ’635 IPR”). Mot. 1. Princeton Digital Image Corporation (“Patent Owner”) timely filed an Opposition to the Motion for Joinder (Paper 8, “Opp.”). Petitioner filed a Reply to Patent Owner’s Opposition (Paper 9, “Reply”) and a Corrected Petition (Paper 11, “Pet.”). On March 17, 2015, Patent Owner filed a Preliminary Response (Paper 13, “Prelim. Resp.”).

For the reasons that follow, we determine that Petitioner has not shown that joinder is warranted in this instance and Petitioner’s Motion is denied.<sup>2</sup> Furthermore, in a decision entered concurrently, the Petition is denied.

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<sup>1</sup> We note that Harmonix Music Systems, Inc. also filed a separate Petition to institute *inter partes* review of claims 1, 5, 6, 8–13, 15–19, and 21–23 of the ’129 patent on November 15, 2013. *See* Case IPR2014-00155 (“the ’155 IPR”), Paper 1. On May 9, 2014, we granted the Petition and instituted an *inter partes* review of claims 10, 11, 22, and 23. ’155 IPR, Paper 11, 2. An oral hearing was held on January 15, 2015, and a Final Written Decision was entered May 6, 2015. ’155 IPR, Papers 25, 26.

<sup>2</sup> The Petition was filed on November 17, 2014, more than one year after Petitioner was served with a complaint alleging infringement of the

## II. PRINCIPLES OF LAW

Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. The Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations. *See* 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (when determining whether and when to allow joinder, the Office may consider factors including “the breadth or unusualness of the claim scope” and claim construction issues). When exercising its discretion, the Board is mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b).

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

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'129 patent. Pet. 55; '155 IPR, Paper 11, 2. Petitioner Konami Digital Entertainment Inc. was added as a party on December 10, 2012. Mot. 5. When a Petition is filed more than one year after Petitioner was served with a complaint alleging infringement of the patent, an *inter partes* review ordinarily may not be instituted. *See* 35 U.S.C. § 315(b); 37 C.F.R. § 42.101(b). An exception to this one-year time bar exists in the case of a request for joinder that is filed within one month of institution of the proceeding sought to be joined. *See* 35 U.S.C. § 315(b) (final sentence); 37 C.F.R. § 42.122(b). The '635 IPR was instituted on October 17, 2014, and Petitioner filed its Motion for Joinder on November 17, 2014. Consequently, we may consider whether joinder is appropriate in this case. Absent joinder of this proceeding with the '635 IPR, the Petition would be barred.

schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See* IPR2013-00004, Paper 15 at 4; Frequently Asked Question (“FAQ”) H5 on the Board’s website at <http://www.uspto.gov/ip/boards/bpai/prps.jsp>.

### III. ANALYSIS

#### A. *New Grounds of Unpatentability*

The Petition seeks review of three claims, claims 14, 19, and 20, that were denied institution in the ’635 IPR and of claims for which review was instituted in the ’635 IPR. Mot. 1; ’635 IPR, Paper 9 (Decision on Institution), 2.<sup>3</sup> In particular, the Petition includes a new challenge to both a claim not instituted in the ’635 IPR, claim 14, and claims instituted in the ’635 IPR, claims 5–7 and 16–18, based on a new combination of references considered in the ’635 IPR. Additionally, Petitioner adds claims 19 and 20 to a ground on which we instituted in the ’635 IPR. Mot. 1; ’635 IPR, Paper 9, 2. Petitioner points out that claim 14 (which Petitioner is challenging based on a combination of Adachi and Tsumura) depends from claim 12, and the Board has already instituted *inter partes* review of claim 12 based on Adachi. Mot. 10–11. Petitioner further points out that claims 19 and 20 (which Petitioner is challenging based on Lytle) depends from claim 16, and the Board has already instituted *inter partes* review of claim 16 based on Lytle. *Id.* at 11.

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<sup>3</sup> The Petition also seeks review of the same claims 1–13, 15–18, and 21–23 upon which we instituted an *inter partes* review in the ’635 IPR, and does not include any challenges rejected by the Board. Mot. 1; Reply 1; ’635 IPR, Paper 9, 2.

As compared to the grounds of unpatentability raised in the '635 IPR, the Petition asserts the following grounds of unpatentability.

Claims challenged in '635 IPR	Claims instituted in '635 IPR	Claims not instituted in '635 IPR	References in '635 IPR and/or '271 IPR	Claims challenged in '271 IPR
1, 5–7, 10–15, 21	10, 11	1, 5–7, 12–15, 21	Tsumura <sup>4</sup>	10, 11
5–7, 9–12, 16–18, 22, 23	5–7, 9–12, 16–18, 22, 23	N/A	Lytle <sup>5</sup>	5–7, 9–12, 16–20, 22, 23
1, 12, 13, 15, 21	1, 12, 13, 15, 21	N/A	Adachi <sup>6</sup>	1, 12, 13, 15, 21
1, 8, 12, 13, 15, 21	1, 8, 12, 13, 15, 21	N/A	Lytle and Adachi	1, 8, 12, 13, 15, 21
1–6, 8, 9, 12, 13, 15–19, 21	1–4, 12, 13, 15, 21	5, 6, 8, 9, 16–19	Thalmann <sup>7</sup> and Williams <sup>8</sup>	1–4, 12, 13, 15, 21
10, 11, 22, 23	N/A	10, 11, 22, 23	Williams	N/A
16–20	N/A	16–20	Tsumura and Williams	N/A
N/A	N/A	N/A	Adachi and Tsumura	5–7, 14, 16–20

Compare Pet. 2 with '635 IPR, Paper 9, 6–7, 24–25.

<sup>4</sup> Tsumura et al., US 5,208,413 (iss. May 4, 1993) (“Tsumura,” Ex. 1002).

<sup>5</sup> Wayne T. Lytle, *Driving Computer Graphics Animation from a Musical Score*, SCIENTIFIC EXCELLENCE IN SUPERCOMPUTING, THE IBM 1990 CONTEST PRIZE PAPERS 643–86 (Keith R. Billingsley et al. ed., 1992) (“Lytle,” Ex. 1003).

<sup>6</sup> Adachi et al., US 5,048,390 (iss. Sept. 17, 1991) (“Adachi,” Ex. 1004).

<sup>7</sup> Daniel Thalmann, *Using Virtual Reality Techniques in the Animation Process*, PROC. VIRTUAL REALITY SYSTEMS, BRITISH COMPUTER SOCIETY 1–20 (1992) (“Thalmann,” Ex. 1006).

<sup>8</sup> Williams et al., US 5,430,835 (iss. July 4, 1995) (“Williams,” Ex. 1005).

Petitioner argues that “joinder should not unduly affect the Board’s ability to issue its final determination because the majority of the challenges are the same and the few additional challenges proposed by Petitioner feature the exact same references already being considered.” Mot. 10. Patent Owner counters that joinder would introduce new evidence and expand discovery. Opp. 8–9 (citing Ex. 1007). Petitioner responds that it provided a Declaration from Ubisoft’s expert that mirrors arguments made in the ’635 IPR and provides support for the additional arguments. Mot. 4; Reply 2–3.

*B. Schedule*

Petitioner argues joinder would have minimal impact on the schedule of the ’635 IPR because it would “coordinate with Ubisoft in the joined proceedings to consolidate submissions and in the taking of any depositions.” Mot. 4. Petitioner suggests that the Board may order Ubisoft and Petitioner to consolidate their submissions and conduct joint discovery in order to minimize complication or delay. *Id.* at 11. Petitioner pointed out in the conference call that (i) it would not be seeking significant page extensions, (ii) Ubisoft consented to the joinder, and (iii) depositions in the ’635 IPR would not be taking place until late January or early February.

The schedule for the ’635 IPR is significantly advanced. Patent Owner’s Response was filed on February 27, 2015. ’635 IPR, Paper 14. Petitioner’s Reply was filed on April 10, 2015. ’635 IPR, Paper 16. Patent Owner filed a Motion for observation regarding cross-examination of a reply witness on May 5, 2015. ’635 IPR, Paper 20. The oral hearing for the ’635 Patent was held on May 22, 2015.

Petitioner points out that the statute governing *inter partes* review gives the Board flexibility to extend the one-year period by up to six months in the case of joinder. Mot. 12; *see also id.* at 14. Petitioner asserts that “[t]he benefits to Petitioner[] of not having to bring . . . invalidity arguments (especially on only the three dependent claims not currently instituted) in a district court far outweighs any short delay in the schedule before the Board.” Mot. 14.

In sum, Petitioner’s proposed schedule does not address convincingly how the Petition could be joined to the ’635 IPR without significantly impacting the trial schedule of the ’635 IPR. Although we are aware that the schedule may be adjusted in the case of joinder, this does not mean that joinder is appropriate in all circumstances. Under the circumstances, joinder would have a significant adverse impact on the Board’s ability to complete the existing proceeding in a timely manner, which weighs against granting Petitioner’s Motion for Joinder.

### *C. Other Factors*

Petitioner argues that joinder is appropriate “because it . . . will not prejudice the parties to the Ubisoft IPR.” Mot. 1. Petitioner argues specifically that Patent Owner will not be prejudiced since Patent Owner will be facing arguments that it would later face in the related district court proceedings anyway and that joinder is “likely more convenient and efficient” for Patent Owner. *Id.* at 14–15. Patent Owner counters that it would be prejudicial to Patent Owner to shorten the time available to it to file a Patent Owner Response, and that Patent Owner should not be penalized by Petitioner’s decision to ultimately assert challenges that could have been asserted in the ’155 IPR, considering that the art relied upon in the

current proceeding was available at the time that Petitioner filed the '155 IPR. Opp. 11. Petitioner responds that Patent Owner has already considered the same references in the '635 IPR and has known about the references since Ubisoft filed its Petition on April 14, 2014. Reply 5.

Additional challenges joined to the '635 IPR would require the Patent Owner to undertake additional cost and effort in an expedited time frame. Further, we are mindful that Petitioner has not provided a compelling reason why the grounds of unpatentability asserted in the Petition could not have been asserted in the '155 IPR, or why Petitioner did not seek to immediately pursue similar grounds of unpatentability after the '635 IPR was instituted. Rather, Petitioner utilized all of its available time under the statute and filed its request for joinder on the last possible day (i.e., one month after the institution date of the *inter partes* review for which joinder is requested).

Petitioner also argues that it would be prejudiced in the absence of joinder “because [its] interests may not be adequately represented in the Ubisoft IPR on the instituted independent claims” and that Konami Digital Entertainment, Inc. has not previously requested *inter partes* review of the claims of the '129 patent. Mot. 3. Additionally, Petitioner asserts that it would be forced to litigate three dependent claims should Ubisoft be successful in the '635 IPR “with the record created by the Board on the independent claims” or would be forced to litigate the same arguments in the district court on all claims from the beginning should the '635 IPR terminate without proceeding to a final written decision. *Id.* at 3–4; *see also id.* at 13.

Patent Owner counters that failure to join to the '635 IPR would not be prejudicial to Petitioner because it was within Petitioner's control to challenge claims 14, 19,<sup>9</sup> and 20 in the '155 IPR. Opp. 2–3. Patent Owner also counters that Konami “was well aware of the IPRs filed by its co-defendants, and chose not to participate” at the time of the earlier filing and that Petitioner's alleged possible prejudice stemming from termination of the '635 IPR before a final written decision is merely speculative. *Id.* at 3; *see also id.* at 14–15.

Petitioner argues that joinder is appropriate because “the entire '129 Patent would be under review by the Board in one proceeding, completely eliminating the need for review by the district court in the two related litigations.” Mot. 2. Petitioner further argues “not addressing all claims of the '129 Patent in a consolidated IPR could result in a waste of judicial resources, an increase in litigation costs to both parties, and contrary to the purpose of ensuring a ‘just, speedy, and inexpensive resolution.’” *Id.* at 13 (citing *Target Corporation v. Destination Maternity Corporation*, Case No. IPR2014-00508 (PTAB Sept. 25, 2014), Paper 18, 10). Patent Owner counters that “any of the grounds under review at the Board could be raised in the '129 patent litigation by Electronic Arts because it is a defendant in the litigation but is not a Petitioner in any of the three IPRs against the '129 patent.” Opp. 3.

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<sup>9</sup> We note that Petitioner did challenge claim 19 as anticipated by US Patent No. 4,771,344 to Fallacaro et al. in the '155 IPR, but we did not institute on this ground. '155 IPR, Paper 11, 2.

Petitioner's assertion that the entire '129 patent would be under review in one proceeding ignores that we already have two Board proceedings relating to the '129 patent—the '155 IPR and the '635 IPR. Petitioner's assertion regarding eliminating the need for review by a district court presumes that we would necessarily institute *inter partes* review based on asserted grounds raised in the instant Petition relating to the additional claims, and that we would ultimately conclude that Petitioner establishes by a preponderance of the evidence that all challenged claims (including the additional claims) are unpatentable based on grounds raised in that Petition. We have not made a determination regarding patentability of the challenged claims of the '129 patent in this proceeding, or with regard to the claims at issue in the '635 IPR. We determine that any prejudice to Petitioner is outweighed by the additional burden that would be placed on Patent Owner under an expedited schedule addressing additional challenges.

#### *D. Conclusion*

Petitioner has not satisfied its burden of proof in showing entitlement to joinder with the '635 IPR. *See* 37 C.F.R. § 42.20. Petitioner presents no persuasive argument or evidence to explain why the grounds of unpatentability asserted in the Petition could not have been asserted in the '155 IPR. Joinder would increase the cost, time, and effort expended by Patent Owner in the '635 IPR and likely necessitate Patent Owner forfeiting its full statutory time periods for response. Moreover, Petitioner has not shown that joinder would promote efficient resolution of the unpatentability issues without substantially affecting the schedule for the '635 IPR. Consequently, we decline to exercise our discretion under 35 U.S.C. § 315(c) to authorize joinder, and deny the Motion for Joinder.

IPR2015-00271  
Patent 5,513,129

IV. ORDER

Accordingly, it is hereby  
ORDERED that the Motion for Joinder is *denied*.

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