

## Harmonix Music Systems, Inc., et al. v. Princeton Digital Image Corporation: Denying Last-Day Motion for Joinder IPR2015-00271

Article By:

Intellectual Property Litigation Drinker Biddle

---

*Takeaway: Waiting until the last possible day to file a motion for joinder without providing compelling rationale justifying any delay, lack of prejudice, or other factors, counsels in favor of denying the motion for joinder and the accompanying petition.*

In its [Decision](#), the Board denied Petitioner's motion for joinder and Petition for *inter partes* review of claims 1-23 of U.S. Pat. No. 5,513,129. Petitioner sought to join challenges against the '129 patent in a pending proceeding against the '129 patent, *Ubisoft Ent. SA v. Princeton Digital Image Corp.*, Case IPR2014-00635 and filed its motion for joinder one month to the day after the *Ubisoft* IPR was instituted.

Joinder may be authorized when warranted, but the decision is discretionary. See 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. When exercising its discretion, the rules for joinder "must be construed to secure the just, speedy, and inexpensive resolution of every proceeding."

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) address specifically how briefing and discovery may be simplified.

The Board noted that "[a]n exception to [the] 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).

Here, the petition included a new challenge to both a claim not instituted in the prior IPR and claims instituted in the prior IPR, but based on a new combination of references. Further, Petitioner challenged additional claims on a ground instituted in the prior IPR. Finally, Petitioner newly challenged claims dependent on claims challenged and instituted in the prior IPR.

Petitioner argued 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.” Patent Owner “counters that joinder would introduce new evidence and expand discovery.”

The Board first addressed potential impact on the schedule of the prior IPR. In the prior IPR the schedule “is significantly advanced.” Indeed, the oral hearing had already taken place. While “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,” Petitioner’s “proposed schedule does not address convincingly how the Petition could be joined to the [prior IPR] without significantly impacting the trial schedule of the [prior IPR].”

The Board next addressed “[o]ther Factors.” First, Petitioner argued that the parties to the prior IPR would not be prejudiced. The Board disagreed, as additional challenges would impose additional cost and effort on Patent Owner in an expedited timeframe. Further, “Petitioner has not provided a compelling reason why the grounds of unpatentability asserted in the Petition could not have been asserted [in the prior petition], or why Petitioner did not seek to immediately pursue similar grounds of unpatentability after [institution].” “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). In sum, the Board determined 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.”

Motion for joinder denied; Petition denied.

***Harmonix Music Systems, Inc., et al. v. Princeton Digital Image Corporation*, IPR2015-00271**

Paper 15: Decision Motion for Joinder

Dated: June 2, 2015

Patent: 5,513,129

Before: Benjamin D. M. Wood, Michelle R. Osinski, and Trenton A. Ward

Written by: Osinski

Related Proceedings: *Ubisoft Ent. SA v. Princeton Digital Image Corp.*, Case IPR2014-00635

© 2025 Faegre Drinker Biddle & Reath LLP. All Rights Reserved.

---

National Law Review, Volume V, Number 239

Source URL: <https://natlawreview.com/article/harmonix-music-systems-inc-et-al-v-princeton-digital-image-corporation-denying-last>