

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner

v.

PROXYCONN, INC.
Patent Owner

Case IPR2013-00109 (TLG)
Patent 6,757,717 B1

Before SALLY C. MEDLEY, SCOTT R. BOALICK, and THOMAS L.
GIANNETTI, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

DECISION
Motion for Joinder
37 C.F.R. § 42.122(b)

I. INTRODUCTION

Petitioner Microsoft Corporation requests joinder of this proceeding with instituted trial proceeding IPR2012-00026. Patent Owner has advised the Board that it does not oppose, and in fact encourages joinder. Paper 9. The present motion was filed concurrently with Petitioner's Second Petition for Inter Partes Review (Paper 1) involving the same patent and parties as IPR2012-00026. In a separate decision, entered today, we grant the second Petition as to all claims. For the reasons that follow, we also grant Petitioner's motion for joinder.

II. BACKGROUND

Petitioner presents a Statement of Material Facts in support of its motion. Mot. 2-3. Those facts are not opposed by Patent Owner and therefore stand as admitted. 37 C.F.R. § 42.24(b). In connection with this motion, the Board makes the following additional findings:

1. IPR2012-00026 and this proceeding involve the same parties.
2. IPR2012-00026 and this proceeding involve the same patent (US Patent 6,757,717).
3. The Yohe patent (US 5,853,943) involved in this proceeding as prior art is also cited in IPR2012-00026.
4. There is no discernible prejudice either to Patent Owner or Petitioner from joining this proceeding with IPR2012-00026.

5. Petitioner proceeded expeditiously in filing a second Petition after learning that additional claims were being asserted by Patent Owner in concurrent district court litigation.

6. Petitioner's motion was filed concurrently with the second Petition and is therefore timely under 37 C.F.R. 42 § 122(b). *See infra*.

7. Joinder of this proceeding with IPR2012-00026 will not unduly delay the resolution of either proceeding. In that regard a Revised Scheduling Order for the joined proceedings is being entered concurrently with this decision.

8. Joinder of this proceeding with IPR2012-00026 will help "secure the just, speedy, and inexpensive resolution" of these proceedings. *See* 37 C.F.R. § 42.1(b).

9. Petitioner has established good cause for joining this proceeding with IPR2012-00026.

III. DISCUSSION

The Leahy-Smith America Invents Act (AIA) permits joinder of like review proceedings. Thus, an inter partes review (IPR) may be joined with another inter partes review, and a post-grant review (PGR) may be joined with another post-grant review. The statutory provision governing joinder of inter partes review proceedings is 35 U.S.C. § 315(c), which reads as follows:

(c) JOINDER.--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.

As is apparent from the statute, a request for joinder affects certain deadlines under the AIA. Normally, a petition for inter partes review filed more than one year after the petitioner (or the petitioner's real party-in interest or privy) is served with a complaint alleging infringement of the patent is barred. 35 U.S.C. § 315(b), as amended; 37 C.F.R. § 42.101(b). However, the one-year time bar does not apply to a request for joinder. 35 U.S.C. § 315(b)(final sentence); 37 C.F.R. § 42.122(b). This is an important consideration here, because Microsoft was served with a complaint asserting infringement of the '717 patent more than a year before filing the second Petition. Pet. 1. Thus, absent joinder of this proceeding with IPR2012-00026, the second Petition would be barred. Moreover, in the case of joinder, the one-year time requirement for issuing a final determination in an inter partes review may be adjusted. 35 U.S.C. § 316(a)(11), as amended.

IV. ANALYSIS

The policy basis for construing our rules for these proceedings is set forth in the Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48758 (Aug. 14, 2012): “The rules are to be construed so as to ensure the just, speedy, and inexpensive resolution of a proceeding” *See also* Rule 1(b) (37 CFR § 42.1(b)). Based upon the admitted facts and our own findings, *supra*, we have determined that this policy would best be served by granting Petitioner's motion. The same patents and parties are involved in both proceedings. There is an overlap in the cited prior art. There is no discernible prejudice to either party. Petitioner has been diligent and timely in filing the motion. And while some adjustments to the schedule have been

necessary, there is not undue delay. In sum, the relevant factors of which we are aware all weigh in favor of granting this motion.

V. ORDER

In view of the foregoing, it is, therefore,

ORDERED that Petitioner's Motion for Joinder is granted;

FURTHER ORDERED that this proceeding is joined with IPR2012-00026;

FURTHER ORDERED that the Revised Scheduling Order entered concurrently with this Decision shall hereafter govern the schedule of the joined proceedings;

FURTHER ORDERED that this proceeding is terminated under 37 C.F.R. § 42.72 and all further filings in the joined proceedings shall be made in IPR2012-00026;

FURTHER ORDERED that the case caption in IPR2012-00026 shall be changed to reflect the joinder with this proceeding in accordance with the attached example.

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