Trial@uspto.gov
571-272-7822

Paper 18
Entered: July 22, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETAPP, INC.
Petitioner,

v.

PERSONALWEB TECHNOLOGIES, LLC
Patent Owner.

Case IPR2013-00319 (JYC)
Patent 5,978,791

Before KEVIN F. TURNER, JONI Y. CHANG, and MICHAEL R. ZECHER, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*.

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

INTRODUCTION

NetApp, Inc. ("NetApp") filed a petition requesting an *inter partes* review of claims 1-3, 29, and 35 of U.S. Patent 5,978,791 ("the '791 patent") (Paper 2, "Pet."), and a motion for joinder with IPR2013-00082 (Paper 5, "Mot."). In IPR2013-00082, the Board instituted an *inter partes* review based on the petition filed by EMC Corporation and VMware, Inc. (collectively "EMC") on all of those claims except claim 35. (IPR2013-00082, Paper 21, Dec. 33.)

Patent Owner, PersonalWeb Technologies, LLC ("PersonalWeb") opposes the motion for joinder, and argues that joinder would be prejudicial to PersonalWeb because NetApp's petition introduces an additional challenged claim, independent claim 35, as well as new substantive issues, arguments, and declarations. (Paper 16, "Opp.")

For the reasons set forth below, NetApp's motion for joinder is *denied*.[1]

DISCUSSION

The Leahy-Smith America Invents Act (AIA) created new administrative trial proceedings, including *inter partes* review, as an efficient, streamlined, and cost-effective alternative to district court litigation. The AIA permits joinders of like proceedings. The Board, acting on the behalf of the Director, has the discretion to join an *inter partes* review with another *inter partes* review. Specifically, 35 U.S.C. § 315(c) provides the following (emphasis added):

[1] NetApp's petition will be decided in a separate, forthcoming, decision.

> (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.

The AIA also makes clear that the one-year bar set forth in 35 U.S.C. § 315(b) does not apply to a request for joinder under 35 U.S.C. § 315(c). In particular, 35 U.S.C. § 315(b) reads as follows (emphasis added):

> "(b) PATENT OWNER'S ACTION.—An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent. **The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c)**.

Further, in the case of joinder, the Board has the discretion to adjust the time period for issuing a final determination in the *inter partes* review. 35 U.S.C. § 316(a)(11); 37 C.F.R. § 42.100(c).

Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b). When exercising that 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. 37 C.F.R. § 42.1(b).[2]

---

[2] 35 U.S.C. § 316(b) ("In prescribing regulations under this section, the Director shall consider the effect of any such regulation on the economy, the integrity of the

As a moving party, NetApp has the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c) and 42.122(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 schedule for the existing review; and (4) specifically address how briefing and discovery may be simplified. *See e.g.*, *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper No. 15 at 4 (PTAB, Apr. 24, 2013); FAQ H5 on the Board's website at http://www.uspto.gov/ip/boards/bpai/prps.jsp.

Furthermore, as indicated in the legislative history, the Board will determine whether to grant joinder on a case-by-case basis taking account the particular facts of each case. (*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, claim construction issues, and consent of the patent owner.) More specifically, the Board considers the impact of both substantive issues and procedural matters on the proceedings, as well as other considerations.

1. Substantive Issues

In its motion, NetApp asserts that joinder with IPR2013-00082 would not prejudice the patent owner or other petitioners, and would not cause any undue complication or delay. (Mot. 6-8.) In support of those assertions, NetApp

---

patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter.")

contends that "the inclusion of claim 35 does not raise substantial issues that are not already before the Board" and "will not materially add to the analysis that must be performed by the parties or the Board in a joined proceeding." (Mot. 7.) According to NetApp, "the same features of the same prior art apply to claim 35 as are currently applied in the EMC IPR to claim 4 and its base independent claim 1," and its petition presents "the same technical analysis for claim 35 as that already presented in the EMC IPR for claim 4." (Mot. 6-8.)

PersonalWeb counters that joinder "would be prejudicial to Patent Owner because it would: (a) introduce a new claim (claim 35) not previously challenged, as well as new claim language and construction issues regarding that claim, (b) add a new party (NetApp) not previously named, and (c) add new declarations and arguments that are different than those in [IPR]2013-00082." (Opp. 6.) In particular, PersonalWeb argues that Dr. Douglas Clark's declaration submitted by NetApp contains new testimony and arguments not previously presented in IPR2013-00082. (*Id*.) It is PersonalWeb's view that NetApp's petition "will require significant additional analysis and expense on behalf of patent owner." (*Id*.) We agree.

NetApp's arguments for joinder are unavailing, as the inclusion of claim 35 would raise substantive issues that are not before the Board in IPR2013-00082. For instance, claim 35 contains claim terms (*e.g.*, "determining whether the particular identifier is in the set of data items") that are not recited in claims 1 and 4. (Pet. 15-16.) Through its claim construction analysis, NetApp raises substantive issues that are related to lack of enablement and written description under 35 U.S.C. 112, ¶ 1, and indefiniteness under 35 U.S.C. 112, ¶ 2. (*Id*.)

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.