

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL INC.
Petitioner

v.

NETWORK-1 SECURITY SOLUTIONS, INC.
Patent Owner

Case IPR2013-00385
Patent 6,218,930

Before JAMESON LEE, JONI Y. CHANG, and JUSTIN T. ARBES,
Administrative Patent Judges.

ARBES, *Administrative Patent Judge.*

DECISION
Dell's Motion for Joinder
37 C.F.R. § 42.122

Introduction

Dell Inc. (“Dell”) filed a Petition (Paper 2) (“Pet.”) to institute an *inter partes* review of claims 6 and 9 of Patent 6,218,930 (the “’930 patent”) pursuant to 35 U.S.C. § 311 *et seq.* and a motion for joinder with Case IPR2013-00071 (Paper 4) (“Mot.”). Patent Owner Network-1 Security Solutions, Inc. (“Network-1”) filed a preliminary response to the Petition and an opposition to Dell’s motion. Paper 14 (“Prelim. Resp.”); IPR2013-00071, Paper 28 (“Network-1 Opp.”). Avaya Inc. (“Avaya”), the petitioner in Case IPR2013-00071, also filed an opposition to Dell’s motion. IPR2013-00071, Paper 30 (“Avaya Opp.”). For the reasons that follow, Dell’s motion for joinder is *granted*.¹

Analysis

The 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 the joinder of like proceedings. The Board, acting on behalf of the Director, has the discretion to join an *inter partes* review with another *inter partes* review. 35 U.S.C. § 315. Section 315(c) provides (emphasis added):

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.

¹ In a decision entered concurrently, Dell’s Petition is granted and a trial is instituted on the same grounds as in Case IPR2013-00071.

The AIA also establishes a one-year bar from the date of service of a complaint alleging infringement for requesting *inter partes* review, but specifies that the bar does not apply to a request for joinder under Section 315(c). Section 315(b) reads (emphasis added):

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 an *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. 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).

As the moving party, Dell has the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 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) address specifically how briefing and discovery may be simplified. *See* Mot. 1; *see also* 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>.

Statutory Authority to Join Dell

As an initial matter, Network-1 and Avaya both argue that the Board does not have the authority to join Dell as a party under 35 U.S.C. § 315. Network-1 Opp. 2-3; Prelim. Resp. 1-8; Avaya Opp. 1-5. Section 315(c) provides that the Director may join a party that “properly files a petition under section 311.” Network-1 and Avaya argue that because Dell’s Petition was filed more than one year after being served with a complaint in violation of Section 315(b), Dell did not “properly file[] a petition” and cannot be joined.² In other words, according to the opposing parties, filing a petition within one year is a “condition *precedent*” to joinder and a party that files beyond the one-year window can never be joined, without exception. *See* Network-1 Opp. 2-3; Avaya Opp. 2-3.

We disagree with Network-1 and Avaya that the Board lacks the authority to join Dell as a party under Section 315. While Dell filed its Petition more than one year after being served with a complaint, the second

² Network-1 contends that Dell was served with a complaint alleging infringement of the ’930 patent on December 14, 2011, and filed its Petition on June 24, 2013. Network-1 Opp. 3 (citing IPR2013-00071, Ex. 2009). Avaya asserts that Dell was served on December 16, 2011. Avaya Opp. 7.

sentence of Section 315(b) provides that the one-year bar “shall not apply to a request for joinder under subsection (c).” The one-year bar, therefore, does not apply to Dell because it filed a motion for joinder with its Petition. This is confirmed by the Board’s rules, which provide that a petition requesting *inter partes* review may not be “filed more than one year after the date on which the petitioner, the petitioner’s real party-in-interest, or a privy of the petitioner is served with a complaint alleging infringement of the patent,” but the one-year time limit “shall not apply when the petition is accompanied by a request for joinder.” 37 C.F.R. §§ 42.101(b), 42.122(b); *see also* IPR2013-00109, Paper 15 (permitting joinder of a party beyond the one-year window); IPR2013-00256, Paper 10 (same). The Board’s rules do not conflict with the language of the statute as Network-1 and Avaya suggest.

Network-1 and Avaya’s interpretation incorporates erroneously the one-year bar into the statutory language of Section 315(c), which permits joinder of “any person who properly files a petition *under section 311*” (emphasis added). Section 311 includes various requirements, such as a requirement that petitions may only raise grounds of unpatentability based on 35 U.S.C. §§ 102 or 103 and only on the basis of prior art patents and printed publications, but does not include the one-year bar, which is part of Section 315(b). Thus, “properly fil[ing] a petition under section 311” does not mean filing a petition within one year as required by Section 315(b). In its opposition, Network-1 argues that Section 311(a) provides that “[s]ubject to the provisions of this chapter, a person who is not the owner of a patent may file with the Office a petition to institute an inter partes review,” and Section 315(b) is a “provision[] of this chapter.” Network-1 Opp. 2. This

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