

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION OF AMERICA and
HEWLETT-PACKARD CO.
Petitioners

v.

NETWORK-1 SECURITY SOLUTIONS, INC.
Patent Owner

Case IPR2013-00495
Patent 6,218,930

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

ARBES, *Administrative Patent Judge.*

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

Introduction

Sony Corporation of America (“Sony”) and Hewlett-Packard Co. (“HP”) (collectively, “Petitioners”) filed a Petition (Paper 3) (“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 7) (“Mot.”).¹ Patent Owner Network-1 Security Solutions, Inc. (“Network-1”) filed an opposition to Petitioners’ motion. IPR2013-00071, Paper 45 (“Network-1 Opp.”). Avaya Inc. (“Avaya”), the first petitioner in Case IPR2013-00071, also filed an opposition to Petitioners’ motion. IPR2013-00071, Paper 46 (“Avaya Opp.”). Dell Inc. (“Dell”), the second petitioner in Case IPR2013-00071,² did not file an opposition. For the reasons that follow, Petitioners’ motion for joinder is *granted*.³

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

¹ Petitioners appear to have filed two copies (Papers 6 and 7) of their motion for joinder in the Patent Review Processing System (PRPS). Paper 6 will be expunged.

² Dell was joined as a party to Case IPR2013-00071 on July 29, 2013. *See* IPR2013-00385, Paper 17.

³ In a decision entered concurrently, the Petition is granted and a trial is instituted on the same grounds as in Case IPR2013-00071.

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.

Thus, 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 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>.

Timeliness of Petitioners' Motion

As an initial matter, Network-1 and Avaya both argue that joinder is prohibited by 37 C.F.R. § 42.122(b), which specifies that “[a]ny request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested.” See Network-1 Opp. 1-3; Avaya Opp. 2-3. Specifically, the Board instituted an *inter partes* review in Case IPR2013-00071 on May 24, 2013, and Petitioners filed their motion in the instant proceeding on August 6, 2013. Petitioners contend that their motion for joinder is timely because it was filed within one month of July 29, 2013, the date on which an *inter partes* review was instituted in Case IPR2013-00385, which was joined with Case IPR2013-00071. Mot. 8-9.

We agree with Network-1 and Avaya that Petitioners' request for joinder was filed after the one-month period set forth in 37 C.F.R. § 42.122(b). On July 29, 2013, the Board instituted a trial in Case IPR2013-00385 (the “’385 proceeding”), joined the ’385 proceeding with Case IPR2013-00071, and terminated the ’385 proceeding under 37 C.F.R. § 42.72. IPR2013-00385, Paper 17 at 10-11. Petitioners, however, still may seek joinder with pending Case IPR2013-00071. Under 37 C.F.R. § 42.5(b), the Board “may waive or suspend a requirement of [part 42 of the Board’s rules] and may place conditions on the waiver or suspension.” Petitioners argue that special circumstances exist justifying waiver of the one-month time period for requesting joinder with Case IPR2013-00071. Mot. 1-4. We turn now to whether such circumstances exist and whether the Board should exercise its discretion to join Petitioners, taking into account substantive, procedural, and other considerations.

Substantive Issues

Petitioners argue that joinder with Case IPR2013-00071 will not impact the Board's ability to complete the proceeding in one year because Petitioners "do not raise any issues that are not already before the Board." Mot. 4-5, 11-13. We agree. Petitioners in their Petition assert the same grounds of unpatentability as those on which a trial was instituted in Case IPR2013-00071. *See* Pet. 10-11; IPR2013-00071, Paper 18 at 29. Petitioners' arguments regarding the asserted prior art references are identical to the arguments made by Avaya and Dell in their petitions. *Compare* Pet. 21-40, with IPR2013-00071, Paper 1 at 17-26, 36-45, and IPR2013-00385, Paper 2 at 17-35. Further, Petitioners submit the same declaration of Dr. George A. Zimmerman that Dell submitted in support of its petition, which itself was largely a copy of the declaration of Dr. Zimmerman submitted by Avaya. *See* Ex. 1011; IPR2013-00071, Ex. 1011; IPR2013-00385, Ex. 1011. Thus, the Petition raises no new issues beyond those already before the Board in the existing proceeding, which weighs in favor of joinder. *See* 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) ("The Office anticipates that joinder will be allowed as of right—if an inter partes review is instituted on the basis of a petition, for example, a party that files an *identical petition* will be joined to that proceeding, and thus allowed to file its own briefs and make its own arguments.") (emphasis added).

Procedural Issues

Petitioners argue that joinder would not require any change to the trial schedule in Case IPR2013-00071 because Petitioners raise the same grounds

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