

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.
Petitioner

v.

B.E. TECHNOLOGY, L.L.C.
Patent Owner

Case IPR2014-00738
Patent 6,628,314 B1

Before SALLY C. MEDLEY, KALYAN K. DESHPANDE, and
LYNNE E. PETTIGREW, *Administrative Patent Judges*.

PETTIGREW, *Administrative Patent Judge*.

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

INTRODUCTION

Petitioner Google Inc. filed a petition requesting an *inter partes* review of claims 11-22 of U.S. Patent No. 6,628,314 B1 (Ex. 1001, “the ’314 patent”). Paper 1 (“Pet.”). With the petition, Petitioner filed a motion for joinder (Paper 3, “Mot.”), seeking to join this case with *Microsoft Corporation v. B.E. Technology, L.L.C.*, Case IPR2014-00039 (PTAB Apr. 9, 2014). In a separate decision, entered today, we institute an *inter partes* review as to the same claims and the same grounds of unpatentability for which we instituted trial in *Microsoft Corporation v. B.E. Technology, L.L.C.*, Case IPR2014-00039. For the reasons that follow, Petitioner’s motion for joinder is *granted*.

BACKGROUND

Petitioner filed its petition and motion for joinder on May 9, 2014, within one month after the institution date of IPR2014-00039. On June 10, 2014, the Board held a conference call with counsel for the respective parties and counsel for the Petitioner in IPR2014-00039 (“the -00039 Petitioner”). Paper 7 at 2. During the conference call, counsel for Patent Owner represented that Patent Owner does not oppose the motion for joinder, and counsel for the -00039 Petitioner indicated that the -00039 Petitioner does not oppose the motion for joinder with it in IPR2014-00039. *Id.*

The petition in this case asserts that claims 11-14 and 16-19 of the ’314 patent are unpatentable under 35 U.S.C. § 102(e) as anticipated by

Guyot¹, claim 15 of the '314 patent is unpatentable under 35 U.S.C. § 103(a) as obvious over Guyot and Robinson², and claims 20-22 are unpatentable under 35 U.S.C. § 103(a) as obvious over Guyot and RFC 1635³. Pet. 10-25. These are the same claims and the same grounds for which we instituted trial in IPR2014-00039. *Microsoft Corporation v. B.E. Technology, L.L.C.*, Case IPR2014-00039, slip op. at 19 (PTAB Apr. 9, 2014) (Paper 13).

ANALYSIS

The Leahy-Smith America Invents Act, Pub. L. No. 112-29 (2011), permits joinder of like review proceedings. Thus, an *inter partes* review may be joined with another *inter partes* review. The statutory provision governing joinder of *inter partes* review proceedings is 35 U.S.C. § 315(c), which provides:

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 the movant, Petitioner bears the burden to show that joinder is appropriate. 37 C.F.R. § 42.20(c). In its motion for joinder, Petitioner contends that joinder is appropriate because (1) “it will promote efficient

¹ U.S. Patent No. 6,119,098 (Ex. 1006) (“Guyot”).

² U.S. Patent No. 5,918,014 (Ex. 1007) (“Robinson”).

³ Deutsch et al., *How to Use Anonymous FTP*, IAFA Working Group, 1-13 (May 1994) (Ex. 1022) (“RFC 1635”).

determination of the validity of the '314 Patent without prejudice" to Patent Owner or the -00039 Petitioner; (2) the petition raises only the same grounds of unpatentability for which the Board instituted review in IPR2014-00039; (3) joinder would not affect the pending schedule in IPR2014-00039 or increase the complexity of that proceeding; and (4) Petitioner is "willing to accept an understudy role to minimize burden and schedule impact." Mot. 2.

The Board, acting on behalf of the Director, has discretion to join proceedings. 35 U.S.C. § 315(c). In exercising its discretion, the Board considers the impact of both substantive issues and procedural matters on the proceedings.

The substantive issues in IPR2014-00039 would not be affected by joinder because Petitioner asserts only the grounds of unpatentability for which trial was instituted in IPR2014-00039, and makes only the arguments made by the -00039 Petitioner in its petition in that proceeding. *Compare* Pet. 10-25, with *Microsoft Corporation v. B.E. Technology, L.L.C.*, Case IPR2014-00039, Paper 1 at 17-42. Further, Petitioner submits the same declaration of Henry Houh that the -00039 Petitioner submitted in support of its petition. *See* Ex. 1003; *Microsoft Corporation v. B.E. Technology, L.L.C.*, Case IPR2014-00039, Ex. 1003. Thus, the petition in this proceeding raises no new issues beyond those already before the Board in IPR2014-00039.

Regarding procedural matters, Petitioner argues that joinder would not require any change to the trial schedule in IPR2014-00039 because Petitioner "agrees to an understudy role and do[es] not raise any issues that

are not already before the Board.” Mot. 4. Specifically, Petitioner “agrees to assume a limited ‘understudy’ role” “[a]s long as Microsoft [i.e., the -00039 Petitioner] remains in the joined IPR.” *Id.* at 5. Given that Petitioner will assume an understudy role, Petitioner states that its presence will not introduce any additional briefing or need for discovery. *Id.* at 4.

CONCLUSION

Under the circumstances, we conclude Petitioner has demonstrated that joinder will not unduly complicate or delay IPR2014-00039, and therefore joinder is appropriate.

ORDER

Accordingly, it is:

ORDERED that Petitioner’s motion for joinder with IPR2014-00039 is *granted*;

FURTHER ORDERED that this proceeding is joined with IPR2014-00039;

FURTHER ORDERED that the grounds on which a trial was instituted in IPR2014-00039 are unchanged;

FURTHER ORDERED that the Scheduling Order and adjustments to the Scheduling Order in place for IPR2014-00039 (Papers 14, 25) shall govern the joined proceedings;

FURTHER ORDERED that IPR2014-00738 is instituted, joined, and terminated under 37 C.F.R. § 42.72, and all further filings in the joined proceeding shall be made in IPR2014-00039;

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