UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE INC.
Petitioner

v.

B.E. TECHNOLOGY, LLC
Patent Owner

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Case No.: IPR2014-00743
Patent 6,628,314

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MOTION FOR JOINDER UNDER 35 U.S.C § 315(c), 37 C.F.R. §§ 42.22 AND 42.122(b)

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

I. INTRODUCTION

Google, Inc. ("Petitioner") submits concurrently herewith a Petition for *Inter Partes* Review of U.S. Patent No. 6,628,314 ("the '314 Patent") ("Petition") based on identical grounds that form the basis for pending IPR proceeding, Case No. IPR2014-00052 ("the Facebook IPR").

Pursuant to 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22, and 37 C.F.R. § 42.122(b), Petitioner respectfully moves that this Petition be instituted and joined with the Facebook IPR. Petitioner merely requests an opportunity to join with the Facebook IPR as an "understudy" to Facebook, only assuming an active role in the event Facebook settles with B.E. Technology. Thus, Petitioner does not seek to alter the grounds upon which the Board has already instituted the IPR, and joinder will have no impact on the existing schedule in the IPR. Under Rule 42.122(b), this Motion is timely as it was filed within one month of the granting of IPR2014-00052.

II. BACKGROUND AND RELATED PROCEEDINGS

B.E Technology ("B.E. Tech") is the owner of the '314 Patent. In 2012, B.E. Tech sued ten different companies for alleged infringement of the '314 Patent ("Underlying Litigation"). In October of 2013, three of the defendants, Facebook, Microsoft, and Petitioner Google, filed four petitions for *inter partes* review of the '314 Patent. The Board instituted trial in all four petitions on April 9, 2014. *See*

Facebook v. B.E. Technology, L.L.C. (Case Nos. IPR2014-00052 and IPR2014-00053); *Microsoft Corporation v. B.E. Technology, L.L.C.* (Case No. IPR2014-00039); and *Google Inc. v. B.E. Technology, L.L.C.* (Case No. IPR2014- 00038).

III. REQUIREMENTS FOR MOTION FOR JOINDER ARE MET

Petitioner respectfully submits that joinder is appropriate because: (1) it will promote efficient determination of the validity of the '314 Patent without prejudice to Facebook or B.E. Tech; (2) this petition raises only the same grounds of unpatentability as Facebook and for which the Board instituted review; (3) it would not affect the pending schedule in the Facebook IPR in any way nor increase the complexity of that proceeding in any way; and (4) Petitioner is willing to accept an understudy role to minimize burden and schedule impact. Absent joinder, Petitioner could be prejudiced if the Facebook IPR is terminated (*e.g.*, via settlement) before a final written decision is issued. For example, Petitioner would lost its opportunity to challenge the claims of the '314 Patent before the Board on the grounds in the Petition. Petitioner might also have to start over before the District Court with the same arguments presented by Facebook before the Board, thereby wasting resources and losing efficiency. Accordingly, joinder should be granted.

a. Joinder Will Promote the Efficient Determination of Validity Without Prejudice to Facebook or B.E. Tech.

Granting joinder and permitting Petitioner to assume the understudy role will not prejudice Facebook or B.E. Tech. The Petition does not raise any issues that are not already before the Board, such that joinder would not affect the timing of the IPR or the content of B.E. Tech's responses. *See* Decision on Joinder, IPR2013-00385 (Paper No. 17). Petitioner's limited role ensures that Facebook and B.E. Tech will not suffer any additional costs. Petitioner has already notified counsel for Facebook its intent to assume only an understudy role. Likewise, B.E. Tech will not have to coordinate with or respond to arguments by more parties than they already do.

Moreover, a final written decision on the validity of the '314 patent will minimize issues in the Underlying Litigation and potentially resolve the Litigation altogether thereby promoting the efficient determination of validity. If the Board permits Petitioner to join the Facebook IPR, and the '314 patent is upheld in a final decision, Petitioner will be estopped from further challenging the validity of the patent on these grounds, avoiding duplication of B.E. Tech's efforts at least as to Petitioner. *See* 35 U.S.C. § 315(e)(1). Accordingly, to avoid duplicate efforts and promote judicial efficiency, joinder is appropriate.

b. No New Arguments Are Presented.

The petition asserts only the arguments that the Board has already instituted in the Facebook IPR. Thus, there are no new arguments to consider. Further, the

Petition relies on the expert witness, Robert J. Sherwood, who is already involved in Facebook's IPR. Thus, no new expert depositions are required.

c. No Schedule Adjustments Are Necessary.

Joinder in this case will not impact the Board's ability to complete its review in a timely manner. Section 316(a)(11) provides that IPR proceedings should be completed and the Board's final decision issued within one year of institution of the review. *See* also 37 C.F.R. § 42.100(c). Here, joinder will not affect the Board's ability to issue its final determination within one year because Petitioner agrees to an understudy role and do not raise any issues that are not already before the Board. Indeed, the Petition includes only those grounds on which the IPR was instituted, and the invalidity grounds were copied from Facebook's petition. Given that Petitioner will assume an understudy role, their presence will not introduce any additional arguments, briefing, or need for discovery. *See* Decision on Joinder, IPR2013-00495 (Paper No. 13).

Petitioner submits that B.E. Tech does not need to file a Patent Owner's Preliminary Response, and request that the Board proceed without it. This is consistent with the Board's Order in IPR2013-00256 (Paper No. 8), which allowed the Patent Owner to file a preliminary response addressing only those points raised in the new petition that were different from those in the granted petition. Here, because the invalidity grounds are exactly the same as the instituted grounds in

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