

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 IPR2014-00744
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 11-13, 15, 18, and 20 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 *Facebook, Inc. v. B.E. Technology, L.L.C.*, Case IPR2014-00053 (PTAB Apr. 9, 2014). In a separate decision, entered today, we institute an *inter partes* review as to the same claims and the same ground of unpatentability for which we instituted trial in *Facebook, Inc. v. B.E. Technology, L.L.C.*, Case IPR2014-00053. 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 IPR2014-00053. On June 10, 2014, the Board held a conference call with counsel for the respective parties and counsel for the Petitioner in IPR2014-00053 (“the -00053 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 -00053 Petitioner indicated that the -00053 Petitioner does not oppose the motion for joinder with it in IPR2014-00053. *Id.*

The petition in this case asserts that claims 11-13, 15, 18, and 20 of the ’314 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over

Angles¹ and Shaw². Pet. 12-41. These are the same claims and the same ground for which we instituted trial in IPR2014-00053. *Facebook, Inc. v. B.E. Technology, L.L.C.*, Case IPR2014-00053, slip op. at 17 (PTAB Apr. 9, 2014) (Paper 10).

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 determination of the validity of the ’314 Patent without prejudice” to Patent Owner or the -00053 Petitioner; (2) the petition raises only the same grounds of unpatentability for which the Board instituted review in IPR2014-00053; (3) joinder would not affect the pending schedule in IPR2014-00053 or

¹ U.S. Patent No. 5,933,811 (Ex. 1003) (“Angles”).

² U.S. Patent No. 5,809,242 (Ex. 1004) (“Shaw”).

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 IPR2014-00053 would not be affected by joinder because Petitioner asserts only the ground of unpatentability for which trial was instituted in IPR2014-00053, and makes only the arguments made by the -00053 Petitioner in its petition in that proceeding. *Compare* Pet. 12-41, *with Facebook, Inc. v. B.E. Technology, L.L.C.*, Case IPR2014-00053, Paper 1 at 35-60. Further, Petitioner submits the same declaration of Robert J. Sherwood that the -00053 Petitioner submitted in support of its petition. *See* Ex. 1007; *Facebook, Inc. v. B.E. Technology, L.L.C.*, Case IPR2014-00053, Ex. 1007. Thus, the petition in this proceeding raises no new issues beyond those already before the Board in IPR2014-00053.

Regarding procedural matters, Petitioner argues that joinder would not require any change to the trial schedule in IPR2014-00053 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 Facebook [i.e., the -00053 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 IPR2014-00053, and therefore joinder is appropriate.

ORDER

Accordingly, it is:

ORDERED that Petitioner's motion for joinder with IPR2014-00053 is *granted*;

FURTHER ORDERED that this proceeding is joined with IPR2014-00053;

FURTHER ORDERED that the ground on which a trial was instituted in IPR2014-00053 is unchanged;

FURTHER ORDERED that the Scheduling Order and adjustments to the Scheduling Order in place for IPR2014-00053 (Papers 11, 25) shall govern the joined proceedings;

FURTHER ORDERED that IPR2014-00744 is instituted, joined, and terminated under 37 C.F.R. § 42.72, and all further filings in the joined proceeding shall be made in IPR2014-00053;

FURTHER ORDERED that unless given prior authorization by the Board, Petitioner is not permitted to file papers, engage in discovery, or participate in any deposition or oral hearing in IPR2014-00053. Petitioner, however, is permitted to appear in IPR2014-00053 so that it may receive notification of filings and may attend depositions and oral hearing. Should

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