

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERNATIONAL BUSINESS MACHINES CORPORATION
AND
ORACLE AMERICA, INC.,
Petitioners,

v.

ELECTRONICS AND TELECOMMUNICATIONS RESEARCH
INSTITUTE,
Patent Owner.

Case IPR2014-00949
Patent 6,978,346 B2

Before MIRIAM L. QUINN, and
GREGG I. ANDERSON, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

DECISION ON
MOTION FOR JOINDER
37 C.F.R. § 42.122(b)

I. INTRODUCTION

On June 13, 2014, International Business Machines Corporation and Oracle America, Inc. (“Petitioner”) filed a petition (“Pet.”) for *inter partes* review of U.S. Patent No. 6,978,346 B2 (Ex. 1001, “the ’346 patent”).

Paper 1.

On January 16, 2015, Electronics and Telecommunications Research Institute (“Patent Owner”) filed a Motion for Joinder (“Mot”) to join this proceeding with *VMWare, Inc. v. Electronics and Telecommunications Research Institute*, Case IPR2014-00901 (“the VMWare IPR”). The VMWare IPR also concerns the ’346 patent.

The Board instituted trial in both the present case and the VMWare IPR on December 11, 2014. Patent Owner represents that Petitioners in this case and the VMWare IPR do not oppose the Motion. Mot. 1.

The Motion for Joinder is granted.

II. DISCUSSION

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 reads as follows:

(c) 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, Patent Owner bears the burden to show that joinder is appropriate. 37 C.F.R. § 42.20(c). A motion for joinder should: (1) set forth

the reasons 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* Frequently Asked Question (“FAQ”) H5 on the Board’s website at <http://www.uspto.gov/ip/boards/bpai/prps.jsp>.

Patent Owner represents that it does not raise any issues that are not already before the Board and VMWare’s Petition is based on the same grounds and same combinations of prior art as those on which trial has been instituted in the instant proceeding. Mot. 1. The Petitions in this case and the VMWare IPR are substantively identical. *Id.* at 2. Both Petitions are supported by the Declaration of Dr. Robert Horst. *Id.* As a result, the unpatentability grounds instituted here is the same as the grounds for which trial was instituted in the VMWare IPR.

The Due Dates in the Scheduling Order in both cases are identical. *Id.* Under these circumstances, joinder would not affect the timing, i.e., the Scheduling Order, of the VMWare IPR, and would not impact the date of the next Due Date, the Patent Owner’s response. Mot. 7.

In the absence of joinder, Patent Owner expects to file substantively identical papers and evidence in both cases. *Id.* at 4. Similarly, Patent Owner would expect to provide and seek the same discovery in both cases, in the absence of joinder. *Id.* Patent Owner expects efficiencies will result from conducting the same briefing and discovery once. *Id.*

Petitioners in both cases have agreed to coordinate filings and discovery to the extent reasonably possible, but request that Petitioner in this case, IBM and Oracle, be granted leave to file a reasonable number of

additional pages—no more than 7—for any filing to address “only points of disagreement with points asserted in [VMware]’s consolidated filing.”

Mot. 5. Petitioner also proposes that such filings by IBM and Oracle must specifically identify and explain each point of disagreement, and that IBM and Oracle may not file separate arguments in support of points made in VMWare’s consolidated filing. *Id.* (citing *Motorola Mobility LLC v. Softview LLC*, IPR2013-00256, Paper 10 at 11 (June 20, 2013)). Patent Owner would have a corresponding number of additional pages for its responsive briefing “limited to the issues raised in the [IBM and Oracle] filing.” *Id.*

We agree with Patent Owner that joinder would be appropriate under the circumstances and that all filings will be subject to the regular page limits allotted by the rules.

III. ORDER

It is

ORDERED that IPR2014-00949 is joined with IPR2014-00901;

FURTHER ORDERED that, subsequent to joinder, the grounds for trial in the joined proceedings are the same as those for which trial was instituted in IPR2014-00949;

FURTHER ORDERED that the Scheduling Order in place for this proceeding and the VMWare IPR is unchanged;

FURTHER ORDERED that, in the joined proceeding, IBM, Oracle, and VMWare will file all papers as consolidated filings and subject to the regular page limits allotted by the rules of the Board, unless the Board grants a motion for additional pages. Each such paper must be filed as a Consolidated Filing.

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FURTHER ORDERED that VMWare, on the one hand, and IBM and Oracle, on the other, will designate attorneys to conduct the cross-examination of any witnesses produced by Patent Owner and the redirect of any witnesses produced by VMWare, IBM and Oracle within the time frame normally allotted by the rules for one party; VMWare, and IBM and Oracle will not receive any separate cross-examination or redirect time;

FURTHER ORDERED that any requests by any party for additional deposition time or additional pages must be brought before the Board;

FURTHER ORDERED that the case caption in IPR2014-00901 shall be changed to reflect joinder with this proceeding in accordance with the caption sample on the next page; and

FURTHER ORDERED that this proceeding (IPR2014-00949) is terminated under 37 C.F.R. § 42.72, and all further filings in the joined proceeding shall be made in IPR2014-00901.

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