UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INTERNATIONAL BUSINESS MACHINES CORPORATION
AND
ORACLE AMERICA, INC.
Petitioners

v.

ELECTRONICS AND TELECOMMUNICATIONS RESEARCH INSTITUTE
Patent Owner

_____

Case No. IPR2014-00949
Patent No. 6,978,346

_____

PATENT OWNER'S MOTION FOR JOINDER
WITH IPR2014-00901

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I.   INTRODUCTION

Pursuant to 37 C.F.R. §§ 42.22 and 42.122(b), the Patent Owner files this motion asking the Board to exercise its discretion under 35 U.S.C. § 315(c) to join this *inter partes* review with identical IPR2014-00901 directed at the same '346 patent under review. This motion is timely filed pursuant to the Board's January 12, 2015 e-mail authorizing the Patent Owner to file this motion by January 16, 2015. None of the collective petitioners (VMware, IBM, and Oracle) oppose joinder of this case (IPR2014-00949) with IPR2014-00901.

II.   SUMMARY OF ARGUMENT

Joinder of this pair of cases is appropriate because the two trials involve identical issues and identical evidence from the petitioners. Joinder would not add any new patentability issues and would not impact the trial schedule at all. Instead, joinder would permit the identical patentability issues to be litigated and decided more efficiently and economically in a single joined proceeding, thereby saving the Board and the parties from having to conduct a duplicative proceeding while also eliminating the risk of inconsistencies. *See* 37 C.F.R. § 42.1 ("This part shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.")

III. STATEMENT OF MATERIAL FACTS

1. VMware filed a petition for *inter partes* review of the '346 Patent on June 4, 2014. That petition was accompanied by a declaration from Dr. Robert Horst. That petition was assigned Case No. IPR2014-00901.

2. On June 13, 2014, IBM and Oracle filed a substantively identical petition, which was assigned Case No. IPR2014-00949. The petition filed by IBM and Oracle included copies of all the same exhibits filed with the IPR2014-00901 petition. It too was supported by Dr. Horst's declaration.

3. On December 11, 2014, the Board instituted an IPR trial in the IPR2014-00901 case on challenge 1, whether Hathorn in view of Mylex renders obvious claims 1-9 of the '346 Patent.

4. On December 11, 2014, the Board also instituted an IPR trial in the IPR2014-00949 case on challenge 1, whether Hathorn in view of Mylex renders obvious claims 1-9 of the '346 Patent.

5. The decisions instituting IPR trials in Case Nos. i IPR2014-00901 and IPR2014-00949 were each accompanied by identical scheduling orders.

IV. ARGUMENT

The Board has discretion under 35 U.S.C. § 315(c) to "join as a party to [an instituted] inter partes review any person who properly files a petition under

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