

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC. and YOUTUBE, LLC,
Petitioners,

v.

PERSONALWEB TECHNOLOGIES, LLC and
LEVEL 3 COMMUNICATIONS, LLC,
Patent Owners.

INTER PARTES REVIEW OF U.S. PATENT NO. 7,802,310

Case IPR: *To Be Assigned*

**MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c),
37. C.F.R. §§ 42.22, 42.122(b), AND 42.5(b)**

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Google Inc. and YouTube, LLC (“Petitioners”) submit concurrently herewith a Petition for *Inter Partes* Review of U.S. Patent No. 7,802,310 (“the ’310 Patent”) (“Petition”) based on identical grounds that form the basis for a pending IPR proceeding, Case No. IPR2014-00062 (“the Rackspace IPR”).

Pursuant to 35 U.S.C. § 315(c), Petitioners respectfully move that this Petition be instituted and joined with the Rackspace IPR filed by Rackspace US, Inc. and Rackspace Hosting, Inc. (collectively, “Rackspace”). The Rackspace IPR was instituted by the Board on April 15, 2014. As discussed herein, Petitioners do not seek to alter the grounds upon which the Board has already instituted the Rackspace IPR, and seek no change in the existing schedule for that IPR proceeding. Petitioners, by this Motion, request an opportunity to join with the Rackspace IPR solely as an “understudy” to Rackspace, where Petitioners would only assume an active role in the event Rackspace settles with PersonalWeb Technologies, LLC (“PersonalWeb”) and Level 3 Communications, LLC (“Level 3”) (collectively, “Patent Owners”) and moves to terminate the Rackspace IPR.

I. SPECIAL CIRCUMSTANCES WARRANT JOINDER

The following special circumstances warrant that the Board exercise its discretion and grant this Motion and Petition, and join the resulting proceeding with the Rackspace IPR. Petitioners also submit that such special circumstances warrant a waiver of certain requirements (including the requirement of Rule 42.122

Google and YouTube Motion for Joinder
that motions for joinder be filed no later than one month after the institution date of
the IPR for which joinder is requested) pursuant to the Board's authority set forth
in Rule 42.5(b):

- 1. The Petitioners are seeking to join an IPR proceeding in its initial stages which is already subject to a stipulated extension.** The Board only recently instituted the Rackspace IPR on April 15, 2014. The Board's scheduling order set Patent Owners' Response for June 16, 2014. *See* IPR2014-00062, Paper No. 10. However, the parties stipulated to a 30-day extension for the Response to July 16, 2014. *See* IPR2014-00062, Paper No. 16. The parties also agreed to delay Rackspace's Reply to the Response until September 15, 2014. *Id.* To date, only the initial telephonic conference has taken place. *See* IPR2014-00062, Paper No. 15. Given the current schedule and the agreed one-month delay in the Rackspace IPR proceedings, Petitioner's request for joinder is occurring at a stage of the proceedings that is contemplated by Rule 42.122(b) – *i.e.*, shortly after Institution and prior to the Patent Owners' Response. Given the early stage of the proceedings, Petitioners submit that joinder is appropriate, and that waiver or suspension of Rule 42.122(b) is appropriate in these circumstances. *See, e.g.*, IPR2013-00495, Paper No. 13 (exercising Board discretion under § 42.5(b) and granting joinder

Google and YouTube Motion for Joinder
motion filed outside the window set forth in § 42.122(b)).

2. Petitioners' request is consistent with the specific set of circumstances under which the Board has, within its discretion, previously approved joinder, and granting this request will not have deleterious effects on future joinder motions. The decisions of the Board suggest that filing a new Petition with identical grounds, a method recently used in other cases, is an acceptable (if not preferred) means to join an instituted IPR. *See, e.g.*, IPR2013-00495, Paper No. 13 (granting, in the Board's discretion, joinder where the petition raises the same grounds from an IPR that has already been instituted); IPR2013-00385, Paper No. 17 (granting joinder where there are no new grounds not already before the Board); *compare* IPR2013-00386, Paper No. 16 (denying joinder where accompanying petition challenged new claims, added new references and raised new grounds of unpatentability). The decisions of the Board also suggest that moving to join an IPR in the limited role of an understudy solely to prevent a Patent Owner from prematurely seeking to terminate an IPR through settlement is an acceptable basis for joining an existing IPR. *See, e.g.*, IPR2013-00495, Paper No. 13 (granting joinder where petitioner agreed to an "understudy" role). The present Petition is consistent with these

Google and YouTube Motion for Joinder decisions and goals and will only confirm, and not expand, the Board's prior decisions.

- 3. Permitting joinder in this circumstance will preserve the Board's significant investment of resources in instituting the Rackspace IPR proceeding (and related ones), ensure its continuation, and prevent great prejudice to Petitioners.** The Board's contemporaneous decisions regarding certain claims of the instant and other related patents confirm that claims of these patents are invalid by a preponderance of the evidence. *See* IPR2013-00082, Paper No. 83 (finding invalid claims of the related '791 patent); IPR2013-00086, Paper No. 66 (finding invalid claims of the related '662 patent); IPR2013-00083, Paper No. 80 (finding invalid claims of the related '280 patent); IPR2013-00087, Paper No. 69 (finding invalid claims of the related '096 patent); IPR2014-00057, IPR2014-00059, IPR2014-00062, IPR2014-00066, Paper No. 9 (instituting proceedings on the '791, '280, '310 and '442 patents, respectively). Indeed, many of the Board's findings in those related proceedings, such as claim construction, have already been incorporated into this IPR. Patent Owner has asserted certain of the claims at issue in this IPR against Petitioner in district court. If the Patent Owner settles with Rackspace, and if a final decision in the Rackspace IPR is not

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