BEFORE THE PATENT TRIAL AND APPEAL BOARD IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Trial No.:	IPR 2014-00978
In re:	U.S. Patent No. 7,802,310
Patent Owners:	PersonalWeb Technologies, LLC & Level 3 Communications
Petitioner:	Google Inc. and YouTube, LLC
Inventors:	David A. Farber and Ronald D. Lachman

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August 25, 2014

PATENT OWNER'S COMBINED OPPOSITION TO PETITIONER'S MOTION FOR JOINDER AND PRELIMINARY RESPONSE

Petitioner (Google Inc. and YouTube, LLC) filed a motion for joinder along with its petition on June 18, 2014. This opposition to the motion for joinder was authorized by the Order dated June 25, 2014 in this proceeding. Patent Owner PersonalWeb (PO) has, in this brief, combined its (i) opposition to the motion for joinder, and (ii) preliminary response to the petition.

I. PETITIONER'S MOTION FOR JOINDER DIRECTLY CONFLICTS WITH RULE 41.122

Rule 41.122(b) expressly requires that "any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any inter partes review for which joinder is requested." (emphasis added.) Here, the Rackspace IPR with which Petitioner seeks joinder (IPR2014-00062) was instituted on April 15, 2014. Petitioner file its joinder motion very late, contrary to the rule. Indeed, Petitioner filed its motion for joinder on June 18, 2014, which is more than two months after the April 15, 2014 institution date. Thus, the motion for joinder is not authorized by Rule 41.122, and instead is directly contrary to that applicable rule. Moreover, because Petitioner filed its motion for joinder and petition well beyond the required one month period, the Rackspace IPR with which joinder is requested is now in its advanced stages and not reasonably subject to joinder with this matter.

Moreover, Petitioner provides no credible explanation or reason regarding why it did not comply with Rule 41.122(b). Petitioner has provided absolutely no reason as to why it could not have filed its petitioner and motion for joinder within

one month of the institution decision in the IPR with which it seeks joinder. Petitioner's delay is particularly inexcusable given that Petitioner has been aware of the patent at issue for a very long time, and at least since it was served with a complaint alleging infringement of that patent in December 2011. (Ex. 2001.) Petitioner's delay of over two years in filing its petition, and its motion for joinder, have not been adequately explained in any respect.

Moreover, the petition is barred by 35 U.S.C. § 315(b) because it was filed more than one year after petitioner was served with a complaint alleging infringement of the patent at issue. (Ex. 2001.) Petitioner readily admits in its motion for joinder that it was sued for infringement of the patent at issue in December, 2011 – well more than one year prior to the June 18, 2014 filing date of the petition. The petition and motion for joinder should be denied for this reason as well. And, again, the 2+ year delay in filing a petition and motion for joinder have not been adequately explained. Furthermore, Petitioner's alleged grounds for standing in the petition indicate that the petition must be denied if the motion for joinder is denied, due to the service of the complaint on petitioner over two years before the petition was filed.

II. JOINDER WOULD COMPLICATE AND DELAY THE RACKSPACE IPR, WASTE JUDICIAL RESOURCES, AND BE PREJUDICIAL TO PATENT OWNER

The Rackspace IPR with which joinder is sought is in its advanced stages. PO has already filed its main response and has already taken depositions. And

Rackspace will be deposing Dr. Dewar next week. Introduction of additional parties and additional attorneys at this late stage may well further complicate and delay that proceeding. Google and YouTube did not participate in the depositions in the Rackspace IPR, and were not served with any evidentiary objections or briefs in that IPR. Moreover, Google and YouTube have expressly stated that there are circumstances where they would take an "active" role in the Rackspace IPR, *i.e.*, additional attorney arguments are contemplated by Petitioner. It would be highly prejudicial to PO if Google and/or YouTube were ever permitted to take an active role in the late-stage Rackspace IPR for any reason, where they never participated in any depositions, were never served with any briefs or evidence, never made any evidentiary objections, and may not be subject to evidentiary objections. It is entirely unclear how the IPR rules would apply to a party that was never served with any briefs, evidence, or evidentiary objections in an IPR, and which never participated in any of the depositions of an IPR. Moreover, if Google and YouTube were to be joined in the Rackspace IPR, PO may well want to take additional depositions which would still further delay that IPR – which again would be prejudicial to PO.

Additionally, the Google/YouTube IPR is wasteful and its institution or joinder with another proceeding would be a waste of both judicial resources and PO's resources given its significant overlap with numerous other proceedings. The patent at issue (the '310 patent) is the subject of two (2) other administrative

proceedings, each of which involves the same '310 patent the same art to Woodhill: (a) the Rackspace IPR (IPR 2014-00062); and (b) IPR2013-00596. This IPR would be prejudicial to PO and an inefficient use of judicial resources, and represents further reasons why the requested joinder and the petition should be denied. PO should not be forced to deal with yet another party in an IPR involving the same '310 patent. The Board should exercise its authority/discretion and terminate this proceeding. Office Patent Trial Practice Guide, 77 Fed. Reg. 48756-48757 (Aug. 14, 2012) ("Where there are multiple matters in the Office involving the same patent, the Board may determine how the proceedings will proceed, including providing for a stay, transfer, consolidation, or *termination* of any such matter.") (emphasis added).

III. LACK OF DILIGENCE BY GOOGLE/YOUTUBE

Whether or not Petitioner was diligent in filing its request for joinder should also be considered. *Microsoft Corp. v. ProxyConn, Inc.*, IPR 2013-00109 (Paper No. 15) (PTAB Feb. 25, 2013). As explained above, Petitioner was served with the complaint for patent infringement in 2011. Petitioner did nothing until June, 2014. Moreover, Petitioner ignored the one month time period called for in Rule 42.122(b). Both of these significant delays demonstrate a substantial lack of diligence on the part of Petitioner in this matter. Petitioner offers no plausible explanation for the delays.

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