

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.

Case IPR2014-00980
Patent 5,978,791

Before KEVIN F. TURNER, JONI Y. CHANG, and
MICHAEL R. ZECHER, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION

Denying Google's Motion for Joinder and
Denying Institution of *Inter Partes* Review
37 C.F.R. §§ 42.108 and 42.122

I. INTRODUCTION

Petitioners, Google Inc. and YouTube, LLC (collectively “Google”), filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–4, 29–33, 35, and 41 of U.S. Patent No. 5,978,791 (“the ’791 patent,” Ex. 1001). Paper 1. Google filed its Petition along with a Motion for Joinder requesting that we join Google as a party with *Rackspace US, Inc. v. PersonalWeb Techs. LLC*, IPR2014-00057. Paper 3, “Google Mot.” In IPR2014-00057, we instituted the same grounds of unpatentability over the same claims at issue in this proceeding. *Compare* IPR2014-00057, Paper 9, with Pet. 7, 27–55. Patent Owners, PersonalWeb Technologies, LLC and Level 3 Communications, LLC (collectively “PersonalWeb”), timely filed a combined Preliminary Response and Opposition to Google’s Motion for Joinder. Paper 7. We have jurisdiction under 35 U.S.C. § 314.

For the reasons discussed below, we deny Google’s Motion for Joinder as untimely and, as a result, deny the Petition because it is barred under 35 U.S.C. § 315(b).

II. BACKGROUND

Based on authority delegated to us by the Director, we have discretion to join an *inter partes* review with another *inter partes* review under 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.

Our patent trial regulations for *inter partes* reviews address the appropriate time frame for filing a motion for joinder. 37 C.F.R. § 42.122(b) provides, in relevant part (emphasis added), “[a]ny 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.*”

Normally, 35 U.S.C. § 315(b) bars institution of an *inter partes* review when the petition is filed more than one year after the petitioner (or petitioner’s real party in interest or privy) is served with a complaint alleging infringement of the patent. Our patent trial regulations for *inter partes* reviews include the same provision. 37 C.F.R. § 42.101(b). The one-year time bar, however, does not apply to a request for joinder. 35 U.S.C. § 315(b) (final sentence); 37 C.F.R. § 42.122(b) (final sentence). This is an important consideration here because it is undisputed that Google filed the Petition on June 18, 2014, which is more than a year after Google was served with a complaint alleging infringement of the ’791 patent on December 12, 2011. Ex. 2001; *see also* Pet. 3 (Google confirms that PersonalWeb asserted the ’791 patent against it in a district court case filed on December 8, 2011); Google Mot. 8 (Google confirms that, in 2011, PersonalWeb sued thirteen different companies, including Google, for allegedly infringing the ’791 patent). Thus, absent joinder of Google as a party to IPR2014-000057, the Petition is barred.

III. ANALYSIS

1. *Google's Motion for Joinder Was Untimely*

First, we note that Google did not file its Motion for Joinder within one month after we instituted an *inter partes* review in IPR2014-00057, as required by 37 C.F.R. § 42.122(b). Notwithstanding that Google did not file its Motion for Joinder within the one-month time limit imposed under § 42.122(b), Google contends that we should exercise our discretion under § 42.5(b) to waive this rule. Google Mot. 1–7. Section 42.5(b) provides that “[we] may waive or suspend a requirement of parts 1, 41, and 42 and may place conditions on the waiver or suspension.” Absent special circumstances, we are reluctant to exercise our discretion under § 42.5(b) to waive the one-month time limit for filing a motion for joinder under § 42.122 (b).

As we explained previously, we instituted an *inter partes* review in IPR2014-00057 on April 15, 2014. IPR2014-00057, Paper 9. Pursuant to § 42.122(b), if Google desired to join IPR2014-00057 as a party, it was required to file a motion for joinder no later than May 15, 2014. Google, however, did not file its Motion for Joinder until June 18, 2014. Google attempts to justify this delay by arguing that the parties in IPR2014-00057 stipulated to a thirty day extension for DUE DATES 1 and 2 (IPR2014-00057, Paper 17) and, at the time it filed its Motion for Joinder, only the initial conference call had occurred (IPR2014-00057, Paper 16). Google Mot. 2. Google asserts that given the revised schedule stipulated to by the parties in IPR2014-00057, its request for joinder was filed during a stage in IPR2014-00057 that is contemplated by § 42.122(b), i.e., shortly after the

date of institution, but prior to PersonalWeb filing its Patent Owner Response. *Id.*

We are not persuaded by Google’s argument. Simply because the parties in IPR2014-00057 stipulated to new dates for DUE DATES 1 and 2—a common practice in proceedings before us—does not constitute a special circumstance that would persuade us to waive the one-month time limit for Google to file its Motion for Joinder. In addition, merely because, at the time Google filed its Motion for Joinder, IPR2014-00057 was in the early stages of trial, e.g., only the initial conference call had occurred, does not constitute a special circumstance that would persuade us to waive the one-month time limit for Google to files its Motion for Joinder. Without more compelling reasons, we decline to exercise our discretion under § 42.5(b) to waive the one-month time limit for Google to file its Motion for Joinder under § 42.122(b). As such, Google’s Motion for Joinder was untimely.

2. *The Termination of IPR2014-00057 Renders
Google’s Motion for Joinder Moot*

Although we deny Google’s Motion for Joinder as untimely, there is at least one additional consideration that weighs in favor of dismissing Google’s Motion for Joinder as moot. On October 10, 2013, Rackspace US, Inc. and Rackspace Hosting, Inc. (collectively “Rackspace”) filed a Petition requesting an *inter partes* review of claims 1–4, 29–33, 35, and 41 of the ’791 patent. IPR2014-00057, Paper 1. PersonalWeb timely filed a Preliminary Response. IPR2014-00057, Paper 8. As discussed previously, on April 15, 2014, upon consideration of the information presented in Rackspace’s Petition, as well as the arguments presented in PersonalWeb’s

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