

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC. and AVAYA, INC.,
Petitioner,

v.

STRAIGHT PATH IP GROUP, INC.,
Patent Owner.

Case IPR2015-01011
Patent 6,108,704 C1

Before KALYAN K. DESHPANDE, TRENTON A. WARD, and
BART A. GERSTENBLITH, *Administrative Patent Judges*.

DESHPANDE, *Administrative Patent Judge*.

DECISION
Motion for Joinder
37 C.F.R. § 42.122(b)

INTRODUCTION

Cisco Systems, Inc. and AVAYA, Inc. (collectively, “Petitioner”) filed a Petition requesting an *inter partes* review of claims 1, 11, 12, 14, 16, 22, 23, 27, 30, and 31 of U.S. Patent No. 6,108,704 C1 (Ex. 1001, “the ’121 patent”). Paper 2 (“Pet.”). With the Petition, Petitioner filed a Motion for Joinder (Paper 4, “Mot.”), seeking to join this case with *Samsung Elecs. Co. v. Straight Path IP Grp., Inc.*, IPR2014-01366 (PTAB Mar. 6, 2015), filed by Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (collectively, “Samsung”). Petitioner indicates that Patent Owner does not oppose the Motion for Joinder. Mot. 1. In a separate decision, entered today, we institute an *inter partes* review as to the same claims and the same ground of unpatentability for which we instituted trial in *Samsung Elecs. Co. v. Straight Path IP Grp., Inc.*, IPR2014-01366. For the reasons that follow, Petitioner’s Motion for Joinder is *granted*.

BACKGROUND

Petitioner filed its Petition and Motion for Joinder on April 6, 2015, within one month after the institution date of IPR2014-01366. On May 5, 2014, we held a conference call with counsel for the respective parties. During the conference call, Patent Owner indicated that all of the parties intended to file a stipulated proposed order defining the parameters of joinder. The parties filed the stipulated proposed order on May 6, 2015. *See* Paper 10.

The Petition in this case asserts at least the grounds that claims 1, 11, 12, 22, and 23 of the '704 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over Microsoft Manual¹ and NetBIOS,² and claims 14, 16, 27, 30, and 31 are unpatentable under 35 U.S.C. § 103(a) as obvious over Microsoft Manual, NetBIOS, and Palmer.³ Pet. 7, 35–54. These are the same claims and the same grounds for which we instituted trial in IPR2014-01366. *Samsung Elecs. Co. v. Straight Path IP Grp., Inc.*, IPR2014-01366, slip op. at 22 (PTAB Mar. 6, 2014) (Paper 12).

ANALYSIS

The Leahy-Smith America Invents Act, Pub. L. No. 112-29 (2011), permits joinder of like review proceedings. Thus, 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 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.

¹ MICROSOFT WINDOWS NT 3.5, TCP/IP USER GUIDE (1994) (Ex. 1012, “Microsoft Manual”).

² THE OPEN GROUP, TECHNICAL STANDARD, PROTOCOLS FOR X/OPEN PC INTERWORKING: SMB, VERSION 2.0 (1992) (Ex. 1014, “NetBIOS”).

³ U.S. Patent No. 5,375,068, issued Dec. 20, 1994 (Ex. 1020, “Palmer”).

As the movant, Petitioner bears the burden to show that joinder is appropriate. 37 C.F.R. § 42.20(c). In its Motion for Joinder, Petitioner contends that joinder is appropriate because “it is the most expedient way to secure the just, speedy, and inexpensive resolution of the related proceedings” because (1) Petitioner represents that IPR2015-01011 is identical to IPR2014-01366 in all substantive aspects, including identical grounds, analysis, exhibits, and relies upon the same expert declaration; (2) Petitioner agrees to (a) incorporate its filings with Samsung, (b) not advance any separate arguments from those advanced by Samsung, and (c) to consolidated discovery; (3) joinder will not have any impact on the IPR2014-01366 schedule; and (4) there will be no prejudice to Patent Owner. Mot. 4–8.

Acting on behalf of the Director, we have discretion to join proceedings. 35 U.S.C. § 315(c). In exercising our discretion, we consider the impact of both substantive issues and procedural matters on the proceedings.

The substantive issues in IPR2014-01366 will not be affected by joinder because Petitioner asserts the ground of unpatentability for which trial was instituted in IPR2014-01366, presents the same arguments as those advanced by Samsung, and, therefore, our analysis would similarly institute review of the claims for the same grounds for which trial was instituted in IPR2014-01366. *Compare* Pet. 35–54 with *Samsung Elecs. Co. v. Straight Path IP Grp., Inc.*, IPR2014-01366, Paper 1, 32–49. Further, Petitioner submits the same Declaration of Dr. Henry Houh that Samsung submitted in

support of its Petition. *See* Ex. 1004; *Samsung Elecs. Co. v. Straight Path IP Grp., Inc.*, IPR2014-01366, Ex. 1004. Thus, the Petition in this proceeding raises no new issues beyond those already before the Board in IPR2014-01366.

Regarding procedural matters, Petitioner argues that joinder would not require any change to the trial schedule in IPR2014-01366. Mot. 7. Petitioner further argues that joinder would “permit Petitioner to maintain its ongoing interests in the Board’s review of the ’704 patent” in the event Samsung withdraws from the proceeding. *Id.* at 8.

EXHIBIT 1001 REEXAMINATION CERTIFICATE

Exhibit 1001, in IPR2014-01366, does not include the Reexamination Certificate. For example, amended claim 14 depends on amended claim 11, which recites the same limitations as originally issued claims 10 and 11. Samsung, in its Petition, presented arguments directed toward the claims as amended. *See Samsung Elecs. Co. v. Straight Path IP Grp., Inc.*, IPR2014-01366, Paper 1. Petitioner, Samsung, and Patent Owner have not raised any arguments or issues based on the failure to include the Reexamination Certificate in Exhibit 1001. However, all further arguments must be directed to the claims as amended by the Reexamination Certificate. Samsung and Petitioner shall file a corrected Exhibit 1001 in IPR2014-01366 that includes the Reexamination Certificate.

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