

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 IPR2015-01397
Patent 6,131,121 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 3, 4, and 6–14 of U.S. Patent No. 6,131,121 C1 (Ex. 1001, “the ’121 patent”). Paper 3 (“Pet.”). With the Petition, Petitioner filed a Motion for Joinder (Paper 2, “Mot.”),

seeking to join this case with *Samsung Elecs. Co. v. Straight Path IP Grp., Inc.*, IPR2015-00196, filed by LG Electronics, Inc., Toshiba Corp., VIZIO, Inc., and Hulu, LLC (collectively, “LG”). Patent Owner does not oppose the Motion for Joinder. Paper 8, 2. In a separate decision, entered today, we institute an *inter partes* review as to the same claims on the same ground of unpatentability for which we instituted trial in *LG Elecs., Inc. v. Straight Path IP Grp., Inc.*, IPR2015-00196. For the reasons that follow, Petitioner’s Motion for Joinder is *granted*.

BACKGROUND

Petitioner filed its Petition and Motion for Joinder on June 15, 2015, within one month after the institution date of IPR2015-00196. Petitioner’s Motion for Joinder includes a proposed order defining the parameters of joinder. *See* Mot. 9–10.

The Petition in this case asserts that claims 3, 4, and 6–14 of the ’121 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over WINS¹ and NetBIOS.² Pet. 29–59. These are the same claims and the same ground for which we instituted trial in IPR2015-00196. *LG Elecs., Inc. v. Straight Path IP Grp., Inc.*, Case IPR2015-00196, slip op. at 9–19 (PTAB May 15, 2015) (Paper 20).

ANALYSIS

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

¹ MICROSOFT WINDOWS NT SERVER VERSION 3.5, TCP/IP USER GUIDE, © 1994 Microsoft Corporation (Ex. 1003, “WINS”).

² X/OPEN PC INTERWORKING: SMB, VERSION 2, THE OPEN GROUP, © September 1992, X/Open Company Limited (Ex. 1004, “NetBIOS”).

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.

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.” Mot. 4. In particular, Petitioner (1) represents that IPR2015-01397 is identical to IPR2015-00196 in all substantive aspects, including identical grounds, analysis, exhibits, and relies upon the same expert Declaration; (2) agrees to (a) incorporate its filings with LG, (b) not advance any arguments separate from those advanced by LG, and (c) consolidated discovery; (3) represents that joinder will not have any impact on the IPR2015-00196 schedule; and (4) asserts that there will be no prejudice to Patent Owner. *Id.* at 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 IPR2015-00196 will not be affected by joinder because Petitioner asserts the same ground of unpatentability, for

which trial was instituted in IPR2014-00196, presents the same arguments as those advanced by LG, and, therefore, our analysis would similarly institute review of the claims for the same ground for which trial was instituted in IPR2015-00196. *Compare* Pet. 29–59 with *LG Elecs., Inc. v. Straight Path IP Grp., Inc.*, Case IPR2015-00196, Paper 1, 29–59. Further, Petitioner submits the same Declaration of Dr. Bruce M. Maggs that Samsung submitted in support of its Petition. *See* Ex. 1002; *LG Elecs., Inc. v. Straight Path IP Grp., Inc.*, Case IPR2015-00196, Ex. 1002. Thus, Petitioner asserts that the Petition in this proceeding raises no new issues beyond those already before the Board in IPR2015-00196.

Regarding procedural matters, Petitioner argues that joinder would not require any change to the trial schedule in IPR2015-00196. Mot. 6–7. Petitioner further argues that joinder would “permit Petitioners to maintain their ongoing interests in the Board’s review of the ’121 patent” in the event Samsung withdraws from the proceeding. *Id.* at 8.

CONCLUSION

Under the circumstances, we conclude Petitioner has demonstrated that joinder will not unduly complicate or delay IPR2015-00196, and therefore joinder is appropriate. Petitioner’s Motion for Joinder is *granted*.

ORDER

Accordingly, it is:

ORDERED that Petitioner’s Motion for Joinder with IPR2015-00196 is *granted*;

FURTHER ORDERED that this proceeding is joined with IPR2015-00196;

FURTHER ORDERED that the ground on which a trial was instituted in IPR2015-00196 is unchanged and that no other grounds raised in the IPR2015-01397 Petition are authorized for *inter partes* review;

FURTHER ORDERED that the Scheduling Order for IPR2015-00196 (Paper 21) shall govern the joined proceedings;

FURTHER ORDERED that throughout the proceeding, LG and Petitioner will file papers as consolidated filings, except for motions that do not involve the other party, in accordance with the Board's established rules regarding page limits. So long as they both continue to participate in the merged proceeding, LG and Petitioner will identify each such filing as a Consolidated Filing and will be responsible for completing all consolidated filings;

FURTHER ORDERED that Petitioner will refrain from requesting or reserving any additional depositions or deposition time;

FURTHER ORDERED that LG and Petitioner will jointly conduct the cross-examination of any given witness produced by Patent Owner and the redirect of any given witness produced by LG or Petitioner within the timeframe normally allotted by the rules for one party. LG and Petitioner will not receive any separate cross-examination or redirect time;

FURTHER ORDERED that Patent Owner will conduct any cross-examination of any given witness jointly produced by LG or Petitioner and the redirect of any given witness produced by Patent Owner within the time frame normally allotted by the rules for one cross-examination or redirect examination;

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