

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 IPR2015-01398
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, 19, 22, 23, 27, 30, and 31 of U.S. Patent No. 6,108,704 C1 (Ex. 1001, “the ’704 patent”). Paper 4 (“Pet.”). With the Petition, Petitioner filed a Motion for

IPR2015-01398
Patent 6,108,704 C1

Joinder (Paper 3, “Mot.”), seeking to join this case with *LG Elecs., Inc. v Straight Path IP Grp., Inc.*, IPR2015-00209, 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.*, IPR2015-00209. 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 IPR2015-00209. 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 claim 1 of the ’704 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over WINS¹ and NetBIOS² and claims 11, 12, 14, 16, 19, 22, 23, 27, 30, and 31 of the ’704 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over WINS, NetBIOS, and Pinard.³ Pet. 34–60. 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 IPR2015-00209, slip op. at 9–23 (PTAB May 15, 2015) (Paper 20).

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

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

³ U.S. Patent No. 5,533,110, issued July 2, 1996 (Ex. 1020, “Pinard”).

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.

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. Petitioner (1) represents that IPR2015-01398 is identical to IPR2015-00209 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 IPR2015-00209 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 IPR2015-00209 will not be affected by joinder because Petitioner asserts the same ground of unpatentability, for which trial was instituted in IPR2014-00209, 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 IPR2014-01368. *Compare* Pet. 34–60 with *LG Elecs., Inc. v. Straight Path IP Grp., Inc.*, Case IPR2015-00196, Paper 1, 34–60. 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 IPR2015-00209, Ex. 1002. Thus, Petitioner asserts that the Petition in this proceeding raises no new issues beyond those already before the Board in IPR2015-00209.

Regarding procedural matters, Petitioner argues that joinder would not require any change to the trial schedule in IPR2015-00209. Mot. 6–7. Petitioner further argues that joinder would “permit Petitioners to maintain their ongoing interests in the Board’s review of the ’704 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 IPR2015-00209, and therefore joinder is appropriate. Petitioner’s Motion for Joinder is *granted*.

ORDER

Accordingly, it is:

ORDERED that Petitioner's Motion for Joinder with IPR2015-00209 is *granted*;

FURTHER ORDERED that this proceeding is joined with IPR2015-00209;

FURTHER ORDERED that the ground on which a trial was instituted in IPR2015-00209 is unchanged and that no other grounds raised in the IPR2015-01398 Petition are authorized for *inter partes* review;

FURTHER ORDERED that the Scheduling Order for IPR2015-00209 (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;

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.