

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERNATIONAL BUSINESS MACHINES CORPORATION,
Petitioner,

v.

PARALLEL NETWORKS LICENSING, LLC,
Patent Owner.

Case IPR2015-01729
Patent 5,894,554

Before KEVIN F. TURNER, JEREMY M. PLENZLER, and
CHRISTOPHER L. CRUMBLEY, *Administrative Patent Judges*.

CRUMBLEY, *Administrative Patent Judge*.

DECISION

Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b)

I. INTRODUCTION

Petitioner, International Business Machines Corporation (“IBM”), filed a Petition requesting *inter partes* review of claims 12–19, 32, 34, 46, and 48 of U.S. Patent No. 5,894,554 (Ex. 1001, “the ’554 patent”). Paper 1, “Pet.” Concurrently with its Petition, IBM filed a Motion for Joinder (Paper 3, “Mot.”), seeking to join as a Petitioner, under 35 U.S.C. § 315(c), the pending *inter partes* review in *Microsoft Corp. v. Parallel Networks Licensing, LLP*, Case IPR2015-00483 (“the Microsoft IPR”), which was instituted on July 15, 2015. See IPR2015-00483, Paper 10.¹

On October 22, 2015, Patent Owner, Parallel Networks Licensing, LLC (“Parallel”), filed a Notice electing to waive a preliminary response to the Petition. Paper 8. Parallel also filed a Non-Opposition to IBM’s Motion for Joinder. Paper 7.

For the reasons explained below, we grant IBM’s Motion for Joinder.

II. DISCRETION TO GRANT JOINDER

As a threshold matter, we determine that IBM’s Motion for Joinder was timely. Our Rules provide that a request for joinder must be filed “no later than one month after the institution date of any *inter partes* review for which joinder is requested.” 37 C.F.R. § 42.122(b). IBM’s Motion was filed August 14, 2015, less than one month after the July 15, 2015 institution date of the Microsoft IPR.

The controlling statute regarding joinder of *inter partes* reviews is 35 U.S.C. § 315(c), which reads as follows:

¹ Following institution, IPR2015-00484 was consolidated with IPR2015-00483.

(c) 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.

By regulation, the Director's discretion has been delegated to the Board. 37 C.F.R. § 42.4(a). We, therefore, have discretion to join IBM to the instituted Microsoft IPR if we determine that IBM's Petition warrants institution of an *inter partes* review.

The grounds of unpatentability asserted in the instant Petition are the same as those presented in the Microsoft IPR. *Compare* Pet. 4–5 with IPR2015-00483, Paper 1, 5. IBM states that its Petition includes the same claim constructions and arguments as those presented by Microsoft, and is relying on the same evidence and same expert declaration as relied upon in the Microsoft IPR. Mot. 4–5.

We previously determined, upon consideration of the Microsoft IPR Petition and Parallel's Preliminary Response, that the record in the Microsoft IPR established a reasonable likelihood that Microsoft would prevail with respect to all challenged claims on all presented grounds. IPR2015-00483, Paper 10, 22–23. Given the identical grounds and evidence presented in the present proceeding, we likewise determine that IBM's Petition warrants institution on all presented grounds. We rely on, and hereby incorporate by reference, the reasoning set forth in our Decision on Institution in the Microsoft IPR. *See id.*

III. GRANT OF MOTION FOR JOINDER

Having determined that IBM's Petition warrants institution, we must determine whether to exercise our discretion to join IBM as a party to the Microsoft IPR.

IBM contends that joinder is appropriate because maintaining two separate proceedings that are substantively identical would require duplication of effort, and hinder the just, speedy, and inexpensive resolution of the proceedings. Mot. 5. Furthermore, if the proceedings are joined, IBM agrees to consolidate its substantive filings, discovery, and hearing argument with those of Microsoft, and agrees not to make arguments separate from those advanced in the consolidated filings. *Id.* at 6–7. Although IBM counsel will attend depositions of any witnesses, IBM agrees that Microsoft counsel will be responsible for conducting the deposition and the depositions will be taken during the normal time period allotted by our Rules. *Id.* at 6. Finally, IBM does not seek any change to the Scheduling Order already in place in the Microsoft IPR. *Id.* at 7.

IBM requests that the Board enter an Order similar to that issued in *The Gillette Company v. Zond, LLC*, Case IPR2014-01012 (PTAB October 23, 2014) (Paper 13), stating that IBM and Microsoft will engage in consolidated filings and discovery. Mot. 8. The Motion contains a proposed joinder order for our consideration. *Id.* at 8–9.

As noted above, Parallel does not oppose IBM's request to join the Microsoft IPR. Paper 7. During a conference call with the Board on October 6, 2015, counsel for Microsoft stated that Microsoft does not oppose IBM's request for joinder, and that Microsoft would agree to a joinder order as proposed by IBM, including consolidated filings and discovery.

Upon review, IBM's Motion demonstrates that joinder of IBM to the Microsoft IPR is appropriate, and will lead to the more efficient resolution of the proceedings. As noted above, the instant Petition does not assert any new ground of unpatentability that is not already being considered in the Microsoft IPR, relies on the same arguments and evidence, and does not require any modification to the existing schedule. We, therefore, determine that joinder will not unduly complicate or delay the proceedings. For these reasons, we grant IBM's Motion for Joinder, subject to the requirements set forth in the Order below.

IV. ORDER

Accordingly, it is

ORDERED that IBM's Motion for Joinder (Paper 3) is *granted*;

FURTHER ORDERED that IBM is joined as a Petitioner to IPR2015-00483;

FURTHER ORDERED that the grounds on which IPR2015-00483 was instituted are unchanged, and no other grounds are instituted in the consolidated proceeding beyond those set forth in IPR2015-00483, Paper 11;

FURTHER ORDERED that the Scheduling Order in place for IPR2015-00483 shall continue to govern the joined proceeding;

FURTHER ORDERED that, throughout IPR2015-00483, any paper, except for a motion that does not involve the other party, shall be filed by Microsoft as a single, consolidated filing on behalf of Microsoft and IBM, pursuant to the page limits set forth in 37 C.F.R. § 42.24, and Microsoft will identify each such filing as a consolidated filing;

FURTHER ORDERED that except as otherwise agreed by all parties, counsel for Microsoft will conduct cross-examination and other discovery on

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