

Paper No. \_\_\_\_\_

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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DELL INC., HEWLETT-PACKARD COMPANY, and NETAPP, INC.,  
Petitioners,

v.

ELECTRONICS AND TELECOMMUNICATIONS RESEARCH INSTITUTE,  
Patent Owner.

Case IPR2015-00549  
Patent No. 6,978,346

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**MOTION FOR JOINDER**  
**PURSUANT TO 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22, and 42.122(b)**

Petitioners Dell Inc., Hewlett-Packard Company, and NetApp, Inc. (“Petitioners”) file this Motion for Joinder of their petition for *inter partes* review of claims 1-9 of U.S. Patent No. 6,978,346 (the “Joinder Petition”), with the instituted *inter partes* review, *VMware, Inc., v. Electronics and Telecommunications Research Institute*, Case IPR2014-00901 (the “VMware IPR”), pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b). No fee is required for this motion.<sup>1</sup>

**I. APPLICABLE RULES**

37 C.F.R. § 42.122(b) states:

*Request for joinder.* Joinder may be requested by a patent owner or petitioner. Any 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. The time period set forth in § 42.101(b) shall not apply when the petition is accompanied by a request for joinder.

**II. RELIEF REQUESTED**

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<sup>1</sup> It is Petitioners’ understanding that the parties to the VMware IPR have requested a conference call with the Board to seek approval to file a motion for joinder of the VMware IPR with IPR2014-00949 (the “IBM/Oracle IPR”). Should the Board merge the VMware IPR and the IBM/Oracle IPR, Petitioners alternatively request that the Joinder Petition be merged with the proceeding that results from the merger of the VMware IPR and the IBM/Oracle IPR. The Petitioners in the IBM/Oracle IPR, specifically International Business Machines Corp. (“IBM”) and Oracle America, Inc. (“Oracle”), do not oppose such joinder.

In this motion, Petitioners request that the Joinder Petition be joined with the VMware IPR.

### **III. STATEMENT OF MATERIAL FACTS**

1. On November 30, 2012, Safe Storage, LLC, the purported exclusive licensee of Electronics and Telecommunications Research Institute (“ETRI” or “Patent Owner”), filed suit against Petitioners in the District of Delaware, alleging infringement of U.S. Patent No. 6,978,346 (the “’346 Patent”). *Safe Storage LLC v. Dell Inc.*, 1:12-cv-01624-GMS, *Safe Storage LLC v. Hewlett-Packard Co. and 3PAR Inc.*, 1:12-cv-01626-GMS, *Safe Storage LLC v. NetApp, Inc.*, 1:12-cv-01628-GMS (the “Concurrent Litigation”).

2. On May 23, 2013, Safe Storage, LLC filed suit against VMware, Inc. (“VMware”) in the district of Delaware, alleging infringement of the ’346 Patent. *Safe Storage LLC v. VMware Inc.*, 1:13-cv-00928-GMS.

3. On September 27, 2013, Petitioners filed IPR2013-00635 (the “DHPN IPR”) requesting review of claims 1-9 of the ’346 Patent.

4. On March 20, 2014, the Patent Trial and Appeal Board (“Board”) entered its decision authorizing an *inter partes* review to be instituted in the DHPN IPR for claims 1-3 and 5-8 of the ’346 Patent as being anticipated under 35 U.S.C. § 102(e) by Hathorn.

5. On June 4, 2014, Petitioner VMware was granted a filing date for the the VMware IPR petition requesting review of claims 1-9 of the '346 Patent.

6. On December 11, 2014, the Board entered its decision authorizing an *inter partes* review to be instituted in the VMware IPR for claims 1-9 of the '346 Patent as being obvious under 35 U.S.C. § 103 over Mylex in view of Hathorn.

7. The '346 patent is also the subject of the IBM/Oracle IPR (instituted December 11, 2014), the petition for which was substantively identical to the petition for the VMWare IPR.

8. Concurrently with this Motion, Petitioners are filing the Joinder Petition for *inter partes* review that is substantively identical to the petition for the VMware IPR, includes the same exhibits, and challenges claims 1-9 of the '346 Patent as obvious under 35 U.S.C. § 103 over Mylex in view of Hathorn. The Joinder Petition further requests that institution be granted solely as to the grounds for which institution was granted in the VMware IPR.

9. Petitioners are filing this Motion and the Joinder Petition within one month of the institution date of the VMware IPR.

10. The Petitioners of the VMware IPR do not oppose this Joinder Petition. Furthermore, The Petitioners of the IBM/Oracle IPR do not object to the

present Petitioners' motion to join the VMware IPR (or alternatively any combined proceeding resulting from joinder of the VMware IPR with the IBM/Oracle IPR).

### **III. ARGUMENT**

The Board has authority under 35 U.S.C. § 315(c) to join a properly-filed subsequent *inter partes* review petition to an instituted *inter partes* review proceeding. This request for joinder is timely and the time periods set forth in 37 C.F.R. § 42.101(b) do not apply to the Joinder Petition because it is accompanied by this request for joinder. 37 C.F.R. § 42.122(b). Specifically, even though the Joinder Petition is filed more than one year after the date of the Concurrent Litigation, 37 C.F.R. § 42.122(b) allows for filing of the Joinder Petition and this request for joinder within one month of institution of the VMware IPR.

According to Frequently Asked Question (“FAQ”) H5 on the Board’s website at [www.uspto.gov/ip/boards/bpai/prps.jsp](http://www.uspto.gov/ip/boards/bpai/prps.jsp), a motion for joinder “should [1] address the reasons why joinder is appropriate, [2] identify any new ground(s) of unpatentability asserted in the petition, and [3] explain what impact (if any) joinder would have on the schedule for the existing review.”

As set forth in detail below, the Board should institute *inter partes* review based on the Joinder Petition, and this Motion for Joinder should be granted because it (1) furthers the policy goals of *inter partes* review; (2) adds no new

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