

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

ELECTRONICS AND TELECOMMUNICATIONS RESEARCH,
INSTITUTE,
Patent Owner.

Case IPR2015-00549
Patent 6,978,346 B2

Before BRIAN J. McNAMARA, MIRIAM L. QUINN, and
GREGG I. ANDERSON, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

DECISION

Denial of Institution of *Inter Partes* Review and
Denial of Motion for Joinder
37 C.F.R. § 42.108(b)
37 C.F.R. § 42.122(a) and (b)

I. INTRODUCTION

On January 8, 2015, Dell, Inc., Hewlett-Packard Company, and NetApp, Inc. (“collectively Petitioner”) filed a Petition (“Pet.”) for *inter partes* review of U.S. Patent No. 6,978,346 B2 (Ex. 1001, “the ’346 patent”). Paper 1. Patent Owner waived a Preliminary Response and concurrently represented it did not oppose joinder. Paper 8. Petitioner filed a Motion for Joinder (“Mot.”) to join this proceeding with *VMWare, Inc. v. Electronics and Telecommunications Research Institute*, Case IPR2014-00901 (“’901 IPR”).¹ Paper 5. We entered a Decision on Institution (“Dec. Inst.,” Paper 14) in the ’901 IPR on December 11, 2014. ’901 IPR, Paper 14. This case and the ’901 IPR both involve the ’346 patent.

The Petition for *inter partes* review and Motion for Joinder are denied.

II. ANALYSIS

A. Denial of Petition for Inter Partes Review

1. Background

The Petition asserts the asserted grounds are identical to those on which we instituted review in the ’901 IPR. Pet. 1; Mot. 7. In the ’901 IPR we instituted trial on the ground alleging that claims 1–9 were obvious under

¹ *International Business Machines Corporation v. Electronics and Telecommunications Research Institute*, Case IPR2014-00949 (“’949 IPR”) was joined previously into the ’901 IPR (’949 IPR, Paper 25) and all further filings in the joined proceeding are made in the ’901 IPR. Petitioner seeks joinder with the resulting ’901 IPR. Mot. 2 n. 1.

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35 U.S.C. § 103 over Mylex² and Hathorn.³ '901 IPR, Dec. Inst. 22. Hathorn and Mylex also were asserted in challenges against the '346 patent asserted in *Dell, Inc. v. Electronics and Telecommunications Research Institute*, Case IPR2013-00635 (“'635 IPR”). Petitioner in this case and in the '635 IPR are the same.

As relevant here,⁴ the '635 Petition challenged claims of the '346 patent on the following grounds: (1) claims 1–3 and 8 as obvious under 35 U.S.C. § 103(a) over Weygant and Mylex ('635 IPR Pet. 20–23); (2) claims 4 and 9 as obvious under 35 U.S.C. § 103(a) over Weygant, Mylex, and Serviceguard⁵ ('635 IPR Pet. 23–39); (3) claims 5–7 as obvious under 35 U.S.C. § 103(a) over Weygant, Mylex, and ANSI⁶ ('635 IPR Pet. 39–45); (4) claims 1–3 and 5–8 as anticipated under 35 U.S.C. § 102(b) by Hathorn ('635 IPR Pet. 45–60). On March 20, 2014, we instituted trial on the ground that claims 1–3 and 5–8 were anticipated under 35 U.S.C. § 102(b) by Hathorn, denying all other grounds on the merits. '635 IPR, Dec. Inst. 23–24. On February 27, 2015, we entered a Final Written Decision (“Final Dec.” Paper 39) finding that claims 1–3 and 5–8 of the '346 patent had not been shown to be unpatentable by a preponderance of the evidence. '635 IPR, Final Dec. 24.

² *Storage Area Networks; Unclogging LANs and Improving Data Accessibility*, Mylex Corporation, published May 29, 1998 (“Mylex,” Exs. 1006 and 1009).

³ U.S. Patent No. 5,574,950, issued Nov. 12, 1996 (“Hathorn,” Ex. 1005).

⁴ One ground is omitted from the list as not including Mylex or Hathorn.

⁵ *Managing MC/Serviceguard*, Hewlett-Packard Company, Jan. 1998 (“ServiceGuard,” Ex. 1004).

⁶ *Fibre Channel Arbitrated Loop (FC-AL-2)*, American Nat. Standards Inst., 1999 (“ANSI,” Ex. 1008).

2. *Legal Analysis*

a. *Claims 1–3 and 5–8*

Petitioner is estopped from requesting *inter partes* review in this case. Under 35 U.S.C. § 315(e)(1), once a Petitioner has obtained a final written decision, that Petitioner may not request or maintain subsequent proceedings on a ground that it “could have raised” during the prior proceeding. Specifically, section 315(e)(1) provides:

(e) Estoppel. –

(1) Proceedings before the office.— The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, *may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.*

(Emphasis added).

The first requirement for estoppel is met because the Petitioner here and in the ’635 IPR are the same. The entry of the Final Written Decision in the ’635 IPR satisfies the second requirement. For the reasons that follow, we determine Petitioner could have raised the ground asserted in this case in the ’635 IPR.

What a Petitioner “could have raised” was described broadly in the legislative history of the America Invents Act (“AIA”) to include “prior art which a skilled searcher conducting a diligent search would reasonably could have been expected to discover.” 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Grassley). Indeed, the administrative estoppel codified in § 315(e)(1), as was pointed out, would effectively preclude petitioners from bringing subsequent

challenges to the patent in USPTO proceedings. *See id.* at S1376 (statement of Sen. Kyl) (“This [estoppel] effectively bars such a party or his real parties in interest or privies from later using inter partes review or ex parte reexamination against the same patent, since the only issues that can be raised in an inter partes review or ex parte reexamination are those that could have been raised in [an] earlier post-grant or inter partes review.”). We need not investigate what any search might have uncovered, for the record before us shows that the prior art references in the instant Petition were asserted in the ’635 IPR.

More specifically, the prior art Petitioner has asserted in the instant Petition, Mylex and Hathorn, was asserted in the ’635 IPR against all the claims of the ’346 patent. Hathorn was asserted as the basis of an anticipation ground under 35 U.S.C. §102. ’635 IPR Pet. 45–60. Mylex was asserted as one of a combination of references in three other obviousness grounds. *Id.* at 23–45. Petitioner asserted Mylex as disclosing a RAID controller limitation in the ’635 IPR (see, e.g., ’635 Pet. 20–21), where, in the instant Petition, the reference is asserted as disclosing a RAID (Pet. 21). On this record, the differences in how the references have been asserted in these proceedings have no weight on our determination of whether the grounds raised in the instant Petition could have been raised in the ’635 IPR. Both Mylex and Hathorn were known to Petitioner as prior art to the ’346 patent, and Mylex has been asserted as an obviousness reference in this Petition and in the ’635 IPR. It makes no difference to us that Petitioner may have believed Hathorn to be an anticipatory

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