

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 IPR2015-01007
Patent 6,009,469 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 1–3, 5, 6, 9, 10, 14, 17, and 18 of U.S. Patent No. 6,009,469 C1 (Ex. 1001, “the ’469 patent”). Paper 3 (“Pet.”). With the Petition, Petitioner filed a Motion for Joinder (Paper 4, “Mot.”), seeking to join this case with *Samsung Elecs. Co. v. Straight Path IP Grp., Inc.*, IPR2014-01367 (PTAB Mar. 6, 2015), filed by Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (collectively, “Samsung”). Petitioner indicates that Patent Owner does not oppose the Motion for Joinder. Mot. 1. In a separate decision, entered today, we institute an *inter partes* review as to the same claims and the same ground of unpatentability for which we instituted trial in *Samsung Elecs. Co., Ltd. v. Straight Path IP Grp., Inc.*, IPR2014-01367. For the reasons that follow, Petitioner’s Motion for Joinder is *granted*.

BACKGROUND

Petitioner filed its Petition and Motion for Joinder on April 6, 2015, within one month after the institution date of IPR2014-01367. On May 5, 2014, we held a conference call with counsel for the respective. During the conference call, Patent Owner indicated that all of the parties intended to file a stipulated proposed order defining the parameters of joinder. The parties filed the stipulated proposed order on May 6, 2015. *See* Paper 10.

The Petition in this case asserts that claims 1–3, 5, 6, and 9¹ of the '469 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over Microsoft Manual² and NetBIOS,³ and claims 10, 14, 17, and 18 are unpatentable under 35 U.S.C. § 103(a) as obvious over Microsoft Manual, NetBIOS, and Palmer.⁴ Pet. 7, 37–54. These are the same claims and the same grounds for which we instituted trial in IPR2014-01367. *Samsung Elecs. Co. v. Straight Path IP Grp., Inc.*, IPR2014-01367, slip op. at 21 (PTAB Mar. 6, 2014) (Paper 12).

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

¹ Although Petitioner first identifies claim 17 as challenged under this ground, Petitioner's argument and claim charts do not include claim 17. Accordingly, we do not understand Petitioner to have challenged claim 17 under this ground. *Compare* Pet. 7 *with id.* at 37–48.

² MICROSOFT WINDOWS NT 3.5, TCP/IP USER GUIDE (1994) (Ex. 1012, "Microsoft Manual").

³ THE OPEN GROUP, TECHNICAL STANDARD, PROTOCOLS FOR X/OPEN PC INTERWORKING: SMB, VERSION 2.0 (1992) (Ex. 1014, "NetBIOS").

⁴ U.S. Patent No. 5,375,068, issued Dec. 20, 1994 (Ex. 1020, "Palmer").

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” because (1) Petitioner represents that IPR2015-01007 is identical to IPR2014-01367 in all substantive aspects, including identical grounds, analysis, exhibits, and relies upon the same expert Declaration; (2) Petitioner agrees to (a) incorporate its filings with Samsung, (b) not advance any separate arguments from those advanced by Samsung, and (c) to consolidated discovery; (3) joinder will not have any impact on the IPR2014-01367 schedule; and (4) there will be no prejudice to Patent Owner. Mot. 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 IPR2014-01367 will not be affected by joinder because Petitioner asserts the ground of unpatentability for which trial was instituted in IPR2014-01367, presents the same arguments as those advanced by Samsung, and, therefore, our analysis would similarly institute review of the claims for the same grounds for which trial was instituted in IPR2014-01367. *Compare* Pet. 37–54 with *Samsung Elecs. Co. v. Straight*

Path IP Grp., Inc., IPR2014-01367, Paper 1, 34–49. Further, Petitioner submits the same declaration of Dr. Henry Houh that Samsung submitted in support of its Petition. *See* Ex. 1004; *Samsung Elecs. Co., Ltd. v. Straight Path IP Grp., Inc.*, IPR2014-01367, Ex. 1004. Thus, Petitioner asserts that the Petition in this proceeding raises no new issues beyond those already before the Board in IPR2014-01367.

Regarding procedural matters, Petitioner argues that joinder would not require any change to the trial schedule in IPR2014-01367. Mot. 6–7. Petitioner further argues that joinder would “permit Petitioner to maintain its ongoing interests in the Board’s review of the ’469 patent” in the event Samsung withdraws from the proceeding. *Id.* 7–8.

CONCLUSION

Under the circumstances, we conclude Petitioner has demonstrated that joinder will not unduly complicate or delay IPR2014-01367, and therefore joinder is appropriate.

ORDER

Accordingly, it is:

ORDERED that Petitioner’s Motion for Joinder with IPR2014-01367 is *granted*;

FURTHER ORDERED that this proceeding is joined with IPR2014-01367;

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