

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Oracle Corporation

Petitioner,

v.

Crossroads Systems, Inc.

Patent Owner.

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IPR2015-\_\_\_\_\_

U.S. Patent No. 7,051,147

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**MOTION FOR JOINDER**

## I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Petitioner Oracle Corporation respectfully requests joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) of the above-captioned *inter partes* review with *NetApp, Inc. v. Crossroads Systems, Inc.*, IPR2015-00773. This motion is timely under 37 C.F.R. §§ 42.22 and 42.122(b) because it is filed before the date which is one month after the date on which the -00773 case is instituted.

## II. STATEMENT OF MATERIAL FACTS

1. Petitioner was served with a complaint asserting infringement of U.S. Patent No. 7,051,147 more than one year before filing the petition in the above-captioned proceeding.
2. The above-captioned *inter partes* review presents challenges which are identical to those on which trial was instituted in IPR2015-00773. The petition in the instant case copies verbatim the challenges set forth in the petition in IPR2015-00773.
3. The above-captioned *inter partes* review relies on the same expert declaration offered in support of IPR2015-00773. Both petitions rely upon the declaration of Professor Jeffrey S. Chase, Ph.D dated July 18, 2014. Ex. 1010 (in both cases).
4. NetApp, Inc., the petitioner in IPR2015-00773, does not oppose this motion for joinder. NetApp has consented to the joinder in part due to the conditions outlined below, to which Petitioner has agreed.
5. Petitioner has agreed that NetApp shall remain in control of the joined

proceedings. Petitioner has agreed to not materially participate in the joined proceedings unless and until the parties to IPR2015-00773 are dismissed from the joined proceedings or elect to transfer control to Petitioner, as may occur in the event of settlement or advanced settlement negotiations. In the event either of the foregoing events occur, Petitioner intends to “step into the shoes” of NetApp and continue to prosecute the joined proceedings.

6. Petitioners have agreed to retain Dr. Chase in the -773 case only if the foregoing contingency occurs. In the meantime, Dr. Chase will be solely retained by NetApp in the -773 case.

7. For avoidance of doubt, the foregoing is not intended to circumscribe any right Petitioner may have to participate in any appeal from the joined proceeding. The foregoing is also not intended to foreclose the possibility that Petitioner may request permission to materially participate in these proceedings if the circumstances change in a manner that warrants such participation. Lastly, the foregoing is not intended to foreclose communication among NetApp and Petitioner concerning the substantive or procedural issues in the joined proceeding.

### III. GOVERNING LEGAL PRINCIPLES

A motion for joinder may be filed within one month after institution of a trial. 37 C.F.R. § 42.122(b). The AIA permits joinder of parties in like review proceedings. The statutory provision governing joinder of *inter partes* review proceedings is 35 U.S.C. § 315(c), which provides:

(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.

35 U.S.C. § 315(b) bars institution of a petition for *inter partes* review when the petition is filed more than one year after the petitioner (or the petitioner’s real party-in-interest or privy) is served with a complaint alleging infringement of the patent. 35 U.S.C. § 315(b); 37 C.F.R. § 42.101(b). However, the one-year time bar does not apply to a request for joinder. 35 U.S.C. § 315(b) (final sentence) (“[t]he time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c)”); 37 C.F.R. § 42.122(b).

Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b). When exercising that discretion, the Board is mindful that patent trial regulations, including the rules for

joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. 37 C.F.R. § 42.1(b). As indicated in the legislative history, the Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case. See 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (when determining whether and when to allow joinder, the Office may consider factors including the breadth or unusualness of the claim scope, claim construction issues, and consent of the patent owner).

That being said, the legislative history suggests that the joinder would be granted as a matter of right where the later petitioner presents the identical grounds of unpatentability. See 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (“The Office anticipates that joinder will be allowed *as of right* - if an *inter partes* review is instituted on the basis of a petition, for example, a party that files an identical petition will be joined to that proceeding, and thus allowed to file its own briefs and make its own arguments.”) (emphasis added).

A motion for joinder should: (1) set forth the reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *Dell, Inc. v. Network-1 Security Solutions, Inc., Case IPR2013-00385, Paper No.*

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