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571–272–7822

Paper 11
Entered: March 6, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VMWARE, INC.,
Petitioner,

v.

GOOD TECHNOLOGY SOFTWARE, INC.,
Patent Owner.

Case IPR2015-00031
Patent 8,012,219 B2

Before BRYAN F. MOORE, PETER P. CHEN, and
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

VMware, Inc. ("Petitioner") filed a Petition (Paper 1; "Petition" or "Pet.") requesting *inter partes* review of claims 1, 9–11, 14–16, 18–19, and 23–24 of U.S. Patent No. 8,012,219 B2 (Ex. 1001; "the '219 patent"). Good Technology Software, Inc. ("Patent Owner") filed a redacted Preliminary Response to the Petition. Paper 8 ("Prelim. Resp."). Patent Owner also filed a confidential version of the Preliminary Response. Paper 9. For the reasons set forth below, the Petition is not timely under 35 U.S.C. § 315(b). Accordingly, the Petition is denied.

II. ANALYSIS

Patent Owner served a complaint (the "Complaint") on AirWatch, LLC ("AirWatch") alleging infringement of the '219 patent on November 15, 2012 (the "Lawsuit"). Pet. 3. Petitioner executed an agreement entitled "Agreement and Plan of Merger" (the "Agreement") on January 21, 2014. Ex. 2002. Pursuant to the Agreement, Petitioner acquired AirWatch as its wholly owned subsidiary in February 2014. *Id.*; Pet. 4. Petitioner admits that AirWatch became its privy as a result of the acquisition, and, thus, Petitioner and AirWatch have been in privity at least since February 2014. IPR2015-00030,[1] Paper 1, 3. Petitioner filed the Petition challenging the '219 patent on October 6, 2014. Pet. 60.

Under 35 U.S.C. § 315(b), an *inter partes* review "may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent."

[1] IPR2015-00030 involves the same parties as this proceeding and identifies this proceeding as being related. IPR2015-00030, Paper 1, 1.

Petitioner admits that AirWatch is its privy. IPR2015-00030, Paper 1, 3 ("Petitioner VMware purchased VMware in February of 2014, and is now in privity with AirWatch"); Prelim. Resp. 10, 42. Petitioner also admits that AirWatch was served with the Complaint alleging infringement of the '219 patent more than a year before the Petition was filed. Pet. 3. Petitioner argues that the Petition is timely under § 315(b), because Petitioner was not in privity with AirWatch at the time of service of the Complaint. Pet. 3–5.

The analysis under § 315(b) is a "highly fact-dependent question" that is evaluated consistent with "flexible and equitable considerations." Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2012). The relevant factors for determining whether a party is a real party in interest or a privy of the petitioner include, *inter alia*, the party's relationship with the petitioner and the nature and/or degree of the party's involvement in the filing of the petition. *Id.* at 48,760. Thus, at least some of the factors analyzed in determining whether a party is a real party in interest or a privy of the petitioner involve actions or events that may occur *after* service of a complaint alleging infringement of the challenged patent. Petitioner cites to several non-precedential decisions of the Board in *inter partes* review proceedings, but does not identify any language in the statute or any other persuasive rationale to support the argument that privity under § 315(b) is determined only at the time of service of the complaint alleging infringement of the challenged patent. *See* Pet. 3–5. Further, although the decision is not binding precedent, in *Synopsys, Inc. v. Mentor Graphics Corp.*, Case IPR2012-00042, slip op. at 16 (Feb. 22, 2013) (Paper 16),[2] the panel

[2] Petitioner cites to *Synopsys* to support its argument that the Petition is timely under § 315(b). Pet. 4.

indicated that the relevant dates for § 315(b) include the filing date of the petition, not just the date of service of the complaint alleging infringement of the challenged patent. Prelim. Resp. 43.

Therefore, we do not conclude that privity under § 315(b) is determined only at the time of service of a complaint alleging infringement of the challenged patent. Because AirWatch, a privy of Petitioner, was served with the Complaint alleging infringement of the '219 patent more than a year before the Petition challenging the '219 patent was filed, we are persuaded, on this record, that the Petition is not timely under § 315(b).

III. CONCLUSION

The Petition is denied because it was not filed within the time period set forth in 35 U.S.C. § 315(b).

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is denied and no trial is instituted.

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Patent 8,012,219 B2

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