

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARUBA NETWORKS, INC., HEWLETT PACKARD ENTERPRISE
COMPANY, and HP INC.,
Petitioner,

v.

MOBILE TELECOMMUNICATIONS TECHNOLOGIES, LLC,
Patent Owner.

Cases¹

IPR2016-00768 (Patent 5,659,891)

IPR2016-00769 (Patent 5,915,210)

Before MEREDITH C. PETRAVICK, SCOTT A. DANIELS, and
MIRIAM L. QUINN, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

¹ This Order addresses issues that are the same in both cases. Therefore, we exercise our discretion to issue one Decision to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

IPR2016-00768 (Patent 5,659,891)

IPR2016-00769 (Patent 5,915,210)

Petitioner requested, by an email dated April 15, 2016, a conference call with the Board seeking authorization to file a motion for expedited action on the Motion for Joinder (Paper 3) filed with the respective Petitions in these proceedings. Petitioner stated in the email that their request was based on motions to terminate filed in IPR2015-01724 and IPR2015-01726 (the “Samsung IPR’s”), with which Petitioner seeks to join the present proceedings.² Patent Owner indicated in a separate email dated April 17, 2016, that it would oppose Petitioner’s motions for joinder.

The Board conducted a telephone conference with the parties on April 20, 2016. Included on the call in addition to counsel in these proceedings and the Samsung IPR’s, were Judges Daniels, Petravick and Quinn. A court reporter provided by Petitioner’s counsel was also on the call.³ Petitioner argued during the call that the Board has authority under 35 U.S.C. §42.5(c)(1) to modify Patent Owner’s preliminary response date in order to determine, at an earlier time, whether trial should be instituted in these proceedings. Tr. 6–10. Assuming a trial would be instituted in these proceedings, Petitioner contends that the Board should then join these proceedings with the Samsung IPR’s before the Board considers termination of the Samsung IPR’s. *Id.* at 6. Petitioner argues that expedited consideration of joinder is appropriate because the petitions in these proceedings are copies of the petitions in the Samsung IPR’s, the motions for joinder were timely filed, and that consolidation of the proceedings

² In each of the Samsung IPR’s the parties filed a Joint Motion to Terminate on April 14, 2015, indicating that the parties have settled their dispute and agreed to terminate the Samsung IPR’s.

³ The transcript of the call is entered into the record as Exhibit 1017 (“Tr.”).

IPR2016-00768 (Patent 5,659,891)

IPR2016-00769 (Patent 5,915,210)

reduces cost and complexities for the parties and the Board. *Id.* at 9–10. In other words, assuming we were to expedite these proceedings and grant joinder, and then subsequently grant the motions for termination in the Samsung IPR’s, as Petitioner requests, Petitioner would then essentially stand in the shoes of Samsung and these proceedings would be subject to the Samsung IPR trial schedule.

Patent Owner opposes the request because, among other reasons, the seven month gap between the filing of the relevant Petitions, and moving Patent Owner’s date to file its preliminary response would be prejudicial primarily to Patent Owner. *Id.* at 11–15. Additionally, although Petitioner has copied the petitions from the Samsung IPR’s, Patent Owner’s counsel indicated during the call that Patent Owner intends to provide a different preliminary response in these proceedings than in the Samsung IPR’s. *Id.* at 13. Further, the recent amendments to 37 C.F.R. Part 42, which became effective May 2, 2016, permit Patent Owner to include testimonial evidence in their preliminary response, which is different from the Samsung IPR’s.

More persuasive than the additional burden to Patent Owner, the potential synchronization of these proceedings leaves Samsung and Patent Owner, who have settled their dispute and undertaken the appropriate steps to terminate the Samsung IPR’s, with their proceedings unresolved for a significant period of time. This period of time in which the outcome of the Samsung IPR’s remains unclear includes not only the time for Patent Owner to file a preliminary response but also the length of time in which the Board has to consider and write a decision. *See* 35 U.S.C. 314(b). We are not persuaded that a marginally accelerated trial schedule in these proceedings is a sufficient benefit to any party or the Board in light of the necessity to provide a just, speedy and inexpensive resolution of the Samsung IPR’s as

IPR2016-00768 (Patent 5,659,891)

IPR2016-00769 (Patent 5,915,210)

contemplated by 37 C.F.R. § 42.1(b). Moreover, denying authorization for a motion for expedited action to consider Petitioner's motions for joinder does no harm to Petitioner as they are not barred in these current proceedings under 35 U.S.C. § 315(b).

For the reasons discussed above, we are not persuaded that the facts and circumstances in these proceedings and the Samsung IPR's weigh in favor of expedited consideration of Petitioner's motions for joinder.

It is

ORDERED that Petitioner's request for expedited consideration of the Motions for Joinder Under 35 U.S.C. 315(c) AND 37 C.F.R. §§ 42.22 and 42.122(b) filed with the Petitions in IPR2016-00768 and IPR2016-00769 is DENIED.

IPR2016-00768 (Patent 5,659,891)

IPR2016-00769 (Patent 5,915,210)

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