

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BAKER HUGHES INCORPORATED and
BAKER HUGHES OILFIELD OPERATIONS, INC.,
Petitioner,

v.

PACKERS PLUS ENERGY SERVICES, INC.,
Patent Owner.

Case IPR2016-01496 (Patent 7,134,505 B2)
Case IPR2016-01505 (Patent 7,543,634 B2)
Case IPR2016-01506 (Patent 7,861,774 B2)¹

Before SCOTT A. DANIELS, NEIL T. POWELL, and
CARL M. DEFRANCO, *Administrative Patent Judges*.

POWELL, *Administrative Patent Judge*.

DECISION
Petitioner's Motions for Joinder
37 C.F.R. § 42.1

¹ This Decision applies to motions in all three cases. The parties are not authorized to use this style heading for any subsequent papers.

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Introduction

Petitioner has requested joinder of the instant Petitions with three earlier *inter partes* review proceedings, currently scheduled to be heard later this month. In August of 2016, we instituted *inter partes* review of U.S. Patent 7,134,505 B2 (“the ’505 patent”), U.S. Patent 7,543,634 B2 (“the ’634 patent”), and U.S. Patent 7,861,774 B2 (“the ’774 patent”) in IPR2016-00596, IPR2016-00597, and IPR2016-00598, respectively (collectively, the “first cases”). The first cases involve the same Petitioner and Patent Owner as here.

In July of 2016, Petitioner filed Petitions raising additional challenges to claims of the ’505 patent, the ’634 patent, and the ’774 patent in the present cases—IPR2016-01496, IPR2016-01505, and IPR2016-01506, respectively (collectively, the “second cases”). IPR2016-01496, Paper 1; IPR2016-01505, Paper 1; IPR2016-01506, Paper 1. Petitioner also filed Joinder Motions requesting joinder of IPR2016-01496 with IPR2016-00596, joinder of IPR2016-01505 with IPR2016-00597, and joinder of IPR2016-01506 with IPR2016-00598. IPR2016-01496, Paper 6; IPR2016-01505, Paper 6; IPR2016-01506, Paper 6. Patent Owner filed Responses to Petitioner’s Joinder Motions.² IPR2016-01496, Paper 13; IPR2016-01505, Paper 13; IPR2016-01506, Paper 13. In February of 2017, we instituted *inter partes* review in each of the second cases. IPR2016-01496, Paper 19; IPR2016-01505, Paper 19; IPR2016-01506, Paper 19. We now decide the Joinder Motions.

² Each reference to “Patent Owner” includes the exclusive licensee of the ’505, ’634, and ’774 patents—Rapid Completions LLC.

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The substantive issues raised in the Joinder Motions are the same for each of IPR2016-01496, IPR2016-01505, and IPR2016-01506. Accordingly, we discuss and cite as representative of all three of these cases the Joinder Motion and Response from IPR2016-01496. IPR2016-01496, Paper 6 (hereafter, “Motion” or “Mot.”); IPR2016-01496, Paper 13 (hereafter, “Response” or “Resp.”).

Authority

The America Invents Act (“AIA”) created new administrative trial proceedings, including *inter partes* review, as an efficient, streamlined, and cost-effective alternative to district court litigation. The AIA permits the joinder of like proceedings. According to 35 U.S.C. § 315(c), the Board, acting on behalf of the Director, has the discretion to join an *inter partes* review with another *inter partes* review. More specifically, section 315(c) provides (emphasis added):

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.*

In the case of joinder, the Board has the discretion to adjust the time period for issuing a final determination in an *inter partes* review. 35 U.S.C. § 316(a)(11); 37 C.F.R. § 42.100(c).

Joinder may be authorized when warranted, and the decision to grant joinder is discretionary. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. The Board will determine whether to grant joinder on a case-by-case basis, taking into

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account the particular facts of each case, the substantive and procedural issues, and other considerations. *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” and claim construction issues). When exercising its 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. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b).

Additionally, under our interpretation of § 315(c), same-party joinder is permitted. Section 315(c) states that “any person who properly *files a petition* under section 311” may be joined at the Director’s discretion. Filing a petition under § 311 is, therefore, a predicate to joinder.

Section 311(a) specifies who can file a petition for *inter partes* review. Under that section, “a person who is not the owner of a patent may file with the Office a petition to institute an inter partes review of the patent.” Thus, when the “any person” of § 315(c) is read in light of § 311(a), the only person excluded by the language is the owner of the patent at issue. More specifically, § 311(a) does not exclude a person who is already a petitioner in an instituted review proceeding that is the subject of the joinder analysis. The choice of Congress to exclude only patent owners is telling. *See, e.g., Figueroa v. Sec’y of Health & Human Servs.*, 715 F.3d 1314, 1322 (Fed. Cir. 2013) (“[T]he term left out must have been meant to be excluded.” (quoting *Chevron U.S.A. Inc. v. Echazabal*, 536 U.S. 73, 81 (2002))); *Espenschied v. MSPB*, 804 F.2d 1233, 1237 (Fed. Cir. 1986)

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(“Where Congress explicitly enumerates certain exceptions to a general prohibition, additional exceptions are not to be implied in the absence of evidence of a contrary legislative intent.” (quoting *Andrus v. Glover Constr. Co.*, 446 U.S. 608, 616–617 (1980))).

Moreover, the word “any” in § 315(c) may be defined as “one or more without specification or identification.”³ If the legislature had meant to exclude joining the same petitioner to an instituted *inter partes* review, it would not have used the word “any” in the statute, such that “any person” who properly files a petition may be joined. Congress could have specified “any non-party” instead of “any person.” An interpretation that requires us to read “any person” as excluding a same petitioner, in essence, reads the word “any” out of the statute. Such an interpretation also ignores the statutory language of § 311(a), which indicates that anyone other than the patent owner may file a petition and thereby become eligible for joinder.

Other sections of the AIA, referenced in section 315(c), further support our interpretation. Section 315(c) specifies that joinder may be granted only after a person “properly files a petition under section 311,” such that the Director, “after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines [that the petition] warrants the institution of an inter partes review under section 314.” Section 314 does not discuss the real parties in interest, related matters, lead and backup counsel, and service information, but instead

³ Random House, Inc., *Any*, DICTIONARY.COM UNABRIDGED, <http://dictionary.reference.com/browse/any> (last visited April 20, 2017).

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