

Paper No. ____
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Filed on behalf of: Aerohive Networks, Inc.
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AEROHIVE NETWORKS, INC.,
Petitioner,

v.

CHRIMAR SYSTEMS, INC.,
Patent Owner.

Case No. IPR2016-01757
U.S. Patent No. 8,942,107 B2

MOTION FOR JOINDER

I. Statement of the Precise Relief Requested

Aerohive Networks, Inc. (“Aerohive”) moves for joinder of its concurrently filed petition (“Petition”) for *inter partes* review of claims 1, 5, 31, 43, 53, 58, 70, 72, 75, 83, 84, 103 (across 1 and 31), 104, 111, 123, and 125 (across 104, 111, and 123) (“the challenged claims”) of U.S. Patent No. 8,942,107 B2 (“the ’107 patent”), purportedly assigned to ChriMar Systems, Inc. (“Patent Owner”), to an instituted *inter partes* review initiated by AMX, LLC and Dell Inc. (“AMX and Dell” or “Existing Petitioners”) *AMX, LLC v. ChriMar Systems, Inc.*, IPR2016-00569 (“the ’569 review”), pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b).

This Motion is timely because the Board instituted the ’569 review on August 10, 2016, less than one month ago. *See* 37 C.F.R. § 42.122(b). Aerohive has not previously sought IPR of the challenged claims.

In the Petition, Aerohive requests cancellation of the challenged claims on the same unpatentability ground, over the same prior art, and in light of the same arguments and expert testimony as AMX and Dell submitted, and on which the

Board instituted the '569 review.¹ No new claims are challenged; no new issues are raised. The Petition is substantially identical to the petition submitted by AMX and Dell with respect to the instituted ground.

Joinder is also appropriate here because Aerohive expects to participate in the '569 review in a limited capacity as an understudy, taking over only if AMX and Dell settle with Patent Owner. Also, if requested, oral argument is scheduled for May 3, 2017—months away—making joinder especially appropriate here.

Joinder will have no impact on the trial schedule of the '569 review because that proceeding is still in its early stages and Aerohive, in its limited role, is agreeable to the same schedule. Adding Aerohive as a back-up party ensures that the challenged claims —asserted against much of the computer networking hardware industry—receive the Board's expert scrutiny without prejudicing the existing parties to the '569 review.

Aerohive has conferred with counsel for AMX and Dell regarding this joinder request. Counsel indicated that the Existing Petitioners do not oppose joinder.

¹ In their petition, AMX and Dell include another unpatentability ground. The Board declined to institute on that ground. Aerohive omits the non-instituted ground from its Petition.

II. Background

Patent owner has asserted the '107 patent against most of the computer networking hardware industry, in courts across the country. Patent owner filed its complaint against Aerohive on July 1, 2015 in Tyler, Texas. *See* Case No. 6:15-cv-00636 (E.D. Tex. filed July 1, 2015). Other companies are fighting off related lawsuits in the Eastern District of Texas, the Northern District of California, and the Eastern District of Michigan, as listed in Exhibit 1013 to Aerohive's Petition.

On February 12, 2016, AMX and Dell petitioned for *inter partes* review of the '107 patent's challenged claims, which was designated as IPR2016-00569. On August 10, 2016 the Board instituted IPR, scheduling oral arguments for May 3, 2017. Here, Aerohive's Petition is a practical copy of AMX and Dell's petition, including the same prior art, analysis, and expert testimony and differing only to address formalities, such as, e.g., mandatory notices, counsel, etc., and to omit the non-instituted ground.

III. Argument

A. Legal Standard

The Board may join any person who properly files a petition for *inter partes* review to an instituted *inter partes* review as a party. 35 U.S.C. §315(c). A motion for joinder must be filed within one month of institution of any *inter partes* review for which joinder is requested. 37 C.F.R. § 42.122(b). In deciding whether to grant

a motion for joinder, the Board considers several factors including: (1) the reasons why joinder is appropriate; (2) whether the party to be joined has presented any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See, e.g., Hyundai Motor Co. v. Am. Vehicular Sciences LLC*, IPR2014-01543, Paper 11 at 3 (Oct. 24, 2014); *Macronix Int'l Co. v. Spansion*, IPR2014-00898, Paper 15 at 4 (Aug. 13, 2014) (quoting *Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (April 24, 2013)).

B. Aerohive's Motion for Joinder Is Timely

Because the Board instituted the '569 review less than a month ago on August 10, 2016, this Motion and the Petition are timely.

C. The Relevant Factors Weigh in Favor of Joinder

Each of the four factors the Board considers weighs in favor of joinder here. Granting joinder neither enlarges the scope of the '569 review nor affects its schedule. Denying joinder, though, would prejudice Aerohive and harm the public.

1. Joinder is Appropriate

Here, joinder is appropriate because no new grounds or evidence are presented. Aerohive's Petition relies on the same prior art, expert testimony, and arguments presented in the '569 petition. Other than minor differences in formalities such as mandatory notices, and omission of the ground that was not

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