

Paper No. ____
Filed: September 8, 2016

Filed on behalf of: Aerohive Networks, Inc.
By: Matthew A. Argenti (margenti@wsgr.com)
Michael T. Rosato (mrosato@wsgr.com)
WILSON SONSINI GOODRICH AND ROSATI

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. IPR2016-01758
U.S. Patent No. 9,019,838 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, 2, 7, 26, 29, 38, 40, 47, 55, and 69 (“the challenged claims”) of U.S. Patent No. 9,019,838 B2 (“the ’838 patent”), purportedly assigned to ChriMar Systems, Inc. (“Patent Owner”), to an instituted *inter partes* review initiated by AMX, LLC. (“AMX”) *AMX, LLC v. ChriMar Systems, Inc.*, IPR2016-00573 (“the ’573 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 ’573 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 submitted, and on which the Board instituted the ’573 review.¹ No new claims are challenged; no new issues are raised. The Petition is substantially identical to the petition submitted by AMX

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

with respect to the instituted ground.

Joinder is also appropriate here because Aerohive expects to participate in the '573 review in a limited capacity as an understudy, taking over only if AMX settles 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 '573 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 does not prejudice the existing parties to the '573 review and ensures that the challenged claims —asserted against much of the computer networking hardware industry— receive the Board's expert scrutiny.

Aerohive has conferred with counsel for AMX regarding this joinder request. Counsel indicated that AMX does not oppose joinder.

II. Background

Patent owner has asserted the '838 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 1014 to Aerohive's Petition.

On March 3, 2016, AMX petitioned for *inter partes* review of the '838 patent's challenged claims, which was designated as IPR2016-00573. 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'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 '573 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 '573 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 '573 petition. Other than minor differences in formalities such as mandatory notices, and omission of the ground that was not instituted in the '573 review, the present Petition is essentially identical to the petition in the '573 review.

Joinder is also appropriate because it allows the just, speedy, and inexpensive resolution of the challenged claims' validity issues. *See* 37 C.F.R. § 42.1(b). A final written decision will narrow the issues left for the courts in Michigan, Texas, and California to handle. Joining Aerohive as a party ensures that the '573 review reaches a final written decision on schedule.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.