

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VALVE CORP.,
Petitioner,

v.

PALTALK HOLDINGS, INC.,
Patent Owner.

Case IPR2018-01243
Patent 6,226,686 B1 & 6,226,686 C1

Before THU A. DANG, KARL D. EASTHOM, and
NEIL T. POWELL, *Administrative Patent Judges*.

POWELL, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and Grant of Motion for Joinder
37 C.F.R. § 42.108; 37 C.F.R. § 42.122(b)

I. INTRODUCTION

On June 14, 2018, Valve Corp. (“Petitioner”) filed a Petition, seeking *inter partes* review of claims 1, 3, 7, 12, 18, 22–27, 36, 41–46, 55, and 58–63 of U.S. Patent No. 6,226,686 B1 (“the ’686 patent”). Paper 2 (“Pet.”). Paltalk Holdings, Inc. (“Patent Owner”) waived its preliminary response. Paper 7.

Along with the Petition, Petitioner filed a Motion for Joinder to join this proceeding with IPR2018-00132. Paper 3 (“Mot.”). Patent Owner does not oppose the Motion.

As explained further below, we institute an *inter partes* review on the same grounds as instituted in IPR2018-00132 and grant Petitioner’s Motion for Joinder.

II. DISCUSSION

In IPR2018-00132, Riot Games, Inc. challenged claims 1, 3, 7, 12, 18, 22–27, 36, 41–46, 55, and 58–63 of the ’686 patent based on the following grounds:

References	Basis	Claims
Aldred ¹ and RFC 1692 ²	§ 103	1, 3, 7, 12, 18, 26, 27, 45, 46, 62, and 63
Aldred, RFC 1692, and Ulrich ³	§ 103	22–27, 41–46, and 58–63
Aldred, RFC 1692, and Denzer ⁴	§ 103	36 and 55

¹ WO 94/11814 (May 26, 1994) (“Aldred”; Ex. 1009).

² Request for Comments (RFC) 1692 (Aug. 1994) (“RFC 1692”; Ex. 1010).

³ US 5,466,200 (Nov. 14, 1995) (“Ulrich”; Ex. 1012).

⁴ US 5,307,413 (Apr. 26, 1994) (“Denzer”; Ex. 1014).

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On May 15, 2018, we instituted an *inter partes* review to review the patentability of those claims. *Riot Games, Inc. v. Paltalk Holdings, Inc.*, IPR2018-00132, Paper 11.

The Petition in this case is substantively identical to the one in IPR2018-00132. *Compare* IPR2018-00132, Paper 1 *with* IPR2018-01243, Paper 2. For the same reasons stated in our Decision on Institution in IPR2018-00132, we institute an *inter partes* review in this proceeding on the same grounds. *See* IPR2018-00132, Paper 11.

Having determined that institution is appropriate, we now turn to Petitioner’s Motion for Joinder. Under the statute, “[i]f 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.” 35 U.S.C. § 315(c). When determining whether to grant a motion for joinder we consider factors such as timing and impact of joinder on the trial schedule, cost, discovery, and potential simplification of briefing. *Kyocera Corp. v. SoftView, LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

Under the circumstances of this case, we determine that joinder is appropriate. Petitioner filed the Petition and Motion for Joinder in the present proceeding within one month of our institution of an *inter partes* review in IPR2017-00132, and thus, satisfies the requirement of 37 C.F.R. § 42.122(b). Petitioner represents that the Petition in this case is “substantially identical to the petition, filed by Riot Games, Inc. (‘Riot’), on which the Board instituted IPR2018-00132.” Mot. 1. According to Petitioner, the Petition “challenges the same claims of

the '686 patent based on the same grounds and the same evidence as Riot's petition in IPR2018-00132." *Id.* Petitioner asserts that it will "take an understudy role in the proceedings for as long as Riot remains a party." *Id.* As a result, Petitioner avers that joinder "does not raise any new grounds and will not impact the schedule or impose substantial costs on the parties to IPR2018-00132 or the Board." *Id.* Therefore, Petitioner asserts, joinder will result in no prejudice to either Riot or Paltalk. *Id.* at 6. Petitioner also asserts that joinder will not affect the schedule, and will simplify discovery and briefing. *Id.* at 7–8.

Where, as in the present case, a party seeks to take a secondary role in an on-going IPR, joinder promotes economy and efficiency, thereby reducing the burden on the Patent Owner and on the limited resources of the Board, as compared to distinct, parallel proceedings. *See* 37 C.F.R. § 42.1(b) (instructing that an *inter partes* review must be conducted to "secure the just, speedy, and inexpensive resolution").

In view of the foregoing, we find that joinder based upon the conditions stated by Petitioner in its Motion for Joinder will have little or no impact on the timing, cost, or presentation of the trial on the instituted ground. Discovery and briefing will be simplified if the proceedings are joined. Having considered Petitioner's Motion, the Motion is granted.

III. ORDER

Accordingly, it is

ORDERED that trial is instituted in IPR2018-01243 on the following grounds:

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1. claims 1, 3, 7, 12, 18, 26, 27, 45, 46, 62, and 63 as obvious over Aldred and RFC 1692;
 2. claims 22–27, 41–46, and 58–63 as obvious over Aldred, RFC 1692, and Ulrich
 3. claims 36 and 55 as obvious over Aldred, RFC 1692, and Denzer;
- FURTHER ORDERED that Petitioner’s Motion for Joinder

with IPR2018-00132 is granted;

FURTHER ORDERED that IPR2018-01243 is terminated and joined to IPR2018-00132, pursuant to 37 C.F.R. §§ 42.72, 42.122;

FURTHER ORDERED that absent leave of the Board, Valve Corp. shall maintain an understudy role with respect to Riot, Inc., coordinate filings with Riot, Inc., not submit separate substantive filings, not participate substantively in oral argument, and not actively participate in deposition questioning except with the assent of all parties;

FURTHER ORDERED that the Scheduling Order in place for IPR2018-00132 shall govern the joined proceedings;

FURTHER ORDERED that all future filings in the joined proceeding are to be made only in IPR2018-00132;

FURTHER ORDERED that the case caption in IPR2018-00132 for all further submissions shall be changed to add Valve Corp. as a named Petitioner after Riot, Inc., and to indicate by footnote the joinder of IPR2018-01243 to that proceeding, as indicated in the attached sample caption;

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2018-00132.

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