

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SNAP INC.,
Petitioner,

v.

BLACKBERRY LIMITED,
Patent Owner.

Case IPR2019-00938
Patent 8,209,634 B2

Before MIRIAM L. QUINN, GREGG I. ANDERSON, and
ROBERT L. KINDER, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and Grant of Motion for Joinder
35 U.S.C. § 314
37 C.F.R. § 42.122(b)

I. INTRODUCTION

Snap Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1, 4–7, 10–13, and 16–18 of U.S. Patent No. 8,209,634 B2 (Ex. 1001, “the ’634 patent”). Paper 2 (“Pet.”). Petitioner also filed a Motion for Joinder seeking joinder of this proceeding with *Facebook, Inc. v. Blackberry Limited*, Case No. IPR2019-00925 (the “Facebook IPR”). Paper 10 (“Mot.”).¹ Blackberry Limited (“Patent Owner”), filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). Patent Owner did not file an opposition to the Motion for Joinder. For the reasons that follow, we institute *inter partes* review, and grant Petitioner’s Motion for Joinder.

II. INSTITUTION OF INTERPARTES REVIEW

We instituted *inter partes* review in IPR2019-00925 on all challenged claims and on all the asserted grounds of unpatentability (Facebook IPR, Paper 15 (Decision on Institution)). The Petition in this proceeding challenges the same claims and asserts the same grounds as those we instituted in the Facebook IPR. Pet. 4. Petitioner also presents testimony from the same declarant relied on in the Facebook IPR. Ex. 1102 (Declaration of Sandeep Chatterjee, Ph.D.).

In view of the identicalness of the issues in the instant Petition and in

¹ The Board issued an Order to Show Cause (Paper 9) giving Petitioner the opportunity to file a Motion for Joinder.

the Facebook IPR, the already considered arguments from Patent Owner proffered in the Facebook IPR, and for the same reasons stated in our Decision on Institution in the Facebook IPR, we institute *inter partes* review in this proceeding on the grounds presented in the Petition.

III. GRANT OF MOTION FOR JOINDER

Joinder in *inter partes* review is subject to the provisions of 35 U.S.C. § 315(c):

(c) 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.

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder should: (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *See See Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

Petitioner has filed a timely Motion in accordance with 35 U.S.C. § 315(c). Petitioner also has met its burden of showing that joinder is appropriate. For instance, the Petition here is substantively identical to the

petition in the Facebook IPR. Mot. 4–5. The evidence also is identical, including the reliance on the same declaration of Dr. Chatterjee. *Id.*

Petitioner further has shown that the trial schedule will not be affected by joinder. Mot. 5–6. No changes in the schedule are anticipated or necessary, and the limited participation, if at all, of Petitioner will not impact the timeline of the ongoing trial. *Id.* Petitioner has agreed to an “understudy” role, which will simplify matters in the ongoing Facebook IPR and will be an efficient use of resources. *Id.* at 6–7.

IV. ORDER

In view of the foregoing, it is

ORDERED that IPR2019-00938 is hereby instituted on all challenged claims and asserted grounds:

Claims Challenged	Statutory Basis	References
1, 4, 5, 7, 10, 11, 13, 16, and 17	§ 103(a)	Ording, Abiko, Crumlish, and Dvorak
6, 12, and 18	§ 103(a)	Ording, Abiko, Crumlish, Dvorak, and McPherson
1, 4, 5, 7, 10, 11, 13, 16, and 17	§ 103(a)	Ording, Abiko, Crumlish, Dvorak, McPherson, and Strom
6, 12, and 18	§ 103(a)	Ording, Canfield, Schwartz, McPherson, and Strom

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FURTHER ORDERED that Petitioner's Motion for Joinder with IPR2019-0925 is *granted*;

FURTHER ORDERED that the Scheduling Order entered in IPR2019-00925 and schedule changes agreed-to by the parties in IPR2019-00925 shall govern the schedule of the joined proceeding;

FURTHER ORDERED that, throughout the joined proceeding, all filings in IPR2019-00925 will be consolidated and no filing by Snap Inc. alone will be allowed without prior authorization by the Board;

FURTHER ORDERED that a copy of this Decision will be entered into the record of IPR2019-00925;

FURTHER ORDERED that the case caption in IPR2019-00925, from now on, shall reflect joinder with this proceeding in accordance with the attached example.

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