

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OHIO FARMERS INSURANCE COMPANY and PREGIS LLC,
Petitioners

v.

GUADA TECHNOLOGIES LLC,
Patent Owner

Case IPR2022-00217
Patent No. 7,231,379

MOTION FOR JOINDER TO *INTER PARTES* REVIEW IPR2021-00875

TABLE OF CONTENTS

I. STATEMENT OF THE PRECISE RELIEF REQUESTED1

II. STATEMENT OF MATERIAL FACTS2

III. STATEMENT OF REASONS FOR RELIEF REQUESTED2

 A. Legal Standard.....2

 B. Petitioner’s Motion for Joinder Is Timely.....3

 C. Each Factor Weighs in Favor of Joinder.....3

 1. Joinder with the Elastic IPR Is Appropriate4

 2. Petitioners Propose No New Grounds of Unpatentability4

 3. Joinder Will Not Unduly Burden or Negatively Impact the
 Elastic IPR Trial Schedule5

 4. Procedures to Simplify Briefing and Discovery6

IV. CONCLUSION.....9

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Ohio Farmers Insurance Company d/b/a Westfield (“Westfield”) and Pregis LLC (“Pregis”) (collectively “Petitioners”) respectfully submit this Motion for Joinder, together with a concurrently-filed Petition for *Inter Partes* Review of U.S. Patent No. 7,231,379 (“the Westfield-Pregis Petition”).

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioners request institution of an *inter partes* review and joinder with *Elastic NV v. Guada Technologies, LLC*, IPR2021-00875 (“the Elastic IPR”), in which a decision instituting *inter partes* review was issued on October 28, 2021 (see Paper 7). Petitioners’ request for joinder is timely under 37 C.F.R. §§ 42.22 and 42.122(b), as it is submitted no later than one month after the institution date of the Elastic IPR. The Westfield-Pregis Petition is also narrowly tailored to the same claims, same prior art, and same grounds for unpatentability that are the subject of the Elastic IPR. In addition, Petitioners are willing to streamline discovery and briefing. In that regard, if Petitioners join the Elastic IPR, Petitioner will act as an “understudy” and will not assume an active role unless the current petitioner ceases to participate in the instituted IPR.

Petitioner submits that joinder is appropriate, as it will not unduly burden or prejudice the parties to the Elastic IPR while efficiently resolving the question of the ’379 Patent’s validity in this proceeding. Moreover, counsel for Petitioners

have spoken with Elastic's counsel in the Elastic IPR, and Elastic does not oppose joinder by Petitioners.

II. STATEMENT OF MATERIAL FACTS

1. On May 3, 2021, Elastic NV filed a petition for *inter partes* review (IPR2021-00875).
2. On October 28, 2021, the Board instituted the Elastic IPR as to all challenged claims and on all grounds.
3. The Westfield-Pregis Petition and the Elastic IPR petition are substantially identical; they contain the same grounds (based on the same prior art combinations and supporting evidence) against the same claims.
4. Elastic does not oppose this Motion for Joinder.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Board has the authority under 35 U.S.C. § 315(c) to join a properly filed *inter partes* review petition to an instituted *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). A motion for joinder must be filed within one month of the Board instituting an original *inter partes* review. 37 C.F.R. § 42.122(b). In deciding whether to exercise its discretion and permit joinder, the Board considers factors, including: (1) the reasons why joinder is appropriate; (2) whether the new petition presents 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 Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

B. Petitioner’s Motion for Joinder Is Timely

This Motion for Joinder is timely because it is filed within one month of the institution decision of the Elastic IPR (i.e., within one month of the October 28, 2021 institution decision). *See* 37 C.F.R. § 42.122(b).

C. Each Factor Weighs in Favor of Joinder

All four factors weigh in favor of granting this Motion for Joinder. The Westfield-Pregis Petition is substantively identical to the Elastic IPR petition. Petitioner does not present any new grounds of unpatentability, and presents no new evidence related to patentability. Additionally, as all issues are substantively identical and Petitioners will act as an “understudy,” joinder will have minimal or no impact on the pending schedule of the Elastic IPR. *See Sony Corp. et al. v. Memory Integrity, LLC*, IPR2015-01353, Paper No. 11 at 6 (PTAB Oct. 15, 2015) (granting motion for joinder where petitioners requested an “understudy” role). Moreover, the briefing and discovery will be simplified by resolving all issues in a single proceeding. Accordingly, joinder is appropriate.

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.