

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ATLASSIAN CORP. PLC, ATLASSIAN, INC., EXPEDIA, INC.,  
HOMEAWAY.COM, INC., PINTEREST, INC., SQUARESPACE, INC.,  
WIX.COM, LTD., AND WIX.COM, INC.,  
Petitioners,

v.

EXPRESS MOBILE INC.,  
Patent Owner.

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IPR2022-00784  
Patent 9,471,287 B2

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Before JEFFREY S. SMITH, AMBER L. HAGY, and  
AARON W. MOORE, *Administrative Patent Judges*.

HAGY, *Administrative Patent Judge*.

DECISION  
Granting Institution of *Inter Partes* Review  
35 U.S.C. § 314  
Granting Motion for Joinder  
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

## I. INTRODUCTION

### A. *Background and Summary*

Atlassian Corp. PLC., Atlassian, Inc., Expedia, Inc., Homeaway.com, Inc., Pinterest, Inc., Squarespace, Inc., Wix.com, Ltd., and Wix.com, Inc. (collectively, “Petitioner”) filed a Petition requesting *inter partes* review of claims 1, 2, 5–7, 11, and 12 of U.S. Patent No. 9,471,287 B2 (“the ’287 patent,” Ex. 1001). Paper 1 (“Pet.”). Petitioner also filed a Motion for Joinder seeking to be joined as a party to *Facebook, Inc. v. Express Mobile Inc.*, IPR2021-01456 (“the Facebook IPR”), which involves the same claims of the ’287 patent. Paper 3 (“Motion” or “Mot.”).

Express Mobile, Inc. (“Patent Owner”) opposed the Motion (Paper 7 (“Opposition” or “Opp.”)), and Petitioner filed a reply in support of the Motion (Paper 8).

Patent Owner also filed a Preliminary Response. Paper 9 (“Prelim. Resp.”).

For the reasons explained below, we determine that institution of *inter partes* review is warranted on the same grounds instituted in the Facebook IPR, and we grant Petitioner’s Motion for Joinder.

### B. *Real Parties in Interest*

The parties identify themselves as the real parties in interest. Pet. 1; Paper 5, 1.

### C. *Related Matters*

As required by 37 C.F.R. § 42.8(b)(2), the parties identify various related matters, including numerous district court proceedings involving the ’287 patent and/or its parent patent, U.S. Patent No. 9,063,755 (“the ’755 patent”). Pet. 1–5; Paper 5, 1–6. Among the identified related matters are

several *inter partes* matters involving the '287 patent: IPR2021-01456 (“the Facebook IPR”) and IPR2022-00248 (“the Booking IPR”) (both instituted); IPR2022-00789 (“the Google IPR”) (co-pending); and IPR2021-00710, IPR2021-01145, and IPR2021-01227 (all denied). Pet. 1, 3; Paper 5, 5.

*D. Asserted Grounds of Unpatentability*

Petitioner asserts that claims 1, 2, 5–7, 11, and 12 are unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 2, 5–7, 12	103(a)	Anderson, <sup>1</sup> Bowers, <sup>2</sup> Jacobs, <sup>3</sup> Ambrose-Haynes, <sup>4</sup> and Geary <sup>5</sup>
11	103(a)	Anderson, Bowers, Jacobs, Ambrose-Haynes, Geary, and NFS Administration <sup>6</sup>

As further support, Petitioner offers the Declaration of Kevin Jeffay, Ph.D. Ex. 1019.

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<sup>1</sup> G. Anderson & P. Anderson, *JAVA Studio Creator Field Guide*, 2d ed. (Prentice Hall 2006) (Ex. 1003, “Anderson”).

<sup>2</sup> B. Bowers & S. Lane, *Advanced FileMaker Pro 6 Web Development* (Wordware Pub. 2003) (Ex. 1004, “Bowers”).

<sup>3</sup> S. Jacobs, *Foundation XML for Flash* (Springer-Verlag 2006) (Ex. 1005, “Jacobs”).

<sup>4</sup> N. Ambrose-Haynes et al., *Professional ColdFusion 5.0* (Wrox Press. Ltd. 2001) (Ex. 1006, “Ambrose-Haynes”).

<sup>5</sup> D. Geary & C. Horstmann, *Core JavaServer Faces* (Sun Microsystems Press, Prentice Hall 2004) (Ex. 1011, “Geary”).

<sup>6</sup> *Unix System V NFS Administration* (D. Herman, ed., Prentice Hall 1993) (Ex. 1007, “NFS Administration”).

## II. ANALYSIS

Joinder for purposes of an *inter partes* review is governed by 35 U.S.C. § 315(c), which states:

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.

“To join a party to an instituted [*inter partes* review (IPR)], the plain language of § 315(c) requires two different decisions.” *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). “First, the statute requires that the Director (or the Board acting through a delegation of authority . . . ) determine whether the joinder applicant’s petition for IPR ‘warrants’ institution under § 314.” *Id.* “Second, to effect joinder, § 315(c) requires the Director to exercise his discretion to decide whether to ‘join as a party’ the joinder applicant.” *Id.*

### A. *Whether the Petition Warrants Institution*

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless the information presented in the Petition and the Preliminary Response shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

The patentability challenges in the Facebook IPR met the “reasonable likelihood” standard of § 314(a). IPR2021-01456, Paper 10, 2, 70, 72.

There is no dispute that the Petition presents the same patentability

challenges as those for which a trial was instituted in the Facebook IPR. *See* Mot. 2 (asserting that the Petition is “identical in substance to the instituted Facebook IPR”); Prelim. Resp. 14 (“[T]his petition is a copy of Facebook’s petition.”). In the present proceeding, Patent Owner does not dispute the patentability merits of Petitioner’s challenges. *See* Prelim. Resp. 9, n.1.

We conclude that Petitioner has demonstrated a reasonable likelihood of prevailing with respect to the challenged claims of the ’287 patent for the reasons set forth in the Facebook IPR. *See* IPR2021-01456, Paper 10, 31–72.

Even if a petition meets the “reasonable likelihood” standard, institution of *inter partes* review is still discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”); 35 U.S.C. § 314(a) (“The Director *may not* authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” (emphasis added)).

Patent Owner contends that we should deny institution based on the factors set forth in the Board’s precedential decision in *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (designated precedential in relevant part). Prelim. Resp. 11–28. *General Plastic* sets forth a series of factors to be considered by the Board in evaluating whether to exercise discretion under 35 U.S.C.

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