

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

SAP AMERICA, INC.  
Petitioner

v.

PI-NET INTERNATIONAL, INC.  
Patent Owner

---

Case No. CBM2014-00018  
Patent 8,037,158

---

Before KARL D. EASTHOM, WILLIAM V. SAINDON, and  
BRIAN J. McNAMARA, *Administrative Patent Judges*

McNAMARA, *Administrative Patent Judge.*

DECISION DENYING MOTION FOR JOINDER  
*Conduct of the Proceeding*  
37 C.F.R. § 42.5

On October 21, 2013, SAP America, Inc. (“Petitioner”) filed a petition for covered business method patent review of claims 4-6, 9, and 10 of US Patent No. 8,037,158 (the ’158 Patent) as unpatentable under 35 U.S.C § 103. Petitioner also moved to join this proceeding with CBM2013-00013 (“Motion For Joinder”).  
Paper 1, Ex. 1.

In CBM2013-00013, the Patent Trial and Appeal Board (“the Board”) instituted a trial on claims 1-3 and 11 of the ’158 Patent as unpatentable under 35 U.S.C. § 101 and 35 U.S.C. § 103, and on claims 1-6 and 11 as unpatentable under 35 U.S.C. § 112(b). CBM2013-00013, Paper 15. In CBM2013-00013, we declined to institute a trial of claims 4 and 6 based on the prior art cited in that petition. *Id.* The petition in CBM2013-00013 did not address claims 9 and 10.

Petitioner argues that joining this proceeding with CBM2013-00013 will secure the just, speedy, and inexpensive resolution of both proceedings because the parties are the same, the patent is the same, and claims 4-6 have been addressed in both proceedings. Motion For Joinder, IV Argument. Patent Owner’s Opposition to Petitioner’s Motion For Joinder (“Opposition to Joinder Motion”) argues that joinder is not appropriate because the schedules of the two proceedings are incompatible, unless the schedule in CBM2013-00013 is extended. Opposition to Joinder Motion, Paper 11, 3-4.

The present proceeding and CBM2013-00013 are related to IPR2013-00194 and IPR2013-00195, in which the involved patents all share substantially the same specification. A Patent Owner Response was filed in CBM2013-00013 (Paper 33) and in IPR2013-00194 (Paper 32) on January 20, 2014. In IPR2013-00195, Patent Owner filed a patent Owner Response (Paper 24) on January 20, 2014 and a Corrected Patent Owner Response (Paper 29) on February 5, 2014. Patent Owner also filed a motion to amend the claims in IPR2013-00195 (Paper 26) on January

Case CBM2014-00018  
Patent 8,037,158

20, 2013 and a corrected motion to amend the claims (Paper 30) on February 5, 2014. We agree with Patent Owner that the timing of the proceedings makes joinder impractical.

CBM2014-00018 also cites prior art not under consideration in CBM2013-00013, IPR2013-00194, or IPR2013-00195. As discussed above, we are aware of the related proceedings. Our Decision To Institute in this proceeding applies the same claim constructions as those we applied in CBM2013-00013, IPR2013-00194 and IPR2013-00195. Claims 4, 6, 9, and 10 in this proceeding all depend directly or indirectly from claims which are the subject of CBM2013-00013. While our final decision in this proceeding may be informed by our analysis in the related proceedings, our consideration of additional prior art in this proceeding can proceed independently.

In consideration of the above, it is ORDERED that Petitioner's Motion For Joinder is DENIED.

Case CBM2014-00018  
Patent 8,037,158

For PETITIONER:

Michael Q. Lee  
[mlee-PTAB@skgf.com](mailto:mlee-PTAB@skgf.com)

Lori A. Gordon  
[lgordon-PTAB@skgf.com](mailto:lgordon-PTAB@skgf.com)

For PATENT OWNER:

Bryan Boyle  
[bboyle@carrferrell.com](mailto:bboyle@carrferrell.com)

Lawrence B. Goodwin  
[LawrenceGoodwinPC@gmail.com](mailto:LawrenceGoodwinPC@gmail.com)

Gerald Dodson  
[jdodson@carrferrell.com](mailto:jdodson@carrferrell.com)