

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PERFECT WORLD ENTERTAINMENT, INC.,
Petitioner,

v.

UNILOC USA, INC. and UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2015-01026
Patent 5,490,216 C2

Before WILLIAM V. SAINDON, DONNA M. PRAISS, and
PATRICK R. SCANLON, *Administrative Patent Judges*.

PRAISS, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review
37 C.F.R. § 42.108

Grant of Motion for Joinder
37 C.F.R. § 42.122(b)

I. INTRODUCTION

Perfect World Entertainment Inc. (“Petitioner”) filed a Petition pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–20 of U.S. Patent No. 5,490,216 C2 (“the ’216 patent”). Paper 1 (“Pet.”). Concurrently, Petitioner filed a Motion for Joinder. Paper 3 (“Joinder Motion”). The Joinder Motion seeks to join this proceeding with *Sega of America, Inc., Ubisoft, Inc., Kofax, Inc., and Cambium Learning Group, Inc. v. Uniloc USA, Inc. and Uniloc Luxembourg S.A.*, Case IPR2014-01453 (“the ’1453 IPR”), which concerns the ’216 patent at issue here. Joinder Motion 1.

Uniloc USA, Inc. and Uniloc Luxembourg S.A. (“Patent Owner”) filed a Preliminary Response (Paper 9, “Prelim. Resp.”) as well as an Opposition to Joinder (Paper 6, “Opposition”). Petitioner filed a Reply to Patent Owner’s Opposition to Motion for Joinder (Paper 7, “Reply”). We instituted trial in the ’1453 IPR on March 10, 2015. ’1453 IPR, Paper 11 (“the ’1453 Institution Decision”). For the reasons described below, we institute an *inter partes* review of claims 1–20 and grant Petitioner’s Motion for Joinder.

II. INSTITUTION OF INTER PARTES REVIEW

A. References

Petitioner relies on the same references as those in the ’1453 IPR:

Reference	Publication	Date	Exhibit
Haines	US 5,077,660	Dec. 31, 1991	1005
Logan	US 5,199,066	Mar. 30, 1993	1003
Grundy	US 5,291,598	Mar. 1, 1994	1004
Schull	US 5,509,070	Apr. 16, 1996	1002
Manduley	US 5,956,505	Sept. 21, 1999	1006

Petitioner also relies on essentially the same Declaration of Vijay K. Madiseti, Ph.D., as in the '1453 IPR, but dated April 8, 2015 for this proceeding. Ex. 1007 (“Madiseti Decl.”).

B. Grounds Asserted

The Petitioner in this proceeding asserts the same grounds as those on which we instituted review in the '1453 IPR. Those are:

Claims Challenged	Basis	Reference(s)
1–11, 17–20	§ 102(e)	Schull
12–14	§ 102(e)	Logan
15, 16	§ 103(a)	Logan and Grundy
12–14	§ 103(a)	Haines and Manduley
10, 11	§ 103(a)	Schull

C. Decision

We have reviewed the Petition, Preliminary Response, and the evidence cited therein. In view of the identity of the challenges to the '216 patent in this Petition and in the petition in the '1453 IPR, we institute an *inter partes* review in this proceeding on the same grounds as those on which we instituted *inter partes* review in the '1453 IPR.

III. MOTION FOR JOINDER

An *inter partes* review may be joined with another *inter partes* review, 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).

To be considered timely, a motion for joinder must be filed no later than one month after the institution date of the *inter partes* review for which joinder is requested. 37 C.F.R. § 42.122(b). The Petition in this proceeding has been accorded a filing date of April 9, 2015 (Paper 4). This date is within one month after the date of institution in the '1453 IPR, which was instituted on March 10, 2015. The Petition, therefore, is timely.

A motion for joinder should: (1) set forth the reasons joinder is appropriate; (2) identify any new ground(s) 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 Kyocera Corporation v. Softview LLC*, IPR2013-00004 (Paper 15, 4) (PTAB Apr. 24, 2013); *see also* Frequently Asked Question H5, <http://www.uspto.gov/patents-application-process/appealing-patent-decisions/trials/patent-review-processing-system-prps-0> (last visited July 29, 2015).

Petitioner contends that joinder will not impact the Board's ability to complete its review in the statutorily prescribed time frame. Joinder Motion 6–7. Petitioner proposes an accelerated schedule in this proceeding in order to “reach a decision on institution prior to the June 8, 2015 deadline for Patent Owner's Response in the ['1453] IPR.” *Id.* at 7. Petitioner contends that the grounds asserted in this Petition are the same grounds of unpatentability asserted in the '1453 IPR. *Id.* at 5–6. Petitioner's arguments regarding the asserted references are identical to the arguments raised in the '1453 IPR, and Petitioner has submitted, in support of its Petition, substantially the same declaration of the same technical expert as submitted

in the '1453 IPR (excluding some minor changes made to reflect Petitioner's subsequent engagement of the same expert). *Id.*

Petitioner further contends that joinder will promote efficiency by avoiding redundancy. *Id.* at 6–7. According to Petitioner, the Board can minimize any scheduling impact by requiring consolidated filings and coordination among petitioners. *Id.*

Patent Owner opposes joinder, contending that joinder would impact the trial schedule because a decision on the joinder motion would coincide with the time that Petitioner's Reply is due in the '1453 IPR. Opposition 5–6; *see also* '1453 IPR, Paper 12, 6 (Scheduling Order, setting the due date for Petitioner's reply to September 8, 2015). Patent Owner also contends that because the Preliminary Response in this proceeding includes new argument not previously considered by the Board in the '1453 IPR, “the risk arises that one of the parties in the pending IPR2014-01453 would be unfairly advantaged by an untimely decision whether to institute trial for the present Petition.” *Id.* at 6.

In response to Patent Owner's concerns about the impact on the trial schedule, Petitioner states:

Petitioner has no intention to revisit the already conducted depositions, despite suggestions otherwise by the Opposition (p. 5). Rather, Petitioner simply seeks to join the ongoing ['1453] IPR, adopting its status upon the grant of joinder.

Reply 3.

As discussed above, joinder is a matter within the Board's discretion based on the particular circumstances of each proceeding. In this proceeding, we are persuaded that Petitioner has demonstrated that joinder with the '1453 IPR would avoid duplication and promote the efficient

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