

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERNATIONAL BUSINESS MACHINES CORPORATION and
SOFTLAYER TECHNOLOGIES, INC,
Petitioner,

v.

ZITOVault, LLC,
Patent Owner.

Case IPR2016-01025
Patent 6,484,257 B1

Before JAMESON LEE, MICHAEL W. KIM, and DANIEL N. FISHMAN,
Administrative Patent Judges.

FISHMAN, *Administrative Patent Judge.*

DECISION

Institution of *Inter Partes* Review and
Granting Petitioner's Unopposed Motion for Joinder
35 U.S.C. § 314(a), 37 C.F.R. §§ 42.108, 42.122

I. INTRODUCTION

International Business Machines Corporation and Softlayer Technologies (collectively “Petitioner”), filed a Petition (Paper 2, “Pet.”) for *inter partes* review of claims 1, 3, 5–8, and 10 of U.S. Patent No. 6,484,257 B1 (“the ’257 Patent”) (Ex. 1001) pursuant to 35 U.S.C. §§ 311–319. Along with the Petition, Petitioner filed a Motion for Joinder with IPR2016-00021. Paper 4 (“Mot.”). The Motion for Joinder was timely filed May 10, 2016, within one month after we instituted trial in IPR2016-00021. *See* 37 C.F.R. § 42.122(b).

In an e-mail message sent July 27, 2016, counsel for Zitovault, LLC (“Patent Owner”) indicated that Patent Owner did not object to the Motion for Joinder and requested a conference call seeking guidance regarding Patent Owner’s options for filing a Preliminary Response. We conducted a conference call on July 28, 2016 with counsel for the parties and Judges Lee, Kim, and Fishman. Furthermore, Lead Counsel for Petitioner in IPR2016-00021 was added to the conference call and confirmed they had no objection to the proposed joinder. On August 15, 2016, Patent Owner filed a paper waiving filing of a preliminary response to the Petition. Paper 6.

As explained further below, we institute trial in this *inter partes* review on the same grounds as instituted in IPR2016-00021 and we grant Petitioner’s unopposed Motion for Joinder.

II. DISCUSSION

A. *Institution of Trial*

In IPR2016-00021, Petitioner (Amazon.com et. al.) challenges the patentability of claims 1, 3–8, and 10 of the '257 Patent based on the following items of prior art:

U.S. Patent No. 6,065,046; May 16, 2000. Ex. 1002 (“Feinberg”).
U.S. Patent No. 6,266,355 B1; July 24, 2001. Ex. 1003 (“Bhaskaran”).
Refik Molva, et al., *Authentication of Mobile Users*, IEEE Network, March/April 1994. Ex. 1004 (“Molva”).

Petitioner in IPR2016-00021 alleged the following grounds of unpatentability:

Reference(s)	Claims	Basis for Challenge
Feinberg	6 and 10	§ 102(e)
Feinberg and Bhaskaran	1, 3, 4, 6, and 10	§ 103(a)
Feinberg and Molva	5, 7, and 8	§ 103(a)

After considering the Petition and the Patent Owner’s Preliminary Response in IPR2016-00021, we instituted trial for all the above-identified grounds of unpatentability with the exception of claim 4. *See* IPR2016-00021, Paper 8, 40. Petitioner here represents that this Petition is substantively identical to the Petition in IPR2016-00021 and challenges the same claims for which we instituted trial (i.e., excludes claim 4 in the asserted grounds). Mot. 1; *Compare* IPR2016-00021, Paper 1 *with* IPR2016-01025, Paper 2. We have considered the relevant Petitions and we agree with Petitioner’s representation.

Patent Owner waived its right to file a preliminary response in this proceeding. Paper 6. Patent Owner also did not file an opposition to Petitioner’s Motion for Joinder. For essentially the same reasons stated in

our Decision to Institute in IPR2016-00021, we conclude Petitioner has established a reasonable likelihood of prevailing with respect to at least one challenged claim and we institute trial in this proceeding for claims 1, 3, 5–8, and 10 on the same grounds as in IPR2016-00021.¹

B. Motion for Joinder

Based on authority delegated to us by the Director, we have discretion to join an *inter partes* review to a previously instituted *inter partes* review. 35 U.S.C. § 315(c). Section 315(c) provides, in relevant part, that “[i]f 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.” *Id.*

In the conference call, we proposed these conditions for joinder, which were agreed to by Petitioner, Patent Owner, and Petitioner in IPR2016-00021:

In the joined proceeding, Petitioner here (IBM Corporation and Softlayer Technologies, Inc.) will be bound by all substantive and procedural filings and representations of current Petitioner in IPR2016-00021 (Amazon.Com, Inc.,

¹ Unlike in the instant proceeding in which Patent Owner waived its right to file a Preliminary Response, Patent Owner did file a Preliminary Response in IPR2016-00021. We have reviewed the Decision to Institute in IPR2016-00021, however, and determine that our decision to institute trial on claims 1, 3, 5–8, and 10 in that proceeding would not have been affected dispositively if Patent Owner had not filed a Preliminary Response. More specifically, in IPR2016-00021, we were unpersuaded by Patent Owner’s arguments, set forth in their Preliminary Response, that Petitioner had not met its burden to show a reasonable likelihood of prevailing concerning unpatentability of claims 1, 3, 5–8, and 10. Therefore, the lack of those arguments in this proceeding is equally unpersuasive.

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Amazon.Com, LLC, Amazon Web Services, Inc., Bazaarvoice, Inc., and Gearbox Software, LLC), without a separate opportunity to be heard, whether orally or in writing, unless and until the joined proceeding is terminated with respect to the current Petitioner in IPR2016-00021.

In view of the foregoing, we determine that joinder based upon the above-noted condition will have little or no impact on the timing, cost, or presentation of the trial on the instituted grounds. Moreover, discovery and briefing will be simplified if the proceedings are joined. Thus, without opposition to the Motion for Joinder from any of the parties and also not from the Petitioner in IPR2016-00021, the Motion is granted.

III. ORDER

After due consideration of the record before us, and for the foregoing reasons, it is:

ORDERED that pursuant to 35 U.S.C. § 314, an *inter partes* review is hereby instituted for claims of the '257 Patent as follows: claims 6 and 10 as anticipated under 35 U.S.C. § 102(e) by Feinberg; claims 1, 3, 6, and 10 as unpatentable under 35 U.S.C. § 103(a) over Feinberg and Bhaskaran; and claims 5, 7, and 8 as unpatentable under 35 U.S.C. § 103(a) over Feinberg and Molva;

FURTHER ORDERED that Petitioner's Motion for Joinder with IPR2016-00021 is *granted*;

FURTHER ORDERED that the grounds on which an *inter partes* review was instituted in Case IPR2016-00021 remain unchanged, and no other grounds are instituted in the joined proceedings;

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