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Paper 12
Date Entered: March 31, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FRIENDFINDER NETWORKS INC.
STREAMRAY INC
WMM, LLC
WMM HOLDINGS, LLC, AND
MULTI MEDIA, LLC.
Petitioner,

v.

WAG ACQUISITION, LLC,
Patent Owner.

Case IPR2017-00784
Patent 8,364,839 B2

Before GLENN J. PERRY, TREVOR M. JEFFERSON, and BRIAN J. McNAMARA, *Administrative Patent Judges*.

PERRY, *Administrative Patent Judge*.

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

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

I. INTRODUCTION

This is a preliminary proceeding to decide whether *inter partes* review of U.S. Patent No. 8,364,839 B2 (Ex. 1001, "the '839 patent") should be instituted under 35 U.S.C. §314(a) and if so, whether this case should be joined with IPR2016-01239 (the "1239 IPR" or the "WebPower IPR"), already in *inter partes* review of the '839 patent. We conclude that the information presented demonstrates that there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of at least one of at least one of the challenged claims and therefore institute *inter partes* review. We also conclude that this case should be joined with IPR2016-01239 and that the joined cases should proceed according to the scheduling order governing IPR2016-01239. *See* IPR2016-01239, Paper 8.

Petitioner, Friendfinder Networks Inc., Streamray Inc., WMM, LLC, WMM Holdings, LLC, and Multi Media, LLC filed a Petition (Paper 2, "Pet.") and a Motion for Joinder (Paper 3, "Mot."), to institute an *inter partes* review of claims 1–21 (the "challenged claims") of the '839 patent and to join with the 1239 IPR, already in trial. 35 U.S.C. § 311. We held a telephone conference with Counsel on February 6, 2017 and issued an Order (Paper 5) authorizing briefing on the Motion for Joinder. Patent Owner, Wag Acquisition, LLC, filed an Opposition to Petitioner's Motion for Joinder (Paper 8, "Opp.") and Petitioner filed a Reply in Support of its Motion for Joinder (Paper 9, "Reply"). Patent Owner waived the filing of a preliminary response. Paper 11, "Waiver."

The '839 patent was the subject of *inter partes* review IPR2015-01036 ("the '1036 review"), brought by a different Petitioner ("Duodecad"). In the '1036 review, we issued a final written decision indicating that claims 1, 4,

6, 8, 11, 13, 15, 18, and 20 are unpatentable under 35 U.S.C. § 103(a) as obvious over Chen and Chen FH; and that claims 3, 10, and 17 are unpatentable under 35 U.S.C. § 103(a) as obvious over Chen, Chen FH, and ISO-11172. IPR2015-01036, Paper 17. No trial was declared as to claims 5, 12, and 19 and they were not part of our Final Written Decision. In the WebPower IPR, we instituted *inter partes* review as to claims 5, 12, and 19 only. That review is pending. The Petition now under consideration raises the same challenges as those enumerated in the Petition filed for IPR2016-01239.

II. INSTITUTION OF *INTER PARTES* REVIEW

In the 1239 IPR, we instituted an *inter partes* review of claims 5, 12, and 19 of the '839 patent as allegedly unpatentable on the following asserted grounds:

References	Basis	Claims Challenged
Chen,[1] Willebeek,[2] and Chen FH[3]	35 U.S.C. § 103	5, 12, and 19
Chen, Cannon,[4] and Chen FH	35 U.S.C. § 103	5, 12, and 19

[1] U.S. Patent 5,822,524, issued October 13, 1998 (Ex. 1004, "Chen").
[2] "*Bamba-Audio and Video Streaming Over the Internet*," M.H. Willebeek-LeMair, et al. International Business Machines, Corporation, IBM J. RES. DEVELOP., Vol. 42, No. 2 (1998) (Ex. 1008, "Willebeek").
[3] File History of U.S. Application 505,488 (Ex. 1010, "Chen FH").
[4] U.S. Patent 6,014,706, issued Jan. 11, 2000 (Ex. 1009, "Cannon").

The Petition in this proceeding challenges the same claims on identical grounds of unpatentability, and relies on the same evidence and arguments as presented in the 1239 IPR. Pet. 1; Mot. 2. Friendfinder represents that the Petition "copies verbatim the challenges set forth in the petition in [the 1239 IPR] and relies upon the same evidence, including the same expert declaration." Pet. 4–5. Patent Owner waived filing a Preliminary Response and has not presented any arguments regarding the merits of the Petition. Patent Owner relies upon its arguments presented in the 1239 IPR. Paper 11.

For the above reasons, in particular the fact that the present Petition virtually is identical to the petition in the 1239 IPR, we determine that Petitioner has demonstrated sufficiently under 35 U.S.C. § 314 that an *inter partes* review should be instituted in this proceeding on the same grounds of unpatentability as the grounds on which we instituted *inter partes* review in the 1239 IPR.

III. MOTION FOR JOINDER

An *inter partes* review may be joined with another *inter partes* review, subject to certain statutory provisions:

> (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 parties review under section 314.

35 U.S.C. § 315(c); see 37 C.F.R. § 42.122. 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).

As an initial matter, the Motion for Joinder meets the requirements of 37 C.F.R. § 42.122(b) because the Motion was filed on January 27, 2017, which is not later than one month after the 1239 IPR was instituted on December 27, 2016.

Additionally, the Petition challenges the same claims of the same patent as those under *inter partes* review in the 1239 IPR, and the Petition also asserts the same grounds of unpatentability based on the same prior art and the same evidence, including the same declaration testimony. Mot. 1; compare Pet. 5, with 1239 IPR, Paper 2, 4–5. The Petition does not assert any other grounds of unpatentability, or present any new evidence not already of record in the 1239 IPR. Mot. 7–8. Indeed, the Petition is identical to the content of the petition in the 1239 IPR. *See* Pet. 1; Mot. 8–9.

Petitioner further asserts that granting joinder would not require any alterations to the existing scheduling order in the 1239 IPR. Mot. 9. Petitioner agrees to:

> 1. Adhere to the Scheduling Order issued in the WebPower IPR, including all applicable deadlines.
> 2. Submit all papers as "consolidated" filings with the WebPower IPR petitioner. Petitioners would not submit any separate filings to the Board unless WebPower settles with Patent Owner.
> 3. Refrain from requesting or reserving any additional discovery, including any depositions or deposition time.
> 4. Will not seek to submit any new expert declarations from those entered by WebPower unless WebPower settles with Patent Owner and that settlement contractually prevents WebPower's expert from continuing to support Petitioners.
> 5. Refrain from requesting or reserving additional oral argument hearing time.
> 6. Take an "understudy" role as long as the WebPower IPR petitioner remains in the proceeding.

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