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Paper No. 13
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ORACLE AMERICA, INC.,
Petitioner,

v.

REALTIME DATA LLC,
Patent Owner.

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Case IPR2016-01672
Patent 9,116,908 B2

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Before GEORGIANNA W. BRADEN, J. JOHN LEE, and JASON J. CHUNG, *Administrative Patent Judges*.

CHUNG, *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)*

## INTRODUCTION

On September 6, 2016, Oracle America, Inc. ("Oracle") filed a Petition (Paper 5, "Pet.") requesting *inter partes* review of claims 1, 2, 4–6, 9, 11, 21, 22, 24, and 25 ("the challenged claims") of U.S. Patent No. 9,116,908 B2 (Ex. 1001, "the '908 patent"). Concurrently with the Petition, Oracle filed a Motion for Joinder (Paper 2, "Mot."), requesting that this proceeding be joined with *Dell, Inc. v. Realtime Data LLC d/b/a IXO*, Case IPR2016-01002 ("1002 IPR"). Mot. 1. Patent Owner Realtime Data LLC d/b/a IXO ("Realtime") filed an Opposition to the Motion for Joinder (Paper 9, "Opp.") on October 6, 2016. Oracle filed a Reply to the Opposition to the Motion (Paper 10, "Reply") on November 7, 2016.

For the reasons discussed below, we institute an *inter partes* review of all of the challenged claims and grant Oracle's Motion for Joinder.

## INSTITUTION OF *INTER PARTES* REVIEW

In the 1002 IPR, we instituted an *inter partes* review of claims 1, 2, 4–6, 9, 11, 21, 22, 24, and 25 of the '908 patent as allegedly unpatentable on the following asserted grounds[1]:

| References | Basis | Claims Challenged |
|---|---|---|
| Franaszek[2] and Osterlund[3] | § 103(a) | 1, 9, 11, 21, 22, 24, and 25 |

[1] Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), revised 35 U.S.C. § 103, effective March 16, 2013. The '812 patent was issued prior to the effective date of the AIA. Thus, we apply the pre-AIA version of § 103.
[2] U.S. Patent No. 5,870,036, filed February 24, 1995, issued Feb. 9, 1999 (Ex. 1004, "Franaszek").
[3] U.S. Patent No. 5,247,646, filed July 22, 1991, issued Sept. 21, 1993 (Ex. 1005, "Osterlund").

| References | Basis | Claims Challenged |
|---|---|---|
| Franaszek, Osterlund, and Fall[4] | § 103(a) | 2, 4, 5, and 6 |

1002 IPR, slip op. at 16–17 (PTAB Nov. 4, 2016) (Paper 25). 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 1002 IPR. Pet. 1; Mot. 2. Oracle represents that the Petition "copies verbatim the challenges set forth in the petition in [the 1002 IPR] and relies upon the same evidence, including the same expert declaration." Pet. 1; *see* Mot. 2. Realtime did not file a preliminary response and has not presented any arguments regarding the merits of the Petition.

For the above reasons, in particular the fact that the present Petition virtually is identical to the petition in the 1002 IPR, we determine Oracle 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 1002 IPR.

## 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

[4] U.S. Patent No. 5,991,515, filed July 15, 1997, issued Nov. 23, 1999 (Ex. 1006, "Fall").

> 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, Oracle 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 September 6, 2016, which is not later than one month after the 1002 IPR was instituted on November 4, 2016.

Additionally, the present Petition challenges the same claims of the same patent as those under *inter partes* review in the 1002 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. 2; *compare* Pet. 5–7, *with* 1002 IPR, Paper 5, 5–7. The Petition does not assert any other grounds of unpatentability, or present any new evidence not already of record in the 1002 IPR. Mot. 7–8. Indeed, the Petition repeats verbatim most of the content of the petition in the 1002 IPR. *See* Pet. 1; Mot. 7–8.

Oracle further asserts that granting joinder would not require any alterations to the existing scheduling order in the 1002 IPR. Mot. 8–9. Moreover, Oracle represents that it "has agreed to not materially participate in the joined proceedings unless and until the parties to [the 1002 IPR] are dismissed from the joined proceedings or elect to transfer control to [Oracle], as may occur in the event of settlement or advanced settlement negotiations." *Id.* As such, Oracle "does not intend to file separate papers

or conduct separate cross examinations of any witnesses," if joined to the 1002 IPR. *Id.* at 10. Oracle also represents that the petitioners in the 1002 IPR do not oppose joinder of the present proceeding. *Id.* at 6.

According to Oracle, joinder "will promote the efficient determination of validity of the challenged claims of the '908 patent," because a final written decision in the 1002 IPR potentially could minimize the issues in all of the underlying litigation in which the '908 patent has been asserted. *Id.* Oracle asserts that Realtime would not be prejudiced because the schedule of the 1002 IPR would be unchanged, and Realtime would not take on additional costs or burden because of the overlap between the present Petition and the 1002 IPR petition. *Id.* at 8. In addition, Oracle argues that briefing and discovery could be simplified if joinder is granted. *Id.* at 9–10.

Realtime argues that the fact that the present Petition and the 1002 IPR petition are similar is not dispositive. Opp. 1–2. According to Realtime, Oracle failed to demonstrate it is entitled to joinder because it did not explain why it could not have included the arguments and grounds in the present Petition in an earlier petition it filed in IPR2016-00377. *Id.* at 2–5. In IPR2016-00377, Oracle challenged all of the claims challenged in the present Petition based on different prior art references. *See Oracle Am., Inc. v. Realtime Data LLC*, Case IPR2016-00377, slip op. at 4–5 (PTAB July 1, 2016). The petition in that case was denied, and no *inter partes* review was instituted. *Id.* at 15. Realtime asserts that Oracle, thus, already had an opportunity to assert the challenges and evidence advanced in the present Petition but did not, and that allowing Oracle to do so now would improperly grant it a "second bite at the apple." Opp. 6–7. In addition, Realtime asserts it would be prejudiced by joinder because the one-year

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