

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WAHOO FITNESS LLC.,

Petitioner,

v.

BLACKBIRD TECH LLC. d/b/a BLACKBIRD TECHNOLOGIES,

Patent Owner.

Case IPR2018-00275

Patent 6,434,212

Before DEBRA K. STEPHENS, THOMAS L. GIANNETTI, and
CHRISTA P. ZADO, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

DECISION

Decision on Institution and Motion for Joinder

37 C.F.R. § 42.1

I. INTRODUCTION

Wahoo LLC. (“Petitioner”) filed a Petition for an *inter partes* review of claims 2, 5, and 6 of U.S. Patent No. 6,434,212 B2 (Ex. 1001, “the ’212 patent”) (Paper 1 (“Pet.”)) and concurrently filed a Motion for Joinder (Paper 3, “Mot.”). The Motion for Joinder seeks to join the proceeding with *Fitbit, Inc. v. Blackbird Tech LLC d/b/a Blackbird Technologies*, IPR2017-02012 (“Fitbit IPR”)(Mot. 1). Blackbird Tech LLC d/b/a Blackbird Technologies (“Patent Owner”) has not filed an Opposition to the Motion for Joinder. Blackbird Tech LLC d/b/a Blackbird Technologies (“Patent Owner”) filed a Preliminary Response (Paper 7 (“Prelim. Resp.”)). For the reasons described below, we institute an *inter partes* review of all the challenged claims and grant Petitioner’s Motion for Joinder.

II. INSTITUTION OF *INTER PARTES* REVIEW

On March 12, 2018, we instituted a trial in IPR2017-02012 (“Fitbit IPR”) on the following grounds:

Claim(s)	Basis	References
2 and 5	§ 103	Amano et al., U.S. Patent Number 6,241,684 B1 (“Amano”) (IPR2017-02012, Exhibit 1003)
6	§ 103	Kato et al. U.S. Patent Number 5,033,013 (“Kato”) (IPR2017-02012, Exhibit 1004) and Amano

IPR2018-00275
Patent 6,434,212

(*Fitbit, Inc. v. Blackbird Tech LLC d/b/a Blackbird Technologies*, IPR2017-02012, Paper 8). Petitioner asserts the same grounds of unpatentability in this Petition as those asserted in the Fitbit IPR (Pet. 1). Petitioner also presents testimony from the same declarant relied on in the Fitbit IPR (*compare* Ex. 1005, *with* Fitbit IPR, Ex. 1005).

In view of the identity of the challenge in the instant Petition and in the petition in the IPR2017-02012, we institute an *inter partes* review in this proceeding on the same grounds as those on which we instituted *inter partes* review in IPR2017-02012. We do not institute *inter partes* review on any other grounds.

III. GRANT OF 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), which governs joinder of inter partes review proceedings:

(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)). A motion for joinder should: (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing

IPR2018-00275
Patent 6,434,212

review (*see* Frequently Asked Question H5, <https://www.uspto.gov/patents-application-process/appealing-patent-decisions/trials/patent-review-processing-system-prps-0>),

Petitioner asserts it has grounds for joinder because, in accordance with 35 U.S.C. § 315(c), Petitioner filed a motion for joinder concurrently with the Petition, prior to one month after the institution date of the Fitbit IPR, the *inter partes* review with which joinder is requested (Mot. 1 (citing 37 C.F.R. 42.122(b))). More specifically, as noted by Petitioner, the Petition was filed before the March 12, 2018 institution date of the Fitbit IPR (*see* Mot. 1 (*see* Fitbit IPR, Paper 8)). Further, Patent Owner has not filed an opposition to the Motion.

In its Preliminary Response, Patent Owner relies on Petitioner's representation that this Petition "is identical to the Fitbit IPR [(IPR2017-02012)] in all substantive respects, including reliance on the same exhibits and reliance on the same expert declaration testimony" and in response, submits a Preliminary Response "that is substantially identical to the Patent Owner Response" that Patent Owner submitted in the Fitbit IPR (Prelim. Resp. 6).

Petitioner asserts joinder is appropriate because the instant Petition presents the same grounds of invalidity as have been raised in the Fitbit IPR. In addition, the Petition filed by [Petitioner] is identical to the Fitbit IPR Petition in all substantive respects, including reliance on the same exhibits and reliance on the same expert declaration testimony. The only differences relate to the identification of the correct Petitioner, mandatory notices, and other non-substantive matter

(Mot. 1). Petitioner represents that “Petitioner has copied the substance of Fitbit’s petition and accompanying declaration” and “does not seek to introduce grounds or claims not in the Fitbit IPR” of “broaden the scope of the Fitbit IPR” (*id.* at 6). Petitioner further represents “Petitioner has retained the same expert, who has submitted a substantively-identical declaration as in the Fitbit IPR” (*id.*).

Petitioner agrees to:

1. Adhere to all applicable deadlines in the Fitbit IPR;
2. Submit “consolidated” filings with the Fitbit Petitioner, . . . ;
3. Refrain from requesting or reserving any additional depositions or deposition time;
4. Refrain from requesting or reserving additional oral hearing time; and
5. Assume an “understudy” role

(*id.* at 6–7). Petitioner further “agrees to withdraw any grounds the Board denies in the Fitbit IPR” and “not introduce any new prior art, expert declarations, or grounds of unpatentability” (*id.* at 7).

In addition, Petitioner asserts “joinder of this proceeding with the Fitbit IPR will not require a change to any existing schedule” (*id.* at 7–8).

IV. DISCUSSION

We find that the Motion is timely (*see* 37 C.F.R. § 42.122). We also find that Petitioner has met its burden of showing that joinder is appropriate.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.