

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

IRON OAK TECHNOLOGIES, LLC,
Patent Owner.

Case IPR2019-00110
Patent 5,699,275

Before SALLY C. MEDLEY, PATRICK R. SCANLON, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

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

I. INTRODUCTION

Google LLC (“Petitioner”) filed a Petition for *inter partes* review of claim 1 of U.S. Patent No. 5,699,275 (Ex. 1001, “the ’275 patent”). Paper 2 (“Pet.”). Petitioner also filed a Motion for Joinder with *Samsung Electronics Co., Ltd. v. Iron Oak Technologies*, Case IPR2018-01552 (“the 1552 IPR”). Paper 8 (“Mot.”). Iron Oak Technologies, LLC (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). Patent Owner indicates that it does not oppose the Motion for Joinder. Paper 10. We have authority under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

For the reasons described below, we institute an *inter partes* review of the challenged claim and grant Petitioner’s Motion for Joinder.

II. RELATED PROCEEDINGS

The parties indicate that the ’275 patent is the subject of several court proceedings. Pet. 1–2; Paper 3, 2–3. The ’275 patent also is the subject of the 1552 IPR, IPR2018-01553, IPR2019-00106, and IPR2019-00111.

In the 1552 IPR, we instituted an *inter partes* review of claim 1 of the '275 patent on the following grounds:

Reference(s)	Basis	Challenged Claim
Sugita ¹	§ 102	1
Sugita and Wortham ²	§ 103	1
Ballard ³ and Shimizu ⁴	§ 103	1

Samsung Electronics Co., Ltd. v. Iron Oak Technologies, Case IPR2018-01552, slip op. at 4, 26 (PTAB February 27, 2019) (Paper 9) (“1552 Dec.”).

III. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same grounds of unpatentability as the ones on which we instituted review in the 1552 IPR. *Compare* Pet. 16–71, with 1552 Dec. 4, 26. Indeed, Petitioner contends that the Petition “is identical to the Samsung Petition, with only formal matters (such as the caption, mandatory notices, signature of counsel and certificate of service) changed.” Mot. 3. Petitioner further explains that it relies on the same declaration from the same expert. *Id.* at 5.

Patent Owner’s Preliminary Response is “substantively identical to the Preliminary response filed by Patent Owner in IPR2018-01552.” Prelim. Resp. 1. For the same reasons set forth in our institution decision in the

¹ JP Published Patent Application No. 1993-128022, published May 25, 1993 (Ex. 1005, “Sugita”).

² U.S. Patent No. 5,155,689, issued Oct. 13, 1992 (Ex. 1014, “Wortham”).

³ Australian Patent Application No. 77395/91, published May 12, 1991 (Ex. 1006, “Ballard”).

⁴ JP Published Patent Application No. 05-66937, published Mar. 19, 1993 (Ex. 1007, “Shimizu”).

IPR2019-00110
Patent 5,699,275

1552 IPR, we determine that the information presented in the Petition shows a reasonable likelihood that Petitioner would prevail in showing that claim 1 is unpatentable. *See* 1552 Dec. 8–25. Accordingly, we institute an *inter partes* review on the same grounds as the ones on which we instituted review in the 1552 IPR.

IV. GRANT OF MOTION FOR JOINDER

The Petition in this proceeding was accorded a filing date of October 24, 2018. *See* Paper 6. The 1552 IPR was instituted on February 27, 2019. Petitioner filed a Motion for Joinder on March 6, 2019. Paper 8. Thus, Petitioner’s Motion for Joinder is timely because joinder was requested no later than one month after the February 27, 2019 institution date of the 1552 IPR. *See* 37 C.F.R. § 42.122(b).

The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads:

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.

A motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

IPR2019-00110
Patent 5,699,275

The Petition in this case asserts the same unpatentability grounds on which we instituted review in the 1552 IPR. *See* Mot. 3. Petitioner further explains that it relies on the same prior art analysis and declaration from the same expert. *Id.* at 5. Thus, this *inter partes* review does not present any ground or matter not already at issue in the 1552 IPR.

If joinder is granted, Petitioner anticipates participating in the proceeding in a limited capacity absent termination of the petitioner in the 1552 IPR (“Samsung”) as a party. *Id.* at 6–8. Petitioner agrees to assume an “understudy” role in the 1552 IPR, “so long as Samsung remains an active party in IPR2018-01552.” *Id.* at 6. Petitioner further represents that it will not “raise any new grounds not already instituted by the Board, or introduce any argument or discovery not already introduced by Samsung.” *Id.* at 7. Because Petitioner expects to participate only in a limited capacity, Petitioner submits that joinder will not impact the trial schedule for the 1552 IPR. *Id.* at 6–8.

We agree with Petitioner that joinder with the 1552 IPR is appropriate under the circumstances. Accordingly, we *grant* Petitioner’s Motion for Joinder.

V. ORDER

Accordingly, it is:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claim 1 of the ’275 patent is instituted in IPR2019-00110;

FURTHER ORDERED that the Motion for Joinder with IPR2018-01552 is *granted*, and Google LLC is joined as a petitioner in IPR2018-01552;

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.