

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

IRON OAK TECHNOLOGIES, LLC,
Patent Owner.

Case IPR2019-00111
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 IPR2018-01553 (“the 1553 IPR”). Paper 7 (“Mot.”). Iron Oak Technologies, LLC (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Patent Owner indicates that it does not oppose the Motion for Joinder. Paper 9. 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 1553 IPR, IPR2018-01552, IPR2019-00106, and IPR2019-00110.

In the 1553 IPR, we instituted an *inter partes* review of claim 1 of the '275 patent on the following grounds:

References	Basis	Challenged Claim
Hapka ¹ and Parrillo ²	§ 103	1
Hapka, Parrillo, and Wortham ³	§ 103	1

Samsung Electronics Co., Ltd. v. Iron Oak Technologies, Case IPR2018-01553, slip op. at 4, 19 (PTAB February 27, 2019) (Paper 9) (“1553 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 1553 IPR. *Compare* Pet. 17–64, with 1553 Dec. 4, 19. Indeed, Petitioner contends that the Petition “is substantially 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 IPR2018-01553.” Prelim. Resp. 1. For the same reasons set forth in our institution decision in the 1553 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* 1553 Dec. 8–18. Accordingly, we institute an

¹ U.S. Patent No. 5,619,412, issued Apr. 8, 1997 (Ex. 1008, “Hapka”).

² U.S. Patent No. 5,442,553, issued Aug. 15, 1995 (Ex. 1009, “Parrillo”).

³ U.S. Patent No. 5,155,689, issued Oct. 13, 1992 (Ex. 1014, “Wortham”).

inter partes review on the same grounds as the ones on which we instituted review in the 1553 IPR.

IV. GRANT OF MOTION FOR JOINDER

The Petition in this proceeding was accorded a filing date of October 24, 2018. *See* Paper 5. The 1553 IPR was instituted on February 27, 2019. Petitioner filed a Motion for Joinder on March 6, 2019. Paper 7. 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 1553 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).

The Petition in this case asserts the same unpatentability grounds on which we instituted review in the 1553 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 1553 IPR.

If joinder is granted, Petitioner anticipates participating in the proceeding in a limited capacity absent termination of the petitioner in the 1553 IPR (“Samsung”) as a party. *Id.* at 6–8. Petitioner agrees to assume an “understudy” role in the 1553 IPR, “so long as Samsung remains an active party in IPR2018-01553.” *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 7–8. Because Petitioner expects to participate only in a limited capacity, Petitioner submits that joinder will not impact the trial schedule for the 1553 IPR. *Id.* at 6–8.

We agree with Petitioner that joinder with the 1553 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 IPR2019-00111;

FURTHER ORDERED that the Motion for Joinder with IPR2018-01553 is *granted*, and Google LLC is joined as a petitioner in IPR2018-01553;

FURTHER ORDERED that IPR2019-00111 is terminated under 37 C.F.R. § 42.72, and all further filings shall be made only in IPR2018-01553;

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