

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLOOMREACH, INC.,
Petitioner,

v.

GUADA TECHNOLOGIES LLC,
Patent Owner.

IPR2019-01304 (Patent 7,231,379 B2)

ORACLE CORP.,
Petitioner,

v.

GUADA TECHNOLOGIES LLC,
Patent Owner.

IPR2020-00598 (Patent 7,231,379 B2)

Before MIRIAM L. QUINN, KIMBERLY McGRAW, and
MATTHEW J. McNEILL, *Administrative Patent Judges*.

McNEILL, *Administrative Patent Judge*.

ORDER
Denying Request to Maintain IPR2019-01304
37 C.F.R. § 42.5

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On January 23, 2020, we instituted *inter partes* review of claims 1–7 of U.S. Patent No. 7,231,379 B2 (“the ’379 patent”). Paper 11. On February 19, 2020, Oracle Corp. filed a Petition in IPR2020-00598 seeking *inter partes* review of claims 1–7 of the ’379 patent. IPR2020-00598, Paper 2. Oracle also filed a Motion for Joinder seeking to join IPR2020-00598 with IPR2019-01304. IPR2020-00598, Paper 3. Oracle states the Petition in IPR2020-00598 is intentionally identical to the Petition filed in IPR2019-01304. *Id.* at 1. The motion for joinder has not yet been decided.

On February 21, 2020, BloomReach and Guada Technologies filed a Joint Motion to Terminate IPR2019-01304. IPR2019-01304, Paper 13. The parties also filed a Joint Request to Treat Settlement Agreement as Business Confidential. IPR2019-01304, Paper 14.

On February 26, 2020, the Board received an email from Oracle seeking authorization to request, via motion or other means, that IPR2019-01034 be maintained until such time as the motion for joinder in IPR2020-00598 is decided.

On March 3, 2020, Judges McNeill, McGraw, and Quinn participated in a conference call with Oracle, BloomReach, and Guada Technologies regarding Oracle’s request. Oracle asserted that maintaining IPR2019-01304 until the Motion for Joinder in IPR2020-00598 is decided would promote Board efficiency, specifically by ensuring the same panel decides IPR2019-01304 and IPR2020-00598. Oracle indicated that the Petition in IPR2020-00598 was filed within the one year deadline under 35 U.S.C. § 315(b).

Oracle also made two contingent requests in the event that the Board maintains IPR2019-01304. First, Oracle requested that the Board vacate the scheduling order in IPR2019-01304 until the Motion for Joinder in

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IPR2020-00598 is decided. Second, Oracle also requested that the Board set an earlier deadline for Patent Owner's Preliminary Response in IPR2020-00598 to expedite the process of joining the cases.

Guada Technologies, Patent Owner in both IPR2019-01304 and IPR2020-00598, opposed Oracle's requests. In particular, Guada Technologies opposed Oracle's request to maintain IPR2019-01304, arguing a Petitioner should not be permitted to choose the panel for an inter partes review. Guada Technologies opposed Oracle's request for an earlier deadline for Patent Owner's Preliminary Response in IPR2020-00598, arguing this would prejudice Patent Owner.

The Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by Board Rules. 37 C.F.R. § 42.5. Based on the totality of the circumstances, Oracle has not shown sufficient reason to grant its request for authorization to file a motion to maintain IPR2019-01304 until the motion for joinder in IPR2020-00598 has been decided. Oracle admitted during the conference call that there is no statutory bar under 35 U.S.C. § 315 that would prevent the Board from considering the Petition in IPR2020-00598 in the event Oracle's joinder motion is denied. Moreover, Oracle's argument for efficiency is premised on a presumption that Oracle's joinder motion must be granted in order for the same panel to decide the later filed IPR2020-00598. Board procedures for paneling a new case in which a request for joinder has been filed, however, include a presumption that the new case should be assigned to the same panel as the existing case to which joinder is requested. *See* PTAB Standard Operating Procedure 1 (Rev. 15) Assignment of Judges to Panels, at 10, available at

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<https://www.uspto.gov/sites/default/files/documents/SOP%201%20R15%20FINAL.pdf>.

Accordingly, we deny Oracle's request to maintain IPR2019-01304 until the motion for joinder in IPR2020-00598 is decided. We also deny Oracle's contingent requests regarding the Scheduling Order in IPR2019-01304 and the deadline for Patent Owner's Preliminary Response in IPR2020-00598.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Oracle's Request for authorization to file a motion to maintain IPR2019-01304 is *denied*, and

FURTHER ORDERED that Oracle's Request to set vacate the Scheduling Order in IPR2019-01304 is *denied*, and

FURTHER ORDERED that Oracle's Request to set an earlier deadline for Patent Owner's Preliminary Response in IPR2020-00598 is *denied*.

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PETITIONER:

James M. Heintz
Alireza Babaei
DLA Piper LLP
Oracle_Guada_IPR@us.dlapiper.com
jim.heintz@dlapiper.com
alireza.babaei@dlapiper.com

PATENT OWNER:

Morgan & Finnegan Transition Team
c/o Locke Lord LLP
P.O. BOX 55874
Boston, MA 02205