

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CODE200, UAB; TESO LT, UAB; METACLUSTER LT,
UAB; OXYSALES, UAB; AND CORETECH LT, UAB,
Petitioner,

v.

BRIGHT DATA LTD.,
Patent Owner.

IPR2021-01503
Patent 9,742,866 B2

Before THOMAS L. GIANNETTI, SHEILA F. McSHANE, and
RUSSELL E. CASS, *Administrative Patent Judges*

McSHANE, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

Denying Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

Code200, UAB, Teso LT, UAB, Metacluster LT, UAB, Oxysales, UAB, and Coretech LT, UAB (“Petitioner”) filed a Petition for *inter partes* review of claims 15–20, 23, 24, 27, and 28 of U.S. Patent No. 9,742,866 B2 (Ex. 1001, “the ’866 patent”). Paper 1 (“Pet.”). Petitioner also filed a Motion for Joinder with *NetNut Ltd. v. Bright Data Ltd.*, IPR2021-00465 (“the 465 IPR” or “the NetNut 465 IPR”). Paper 7 (“Mot.”). Bright Data Ltd. (“Patent Owner”) filed an Opposition to the Motion for Joinder. Paper 11 (“Opp.”). Petitioner filed a Reply to Patent Owner’s Opposition. Paper 12 (“Reply”).

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.” Under 35 U.S.C. § 315(b), “[a]n *inter partes* review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” Section 315(b) further provides that “[t]he time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).” Additionally, under 35 U.S.C. § 315(c), “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 . . . determines warrants the institution of an *inter partes* review under section 314.”

IPR2021-01503
Patent 9,742,866 B2

For the reasons described below, we do not institute an *inter partes* review of the challenged claims and we deny Petitioner's Motion for Joinder.

II. RELATED PROCEEDINGS

Patent Owner indicates that a related proceeding is IPR2021-01502. Paper 10, 1. The parties also indicate that related patents are the subject of multiple litigations, *inter partes* reviews, and other Patent Office proceedings. Pet. 3–10; Paper 10, 1–3.

In a related litigation, Luminati Networks, Ltd., now known as Bright Data Ltd., the Patent Owner here, sued UAB Teso LT (f/k/a UAB Tesonet) and UAB Metacluster LT, some of the petitioners here, for infringement of the '866 patent in *Luminati Networks Ltd. v. UAB Tesonet, UAB Metacluster Ltd.*, Civil Action No. 2:18-CV-00299-JRG (E.D. Tx.). Mot. 2; Opp. 2. That lawsuit was filed on July 19, 2018. Mot. 2. In that lawsuit, the claims and counterclaims, which included invalidity assertions, were dismissed with prejudice on February 4, 2020. *Id.* (citing Ex. 1 (attached to Motion)).

In the NetNut 465 IPR, we instituted an *inter partes* review of claims 15–20, 23, 24, 27, and 28 of the ’866 patent on the following grounds:

Claim(s)	35 U.S.C. §	References/Basis
15–17, 23, 24	102(a) ¹	Sharp KK ²
18	103	Sharp KK, MPEG DASH ³
19, 20, 27, 28	103	Sharp KK, Shribman ⁴
15, 17, 18	103	Luotonen ⁵ , RFC 2616 ⁶
15, 17, 18	103	Luotonen, RFC 2616, RFC 3040 ⁷

NetNut Ltd. v. Bright Data Ltd., IPR2021-00465, Paper 11 at 4–5, 35 (PTAB Aug. 12, 2021) (“465 Decision” or “465 Dec.”).

III. DISCUSSION

A. Joinder Motion

The Petition in this proceeding asserts the same grounds of unpatentability as those upon which we instituted review in the NetNut 465 IPR. *Compare* Pet. 1, 12, *with* 465 Dec. 4–5, 35. Consistent with this,

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), which amended 35 U.S.C. §§ 102 and 103, was effective on March 16, 2013 and applies here.

² EP 2 597 869 A1, published on May 29, 2013. (Ex. 1018)

³ Information technology–Dynamic adaptive streaming over HTTP (DASH)–Part 1: Media Presentation Description and Segment Formats, ISO/IEC JTC 1/SC 29, January 5, 2012 (Ex. 1027).

⁴ U.S. Patent Application No. 2011/0087733 A1, filed July 14, 2010, published April 14, 2011 (Ex. 1017).

⁵ Ari Luotonen, WEB PROXY SERVERS, Prentice Hall Web Infrastructure Series, 1998 (Ex. 1014).

⁶ Hypertext Transfer Protocol–HTTP/1.1, Network Working Group, RFC 2616, The Internet Society, 1999 (Ex. 1007).

⁷ Internet Web Replication and Caching Taxonomy, Network Working Group, RFC 3040, The Internet Society, 2001 (Ex. 1020).

Petitioner contends that the Petition is “is substantially identical to the petition in the NetNut IPR [465 IPR] and contains the same grounds (based on the same prior art and supporting evidence) against the same claims, and differs only as necessary to reflect the fact that it is filed by a different petitioner.” Pet. 1 (citing Ex. 1034).

Petitioner requests that we institute *inter partes* review and seeks joinder with the NetNut 465 IPR. Mot. 1. Petitioner asserts that the request for joinder has been timely made. *Id.* at 3. Petitioner contends that the following factors identified in *Kyocera Corp. v. Softview LLC* favor joinder: (1) the reasons why joinder is appropriate; (2) whether the petition raises any new grounds of unpatentability; (3) any impact joinder would have on the cost and trial schedule for the existing review; and (4) whether joinder will add to the complexity of briefing or discovery. *Id.* at 3–4 (citing *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013); Consolidated Trial Practice Guide 76 (Nov. 2019)⁸). More specifically, Petitioner argues that the Board routinely grants joinder where the party seeking joinder relies upon identical arguments and the same grounds raised in the existing proceeding, as is the case here. *Id.* at 4. Petitioner asserts that joinder is the most efficient and economical manner to proceed. *Id.* at 5. Petitioner states that it will not request any alterations to the trial schedule of the NetNut 465 IPR and it will adopt a secondary, understudy role in that IPR. *Id.* Petitioner argues that, because it will rely on the same prior art and the same expert to support identical arguments

⁸ Available at <https://go.usa.gov/xpvPF>.

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