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Paper 14
Date: July 29, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MAJOR DATA UAB,
Petitioner,

v.

BRIGHT DATA LTD.,
Patent Owner.

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IPR2022-00915
Patent 10,257,319 B2

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

CASS, *Administrative Patent Judge*.

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

## I. INTRODUCTION

Major Data UAB ("Petitioner") filed a Petitioner for *inter partes* review of claims 1–2, 12, 14–15, 17–19, and 21–29 of U.S. Patent No. 10,257,319 B2 (Ex. 1001, "the '319 patent"). Paper 1 ("Pet."). Concurrently with its Petition, Petitioner filed a motion for Joinder with *Net Nut Ltd. v. Bright Data Ltd.*, IPR2021-01492 ("the 1492 IPR"). Paper 3 ("Mot."). Patent Owner filed a Preliminary Response (Paper 12 ("Prelim. Resp.")) and an opposition to the motion for joinder (Paper 7 ("Opp.")). Petitioner filed a Reply to Patent Owner's opposition. Paper 13 ("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." 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."

For the reasons described below, we deny Petitioner's Motion for Joinder. We will issue a decision on whether to institute an *inter partes* review based on the Petition in due course.

## II. RELATED PROCEEDINGS

The parties indicate that there are multiple related district court litigations. Pet. 5–6; Mot. 2–3; Paper 6, 2–3. In addition to the 1492 IPR, the parties also identify IPR2020-01266 ("the previously-filed 1266 IPR"), filed by Metacluster LT, UAB, Code 200, UAB, Oxysales, UAB, and Teso LT, UAB, which challenged claims of the '319 patent. Mot. 3; Paper 6, 1.

The previously-filed 1266 IPR was denied on discretionary grounds. Mot. 3. The parties also indicate that the '319 patent is the subject of an *ex parte* reexamination, Control No. 90/014,875, which has been stayed. Mot. 3; Paper 6, 2. The parties also identify IPR2022-00861 ("the 861 IPR") filed by the same parties who filed the previously-filed 1266 IPR, along with a motion for joinder to the 1492 IPR. Pet. 5; Paper 6, 2. We recently issued a decision in the 861 IPR denying Petitioner's motion for joinder and also denying institution of *inter partes* review. IPR2022-00861, Paper 17.

In the 1492 IPR, the case which Petitioner is seeking to join, we instituted an *inter partes* review of claims 1, 2, 12, 14, 15, 17–19, and 21–29 of the '319 patent. 1492 IPR, Paper 12 at 7–8, 39 ("1492 Decision" or "1492 Dec."). Thereafter, Patent Owner settled with NetNut in the 1492 IPR, and NetNut has been terminated as petitioner in that action. 1492 IPR, Paper 20. Due to the termination of NetNut and our denial of joinder in the 861 IPR, there is no remaining petitioner in the 1492 IPR.

## III. DISCUSSION

### *A. Background*

Petitioner argues that its Petition "is substantially identical to the petition submitted in" the 1492 IPR and that it "agrees to proceed solely on the grounds, substantive evidence, and arguments advanced, or that will be advanced in" the 1492 IPR. Mot. 2. Petitioner further states that it "is willing to take an 'understudy' role in the joined proceedings, so long as NetNut is party to the proceedings and is not estopped under 35 U.S.C. § 315(e)(1)," and thus "there will be no added complexity" to the proceeding. *Id.* at 2, 8. Additionally, Petitioner argues, "[j]oinder will not impact the [1492] IPR trial schedule" because Petitioner "consents to the

existing trial schedule in" the 1492 IPR. *Id.* at 7. Thus, according to Petitioner, "[g]ood cause exists for joining this proceeding with the [1492] IPR because these proceedings are substantive identical, and consistent with 35 C.F.R. § 42.1(b)[,] joinder will enable the Board to efficiently 'secure the just, speedy, and inexpensive resolution' of multiple petitions in a single proceeding." *Id.* at 5–6.

Petitioner states that it has not been served with a complaint for infringement, and therefore the Petition in this proceeding is not time-barred under 35 U.S.C. § 315(b). Mot. 1 n.1. Patent Owner agrees that "[b]ased on the information presently available, Major Data is not time-barred from IPR." Opp. 15.

Patent Owner argues that the Board should exercise its discretion to deny joinder because, among other reasons, it will add complexity to the 1492 IPR. Opp. 3. As an example, Patent Owner states that, if joinder is granted, it will have to prepare its Patent Owner Response on an expedited schedule. *Id.* at 11. Moreover, according to Patent Owner, in preparation for its Patent Owner Response, it "intends to submit secondary considerations evidence which requires agreement with opposing counsel (whoever that may be) on a modified protective order (due to confidential productions in the district court litigations)." *Id.* Patent Owner also asserts that it "intends to depose the testifying expert, Mr. Teruya, as part of preparing its PORs," and "[i]t is unclear which party/ies would be defending Mr. Teruya and how that examination would be fairly conducted." *Id.* at 13.

Additionally, according to Patent Owner, because the Petition in this case is not time-barred, "denying joinder causes no prejudice to" Petitioner. Mot. 15. Thus, Patent Owner contends, it "should not have to bear the

additional cost of continuing the [1492] IPR when [it] otherwise should be terminated due to settlement." *Id.* at 11.

Petitioner responds that it "has already invested significant expense and time to join an existing, already-instituted, demonstratively meritorious petition," and that there is no good reason to force it "to suffer the prejudice of the substantial delay and additional cost involved in needlessly setting this petition all the way back to the pre-institution stage." Reply 2. Petitioner further argues that Patent Owner will not be prejudiced by having to file its Patent Owner Response on an accelerated schedule because the Board has extended the deadline for the Patent Owner Response. *Id.* at 3.

*B. Analysis*

The decision to grant joinder is discretionary. 35 U.S.C. § 315(c). "The Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations." *Dell Inc. v. Network-1 Sec. Solutions, Inc.*, IPR2013-00385, Paper No. 17 at 3 (PTAB July 29, 2013).

Under the particular facts and circumstances of this case, we decline to exercise our discretion to join this proceeding with the 1492 IPR. First, both parties agree that Petitioner's Petition is not time-barred under 35 U.S.C. § 315(b). Mot. 1 n.1; Opp. 15. Therefore, even if joinder is not granted, we will evaluate the merits of the Petition and, if appropriate, institute this proceeding in the normal course. Indeed, because the due date of Patent Owner's Preliminary Response was moved up, an institution decision in this proceeding will be rendered earlier than it would have been under normal circumstances. *See* Paper 10.

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