

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC. and YOUTUBE, LLC,
Petitioners,

v.

PERSONALWEB TECHNOLOGIES, LLC and
LEVEL 3 COMMUNICATIONS, LLC,
Patent Owners.

Case IPR2014-00977
Patent 6,415,280 B1

Before KEVIN F. TURNER, JONI Y. CHANG, and
MICHAEL R. ZECHER, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION

Denying Google's Motion for Joinder and
Denying Institution of *Inter Partes* Review
37 C.F.R. §§ 42.108 and 42.122

I. INTRODUCTION

Petitioners, Google Inc. and YouTube, LLC (collectively “Google”), filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 10, 15, 16, 18, 25, 31–33, 36, and 38 of U.S. Patent No. 6,415,280 B1 (“the ’280 patent,” Ex. 1001). Paper 1. Google filed its Petition along with a Motion for Joinder requesting that we join Google as a party with *Rackspace US, Inc. v. PersonalWeb Techs. LLC*, IPR2014-00059. Paper 3, “Google Mot.” In IPR2014-00059, we instituted the same grounds of unpatentability over the same claims at issue in this proceeding. *Compare* IPR2014-00059, Paper 9, *with* Pet. 8, 19–49. Patent Owners, PersonalWeb Technologies, LLC and Level 3 Communications, LLC (collectively “PersonalWeb”), timely filed a combined Preliminary Response and Opposition to Google’s Motion for Joinder. Paper 7. We have jurisdiction under 35 U.S.C. § 314.

For the reasons discussed below, we deny Google’s Motion for Joinder as untimely and, as a result, deny the Petition because it is barred under 35 U.S.C. § 315(b).

II. BACKGROUND

Based on authority delegated to us by the Director, we have discretion to join an *inter partes* review with another *inter partes* review under 35 U.S.C. § 315(c), which provides:

JOINDER. – 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.

Our patent trial regulations for *inter partes* reviews address the appropriate time frame for filing a motion for joinder. 37 C.F.R. § 42.122(b) provides, in relevant part (emphasis added), “[a]ny request for joinder must be filed, as a motion under § 42.22, *no later than one month after the institution date of any inter partes review for which joinder is requested.*”

Normally, 35 U.S.C. § 315(b) bars institution of an *inter partes* review when the petition is filed more than one year after the petitioner (or petitioner’s real party in interest or privy) is served with a complaint alleging infringement of the patent. Our patent trial regulations for *inter partes* reviews include the same provision. 37 C.F.R. § 42.101(b). The one-year time bar, however, does not apply to a request for joinder. 35 U.S.C. § 315(b) (final sentence); 37 C.F.R. § 42.122(b) (final sentence). This is an important consideration here because it is undisputed that Google filed the Petition on June 18, 2014, which is more than a year after Google was served with a complaint alleging infringement of the ’280 patent on December 12, 2011. Ex. 2001; *see also* Pet. 3 (Google confirms that PersonalWeb asserted the ’280 patent against it in a district court case filed on December 8, 2011); Google Mot. 8 (Google confirms that, in 2011, PersonalWeb sued thirteen different companies, including Google, for allegedly infringing the ’280 patent). Thus, absent joinder of Google as a party to IPR2014-000059, the Petition is barred.

III. ANALYSIS

1. *Google's Motion for Joinder Was Untimely*

First, we note that Google did not file its Motion for Joinder within one month after we instituted an *inter partes* review in IPR2014-00059, as required by 37 C.F.R. § 42.122(b). Notwithstanding that Google did not file its Motion for Joinder within the one-month time limit imposed under § 42.122(b), Google contends that we should exercise our discretion under § 42.5(b) to waive this rule. Google Mot. 1–7. Section 42.5(b) provides that “[we] may waive or suspend a requirement of parts 1, 41, and 42 and may place conditions on the waiver or suspension.” Absent special circumstances, we are reluctant to exercise our discretion under § 42.5(b) to waive the one-month time limit for filing a motion for joinder under § 42.122 (b).

As we explained previously, we instituted an *inter partes* review in IPR2014-00059 on April 15, 2014. IPR2014-00059, Paper 9. Pursuant to § 42.122(b), if Google desired to join IPR2014-00059 as a party, it was required to file a motion for joinder no later than May 15, 2014. Google, however, did not file its Motion for Joinder until June 18, 2014. Google attempts to justify this delay by arguing that the parties in IPR2014-00059 stipulated to a thirty day extension for DUE DATES 1 and 2 (IPR2014-00059, Paper 14) and, at the time it filed its Motion for Joinder, only the initial conference call had occurred (IPR2014-00059, Paper 13). Google Mot. 2. Google asserts that given the revised schedule stipulated to by the parties in IPR2014-00059, its request for joinder was filed during a stage in IPR2014-00059 that is contemplated by § 42.122(b), i.e., shortly after the

date of institution, but prior to PersonalWeb filing its Patent Owner Response. *Id.*

We are not persuaded by Google’s argument. Simply because the parties in IPR2014-00059 stipulated to new dates for DUE DATES 1 and 2—a common practice in proceedings before us—does not constitute a special circumstance that would persuade us to waive the one-month time limit for Google to file its Motion for Joinder. In addition, merely because, at the time Google filed its Motion for Joinder, IPR2014-00059 was in the early stages of trial, e.g., only the initial conference call had occurred, does not constitute a special circumstance that would persuade us to waive the one-month time limit for Google to files its Motion for Joinder. Without more compelling reasons, we decline to exercise our discretion under § 42.5(b) to waive the one-month time limit for Google to file its Motion for Joinder under § 42.122(b). As such, Google’s Motion for Joinder was untimely.

*2. The Termination of IPR2014-00059 Renders
Google’s Motion for Joinder Moot*

Although we deny Google’s Motion to Joinder as untimely, there is at least one additional consideration that weighs in favor of dismissing Google’s Motion for Joinder as moot. On October 10, 2013, Rackspace US, Inc. and Rackspace Hosting, Inc. (collectively “Rackspace”) filed a Petition requesting an *inter partes* review of claims 10, 15, 16, 18, 25, 31–33, 36, and 38 of the ’280 patent. IPR2014-00059, Paper 3. PersonalWeb timely filed a Preliminary Response. IPR2014-00059, Paper 8. As we discussed previously, on April 15, 2014, upon consideration of the information presented in Rackspace’s Petition, as well as the arguments presented in

PersonalWeb's Preliminary Response, we authorized an *inter partes* review to be instituted as to the challenged claims of the '280 patent. IPR2014-00059, Paper 9. On October 16, 2014, Rackspace and PersonalWeb requested that we terminate IPR2014-00059 as to all parties by filing a Joint Motion to Terminate, as well as a true copy of their written settlement agreement, in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). IPR2014-00059, Paper 27; Ex. 1014. Upon consideration of this request, we terminated IPR2014-00059. IPR2014-00059, Paper 30. Given that IPR2014-00059 is no longer pending, it cannot serve as a proceeding to which another proceeding may be joined. As such, the termination of IPR2014-00059 renders Google's Motion for Joinder moot.

3. *The Petition is Barred under 35 U.S.C. § 315(b)*

As we explained previously, absent joinder of Google as a party to IPR2014-00059, the Petition is barred under § 315(b). Given that we deny Google's Motion for Joinder as untimely, along with the additional consideration that it is moot because the proceeding that it sought to join—IPR2014-00059—has been terminated, the Petition now stands alone. It is undisputed that the Petition was filed on June 18, 2014, which is more than one year after Google was served with a complaint alleging infringement of the '280 patent on December 12, 2011. Ex. 2001. As a consequence, Google is barred from pursuing an *inter partes* review of the '791 patent.

IV. CONCLUSION

In summary, we deny Google's Motion for Joinder as untimely and, as a result, deny the Petition because it is barred under 35 U.S.C. § 315(b).

V. ORDER

Accordingly, it is:

ORDERED that Google's Motion for Joinder is DENIED; and
FURTHER ORDERED that the Petition is DENIED and no trial is
instituted.

IPR2014-000977
Patent 6,415,280 B1

For PETITIONERS:

Jennifer A. Sklenar
Alissa H. Faris
Emily C. Hostage
ARNOLD & PORTER LLP
Jennifer.Sklenar@aporter.com
Alissa.Faris@aporter.com
Emily.Hostage@aporter.com

For PATENT OWNERS:

Joseph A. Rhoa
Updeep S. Gill
NIXON & VANDERHYE P.C.
jar@nixonvan.com
usg@nixonvan.com