

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SKYHAWKE TECHNOLOGIES, LLC,
Petitioner,

v.

L&H CONCEPTS, LLC,
Patent Owner.

Case IPR2014-01485
Patent 5,779,566

Before JAMES T. MOORE, PATRICK R. SCANLON, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

DECISION

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

I. INTRODUCTION

Petitioner, SkyHawke Technologies, LLC, filed a corrected Petition (Paper 5, “Petition” or “Pet.”)¹ to institute an *inter partes* review of claims 6, 15, and 16 of U.S. Patent No. 5,779,566 (Ex. 1001, “the ’566 patent”) pursuant to 35 U.S.C. §§ 311–319. The Petition involves the same parties and patent at issue in instituted trial proceeding, *SkyHawke Technologies, LLC v. L&H Concepts, LLC*, Case IPR2014-00438 (“the ’438 proceeding”).² Petitioner concurrently filed a Motion for Joinder (Paper 3, “Mot.”) seeking joinder of the Petition with the ’438 proceeding. The Motion for Joinder was filed within one month after institution of the ’438 proceeding, as required by 37 C.F.R. § 42.122(b). Petitioner also filed Petitioner’s Reply in Support of its Motion for Joinder (Paper 11).

Patent Owner, L&H Concepts, LLC, filed a Patent Owner’s Response to Motion for Joinder (Paper 10) and a Preliminary Response (Paper 12, “Prelim. Resp.”). We consider and rule upon the Petition pursuant to the authority granted by the Director under 37 C.F.R. § 42.4.

For the reasons provided below, we deny Petitioner’s Motion for Joinder. We also deny the Petition and do not institute an *inter partes* review as to claims 6, 15, and 16 of the ’566 patent.

¹ Paper 5 is a corrected Petition for *inter partes* review, filed September 25, 2014, and subsequently accepted by the Board. See Paper 7. The original Petition for *inter partes* review (Paper 1) has been accorded the filing date of September 11, 2014. Paper 4.

² The same parties and patent also are involved in related instituted trial proceeding, *SkyHawke Technologies, LLC v. L&H Concepts, LLC*, Case IPR2014-00437.

II. ANALYSIS

A. Decision on the Motion for Joinder

Petitioner argues that the requested joinder is appropriate because (1) “joinder will promote the efficient determination of the patentability of the ’566 patent” (Mot. 7); (2) “there will be no prejudice to [Patent Owner] from joining the proceedings” (*id.*); and (3) Petitioner “will suffer undue prejudice” if the Petition is not joined to the ’438 proceeding (*id.* at 8). Patent Owner takes exception with all three of these assertions and argues that the Motion for Joinder should be denied. *See generally* Paper 10.

In addition, Patent Owner argues Petitioner’s Motion for Joinder should be denied because 35 U.S.C. § 315(c) provides for the joinder of parties only, not issues, and does not contemplate joinder by someone who is already a party. Prelim. Resp. 3–5 (citing *Target Corp. v. Destination Maternity Corp.*, Case IPR2014-00508 (PTAB Sept. 25, 2014) (Papers 18, 20)). We agree with Patent Owner.

Section 315(c) provides:

(c) 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.

In our view, the phrase “join as a party” indicates that only a person who is not already a party to an instituted *inter partes* review can be joined to the proceeding. A person cannot be joined *as a party* to a proceeding in which it is already a party. The statute does not refer to the joining of a petition or new

patentability challenges presented therein, nor does the statute refer to the joining of a new issue (as opposed to a person).

Although the statute uses the expansive term “any person,” the overall language of § 315(c) places limits on this term. For example, the phrase “who properly files a petition under section 311” excludes the owner of the patent at issue from “any person” because § 311(a) specifies “a person who is not the owner of a patent may file with the Office a petition to institute an inter partes review of the patent.” Similarly, the phrase “join as a party” excludes a person who is already a party.

Furthermore, to the extent there is any ambiguity in § 315(c), the legislative history supports our view that § 315(c) provides for joinder of only a person who is not already a party to the proceeding. Specifically, the Final Committee Report states, under §§ 315(c) and 325(c), “[t]he Director may allow *other petitioners* to join an inter partes or post-grant review.” H.R. REP. NO. 112-98, pt.1, at 76 (2011) (emphasis added). We discern no reason why the drafters intentionally would describe only part of their understanding of what the statute provides, for example, by referring to joinder of “other petitioners,” if, in fact, they understood the statute to provide for joinder also of same petitioners.

In view of the foregoing, we determine that the relief requested by Petitioner—joining the Petition to an instituted *inter partes* review to which Petitioner is already a party—is not permitted under § 315(c). Accordingly, Petitioner’s Motion for Joinder is *denied*.

B. Decision on the Petition

Institution of *inter partes* review is barred when the petition is filed more than one year after the petitioner is served with a complaint alleging infringement of the patent. 35 U.S.C. § 315(b); 37 C.F.R. § 42.101(b). The one-year 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).

The record indicates that Petitioner was served with a complaint asserting infringement of the '566 patent more than one year before filing the Petition. Pet. 3. Accordingly, in view of our decision to deny Petitioner's Motion for Joinder, we deny the Petition because it was not filed within the time limits imposed under 35 U.S.C. § 315(b).

III. ORDER

In consideration of the foregoing, it is hereby:
ORDERED that the Motion for Joinder is *denied*; and
FURTHER ORDERED that the Petition is *denied* and no trial is instituted.

IPR2014-01485
Patent 5,779,566

PETITIONER:

Thomas J. Fisher

Scott McKeown

Alexander Englehart

Christopher Ricciuti

OBLON, MCCLELLAND, MAIER & NEUSTADT, L.L.P.

cpdocketfisher.oblon.com

cpdocketmckeown.oblon.com

cpdocketenglehart.oblon.com

cpdocketricciuti@oblon.com

PATENT OWNER:

David M. Hoffman

Matthew K. Wernli

FISH & RICHARDSON P.C.

hoffman@fr.com

IPR30912-0003IP3@fr.com