

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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EPICOR SOFTWARE CORPORATION,  
Petitioner,

v.

PROTEGRITY CORPORATION,  
Patent Owner.

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Case CBM2015-00006  
Patent 8,402,281 B1

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Before KEVIN F. TURNER, MEREDITH C. PETRAVICK, and  
GREGG I. ANDERSON, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

DECISION  
Denying Motion to Consolidate  
*37 C.F.R. § 42.222*

## INTRODUCTION

On May 21, 2015, Patent Owner filed a Motion to Consolidate (Paper 22, “Mot.”), and, on May 28, 2015, Petitioner filed an Opposition (Paper 24, “Opp.”). The following covered business method patent reviews (“CBM”) are the subject of the Motion:

Proceeding	U.S. Patent No.	Petitioner
CBM2014-00182	8,402,281 B2	Square, Inc.
CBM2015-00006	8,402,281 B2	Epicore Software Corporation
CBM2015-00010	8,402,281 B2	Informatica Corporation
CBM2015-00002	6,321,201 B1	Epicore Software Corporation
CBM2015-00014	6,321,201 B1	Square, Inc.
CBM2015-00021	6,321,201 B1	Informatica Corporation
CBM2015-00030	6,321,201 B1	Epicore Software Corporation

U.S. Patent No. 8,402,281 B2 (“the ’281 patent”) issued from an application, which was a continuation of the patent application that matured into U.S. Patent No. 6,321,201 (“the ’201 patent”). Ex. 1004, 1.

### *Patent Owner’s Request*

Patent Owner requests that all of the above CBMs be consolidated into one proceeding or, alternatively, that the CBMs be consolidated into two proceedings by subject patent. Mot. 1. As a third alternative, Patent Owner requests that just the CBMs concerning the ’281 patent and filed by Petitioners Square, Inc. and Epicore Software Corporation (CBM2014-00182 and CBM2015-00006) be consolidated into one proceeding, with an option to consolidate the CBM filed by Informatica Corporation (CBM2015-00010), later. *Id.*

According to Patent Owner, consolidation is appropriate because the ’281 patent and the ’201 patent are related, share a near identical specification, and have been determined to be not patently-distinct from each

other. *Id.* at 5. Patent Owner contends that consolidation would have no discernable impact on the trial schedule and would simplify brief and discovery. *Id.* at 10–13. Patent Owner also argues that: the claims in each CBM are similar; that the CBMs are instituted on the same or similar grounds; and that the Petitioners rely upon the same two declarants. *Id.* at 7–10. Patent Owner, further, argues that it intends to file the same motion to amend claims 1 and 17 in all of the '281 patent related CBMs and that allowing each of the Petitioner in those proceedings to respond would “essentially give[] Petitioners an avenue around the page limits for opposing a motion to amend, as the Petitioners could (and likely would) direct their various arguments to the separate briefing.” *Id.* at 12.

#### *Petitioner's Opposition*

Petitioner opposes consolidation because joining these proceedings will unduly prejudice it, will cause unnecessary delay, and create undue burden for Petitioner and the Board. Opp. 1. Petitioner argues that consolidating the matters will delay the schedule already in place, and that, in particular, discovery in CBM2014-000182 has already taken place. *Id.* at 2. Petitioner disagrees with Patent Owner regarding the extent of overlapping issues, and states that “Petitioners have all articulated significantly different arguments and alleged different prior art.” *Id.* Petitioner further argues that the '201 patent and the '281 patent are not similar and do not contain the same claims. *Id.*

#### *Conference Call*

On May 27, 2015, counsel for the parties in each of the above proceedings and Judges Turner, Petravick, and Anderson participated in a conference call to discuss consolidation. During the call, the Petitioners for

each proceeding expressed their opposition to consolidation. The Petitioners opposed consolidation because the CBMs involve different patents with different claims, involve grounds based on different prior art or different analysis. Petitioners argues that consolidation would be prejudicial to them because of estoppel. Nonetheless, all of the Petitioners indicated that they were agreeable to modifying the trial schedules in the proceedings so that the oral argument would occur on two consecutive days. Patent Owner also agreed to such a modification of the trial schedule.

## DISCUSSION

The statutory provision governing consolidation of a covered business method review proceeding is 35 U.S.C. § 325, which states:

(c) JOINDER. — If more than 1 petition for a post-grant review under this chapter is properly filed against the same patent and the Director determines that more than 1 of these petitions warrants the institution of a post-grant review under section 324, the Director may consolidate such reviews into a single post-grant review.

*See* 37 C.F.R. § 42.222(a). Consolidation of two or more proceedings for covered business method patent review is discretionary. When exercising its discretion, the Board is mindful that patent trial regulations must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. *See* 35 U.S.C. § 326(b); 37 C.F.R. § 42.1(b).

The party moving for consolidation has the burden of proof to establish that it is entitled to consolidation. *See* 37 C.F.R. § 42.20(c), 42.222(b).

After consideration of all of the parties' arguments made in the Motion, the Opposition, and during the conference call, we decline to

exercise our discretion to consolidate any of the CBMs according to any of the three alternatives proposed by the Patent Owner. Despite the '281 patent and the '201 patent being related and having essentially the same Specification, they are not the same patent. We decline to consolidate the CBMs related to the '281 patent with the CBMs related to the '201 patent, as proposed by Patent Owner's first alternative.

We also decline to consolidate the CBMs related to the '281 patent into one proceeding, as proposed by Patent Owner's second and third alternative. Although there is some overlap of grounds and prior art, there are also additional non-overlapping grounds and there are differences in analyses in the Petitions. Denning<sup>1</sup> is primary basis for the prior art grounds in the Petitions of each of these CBMs. Denning, however, is a lengthy textbook and Petitioners do not always rely upon the same portions of Dennings in their analyses. Petitioners also rely upon different declarants to support their analyses in the Petitions. CBM2014-00182 and CBM2015-00010 rely upon declarations of Dr. Michael Shamos and CBM2014-00006 relies upon a declaration of Mr. Bruce Schneier. The cross-examination of Dr. Michael Shamos has already occurred in CBM2014-00182. Although mindful of Patent Owner's burden, we decline to consolidate the CBMs related to the '281 patent into one proceeding.

We further decline to consolidate the CBMs related to the '201 patent into one proceeding, as proposed by Patent Owner's second alternative. Although there is some overlap of grounds and prior art, there are also additional non-overlapping grounds. For example, CBM2015-00014

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<sup>1</sup> DOROTHY ELIZABETH ROBLING DENNING, *CRYPTOGRAPHY AND DATA SECURITY*, 1–400 (1982) (Ex. 1005) (“Denning”).

CBM2015-00006  
Patent 8,402,281 B2

includes obviousness grounds based upon a combination of Hoffman<sup>2</sup> and Codd<sup>3</sup> and CBM2015-00021 contains obviousness grounds based upon a combination of Hoffman and IBM D2<sup>4</sup>. Petitioners also rely upon different declarants to support their analyses in the Petitions. CBM2015-00014 and CBM2015-00021 rely upon declarations of Dr. Michael Shamos and CBM2015-00002 and CBM2015-00030 relies upon declarations of Mr. Bruce Schneier. Given this, we decline to consolidate the CBMs related to the '201 patent into one proceeding.

We will, however, exercise our discretion (*see* 37 C.F.R. § 42.5) and coordinate the date of the oral arguments in these CBMs so that oral arguments, if requested, will occur on two consecutive days. All parties indicated during the conference call that they would be agreeable to this coordination. We issue, as necessary, separate orders in the CBMs to reset the date of the oral arguments.

#### ORDER

It is:

ORDERED that Patent Owner's motion for consolidation is *denied*.

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<sup>2</sup> Lance J. Hoffman, *The Formulary Model for Flexible Privacy and Access Controls*, AFIPS Fall Joint Computer Conference Proceedings (1971).

<sup>3</sup> E.F. Codd, *Extending the Database Relational Model to Capture More Meaning*, 4 ACM Transactions on Database Systems 397–434 (1979).

<sup>4</sup> Public use of the IBM DB2 database management system as evidenced by various documents.

CBM2015-00006  
Patent 8,402,281 B2

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