Paper No. 7

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EXPEDIA, INC., FANDANGO, LLC, HOTELS.COM, L.P., HOTEL TONIGHT, INC., HOTWIRE, INC., KAYAK SOFTWARE CORP., OPENTABLE, INC., ORBITZ, LLC, PAPA JOHN'S USA, INC., STUBHUB, INC., TICKETMASTER, LLC, LIVE NATION ENTERTAINMENT, INC., TRAVELOCITY.COM LP, WANDERSPOT LLC, AGILYSYS, INC., DOMINO'S PIZZA, INC., DOMINO'S PIZZA, LLC, HILTON RESORTS CORPORATION, HILTON WORLDWIDE, INC., HILTON INTERNATIONAL CO., MOBO SYSTEMS, INC., PIZZA HUT OF AMERICA, INC., PIZZA HUT, INC., and USABLENET, INC.,
Petitioner

v.

AMERANTH, INC.,
Patent Owner

Case CBM2015-00095
Patent No. 8,146,077

PETITIONER'S MOTION FOR JOINDER UNDER 35 U.S.C. § 325(c) and 37 C.F.R. § 42.222(b)

I. INTRODUCTION

Petitioner moves the Patent Trial and Appeal Board ("Board") for joinder of this case (Case No. **CBM2015-00095**, "Expedia CBM") and an earlier case filed by Apple, Inc. et al. (Case No. **CBM2015-00081**, "Apple CBM"). The Expedia CBM is intentionally identical to the Apple CBM in all substantive aspects. Both seek covered business method ("CBM") review of claims 1-18 (the "Challenged Claims") of Ameranth, Inc.'s ("PO") U.S. Patent No. 8,146,077 (the "'077 patent"). Further, the Apple CBM and Expedia CBM rely upon the same analytical framework (*e.g.*, same expert declarant, prior art, claim charts, and claim constructions) in addressing the Challenged Claims. Accordingly, resolving the Apple CBM and Expedia CBM will necessarily involve considering the same issues by all parties and the Board. The Petitioner group for the Apple CBM (collectively, "Apple") does not oppose this motion.

Further, joinder at an early stage—at the time of institution of the Apple and Expedia CBMs and before a schedule has been entered for either case—means that no trial schedule will be adversely affected. Joinder of these proceedings also presents the best opportunity to secure the just, speedy, and inexpensive resolution of the related proceedings without any prejudice to the PO. This includes consolidated filings and discovery and eliminating the duplicate hearings and briefing that would surely accompany separate proceedings, which Apple does not

oppose. Joinder should also provide for case management efficiencies for the Board.

In light of the similarities of the proceedings and the efficiencies that can be realized via joinder, Petitioner respectfully requests that the Board join the Apple CBM and Expedia CBM, if and when both CBM reviews have been instituted.

II. BACKGROUND

Apple filed a petition requesting CBM review of the ’077 Patent under the transitional program for CBM patents on February 19, 2015. Apple CBM, Paper 1. A decision regarding institution of that petition is still pending.

The Apple CBM and Expedia CBM involve different petitioner groups and real parties-in-interest. *Compare* Apple CBM, Paper 1 at 2 (identifying real parties-in-interest) *with* Expedia CBM, Paper 2 at 2 (identifying real parties-in-interest). However, all such parties are defendants in numerous different infringement lawsuits asserting the ’077 Patent and three other patents filed by the PO (collectively, the “PO Patents”) in the U.S. District Court for the Southern District of California. *See* Apple CBM, Paper 1 at 2-4 (listing related matters); Expedia CBM, Paper 2 at 2-4 (listing related matters). The other three PO Patents are U.S. Patent No. 6,982,733 (“’733 patent”), U.S. Patent No. 6,384,850 (“’850 patent”), and U.S. Patent No. 6,871,325 (“’325 patent”), for which there are multiple other pending CBM proceedings. A summary of the CBM proceedings

related to the PO Patents is provided below in **Tables 1** and **2**. We further note that the aforementioned litigation has been stayed pending resolution of certain of the earlier filed CBM petitions (CBM2014-00013 for the '733 Patent, CBM2014-00014 for the '077 Patent, CBM2014-00015 for the '850 Patent, and CBM2014-00016 for the '325 Patent). Stay Order, **Ex. 1**; Order Continuing Stay, **Ex. 2.**

Table 1: Related Proceedings

Case	Petition Filed	Petitioner	Patent	Challenged Claims
CBM2014-00013	Oct. 15, 2013	Apple et al.	'733 patent	1-16
CBM2014-00014	Oct. 15, 2013	Agilysys et al.	'077 patent	1-18
CBM2014-00015	Oct. 15, 2013	Agilysys et al.	'850 patent	1-16
CBM2014-00016	Oct. 15, 2013	Agilysys et al.	'325 patent	1-15
CBM2015-00080	Feb. 19, 2015	Apple et al.	'850 patent	12-16
CBM2015-00081	Feb. 19, 2015	Apple et al.	'077 patent	1-18
CBM2015-00082	Feb. 19, 2015	Apple et al.	'325 patent	11-13, 15
CBM2015-00091	Mar. 2, 2015	Starbucks	'850 patent	12-16
CBM2015-00095	Mar. 3, 2015	Expedia et al.	'077 patent	1-18
CBM2015-00096	Mar. 3, 2015	Expedia et al.	'850 patent	12-16
CBM2015-00097	Mar. 4, 2015	Expedia et al.	'325 patent	11-13, 15
CBM2015-00099	Mar. 6, 2015	Starbucks	'325 patent	11-13, 15

Table 2: Status of Related Proceedings

Case	Status
CBM2014-00013	Instituted for claims 1-16 on ground of 35 U.S.C. § 101; denied as to all other grounds; Final Written Decision issued Mar. 20, 2015
CBM2014-00014	Institution denied
CBM2014-00015	Instituted for claims 1-11 on ground of 35 U.S.C. § 101; denied as to all other grounds; Final Written Decision issued Mar. 20, 2015
CBM2014-00016	Instituted for claims 1-10 on ground of 35 U.S.C. § 101; denied as to all other grounds; Final Written Decision issued

Case	Status
	Mar. 20, 2015
CBM2015-00080	Petition pending
CBM2015-00081	Petition pending
CBM2015-00082	Petition pending
CBM2015-00091	Petition pending
CBM2015-00095	Petition pending
CBM2015-00096	Petition pending
CBM2015-00097	Petition pending
CBM2015-00099	Petition pending

In addition to the present motion, Petitioner will be concurrently filing petitions to join other CBM cases pertaining to the PO patents. Specifically, by separate motions, Petitioner is seeking to join CBM2015-00096 with CBM2015-00080 ('850 patent), and to join CBM2015-00097 with CBM2015-00082 ('325 patent) on bases parallel to the ones set forth below.

III. LEGAL STANDARD

When more than one petition for CBM review of the same patent is properly filed and those petitions warrant institution, the Board has the authority and discretion to join the proceedings. *See* 35 U.S.C. § 325(c) (permitting joinder of post-grant review proceedings); 37 C.F.R. § 42.222(b) (same); Leahy-Smith America Invents Act, Pub. L. No. 112-29 § 18(a)(1), 125 Stat. 284, 329 (2011) (making certain post-grant review standards and procedures applicable to CBM review); *see also* Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48687 (Aug. 14, 2012). Joinder of one CBM review with another CBM

review is appropriate where it secures the just, speedy, and inexpensive resolution of the CBM review proceedings. *See* 37 C.F.R. § 42.1(b).

A petitioner may request joinder, without prior authorization, up to one month after the institution date of the proceeding to which joinder is requested. 37 C.F.R. § 42.222(b) (addressing timing to request joinder); *Taiwan Semiconductor Mfg. Co., Ltd. v. Zond LLC*, IPR2014-00781 and IPR2014-782, Paper 5 at 3 (May 29, 2014) (prior authorization not required before one month deadline). Typically, such a joinder request: (1) sets forth the reasons why joinder is appropriate; (2) identifies any new grounds of unpatentability asserted in the petition; and (3) explains what impact (if any) joinder would have on the trial schedule for the existing review. *See, e.g. Microsoft Corp. v. IPR Licensing, Inc.*, IPR2015-00074, Paper 21 at 4 (Mar. 4, 2015). A joinder request can additionally address specifically how briefing and discovery may be simplified. *See, e.g.*, *Sony Corp. of Am. v. Network-1 Security Solutions, Inc.*, IPR2013-00495, Paper 13 at 3 (Sep. 16, 2013); *Fujitsu Semiconductor Ltd. v. Zond, LLC*, IPR2014-00845, Paper 14 at 304 (Oct. 2, 2014). Petitioner addresses each of these points below.

IV. ANALYSIS

If CBM review of any claim of the ’077 Patent is instituted based on the Apple and Expedia CBMs, Petitioner respectfully requests that the Board grant this

motion for joinder pursuant to 35 U.S.C. § 325(c) and 37 C.F.R. § 42.222(b) and enter an order consistent with the proposed order provided below.

A. This Joinder Motion Is Timely

This motion is timely. Under 37 C.F.R. § 42.222(b), joinder can be requested without prior authorization no later than one month after the institution date of the proceeding to which joinder is requested. *Taiwan Semiconductor*, IPR2014-00781 and IPR2014-782, Paper 5 at 3. Because this motion is being filed prior to the Board's decision whether to institute the Apple CBM, it meets the requirements of § 42.222(b). *See, e.g.*, *Biotronik, Inc. v. Atlas IP LLC*, IPR2015-00534, Paper 10 (Feb. 25, 2015) (granting motion for joinder filed concurrently with institution of IPR review).

B. Joinder Is Appropriate

Joinder of the Apple CBM and the Expedia CBM is the most practical way to secure the just, speedy, and inexpensive resolution of these related proceedings. *See* 37 C.F.R. § 42.1(b). The Expedia CBM is intentionally identical to the Apple CBM in all substantive aspects. That is, the same claims are challenged (claims 1-18 of the '077 patent) based on the same prior art, same claim charts, and same claim constructions.[1] The same expert declarant is used, and the expert's

[1] The later filed Expedia CBM includes a few edits to address typographical errors in the earlier filed Apple CBM. These edits do not change the substantive bases for challenging the claims of the '077 Patent.

declarations in the two cases are substantively identical. Further, unity of exhibits and exhibit numbering (particularly with respect to prior art) with the Apple CBM have also been maintained, with only minor exceptions.[2] Accordingly, resolving the Expedia CBM and Apple CBM will necessarily involve considering the same issues and same papers. Joining these CBM reviews thus presents an opportunity to streamline review of the '077 Patent's Challenged Claims and eliminate unnecessary duplication of filings, papers, and efforts of the Petitioner, the PO, and the Board. On the other hand, if the Expedia CBM and Apple CBM proceed separately, there would undoubtedly be needless duplicate effort.

C. Consolidated Filings and Discovery

To further ensure a streamlined process, and because the grounds of unpatentability in the Apple and Expedia CBMs are the same, Petitioner agrees to work closely with Apple to avoid redundancies wherever possible.

For example, Petitioner will agree to consolidated filings for all substantive papers in the proceeding (*e.g.*, Reply to the PO's Response, Opposition to Motion to Amend, Motion for Observation on Cross Examination Testimony of a Reply Witness, Motion to Exclude Evidence, Opposition to Motion to Exclude Evidence,

[2] Exhibits 1030 (PO's complaints against Petitioner), 1031 (PO's complaints against Petitioner), and 1060 (PO's Infringement Contentions against Petitioner) necessarily differ due to different real parties-in-interest in the Expedia CBM and Apple CBM. The Expedia CBM includes the Apple CBMs as additional Exs. 1068-1070. Otherwise, all exhibits are the same.

and Reply). Specifically, so as to avoid lengthy and duplicative briefing, Petitioner will agree to:

- incorporate its filings with those of Apple in a consolidated filing, subject to the ordinary rules for one party on page limits;
- be jointly responsible with Apple for the consolidated filings; and
- not be permitted to make arguments separately from those advanced by Petitioner and Apple in the consolidated filings.

Petitioner will also agree to consolidated discovery. This is appropriate given that Petitioner and Apple are using the same expert declarant who has submitted a substantively identical declaration in the two proceedings. Additionally, Petitioner will agree to designate a single attorney to conduct, on behalf of Petitioner and Apple, the cross-examination of any witness produced by PO and the redirect of any witness produced by Petitioner and PO, and to limit such cross-examinations and redirect to the time normally allotted for one party. Petitioner and Apple will not receive any separate cross-examination or redirect time.

D. No New Grounds of Unpatentability

The Expedia CBM raises no new grounds of unpatentability from those raised in the Apple CBM. This is because, as noted above, the Apple CBM and Expedia CBM are substantively identical.

E. No Impact on CBM Trial Schedule

This motion is being filed before institution of the Apple CBM and, thus, before a trial schedule has been set in that matter. Accordingly, the trial schedule for the Apple CBM should not be adversely affected. Further, joinder at an early stage—at the time of institution of the Apple and Expedia CBMs—means all parties to the Apple and Expedia CBMs and known issues can be taken into account before setting the trial schedule, presenting the best opportunity to complete trial within the statutory one-year period.

F. Joinder Will Streamline the Proceedings and Result in No Prejudice to PO

Joinder will streamline the proceedings and reduce the costs and burden on Petitioner, PO, and the Board. Joining these proceedings will eliminate duplicate papers that must be filed, reviewed, and managed in each proceeding if the proceedings are not joined. Joinder will therefore also create case management efficiencies for the Board and parties. Further, because Petitioner and Apple have agreed to cooperate, joinder will also reduce by half the time and expense for depositions and other discovery that would otherwise accompany separate CBM proceedings. As such, joinder will simplify briefing and discovery, without any foreseeable prejudice to PO.

V. PROPOSED ORDER

In light of the benefits of joinder described above, Petitioner proposes an order joining the Expedia CBM with the Apple CBM consistent with the following, which Apple does not oppose:

- If CBM review is instituted on any ground in the Apple CBM, the Expedia CBM will be instituted on the same grounds and joined with the Apple CBM;
- The scheduling order entered for the Apple CBM will apply to the joined proceedings;
- Throughout the joined proceedings, Petitioner and Apple will file papers as consolidated filings, except for motions that do not involve the other party, in accordance with the Board's established rules regarding page limits. So long as they both continue to participate in the merged proceedings, Petitioner and Apple will identify each such filing as a Consolidated Filing and will be responsible for completing all consolidated filings;
- Petitioner and Apple will designate an attorney to conduct the cross examination of any witness produced by PO and the redirect of any given witness produced by Petitioner and Apple within the timeframe normally allotted by the rules for one party. Petitioner and Apple will not receive any separate cross-examination or redirect time; and

- PO will conduct any cross examination of any given witness jointly produced by Petitioner and Apple and the redirect of any given witness produced by PO within the timeframe normally allotted by the rules for one cross-examination or redirect examination.

VI. CONCLUSION

For the foregoing reasons, if the Board institutes CBM review, Petitioner respectfully requests that the Board grant joinder of the Apple CBM and Expedia CBM.

April 7, 2015 Respectfully Submitted,

By: /s/ Richard S. Zembek

Richard S. Zembek
Reg. No. 43,306
Norton Rose Fulbright US LLP
1301 McKinney, Suite 5100
Houston, Texas 77010
Tel: 713-651-5151
Fax: 713-651-5246
richard.zembek@nortonrosefulbright.com

Gilbert A. Greene
Reg. No. 48,366
Norton Rose Fulbright US LLP
98 San Jacinto Boulevard, Suite 1100
Austin, Texas 78701
Tel: 512-474-5201
Fax: 512-536-4598
bert.greene@nortonrosefulbright.com

Attorneys for Expedia, Inc., Fandango, LLC, Hotel Tonight, Inc., Hotwire, Inc., Hotels.com, L.P., Kayak Software Corp., Live Nation Entertainment, Inc., Orbitz, LLC, OpenTable, Inc., Papa John's USA, Inc., StubHub, Inc., Ticketmaster, LLC, Travelocity.com LP, Wanderspot LLC, Agilysys, Inc., Domino's Pizza, Inc., Domino's Pizza, LLC, Hilton Resorts Corporation, Hilton Worldwide, Inc., Hilton International Co., Mobo Systems, Inc., Pizza Hut of America, Inc. and Pizza Hut, Inc., and Usablenet, Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Petitioner's Motion for Joinder under 35 U.S.C. § 325(c) and 37 C.F.R. § 42.222(b), together with exhibit thereto, was served by electronic mail on April 7, 2015 as follows:

Michael D. Fabiano
FABIANO LAW FIRM, P.C.
12526 High Bluff Drive, Suite 300
San Diego, CA 92130
mdfabiano@fabianolawfirm.com

John W. Osborne
OSBORNE LAW LLC
josborne@osborneipl.com

By: /s/ Richard S. Zembek
Richard S. Zembek