

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 IPR2014-00979
Patent 6,928,442 B2

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

CHANG, *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

Google Inc. and YouTube, LLC (collectively “Google”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1, 2, 4, 7, 23, 27, 28, and 30 of U.S. Patent No. 6,928,442 B2 (“the ’442 patent,” Ex. 1001). Paper 1. Google filed its Petition along with a Motion for Joinder requesting that we join the instant case with *Rackspace US, Inc. v. PersonalWeb Techs. LLC*, IPR2014-00066. Paper 3, “Google Mot.” In IPR2014-00066, we instituted the same grounds of unpatentability over the same claims at issue in the instant proceeding. *Compare* IPR2014-00066, Paper 9, 40, *with* Pet. 8, 17–43. 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 deny the Petition because, absent joinder of Google as a party to IPR2014-00066, the Petition 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.*” Emphasis added.

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 ’442 patent on December 12, 2011. Ex. 2001; *see also* Pet. 3 (Google stating that PersonalWeb asserted the ’442 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 ’442 patent). Thus, absent joinder to IPR2014-00066, the Petition is barred.

III. ANALYSIS

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

We first note that Google did not file its Motion for Joinder within one month after we instituted an *inter partes* review in IPR2014-00066, 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).

We instituted an *inter partes* review in IPR2014-00066 on April 15, 2014. IPR2014-00066, Paper 9. Pursuant to § 42.122(b), if Google desired to join IPR2014-00066 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 IPR2014-00066 stipulated to a thirty-day extension for DUE DATES 1 and 2 (IPR2014-00066, Paper 14) and, at the time it filed its Motion for Joinder, only the initial conference call had occurred (IPR2014-00066, Papers 13 and 14). Google Mot. 2. Google asserts that given the revised schedule stipulated to by the parties in IPR2014-00066, its request for joinder was filed during a stage in IPR2014-00066 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 IPR2014-00066 stipulated to new dates for DUE DATES 1 and 2—a common practice in proceedings before us—does not constitute an 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, IPR2014-00066 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 IPR2014-00066 Renders
Google’s Motion for Joinder Moot*

Although we deny Google 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 11, 2013, Rackspace US, Inc. and Rackspace Hosting, Inc. (collectively “Rackspace”) filed a Petition requesting an *inter partes* review of claims 1, 2, 4, 7, 23, 27, 28, and 30 of the ’442 patent. IPR2014-00066, Paper 3. PersonalWeb timely filed a Preliminary Response. IPR2014-00066, 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 instituted an *inter partes* review as to the claims challenged by Rackspace. IPR2014-00066, Paper 9. On October 16, 2014, Rackspace and PersonalWeb jointly requested that we terminate IPR2014-00066 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).

IPR2014-00066, Paper 27; Ex. 1017. Upon consideration of this request, we terminated IPR2014-00066. IPR2014-00066, Paper 30. Given that IPR2014-00066 is no longer pending, it cannot serve as a proceeding to which another proceeding may be joined. As such, the termination of IPR2014-00066 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 IPR2014-00066, 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—IPR2014-00066—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 '442 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.

IPR2014-00979
Patent 6,928,442 B2

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