

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

ENFISH, LLC,
Patent Owner.

Case IPR2014-00574
Patent 6,151,604

Before THOMAS L. GIANNETTI, BRYAN F. MOORE,
SCOTT A. DANIELS, and BARBARA A. PARVIS, *Administrative Patent
Judges.*

DANIELS, *Administrative Patent Judge.*

DECISION
Motion for Joinder
37 C.F.R. § 42.122(b)

I. INTRODUCTION

On April 4, 2014, Microsoft Corporation (“Microsoft”) filed four petitions for *inter partes* review of patents owned by Enfish, LLC (“Enfish”), IPR2014-00574, IPR2014-00575, IPR2014-00576 and IPR2014-00577. Each petition was accompanied by a motion for joinder. This decision addresses the Motion for Joinder in this case, IPR2014-00574. Concurrently, separate decisions are being issued on the joinder motions filed in each of the other proceedings.

In this proceeding the Petition (Paper 1) requests *inter partes* review of certain claims of U.S. Patent No. 6,151,604 (“the ’604 patent”). On April 16, 2014, Microsoft filed a Corrected Petition (Paper 5). In this Decision, we refer to the Corrected Petition as the Petition (“Pet.”). Microsoft also has filed a Motion for Joinder (Paper 3, “Motion”), seeking to join this case with a previously instituted proceeding, also involving the ’604 patent. Patent Owner, Enfish, filed an Opposition to the Joinder Motion (Paper 9, “Opp.”), and a Preliminary Response to the Petition (Paper 11, “Prelim. Resp.”) For the reasons that follow, we deny Microsoft’s Joinder Motion. As a result of this denial, separately, we deny the Petition as time-barred under 35 U.S.C. §315(b)(1).

II. BACKGROUND

A. *Related Proceedings*

On September 3, 2013, Microsoft filed five separate petitions seeking review of two Enfish patents, including the ’604 patent involved in this proceeding. On March 4, 2014, in response to those petitions, the Board instituted five separate trial proceedings. Those proceeding are as follows: IPRs 2013-00559, 2013-00560, and 2013-00561 (all involving US Patent

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No. 6,163,775); and IPRs 2013-00562 and 2013-00563 (both involving US Patent No. 6,151,604). The initial conference with the Board has taken place in those proceedings, and discovery is under way under a common schedule. In addition to those proceedings, currently pending is an infringement lawsuit, *Enfish, LLC v. Microsoft Corporation, et al.*, Case No. CV12-7360 MRP (MRWx) filed in the Central District of California on August 27, 2012. Pet. 2.

B. IPR2013-00562

Microsoft seeks to join this proceeding with IPR2013-00562. Motion 1. Microsoft's Petition in this proceeding seeks review of claims 1, 2, 6, 7, 11–13, 31, 32, 36, 37, and 41–43 of the '604 patent. Pet. 4. In IPR2013-00562, we instituted review on these claims. *Microsoft Corp. v. Enfish, LLC*, Case IPR2013-00562, slip. op. at 31–32 (PTAB Mar. 4, 2014) (Paper 15), (“IPR2013-00562 Decision”). In that proceeding, however, we declined to institute *inter partes* review on one of the grounds asserted by Microsoft, namely, that claims 1, 2, 31, and 32 of the '604 patent are obvious over Chang and Smith '510,¹ because we determined that this ground was redundant of others on which we instituted *inter partes* review. *Id.* at 31.

C. The Joinder Motion

Microsoft contends that joinder is appropriate for several reasons. Microsoft first acknowledges that two of its previous petitions involve the same parties and the same patent as the Petition in this proceeding. Motion

¹ Chang et al., EP Publication No. 0 336 580 A2 (pub. Oct. 11, 1989) (“Chang,” Ex. 1304).
Smith et al., U.S. Patent No. 5,404,510 (issued Apr. 4, 1995) (“Smith '510,” Ex. 1307).

3. Microsoft justifies filing additional petitions by alleging “changed circumstances” occurring after its earlier petitions were filed. *Id.* According to Microsoft, these events “were unknown and unanticipated” at the time. *Id.*

Microsoft contends that Enfish took positions in the California lawsuit that are inconsistent with its position here on claim construction. Motion 3–4. As a result, Microsoft seeks to have the Board reconsider its earlier decision that Chang and Smith ’510 is redundant by adding it to the proceedings. *Id.* at 5. Microsoft further contends that we should institute a trial on four additional patentability challenges under 35 U.S.C. § 103, each of which would add Smith ’510. *Id.* at 6–7.

Microsoft recognizes that joinder would require scheduling adjustments for the trials that have been instituted on its earlier petitions, all of which are following the same track. *Id.* at 8. In this regard, Microsoft proposes modifying the schedule to provide additional time (six weeks) for Enfish to prepare its Patent Owner Responses. *Id.* at 8–9. The other dates on the schedule all would remain unchanged. *Id.*

B. Patent Owner’s Opposition

Enfish responds by challenging the availability of joinder to a petitioner who is already a party to a proceeding. Opp. 1. Enfish further asserts that under the “guise” of a new petition Microsoft is attempting to seek rehearing of the Board’s Decision not to institute trial on “the exact same grounds of unpatentability” as in IPR 2013-00562 involving the Chang and Smith ’510 references. *Id.* at 8–9. Enfish also points to the “negative impact on the schedule” and “significant burden” to Enfish that would result from joinder. *Id.* at 14. As examples, Enfish points to complications in

scheduling and preparing for the deposition of its expert that would result from joinder, as well as the additional time necessary to analyze the new grounds and references. *Id.* at 13–14.

C. Petitioner’s Reply

Microsoft challenges Enfish’s position on the availability of joinder. Reply 1. Microsoft reasserts that Enfish’s changed claim construction position necessitated Microsoft’s additional petitions and joinder request. *Id.* at 3-4. And Microsoft cites the proposed six-week extension to counter Enfish’s claim of undue complication, delay, and burden. *Id.* at 5.

III. LEGAL STANDARDS

The Leahy-Smith America Invents Act (AIA) permits joinder of like review proceedings. The statutory provision governing joinder of *inter partes* review proceedings is 35 U.S.C. § 315(c), which is reproduced below.

(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.

The standard for joinder gives the Director discretion as to whether to join an *inter partes* review with another *inter partes* review. 35 U.S.C. § 315(c).

As the movant, Microsoft bears the burden to show that joinder is appropriate. 37 C.F.R. § 42.20(c). We also consider that the Board’s rules for AIA proceedings “shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b); *see* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,758 (Aug. 14, 2012).

IV. DISCUSSION

As will be discussed further below, Microsoft's argument and evidence are insufficient to persuade us to exercise our discretion to join these matters. We, thus, deny Microsoft's Joinder Motion.

A. Chang and Smith '510

Ground 1 asserts that claims 1,2, 31, and 32 are unpatentable under 35 U.S.C. §103 as obvious over Chang and Smith '510.² Microsoft argues that in IPR 2014-00562, Microsoft's petition "predict[ed]" that Enfish would attempt to narrow its claim construction and distinguish Chang, and therefore Microsoft advanced an alternative ground based upon the combination of Chang and Smith '510. Now that Enfish's preliminary response has "criticized" Chang, Microsoft argues that it should be able to reassert that alternative combination. We are not persuaded by this argument. In IPR2013-00562 we have already considered the combination of Smith'510 and Chang in light of Microsoft's prediction that Enfish would narrow their claim construction, and determined Smith '510 to be redundant of Chang. *See* IPR 2014-00562 Decision, 31, *and see* Pet. 14. In essence, Microsoft seeks a rehearing of that decision.

In its Petition, however, Microsoft merely asserts that Smith '510 discloses rows having an OID "under the Board's construction." Pet. 24-25. But Microsoft does not explain sufficiently where Smith '510 discloses the alleged narrower OID construction or how the already-identified disclosure of Smith '510 describes the narrower OID construction better than prior art on which we already instituted review. Microsoft's assertion regarding

² To be clear, ground 1, in this proceeding, is exactly the same as ground 2 in IPR 2013-00562.

Smith '510's disclosure of columns having an OID is similarly deficient. *Id.* at 25-26.

B. Addition of Chang and Smith '510

Microsoft proposes that the combination of Chang and Smith '510 be added to various other prior art references in each of grounds 2–5. Pet. 30–46. For the same reasons as discussed above we are not persuaded that the alleged changed circumstances justifies granting joinder with IPR 2013-00562.

C. Scheduling Issues and Other Matters

Microsoft has not convinced us that joining this Petition with the previously instituted trials would “secure a just, speedy, and inexpensive resolution.” Motion 7; *see* 37 C.F.R. § 42.1(b). Microsoft's offer to extend time for Enfish's Patent Owner response does not convince us that Enfish will not be unduly burdened or prejudiced by joinder or that the existing trials will not be complicated unnecessarily by the addition of Smith '510. Microsoft has failed to address convincingly the expert preparation and discovery issues raised by Enfish (Opp. 12-14). Microsoft's offer of “additional deposition time” is not sufficient to remedy these issues. Reply 5. Nor does Microsoft address the additional burden on the Board, which has already determined that Smith '510 is redundant of references included in the existing trials. Microsoft's claim that Enfish has changed its position is not reason enough to permit what is essentially a rehearing request on Smith '510.

Under 35 U.S.C. §§ 315(c), we exercise our discretion to deny joinder.

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V. ORDER

For the reasons given, it is

ORDERED that pursuant to 35 U.S.C. § 315(c), we deny Microsoft's request to join IPR2014-00574 with IPR2013-00562.

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