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Paper No. 15
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ORACLE AMERICA, INC.,
Petitioner,

v.

REALTIME DATA LLC,
Patent Owner.

Case IPR2016-01671
Patent 7,415,530 C1

Before J. JOHN LEE, JASON J. CHUNG, and SCOTT C. MOORE, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

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

INTRODUCTION

On September 6, 2016, Oracle America, Inc. ("Oracle") filed a Petition (Paper 5, "Pet.") requesting *inter partes* review of claims 1–5, 9–12, 14, 18, 19, and 24 ("the challenged claims") of U.S. Patent No. 7,415,530 C1 (Ex. 1001, "the '530 patent"). Concurrently with the Petition, Oracle filed a Motion for Joinder (Paper 2, "Mot."), requesting that this proceeding be joined with *Dell Inc. v. Realtime Data LLC*, Case IPR2016-00972 ("972 IPR"). Mot. 1. Patent Owner Realtime Data LLC ("Realtime") filed an Opposition to the Motion for Joinder (Paper 11, "Opp.") on October 6, 2016. Oracle filed a Reply to the Opposition to the Motion (Paper 12, "Reply") on November 7, 2016.

For the reasons discussed below, we institute an *inter partes* review of all challenged claims and grant Oracle's Motion for Joinder.

INSTITUTION OF *INTER PARTES* REVIEW

In the 972 IPR, we instituted an *inter partes* review of claims 1–5, 9–12, 14, 18, 19, and 24 of the '530 patent as allegedly unpatentable on the following asserted grounds:

Challenged Claim(s)	Asserted Prior Art
1, 9–11, 14, 18	Franaszek[1] and Osterlund[2]
2–5	Franaszek, Osterlund, and Fall[3]

[1] U.S. Patent No. 5,870,036, issued Feb. 9, 1999 (972 IPR, Ex. 1004, "Franaszek").
[2] U.S. Patent No. 5,247,646, issued Sept. 21, 1993 (972 IPR, Ex. 1005, "Osterlund").
[3] U.S. Patent No. 5,991,515, filed July 15, 1997, issued Nov. 23, 1999 (972 IPR, Ex. 1007, "Fall").

Challenged Claim(s)	Asserted Prior Art
12	Franaszek, Osterlund, and Assar[4]
19	Franaszek, Osterlund, and Crawford[5]
24	Franaszek, Osterlund, Clark,[6] and Rynderman[7]

972 IPR, slip op. at 19–20 (PTAB Nov. 1, 2016) (Paper 24). The Petition in this proceeding challenges the same claims on identical grounds of unpatentability, and relies on the same evidence and arguments as presented in the 972 IPR. Pet. 1; Mot. 2. Oracle represents that the Petition "copies verbatim the challenges set forth in the petition in [the 972 IPR] and relies upon the same evidence, including the same expert declaration." Pet. 1; *see* Mot. 2. Realtime did not file a preliminary response and has not presented any arguments regarding the merits of the Petition.

For the above reasons, in particular the fact that the present Petition is virtually identical to the petition in the 972 IPR, we determine Oracle has demonstrated sufficiently under 35 U.S.C. § 314 that an *inter partes* review should be instituted in this proceeding on the same grounds of unpatentability as the grounds on which we instituted *inter partes* review in the 972 IPR.

[4] U.S. Patent No. 5,479,638, issued Dec. 26, 1995 (972 IPR, Ex. 1016, "Assar").
[5] U.S. Patent No. 5,771,354, issued June 23, 1998 (972 IPR, Ex. 1009, "Crawford").
[6] U.S. Patent No. 5,319,682, issued June 7, 1994 (972 IPR, Ex. 1008, "Clark").
[7] U.S. Patent No. 5,563,961, issued Oct. 8, 1996 (972 IPR, Ex. 1006, "Rynderman").

MOTION FOR JOINDER

An *inter partes* review may be joined with another *inter partes* review, subject to certain statutory provisions:

> (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 parties review under section 314.

35 U.S.C. § 315(c); *see also* 37 C.F.R. § 42.122. As the moving party, Oracle bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c).

As an initial matter, the Motion for Joinder meets the requirements of 37 C.F.R. § 42.122(b) because the Motion was filed on September 6, 2016, which is not later than one month after the 972 IPR was instituted on November 1, 2016.

Additionally, the present Petition challenges the same claims of the same patent as those under *inter partes* review in the 972 IPR, and the Petition also asserts the same grounds of unpatentability based on the same prior art and the same evidence, including the same declaration testimony. Mot. 2; *compare* Pet. 4–6, *with* 972 IPR, Paper 10, 7–8. The Petition does not assert any other grounds of unpatentability, or present any new evidence not already of record in the 972 IPR. Indeed, the Petition repeats verbatim most of the content of the petition in the 972 IPR. *See* Pet. 1; Mot. 7–8.

Oracle further asserts that granting joinder would not require any alterations to the existing scheduling order in the 972 IPR. Mot. 8–9. Moreover, Oracle represents that it "has agreed to not materially participate

in the joined proceedings unless and until the parties to [the 972 IPR] are dismissed from the joined proceedings or elect to transfer control to [Oracle], as may occur in the event of settlement or advanced settlement negotiations." *Id.* at 9. As such, Oracle "does not intend to file separate papers or conduct separate cross examinations of any witnesses," if joined to the 972 IPR. *Id.* at 10. Oracle also represents that the petitioners in the 972 IPR do not oppose joinder of the present proceeding. *Id.* at 6.

According to Oracle, joinder "will promote the efficient determination of validity of the challenged claims of the '530 patent," because a final written decision in the 972 IPR potentially could minimize the issues in all of the underlying litigation in which the '530 patent has been asserted. *Id.* at 6–7. Oracle asserts that Realtime would not be prejudiced because the schedule of the 972 IPR would be unchanged, and Realtime would not take on additional costs or burden because of the overlap between the present Petition and the 972 IPR petition. *Id.* at 7–9. In addition, Oracle argues that briefing and discovery could be simplified if joinder is granted. *Id.* at 10.

Realtime argues that the fact that the present Petition and the 972 IPR petition are similar is not dispositive. Opp. 1–2. According to Realtime, Oracle failed to demonstrate it is entitled to joinder because it did not explain why it could not have included the arguments and grounds in the present Petition in an earlier petition it filed in IPR2016-00375. *Id.* at 2–6. In IPR2016-00375, Oracle challenged some, but not all, of the claims challenged in the present Petition based on different prior art references. *See Oracle Am., Inc. v. Realtime Data LLC*, Case IPR2016-00375, slip op. at 3–4 (PTAB July 1, 2016). The petition in that case was denied, and no *inter partes* review was instituted. *Id.* at 12. Realtime asserts that Oracle, thus,

already had an opportunity to assert the challenges and evidence advanced in the present Petition but did not, and that allowing Oracle to do so now would improperly grant it a "second bite at the apple." Opp. 6–7. In addition, Realtime asserts it would be prejudiced by joinder because the one-year deadline for the final determination in an *inter partes* review may be adjusted in the event of joinder. *Id.* at 6; *see* 35 U.S.C. § 316(a)(11).

Based on the facts and circumstances discussed above, we determine Oracle has established good cause for joining this proceeding with the 972 IPR. Realtime's arguments are unpersuasive. First, its assertion of prejudice is speculative. Although the Board has the authority to adjust the schedule of a case beyond the one-year deadline mandated in 35 U.S.C. § 316(a)(11) and 37 C.F.R. § 42.100(c), Realtime does not explain why it believes such an adjustment is necessary or even likely. In fact, the present circumstances indicate such an adjustment is *unlikely* to be needed given that joinder will not add any new arguments or evidence to the 972 IPR, nor require any modification of its schedule.

With respect to Realtime's argument that Oracle could have raised the arguments and evidence in the present Petition in its earlier petition denied in IPR2016-00375, we have considered that factor but conclude joinder is warranted nonetheless considering the totality of the facts and circumstances. Realtime relies on three non-binding prior decisions of the Board, each of which is distinguishable from the present case. *See* Opp. 2–3, 5. As Oracle notes (Reply 6–7), two of the cases cited by Realtime involved motions for joinder where the prior proceeding to which joinder was sought had been terminated; thus, joinder could not be granted. *See Toyota Motor Corp. v. Am. Vehicular Sci. LLC*, Case IPR2015-00262, slip

op. at 4–5 (PTAB Jan. 29, 2015) (Paper 10); *Ubisoft, Inc. v. Uniloc USA, Inc.*, Case IPR2016-00414, slip op. at 5 (PTAB June 2, 2016) (Paper 16). Further, in *Toyota*, the joinder petition also relied on new evidence not raised in the proceeding to which the petitioner sought joinder. *Toyota*, Case IPR2015-00262, slip op. at 5. Similarly, in *Harmonix Music Sys., Inc. v. Princeton Digital Image Corp.*, the joinder petition asserted new grounds of unpatentability and new evidence not raised in the proceeding to which joinder was sought, as well as challenging claims for which institution had been denied. Case IPR2015-00271, slip op. at 4–6 (PTAB June 2, 2015) (Paper 15). Significant modifications to the schedule would also have been required, which also weighed against joinder. *Id.* at 6–7.

Although the fact that a petition includes arguments and evidence that reasonably could have been raised in an earlier petition may weigh against joinder, the decision to grant or deny joinder is made "on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations." *See Unified Patents, Inc. v. PersonalWeb Techs., LLC*, Case IPR2014-00702, slip op. at 3 (PTAB July 24, 2014) (Paper 12); *Dell Inc. v. Network-1 Sec. Solutions, Inc.*, Case IPR2013-00385, slip op. at 3 (PTAB July 29, 2013) (Paper 17). Here, we conclude the facts and circumstances discussed above weigh in favor of granting joinder. Joinder of this proceeding with the 972 IPR will not require any delay or modification to the scheduling order already in place for the 972 IPR. We determine that Realtime will not be unduly prejudiced by the joinder of these proceedings, and joining Oracle's identical challenges to those in the 972 IPR will lead to greater efficiency while reducing the resources necessary from both Realtime and the Board. Consequently,

granting the Motion for Joinder under these circumstances would help "secure the just, speedy, and inexpensive resolution" of these proceedings. *See* 37 C.F.R. § 42.1(b). For the above reasons, we conclude that the Motion for Joinder should be granted.

ORDER

It is

ORDERED that pursuant to 35 U.S.C. § 314, an *inter partes* review in IPR2016-01671 is hereby instituted for claims 1–5, 9–12, 14, 18, 19, and 24 of the '530 patent on the grounds of unpatentability set forth above;

FURTHER ORDERED that Oracle's Motion for Joinder is *granted*;

FURTHER ORDERED that IPR2016-01671 is hereby joined with IPR2016-00972;

FURTHER ORDERED that the grounds of unpatentability on which trial was instituted in IPR2016-00972 are unchanged and remains the only grounds on which trial has been instituted;

FURTHER ORDERED that the Scheduling Order entered in IPR2016-00972 (Paper 25), as modified by joint stipulation (Paper 29), is unchanged and shall govern the schedule of the joined proceeding;

FURTHER ORDERED that Oracle and the petitioners in IPR2016-00972 will file all papers jointly in the joined proceeding as consolidated filings, and will identify each such paper as "Consolidated," except for papers that involve fewer than all of these parties;

FURTHER ORDERED that IPR2016-01671 is terminated under 37 C.F.R. § 42.72, and all further filings in the joined proceeding are to be made in IPR2016-00972;

FURTHER ORDERED that a copy of this Decision will be entered into the record of IPR2016-00972; and

FURTHER ORDERED that the case caption in IPR2016-00972 shall be modified to reflect joinder with this proceeding in accordance with the attached example.

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Example Case Caption for Joined Proceeding

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL INC.; RIVERBED TECHNOLOGY, INC.; HEWLETT-PACKARD ENTERPRISE CO.; HP ENTERPRISE SERVICES, LLC; TERADATA OPERATIONS, INC.; ECHOSTAR CORPORATION; HUGHES NETWORK SYSTEMS, INC.; and ORACLE AMERICA, INC.,
Petitioners,

v.

REALTIME DATA LLC,
Patent Owner.

Case IPR2016-00972[1]
Patent 7,415,530 C1

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[1] Case IPR2016-01671 has been joined with this proceeding.