

Petitioner's Motion for Joinder under 35 U.S.C. § 315(c),
37 C.F.R. § 42.22 AND § 42.122(b)

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EBAY INC., EXPEDIA, INC., HOMEAWAY.COM, INC., SQUARESPACE,
INC., WIX.COM, LTD., AND WIX.COM, INC.,
Petitioner

v.

EXPRESS MOBILE INC.,
Patent Owner

U.S. Patent No. 7,594,168 B2
Issue Date: September 22, 2009

Title: Browser Based Web Site Generation Tool and Run Time Engine

**PETITIONER'S MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c),
37 C.F.R. § 42.22 AND § 42.122(b)**

IPR Trial No. IPR2022-00572

TABLE OF CONTENTS

I.	Statement of the Precise Relief Requested.....	1
II.	Reasons for the relief requested.....	2
A.	Legal Standard.....	2
B.	Reasons Why Joinder Is Appropriate.....	2
C.	The Instant Petition Does Not Raise Any New Grounds of Unpatentability	4
D.	Joinder Will Not Affect the Schedule in the Facebook IPR	4
E.	Joinder will Simplify Briefing Because Petitioner Has Agreed to Consolidated Filings and an Understudy Role.....	5
F.	Joinder Will Not Prejudice Patent Owner.....	6
III.	Conclusion	6

TABLE OF AUTHORITIES

Cases

<i>Dell, Inc. v. Network-1 Security Solutions, Inc.</i> , IPR2013-00385 (PTAB July 29, 2013).....	2
<i>Enzymotec Ltd. v. Neptune Techs & Bioresources, Inc.</i> , IPR2014-00556 (PTAB July 9, 2014).....	2
<i>Everlight Elecs. Co. v. Document Security Sys., Inc.</i> , IPR2018-01260 (PTAB Nov. 14, 2018).....	3
<i>Noven Pharm., Inc. v. Novartis AG</i> , IPR2014-00550 (PTAB April 10, 2015).....	5
<i>Samsung Elecs. Co., Ltd. v. Raytheon Co.</i> , IPR2016-00962 (PTAB Aug. 24, 2016).....	3

Statutes

35 U.S.C. § 314(a)	2
35 U.S.C. § 315(c)	1
35 U.S.C. § 325(d)	2

Other Authorities

37 C.F.R. § 42.122(b)	1, 2
37 C.F.R. § 42.22	1, 2

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

eBay Inc. (“eBay”); Expedia, Inc., and Homeaway.com, Inc. (collectively, “Expedia”); Squarespace, Inc. (“Squarespace”); Wix.com, Ltd., and Wix.com, Inc. (collectively, “Wix”) (all collectively, “Petitioner”) respectfully submit this Motion for Joinder under 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22 and 42.122(b) , concurrently with its Petition (“Instant Petition”) for *inter partes* review of U.S. Patent No. 7,594,168 (the “’168 Patent”).

Joinder is appropriate because the Instant Petition is essentially a copy of the petition filed in *Facebook Inc. v. Express Mobile, Inc.*, IPR2021-01226 (“the Facebook Petition”), on which trial was instituted on January 14, 2022. The Instant Petition includes identical grounds presented in the Facebook IPR and therefore would create no additional burden for the Board, Facebook, or the Patent Owner, if joined.

Petitioner stipulates that if joinder is granted, it will cooperate with Facebook in the joined proceeding, whether at hearings, at depositions, in filings, or otherwise, as outlined below. Joinder will not impact the trial schedule because the Facebook IPR proceeding is in its early stages. Joinder would therefore lead to an efficient resolution of the validity of the ’168 Patent.

This Motion for Joinder is timely under 37 C.F.R. §§ 42.22 and 42.122(b), as it is submitted within one month of January 14, 2022, the date on which the Facebook IPR was instituted.

II. REASONS FOR THE RELIEF REQUESTED

A. Legal Standard

In determining whether to join one IPR proceeding to another, the Board considers: (1) reasons why joinder is appropriate; (2) any new grounds of unpatentability asserted in the petition; (3) what impact (if any) joinder would have on the trial schedule for the existing review; and (4) specifically how briefing and discovery may be simplified. *See Dell, Inc. v. Network-1 Security Solutions, Inc.*, IPR2013-00385, Paper 17 at 3 (PTAB July 29, 2013). Each of these factors favors joinder here.

B. Reasons Why Joinder Is Appropriate

Joinder is appropriate because it is the most efficient way to resolve the two related proceedings. The Instant Petition is intentionally identical in substance to the instituted Facebook IPR and does “not present issues that might complicate or delay” the Facebook IPR. *See Enzymotec Ltd. v. Neptune Techs & Bioresources, Inc.*, IPR2014-00556, Paper 19 (PTAB July 9, 2014). The only difference between the Instant Petition and the Facebook Petition are the sections on Real Party-In-Interest, Related Matters, Counsel, Considerations Under §§ 314(a) and 325(d)

(discretionary denial), and Claim Construction, which have been appropriately updated.¹

Joinder would therefore have little, if any, impact on the Facebook IPR because no new grounds would be added, the schedule would not be affected, no additional briefing or discovery would be required, and no additional burdens would be placed on the Patent Owner, as detailed below. Accordingly, joinder is appropriate because it ensures a just, speedy, and inexpensive resolution of these proceedings. *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (PTAB Aug. 24, 2016) (recognizing that the Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.” (internal quotations and citations omitted)).

¹ The Instant Petition is supported by a declaration from Dr. Kevin Jeffay, Ph.D. (Paper 1, Ex. 1028), who considered the declaration of Vijay K. Madisetti, Ph.D., submitted in the Facebook IPR (IPR2021-01226, Paper 1, Ex. 1002 (July 6, 2021)) and the opinions set forth therein. Dr. Jeffay agrees with Dr. Madisetti's opinions and adopts them as his own. Therefore, the declaration of Dr. Jeffay is substantively identical to the declaration of Dr. Madisetti and does not expand on the scope of expert opinions provided by Dr. Madisetti in the Facebook IPR. *See Everlight Elecs. Co. v. Document Security Sys., Inc.*, IPR2018-01260, Paper No. 12 at 6-7 (PTAB Nov. 14, 2018) (granting motion for joinder where petitioner submitted separate but substantially identical expert declaration).

C. The Instant Petition Does Not Raise Any New Grounds of Unpatentability

The Instant Petition relies on the same grounds of unpatentability of claims 1-4 and 6 of the '168 Patent that were instituted in the Facebook IPR. See IPR-2021-01226, Paper 1 (July 6, 2021). As discussed above, the evidence and arguments supporting the Instant Petition is substantively identical to the evidence and arguments supporting the Facebook IPR.

D. Joinder Will Not Affect the Schedule in the Facebook IPR

Joinder will not affect the schedule in the Facebook IPR, because Petitioner agrees to the deadlines set forth in the Facebook IPR Scheduling Order. See IPR2021-01226, Paper 9 (Jan. 14, 2022). Since the Instant Petition does not raise any new arguments and is substantively identical to the Facebook IPR petition, there should be no need for Patent Owner to submit a preliminary response to the Instant Petition. Joinder would allow the Board and parties to focus on the merits of the unpatentability challenge to claims 1-4 and 6 of the '168 patent in a single consolidated proceeding without duplication of effort, and in an efficient manner.

E. Joinder will Simplify Briefing Because Petitioner Has Agreed to Consolidated Filings and an Understudy Role

Petitioner agrees, as long as Facebook remains a party to the Facebook IPR, to take an “understudy” role, which will simplify briefing and discovery.² *See, e.g., Noven Pharm., Inc. v. Novartis AG*, IPR2014-00550, Paper 38 at 5 (PTAB April 10, 2015). In this role, Petitioner agrees to the following conditions:

(a) Petitioner will not make any substantive filings and shall be bound by the filings of the Facebook, unless a filing concerns termination and settlement, or issues solely involving Petitioner.

(b) Petitioner will not present any argument or make any presentation at oral hearing unless an issue solely involves Petitioner, or when addressing Board-approved motions that do not affect Facebook.

(c) Petitioner will not seek to cross-examine or defend the cross-examination of any witness, unless the topic of cross-examination concerns issues solely involving Petitioner, within the time permitted by Facebook alone and with Facebook's agreement.

(d) Petitioner will not seek discovery from Patent Owner, unless issues arise that are unique to, and only applicable to, Petitioner.

² In the event Facebook no longer participates in the IPR proceedings, Petitioner would take over primary responsibility for subsequent filings and discovery.

(e) Petitioner will not rely on expert testimony beyond that submitted by Facebook unless and until Facebook is terminated as party to the proceedings, prior to any necessary depositions. Petitioner's expert declaration of Dr. Jeffay is substantially identical to the declaration of Dr. Madisetti submitted in the Facebook IPR. Dr. Jeffay will not actively participate in these proceedings, unless and until Facebook is terminated as a party.

F. Joinder Will Not Prejudice Patent Owner

Petitioner's joining of the Facebook IPR proceedings should not result in any prejudice to Patent Owner. No additional grounds or arguments are being introduced, no new evidence or issues are being added, and no additional discovery or briefing or oral argument should be necessary as a result of the Instant Petition and joinder. Additionally, joinder decreases the number filings by the parties, eliminates duplication of effort, and will create case management efficiencies for the Board and Patent Owner.

III. CONCLUSION

For the reasons above, Petitioner respectfully request that its Petition for *Inter Partes* Review of the '168 Patent be instituted and that Petitioner be joined to the Facebook IPR proceeding IPR2021-01226.

Petitioner's Motion for Joinder under 35 U.S.C. § 315(c),
37 C.F.R. § 42.22 AND § 42.122(b)

Dated: February 10, 2022

DURIE TANGRI LLP
217 Leidesdorff Street
San Francisco, CA 94111
Tel: (415) 362-6666
Fax: (415) 236-6300

Respectfully submitted,

By: /Adam R. Brausa/
Adam R. Brausa
Reg. No. 60,287
Counsel for Petitioner

CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. Sections 42.6 and 42.105, that a complete copy of the attached **MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c), 37 C.F.R. § 42.22 AND § 42.122(b)** is being served via Federal Express on the 10th day of February 2022, the same day as the filing of the above-identified document in the United States Patent and Trademark Office/Patent Trial and Appeal Board, upon Patent Owner by serving the correspondence address of record with the USPTO as follows:

Lowenstein & Weatherwax LLP
Attn: Kenneth Weatherwax
1880 Century Park East, Suite 815
Los Angeles, CA 90067

And, via email upon counsel of record in the pending litigations entitled *Express Mobile, Inc. v. Squarespace, Inc.*, No. 1-20-cv-01163 (D. Del.), *Express Mobile, Inc. v. Expedia, Inc.*, No. 6-20-cv-00801 (W.D. Tex.), *Express Mobile, Inc. v. eBay Inc.*, No. 3-21-cv-06656 (N.D. Cal.), and *Express Mobile, Inc. v. Wix.com, Ltd.*, No. 3-19-cv-06559 (N.D. Cal.) as follows:

David Alberti
Marc Belloli
Jerry D. Tice, II
Ryan Dooley
Sven Raz
M. Elizabeth Day
Robert F. Kramer
Russell S. Tonkovich
Sal Lim

James Richard Nuttall
Katherine H. Johnson
Michael Dockterman
Robert F. Kappers
Tron Yue Fu
Steptoe & Johnson LLP
227 West Monroe Street, Suite 4700
Chicago, IL 60606
jnuttall@steptoe.com

Kramer Day Alberti Lim
Tonkovich & Belloli LLP
577 Airport Blvd., Suite 250
Burlingame, CA 94010
dalberti@kramerday.com
mbelloli@kramerday.com
jtice@kramerday.com
rdooley@kramerday.com
sraz@kramerday.com
eday@kramerday.com
rkramer@kramerday.com
rtonkovich@kramerday.com
slim@kramerday.com

Attorneys for Patent Owner
EXPRESS MOBILE, INC.

Christopher Alan Suarez
Steptoe & Johnson LLP
1330 Connecticut Avenue, NW
Washington, DC 20036
csuarez@steptoe.com

Attorneys for Patent Owner
EXPRESS MOBILE, INC.

Jamie L. Lucia
Steptoe and Johnson LLP
One Market Plaza
Spear Tower, Suite 3900
San Francisco, CA 94105
jlucia@steptoe.com

Attorneys for Patent Owner
EXPRESS MOBILE, INC.

Scott W. Hejny
Abigail E. Clark
McKool Smith, PC

kjohnson@steptoe.com
mdockterman@steptoe.com
rkappers@steptoe.com
tfu@steptoe.com
SJXMOWix@Steptoe.com

Attorneys for Patent Owner
EXPRESS MOBILE, INC.

Timothy Devlin
Devlin Law Firm LLC
1526 Gilpin Avenue
Wilmington, DE 19806
tdevlin@devlinlawfirm.com

Attorneys for Patent Owner
EXPRESS MOBILE, INC.

Ramy E. Hanna
McKool Smith, PC
600 Travis Street Suite 7000
Houston, TX 10001-8603
rhanna@mckoolsmith.com

Attorneys for Patent Owner
EXPRESS MOBILE, INC.

Christopher Paul McNett

300 Crescent Court, Suite 1500
Dallas, TX 75201
shejny@mckoolsmith.com
aclark@mckoolsmith.com

Attorneys for Patent Owner
EXPRESS MOBILE, INC.

Steven J. Rizzi
McKool Smith, PC
One Manhattan West 395 9th
Avenue, 50th Floor
New York, NY 10001
srizzi@mckoolsmith.com
MSXMO@mckoolsmith.com

Attorneys for Patent Owner
EXPRESS MOBILE, INC.

McKool Smith, PC
1717 K Street Nw Suite 900
Washington, DC 20006
cmcnett@mckoolsmith.com

Attorneys for Patent Owner
EXPRESS MOBILE, INC.

Kenneth Weatherwax
Parham Hendifar
Patrick Maloney
Lowenstein & Weatherwax LLP
1880 Century Park East, Suite 815
Los Angeles, CA 90067
weatherwax@lowensteinweatherwax.com
hendifar@lowensteinweatherwax.com
maloney@lowensteinweatherwax.com

Attorneys for Patent Owner
EXPRESS MOBILE, INC.

DATED: February 10, 2022

/Adam R. Brausa/
Adam R. Brausa
Reg. No. 60,287