

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EXPEDIA, INC., HOMEAWAY.COM, INC., SQUARESPACE, INC.,
WIX.COM, LTD., and WIX.COM, INC.,
Petitioner

v.

EXPRESS MOBILE, INC.,
Patent Owner.

IPR2022-00785
Patent 9,063,755 B2

Before JEFFREY S. SMITH, AMBER L. HAGY, and
AARON W. MOORE *Administrative Patent Judges.*

MOORE, *Administrative Patent Judge.*

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314
Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

A. Background

Expedia, Inc., Homeaway.com, Inc., Expedia Group, Inc., VRBO Holdings, Inc., Squarespace, Inc., Wix.com, Ltd., and Wix.com, Inc. (collectively “Petitioner”) filed a Petition requesting *inter partes* review of claims 1, 2, 5–7, and 11 of U.S. Patent No. 9,063,755 B2 (“the ’755 patent,” Ex. 1001). Paper 1 (“Pet.”). Petitioner also filed a Motion for Joinder, seeking to be joined as a party to *Facebook, Inc. v. Express Mobile Inc.*, IPR2021-01455 (“the Facebook IPR”), which involves the same claims of the ’755 patent. Paper 3 (“Motion” or “Mot.”). Express Mobile, Inc. (“Patent Owner”) opposed the Motion (Paper 7, “Opp.”), Petitioner filed a reply in support of the Motion (Paper 8, “Reply”), and Patent Owner filed a Preliminary Response (Paper 9, “Prelim. Resp.”).

For the reasons explained below, we determine that institution of *inter partes* review is warranted on the same grounds instituted in the Facebook IPR, and we grant Petitioner’s Motion for Joinder.

B. Related Matters

The parties identify various related matters, including twenty pending District Court cases, nine terminated District Court cases, two pending Board IPRs (including the Facebook IPR), and four IPR petitions that were denied. *See* Pet. 1–4; Paper 5, 1–3.

C. Asserted Grounds of Unpatentability

Petitioner presents the following grounds, which are identical to the grounds instituted in the Facebook IPR:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 2, 5–7	103(a)	Anderson, ¹ Bowers, ² Jacobs, ³ Ambrose-Haynes ⁴
11	103(a)	Anderson, Bowers, Jacobs, Ambrose-Haynes, NFS Administration ⁵

II. ANALYSIS

Joinder in *inter partes* review proceedings is governed by 35 U.S.C. § 315(c):

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.

¹ G. Anderson & P. Anderson, *JAVA Studio Creator Field Guide*, 2d ed. (Prentice Hall 2006) (Ex. 1003, “Anderson”).

² B. Bowers & S. Lane, *Advanced FileMaker Pro 6 Web Development* (Wordware Pub. 2003) (Ex. 1004, “Bowers”).

³ S. Jacobs, *Foundation XML for Flash* (Springer-Verlag 2006) (Ex. 1005, “Jacobs”).

⁴ N. Ambrose-Haynes et al., *Professional ColdFusion 5.0* (Wrox Press. Ltd. 2001) (Ex. 1006, “Ambrose-Haynes”).

⁵ *Unix System V NFS Administration* (D. Herman, ed., Prentice Hall 1993) (Ex. 1007, “NFS Administration”).

In deciding whether to join a party to an instituted *inter partes* review, “the plain language of § 315(c) requires [that we make] two different decisions.” *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). First, “the statute requires that [we] determine whether the joinder applicant’s petition for IPR ‘warrants’ institution under § 314.” *Id.* Second, we must decide whether to exercise discretion to join the Petitioner to the existing proceeding. *See id.*

A. Whether the Petition Warrants Institution

35 U.S.C. § 314(a) provides that an *inter partes* review may not be instituted unless the information presented in the Petition and the Preliminary Response shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

This Petition presents the same patentability challenges as those we found sufficient in the Facebook IPR, and Patent Owner does not argue the patentability merits of Petitioner’s challenges at this stage. *See* Pet. 1 (“This Petition raises grounds of unpatentability identical to those in the already instituted in IPR2021-01455.”); Prelim. Resp. 10, n.1 (“Patent Owner is not including technical merits arguments in its Preliminary Response”). We thus conclude that Petitioner has demonstrated a reasonable likelihood of prevailing with respect to the challenged claims of the ’755 patent for the reasons given in the Institution Decision in the Facebook IPR.

Even if a petition meets the “reasonable likelihood” standard, however, institution of *inter partes* review is still discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016)

(“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

Patent Owner contends that we should deny institution based on the Board’s precedential decisions in *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (designated precedential in relevant part) and *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (PTAB Oct. 28, 2020) (precedential). Prelim. Resp. 7–24.

General Plastic identifies a list of factors to be considered by the Board in evaluating whether to exercise discretion under 35 U.S.C. § 314(a) to deny a petition that challenges a patent that was previously challenged before the Board:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

General Plastic, Paper 19 at 15–18. This is a “non-exhaustive list,” and “additional factors may arise in other cases for consideration, where appropriate.” *Id.* at 16, 18.

In *Uniloc*, the petitioner (Apple) sought to join an instituted *inter partes* review by filing a petition that was substantially the same as the petition on which a trial had been instituted. *Uniloc*, Paper 9 at 2–3. It was the petitioner’s second petition challenging the patent, and the panel applied the *General Plastic* factors and denied the petition. *Uniloc*, Paper 9 at 8–13.

Patent Owner argues that the present situation is similar to the circumstances in *Uniloc* that favored denial under *General Plastic* and, therefore, that the Petition should be denied. Prelim. Resp. 7–24.

For the reasons explained below, we find the present circumstances distinguishable from those in *Uniloc*, and we decline to deny the Petition based on the *General Plastic* factors.

*Whether Petitioner Previously Filed a
Petition Directed to the Same Claims*

Petitioner has not previously filed a petition challenging the ’755 patent, so this Petition does not present the situation addressed in *General Plastic*. We recognize, however, that *General Plastic* has not been limited to instances in which multiple petitions are filed by the same petitioner and that “when different petitioners challenge the same patent, we consider any relationship between those petitioners when weighing the *General Plastic* factors.” *See, e.g., Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11, at 9 (PTAB Apr. 2, 2019) (precedential).

Patent Owner argues there is a “significant relationship” between Petitioner and Facebook because both “were sued for infringing the ’755 patent” and because Petitioner copied Facebook’s petition. Prelim. Resp. 14–17 (citing *Valve*, Paper 11 at 2, 9–10).

We do not agree. In *Valve*, the Board noted that “Valve and HTC were co-defendants in the District Court litigation and were accused of infringing the [challenged] patent based on HTC’s VIVE devices that incorporate technology licensed from Valve.” *Valve*, Paper 11 at 10. Based on those particular facts, the Board determined that there was “a significant relationship between Valve and HTC with respect to Patent Owner’s assertion of the [challenged] patent.” *Id.*

Nothing in the record before us indicates any such relationship between Petitioner and Facebook. Rather, Petitioner and Facebook are individual entities among numerous entities that Patent Owner has sued for allegedly infringing the ’755 patent. *See* Paper 5, 1–3 (listing lawsuits involving the ’755 patent filed by Patent Owner).

We also do not agree with Patent Owner’s assertion that Petitioner’s copying of the petition from the Facebook IPR created a “significant relationship” between Petitioner and Facebook. *See* Prelim. Resp. 14–15 (citing *Ericsson Inc. v. Uniloc 2017, LLC*, IPR2019-01550, Paper 8, 12 (Mar. 17, 2020); *Samsung Elecs. Co., Ltd. v. Elm 3DS Innovations, LLC*, IPR2017-01305, Paper 11, 18–19 (Oct. 17, 2017)). The Board decisions on which Patent Owner relies are not precedential and are readily distinguishable because they did not involve joinder. Copying a previously-instituted petition is common in the joinder context because it is an efficient

mechanism by which to satisfy the requirement of 35 U.S.C. § 315(c) to file a petition that “warrants the institution of an inter partes review.”

Patent Owner also argues that Petitioner is “gaming . . . the system with a time-barred petition” and should be not be allowed a “mulligan” or “a second bite at the apple.” Prelim. Resp. 2 (citing *Uniloc*, Paper 9).

We find Patent Owner’s reliance on *Uniloc* misplaced because that case involved a petitioner that had previously filed a petition against the challenged patent. *See Uniloc*, Paper 9 at 8 (“[T]his is the second petition Apple has filed challenging the claims of the ’088 patent.”). As discussed above, Petitioner has not previously filed a petition challenging the ’755 patent. And the statute expressly authorizes joinder of a time-barred petitions. *See* 35 U.S.C. § 315(b) (explaining that the one year bar “shall not apply to a request for joinder under subsection (c)”). Thus, we disagree with Patent Owner’s characterization of Petitioner’s filing as “gaming of the system with a time-barred petition.” Prelim. Resp. 2.

For these reasons, we find that the first *General Plastic* factor does not favor denial.

*Whether Petitioner Knew or Should
Have Known of the Prior Art*

In *Uniloc*, the panel found that the second *General Plastic* factor favored denial because “Apple ha[d] failed to set forth facts or offer an explanation concerning its knowledge, at the time it filed the first petition, of the prior art asserted in” the second petition. *Uniloc*, Paper 9 at 9.

In contrast to the situation in *Uniloc*, Petitioner claims that, prior to the Facebook IPR, it “was not aware of the majority of the prior art references, or the specific combinations, raised in the grounds” (Reply 4) and there is no evidence to rebut that assertion.

We thus find that the second *General Plastic* factor does not favor denial.

Whether the Petitioner Had Received the Preliminary Response to the First Petition or the Board's Institution Decision

The third factor requires us to consider whether, at the time of the filing of this petition, Petitioner had received the preliminary response or the Board's institution decision in the first petition.

The idea is that Petitioner should not be permitted to hold back prior art or use the filings or decision in a first petition to gain an advantage in a second petition. *See General Plastic*, Paper 19 at 9 n.13. However, these concerns simply don't apply in the case of a "me too" Petition like this one, because Petitioner is not trying to leverage an earlier Petitioner for an unfair advantage. In fact, as noted above, copying a previously-instituted petition is an accepted approach in joinder cases like this one.

For these reasons, we conclude that *General Plastic* factor three does not favor denial.

The Length of and Reasons for the Time that Elapsed from Learning of the Prior Art to the Filing of the Petition

The fourth and fifth *General Plastic* factors "assess and weigh whether a petitioner should have or could have raised the new challenges earlier." *General Plastic*, Paper 19 at 18. In *Uniloc*, the panel determined that the petitioner's lack of explanation of its knowledge of the prior art favored denial based on the fourth and fifth *General Plastic* factors. *Uniloc*, Paper 9 at 10–11.

Here, as there is no evidence that Petitioner was aware of the prior art asserted in the Petition before the Facebook IPR, the fourth and fifth *General Plastic* factors do not favor denial.

Board Resources

Patent Owner argues that the sixth *General Plastic* factor favors denial because, in case of a settlement with Facebook, this case will continue with Petitioner. Prelim. Resp. 23–25.

The question is whether joining Petitioner to the Facebook IPR would have an adverse impact on Board resources. We think not.

Although any arguments about potential settlements are speculative, we are concurrently granting joinder to the petitioner in IPR2022-00790, which means that IPR2021-01455 would still proceed should Facebook settle. And, in any event, we find that “board resources” are not a concern here because this panel has the capacity to see the Facebook IPR to its conclusion regardless of the constitution of the Petitioner.

For these reasons, we conclude that the sixth *General Plastic* factor does not favor denial.

*The Need to Issue a Final Determination
Within a Year of Institution*

The seventh *General Plastic* factor does not favor discretionary denial because Petitioner merely seeks to join an ongoing proceeding as an understudy, and we see no difficulty in timely issuing a final written decision in that proceeding.

* * *

As we find that no *General Plastic* factor weighs in favor of not instituting, we see no reason for a discretionary denial. We accordingly determine that the Petition warrants institution under Section 314, and turn to Petitioner’s request for joinder.

B. Whether the Motion Should Be Granted

As the moving party, Petitioner has the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b).

Petitioner argues that joinder is appropriate “because the Instant Petition is essentially a copy of the petition filed in *Facebook Inc. v. Express Mobile, Inc.*, IPR2021-01455,” and that the 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.” Mot. 1. Petitioner further “stipulates that if joinder is granted, it will cooperate with Facebook in the joined proceeding, whether at hearings, at depositions, in filings, or otherwise,” that “[j]oinder will not impact the trial schedule because the Facebook IPR proceeding is in its early stages,” and that “[j]oinder would therefore lead to an efficient resolution of the validity of the ’755 Patent.” *Id.*

Patent Owner responds that the Petitioner entities “already had a full and fair chance to file a petition (or petitions) for review of the ’755 patent” and “all passed on that opportunity, even though they were all served over 1½ years ago with complaints alleging they infringed the Patent.” Opp. 1. Patent Owner asserts that “Petitioner offers no explanation for why it could not have filed an IPR petition earlier.” Opp. 11.

Although we are sympathetic to Patent Owner’s arguments about multiple petitions filed against the ’755 patent, this is not a new challenge, because the Facebook IPR has already been instituted. And Petitioner has now confirmed that, prior to the Facebook IPR, it “was not aware of the majority of the prior art references, or the specific combinations, raised in the grounds” (Reply 4), and there is no evidence to rebut that assertion.

Patent Owner further argues that “Petitioner, although subject to a duty of candor, did not disclose to the Board, or serve on the party, any acknowledgement that it is subject to the time bar under § 315(b) unless joinder is granted,” and that “[g]ranted Petitioner’s request for joinder would also add complexity to the proceedings.” Opp. 12.

We are not persuaded that Petitioner violated its duty of candor because it is apparent from the Petition, which identified the litigations filed against the Petitioner entities (*see* Pet. 2), that they had been sued for infringement. Petitioner did not highlight the statutory bar, but it was not hidden.

We also are not persuaded by Patent Owner’s argument that granting the Motion would increase complexity. Petitioner has agreed to act as an understudy, and thus will not have a material role in this proceeding unless all other entities are terminated. Consistent with our normal practice, all Petitioning entities will speak with one voice. And although Petitioner does identify a new expert, it states that “Dr. Jeffay agrees with Dr. Madisetti’s opinions and adopts them as his own” and that “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.” Mot. 3 n.1. We understand that Dr. Jeffay will have no active role in the proceeding unless and until Facebook settles and Dr. Madisetti withdraws, in which case Dr. Jeffay will be limited to the positions previously taken by Dr. Madisetti.

Having considered the parties' arguments, we determine that it is appropriate under these circumstances to join Petitioner as a party to the Facebook IPR. Petitioner will be subject to the estoppel provisions of 35 U.S.C. § 315(e).

III. ORDER

Accordingly, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a) and 37 C.F.R. § 42.4, an *inter partes* review is hereby instituted on the challenges raised in the Petition;

FURTHER ORDERED that Petitioner's Motion for Joinder with Case IPR2021-01455 is *granted*, and Petitioner is hereby joined as a petitioner in Case IPR2021-01455;

FURTHER ORDERED that the grounds on which trial in Case IPR2021-01455 were instituted are unchanged, and no other grounds are added in Case IPR2021-01455;

FURTHER ORDERED that the Scheduling Order entered in Case IPR2021-01455 (Paper 12) and schedule changes agreed by the parties in Case IPR2021-01455 pursuant to the Scheduling Order shall govern the trial schedule in Case IPR2021-01455;

FURTHER ORDERED that Petitioner's role in Case IPR2021-01455 shall be limited as stated by Petitioner in the Motion for Joinder unless and until Facebook is terminated from that proceeding;

FURTHER ORDERED that the case caption in Case IPR2021-01455 shall be changed to reflect joinder of Petitioner and the petitioners in IPR2022-00790 as petitioners in accordance with the attached example;

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FURTHER ORDERED that a copy of this Decision be entered into the record of Case IPR2021-01455; and

FURTHER ORDERED that all further filings shall be made in Case IPR2021-01455.

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