

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Keysight Technologies, Inc.,

Petitioner,

v.

Centripetal Networks, Inc.,

Patent Owner.

Case IPR Unassigned

Patent No. 9,917,856

PETITIONER'S MOTION FOR JOINDER

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Petitioner Keysight Technologies (“Keysight”) respectfully moves to join its concurrently filed *inter partes* review petition involving U.S. Patent No. 9,917,856 (“the ‘856 patent”) with the *inter partes* review that Palo Alto Networks (“PAN”) requested for the same patent in *Palo Alto Networks, Inc. v. Centripetal Networks, Inc.*, IPR2022-00182 (“the PAN IPR”). The Board instituted trial in the PAN IPR on May 25, 2022. IPR2020-00185, Paper 11. This motion is therefore timely. 37 C.F.R. § 42.122(b); *Central Security Group – Nationwide, Inc. v. Ubiquitous Connectivity, LP*, IPR2019-01609, Paper 11, at 8-9 (P.T.A.B. Feb. 26, 2020) (stating that § 42.122(b) is “[t]he only timing requirement for a motion for joinder”). Keysight understands that PAN does not oppose Petitioner’s request for joinder.

Keysight presents substantively identical patentability challenges in its petition and supporting expert declaration as those presented in the PAN IPR. Keysight’s petition therefore warrants institution, and joinder would not affect the PAN IPR trial schedule or require additional Board or party resources to adjudicate. Joinder would therefore lead to an efficient resolution of the validity of the ‘856 patent.

Counsel for Keysight and counsel for PAN conferred as to the cooperation between PAN and Keysight that will be maintained if Keysight’s motion for

joinder is granted. Keysight stipulates that if joinder is granted, it will cooperate with PAN in the joined proceeding, whether at hearings, at depositions, in filings, or otherwise, as outlined below. Unless PAN is terminated from the proceedings, Keysight will proceed in a limited “understudy” role. Joinder will not impact the trial schedule because the PAN IPR is in its early stages and joinder will not add any new grounds of unpatentability.

The Board has granted joinder in other proceedings when presented with this fact pattern and procedural history. For example, in *Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11 (P.T.A.B. Oct. 30, 2018), the petitioner, Celltrion, filed a petition with a motion for joinder to Pfizer’s pending petition IPR2017- 01923. *Id.* at 13. Celltrion had agreed to take an understudy role to Pfizer and no deadlines in the original IPR were changed. *Id.* at 14. The Board therefore granted joinder, finding that doing so did not increase the burden on either the patent owner or the Board, and the timing of petition supported joinder. *Id.* The Board reached the same conclusion in *Pfizer, Inc. v. Genentech, Inc.*, IPR2017-02063, Paper 25 (P.T.A.B. Feb. 21, 2018), where Pfizer took an “understudy” role to an earlier filed Celltrion petition.

Accordingly, Keysight’s IPR should be instituted and joined with the proceedings in the ongoing and already-instituted PAN IPR.

II. BACKGROUND AND RELATED PROCEEDINGS

The ‘856 patent issued on March 13, 2018 and is assigned to Centripetal Networks, Inc. (“Centripetal”). In 2017, Centripetal sued Keysight asserting multiple patents, but not the ‘856 patent. *Centripetal Networks, Inc. v. Keysight Technologies, Inc. et al.*, Case No. 2:17-cv-00383, Dkt. 1 (E.D. Va. Jul. 20, 2017). In June 2018, Centripetal filed an amended complaint in that action alleging infringement of the ‘856 patent. *Id.*, Dkt. 192 (E.D. Va. Jun. 13, 2018). That case proceeded to trial in October 2018. The parties reached a settlement agreement mid-trial and stipulated to dismissal of all claims. *Id.*, Dkt. 589 (E.D. Va. Oct. 11, 2018). The jury in that trial was not asked to assess the validity of the ‘856 patent.

On November 18, 2021, PAN filed a petition for *inter partes* review of the ‘856 patent. *See* IPR2022-00182, Paper 2. The Board instituted trial in the PAN IPR on May 25, 2022. *Id.*, Paper 11. Keysight now files this motion concurrently with a petition for *inter partes* review of the ‘856 patent. Keysight has not filed any other petitions for *inter partes* review of the ‘856 patent.

III. ARGUMENT

The Board may join any person who properly files a petition for *inter partes* review to a separate IPR proceeding. 35 U.S.C. § 315(c). A motion for joinder should “(1) set forth the reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address

specifically how briefing and discovery may be simplified.” *Macronix Int’l Co., Ltd. v. Spansion LLC*, IPR2014-00898, Paper 15 at 4 (P.T.A.B. Aug. 13, 2014) (citing *Kyocera Corp. v. SoftView LLC*, IPR2013-00004, Paper 15 at 4 (P.T.A.B. Apr. 24, 2013)).

Keysight’s motion is timely, and the Board should grant joinder because consideration of the foregoing factors weighs in favor of joinder.

A. Keysight’s Motion for Joinder Is Timely

Joinder may be requested “no later than one month after the institution date of any *inter partes* review for which joinder is requested.” 37 C.F.R. § 42.122(b). The Board instituted the PAN IPR on May 25, 2022, and this joinder motion is filed within one month of that institution. Accordingly, Keysight’s motion is timely. *Central Security Group – Nationwide, Inc. v. Ubiquitous Connectivity, LP*, IPR2019-01609, Paper 11, at 8-9 (P.T.A.B. Feb. 26, 2020) (§ 42.122(b) is “[t]he only timing requirement for a motion for joinder”).

B. The Kyocera Factors Weigh in Favor of Joinder

Each of the four factors that the Board considers in motions for joinder favor granting of Keysight’s motion.

1. Joinder is Warranted Because It Will Promote an Efficient Determination of the Validity of the ‘856 Patent Without Undue Prejudice to Any Party

Keysight’s Petition challenges the validity of the same claims of the ‘856 patent on identical grounds to those in the PAN IPR. There are no substantive

differences between PAN's and Keysight's Petitions. *See Palo Alto Networks*, IPR2022-00182, Paper 2 (November 18, 2021). Keysight also relies on substantially the same supporting evidence in its Petition as is relied on in the PAN Petition.¹ A consolidated proceeding including both PAN and Keysight will therefore be efficient, as only a single trial on these common grounds would be required.

¹ Keysight submits a “copycat” declaration from Dr. Doug W. Jacobson, on whom Keysight will rely only in the event that PAN is terminated from the proceedings. The supporting declaration submitted by Keysight differs from that filed by PAN (from Dr. Jon Weissman) in that it has been updated to list the qualifications and personal experience of Dr. Jacobson. The opinions in Dr. Jacobson's declaration are substantively identical to those in Dr. Weissman's declaration filed in the PAN IPR, and Dr. Jacobson's discussion of the prior art and his analysis is the same as the analysis of PAN's expert. *See Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11 at 14 (P.T.A.B. Oct. 30, 2018) (granting motion for joinder of petitioner who “relie[d] on different experts” when the petitioner “assert[ed] that its ‘copycat declarations’ provide a discussion and analysis that ‘is substantially the same as the analysis of Pfizer's experts’ and will not be relied upon unless [the original petitioner] is terminated from the proceedings.”).

Joining Keysight as a party to the PAN IPR also would not materially prejudice either Centripetal or PAN. Centripetal must respond to the common invalidity grounds identified in PAN's and Keysight's Petitions regardless of joinder. Thus, Patent Owner bears no additional burden. For both Patent Owner and PAN, Keysight's Petition has been filed sufficiently early so that joinder would affect neither the schedule of the *inter partes* review, nor the costs associated with a full trial.

Accordingly, this factor favors joinder.

2. Keysight's Petition Does Not Add Complexity to the Grounds in PAN's Petition

Keysight's validity challenges are identical to those in the PAN IPR. *See Palo Alto Networks*, IPR2022-00182, Paper 2 (November 18, 2021). Keysight's supporting materials, including its supporting expert declaration, are also substantially the same as those presented by PAN. *See, supra*, n.1. Therefore, consolidation of this proceeding with PAN's via joinder of Keysight's Petition will not raise any new issues of unpatentability and will not impose any additional burden on the Board or add complexity to the case. The Board has granted joinder in similar situations. *See, e.g., Hyundai Motor Co. v. Am Vehicular Scis. LLC*, IPR2014-01543, Paper 11 at 2-4 (PTAB Oct. 24, 2014); *Sony Corp. of Am. v. Network-1 Sec Solutions, Inc.*, IPR2013-00495, Paper 13 at 5- 9 (PTAB Sept. 16, 2013); *Dell Inc. v. Network-1 Solutions, Inc.*, IPR2013-00385, Paper 17 at 6-10

(PTAB July 29, 2013); *Motorola Mobility*, IPR2013-00256, Paper 10 at 4-10 (PTAB June 20, 2013).

Accordingly, this factor also favors joinder.

3. Joinder Would Not Affect the Schedule in the PAN IPR

Joinder of Keysight would not affect the schedule in the forthcoming PAN IPR trial. Joining Keysight will not add procedural complications or delay the PAN IPR because it will not introduce new prior art, new expert opinions, or new grounds of unpatentability into the PAN IPR. Keysight's participation would result in no changes to the schedule or undue prejudice to the Patent Owner.

Accordingly, this factor favors joinder.

4. Keysight Will Take an Understudy Role

To further prevent joinder from imposing any additional burden on the parties or the Board and to further ensure that there are no changes in the trial schedule, Keysight agrees, as long as PAN remains a party to the review, to (1) coordinate any communications with PAN's expert through PAN's counsel; (2) not produce its own testifying witnesses; and (3) not file substantive papers (except, if applicable, for those associated with Board-approved motions that do

not affect PAN or PAN's position).² Keysight also will cooperate with PAN on the consolidated filings but, as long as PAN is a party to the review, PAN will make all final decisions and will retain responsibility for oral argument (including telephone hearings and appeals). Keysight will not seek or receive separate time and will not separately argue during oral argument, including telephone hearings and appeals, except when addressing Board-approved motions that do not affect PAN or PAN's position.

Keysight also will coordinate the discovery and testimony relating to witnesses with PAN but, as long as PAN is a party to the review, PAN will make all final decisions. In particular, as long as PAN is a party to the review, Keysight will not separately file or serve objections or discovery requests, will not receive separate cross examination or redirect time, will not separately cross examine or redirect any witness, and agrees that cross examinations will occur within the

² If Centripetal and PAN settle and move to terminate the PAN IPR, the Board should resolve this motion for joinder prior to acting on any motion to terminate. *See AT&T Servs., Inc. v. Convergent Media Solutions, LLC*, IPR2017-01237, Paper 11 at 26-28 (PTAB May 10, 2017); *Qualcomm Inc. v. Bandspeed, Inc.*, IPR2015-01577, Paper 12 at 2-3, 6, 8 (PTAB Nov. 16, 2015); *Nintendo of Am., Inc. v. Babbage Holdings, LLC*, IPR2015-00568, Paper 12 at 4-5 (PTAB Mar. 18, 2015).

timeframe normally allotted to one party without a need for extension in light of the joinder.

Thus, for briefing and document submissions, as long as PAN remains a party to the *inter partes* review, the Board may order petitioners to consolidate filings such that PAN would submit papers on behalf of petitioners and Keysight would not be allowed additional filings. Moreover, for depositions, no adjustments to the schedule would be required and, indeed, no additional depositions would be necessary. Keysight will not rely on expert testimony beyond that submitted by PAN unless PAN is terminated from the case prior to any necessary depositions. Thus, Dr. Jacobson would not be relied on if PAN's expert remains available. Absent termination of PAN from the proceedings, Keysight will participate only in a secondary "understudy" role. However, if PAN is no longer a party, Keysight will be free to rely on the opinions and testimony of Dr. Weissman, and other declarants for PAN that are already of record.

As a result of the foregoing, by consolidating filings with PAN, Patent Owner will only need to respond to one principal set of papers. No further time to address additional arguments will be required by any party, and the consolidated trial can thus proceed at the same pace as if Keysight was not joined. *Torrent Pharm Ltd, v. UCB Pharma GMBH*, IPR2016-01636, Paper 10 at 5 (PTAB Dec. 7, 2016); *Amerigen Pharm Ltd, v. UCB Pharma GMBH*, IPR2016-01665, Paper 8

at 6 (PTAB Dec. 7, 2016).

Accordingly, this factor favors joinder.

C. No Basis for Discretionary Denial Exists

The *General Plastic* factors are irrelevant to Keysight’s IPR petition and this motion for joinder. *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i) (“*General Plastic*”). This is Keysight’s first petition for IPR of the ‘856 patent; this is not a follow-on petition after the Board’s denial of an earlier petition subject to the *General Plastic* factors. Keysight has no relevant relationship to PAN or Cisco and did not collaborate with either party to support their challenges of the validity of the ‘856 patent.³ There can be no concern that

³ Centripetal asserted the ‘856 patent against Cisco in *Centripetal Networks, Inc. v. Cisco Systems, Inc.*, Case No. 2:18-cv-00094 (E.D. Va.). After a bench trial the district court held that claims 24 and 25 were infringed by Cisco, but the Federal Circuit vacated that holding on appeal and remanded the case for further proceedings before a different district court judge. *Centripetal Networks, Inc. v. Cisco Systems, Inc.*, Case 21-1888, slip op. at 2-3 (Fed. Cir. Jun. 23, 2022), available at https://cafc.uscourts.gov/opinions-orders/21-1888.OPINION.6-23-2022_1968538.pdf.

Keysight is trying to abuse the system with serially-asserted prior art since Keysight asserts *the same* invalidity grounds as in the PAN IPR and seeks joinder *to assume an understudy role*. Further, the “roadmapping” concern under *General Plastic* is irrelevant since this is a petition for joinder and Keysight’s IPR petition made no substantive changes from PAN’s IPR petition based on Centipetal’s preliminary response or the Board’s institution decision. *Intel Corporation v. VLSI Tech. LLC*, IPR2022-00479, Paper 13 at 10-11 (PTAB Jun. 6, 2022) (finding “roadmapping” concern not present in joinder petition and granting joinder). Factors regarding the Board’s finite resources and ability to issue a final written decision within one year likewise weigh against discretionary denial here, since the Board will already be dedicating the same resources in the PAN IPR and joinder will not necessitate any scheduling changes. Allowing Keysight to join the identical PAN IPR therefore best balances the desires to improve patent quality and patent-system efficiency against the potential for abuses of the review process.

The *Fintiv* factors likewise do not favor discretionary denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). The validity of the ‘856 patent was not presented to the jury in the prior litigation between Centripetal and Keysight, so there is no overlap and “no chance of an inconsistent outcome.” *Intel*, IPR2022-00479, Paper 13 at

6.⁴ Since January 1, 2022, Centripetal has sued Keysight in both district court and the ITC alleging patent infringement. *Centripetal Networks, Inc. v. Keysight Technologies, Inc.*, Civ. No. 2-22-cv-00002 (E.D. Va., filed Jan. 1, 2022) and *Certain Computer Network Security Equipment and Systems, Related Software, Components Thereof, and Products Containing Same*, Inv. No. 337-TA-1314 (ITC, filed Apr. 19, 2022). Those pending suits, however, do not involve the ‘856 patent and therefore do not support discretionary denial. Because the issue of the invalidity of the ‘856 patent on the grounds set forth in this IPR were not addressed in the prior litigation and will not be addressed in the pending litigation, *Fintiv* weighs against discretionary denial.

Moreover, the Board found in its PAN IPR institution decision that “the merits of Petitioner’s challenge to the ‘856 patent seem ‘particularly strong.’” IPR2022-00182, paper 11 at 30. The “compelling merits” of this challenge therefore make discretionary denial improper. *See* June 21, 2022 Interim Procedure For Discretionary Denials in AIA Post-Grant Proceedings With Parallel

⁴ While a subset of the challenged claims were at issue in the Cisco trial, the Federal Circuit vacated the holdings from that trial and no schedule has been set for the proceedings on remand. *Centripetal Networks, Inc. v. Cisco Systems, Inc.*, Case No. 2021-1888, slip op. at 2-3.

District Court Litigation, available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

Further, Keysight has a legitimate interest in challenging this patent because Centripetal *has accused* Keysight of infringing this patent. Centripetal has even asserted it against Keysight in a prior lawsuit. Centripetal has also filed new lawsuits in 2022 in district court and the ITC asserting several of its patents against Keysight. The IPR process was created to help improve patent quality, and Keysight should be able to avail itself of the IPR process to protect itself against a potential future reassertion of claims that should be invalidated.

D. The Board Has Granted Joinder under Similar Circumstances, Finding No Undue Burden or Prejudice

The Board has granted joinder in other petitions, with facts like those here. *See, e.g., Teva Pharms. USA, Inc. v. Allergan, Inc.*, IPR2017-00579, Paper 9 at 4-5 (Mar. 31, 2017) (granting joinder of substantively identical petition that would otherwise be time-barred where petitioner agreed to assume an ‘understudy’ role); *Apple Inc. v. VirnetX Inc.*, IPR2016-00062, Paper 14 at 3-6 (Sept. 9, 2016) (granting joinder of otherwise time-barred petition). Keysight has agreed to take an understudy role and no deadlines in the PAN IPR will be affected. Therefore, the Board should institute IPR and grant joinder.

IV. CONCLUSION

For the foregoing reasons, Keysight respectfully requests that the Board grant its concurrently filed Petition for *inter partes* review of the '856 patent and join the grounds of invalidity therein raised with PAN IPR2022-00182.

Dated: June 24, 2022

Respectfully submitted,

/Gerard M. Donovan/

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Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that true copies of the foregoing Motion for Joinder has been served this 24th day of June, 2022, by FedEx® mail delivery service on Patent Owner at the correspondence address for the attorney of record for the '856 Patent shown in USPTO PAIR:

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Dated: June 24, 2022

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