

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AO KASPERSKY LAB,
Petitioner

v.

WEBROOT, INC.,
Patent Owner.

IPR2023-01011
U.S. Patent 10,257,224 B2

Before GREGG I. ANDERSON, MICHELLE N. WORMMEESTER,
and AARON W. MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION

Instituting Inter Partes Review
35 U.S.C. § 314
Granting Petitioner's Motion for Joinder
37 C.F.R. § 42.122(b)

I. INTRODUCTION

AO Kaspersky Lab (“Petitioner”) filed a Petition (Paper 1, “Pet.”) for institution of an *inter partes* review of claims 1–4, 7, 8, 10–13, and 16–19 of U.S. Patent 10,257,224 B2 (Ex. 1001, the “’224 patent”). Petitioner also filed a Motion for Joinder to instituted *inter partes* review IPR2023-00126 (“the ’00126 IPR”). Paper 2 (“Motion”). Patent Owner did not file an opposition to the Motion, but did file a Preliminary Response. *See* Paper 7 (“Prelim. Resp.”).

We have authority under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

For the reasons described below, we institute an *inter partes* review of the challenged claims and grant the Motion.

II. INSTITUTION OF INTER PARTES REVIEW

In the ’00126 IPR, we instituted an *inter partes* review of the challenged claims under 35 U.S.C. § 103, on the following grounds:

Reference(s)	Basis	Claims
Morris ¹	§ 103(a)	1–2, 4, 8, 10–13, 17
Morris and Van Oorschot ²	§ 103(a)	3, 17
Capalik ³	§ 103(a)	1–2, 4, 7, 8, 10–13, 16–19

¹ U.S. Patent Publication No. 2007/0016953 A1 (Ex. 1005).

² U.S. Patent No. 8,087,087 B1 (Ex. 1006).

³ U.S. Patent Publication No. 2011/0321166 A1 (Ex. 1008).

Reference(s)	Basis	Claims
Capalik and Van Oorschot	§ 103(a)	3, 17

Petitioner states that the instant petition is “essentially a copy” of the ’00126 IPR and “includes the identical grounds presented” in the ’00126 IPR. Motion 1. A comparison of the Petitions confirms that to be the case.

The Preliminary Response “opposes institution of *inter partes* review in this proceeding for the same reasons addressed in Patent Owner’s Preliminary Response in the [’00126 IPR].” Prelim. Resp. 1. We have already found those arguments insufficient to avoid institution.

Thus, for the same reasons set forth in the institution decision in the ’00126 IPR, we determine that the information presented in the Petition shows a reasonable likelihood that Petitioner will prevail in showing that the challenged claims would have been obvious. Accordingly, we institute an *inter partes* review on the same grounds upon which we instituted review in the ’00126 IPR.

III. GRANT OF MOTION FOR JOINDER

The ’00126 IPR was instituted on May 5, 2023 and Petitioner filed the Motion on June 2, 2023. The Motion is thus timely because joinder was requested no later than one month after institution of the ’00126 IPR. *See* 37 C.F.R. § 42.122(b).

The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads:

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.

A motion for joinder should (1) set forth 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. *See Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, 4 (PTAB Apr. 24, 2013) (Paper 15).

As noted, the Petition asserts the same unpatentability grounds upon which we instituted review in the '00126 IPR, relying on the same evidence. *See* Motion 1. If joinder is granted, Petitioner agrees to assume an “understudy” role and states that “[u]nless and until the current petitioners in IPR2023-00126 cease to participate,” Petitioner “will not assume an active role.” *See id.* at 7–9. Petitioner also explains that “[n]o 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 [Petitioner]’s joinder.” *Id.* at 9. Petitioner further “agrees to adhere to all applicable deadlines set forth in the [’00126 IPR] Scheduling Order.” *Id.* at 7.

Because Patent Owner has not opposed the Motion, and because we agree with Petitioner that joinder with the '00126 IPR is appropriate under these circumstances, we grant the Motion.

IV. ORDER

For the reasons given, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–4, 7, 8, 10–13, and 16–19 of the '224 patent is instituted in IPR2023-01011;

FURTHER ORDERED that the Motion is granted, and that AO Kaspersky Lab is joined as a petitioner in IPR2023-00126;

FURTHER ORDERED that, subsequent to joinder, the grounds for trial in IPR2023-00126 remain unchanged and the Scheduling Order in place for IPR2023-00126 remains unchanged;

FURTHER ORDERED that the Petitioner in IPR2023-00126 (i.e., Trend Micro, Inc. and AO Kaspersky Lab) will file all papers in IPR2023-00126 as a single, consolidated filing, subject to the page limits set forth in 37 C.F.R. § 42.24;

FURTHER ORDERED that, for any consolidated filing, if AO Kaspersky Lab wishes to file an additional paper to address points of disagreement with the other Petitioner, AO Kaspersky Lab must request authorization from the Board to file a motion for additional pages, and no additional paper may be filed unless the Board grants such a motion;

FURTHER ORDERED that the case caption in IPR2023-00126 shall be changed to reflect joinder of AO Kaspersky Lab as a Petitioner; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2023-00126.

Case IPR2023-01011
U.S. Patent 10,257,224 B2

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