UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.,
Petitioner,

v.

CENTRIPETAL NETWORKS, LLC,
Patent Owner.

Case IPR2023-01353
Patent No. 10,567,343

MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c) AND 37 C.F.R. §§ 42.22 AND 42.122(b) TO *INTER PARTES* REVIEW IPR2023-00446

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I. PRELIMINARY STATEMENT

Palo Alto Networks, Inc. ("PAN" or "Petitioner") respectfully submits this Motion for Joinder, together with a Petition for *Inter Partes* Review of U.S. Patent No. 10,567,343 ("PAN Petition"), filed contemporaneously herewith. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner requests institution of an *inter partes* review and joinder with the *inter partes* review in *Keysight Technologies, Inc. v. Centripetal Networks, Inc.*, IPR2023-00446 ("Keysight IPR") filed by Keysight Technologies, Inc. ("Keysight"), which was instituted by the Patent Trial and Appeal Board ("Board") on August 7, 2023. Petitioner's Motion for Joinder is timely under 37 C.F.R. § 42.22 and 42.122(b) as it is submitted no later than one month after the institution date of the Keysight IPR. The PAN Petition is also narrowly tailored to the same claims, prior art, and grounds for unpatentability that are the subject of the Keysight IPR.

Petitioner submits that joinder is appropriate because it will not unduly burden or prejudice the parties to the Keysight IPR while efficiently resolving the question of the validity of U.S. Patent No. 10,567,343 ("'343 patent") in a single proceeding.

II. STATEMENT OF MATERIAL FACTS

1. Centripetal Networks, LLC (fka Centripetal Networks, Inc.) ("Centripetal" or "Patent Owner") filed civil actions against numerous companies, as explained in Section II.B. of the PAN Petition. Those companies included

Petitioner (*Centripetal Networks, Inc. v. Palo Alto Networks, Inc.*, Case No. 2:21-cv-00137-RCY-RJK (E.D. Va.)) and Keysight (*Centripetal Networks, Inc. v. Keysight Technologies, Inc.*, Civ. No. 2-22-cv-00002 (E.D. Va.)).

2. On January 6, 2023, Keysight filed a petition for *inter partes* review (IPR2023-00446) requesting cancellation of claims 1-20 of the ’343 patent.

3. On August 7, 2023, the Board instituted Keysight’s Petition in IPR2023-00446, finding a reasonable likelihood existed that Keysight’s Petition for *inter partes* review would prevail in showing the unpatentability of claims of the ’343 patent. *See* IPR2023-00446, Decision Granting Institution of *Inter Partes* Review, Paper No. 9 (Aug. 7, 2023).

4. On September 5, 2023, contemporaneously with this Motion, PAN filed its Petition for *inter partes* review (IPR2023-01353) requesting cancellation of claims 1-20 of the ’343 patent, which is substantively identical to Keysight’s IPR.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Board has the authority under 35 U.S.C. § 315(c) to join a properly filed *inter partes* review petition to an instituted *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). A motion for joinder must be filed within one month of the Board instituting an original *inter partes* review. 37 C.F.R. § 42.122(b). “To join a party to an instituted [*inter partes* review (IPR)], the plain language of § 315(c) requires

two different decisions. First, the statute requires that the Director (or the Board acting through a delegation of authority) ... determine whether the joinder applicant's petition for IPR 'warrants' institution under § 314. ... Second, to effect joinder, § 315(c) requires the Director to exercise his discretion to decide whether to 'join as a party' the joinder applicant." *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020).

Under the first step, the Board analyzes the merits of the petition and whether it should exercise its discretion to deny institution. *See, e.g.*, *AT&T Servs., Inc. v. Broadband iTV, Inc.*, IPR2021-00556, Paper No. 14 (Aug. 25, 2021). Under the second step, the Board considers factors, including: (1) the reasons why joinder is appropriate; (2) whether the new petition presents any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper No. 15 at 4 (Apr. 24, 2013).

B. Petitioner's Motion for Joinder is Timely

This Motion for Joinder is timely because it is filed within one month of the August 7, 2023 institution decision of the Keysight IPR. *See* 37 C.F.R. § 42.122(b).

C. The Board Should Not Exercise Its Discretion Under § 314(a)

As explained in the PAN Petition (*see* PAN Petition at Section § V.D), the Board should not exercise its discretion to deny this Petition. Additionally, the Keysight IPR was instituted and is substantively identical to the PAN IPR.

D. Each Factor Weighs in Favor of Joinder

Each of the four factors considered by the Board weighs in favor of joinder here. Specifically, the PAN Petition does not present any new grounds of unpatentability; rather it is substantively identical to the Keysight Petition. Further, joinder will have minimal, if any, impact on the trial schedule, as all issues are substantively identical and Petitioner will accept an "understudy" role. *See, e.g.*, *Apple Inc. v. INVT SPE LLC*, IPR2019-00958, Paper 9 at 5-8 (May 30, 2019) (granting IPR where petitioners requested an "understudy" role); *Sony Corp. v. Memory Integrity, LLC*, IPR2015-01353, Paper 11 at 6 (Oct. 15, 2015); *Google LLC v. Express Mobile, Inc.*, IPR2022-00789, Paper 15 at 7-8 (Oct. 5, 2022). Lastly, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

Accordingly, joinder is appropriate here. *See, e.g.*, *Apple*, IPR2019-00958, Paper 9 at 5-8; *Sony*, IPR2015-01353, Paper 11 at 5-6 (granting institution of IPR and motion for joinder where petitioners relied "on the same prior art, same arguments, and same evidence, including the same expert and a substantively

identical declaration"); *Google*, IPR2022-00789, Paper 15 at 15 (granting institution and motion for joinder).

1. Joinder Is Appropriate with the Keysight IPR

Joinder with the Keysight IPR is appropriate because the PAN Petition involves the same patent, challenges the same claims, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the Keysight Petition. *Id.* The PAN Petition is substantively identical to the Keysight Petition with only non-substantive modifications specific to the formalities of a different party filing the petition as well as an explanation that the Board should not exercise its discretion to deny PAN's petition.

Because these proceedings are substantively identical, good cause exists for joining this proceeding with the Keysight IPR so that the Board can efficiently resolve all grounds in both the PAN and Keysight Petitions in a single proceeding. *Id.*

2. Petitioner Proposes No New Grounds of Unpatentability

The PAN Petition does not present any new grounds of unpatentability and is substantively identical to the Keysight Petition. The PAN Petition presents the unpatentability of the same claims of the same patent on the same grounds as the Keysight Petition.

3. Joinder Will Not Unduly Burden or Negatively Impact the Keysight IPR Trial Schedule

Because the PAN Petition is substantively identical to the Keysight Petition, with the same grounds challenging the same claims as instituted by the Board, there are no new issues for Patent Owner to address. Due to the same issues presented in the Keysight Petition, Patent Owner will not be required to present any additional responses or arguments. *See Apple*, IPR2019-00958, Paper 9 at 8 (holding "joinder is appropriate in these circumstances because joinder will not unduly burden the parties to the [first] IPR while efficiently resolving the question of unpatentability of" the challenged claims); *Sony*, IPR2015-01353, Paper 11 at 6 (granting IPR and motion for joinder where "joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]"). Further, the Patent Owner Preliminary Response already filed in the Keysight IPR addresses any and all issues in the PAN Petition, since the issues are substantively identical to the issues of the PAN Petition. *See* Keysight IPR, IPR2023-00446, Paper 6.

The Patent Owner Response will also not be negatively impacted because the issues presented in the Keysight Petition are identical to the issues presented in the PAN Petition. Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in responding to the Keysight

Petition. Also, because the PAN Petition relies on the same experts and identical declarations, only a single deposition of each expert is needed for the proposed joined proceeding.

Joinder of this proceeding with the Keysight IPR does not unduly burden or negatively impact the trial schedule in any meaningful way. Further, even if a small adjustment of the trial schedule were necessary, this is already provided for in the rules and is a routine undertaking by parties in IPR proceedings. *See* 37 C.F.R. § 42.100(c). Thus, a slight adjustment in the trial schedule, should one be needed, is not enough of a reason to deny joining the present PAN Petition with the Keysight IPR.

4. Procedures to Simplify Briefing and Discovery

The Keysight Petition and PAN Petition present substantively identical grounds of rejection, including the same art combinations against the same claims. Additionally, Petitioner explicitly agrees to take an "understudy" role, as described by the Board:

> (a) all filings by [PAN] in the joined proceeding be consolidated with [the filings of the petitioner in the Keysight IPR], unless a filing solely concerns issues that do not involve [the petitioner in the Keysight IPR]; (b) [PAN] shall not be permitted to raise any new grounds not already instituted by the Board in the [Keysight IPR], or

> introduce any argument or discovery not already introduced by [the petitioner in the Keysight IPR]; (c) [PAN] shall be bound by any agreement between [Patent Owner] and [the petitioner in the Keysight IPR] concerning discovery and/or depositions; and (d) [PAN] at deposition shall not receive any direct, cross-examination or redirect time beyond that permitted for [the petitioner in the Keysight IPR] alone under either 37 C.F.R. § 42.53 or any agreement between [Patent Owner] and [the petitioner in the Keysight IPR].

See Noven Pharms., Inc. v. Novartis AG, IPR2014-00550, Paper 38 at 5 (PTAB Apr. 10, 2015) (emphasis in original). Petitioner PAN will assume the primary role only if Keysight ceases to participate in the Keysight IPR.

By Petitioner accepting an "understudy" role, Patent Owner and PAN can comply with the current trial schedule and avoid any duplicative efforts by the Board or the Patent Owner. These steps will minimize any potential complications or delay that potentially may result by joinder. *See Apple*, IPR2019-00958, Paper 9 at 5-8; *Sony*, IPR2015-01353, Paper 11 at 6-7 (granting IPR and motion for joinder because "joinder would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board" where petitioners agreed to an "understudy" role).

IV. CONCLUSION

Based on the factors discussed above, Petitioner PAN respectfully requests that the Board institute the PAN Petition for *Inter Partes* Review of U.S. Patent No. 10,567,343 and grant joinder with the instituted *Keysight Technologies, Inc. v. Centripetal Networks, Inc.*, IPR2023-00446 proceeding.

Respectfully submitted,

Dated: September 5, 2023

By: /*James L. Davis, Jr.*/
James L. Davis, Jr.
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Counsel for Petitioner
Palo Alto Networks, Inc.

CERTIFICATE OF SERVICE

The undersigned certifies service on Patent Owner by Priority Mail Express of a copy of this MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c) AND 37 C.F.R. §§ 42.22 AND 42.122(b) TO *INTER PARTES* REVIEW IPR2023-00446 at the correspondence address of record for the ’343 patent:

22907 - BANNER & WITCOFF, LTD.
1100 13th STREET, N.W.
SUITE 1200
WASHINGTON, DC 20005-4051

A courtesy copy was also sent via electronic mail to the Patent Owner’s litigation counsel and counsel in IPR2023-00446 at the following addresses:

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