UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CROWDSTRIKE, INC.,
Petitioner

v.

TAASERA LICENSING LLC,
Patent Owner

Inter Partes Review Case No. IPR2023-01466
U.S. Patent No. 9,092,616

MOTION FOR JOINDER UNDER
35 U.S.C. § 325(c) AND 37 C.F.R. § 42.222(b)
TO RELATED *INTER PARTES* REVIEW IPR2023-00799

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

CrowdStrike, Inc. ("Petitioner") respectfully submits this Motion for Joinder, together with a Petition for *Inter Partes* Review of U.S. Patent No. 9,092,616 ("the CrowdStrike 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 *Trend Micro, Inc. v. Taasera Licensing LLC,* IPR2023-00799 ("the Trend Micro IPR") after the Patent Trial and Appeal Board (the "Board") institutes the Trend Micro IPR. Petitioner's request for joinder is timely under 37 C.F.R. §§ 42.22 and 42.122(b), having been submitted prior to institution of the Trend Micro IPR. The CrowdStrike Petition is also narrowly tailored to the same claims, prior art, and grounds for unpatentability that are the subject of the Trend Micro IPR. In addition, Petitioner is willing to streamline discovery and briefing.

Petitioner submits that joinder is appropriate because it will not unduly burden or prejudice the parties to the Trend Micro IPR while efficiently resolving the question of the '517 Patent's validity in a single proceeding.

II. STATEMENT OF MATERIAL FACTS

1. On April 5, 2023, Trend Micro, Inc. filed a petition for *inter partes* review (IPR2023-00799) requesting cancellation of claims 1-7 of the '616 Patent.

III. STATEMENT OF THE PRECISE 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). In deciding whether to exercise its discretion and permit joinder, 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. *Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (April 24, 2013).

B. Petitioner's Motion for Joinder is Timely

This Motion for Joinder is timely because it is filed before any institution decision of the Trend Micro IPR. 37 C.F.R. § 42.122(b). Further, although the one-year bar set forth in 37 C.F.R. § 42.101(b) does not apply to the CrowdStrike Petition, CrowdStrike's one-year statutory deadline has not yet passed. 37 C.F.R. § 42.122(b).

C. Each Factor Weighs in Favor ofJoinder

Each of the four factors considered by the Board weighs in favor of joinder here. Specifically, the CrowdStrike Petition does not present any new grounds of

unpatentability; rather it is substantively identical to the Trend Micro 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* IPR2015-01353, Decision Instituting IPR Review, Motion for Joinder, paper 11 at 6; (granting IPR where petitioners requested an "understudy" role); *see also* IPR2015-01353, Motion for Joinder, paper 4 at 5-7. Lastly, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

Accordingly, joinder is appropriate. *See* IPR2015-01353, Decision Instituting IPR Review, Motion for Joinder, 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."); *see also* IPR2015-01353, Motion for Joinder, paper 4 at 4-5.

1. Joinder is Appropriate

Joinder with the Trend Micro IPR is appropriate because the CrowdStrike 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 Trend Micro Petition. *Id.* The CrowdStrike Petition is substantively identical to the Trend Micro Petition, containing only minor differences related to formalities of a different party filing the petition. There are no changes to the facts, citations, evidence, or arguments presented in the Trend Micro Petition. Because

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

2. Petitioner Proposes No New Grounds of Unpatentability

The CrowdStrike Petition presents the same grounds of unpatentability as the Trend Micro Petition.

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

Because the CrowdStrike Petition is substantively identical to the Trend Micro Petition, with the same grounds rejecting the same claims as instituted by the Board, there are no new substantive issues for Patent Owner to address. Due to the same issues being presented in the Trend Micro Petition, Patent Owner will not be required to present any additional responses or arguments. *See* IPR2015-01353, Decision Instituting IPR, Motion for Joinder, 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]."); *see also* IPR2015-01353, Motion for Joinder, paper 4 at 5-7. Further, the Patent Owner Preliminary Response already filed in the Trend Micro IPR addresses any and all issues in the CrowdStrike Petition, since the issues are substantively identical to the

issues of the Trend Micro Petition. *See* IPR2023-00798, Patent Owner's Preliminary Response, Paper 6.

The Patent Owner Response will also not be negatively impacted because the issues presented in the Trend Micro Petition are identical to the issues presented in the CrowdStrike Petition. Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in responding to the Trend Micro Petition. Also, because the CrowdStrike Petition relies on the same expert and an identical declaration, only a single deposition is needed for the proposed joined proceeding.

Joinder of this proceeding with the Trend Micro 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 was 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 CrowdStrike Petition with the Trend Micro IPR.

4. Procedures to Simplify Briefing and Discovery

The Trend Micro Petition and CrowdStrike 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 [Petitioner] in the joined proceeding be consolidated with [the filings of the petitioner in the Trend Micro IPR], unless a filing solely concerns issues that do not involve [the petitioner in the Trend Micro IPR]; (b) [Petitioner] shall not be permitted to raise any new grounds not already instituted by the Board in the [Trend Micro] IPR, or introduce any argument or discovery not already introduced by [the petitioner in the Trend Micro IPR]; (c) [Petitioner] shall be bound by any agreement between [Patent Owner] and [the petitioner in the Trend Micro IPR] concerning discovery and/or depositions; and (d) [Petitioner] at deposition shall not receive any direct, cross-examination or redirect time beyond that permitted for [the petitioner in the Trend Micro IPR] alone under either 37 C.F.R. § 42.53 or any agreement between [Patent Owner] and [the petitioner in the Trend Micro IPR]."

IPR2014-00550, paper 38 at 5 (Apr. 10, 2015) (emphasis in original). Petitioner CrowdStrike will assume the primary role only if Trend Micro ceases to participate in the Trend Micro IPR.

By Petitioner accepting an "understudy" role, Patent Owner and Petitioner CrowdStrike 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* IPR2015-01353,

Decision Instituting IPR, 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.); *see also* IPR2015-01353, Motion for Joinder, paper 4 at 6-7.

IV. GENERAL PLASTICS IS INAPPLICABLE

Petitioner respectfully submits application of the *General Plastic* analysis is inapplicable here. In *General Plastic*, the Board set forth a series of factors that may be analyzed for follow-on petitions to help conserve the finite resources of the Board. Here, both CrowdStrike and Trend Micro submitted separate, independent petitions. In the current motion, CrowdStrike merely seeks to join Trend Micro's petition and does not present any new grounds. As such, CrowdStrike respectfully submits that *General Plastic* does not apply in this circumstance because CrowdStrike would be taking an understudy role and the Board's finite resources would not be impacted. Moreover, a joinder petition in these circumstances is not the type of serial petition to which *General Plastic* applies, especially as CrowdStrike has not previously filed an IPR against the '616 Patent. The PTAB has previously stated that a joinder petition "effectively neutralizes" a *General Plastic* analysis. *See Apple Inc. v. Uniloc 2017 LLC*, IPR2018-00580, Paper 13 at 10 (PTAB Aug. 21, 2018) (instituting a joinder petition where joinder petitioner previously filed a non-instituted IPR, stating

joinder petitioner's joinder motion agreeing to a passive understudy role "effectively neutraliz[es] the *General Plastic* factors"); *see also Celltrion, Inc. v. Genentech, Inc.,* IPR2018-01019, Paper 11 at 10 (PTAB Oct. 30, 2018) (instituting a joinder petition where joinder petition previously filed a non-instituted IPR, stating the joinder motion "effectively obviates any concerns of serial harassment and unnecessary expenditure of resources").

In the event the Board does analyze the *General Plastic* factors, those factors heavily weigh in favor of instituting the present IPR. *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha,* IPR2016-01357, slip op. at 16 (PTAB Sept. 6, 2017) (Paper 19) (precedential as to § II.B.4.i).

Regarding factor 1, CrowdStrike has not previously filed a petition against the '616 Patent. This factor weighs in favor of institution.

The second factor is whether at the time of filing the first petition the petitioner knew or should have known of the prior art asserted in the second petition. This factor is neutral, if not inapplicable, in the *General Plastic* analysis. Here, Trend Micro's petition and CrowdStrike's petition share the same prior art because CrowdStrike's Petition is a "copycat" of Trend Micro's petition. Because CrowdStrike is merely seeking to join in an understudy role, the factor is neutral, at best, in determining whether to institute.

The third factor is 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. Because this is a Motion for Joinder requesting an understudy role, CrowdStrike is submitting a substantively identical petition and has not added to, or changed, any of the substantive arguments from the Trend Micro petition. Moreover, because the present Petition is submitted as a joinder and CrowdStrike will serve an understudy role, the Petition is not an attempt to harass the Patent Owner or otherwise engage in serial, tactical filings. Thus, this factor weighs against denial of joinder/institution.

The fourth factor is the length of time elapsed between the time the petitioner learned of the prior art asserted in the second petition and filing of the second petition, and the fifth factor is 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. In the context of a joinder motion where CrowdStrike will be taking an understudy role, these factors are inapplicable.

The sixth factor is the finite resources of the Board. Allowing CrowdStrike's joinder motion where it will serve in an understudy role will not impact the Board's resources beyond those resources the Board dedicates to the instant joinder motion.

The seventh factor is 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. As noted above, joining CrowdStrike should not impact the schedule. Accordingly, this factor weighs in favor of institution.

An eighth factor identified by the Board in *Shenzhen* is the extent to which the petitioner and any prior petitioner(s) were similarly situated defendants or otherwise realized a similar-in-time hazard regarding the challenged patent. *Shenzhen Silver Star Intelligent Tech. Co., Ltd. v. iRobot Corp.,* IPR2018-00898, Paper 9 at 7, 13-14 (PTAB Oct. 1, 2018) (noting "the purpose of proposed Factor 8 is to discourage tactical filing of petitions over time by parties that faced the same threat at the same time" such that earlier petitions are filed as "test case(s)" to gain "tactical advantage"). Because CrowdStrike's petition does not introduce any new grounds of unpatentability and will effectively merge into a single proceeding with Trend Micro's IPR, no such tactical advantage is gained here.

Thus, none of the *General Plastic* factors weighs against institution and joinder in this situation.

V. CONCLUSION

Based on the factors discussed above, Petitioner CrowdStrike respectfully requests that the Board grant the CrowdStrike Petition for *Inter Partes* Review of

U.S. Patent No. 9,092,616 and then grant joinder with the *Trend Micro, Inc.* IPR2023-00799 proceeding.

Date: October 20, 2023

Respectfully submitted,
ERISE IP, P.A.

BY: /s/ Adam P. Seitz
Adam P. Seitz, Reg. No. 52,206
Paul R. Hart, Reg. No. 59,646
Hunter A. Horton, *pro hac vice*

COUNSEL FOR PETITIONER

CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the Motion for Joinder has been served on the Patent Owner on October 20, 2023, via Federal Express or by means at least as fast and reliable as Federal Express on the below date, at the following address:

Buchanan, Ingersoll & Rooney PC
1737 King Street
Suite 500
Alexandria, VA 22314

Further, a courtesy copy of this Petition for *Inter Partes* Review was sent via electronic mail to Petitioner's and Patent Owner's counsel in IPR2023-00799:

Robert M. Hansen (rhansen@marburylaw.com)
Scott B. Amankwatia (samankwatia@marburylaw.com)
Matthew Anderson (manderson@marburylaw.com)
pat-docketing@marburylaw.com
Peter Lambrianakos (plambrianakos@fabricantllp.com)
Vincent J. Rubino, III (vrubino@fabricantllp.com)
Alfred R. Fabricant (ffabricant@fabricantllp.com)
Joseph M. Mercadante (jmercadante@fabricantllp.com)
PTAB@fabricantllp.com

Date: October 20, 2023

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ERISE IP, P.A.

BY: /s/ Adam P. Seitz
Adam P. Seitz, Reg. No. 52,206
Paul R. Hart, Reg. No. 59,646
Hunter A. Horton, *pro hac vice*

COUNSEL FOR PETITIONER