UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CROWDSTRIKE, INC.,

Petitioner,

v.

TAASERA LICENSING LLC,

Patent Owner.

Patent No. 9,092,616
Filing Date: July 27, 2012
Issue Date: July 28, 2015

Inventors: Srinivas Kumar and Dennis Pollutro
Title: SYSTEMS AND METHODS FOR THREAT IDENTIFICATION AND REMEDIATION

PATENT OWNER'S OPPOSITION TO PETITIONER'S 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

Case No. IPR2023-01466

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I. INTRODUCTION

On October 19, 2023, Petitioner CrowdStrike, Inc. ("Petitioner") filed a Petition for *Inter Partes* Review (Paper 1, "Petition") against U.S. Patent No. 9,092,616 (Ex. 1001, the "'616 Patent"). At the same time, Petitioner filed a "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" (the "Trend Micro IPR"). Paper No. 3 ("Motion").

The Board should deny Petitioner's Motion because joinder will needlessly complicate the Trend Micro IPR. Moreover, the *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (P.T.A.B. Sept. 6, 2017), factors weigh in favor of denial of CrowdStrike's Petition.

II. ARGUMENT

A. Legal Standard

"To join a party to an instituted IPR, the plain language of § 315(c) requires two different decisions." *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). The first decision is "whether the joinder [to] applicant's petition for IPR 'warrants' institution under § 314." *Id.* The second is "whether to 'join as a party' the joinder applicant." *Id.* "Joinder may be authorized when warranted, but the decision to grant joinder is discretionary." *Sony Corp. of Am. v. Network-1 Sec. Sols., Inc.,* IPR2013-00386, Paper 16, 3 (P.T.A.B. Jul. 29,

2013). "The fact that the Board has the *discretion* to join a party does not mean that joinder is automatic, particularly given the need to complete proceedings in a just, speedy, and inexpensive manner." *Dell Inc. v. Network-1 Sec. Sols., Inc.*, IPR2013-00385, Paper 17, 6 (P.T.A.B. July 29, 2013).

As the moving party, Petitioner has the burden of proof to establish that joinder is appropriate. 37 C.F.R. §§ 42.20(c), 42.122(b). When considering a motion for joinder, the Board examines factors including: (1) reasons why joinder is appropriate; (2) any new grounds of unpatentability asserted in the petition; (3) what impact (if any) joinder would have on the trial schedule for the existing review; and (4) specifically how briefing and discovery may be simplified. *See Dell Inc.*, IPR2013-00385, Paper 17 at 4.

B. Granting Joinder Will Complicate the Proceedings

Petitioner states that it will participate in an "understudy" role and "assume the primary role only if Trend Micro ceases to participate in the Trend Micro IPR." Motion at 6-10. However, Petitioner then immediately undercuts that statement by carving out exceptions. For example, Petitioner would seek to participate in depositions, with the only restriction being that it could not receive any time beyond that allotted for Trend Micro. *Id.* at 5-6. Petitioner also would reserve the ability to

make filings that "solely concerns issues that do not involve [the petitioner in the Trend Micro IPR]." *Id.*

This list of carve-outs leaves open the possibility that Petitioner, in its sole judgment, could deem that any issue is subject to the exceptions and decide to take an active role. In such circumstances, joinder would cause needless complication.

C. Patent Owner Will Address Whether CrowdStrike's Petition Warrants Institution in its Preliminary Response

Patent Owner is preparing its Patent Owner Preliminary Response which will address whether CrowdStrike's Petition warrants institution. A Petition that does not warrant institution cannot join another proceeding. *Facebook*, 973 F.3d at 1332 ("The statute makes clear that the joinder decision is made *after* a determination that a petition warrants institution, thereby affecting the manner in which an IPR will proceed.").

D. The *Gen. Plastic* Factors Weigh Against Joinder

The Board has clarified that discretionary factors must be considered before determining a joinder motion. *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9, 5 (P.T.A.B. Oct. 28, 2020) (precedential) ("Uniloc") ("before determining whether to join . . . even though the Petition is a 'me-too petition,' we first determine whether application of the *General Plastic* factors warrants the exercise of discretion to deny the Petition under §314(a)."); *see also Gen. Plastic*, IPR2016-01357, Paper

19 at 15-19 (precedential) (noting that the factors considered when exercising discretion to deny institution of an *inter partes* review are: "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.").

The *Gen. Plastic* factors weigh in favor of exercising discretion to deny the petition and joinder.

As to Factor 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," Petitioner refuses to indicate when it first learned of the references in the Petition. Motion at 8. Given Petitioner's failure to provide this information, it should be

presumed that Petitioner was aware of the references long before filing this Petition. This factor, accordingly, weighs in favor of denial.

As to Factor 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," Petitioner cannot deny that it had Patent Owner's Preliminary Response in the Trend Micro IPR at the time it filed the Instant Petition. This factor, accordingly, weighs in favor of denial. *Id*. at 9.

With respect to Factor 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," as discussed above, Petitioner does not state when it first learned of the references in the Petition. *Id*. Petitioner makes no substantive argument as to this factor and, accordingly, this factor weighs in favor of denial.

As to Factor 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," Petitioner provides no explanation for the elapsed time. *Id*.

Finally, Factors 6 and 7, "the finite resources of the Board" and "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," weigh

in favor of denial for the reasons stated above due to the increased complexity from joinder. *Id*. at 9-10.

The majority of the *General Plastic* factors therefore weigh against institution and joinder in this situation.

III. CONCLUSION

Allowing joinder will needlessly complicate the proceedings in the Trend Micro IPR. Further, the *Gen. Plastic* factors favor denial of the Petition and Motion. Accordingly, the Board should deny the Petitioner's Motion.

Respectfully submitted,

Dated: November 20, 2023 By: /*Peter Lambrianakos* /

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CERTIFICATE OF SERVICE

A copy of the foregoing Patent Owner's Opposition to Petitioner's 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 has been served on Petitioner's counsel of record as follows:

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