

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PALO ALTO NETWORKS, INC.,  
FORTINET INC.,

Petitioners,

v.

LIONRA TECHNOLOGIES LTD.,

Patent Owner.

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Case IPR2024-00099  
U.S. Patent No. 7,685.436

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**PATENT OWNER'S OPPOSITION TO  
PETITIONERS' MOTION FOR JOINDER**

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## **TABLE OF CONTENTS**

|                                                                                                                                                | <b>Page</b> |
|------------------------------------------------------------------------------------------------------------------------------------------------|-------------|
| I. INTRODUCTION .....                                                                                                                          | 1           |
| II. BACKGROUND AND RELATED PROCEEDINGS .....                                                                                                   | 3           |
| III. THE <i>FINTIV</i> FACTORS WEIGH AGAINST INSTITUTION.....                                                                                  | 4           |
| A. <u>Factor 1</u> : The district court has not granted a stay, nor is there<br>any evidence that a stay will be granted.....                  | 5           |
| B. <u>Factor 2</u> : The proximity of the court’s trial date to the Board’s<br>projected statutory deadline for a final written decision. .... | 8           |
| C. <u>Factor 3</u> : The parties and the courts have made a substantial<br>investment in the parallel proceeding. ....                         | 9           |
| D. <u>Factor 4</u> : There is an overlap between this IPR and the district<br>court proceedings. ....                                          | 10          |
| E. <u>Factor 5</u> : Petitioners are defendants in the district court<br>litigation. ....                                                      | 11          |
| F. <u>Factor 6</u> : Other circumstances that impact the Board’s exercise<br>of discretion, including the merits.....                          | 11          |
| IV. INSTITUTION SHOULD BE DENIED UNDER THE <i>GENERAL PLASTIC</i><br>FACTORS AND § 314(a). ....                                                | 12          |
| A. Factors 1, 2, 3 4 and 7 are neutral. ....                                                                                                   | 13          |
| B. Factors 5 and 6 weigh against joinder and factor 7 is neutral.....                                                                          | 13          |
| V. CONCLUSION .....                                                                                                                            | 15          |

## **TABLE OF AUTHORITIES**

### **Cases**

|                                                                                                                                                   |                  |
|---------------------------------------------------------------------------------------------------------------------------------------------------|------------------|
| <i>Apple Inc. v. Fintiv, Inc.</i> ,<br>IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020)<br>(precedential, designated May 5, 2020).....                | 4, 5, 8, 10, 11  |
| <i>Apple Inc. v. Fintiv, Inc.</i> ,<br>IPR2020-00019, Paper 15 (PTAB May 13, 2020) .....                                                          | 4, 8, 10, 11     |
| <i>Apple Inc. v. Uniloc 2017 LLC</i> ,<br>IPR2020-00854, Paper 9 (PTAB Oct. 28, 2020).....                                                        | 15               |
| <i>Cisco Systems, Inc. v. Lionra Technologies, Ltd.</i> ,<br>IPR2023-00673, Paper 9 (PTAB Oct. 18, 2023).....                                     | 12               |
| <i>Facebook, Inc. v. Windy City Innov., LLC</i> ,<br>973 F.3d 1321 (Fed. Cir. 2020) .....                                                         | 2                |
| <i>General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha</i> ,<br>IPR2016- 01357, Paper 19 (PTAB Sept. 6, 2017)<br>(precedential) .....  | 2, 3, 12, 13, 15 |
| <i>LG Elecs., Inc. v. Ancora Techs., Inc.</i> ,<br>IPR2021-00581, Paper 16 (June 10, 2021).....                                                   | 3                |
| <i>MyPort, Inc. v. Samsung Electronics Co., Ltd., et al.</i> ,<br>No. 2:22-cv-00114-JRG (E.D. Tex. June 12, 2023).....                            | 7, 8             |
| <i>NHK Spring Co. v. Intri-Plex Techs., Inc.</i> ,<br>IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018)<br>(precedential, designated May 7, 2019)..... | 2, 4, 11         |
| <i>OpenSky Indus., LLC v. VLSI Tech. LLC</i> ,<br>IPR2021-01064, Paper 102 (PTAB Oct. 4, 2022)<br>(precedential) .....                            | 12               |
| <i>Samsung Elecs. Co. Ltd. v. Clear Imaging Research, LLC</i> ,<br>IPR2020-0152, Paper 12 (PTAB March, 3, 2021) .....                             | 7                |

|                                                                                                                              |    |
|------------------------------------------------------------------------------------------------------------------------------|----|
| <i>Samsung Elecs. Co. Ltd. v. Evolved Wireless LLC</i> ,<br>IPR2021-00950, Paper 10 (PTAB Nov. 29, 2021).....                | 6  |
| <i>Shenzhen Silver Star Intelligent Tech. Co., Ltd. v. iRobot Corp.</i> ,<br>IPR2018-00898, Paper 9 (PTAB Oct. 1, 2018)..... | 14 |
| <i>T-Mobile USA, Inc. v. VoIP-Pal.com, Inc.</i> ,<br>IPR2023-00638, Paper 11 (PTAB, July 28, 2023).....                      | 15 |

**Statutes**

|                          |                 |
|--------------------------|-----------------|
| 35 U.S.C. § 314(a) ..... | 2, 3, 4, 12, 15 |
| 35 U.S.C. § 315(c) ..... | 2, 15           |
| 37 C.F.R. § 42.100.....  | 8               |

**PATENT OWNER'S EXHIBIT LIST**

| <b>Exhibit No.</b> | <b>Description</b>                                                                                                                                                                                                                                                                                                          |
|--------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 2001               | Docket Sheet, <i>Lionra Technologies Limited v. Fortinet, Inc.</i> , No. 2:22-cv-00322-JRG-RSP (Lead Case) (E.D. Tex. July 19, 2023)                                                                                                                                                                                        |
| 2002               | Order, <i>Lionra Technologies Limited v. Fortinet, Inc.</i> , No. 2:22-cv-00322-JRG-RSP (Lead Case), Dkt. No. 21 (E.D. Tex. Oct. 24, 2022)                                                                                                                                                                                  |
| 2003               | Second Amended Docket Control Order, <i>Lionra Technologies Limited v. Fortinet, Inc.</i> , No. 2:22-cv-00322-JRG-RSP (Lead Case), Dkt. No. 160 (E.D. Tex. Nov. 27, 2023)                                                                                                                                                   |
| 2004               | Order, <i>MyPort, Inc. v. Samsung Electronics Co., Ltd., et al.</i> , No. 2:22-cv-00114-JRG (E.D. Tex. June 12, 2023)                                                                                                                                                                                                       |
| 2005               | Defendants' Invalidity Contentions, <i>Lionra Technologies Limited v. Fortinet, Inc.</i> , No. 2:22-cv-00322-JRG-RSP (Lead Case) (E.D. Tex. Feb. 10, 2023)                                                                                                                                                                  |
| 2006               | U.S. District Courts—Federal Court Management Statistics—Profiles—During the 12-Month Periods Ending September 30, 2018 Through 2023 available at <a href="https://www.uscourts.gov/sites/default/files/fcms_na_distprofile0930.2023.pdf">https://www.uscourts.gov/sites/default/files/fcms_na_distprofile0930.2023.pdf</a> |

## I. INTRODUCTION

Patent Owner Lionra Technologies Ltd. (“Patent Owner”) submits this opposition to Petitioners Palo Alto Networks, Inc. and Fortinet Inc. (“Petitioners”) Motion for Joinder of *inter partes* review of U.S. Patent No. 7,685,436 (“the ’436 patent”) (Paper 4) (“Motion”). Patent Owner submits this opposition to Petitioners’ Motion for Joinder in accordance with 37 C.F.R. §42.25(a)(1). Patent Owner intends to timely file a Patent Owner’s Preliminary Response on or before February 22, 2024, in accordance with the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response, Paper 7 at 1.

Joinder is not appropriate here because the Board should exercise its discretion to deny the petition in light of a parallel district court case involving the same patent, overlapping claims, the same prior art, and the same parties. By the time the Board reaches an institution decision in this proceeding, the parties and the district court will have already invested significant time and resources in the cases which were filed in August of 2022 – over a year before the institution decision is due. Fact discovery is ongoing (including source code review). By the date of the institution and joinder decisions, the parties will have begun the jury trial in the District Court. A Final Written Decision will not be due in a joined

proceeding until five (5) months *after* trial is scheduled to begin in the District Court on May 20, 2024.

The Board must consider whether to exercise discretion under § 314(a) before permitting joinder. *See Facebook, Inc. v. Windy City Innov., LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020) (determining that § 315(c) requires “two different decisions,” first “whether the joinder applicant’s petition for IPR ‘warrants’ institution under § 314,” and then whether to “exercise . . . discretion to decide whether to ‘join as a party’ the joinder applicant”). Under 35 U.S.C. § 315(c), the discretion of the Director to join a party to an ongoing IPR is premised on the Director’s determination that the petition warrants institution. Under *General Plastic*, the Board may deny a petition based on the Director’s discretionary authority of § 314(a). *See, e.g., General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 17 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i)).

35 U.S.C. § 314(a) also gives the Board discretion to deny institution of the requested *inter partes* review due to the advanced state of parallel district court litigation regarding the same issues. *See NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019) (“*NHK Spring*”), where the Board set forth six factors for determining whether discretionary denial due to such parallel litigation is appropriate (the “*Fintiv*

factors”). The *Fintiv* factors, like the *General Plastic* factors, furnish another basis to deny an “understudy” joinder request, under “a holistic view of whether efficiency and integrity of the system are best served” by rejecting it. See *LG Elecs., Inc. v. Ancora Techs., Inc.*, IPR2021-00581, Paper 16 at 7 (June 10, 2021) (applying *Fintiv* and denying an “understudy” joinder request).

Both the *General Plastic* and the *Fintiv* factors strongly favor a discretionary denial under § 314(a) and, as discussed below, the Board should exercise its discretion under both the *Fintiv* factors and the *General Plastic* factors and deny Petitioner’s Motion.

## **II. BACKGROUND AND RELATED PROCEEDINGS**

The ’436 patent is an asserted patent in *Lionra Technologies Limited v. Fortinet, Inc.*, No. 2:22-cv-00322-JRG-RSP (E.D. Tex.). It is also an asserted patent in *Lionra Technologies Limited v. Palo Alto Networks, Inc.*, No. 2:22-cv-00334-JRG-RSP (E.D. Tex.). Because those litigations, which have been consolidated, commenced on August 19, 2022, and August 29, 2022, respectively, petitioners are precluded from seeking *inter partes* review of the ’436 patent under 35 U.S.C. § 315(b) absent joinder with IPR 2023-00673. See Exhibit 2001, Docket Sheet, *Lionra Technologies Limited v. Fortinet, Inc.*, No. 2:22-cv-00322-JRG-RSP (Lead Case) (E.D. Tex. December 11, 2023).

### III. THE *FINTIV* FACTORS WEIGH AGAINST INSTITUTION

35 U.S.C. § 314(a) gives the Board discretion to deny institution of the requested *inter partes* review due to the advanced state of parallel district court litigation regarding the same issues. *See NHK Spring Co. v. Intrix-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019) (“*NHK Spring*”). The Board has set forth six factors for determining whether discretionary denial due to such parallel litigation is appropriate (the “*Fintiv* factors”):

- whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
- proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
- investment in the parallel proceeding by the court and the parties;
- overlap between issues raised in the petition and in the parallel proceeding;
- whether the petitioner and the defendant in the parallel proceeding are the same party; and
- other circumstances that impact the Board’s exercise of discretion, including the merits.

*Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential, designated May 5, 2020) (“*Fintiv I*”); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 7-8 (PTAB May 13, 2020) (decision denying institution

of *inter partes* review) (“*Fintiv II*”). “These factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Fintiv I* at 6. In evaluating the factors, “the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.*

As set forth below, all of the *Fintiv* factors weigh against institution and joinder. The Board should deny institution and joinder.

**A. Factor 1: The district court has not granted a stay, nor is there any evidence that a stay will be granted.**

There is presently one active consolidated district court case involving the ’436 patent pending in the Eastern District of Texas: *Lionra Technologies Limited v. Fortinet, Inc.*, No. 2:22-cv-00322-JRG-RSP (Lead Case). This case was consolidated with Member Cases *Lionra Technologies Limited v. Cisco Systems, Inc.*, No. 2:22-cv-00305-JRG-RSP (E.D. Tex.) and *Lionra Technologies Limited v. Palo Alto Networks, Inc.*, No. 2:22-cv-00334-JRG-RSP (E.D. Tex.). See Ex. 2002, Order, *Lionra Technologies Limited v. Fortinet, Inc.*, No. 2:22-cv-00322-JRG-RSP (Lead Case), Dkt. No. 21 (E.D. Tex. Oct. 24, 2022) (Consolidating cases). Jury selection is scheduled for May 20, 2024. See Ex. 2003, Second Amended Docket Control Order, *Lionra Technologies Limited v. Fortinet, Inc.*, No. 2:22-cv-00322-JRG-RSP (Lead Case), Dkt. No. 160 (E.D. Tex. Nov. 27, 2023). This is “a deadline

that cannot be changed without an acceptable showing of good cause. Good cause is not shown merely by indicating that the parties agree that the deadline should be changed.” Ex. 2003 at 4.

The district court case is not at an early stage. The cases against petitioners were filed in August of 2022 – almost two years before an institution decision is due on May 22, 2022. Fact discovery is ongoing (including source code review). By the date the institution decision is due in a joined proceeding, the parties will have commenced trial. *See* Ex. 2003 at 1. A Final Written Decision in a joined proceeding will not be due until five (5) months *after* trial is scheduled to begin with jury selection on May 20, 2024. *Id.* This has been an actively litigated matter with 177 docket entries to date. *See* Ex. 2001, Docket Sheet, *Lionra Technologies Limited v. Fortinet, Inc.*, No. 2:22-cv-00322-JRG-RSP (Lead Case), (E.D. Tex. December 11, 2023). Nevertheless, and notwithstanding the number of defendants in this consolidated case, only one party has filed a motion for a stay, and that was on December 8, 2023. *Id.*

And it is unlikely that a stay would be granted in the district court. *See Samsung Elecs. Co. Ltd. v. Evolved Wireless LLC*, IPR2021-00950, Paper 10 at 10-11 (PTAB Nov. 29, 2021) (“*Evolved*”) (finding this factor weighed in favor of denial and denying institution where patent owner showed a stay was unlikely based on the

advanced stage of the case and the court's past decisions denying stays); *Samsung Elecs. Co. Ltd. v. Clear Imaging Research, LLC*, IPR2020-0152, Paper 12 at 12-13 (PTAB Mar. 3, 2021) (denying institution because, in part, Judge Gilstrap deemed unlikely to stay a case in similar circumstances).

The Eastern District of Texas is likely to find that a stay in this situation would unduly prejudice Patent Owner disfavoring a stay. *See, e.g.*, Ex. 2004, Order, *MyPort, Inc. v. Samsung Electronics Co., Ltd., et al.*, No. 2:22-cv-00114-JRG (E.D. Tex. June 12, 2023) at 4 (Noting that patent owner has an interest in the timely enforcement of its patent rights and that granting a stay could delay the case by nearly two years where the PTAB decision is not due until over two months after jury trial is set to begin.). The district court is also likely to find that the stage of litigation disfavors a stay. Under similar circumstances, the district court has found that the stage of litigation disfavors a stay. *Id.* at 5.

Moreover, because petitioners have asserted multiple invalidity theories, a stay in the district court would be unlikely to simplify the issues. *See, e.g.*, Ex. 2005, Defendants' Invalidity Contentions, *Lionra Technologies Limited v. Fortinet, Inc.*, No. 2:22-cv-00322-JRG-RSP (Lead Case), (E. D. Tex. Feb. 10, 2023). As the district court recently noted, when a party has raised multiple invalidity theories that

will not go before the PTAB, a stay would leave in limbo these invalidity theories that will not go before the Board, weighing against a stay. *MyPort* at 6-7.

As explained by the Board, a stay of the district court litigation pending resolution of the PTAB proceedings “allays concerns about inefficiency and duplication of efforts.” *Fintiv I* at 6; *Fintiv II* at 12. But here, the district court has not stayed the pending litigation, nor is there any evidence that a stay will be granted. Allowing this IPR to proceed simultaneously with the district court litigation would be wasteful and inefficient. This factor weighs against institution and joinder.

**B. Factor 2: The proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.**

The statutory deadline for a final written decision in a joined proceeding is October 18, 2024, which can be extended to April 8, 2025, for good cause or in the case of joinder. 37 C.F.R. § 42.100. Jury selection in the district court is scheduled for May 20, 2024. *See* Ex. 2003. This is “a deadline that cannot be changed without an acceptable showing of good cause. Good cause is not shown merely by indicating that the parties agree that the deadline should be changed.” *Id.* at 5.

Even if the Board disregards the scheduled trial date, an analysis of the current median time-to-trial statistics still weighs against institution. *See* Ex. 2006, U.S. District Courts—Federal Court Management Statistics—Profiles—During the 12-Month Periods Ending September 30, 2018 Through 2023. The most recent

statistics, for a 12-month period ending September 30, 2023, show a median time-to-trial in the Eastern District of Texas of 19.0 months. *Id.* Accordingly, the projected trial date for purposes of *Fintiv* in accordance with Director’s June 21, 2022 Memorandum on Discretionary Denials would be in March of 2024 – before even the scheduled trial date and well before the expected timing of a Final Written Decision if proceedings are joined. This factor weighs against institution and joinder.

**C. Factor 3: The parties and the courts have made a substantial investment in the parallel proceeding.**

This factor relates to the “amount and type of work already completed in the parallel litigation by the court and the parties *at the time of the institution decision.*” *Fintiv I* at 9 (emphasis added). For example, “if, at the time of the institution decision, the district court has issued substantive orders related to the patent at issue in the petition,” this factor favors denial. *Id.* at 9-10. Claim construction orders entered by the district court likewise “indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.” *Id.* at 10.

As discussed above, fact discovery is ongoing (including source code review). By the date the institution and joinder decision is due, the parties will have commenced trial. *See* Ex.2003. As shown in the district court docket sheet, the courts and the parties have made a substantial investment in the parallel proceeding.

*See* Ex. 2001 (Docket Sheet). Thus, the parties and the district court will have invested significant time and resources in the litigation by the time the Board reaches an institution decision in this matter. This favors discretionary denial. *Fintiv I* at 10; *Fintiv II* at 13-14 (finding that “the level of investment and effort already expended on claim construction and invalidity contentions” favored denial). Accordingly, joinder should be denied.

**D. Factor 4: There is an overlap between this IPR and the district court proceedings.**

This factor looks at “whether all or some of the claims challenged in the petition are also at issue in district court,” and whether the “petition includes the same or substantially the same claims, grounds, arguments, and evidence” as the parallel district court case. *Fintiv I* at 12-13.

Here, Movants have challenged all of the asserted claims of the ’436 patent. Petitioners’ Amended Preliminary Invalidity Contentions in the district court case identify the same Pham, Wu, Collins, and Krishna references asserted in the Petition as prior art that anticipates and/or renders obvious the asserted claims. *See* Ex. 2005 at 29-31. Thus, there is complete overlap with respect to Petitioners’ invalidity arguments and evidence. That the district court case involves additional prior art references not asserted in this IPR is “not relevant to the question of the degree of overlap for this factor.” *Fintiv II* at 15.

Although a Petitioner has represented to the Board that it will stipulate to not raising this prior art in the District Court proceedings, neither Petitioner has filed a “Sotera” stipulation in the District Court proceedings or notified the District Court if that is their intention. In sum, this IPR and the district court case involve the same claims—which will be construed under the same *Phillips* standard—and substantially the same prior art (and, as discussed below, the same parties), which raises substantial “concerns of inefficiency and the possibility of conflicting decisions.” *Fintiv I* at 12. This factor thus weighs in favor of a discretionary denial. *See Fintiv II* at 15; *NHK Spring* at 19–20. Accordingly, joinder should be denied.

**E. Factor 5: Petitioners are defendants in the district court litigation.**

There is no dispute that Petitioners are defendants in the district court litigation. “Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.” *Fintiv II* at 15. Accordingly, joinder should be denied.

**F. Factor 6: Other circumstances that impact the Board’s exercise of discretion, including the merits.**

The Board may consider other circumstances in the exercise of its discretion, including the merits of the case. *Fintiv I* at 14. However, “a full analysis of the merits is not necessary to evaluate this factor.” *Fintiv II* at 17. And it is important to note that the compelling merits standard is a higher standard than the standard for

institution set by statute. “A challenge can only ‘plainly lead to a conclusion that one or more claims are unpatentable’ if it is highly likely that the petitioner would prevail with respect to at least one challenged claim.” *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 102, 49 (PTAB Oct. 4, 2022) (precedential). In the proceeding sought to be joined, the Board did not rule that it was highly likely that petitioner would prevail, but rather that petitioner had established a reasonable likelihood of success. *Cisco Systems, Inc. v. Lionra Technologies, Ltd.*, IPR2023-00673, Paper 9, 13 (PTAB Oct. 18, 2023). All six *Fintiv* factors strongly favor discretionary denial, and the Motion should be denied.

**IV. INSTITUTION SHOULD BE DENIED UNDER THE *GENERAL PLASTIC* FACTORS AND § 314(a).**

35 U.S.C. § 314(a) gives the Board discretion to deny instituting “follow on” petitions. *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB, Sept. 6, 2017) (precedential). The Board has set forth seven factors for determining whether discretionary denial is appropriate (the “*General Plastic* factors”):

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.

*General Plastic Indus. Co.*, IPR2016-01357, Paper 19 at 16.

Here, the *General Plastic* factors weigh against joinder or are neutral.

**A. Factors 1, 2, 3 4 and 7 are neutral.**

Factors 1 through 4 relate to successive petitions filed by the same petitioners, which is not at issue here. Since Petitioners explicitly consented to the trial schedule in IPR2023-00673, Factor 7 is neutral as well.

**B. Factors 5 and 6 weigh against joinder and factor 7 is neutral.**

Factor 5 weighs against joinder because Petitioners did not provide any explanation for the time elapsed between the filings of multiple petitions directed

to the same claims of the same patent, let alone an adequate explanation. Accordingly, factor 5 weighs against institution and joinder. This is also relevant to so-called proposed factor 8.

8. 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 (PTAB Oct. 1, 2018) quoting *Shenzhen Silver Star Intelligent Technology Co., Ltd. v. iRobot Corp.*, IPR2018-00761, Paper 15, 18 (PTAB Sept. 5, 2018) (Saindon, concurring). As the Board further explained, this is intended to discourage tactical filing of petitions over time by parties that faced the same threat at the same time. *Id.* at 13-14. Just as in that proceeding, Petitioners here are co-defendants and even filed a single set of invalidity contentions. Accordingly, Petitioners and Cisco both faced a similar-in-time hazard regarding the '436 patent yet waited for the institution decision in IPR2023-00673 to file this joinder motion and petition. Absent mitigating explanations, of which there are none, this suggests an attempt to secure tactical advantage and, because proposed Factor 8 weighs against tactical filing of petitions, this weighs in favor of Patent Owner.

Notwithstanding Petitioners' understudy role, Petitioners would be able to continue the proceedings that would otherwise be terminated after settlement with the primary petitioner. As the Board recently noted, this possibility is relevant to Factor 6. *See T-Mobile USA, Inc. v. VoIP-Pal.com, Inc.*, IPR2023-00638, Paper 11 at 11-13 (PTAB, July 28, 2023). *See also Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (PTAB Oct. 28, 2020). Accordingly, Factor 6 weighs against joinder as well. In summary, the *General Plastic* factors weigh against institution and joinder and joinder should be denied.

## V. CONCLUSION

Although Petitioner's Motion is timely and does not propose new grounds or impact the trial schedule, joinder is not appropriate because institution should be denied under 35 U.S.C § 314(a) under a holistic view of whether efficiency and integrity of the system are best served by denying review. The Director may join a party to an ongoing IPR only if the later-filed petition warrants institution under § 314(a). 35 U.S.C § 315(c). Where, as here, institution should be denied under § 314(a), the Joinder Motion should be denied as well.

Date: December 11, 2023

Respectfully submitted,

/Brett Cooper/

Brett Cooper, Reg. No. 55,085  
Lead counsel for Patent Owner

**CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))**

The undersigned hereby certifies that the above document was served on December 11, 2023, by filing this document through the Patent Trial and Appeal Case Tracking System as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioner:

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