UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VMWARE, LLC,
Petitioner

v.

LIONRA TECHNOLOGIES LTD.,
Patent Owner

Inter Partes Review Case No. IPR2024-00302
U.S. Patent No. 7,302,708

MOTION FOR JOINDER UNDER
35 U.S.C. § 325(c) AND 37 C.F.R. § 42.222(b)
TO RELATED *INTER PARTES* REVIEW IPR2023-00669

TABLE OF CONTENTS

I. STATEMENT OF THE PRECISE RELIEF REQUESTED 1

II. STATEMENT OF MATERIAL FACTS 1

III. STATEMENT OF THE PRECISE RELIEF REQUESTED 2

A. LEGAL STANDARD 2

B. EACH FACTOR WEIGHS IN FAVOR OF JOINDER 2

1. Joinder is Appropriate 3

2. Petitioner Proposes No New Grounds of Unpatentability 4

3. Joinder Will Not Unduly Burden or Negatively Impact the Cisco IPR Trial Schedule 4

4. Procedures to Simplify Briefing and Discovery 5

C. 37 C.F.R. §42.122(B) SHOULD BE WAIVED 6

IV. *GENERAL PLASTIC* IS INAPPLICABLE 7

V. CONCLUSION 11

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

VMware, LLC ("Petitioner") respectfully submits this Motion for Joinder, together with a Petition for *Inter Partes* Review of U.S. Patent No. 7,302,708 ("'708 Patent") ("the VMware 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 *Cisco Systems, Inc. v. Lionra Technologies Ltd,* IPR2023-00669 ("the Cisco IPR"). The VMware Petition is also narrowly tailored to the same claims, prior art, and grounds for unpatentability that are the subject of the Cisco IPR. In addition, Petitioner is willing to streamline discovery and briefing. Cisco does not oppose Petitioner's request for joinder.

Petitioner submits that joinder is appropriate because it will not unduly burden or prejudice the parties to the Cisco IPR while efficiently resolving common questions of the '708 Patent's validity in a single proceeding.

II. STATEMENT OF MATERIAL FACTS

1. On March 9, 2023, Cisco Systems, Inc. filed a petition for *inter partes* review (IPR2023-00669) requesting cancellation of claims 1-6 and 9 of the '708 Patent.

2. On October 23, 2023, the Board instituted *inter partes* review on all challenged claims and grounds. IPR2023-00669, Paper 10 (Oct. 23, 2023).

3. Contemporaneously with this Motion, Petitioner filed its Petition for *Inter Partes* Review requesting cancellation of claims 1-6 and 9 of the '708 Patent, which is substantively identical to the Cisco IPR.

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). Although 37 C.F.R. § 42.122(b) provides for motions for joinder to be filed within one month of the Board instituting an original *inter partes* review, the Board may waive the one-month requirement under 37 C.F.R. § 42.5(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 Corp. v. Softview LLC,* IPR2013-00004, Paper 15 at 4 (Apr. 24, 2013).

B. Each Factor Weighs in Favor of Joinder

Each of the four factors considered by the Board weighs in favor of joinder here. Specifically, the VMware Petition does not present any new grounds of unpatentability; rather it is substantively identical to the Cisco 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 joinder 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 Cisco IPR is appropriate because the VMware 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 Cisco Petition.[1] *Id.* The VMware Petition is substantively identical to the Cisco Petition, containing only minor differences related to formalities of a different party filing the petition. There are no changes to the facts, citations,

[1] Fortinet Inc. has similarly filed petitions substantively identical to Cisco and VMware's and has sought joinder. *See* IPR2024-00176, papers 2 and 3; IPR 2024-00177, papers 2 and 3.

evidence, or arguments presented in the Cisco Petition. Because these proceedings are substantively identical, good cause exists for joining this proceeding with the Cisco IPR so that the Board can efficiently resolve all grounds in both the VMware Petition and Cisco Petition in a single proceeding. *Id.*

2. Petitioner Proposes No New Grounds of Unpatentability

The VMware Petition presents the same grounds of unpatentability as the Cisco Petition.

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

Because the VMware Petition is substantively identical to the Cisco 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 Cisco 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.

The Patent Owner Response will also not be negatively impacted because the issues presented in the Cisco Petition are identical to the issues presented in the VMware Petition. Patent Owner will not be required to provide any additional

analysis or arguments beyond what it will already provide in responding to the Cisco Petition. Also, because the VMware 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 Cisco 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 VMware Petition with the Cisco IPR.

4. Procedures to Simplify Briefing and Discovery

The Cisco Petition and VMware 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 Cisco IPR], unless a filing solely concerns issues that do not involve [the petitioner in the Cisco IPR]; (b) [Petitioner] shall not be permitted to raise any new grounds not already instituted by the Board in the [Cisco] IPR, or introduce any argument

> or discovery not already introduced by [the petitioner in the Cisco IPR]; (c) [Petitioner] shall be bound by any agreement between [Patent Owner] and [the petitioner in the Cisco 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 Cisco IPR] alone under either 37 C.F.R. § 42.53 or any agreement between [Patent Owner] and [the petitioner in the Cisco IPR]."

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

By Petitioner accepting an "understudy" role, Patent Owner and Petitioner 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.

C. 37 C.F.R. § 42.122(b) Should Be Waived

Under 37 C.F.R. § 42.5(b), the Board may "waive or suspend" § 42.122(b)'s requirement that motions for joinder be filed within a month of institution of the *inter partes* review for which joinder is requested. Waiver of § 42.122(b) is

warranted because joinder would facilitate "the Office's ability to complete reviews timely." *See* Changes to Implement *Inter Partes* Review Proceedings, 77 Fed. Reg. 48,680, 48,707 (Aug. 14, 2012) (creating one-month requirement). The VMware Petition is identical in substance and merit to Cisco's Petition, with the same grounds and the same evidence rejecting the same claims as instituted by the Board. Moreover, Cisco does not oppose Petitioner's request for joinder, and Petitioner would accept an understudy role that would result in no negative impact on the current trial schedule, as described above. Thus, joinder would allow the Board to efficiently resolve all grounds in both the VMware Petition and the Cisco Petition in a single proceeding according to the current schedule.

IV. *GENERAL PLASTIC* IS INAPPLICABLE

Lionra may argue that joinder is inappropriate under *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*. IPR2016-01357, slip op. at 16 (PTAB Sept. 6, 2017) (Paper 19) (precedential as to § II.B.4.i). Petitioner respectfully submits, however, that 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 Petitioner and Cisco submitted separate, independent petitions. In the current motion, Petitioner merely seeks to join Cisco's petition and does not present any new grounds. As such, Petitioner respectfully submits that *General Plastic* does not

apply in this circumstance because Petitioner 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 Petitioner has not previously filed an IPR against the '708 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.

Regarding factor 1, Petitioner has not previously filed a petition against the '708 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, Cisco's petition and VMware Petition share the same prior art and arguments. Because Petitioner 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, Petitioner is submitting a substantively identical petition and has not added to, or changed, any of the substantive arguments from the Cisco petition. Moreover, because the present Petition is submitted together with a motion for joinder and Petitioner 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 Petitioner will be taking an understudy role, these factors are inapplicable.

The sixth factor is the finite resources of the Board. Allowing Petitioner'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 Petitioner 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 the VMware Petition does not introduce any new grounds of unpatentability and will effectively merge into a single proceeding with Cisco's IPR, no such tactical advantage is gained here. Moreover, Lionra sued VMware a year after it sued Cisco, so VMware's threat emerged substantially later.

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

V. CONCLUSION

Based on the factors discussed above, Petitioner respectfully requests that the Board grant the VMware Petition for *Inter Partes* Review of U.S. Patent No. 8,566,708 and then grant joinder with the *Cisco Systems, Inc.* IPR2023-00669 proceeding.

Date: December 12, 2023

Respectfully submitted,

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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 December 12, 2023, via Federal Express or by means at least as fast and reliable as Federal Express on the below date, at the following address:

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