

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

DELL INC. and DELL TECHNOLOGIES INC.

Petitioners,

v.

SOFTEX, LLC

Patent Owner.

---

Case No. IPR2024-00564

Patent No. 8,506,649

---

**MOTION FOR JOINDER TO *INTER PARTES* REVIEW IPR2023-01185**

## TABLE OF CONTENTS

|      |                                                    |   |
|------|----------------------------------------------------|---|
| I.   | STATEMENT OF THE PRECISE RELIEF REQUESTED .....    | 1 |
| II.  | STATEMENT OF MATERIAL FACTS .....                  | 1 |
| III. | STATEMENT OF REASONS FOR RELIEF REQUESTED .....    | 3 |
| A.   | Legal Standard.....                                | 3 |
| B.   | The Board Should Grant Joinder.....                | 3 |
| 1.   | Joinder with the Microsoft IPR is Appropriate..... | 4 |
| 2.   | Petitioner Does Not Propose New Grounds. ....      | 5 |
| 3.   | Joinder Will Not Impact Any Trial Schedule. ....   | 5 |
| 4.   | Joinder Will Simplify Briefing and Discovery.....  | 6 |
| IV.  | CONCLUSION.....                                    | 8 |

## **TABLE OF AUTHORITIES**

| <b>Cases</b>                                                                                                                                                             | <b>Page(s)</b> |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------|----------------|
| <i>Apple Inc. v. Uniloc 2017, LLC</i> ,<br>IPR2020-00854, Paper 9 (PTAB Oct. 28, 2020).....                                                                              | 4              |
| <i>Central Security Group – Nationwide, Inc. d/b/a Alert360 v.</i><br><i>Ubiquitous Connectivity, LP</i> ,<br>IPR2019-01610, Paper No. 12 (PTAB February 26, 2020) ..... | 3, 4, 5, 7     |
| <i>General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha</i> ,<br>IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017).....                                             | 4              |
| <i>LG v. Memory Integrity, LLC.</i> ,<br>IPR2015-01353, Paper No. 11 (PTAB Oct. 5, 2015).....                                                                            | 5              |
| <i>Microsoft Corp. v. Softex LLC</i> ,<br>IPR2023-01185, Paper No. 1 (PTAB July 11, 2023) .....                                                                          | 2              |
| <i>Softex LLC v. Absolute Software Corp. et al.</i> ,<br>Case No. 1:22-01308 (W.D. Tex.).....                                                                            | 2              |
| <i>Softex LLC v. Dell Tech. Inc. et al.</i> ,<br>Case No. 1:22-01309 (W.D. Tex.).....                                                                                    | 2              |
| <i>Softex LLC v. HP Inc. et al.</i> ,<br>Case No. 1:22-01311 (W.D. Tex.).....                                                                                            | 2              |
| <i>Softex LLC v. Lenovo (Shanghai) Elecs. Tech. Co. Ltd., et al.</i> ,<br>Case No. 5:23-cv-00090 (E.D.N.C.).....                                                         | 2              |
| <br><b>Statutes, Rules &amp; Regulations</b>                                                                                                                             |                |
| 35 U.S.C. § 315(c) .....                                                                                                                                                 | 3, 4           |
| 37 C.F.R. § 42.1(b) .....                                                                                                                                                | 5              |
| 37 C.F.R. § 42.122(b) .....                                                                                                                                              | 3, 4           |

## **I. STATEMENT OF THE PRECISE RELIEF REQUESTED**

Petitioners Dell Technologies Inc. and Dell Inc. (together, “Petitioner” or “Dell”) hereby move for joinder of Dell’s contemporaneously-filed petition for *Inter Partes* Review (“IPR”) of claims 1-25 of U.S. Patent No. 8,506,649 (the “’649 Patent”) with a pending IPR filed by Microsoft Corp. against Softex LLC, IPR2023-01185 (“Microsoft IPR”).

The Microsoft IPR was filed on July 11, 2023, on the same patent and the same claims as this Petition. This Petition and supporting declaration are substantively identical to the petition and declaration submitted in the Microsoft IPR. More specifically, Petitioner here asserts that the same claims are anticipated and/or rendered obvious by the same prior art based on the same arguments presented by the same expert as in the Microsoft IPR.

Microsoft has informed Petitioner that it does not oppose joinder. Petitioner here has agreed to take an “understudy” role if joined. Joinder will not cause any delay in the resolution of the Microsoft IPR. Joinder is therefore appropriate because it will promote the efficient and consistent resolution of the same patentability issues of the same patent. It will not delay any schedule in the Microsoft trial schedule, and the parties in the Microsoft IPR will not be prejudiced.

## **II. STATEMENT OF MATERIAL FACTS**

1. Softex LLC (“Patent Owner”) purportedly owns the ’649 Patent.

2. The following litigation or *inter partes* reviews related to the '649 Patent are pending:

- *Softex LLC v. Lenovo (Shanghai) Elecs. Tech. Co. Ltd., et al.*, Case No. 5:23-cv-00090 (E.D.N.C.)
- *Softex LLC v. Absolute Software Corp. et al.*, Case No. 1:22-01308 (W.D. Tex.)
- *Softex LLC v. Dell Tech. Inc. et al.*, Case No. 1:22-01309 (W.D. Tex.)
- *Softex LLC v. HP Inc. et al.*, Case No. 1:22-01311 (W.D. Tex.)
- *Microsoft Corp. v. Softex LLC*, IPR2023-01185

3. On July 11, 2023, Microsoft Corp. filed a petition challenging claims 1-25 of the '649 Patent in *Microsoft Corp. v. Softex LLC*, IPR2023-01185. The Board instituted review of claims 1-25 and all grounds on January 17, 2024.

4. Along with this Motion for Joinder, Petitioner here has simultaneously filed a Petition for *inter partes* review, which argues, *inter alia*, that exactly the same claims of the '649 Patent are obvious over exactly the same grounds and reasons set out in the Microsoft IPR. The Petition is also supported by the expert declaration of Dr. John Black, the same expert who submitted an identical declaration in support of the Microsoft IPR.

5. The grounds proposed in the present Petition are therefore the same grounds of unpatentability. The Petition does not contain any additional arguments or evidence in support of the invalidity of claims 1-25 of the '649 Patent.

### **III. STATEMENT OF REASONS FOR RELIEF REQUESTED**

#### **A. Legal Standard**

The Board may grant a motion to join an *inter partes* review petition with another *inter partes* review proceeding. 35 U.S.C. § 315(c). A petitioner may request joinder up to one month after the institution date of the proceeding to which joinder is requested, without prior authorization. 37 C.F.R. § 42.122(b). The Board, in determining whether to exercise its discretion to grant joinder, considers whether the joinder motion: (1) sets forth the reasons why joinder is appropriate; (2) identifies any new grounds of unpatentability asserted in the petition; (3) explains what impact (if any) joinder would have on the trial schedule for the existing review; and (4) addresses specifically how briefing and discovery may be simplified. *Central Security Group – Nationwide, Inc. d/b/a Alert360 v. Ubiquitous Connectivity, LP*, IPR2019-01610, Paper No. 12, p. 6.

#### **B. The Board Should Grant Joinder.**

The motion for joinder is timely because it is submitted within one month after the institution date of the Microsoft IPR. *See* 37 C.F.R. § 42.122(b). The Board has

discretion to, and should, join this IPR with the Microsoft IPR. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b).

**1. Joinder with the Microsoft IPR is Appropriate.**

The Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in [an] existing proceeding.” *Central Security*, IPR2019-01610, Paper No. 12, p. 6 (internal citations omitted). Here, joinder with the Microsoft IPR is appropriate because the present Petition introduces the same arguments and the same grounds raised in the existing Microsoft IPR. Although there are minor differences related to the mandatory notices and grounds for standing, there are no substantive changes to the facts, citations, evidence, or arguments relied upon to assert unpatentability of the claims relative to the Microsoft Petition. Exhibit 1034 (redline comparison of petitions). Moreover, the same expert, Dr. Black, has submitted an identical supporting declaration in both IPRs.

This is Petitioner’s first challenge of the ’649 Patent. Accordingly, in the instant case there is no “potential for abuse of the review process by repeated attacks on patents.” *Apple Inc. v. Uniloc 2017, LLC*, IPR2020-00854, Paper 9 at 5 (PTAB Oct. 28, 2020) (precedential) (quoting *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16–17 (PTAB Sept. 6, 2017)

(precedential)). Instead, allowing joinder would enable an efficient and appropriate use of the review process.

Because these proceedings are substantively identical, good cause exists for joining this proceeding with the Microsoft IPR so that the Board, consistent with 37 C.F.R. § 42.1(b), can efficiently “secure the just, speedy, and inexpensive resolution” of the present Petition and Microsoft’s Petition in a single proceeding.

## **2. Petitioner Does Not Propose New Grounds.**

As noted above, the Petition challenges the same claims of the ’649 Patent, relying on the same expert declaration, and on the same grounds and combinations of prior art submitted in the Microsoft Petition. *See LG v. Memory Integrity, LLC.*, IPR2015-01353, Paper No. 11, p. 5-6 (granting institution of IPR and motion for joinder where petitioner relied “on the same prior art, same arguments, and same evidence, including the same expert and a substantively identical declaration”); *see also Central Security*, IPR2019-01610, Paper No. 12, p. 8 (granting motion for joinder where the Petitions challenge the same claims on the same grounds using the same prior art).

## **3. Joinder Will Not Impact Any Trial Schedule.**

Joinder should have no meaningful impact on the Microsoft IPR trial schedule because the present Petition presents no new issues or grounds of unpatentability. *See LG*, Paper No. 11, p. 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, Petitioner explicitly consents to the IPR2023-01185 trial schedule. There are no new issues for the Board to address, and Patent Owner will not be required to present any additional responses or arguments upon joinder. It is noted that, in the Microsoft IPR (IPR2023-01185), the Patent Owner filed a Patent Owner’s Preliminary Response, on October 24, 2023, and already presented certain arguments against the same grounds presented in the present Petition. Patent Owner is under no obligation to file a Preliminary Response in response to the Present Petition. Presumably, Patent Owner has also already been actively analyzing the same ground presented in the present Petition in connection with its Patent Owner’s Response due in the Microsoft IPR.

Accordingly, joinder with the Microsoft IPR does not unduly burden or negatively impact the trial schedule.

#### **4. Joinder Will Simplify Briefing and Discovery.**

Petitioner explicitly agrees to take an “understudy” role, which will simplify briefing and discovery. Specifically, Petitioner explicitly agrees, upon joining the Microsoft IPR, that the following conditions shall apply so long as the current lead petitioner in IPR2023-01185 does not enter into a settlement of its dispute with Patent Owner and remains an active party:

a) Petitioner shall not make any substantive filings and shall be bound by the filings of Microsoft, unless a filing concerns termination and settlement;

b) Petitioner shall not present any argument or make any presentation at oral hearing;

c) Petitioner shall not seek to cross-examine or defend the cross-examination of any witness; and

d) Petitioner shall not seek discovery from Patent Owner.

*See, e.g., Central Security*, IPR2019-01610, Paper No. 12, p. 8 (“Petitioner avers it will take an ‘understudy’ role in the [joined] IPR by consolidating all filings, refraining from advancing new arguments, binding itself to any discovery agreements, and limiting its deposition time to the time already allotted . . . Thus, joinder would result in the just, speedy, and inexpensive resolution of the instant Petition as well as the petition filed in the [joined] IPR.”). Unless and until the current petitioner ceases to participate in the instituted IPR proceeding, Petitioner will not assume an active role therein.

Thus, by Petitioner accepting an “understudy” role, Patent Owner and the current petitioner in the Microsoft IPR can comply with the existing trial schedule without requiring 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. Petitioner is further amenable to any other reasonable conditions the Board deems necessary.

#### **IV. CONCLUSION**

Based on the factors discussed above, Petitioner respectfully requests that the Board grant the Petition and grant this motion for joinder with the Microsoft IPR.

Dated February 15, 2024

/Carrie A. Beyer/  
Carrie A. Beyer, Reg. No. 59,195  
Kirstin Stoll-DeBell, Reg. No. 43,164  
Zachary D. Kachmer, Reg. No. 75,414

Attorneys for Petitioner

## **CERTIFICATE OF SERVICE**

Pursuant to 37 CFR §§42.6(e)(4)(i) et seq. and 42.105(b), the undersigned certifies that on February 15, 2024, a complete and entire copy of this Motion for Joinder was provided, via Federal Express, to the Patent Owner by serving the correspondence address of record as follows:

**Georgios Georgakis  
13858 - G+J Softex Transferred  
4301 W William Cannon Dr.,  
Suite B150 PMB200  
Austin, TX 78749-1487**

and courtesy copies were provided via email to Patent Owner's counsel of record in the Microsoft IPR as follows:

John Holley [jholley@mckoolsmith.com](mailto:jholley@mckoolsmith.com)  
Elizabeth Bernard [ebarnard@mckoolsmith.com](mailto:ebarnard@mckoolsmith.com)  
[Softex\\_MS@mckoolsmith.com](mailto:Softex_MS@mckoolsmith.com)

/Emilija Andrulyte/  
Emilija Andrulyte, Paralegal