UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORP.,

Petitioner,

v.

VIRTAMOVE, CORP.,

Patent Owner.

Case No. IPR2025-00853

U.S. Patent No. 7,784,058

MOTION FOR JOINDER UNDER
35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)
TO RELATED *INTER PARTES* REVIEW IPR2025-00489

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. PETITIONER'S MOTION FOR JOINDER IS TIMELY 2
C. 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 Any Forthcoming Trial Schedule for the 00489 IPR 4
4. Procedures to Simplify Briefing and Discovery 5

IV. *GENERAL PLASTIC* IS INAPPLICABLE 7

V. CONCLUSION 8

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Microsoft Corp. ("Petitioner") respectfully submits this Motion for Joinder, together with a Petition for *Inter Partes* Review of U.S. Patent No. 7,784,058 ("'058 Patent") (IPR2025-00853, "the 00853 IPR 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 *Google LLC v. VirtaMove, Corp.*, IPR2025-00489 ("the 00489 IPR Petition" or "00489 IPR"), filed by Google LLC ("Google"). The 00853 IPR Petition is substantively identical to the 00489 IPR Petition; i.e., it is narrowly tailored to the same claims, prior art, and grounds for unpatentability that are the subject of the 00489 IPR. In addition, Petitioner is willing to streamline discovery and briefing. Petitioner understands that Google 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 00489 IPR while efficiently resolving the question of the '058 Patent's validity in a single proceeding.

II. STATEMENT OF MATERIAL FACTS

1. On January 31, 2025, Google LLC filed a petition for *inter partes* review (IPR2025-00489) requesting cancellation of claims 1-18 of the '058 Patent.

2. Contemporaneously with this Motion, Petitioner filed its Petition for *Inter Partes* Review requesting cancellation of claims 1-18 of the '058 Patent, which is substantively identical to the 00489 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). 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 has been made in the 00489 IPR Petition. 37 C.F.R. § 42.122(b).

C. Each Factor Weighs in Favor of Joinder

Each of the four factors considered by the Board weighs in favor of joinder here. Specifically, the 00853 IPR Petition does not present any new grounds of

unpatentability; rather it is substantively identical to the 00489 IPR Petition. Further, joinder will have minimal, if any, impact on any forthcoming trial schedule, as all issues are substantively identical and Petitioner will accept an "understudy" role. *See Sony Corp. et al. v. Memory Integrity, LLC,* 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.

1. Joinder is Appropriate

Joinder with the 00489 IPR is appropriate because the 00853 IPR 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 00489 IPR Petition. The 00853 IPR Petition is substantively identical to the 00489 IPR Petition, containing only minor differences related to only other issues associated with a different party filing the petition. The 00853 IPR Petition presents no changes to the facts, citations, evidence, or arguments related to patentability presented in the 00489 IPR Petition. Because these proceedings are substantively identical, good cause exists for joining this proceeding with the 00489 IPR so that the Board can efficiently resolve all grounds in both the 00853 IPR Petition and 00489 IPR Petition in a single proceeding. *Id.*

2. Petitioner Proposes No New Grounds of Unpatentability

The 00853 IPR Petition presents the same grounds of unpatentability as the 00489 IPR Petition.

3. Joinder Will Not Unduly Burden or Negatively Impact Any Forthcoming Trial Schedule for the 00489 IPR

Because the 00853 IPR Petition is substantively identical to the 00489 IPR Petition, with the same grounds challenging the same claims as in the original 00489 IPR Petition, there are no new substantive issues for Patent Owner to address. Due to the same issues being presented in the 00853 IPR Petition and the 00489 IPR 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 00853 IPR Petition are identical to the issues presented in the 00489 IPR Petition. Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in responding to the 00489 IPR Petition. Also, because the 00853 IPR 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 00489 IPR does not unduly burden or negatively impact any forthcoming trial schedule in any meaningful way. Currently, the parties will not submit a proposed scheduling order in the district court litigation against Petitioner until April 25, 2025. Trial has not been scheduled, and any final written decision in the 00489 IPR would issue at least two to three months before the earliest likely trial date. 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 00853 IPR Petition with the 00489 IPR.

4. Procedures to Simplify Briefing and Discovery

The 00489 IPR Petition and 00853 IPR Petition present substantively identical grounds of unpatentability, 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 00489 IPR], unless a filing solely concerns issues that do not involve [the petitioner in the 00489 IPR]; (b) [Petitioner] shall not be permitted to raise any new grounds

> not already instituted by the Board in the [00489] IPR, or introduce any argument or discovery not already introduced by [the petitioner in the 00489 IPR]; (c) [Petitioner] shall be bound by any agreement between [Patent Owner] and [the petitioner in the 00489 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 00489 IPR] alone under either 37 C.F.R. § 42.53 or any agreement between [Patent Owner] and [the petitioner in the 00489 IPR]."

Noven Pharmaceuticals, Inc. et al. v. Novartis AG et al., IPR2014-00550, Paper 38 at 5 (Apr. 10, 2015) (emphasis in original). Petitioner will assume the primary role only if Google ceases to participate in the 00489 IPR.

By Petitioner accepting an "understudy" role, Patent Owner and Petitioner can comply with any forthcoming 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.

Accordingly, joinder should be permitted. *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.

IV. *GENERAL PLASTIC* IS INAPPLICABLE

Pursuant to and in reliance on Acting Director Coke M. Stewart's March 26, 2025, Memorandum regarding Interim Processes for PTAB Workload Management, Petitioner understands that discretionary denial issues, if any, will be raised in a separate brief to be filed by Patent Owner. To the extent that Patent Owner files such a brief implicating the *General Plastic* factors, Petitioner intends to respond in an opposition brief consistent with the aforementioned March 26, 2025, Memorandum. Accordingly, Petitioner will not address discretionary denial issues in this Motion other than to address a threshold issue, namely, that the *General Plastic* analysis is inapplicable here because the Petitioner is unrelated to and lacks any legally significant relationship to Google or any earlier Petitioner who has filed an IPR against the '814 patent. *Olympus Corp. et al. v. Optimum Imaging Techs., LLC*, IPR2024-01220, Paper 13 at 9 (P.T.A.B. Feb. 24, 2025) (citing *Videndum Prod. v. Rotolight*, IPR2023-01218, Paper 12 at 5–6 (PTAB Apr. 19, 2024)).

V. CONCLUSION

Based on the factors discussed above, Petitioner respectfully requests that the Board grant the 00853 Petition for *Inter Partes* Review of U.S. Patent No. 7,784,058 and then grant joinder with the Google IPR2025-00489 proceeding.

Date: April 18, 2025

Respectfully submitted,

DLA PIPER LLP

By: /*James M. Heintz*/
James M. Heintz, Reg. No. 41,828
DLA Piper LLP
One Fountain Square
11911 Freedom Drive, Suite 300
Reston, VA 20190-5602

ATTORNEY FOR PETITIONER

CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §§ 42.6(e) and 42.105 that on April 18, 2025, a true and correct copy of the Motion for Joinder was served by emailing a copy of same to the following attorneys, who have agreed to accept service on behalf of Patent Owner:

Reza Mirzaie
rmirzaie@raklaw.com
Marc A. Fenster
mfenster@raklaw.com
Neil A. Rubin
nrubin@raklaw.com
Amy E. Hayden
ahayden@raklaw.com
Christian W. Conkle
cconkle@raklaw.com
Jonathan Ma
jma@raklaw.com
Daniel B. Kolko
dkolko@raklaw.com
Jacob R. Buczko
jbuczko@raklaw.com
James Milkey
jmilkey@raklaw.com
James S. Tsuei
jtsuei@raklaw.com
Mackenzie Paladino
mpaladino@raklaw.com

RUSS AUGUST & KABAT
12424 Wilshire Boulevard, 12th Floor
Los Angeles, CA 90025

Qi (Peter) Tong
ptong@raklaw.com

RUSS AUGUST & KABAT
4925 Greenville Ave, Suite 200
Dallas, TX 75206

Date: April 18, 2025

By: /*James M. Heintz*/

James M. Heintz, Reg. No. 41,828
DLA Piper LLP
One Fountain Square
11911 Freedom Drive, Suite 300
Reston, VA 20190-5602
P: +1 703 773 4000
F: +1 703 773 5000
jim.heintz@dlapiper.com

ATTORNEY FOR PETITIONER