

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,

Petitioners

v.

STERLING COMPUTERS CORPORATION,

Patent Owner.

IPR2025-01248

U.S. Patent No. 7,716,217

**PETITIONER'S CONDITIONAL MOTION FOR JOINDER UNDER
35 U.S.C. § 315(C) AND 37 C.F.R. §§42.22 AND 42.122(B)**

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Petitioner, Meta Platforms, Inc. (“Meta” or “Petitioner”) **conditionally moves** for joinder with the *inter partes* review instituted against U.S. Patent No. 7,716,217 (“the ’217 Patent”) in *X Corp. v. Sterling Computers Corp.*, IPR2025-00299, filed December 12, 2024, and instituted on June 10, 2025 (“the X IPR”). *See* IPR2025-00299, Paper 13. This motion is timely filed within one month of the Board’s June 10, 2025 institution decision in the X IPR. 37 C.F.R. § 42.122(b) (“no later than one month after the institution date of any *inter partes* review for which joinder is requested.”).

More specifically, Petitioner respectfully requests that the Board institute review of IPR2025-01248 based on the concurrently-filed petition and that it grant this motion **if, and only if**, the Board has previously denied institution of *Meta Platforms, Inc. v. Sterling Computers Corp.*, IPR2025-00430 (“the 430 Proceeding”).

Meta has conferred with X, and X, including the real parties-in-interest identified in the X IPR, does not oppose this Motion for Joinder. The instant Petition is substantially the same as the X IPR: it involves the same patent, same claims, same grounds of unpatentability, and the same evidence (including the same prior art combinations supported by the same expert declarations) as the X IPR. If joined Meta will assume a “silent understudy” role and will not take an active role in the

inter partes review proceeding unless the X Petitioner ceases to participate in the instituted IPR. Thus, the proposed joinder will neither unduly complicate the X IPR nor delay its schedule. As such, the joinder will promote judicial efficiency in determining patentability in the X IPR without prejudice to Patent Owner.

II. BACKGROUND AND RELATED PROCEEDINGS

Sterling Computer Corporation is the purported owner of the '217 Patent. Sterling asserted the '217 patent against each of X and Petitioner in two separate actions: *Sterling Computers Corp. v. X Corp.*, Case No. 1:24-cv-00552 (W.D. Tex. May 22, 2024) and *Sterling Computers Corp. v. Meta Platforms, Inc.*, Case No. 1-24-cv- 00551 (W.D. Tex. May 22, 2024). The below summarizes the pre-existing *inter partes* review proceedings as to the '217 patent:

IPR Proceedings	Key Dates
<i>X Corp. v. Sterling Computers Corp.</i> , IPR2025-00299	<u>Filed</u> : Dec. 12, 2024 <u>Institution Decision</u> : Instituted on June 10, 2025
<i>Meta Platforms, Inc. v. Sterling Computers Corp.</i> , IPR2025-00430	<u>Filed</u> : Jan. 31, 2025 <u>Institution Decision Due</u> : Sept. 10, 2025

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Leahy-Smith America Invents Act (AIA) permits joinder of *inter partes* review (IPR) proceedings. Joinder is governed by 35 U.S.C. § 315(c), which states:

(c) JOINDER. – If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

The AIA’s legislative history makes clear that joinder is to be liberally granted. 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl).

A motion for joinder should “(1) set forth the reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified.” *Dell Inc. v. Network-1 Sec. Solutions, Inc.*, IPR2013-00385, Paper 17 (July 29, 2013); *Hyundai Motor Co. v. Am. Vehicular Scis. LLC*, IPR2014-01543, Paper 11, at 3 (Oct. 24, 2014); *Macronix Int’l Co. v. Spansion LLC*, IPR2014-00898, Paper 15, at 4 (Aug. 13, 2014) (quoting *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15, at 4 (April 24, 2013)).

B. Meta’s Motion for Joinder is Timely

A motion for joinder is timely if the moving party files within one month of institution of the *inter partes* review for which joinder is requested. 37 C.F.R. 42.122(b). Because Meta files this motion within one month after a decision on the institution of the X IPR, this motion is timely.

C. Joinder is Appropriate

If the Board were to deny institution of Meta's Petition in the 430 Proceeding, Petitioner respectfully submits that Joinder with the X IPR would be appropriate. Meta's Petition does not raise any new grounds of unpatentability and does "not present new issues that might complicate or delay" the X IPR. *See Enzymotec Ltd. v. Neptune Techs & Bioresources, Inc.*, IPR2014-00556, Paper 19, at 5 (July 9, 2014). Meta's Petition is substantially identical to the petition in the X IPR, challenging the same claims of the '217 Patent on the same grounds and relying on the same expert testimony. Thus, the only difference between Meta's Petition and the petition filed in the X IPR are the removal of sections addressing discretionary denial (including § 325(d) and *Fintiv* (35 U.S.C. § 314(a))) and appropriate updates to the Mandatory Notices.

By joinder, a single Board decision may dispose of the issues raised in the X IPR for all interested parties. Moreover, both district court cases brought by Sterling against X and Petitioner have been stayed to allow IPR proceedings against the '217 patent. *Sterling Computers Corp. v. X Corp.*, Case No. 1:24-cv-00552 (W.D. Tex. May 22, 2024), ECF No. 46 (granting stay pending resolution of the X IPR); *Sterling Computers Corp. v. Meta Platforms, Inc.*, Case No. 1-24-cv-00551 (W.D. Tex. Feb. 24, 2025), ECF No. 45 (granting "stay of all proceedings in this matter pursuant to

the agreement of the Parties described herein pending the PTAB's final written decisions on all *inter partes* review proceedings regarding the '217 Patent").

Joinder would, therefore, have little, if any, impact on the X IPR, the schedule would not be affected, no additional briefing or discovery would be required, and no additional burdens would be placed on any party or the PTAB, as detailed below. In fact, joinder will help efficiently resolve the disputes among the parties.

1. No New Grounds of Unpatentability in the Petition

Meta's Petition does not assert any new grounds of unpatentability. It challenges the same claims (1-22) of the '217 Patent based on the same arguments and analysis, prior art, evidence (including expert declaration), and five grounds of unpatentability as the X IPR. *See, e.g., Hyundai*, IPR2014-01543, Paper 11, at 2-4; *Dell*, IPR2013-00385, Paper 17, at 6-10.

2. No Impact on the Schedule for the Existing IPR Proceeding

Because Meta's Petition raises no new grounds of unpatentability, and because a Scheduling Order has been established for the X IPR less than one month ago, joinder should have no impact on the schedule of the X IPR. *See Sony Corp. v. Memory Integrity, LLC*, IPR2015-01353, Paper 11, at 6 (Oct. 15, 2015) (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 IPRJ”). Meta will adhere to all applicable deadlines set in the Scheduling Order for the X IPR.

As discussed further below, Meta is willing to limit its participation in this proceeding to a “silent understudy.” In the event that the X IPR is terminated with respect to the X Petitioner, only then does Meta intend to “step into the shoes” of the dismissed petitioner and materially participate in the joined proceedings. Accordingly, for the reasons stated above, joinder of Meta to the X IPR will not affect the Board’s ability to complete its review and final decision within the statutory time limits under 35 U.S.C. § 316(a)(11) and 37 C.F.R. § 42.100(c).

3. Briefing and Discovery Will Be Simplified

As a “silent understudy,” Meta agrees that, if joined, the following conditions will apply so long as X remains an active party, as previously approved by the Board in other joinder circumstances:

(a) all filings by Meta in the joined proceeding be consolidated with the filings of X, unless a filing solely concerns issues that do not involve X;

(b) Meta shall not be permitted to raise any new grounds not instituted by the Board in the X IPR, or introduce any argument not already introduced by X;

(c) With regard to taking of testimony, Meta will abide by 37 C.F.R. § 42.53 or any agreement between the Patent Owner and X.

See Mylan Pharms. Inc. v. Novartis AG, IPR2015-00268, Paper 17, at 5-6 (Apr. 10, 2015) (finding the same proposed limitations “are consistent with the ‘understudy’ role that Petitioner agrees to assume, as well as Petitioner’s assertion that its presence would not require introducing any additional arguments, briefing or discovery.”). Meta also is willing to abide by any additional conditions the Board deems appropriate.

4. No Prejudice to Patent Owner

Joinder of Petitioner to the X IPR will not create any additional burden on the Patent Owner. The Patent Owner need not expend any additional resources above and beyond those required in the current X IPR.

IV. CONCLUSION

For the foregoing reasons, Meta respectfully requests **if, and only if**, institution is denied in IPR2025-00430, that its Petition for *inter partes* review of the ’217 patent in this IPR (IPR2025-01248) be granted and that the proceeding be joined with the X IPR (IPR2025-00299).

Date: July 10, 2025

Respectfully submitted,

/ Jessica Kaiser /

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CERTIFICATE OF SERVICE

I hereby certify that on July 10, 2025 true and correct copies of the foregoing **PETITIONER’S MOTION FOR JOINDER UNDER 35 U.S.C. § 315(C) AND 37 C.F.R. §§42.22 AND 42.122(B)**, I caused to be served a true and correct copy of the foregoing and any accompanying exhibits by FedEx on the following counsel:

Padda Law Group
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A courtesy copy was also sent via electronic mail to Patent Owner’s litigation counsel listed below:

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Date: July 10, 2025