

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABB INC.
Petitioner,

v.

ROY-G-BIV CORPORATION
Patent Owner

Case IPR2013-00286
Patent 8,073,557 B2

Before, THOMAS L. GIANNETTI, BRYAN F. MOORE and, JENNIFER S. BISK, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION
Motion for Joinder
37 C.F.R. § 42.122(b)

I. INTRODUCTION

ABB Inc. (ABB) filed a petition for *inter partes* review of U.S. Patent 8,073,557 (the '557 Patent) on May 17, 2013 (Paper 1) (the Petition). With its Petition, ABB filed a Motion for Joinder (Paper 4), seeking to join this case with *ABB, Inc. v. ROY-G-BIV Corporation*, IPR2013-00074, instituted on April 18, 2013. In a separate decision, entered today, we grant the Petition, which has been limited mainly to references that also are being asserted in IPR2013-00074 and in another related case involving the same parties, also instituted on April 18, 2013, namely, IPR2013-00062. For the reasons that follow, we grant ABB's Motion for Joinder.

II. BACKGROUND

On May 29, 2013, the Board held a teleconference concerning the Petition and the accompanying motion for joinder. On May 30, 2013, the Board issued an order authorizing ABB to file a motion limiting the Petition as discussed on the call, in order to make joinder with the IPR2013-00074 more feasible. Paper 6 (May 30, 2013 Order). The Board's May 30, 2013 Order authorized ABB to file a motion to limit the Petition to certain claims and grounds to reduce Patent Owner's burden in responding and to facilitate joinder.

In response, on June 6, 2013, ABB filed a motion to limit the Petition to the following grounds of unpatentability of the '236 Patent: Gertz, Stewart, Morrow, Brockschmidt, and Architect render claims 26, 29, 30, and 46-59 obvious. Paper 10.

On June 10, 2013, the Board granted the motion to limit the Petition as requested by ABB. Paper 11. On June 24, 2013, Patent Owner Roy-G-Biv

Corporation (Roy-G-Biv) filed a waiver of the right to file both a preliminary response and an opposition to the motion for joinder. Paper 12.

III. DISCUSSION

The Leahy-Smith America Invents Act (AIA) permits joinder of like review proceedings. Thus, an *inter partes* review (IPR) may be joined with another *inter partes* review. The statutory provision governing joinder of *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads as follows:

(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.

As the movant, ABB bears the burden to show that joinder is appropriate. 37 C.F.R. § 42.20(c). In its Motion for Joinder, ABB notes that IPR2013-00074 involves the same parties, the same patent, and much of the same prior art as this proceeding. Motion for Joinder, p. 3. As noted above, ABB has simplified this proceeding by limiting the number of challenges to one ground. The prior art references for this ground substantially overlap with the references at issue in IPR2013-00074. This facilitates scheduling of the joined actions and minimizes delay.

In exercising its discretion to grant joinder, the Board considers the impact of both substantive issues and procedural matters on the proceedings, as well as any other appropriate considerations.

Substantive issues in this IPR would not be unduly complicated by joining with IPR2013-00074 because the joinder introduces only two pieces of new prior

art (both of which are exhibits in IPR2013-00074). Regarding procedural matters, we note that ABB and Roy-G-Biv each indicated that they were satisfied with the dates in the current Scheduling Order in IPR2013-00074 (Paper 18); however, Petitioner noted that the schedule may have to be adjusted depending on the outcome of joinder motions. The Scheduling Order in IPR2013-00074 sets the final hearing for January 23, 2014. Final hearing and final determination should not be delayed by joining the two proceedings. Another consideration is that Roy-G-Biv does not oppose the motion for joinder.

IV. CONCLUSION

Under the circumstances, we are persuaded that for all of the foregoing reasons granting ABB's Motion for Joinder will not unduly complicate or delay IPR2013-00074 and therefore the motion should be granted.

V. ORDER

In view of the foregoing, it is therefore

ORDERED that IPR2013-00286 is joined with IPR2013-00074;

FURTHER ORDERED that Patent Owner is given leave to file a Supplemental Patent Owner Response of up to 10 pages. The response will be filed no later than August 30, 2013 and strictly is limited to addressing the new grounds added by joinder;

FURTHER ORDERED that the Scheduling Order in place for IPR2013-00074 shall govern the joined proceedings, except that the dates identified as DATES 2-5 contained in the Scheduling Order may be modified by agreement of the parties, but no later than DUE DATE 6;

FURTHER ORDERED that DUE DATE 7 in the Scheduling Order shall not be changed, and, in the event of any changes to the schedule, the parties inform the Board promptly in the form of a notice of stipulation;

FURTHER ORDERED that this proceeding (IPR2013-00286) is terminated under 37 C.F.R. § 42.72 and all further filings in the joined proceeding shall be made in IPR2013-00074; and

FURTHER ORDERED that the case caption in IPR2013-00074 shall be changed to reflect joinder with this proceeding in accordance with the attached example.

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