

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ORACLE CORPORATION,  
Petitioner,

v.

CROSSROADS SYSTEMS, INC.,  
Patent Owner.

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Case IPR2015-00854  
Patent 7,934,041 B2

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Before NEIL T. POWELL, KRISTINA M. KALAN, J. JOHN LEE, and  
KEVIN W. CHERRY, *Administrative Patent Judges*.

POWELL, *Administrative Patent Judge*.

DECISION  
Institution of *Inter Partes* Review  
*37 C.F.R. § 42.108*

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

## INTRODUCTION

On March 6, 2015, Oracle Corporation (“Oracle”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–53 of U.S. Patent No. 7,934,041 B2 (Ex. 1001, “the ’041 patent”). Concurrently with the Petition, Oracle filed a Motion for Joinder (Paper 3, “Mot.”), requesting that this proceeding be joined with *Cisco Systems, Inc. v. Crossroads Systems, Inc.*, Case IPR2014-01463 (“1463 IPR”). Mot. 1. Patent Owner Crossroads Systems, Inc. (“Crossroads”) filed a Preliminary Response (Paper 12, “Prelim. Resp.”) on June 22, 2015. Crossroads did not file an opposition to the Motion for Joinder.

For the reasons discussed below, we institute an *inter partes* review of all challenged claims and grant Oracle’s Motion for Joinder.

## INSTITUTION OF *INTER PARTES* REVIEW

In the 1463 IPR, an *inter partes* review of claims 1–53 of the ’041 patent was instituted. 1463 IPR, slip op. at 20 (PTAB Mar. 17, 2015) (Paper 9). Specifically, an *inter partes* review was instituted (1) as to claims 1–14, 16–33, 35–50, and 53 as allegedly being unpatentable over the CRD-5500 Manual<sup>1</sup> and the HP Journal<sup>2</sup>; and (2) as to claims 15, 34, 51, and 52 as

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<sup>1</sup> CMD TECHNOLOGY, INC., CRD-5500 SCSI RAID CONTROLLER USER’S MANUAL (Rev. 1.3, 1996) (Ex. 1004, “CRD-5500 Manual”).

<sup>2</sup> HEWLETT-PACKARD JOURNAL, Oct. 1996 (Ex. 1006, “HP Journal”). The HP Journal is a collection of articles dated October 1996. Ex. 1006, 1–3. The portions of the HP Journal relied on by Oracle share a common author, similar subject matter, and the same apparent publication date in the same issue of the journal. In its Preliminary Response, Crossroads does not dispute that one of ordinary skill would have combined the teachings of the different articles in the HP Journal cited by Oracle. Thus, for purposes of this Decision, we refer to these HP Journal articles together.

allegedly being unpatentable over the CRD-5500 Manual, the HP Journal, and the Fibre Channel Standard.<sup>3</sup> *Id.* The Petition in this proceeding challenges the same claims, asserts identical grounds of unpatentability, and relies on the same evidence as presented in the 1463 IPR. Pet. 1; Mot. 1. Oracle represents that the Petition “copies verbatim the challenges set forth in the petition in [the 1463 IPR] and relies upon the same evidence, including the same expert declaration.” Pet. 1 (citation omitted); *see* Mot. 1.

In its Preliminary Response, Crossroads does not present any arguments concerning the merits of the ground of unpatentability asserted against the challenged claims. Instead, Crossroads argues the Petition should be denied under 35 U.S.C. § 325(d). Prelim. Resp. 1–26. Specifically, Crossroads notes that the present Petition “is the second of *three* petitions for *inter partes* review filed by [Oracle] against the ’041 Patent.” *Id.* at 1. According to Crossroads, the present Petition is the product of Oracle’s improper efforts to use the Board’s decision in the earlier-filed case, IPR2014-01177 (“1177 IPR”), as a guide to address deficiencies in its earlier petition. *Id.* at 11–15 (citing prior Board decisions). Crossroads contends the present Petition represents “nothing more than a ‘second bite at the apple,’” where the only difference compared to Oracle’s earlier petition “is the presence of additional reasoning to support the assertion of unpatentability over the same prior art.” *Id.* at 11 (quoting *Samsung Elecs. Co. v. Rembrandt Wireless Techs., LP*, Case IPR2015-00118, slip op. at 6 (PTAB Jan. 28, 2015) (Paper 14)). Crossroads notes that the Board’s rules must be “construed to secure the just, speedy, and

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<sup>3</sup> AMERICAN NATIONAL STANDARDS INSTITUTE, INC., FIBRE CHANNEL PHYSICAL AND SIGNALING INTERFACE (FC-PH) X3.230, June 1994 (Ex. 1007, “Fibre Channel Standard”).

inexpensive resolution of every proceeding,” and asserts that instituting trial on Oracle’s Petition in this proceeding would frustrate that purpose. *Id.* at 15–16 (quoting 37 C.F.R. § 42.1(b)). We are not persuaded that denial of the Petition under § 325(d) is warranted.

The facts and circumstances of this case do not support Crossroads’s allegations. Oracle and others filed an earlier petition in the 1177 IPR. *Oracle Corp. v. Crossroads Systems, Inc.*, Case IPR2014-01177, Paper 5 (PTAB July 24, 2014) (“1177 IPR Petition”). Cisco Systems, Inc. and Quantum Corporation (“Cisco/Quantum”) filed the 1463 IPR on September 8, 2014. 1463 IPR, Paper 3 (“1463 IPR Petition”). A decision on institution in the 1177 IPR was issued on January 28, 2015. 1177 IPR, Paper 13. When Oracle filed the present Petition on March 6, 2015, it did not base the Petition on the 1177 IPR Petition, nor did it tailor the present Petition specifically to address issues raised in the institution decision in that earlier case. Rather, it copied verbatim the challenges presented in the 1463 IPR Petition, which was filed well before the institution decision in the 1177 IPR. Mot. 1; Pet. 1.

Moreover, the present case can be distinguished from those cited by Crossroads (*see* Prelim. Resp. 8–13, 16–26) because institution of the present Petition would not subject Crossroads or the ’041 patent to any new challenges. For example, in the *Samsung/Rembrandt* case, the latter-filed petition challenged the same claims for which institution of an *inter partes* review had been denied in a prior case. *Samsung/Rembrandt*, Case IPR2015-00118, Paper 14 at 2; *see also ZTE Corp. v. ContentGuard Holdings, Inc.*, Case IPR2013-00454, slip op. at 2 (PTAB Sept. 25, 2013) (Paper 12) (declining to institute *inter partes* review on second petition

challenging claims for which *inter partes* review was previously denied); *Unilever, Inc. v. Procter & Gamble Co.*, Case IPR2014-00506, slip op. at 2 (PTAB July 7, 2014) (Paper 17) (same); *Butamax Advanced Biofuels LLC v. Gevo, Inc.*, Case IPR2014-00581, slip op. at 2, 4 (PTAB Oct. 14, 2014) (Paper 8) (same); *CustomPlay, LLC v. ClearPlay, Inc.*, Case IPR2014-00783, slip op. at 2, 6 (PTAB Nov. 7, 2014) (Paper 9) (same); *Zimmer Holdings, Inc. v. Bonutti Skeletal Innovations LLC*, Case IPR2014-01080, slip op. at 2 (PTAB Oct. 31, 2014) (Paper 17) (same). Unlike *Samsung/Rembrandt*, Oracle's Petition in this case presents only challenges identical to those already instituted in the 1463 IPR, and Oracle further seeks to join this proceeding with the 1463 IPR.<sup>4</sup> Thus, instituting an *inter partes* review based on the present Petition, and joining it with the 1463 IPR, would not prevent "the just, speedy, and inexpensive resolution" of either the 1463 IPR or this proceeding.

In addition, differences exist between the arguments and evidence presented in this proceeding and those presented in the 1177 IPR. The grounds of unpatentability asserted in the present Petition are obviousness of (1) claims 1–14, 16–33, 35–50, and 53 over the CRD-5500 Manual and the HP Journal; and (2) claims 15, 34, 51, and 52 over the CRD-5500 Manual, the HP Journal, and the Fibre Channel Standard. Pet. 7–8. In addition to those references, the present Petition relies on the Declaration of Andrew Hospodor, Ph.D. *See, e.g.*, Pet. 16–20 (arguing that one of ordinary skill would have been motivated to combine the teachings of the CRD-5500

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<sup>4</sup> As discussed further below, Oracle's Motion for Joinder demonstrates that joining this proceeding with the 1463 IPR would cause no delay in the resolution of the 1463 IPR and would not add significantly to the burden on any party, including Crossroads.

Manual and the HP Journal, citing as supporting evidence Dr. Hospodor's declaration testimony); *see generally* Ex. 1003 (Declaration of Andrew Hospodor, Ph.D.).

The 1177 IPR Petition, however, relied on different testimony from a different witness—Professor Jeffrey S. Chase, Ph.D. *See, e.g.*, 1177 IPR Petition 17–19 (citing Ex. 1010). Also, although the 1177 IPR Petition relied on the same CRD-5500 Manual as the present Petition, the 1177 IPR Petition advanced grounds of unpatentability combining the CRD Manual with teachings from the CRD-5500 Data Sheet,<sup>5</sup> and the Smith article.<sup>6</sup> 1177 IPR Petition 5. The present Petition, however, does not include the CRD-5500 Data Sheet as the basis for any asserted ground of unpatentability. Further, although the Smith article is included in the HP Journal relied on in this proceeding, the present Petition further relies on other portions of the HP Journal that were not included in the 1177 IPR Petition. *See* Pet. 4, 15–18, 26, 31–32, 42 (citing Ex. 1006, 94–96 (portions of Meryem Primmer, *An Introduction to Fibre Channel*, HEWLETT-PACKARD JOURNAL, Oct. 1996)); *see also id.* at 15–16, 42, 51 (citing Ex. 1006, 5 (portions of C. L. Leath, *In This Issue*, HEWLETT-PACKARD JOURNAL, Oct. 1996)). Although Crossroads is correct that there are some similarities between the present Petition's arguments and cited evidence, and those of the 1177 IPR Petition, we are not persuaded denial of the present Petition

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<sup>5</sup> The “CRD-5500 Data Sheet” is a document describing a product, the CRD-5500 RAID Disk Array Controller. 1177 IPR, Ex. 1004. It was also filed in the present proceeding as Exhibit 1005.

<sup>6</sup> Judith A. Smith & Meryem Primmer, *Tachyon: A Gigabit Fibre Channel Protocol Chip*, HEWLETT-PACKARD JOURNAL, Oct. 1996. 1177 IPR, Ex. 1005 (“Smith article”). The Smith article is one of the articles included in the HP Journal relied on in this proceeding. *See* Ex. 1006, 99–112.

under § 325(d) is warranted based on the facts and circumstances of this case.

Denial of a petition under § 325(d) is discretionary, not mandatory. *See* 35 U.S.C. § 325(d) (“[The Board, on behalf of the Director,] *may* take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”) (emphasis added). Based on the parties’ arguments and the present record, we decline to exercise that discretion.

Consequently, for the above reasons, and in view of the fact that the present Petition is virtually identical to the petition in the 1463 IPR, we determine Oracle has demonstrated sufficiently under 35 U.S.C. § 314 that an *inter partes* review should be instituted in this proceeding on the same grounds of unpatentability as the grounds on which we instituted *inter partes* review in the 1463 IPR.

#### MOTION FOR JOINDER

An *inter partes* review may be joined with another *inter partes* review, subject to certain statutory provisions:

(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.

35 U.S.C. § 315(c); *see also* 37 C.F.R. § 42.122. As the moving party, Oracle bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c).

As an initial matter, the Motion for Joinder meets the requirements of 37 C.F.R. § 42.122(b) because the Motion was filed on March 6, 2015 (Paper 3, 1), which is not later than one month after the 1463 IPR was instituted on March 17, 2015 (1463 IPR, Paper 9).

Additionally, the present Petition challenges the same patent and the same claims as those under *inter partes* review in the 1463 IPR, and the Petition also asserts the same grounds of unpatentability based on the same prior art and the same evidence, including the same declaration testimony. Mot. 1; *compare* Pet. 7–8, *with* 1463 IPR, Paper 3, 9–10. The present Petition does not advance any other grounds of unpatentability, or present any new evidence not already of record in the 1463 IPR. Indeed, the Petition repeats verbatim most of the content of the petition in the 1463 IPR. *See* Mot. 5.

Oracle further asserts that granting joinder would not require any alterations to the existing scheduling order in the 1463 IPR. *Id.* at 6. Moreover, Oracle represents that it “has agreed to not materially participate in the joined proceedings unless and until the parties to IPR2014-01463 are dismissed from the joined proceedings or elect to transfer control to [Oracle], as may occur in the event of settlement or advanced settlement negotiations.” *Id.* at 2. As such, Oracle “does not intend to file separate papers or conduct separate cross examinations of any witnesses,” if joined to the 1463 IPR. *Id.* at 5. Oracle also represents that the petitioners in the 1463 IPR do not oppose joinder of the present proceeding. *Id.* at 1–2. As previously noted, Crossroads did not file an opposition to Oracle’s Motion for Joinder.



Based on the facts and circumstances discussed above, Oracle has established good cause for joining this proceeding with the 1463 IPR. Joinder of this proceeding with the 1463 IPR will not require any delay or modification to the scheduling order already in place for the 1463 IPR. Crossroads will not be unduly prejudiced by the joinder of these proceedings, and joining Oracle's identical challenges to those in the 1463 IPR will lead to greater efficiency while reducing the resources expended by both Crossroads and the Board. Thus, we conclude that granting the Motion for Joinder under these circumstances would help "secure the just, speedy, and inexpensive resolution" of these proceedings. *See* 37 C.F.R. § 42.1(b); *Microsoft Corp. v. Proxyconn, Inc.*, Case IPR2013-00109, slip op. at 2–3 (PTAB Feb. 25, 2013) (Paper 15) (representative).

#### ORDER

It is

ORDERED that pursuant to 35 U.S.C. § 314, an *inter partes* review in IPR2015-00854 is hereby instituted as to claims 1–53 of U.S. Patent No. 7,934,041 B2 on the following grounds of unpatentability:

- A. Claims 1–14, 16–33, 35–50, and 53 under 35 U.S.C. § 103(a) for obviousness over CRD-5500 Manual and HP Journal; and
- B. Claims 15, 34, 51, and 52 under 35 U.S.C. § 103(a) for obviousness over CRD-5500 Manual, HP Journal, and Fibre Channel Standard;

FURTHER ORDERED that Oracle's Motion for Joinder is *granted*;

FURTHER ORDERED that IPR2015-00854 is hereby joined with IPR2014-01463;

FURTHER ORDERED that the grounds of unpatentability on which trial was instituted in IPR2014-01463 are unchanged and remain the sole grounds on which trial has been instituted;

FURTHER ORDERED that the Revised Scheduling Order entered in IPR2014-01463 (Paper 14) is unchanged and shall govern the schedule of the joined proceeding;

FURTHER ORDERED that Oracle, Cisco Systems, Inc., and Quantum Corporation will file all papers jointly in the joined proceeding as consolidated filings, and will identify each such paper as “Consolidated,” except that papers filed on behalf of fewer than all three parties need not be marked Consolidated;

FURTHER ORDERED that IPR2015-00854 is terminated under 37 C.F.R. § 42.72, and all further filings in the joined proceeding are to be made in IPR2014-01463;

FURTHER ORDERED that a copy of this Decision will be entered into the record of IPR2014-01463; and

FURTHER ORDERED that the case caption in IPR2014-01463 shall be modified to reflect joinder with this proceeding in accordance with the attached example.

IPR2015-00854  
Patent 7,934,041 B2

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*Example Case Caption for Joined Proceeding*

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CISCO SYSTEMS, INC., QUANTUM CORPORATION,  
and ORACLE CORPORATION,  
Petitioners,

v.

CROSSROADS SYSTEMS, INC.,  
Patent Owner.

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Case IPR2014-01463<sup>1</sup>  
Patent 7,934,041 B2

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<sup>1</sup> Case IPR2015-00854 has been joined with this proceeding.