

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TAIWAN SEMICONDUCTOR MANUFACTURING COMPANY, LTD.,
TSMC NORTH AMERICA CORP., FUJITSU SEMICONDUCTOR
LIMITED, and FUJITSU SEMICONDUCTOR AMERICA, INC.,
Petitioner,

v.

ZOND, LLC,
Patent Owner.

Case IPR2014-01481
Patent 6,896,773 B2

Before KEVIN F. TURNER, JONI Y. CHANG, SUSAN L.C. MITCHELL,
and JENNIFER M. MEYER, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION
Granting Motion for Joinder
37 C.F.R. § 42.122

INTRODUCTION

Taiwan Semiconductor Manufacturing Company, Ltd., TSMC North America Corp., Fujitsu Semiconductor Limited, and Fujitsu Semiconductor America (collectively, “Petitioner”) filed a Petition requesting *inter partes* review of claims 21–33 and 40 of U.S. Patent No. 6,896,773 B2 (Ex. 1101, “the ’773 Patent”). Paper 3 (“Pet.”). Pursuant to 37 C.F.R. § 42.122(b), Petitioner also filed a Motion for Joinder, seeking to join the instant proceeding with *The Gillette Company v. Zond, LLC*, Case IPR2014-00726 (PTAB) (“IPR2014-00726”). Paper 5 (“Mot.”).

The Gillette Company (“Gillette”), the Petitioner in IPR2014-00726, does not oppose the instant Petitioner’s Motion for Joinder. Mot. 2. Patent Owner, Zond, LLC (“Zond”), filed a Preliminary Response to the Petition (Paper 10, “Prelim. Resp.”), and an Opposition to Petitioner’s Motion for Joinder (Paper 9, “Opp.”). In a separate decision, we institute *inter partes* review as to the same claims on the same ground of unpatentability for which we instituted trial in IPR2014-00726. For the reasons set forth below, Petitioner’s Motion for Joinder is *granted*.

ANALYSIS

The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”) permits joinder of like review proceedings. The Board, acting on behalf of the Director, has the discretion to join an *inter partes* review with another *inter partes* review. *See* 35 U.S.C. § 315(c). Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. When exercising its discretion, the Board is mindful that patent trial regulations, including the

rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b). The Board considers the impact of both substantive issues and procedural matters on the proceedings.

As the moving party, Petitioner bears the burden to show that joinder is appropriate. 37 C.F.R. §§ 42.20(c), 42.122(b). In its Motion for Joinder, Petitioner contends that joinder, in this particular situation, is appropriate because: (1) “it is the most expedient way to secure the just, speedy, and inexpensive resolution of the related proceedings” (Mot. 4); (2) Petitioner’s Petition is substantively identical to Gillette’s Petition filed in IPR2014-00726 (*id.* at 5); (3) Petitioner agrees to consolidated filings and discovery (*id.* at 5–6); (4) joinder would not affect the schedule in IPR2014-00726 (*id.* at 6–7); and (5) joinder would streamline the proceedings, reduce the costs and burdens on the parties, and increase efficiencies for the Board without any prejudice to Zond (*id.* at 7).

We agree that the substantive issues in IPR2014-00726 would not be affected by joinder, because the instant Petition is substantively identical to Gillette’s Petition filed in IPR2014-00726. Notably, the instant Petition asserts identical grounds of unpatentability, challenging the same claims of the ’773 Patent. *Compare* Pet. 22–35, 47–50, 54–58, *with* IPR2014-00726, Paper 3 (“’726 Pet.”), 23–36, 47–50, 55–59. Petitioner also submits identical proposed claim constructions, as well as the same Declaration of Mr. Richard DeVito. *Compare* Pet. 4–6, *with* ’726 Pet. 4–6; *compare* Ex. 1105, *with* ’726 Ex. 1105. Moreover, we institute the instant trial based on the same ground for which we instituted trial in IPR2014-00726.

Therefore, the instant Petition raises no new issues beyond those already before us in IPR2014-00726.

In its Opposition, Zond indicates that it has specific requirements for joinder, although it does not raise specific objections. Opp. 1. Zond proposes a procedure for the joined proceeding to consolidate the schedule, filings, and discovery. Opp. 1–3.

We agree with the parties that conducting a single joined proceeding for reviewing claims 21–33 and 40 of the '773 Patent is more efficient than conducting multiple proceedings, eliminating duplicate filings and discovery. As previously indicated, Petitioner agrees to consolidated filings for all substantive papers. Mot. 5–6. Petitioner further indicates that it will not file any paper with arguments separate from those advanced by the consolidated filings, eliminating duplicate briefing. *Id.* at 6. Petitioner further agrees to consolidated discovery, as each Petitioner proffers the same Declaration of Mr. DeVito. *Id.* Petitioner indicates that Petitioners of the joined proceeding (Gillette and Petitioner) collectively will designate an attorney to conduct the cross-examination of any witnesses produced by Zond and the redirect of any witnesses produced by Petitioners, within the timeframe normally allotted by the rules for one party. *Id.* Moreover, joinder will not require any change to the trial schedule in IPR2014-00726, allowing the trial still to be completed within one year. *Id.* at 8–9. Given that the instant Petition raises no new issues, and Petitioners agree to consolidated filings and discovery, the impact of joinder on IPR2014-00726 will be minimal, and joinder will streamline the proceedings, reducing the costs and burdens on the parties and the Board.

For the foregoing reasons, Petitioner has met its burden of demonstrating that joinder of the instant proceeding with IPR2014-00726 is warranted under the circumstances.

ORDER

Accordingly, it is:

ORDERED that Petitioner's Motion for Joinder with IPR2014-00726 is *granted*;

FURTHER ORDERED that the instant proceeding is joined with IPR2014-00726;

FURTHER ORDERED that the grounds of unpatentability on which a trial was instituted in IPR2014-00726 are unchanged;

FURTHER ORDERED that the Scheduling Order for IPR2014-00726 (Paper 9) shall govern the joined proceeding, with the exception of the initial conference call; the initial conference call for this proceeding is scheduled on November 13, 2014 at 2:00 PM ET;

FURTHER ORDERED that the instant proceeding is instituted, joined, and terminated under 37 C.F.R. § 42.72, and all further filings in the joined proceeding shall be made only in IPR2014-00726;

FURTHER ORDERED that, throughout IPR2014-00726, Petitioners (Gillette and Petitioner) will file papers, except for motions which do not involve the other parties, as consolidated filings¹; Gillette will identify each such filing as a consolidated filing and will be responsible for completing all

¹ The parties are directed to the Board's website, in particular FAQs C3, D5, and G8, for information regarding filings in the Patent Review Processing System (PRPS). See <http://www.uspto.gov/ip/boards/bpai/prps.jsp>.

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