

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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MACRONIX INTERNATIONAL CO., LTD., MACRONIX ASIA LIMITED,  
MACRONIX (HONG KONG) CO., LTD. and MACRONIX AMERICA, INC.  
Petitioners

v.

SPANSION LLC  
Patent Owner

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Case: IPR2014-00898

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**MOTION FOR JOINDER TO RELATED INSTITUTED  
INTER PARTES REVIEW UNDER 37 C.F.R. § 42.122(B)**

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Patent Trial and Appeal Board  
United States Patent and Trademark Office  
PO Box 1450  
Alexandria, Virginia 22313-1450  
*Submitted Electronically via the Patent Review Processing System*

Macronix International Co., Ltd., Macronix Asia Limited, Macronix (Hong Kong) Co., Ltd., and Macronix America, Inc. (collectively “Petitioners”) file this Motion for Joinder of the Petition for *Inter Partes* Review of Claims 7 and 14 of U.S. Patent No. 7,151,027 (“Second Petition”), with the instituted *inter partes* review, *Macronix International Co., Ltd., et al. v. Spansion LLC*, No. IPR2014-00108 (“IPR2014-00108”), pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b).

No fee is required for consideration of this Motion. Petitioners have paid the fee for IPR2014-00108, and are submitting herewith the fee for this Second Petition.

## **I. APPLICABLE RULES**

The rule permitting joinder of proceedings, 37 C.F.R. § 42.122(b) states:

Request for joinder. Joinder may be requested by a patent owner or petitioner. Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested. The time period set forth in § 42.101(b) shall not apply when the petition is accompanied by a request for joinder.

## **II. RELIEF REQUESTED**

Petitioners request that the Second Petition be joined with IPR2014-00108.

### III. STATEMENT OF MATERIAL FACTS

[1] On November 8, 2013 Petitioners filed a first petition for *inter partes* review of U.S. Patent No. 7,151,027 (“the ’027 Patent”). That petition was assigned number IPR2014-00108. In that Petition, Petitioner requested institution of *inter partes* review of all claims (claims 1-14) of the ’027 Patent.

[2] There is pending litigation before the United States International Trade Commission involving the ’027 Patent. A *Markman* hearing has been held, expert reports have been exchanged, and expert depositions have occurred. One of the secondary references relied on in the accompanying Petition, U.S. Patent Application No. 2003/0042520 was raised by Respondents in that investigation in their expert reports as a basis for invalidating certain claims of the ’027 Patent. Trial is currently scheduled in that matter for October 2014.

[3] On May 8, 2014, the Board instituted trial on claims 1-6 and 8-13 of the ’027 Patent based on the following grounds:

- a. Claims 1-4 and 8-10 under 35 U.S.C. § 102(b) as anticipated by Yuzuriha;
- b. Claims 5, 11, and 12 under 35 U.S.C. § 103(a) as obvious over Yuzuriha in view of Shukuri; and
- c. Claims 6 and 13 under 35 U.S.C. § 103(a) as unpatentable over Yuzuriha in view of Nakagawa.

[4] The Board found that Petitioners had not established, based on the record presented, that claims 7 and 14 are (1) anticipated by Nakagawa, (2) obvious over Yuzuriha and Nakagawa, or (3) obvious over Shukuri and Nakagawa. The Board denied other grounds for trial as being redundant.

[5] An initial conference call is currently scheduled for 10 AM on June 5, 2014 in IPR2014-00108, as well as several other co-pending trials between the parties.

[6] Concurrently with this Motion, Petitioners are filing their Second Petition, challenging claims 7 and 14 using Yuzuriha as the base reference for the obviousness challenge presented in the Second Petition.

#### **IV. ARGUMENT**

The Board has the authority under 35 U.S.C. § 315(c) to join a properly-filed second *inter partes* review petition to an instituted *inter partes* review proceeding. This request for joinder is timely filed under 37 C.F.R. § 42.122(b).

The Second Petition involves the same parties—Petitioners and Spansion—and the same patent. The Second Petition relies on a declaration by the same declarant as that presented in connection with IPR2014-00108 such that a single deposition of the declarant can occur in this proceeding. The Second Petition further adopts the Yuzuriha reference as the primary reference in an obviousness challenge so as to keep the issues narrow for the purposes of a joined proceeding.

Moreover, the Second Petition relies on U.S. Patent Application Publication No. 2003/0042520 to Tsukamoto *et al.* (hereafter “Tsukamoto”) which has been raised by Respondents in co-pending litigation before the ITC.

Since expert reports have been exchanged and expert depositions have occurred, Patent Owner has had ample time to consider both Yuzuriha and Tsukamoto and their combined teachings in developing its litigation positions in response to Petitioners’ positions regarding validity in the co-pending ITC litigation. To the extent that additional references have been cited in the Second Petition, they are provided to show the knowledge of those skilled in the art and should not present positions that surprise Patent Owner. Finally, the independent claims from which claims 7 and 14 depend are already involved in a just-instituted trial such that considering dependent claims 7 and 14 in a joined proceeding would assist in securing the “just, speedy, and inexpensive resolution” of both IPR2014-00108 and the Second Petition.

## **V. CONCLUSION**

For the foregoing reasons joinder of IPR2014-00108 with Petitioners’ Second Petition is respectfully requested.

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