

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

SPANSION LLC,
Patent Owner.

Case IPR2014-00898
Patent 7,151,027 B1

Before DEBRA K. STEPHENS, JUSTIN T. ARBES, and
RICHARD E. RICE, *Administrative Patent Judges*.

RICE, *Administrative Patent Judge*.

DECISION
Petitioner's Motion for Joinder
37 C.F.R. § 42.122

Introduction

Macronix International Co., Ltd., Macronix Asia Limited, Macronix (Hong Kong) Co., Ltd., and Macronix America, Inc. (collectively “Petitioner”) filed a Petition (Paper 2) and a Corrected Petition (Paper 6) to institute an *inter partes* review of claims 7 and 14 of U.S. Patent No. 7,151,027 B1 (Ex. 1001, “the ’027 patent”) pursuant to 35 U.S.C. §§ 311-319 and a motion for joinder with Case IPR2014-00108 (Paper 3) (“Mot.”). Patent Owner Spansion LLC (“Patent Owner”) filed an opposition (Paper 10) (“Opp.”) to Petitioner’s motion. For the reasons that follow, Petitioner’s motion is *denied*.¹

Related Case IPR2014-00108

On November 8, 2013, Petitioner filed a petition to institute an *inter partes* review of claims 1-14 of the ’027 patent. IPR2014-00108, Paper 1. On May 8, 2014, we granted the petition and instituted an *inter partes* review of claims 1-6 and 8-13. IPR2014-00108, Paper 16, 2. Petitioner subsequently filed its Petition and motion for joinder (Paper 3) in the instant proceeding challenging claims 7 and 14 on June 4, 2014, and filed its Corrected Petition on June 13, 2014. Petitioner also filed in Case IPR2014-00108, a proposed revised schedule, should its motion for joinder be granted. IPR2014-00108, Paper 21.

¹ In a decision entered concurrently, the Petition is granted, and an *inter partes* review is instituted, on a single ground of unpatentability.

Analysis

The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (AIA), created new administrative trial proceedings, including *inter partes* review, as an efficient, streamlined, and cost-effective alternative to district court litigation. The AIA permits the joinder of like proceedings. The Board, acting on behalf of the Director, has the discretion to join an *inter partes* review with another *inter partes* review. 35 U.S.C. § 315. Section 315(c) provides (emphasis added):

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.*

Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. The Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations. *See* 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (when determining whether and when to allow joinder, the Office may consider factors including “the breadth or unusualness of the claim scope” and claim construction issues). 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). As such, any motion for joinder must be filed “no later than one month after the institution date of any *inter partes* review

for which joinder is requested.” 37 C.F.R. § 42.122(b).

As the moving party, Petitioner has the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b). 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. *See Kyocera Corp. v. SoftView LLC*, IPR2013-00004, Paper 15, 4 (Apr. 24, 2013); Frequently Asked Question H5 on the Board’s website at <http://www.uspto.gov/ip/boards/bpai/prps.jsp>.

Petitioner contends that joining this case with Case IPR2014-00108 would assist in securing the just, speedy, and inexpensive resolution of both cases. Mot. 5. Petitioner essentially argues that joining the cases would have only a minimal impact on Patent Owner, because in this case Petitioner relies on the same declarant as in Case IPR2014-00108, adopts the same primary prior art reference (Yuzuriha²) as in Case IPR2014-00108, and asserts only a few additional references. *Id.* at 4-5. Petitioner further argues that Patent Owner should have considered, already, the combination of Yuzuriha and Tsukamoto,³ because those references have been asserted against Patent Owner in a co-pending International Trade Commission (ITC) investigation. *Id.* at 5. Petitioner further argues that its proposed revised schedule would add only seven weeks to each of the Due Dates under the existing Schedule, for example, extending Due Date 7 from January 13, 2015, to March 3, 2015. IPR2014-00108, Paper 21, 2-3.

² US 6,458,655 B1.

³ US 2003/0042520 A1.

IPR2014-00898
Patent 7,151,027 B1

Patent Owner opposes Petitioner's motion. Paper 10. In particular, Patent Owner argues that the Corrected Petition in the instant proceeding raises numerous substantive issues that are not present in Case IPR2014-00108 and that Patent Owner would be prejudiced by Petitioner's proposed revised schedule. *Id.* at 1-10. Patent Owner contends that the existing schedule should be extended by at least 12 weeks in the event we decide to join the cases. *Id.* at 8-9. Patent Owner's proposal would extend Due Date 7, for example, to April 7, 2015. *Id.* at 9. Petitioner further contends that the same extended schedule be adopted for related Case IPR2014-00105, at least through Due Date 3. *Id.* at 10.

Under either of the parties' proposed schedules, joinder would have a significant adverse impact on our ability to complete the existing proceeding in a timely manner, which weighs against granting the motion for joinder. The Board is charged with securing the just, speedy, and inexpensive resolution of every proceeding, and has the discretion to join or not join proceedings to ensure that objective is met. 37 C.F.R. §§ 42.1(b), 42.122. Case IPR2014-00108 was filed more than eight months ago and is already well underway, with Patent Owner having cross-examined Petitioner's Declarant and filed its response, and Petitioner's reply being due on October 6, 2014. *See* IPR2014-00108, Paper 17. Joinder at this stage would require a lengthy delay in the ongoing review. Further, Patent Owner objects to Petitioner's proposed revised schedule if joinder is permitted. *See* Paper 10. Nevertheless, while this proceeding is not being joined with Case IPR2014-00108, we will attempt to schedule both proceedings to maximize efficiencies and to complete both in a timely manner.

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