

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE GILLETTE COMPANY,
Petitioner,

v.

ZOND, LLC,
Patent Owner.

Cases IPR2014-01016
Patent 6,853,142 B2

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

TURNER, *Administrative Patent Judge.*

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

INTRODUCTION

The Gillette Company (“Gillette”) filed a Petition requesting *inter partes* review of claims 40 and 41 of U.S. Patent No. 6,853,142 B2 (“the ’142 Patent”). Paper 3 (“Pet.”). Pursuant to 37 C.F.R. § 42.122(b), Gillette also filed a renewed Motion for Joinder, seeking to join the instant proceeding with *GLOBALFOUNDRIES U.S., Inc. v. Zond, LLC*, Case IPR2014-01098 (PTAB) (“IPR2014-01098”). Paper 10 (“Mot.”).

GLOBALFOUNDRIES U.S., Inc., GLOBALFOUNDRIES Dresden Module One LLC & Co. KG, and GLOBALFOUNDRIES Dresden Module Two LLC & Co. KG, (collectively, “GF”), the Petitioner in IPR2014-01098, does not oppose Gillette’s renewed Motion for Joinder. Mot. 2. Patent Owner, Zond, LLC (“Zond”), filed a Preliminary Response to the Petition (Paper 8, “Prelim. Resp.”), and an Opposition to Gillette’s renewed Motion for Joinder (Paper 11, “Opp.”). In a separate decision, we institute *inter partes* review as to the same claims on the same grounds of unpatentability for which we instituted trial in IPR2014-01098. For the reasons set forth below, Gillette’s renewed 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, Gillette bears the burden to show that joinder is appropriate. 37 C.F.R. §§ 42.20(c), 42.122(b). In its renewed Motion for Joinder, Gillette 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. 5); (2) Gillette’s Petition is substantively identical to GF’s Petition filed in IPR2014-01098 (*id.* at 5–6); (3) Gillette agrees to consolidated filings and discovery (*id.* at 6–7); (4) joinder would not affect the schedule in IPR2014-01098 (*id.* at 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 8).

We agree that the substantive issues in IPR2014-01098 would not be affected by joinder, because Gillette’s Petition is substantively identical to GF’s Petition filed in IPR2014-01098. Notably, Gillette’s Petition asserts identical grounds of unpatentability, challenging the same claims of the ’142 Patent. *Compare* Pet. 17–60, *with* IPR2014-01098, Paper 2 (“’1098 Pet.”), 16–60. Gillette also submits identical proposed claim constructions, as well as the same Declaration of Dr. Uwe Kortshagen. *Compare* Pet. 12–17, *with* ’1098 Pet. 12–16; *compare* Ex. 1402, *with* ’1098 Ex. 1402. Moreover, we institute the instant trial based on the same grounds for which we instituted trial in IPR2014-01098. Therefore, Gillette’s Petition raises no new issues beyond those already before us in IPR2014-01098.

In its Opposition, Zond indicates that it is *not opposed to joinder*.
Opp. 1. Rather, Zond proposes a procedure for the joined proceeding to consolidate the schedule, filings, and discovery. Opp. 2–3.

We agree with the parties that conducting a single joined proceeding for reviewing claims 40 and 41 of the '142 Patent is more efficient than conducting multiple proceedings, eliminating duplicate filings and discovery. As previously indicated, Gillette agrees to consolidated filings for all substantive papers. Mot. 6. Gillette further indicates that it will not file any paper with arguments separate from those advanced by the consolidated filings, eliminating duplicate briefing. *Id.* Gillette further agrees to consolidated discovery, as each Petitioner proffers the same Declaration of Dr. Kortshagen. *Id.* at 6–7. Gillette indicates that Petitioners 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.* at 7. Moreover, joinder will not require any change to the trial schedule in IPR2014-01098, allowing the trial still to be completed within one year. *Id.* Given that Gillette's Petition raises no new issues, and Petitioners agree to consolidated filings and discovery, the impact of joinder on IPR2014-01098 will be minimal, and joinder will streamline the proceedings, reducing the costs and burdens on the parties and the Board.

For the foregoing reasons, Gillette has met its burden of demonstrating that joinder of the instant proceeding with IPR2014-01098 is warranted under the circumstances.

ORDER

Accordingly, it is:

ORDERED that Gillette's Motion for Joinder with IPR2014-01098 is *granted*;

FURTHER ORDERED that the instant proceeding is joined with IPR2014-01098;

FURTHER ORDERED that the grounds of unpatentability on which a trial was instituted in IPR2014-01098 are unchanged;

FURTHER ORDERED that the Scheduling Order for IPR2014-01098 (Paper 10) shall govern the joined proceeding; the initial conference call for the joined proceeding is scheduled on November 25, 2014 at 3:00 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 IPR2014-01098;

FURTHER ORDERED that, throughout IPR2014-01098, Petitioners (GF and Gillette) will file papers, except for motions which do not involve the other parties, as consolidated filings¹; GF will identify each such filing as a consolidated filing and will be responsible for completing all consolidated filings; the page limits set forth in 37 C.F.R. § 42.24 will apply to all consolidated filings; no individual Petitioner will receive any additional pages in addition to the page limits set forth in 37 C.F.R. § 42.24 for one party;

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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