

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE GILLETTE COMPANY,
Petitioner,

v.

ZOND, LLC,
Patent Owner.

Cases IPR2014-00984
Patent 7,147,759 B2

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

CHANG, *Administrative Patent Judge.*

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

INTRODUCTION

The Gillette Company (“Gillette”) filed a Petition requesting an *inter partes* review of claims 2, 3, 5–9, 13–16, 19, 41–43, and 45 of U.S. Patent 7,147,759 B2 (Ex. 1001, “the ’759 patent”). Paper 3 (“Pet.”). Pursuant to 37 C.F.R. § 42.122(b), Gillette also filed a revised Motion for Joinder with *GLOBALFOUNDRIES U.S., Inc. v. Zond, LLC.*, Case IPR2014-01087 (PTAB) (“IPR2014-01087”). Paper 10 (“Mot.”).

GlobalFoundries does not oppose Gillette’s request for joinder. Mot. 1. Patent Owner, Zond, LLC (“Zond”), filed a Preliminary Response to the Petition (Paper 7, “Prelim. Resp.”) and an Opposition to Gillette’s revised Motion for Joinder (Paper 11, “Opp.”). In a separate decision, entered concurrently, we institute an *inter partes* review as to the same claims on the same grounds of unpatentability for which we instituted trial in IPR2014-01087. For the reasons set forth below, Gillette’s revised 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. 35 U.S.C. § 315. The statutory provision governing joinder of *inter partes* review proceedings is 35 U.S.C § 315(c), which provides:

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. 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 revised 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 GlobalFoundries’s Petition filed in IPR2014-01087 (*id.* at 5–6); (3) Gillette agrees to consolidated filings and discovery (*id.* at 6–7); (4) joinder would not affect the schedule in IPR2014-01087 (*id.* at 7); (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 IPR2014-01087 would not be affected by joinder, because Gillette’s Petition is substantively identical to GlobalFoundries’s Petition filed in IPR2014-01087. Notably, Gillette’s Petition asserts identical grounds of unpatentability, challenging the same claims of the ’759 patent. *Compare* Pet. 17–60, with IPR2014-01087,

Paper 2 (“’1087 Pet.”), 18–60. Gillette also submits identical claim constructions, as well as the same Declaration of Dr. Uwe Kortshagen. *Compare* Pet. 14–17, *with* ’1087 Pet. 14–18; *compare* Ex. 1102, *with* ’1087 Ex. 1102. More importantly, we institute the instant trial based on the same grounds for which we instituted trial in IPR2014-01087. Therefore, Gillette’s Petition raises no new issues beyond those already before us in IPR2014-01087.

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 2, 3, 5–9, 13–16, 19, 41–43, and 45 of the ’759 patent is more efficient than conducting multiple proceedings, eliminating duplicate filings and discovery. Gillette agrees to consolidated filings for all substantive papers. Mot. 6–7. Gillette indicates that it will not file any paper with arguments different from those advanced by the consolidated filings, eliminating duplicate briefing. *Id.* at 6. Gillette further agrees to consolidated discovery, as each Petitioner proffers the same Declaration of Dr. Kortshagen. *Id.* at 7. Gillette indicates that Petitioners of the joined proceeding 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 IPR2014-01087, 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 IPR2014-01087 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 IPR2014-01087 is warranted under the circumstances.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Gillette's Motion for Joinder with IPR2014-01087 is *granted*;

FURTHER ORDERED that the instant proceeding is joined with IPR2014-01087;

FURTHER ORDERED that the grounds of unpatentability on which a trial was instituted in IPR2014-01087 are unchanged;

FURTHER ORDERED that the Scheduling Order for IPR2014-01087 (Paper 10) shall govern the joined proceeding; the initial conference call for the joined proceeding is scheduled on October 27, 2014 at 2:00 p.m. 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 IPR2014-01087;

FURTHER ORDERED that, throughout IPR2014-01087, Petitioners (GlobalFoundries and Gillette) will file papers, except for motions which do not involve the other parties, as consolidated filings¹; GlobalFoundries will

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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