

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 IPR2014-01494
Patent 6,896,775 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 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 (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–29 of U.S. Patent No. 6,896,775 B2 (“the ’775 Patent”). Paper 1 (“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 IPR2014-00578 (PTAB) (“IPR2014-00578”). Paper 4 (“Mot.”).

The Gillette Company (“Gillette”), the Petitioner in IPR2014-00578, 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 IPR2014-00578. For the reasons set forth below, Petitioner’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. *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 IPR2014-00578 (*id.* at 5); (3) Petitioner agrees to consolidated filings and discovery (*id.* at 5–6); (4) joinder would not affect the schedule in IPR2014-00578 (*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 IPR2014-00578 would not be affected by joinder, because Petitioner’s Petition is substantively identical to Gillette’s Revised Petition filed in IPR2014-00578. Notably, Petitioner’s Petition asserts identical grounds of unpatentability, challenging the same claims of the ’775 Patent. *Compare* Pet. 14–59, *with* IPR2014-00578, Paper 9 (“’578 Pet.”), 13–60. Petitioner also submits identical proposed claim constructions, as well as the same Declaration of Mr. Richard DeVito. *Compare* Pet. 4–6, *with* ’578 Pet. 4–5; *compare* Ex. 1011, *with* ’578 Ex. 1011. Moreover, we institute the instant trial based on the same ground for which we instituted trial in IPR2014-00578. Therefore, Petitioner’s Petition raises no new issues beyond those already before us in IPR2014-00578.

In its Opposition, Zond indicates that it has specific requirements of 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 1–29 of the '775 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 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 IPR2014-00578, allowing the trial still to be completed within one year. *Id.* at 8–9. Given that Petitioner's Petition raises no new issues, and Petitioners agree to consolidated filings and discovery, the impact of joinder on IPR2014-00578 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 IPR2014-00578 is warranted under the circumstances.

ORDER

Accordingly, it is:

ORDERED that Petitioner's Motion for Joinder with IPR2014-00578 is *granted*;

FURTHER ORDERED that the instant proceeding is joined with IPR2014-00578;

FURTHER ORDERED that the grounds of unpatentability on which a trial was instituted in IPR2014-00578 are unchanged;

FURTHER ORDERED that the Scheduling Order for IPR2014-00578 (Paper 14) shall govern the joined proceeding; the initial conference call for the joined 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 IPR2014-00578;

FURTHER ORDERED that, throughout IPR2014-00578, 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 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>.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.