

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LINEAR TECHNOLOGY CORPORATION,
Petitioner,

v.

IN-DEPTH TEST LLC,
Patent Owner.

Case IPR2015-01994
Patent 6,792,373 B2

Before LINDA M. GAUDETTE and BARRY L. GROSSMAN,
Administrative Patent Judges.

GAUDETTE, *Administrative Patent Judge.*

DECISION

Denying Petitioner's Motion for Joinder under 35 U.S.C. § 315(c) and
37 C.F.R. §§ 42.22 and 42.122(b) and Request for Shortened Response Time
for Patent Owner's Preliminary Response

I. BACKGROUND

On September 28, 2015, Linear Technology Corporation (“Petitioner”) filed a Petition (Paper 2) to institute an *inter partes* review of U.S. Patent No. 6,792,373 B2, together with a Motion for Joinder (Paper 3)¹ of the Petition with *Maxim Integrated Products Inc. v. In-Depth Test LLC*, Case IPR2015-01627 (PTAB July 27, 2015). On October 5, 2015, Petitioner sent an email communication to the Board requesting a conference call “to seek permission to move to shorten the time for any preliminary response in IPR2015-01994, and to seek an expedited schedule for briefing on Petitioner’s pending Motion for Joinder with IPR2015-01627.”

In response to Petitioner’s email communication, a conference call was held on October 19, 2015, among Mark Rowland, representing Petitioner; Joshua Wyde and Daniel Noblitt, representing In-Depth Test LLC (“Patent Owner”); and Judges Gaudette, Grossman, and Chen.

On the call, Petitioner requested an expedited briefing schedule for its Motion for Joinder, arguing joinder would promote judicial efficiency, because the petitions in IPR2015-01627 and the present *inter partes* review involve the same patent, claims, and grounds, and rely on the same arguments and evidentiary record. Petitioner further requested that the pre-institution briefing schedule in the present case be revised to correspond with the schedule in IPR2015-01627 (wherein a preliminary response is due on November 4, 2015), and proposed that Patent Owner file a single, joint preliminary response, if any, in both the present *inter partes* review and

¹ Paper 3 also included a “Request for Shortened Response Time for Patent Owner’s Preliminary Response.”

IPR2015-01627. According to Petitioner, Patent Owner would not be prejudiced by the shortened time period for filing a preliminary response (due in the present case on January 8, 2016), because the Petition in the present *inter partes* review is substantially identical to the petition filed in IPR2015-01627. Petitioner advised that it had contacted Maxim Integrated Products, Inc., the petitioner in IPR2015-01627, regarding the Motion for Joinder, but that Maxim had not stated its views on the joinder issue.

Patent Owner responded that it believed a Motion for Joinder was premature at this stage of the proceeding, contending 35 U.S.C. § 315 provides for joinder only after institution of an *inter partes* review, and the Board has not yet instituted such review in IPR2015-01627. Patent Owner further stated that it would be prejudiced if required to file a single, joint preliminary response, because its preliminary response in each case would likely differ in that an argument under 35 U.S.C. §325(d), available in the present Petition for *inter partes* review, would not be applicable in IPR2015-01627.

II. ANALYSIS

35 U.S.C. § 315(c) pertains to joinder in an *inter partes* review, and reads as follows:

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.

37 C.F.R. § 42.122(b), also pertaining to requests for joinder in *inter partes* proceedings, reads:

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.

It is clear from both the statute and the rule that a request for joinder is appropriate only if a decision granting institution has been entered in the *inter partes* review for which joinder is requested.

After consideration of the arguments advanced by Petitioner in its Motion for Joinder, and during the conference call on October 19, we are not persuaded that a departure from the requirements of 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) is warranted in this case. In this regard, we note that in the cases cited by Petitioner in support of its Motion for Joinder, the requests were for joinder with an *inter partes* review in which trial already had been instituted. *See e.g., Motorola Mobility LLC v. Softview LLC*, Case IPR2013-00256, slip op. at 2 (PTAB March 27, 2014) (Paper 10); *Dell Inc. v. Network-1 Security Solutions, Inc.*, Case IPR2013-00385, slip op. at 7 (PTAB July 29, 2013) (Paper 17).

As no decision on the request for *inter partes* review has been entered in IPR2015-01627, Petitioner's Motion for Joinder is premature. We, therefore, deny Petitioner's Motion for Joinder and concurrent request, made in contemplation of joinder, to accelerate the briefing schedule in this case to correspond with the schedule in IPR2015-01627.

III. ORDER

In consideration of the foregoing, it is

ORDERED that Petitioner's Motion for Joinder under 35 U.S.C.

IPR2015-01994
Patent 6,792,373 B2

§ 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b) and Request for Shortened Response Time for Patent Owner's Preliminary Response is *denied*; and

FURTHER ORDERED that Petitioner is authorized to file a Motion for Joinder with IPR2015-01627 when, and if, trial is instituted in that case.

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