

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GLOBALFOUNDRIES U.S. INC.,
Petitioner,

v.

GODO KAISHA IP BRIDGE 1,
Patent Owner.

Cases IPR2017-00925 and IPR2017-00926
Patent 7,126,174 B2

Before JUSTIN T. ARBES, MICHAEL J. FITZPATRICK, and
JENNIFER MEYER CHAGNON, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* ARBES.

Opinion Concurring-in-Part, Dissenting-in-Part filed by *Administrative
Patent Judge* FITZPATRICK.

ARBES, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Review
37 C.F.R. § 42.108

Granting Petitioner's Motions for Joinder
37 C.F.R. § 42.122

Petitioner GlobalFoundries U.S. Inc. filed two Petitions requesting *inter partes* review of claims 1–12 and 14–18 (“the challenged claims”) of U.S. Patent No. 7,126,174 B2 (Ex. 1001, “the ’174 patent”)¹ and a Motion for Joinder with Case IPR2016-01246 in each proceeding. Patent Owner Godo Kaisha IP Bridge 1 filed a Combined Opposition to Petitioner’s Motion for Joinder and Preliminary Response and Petitioner filed a Reply in each proceeding, as listed in the following chart.

Case Number	Challenged Claims	Petition	Motion for Joinder	Combined Opposition and Preliminary Response	Reply
IPR2017-00925	1–3, 5–7, 9–12, and 14–18	Paper 2 (“Pet.”)	Paper 3 (“Mot.”)	Paper 8 (“Opp.”)	Paper 12 (“Reply”)
IPR2017-00926	1, 4, 5, 8–12, 14, and 16	Paper 1 (“-926 Pet.”)	Paper 3 (“-926 Mot.”)	Paper 8	Paper 11

Pursuant to 35 U.S.C. § 314(a), the Director may not authorize an *inter partes* review unless the information in the petition and preliminary response “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons that follow, we institute an *inter partes* review as to claims 1–12 and 14–18 of the ’174 patent on certain grounds of unpatentability, and grant Petitioner’s Motions for Joinder.

¹ References to exhibits herein are to those filed in Case IPR2017-00925. Petitioner’s original Reply in each proceeding exceeded the five-page limit set forth in 37 C.F.R. § 42.24(c)(2). On April 17, 2017, we authorized Petitioner by email to re-file its Replies and expunged the original versions. See IPR2017-00925, Papers 10–12; IPR2017-00926, Papers 10, 11.

I. BACKGROUND

A. *Related Proceedings*

On June 24, 2016, Taiwan Semiconductor Manufacturing Company, Ltd. (“TSMC”) filed two petitions, in Case IPR2016-01246 (“the -1246 Case”) and Case IPR2016-01247 (“the -1247 Case”), requesting *inter partes* review of the challenged claims of the ’174 patent. On January 4, 2017, we instituted an *inter partes* review on all of the asserted grounds, and exercised our authority under 35 U.S.C. § 315(d) to consolidate the two proceedings and conduct the proceedings as one trial, with papers being filed in the -1246 Case. *Taiwan Semiconductor Mfg. Co., Ltd. v. Godo Kaisha IP Bridge 1*, Case IPR2016-01246 (PTAB Jan. 4, 2017) (Paper 8) (“-1246 Dec. on Inst.”). Patent Owner filed its Response on March 24, 2017.

On February 3, 2017, GlobalFoundries, Inc. (Petitioner’s corporate parent) filed two petitions in Cases IPR2017-00849 and IPR2017-00850 requesting *inter partes* review of the challenged claims based on the same asserted grounds as the petitions in the -1246 and -1247 Cases, along with Motions for Joinder. The petitions listed GlobalFoundries, Inc. as the sole real party-in-interest. *See, e.g.*, IPR2017-00849, Paper 2, 70. Petitioner subsequently filed its Petitions and Motions for Joinder² in the instant proceedings on February 17, 2017, listing itself and GlobalFoundries, Inc. as real parties-in-interest. *See* Pet. 88; -926 Pet. 75. On March 10, 2017, we dismissed the petitions in Cases IPR2017-00849 and IPR2017-00850. *See, e.g.*, IPR2017-00849, Paper 12.

² In its Motion for Joinder filed in Case IPR2017-00926, Petitioner requests joinder with the -1247 Case. -926 Mot. 1. As explained above, however, we consolidated the -1247 Case with the -1246 Case. Thus, we understand the Motion to apply to the consolidated proceeding.

B. The Prior Art

Petitioner relies on the following prior art:

U.S. Patent No. 4,506,434, issued Mar. 26, 1985 (Ex. 1010, “Ogawa”);

U.S. Patent No. 5,021,353, issued June 4, 1991 (Ex. 1017, “Lowrey”);

U.S. Patent No. 5,153,145, issued Oct. 6, 1992 (Ex. 1002, “Lee”); and

U.S. Patent No. 5,539,229, filed Dec. 28, 1994, issued July 23, 1996 (Ex. 1015, “Noble”).

C. The Asserted Grounds

Petitioner challenges claims 1–12 and 14–18 of the ’174 patent as unpatentable under 35 U.S.C. § 103(a)³ on the following grounds:

Case Number	References	Claims Challenged
IPR2017-00925	Lee and Noble	1–3, 5–7, 9–12, and 14–18
IPR2017-00925	Lee and Ogawa	1–3, 5–7, 9–12, and 14–18
IPR2017-00926	Lowrey and Noble	1, 4, 5, 8–12, 14, and 16
IPR2017-00926	Lowrey and Ogawa	1, 4, 5, 8–12, 14, and 16

³ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 103. Because the challenged claims of the ’174 patent have an effective filing date before the effective date of the applicable AIA amendment, we refer to the pre-AIA version of 35 U.S.C. § 103.

II. DISCUSSION

A. The Petitions

Petitioner asserts the same grounds of unpatentability as those on which we instituted a trial in the -1246 Case. *See* Pet. 17; -926 Pet. 16–17; -1246 Dec. on Inst. 29. Petitioner’s arguments are identical to the arguments made by TSMC in its petitions. *Compare* Pet. 10–88, *with* IPR2016-01246, Paper 2, 10–85; *compare* -926 Pet. 10–75, *with* IPR2016-01247, Paper 2, 10–76; *see also* Mot. 3 (arguing that the Petitions “include[] grounds that are essentially the same as the grounds instituted” in the -1246 Case); Reply 2 (arguing that “Petitioner’s arguments regarding the asserted prior art references are identical to the arguments made by” TSMC, and Petitioner relies on the same declaration as TSMC in the -1246 Case). Patent Owner does not argue the merits of Petitioner’s asserted grounds in its Combined Opposition and Preliminary Response in each proceeding. We incorporate our previous analysis regarding the asserted grounds of unpatentability, and conclude that Petitioner has demonstrated a reasonable likelihood of prevailing on the grounds of unpatentability asserted in the Petitions for the same reasons. *See* -1246 Dec. on Inst. 7–28.

B. The Motions for Joinder

The AIA created administrative trial proceedings, including *inter partes* review, as an efficient, streamlined, and cost-effective alternative to district court litigation. 35 U.S.C. § 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

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