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Paper 13
Entered: June 9, 2017

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.

Case IPR2017-00920
Patent 6,538,324 B1

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 Motion for Joinder
37 C.F.R. § 42.122

Petitioner GlobalFoundries U.S. Inc. filed a Petition (Paper 1, "Pet.") requesting *inter partes* review of claims 1–3, 5–7, and 9 ("the challenged claims") of U.S. Patent No. 6,538,324 B1 (Ex. 1001, "the '324 patent") and a Motion for Joinder (Paper 3, "Mot.") with Case IPR2016-01264 ("the -1264 Case"). Patent Owner Godo Kaisha IP Bridge 1 filed a Combined Opposition to Petitioner's Motion for Joinder and Preliminary Response. Paper 8 ("Opp."). Petitioner filed a Reply. Paper 12 ("Reply").[1]

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 1–3, 5–7, and 9 of the '324 patent on certain grounds of unpatentability, and grant Petitioner's Motion for Joinder.

I. BACKGROUND

A. Related Proceedings

On June 24, 2016, Taiwan Semiconductor Manufacturing Company, Ltd. ("TSMC") filed a petition in the -1264 Case requesting an *inter partes* review of the challenged claims of the '324 patent. On December 21, 2016, we instituted an *inter partes* review. *Taiwan Semiconductor Mfg. Co., Ltd. v. Godo Kaisha IP Bridge 1*, Case IPR2016-01264 (PTAB Dec. 21, 2016) (Paper 7) ("-1264 Dec. on Inst."). Patent Owner filed its Response and

[1] Petitioner's original Reply 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 Reply and expunged the original version. *See* Papers 11, 12.

Motion to Amend on March 7, 2017, and TSMC filed its Reply and Opposition to the Motion to Amend on May 22, 2017.

On January 23, 2017, GlobalFoundries, Inc. (Petitioner's corporate parent) filed a petition in Case IPR2017-00757 requesting an *inter partes* review of the challenged claims based on the same asserted grounds as the petition in the -1264 Case, along with a Motion for Joinder. The Petition listed GlobalFoundries, Inc. as the sole real party-in-interest. *See* IPR2017-00757, Paper 2, 40. Petitioner subsequently filed its Petition and Motion for Joinder in the instant proceeding on February 16, 2017, listing itself and GlobalFoundries, Inc. as real parties-in-interest. *See* Pet. 40. On March 10, 2017, we dismissed the petition in Case IPR2017-00757. *See* IPR2017-00757, Paper 15.

B. The Prior Art

Petitioner relies on the following prior art:

U.S. Patent No. 5,893,752, issued April 13, 1999 (Ex. 1004, "Zhang");

U.S. Patent No. 6,887,353 B1, filed Dec. 19, 1997, issued May 3, 2005 (Ex. 1005, "Ding"); and

Sun et al., "Properties of Reactively Sputter-Deposited Ta – N Thin Films," *Thin Solid Films*, vol. 236, pp. 347–351 (1993) (Ex. 1007, "Sun").

C. The Asserted Grounds

Petitioner challenges claims 1–3, 5–7, and 9 of the '324 patent on the following grounds:

References	Basis	Claims Challenged
Zhang and Ding	35 U.S.C. § 103(a)[2]	1–3, 5–7, and 9
Zhang, Ding, and Sun	35 U.S.C. § 103(a)	1–3, 5–7, and 9

II. DISCUSSION

A. The Petition

Petitioner asserts the same grounds of unpatentability as those on which we instituted a trial in the -1264 Case. *See* Pet. 9, 37; -1264 Dec. on Inst. 17. Petitioner presents the same arguments as those made by TSMC in its petition in the -1264 Case. *Compare* Pet. 9–40, *with* IPR2016-01264, Paper 2, 12–51; *see also* Mot. 7 (Petitioner representing that they "are essentially identical"); Opp. 8 (Patent Owner arguing against "[i]nstituting an essentially identical IPR proceeding involving the same prior art, the same arguments, and the same evidence"). Patent Owner does not argue the merits of Petitioner's asserted grounds in its Combined Opposition and Preliminary Response. We incorporate our previous analysis regarding the asserted grounds of unpatentability, and conclude that Petitioner has

[2] 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 '324 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.

demonstrated a reasonable likelihood of prevailing on the grounds of unpatentability asserted in the Petition for the same reasons. *See* -1264 Dec. on Inst. 5–17.

B. The Motion 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 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.

"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." 37 C.F.R. § 42.122(b). Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. The Board determines whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations. *See Sony Corp. of Am. v. Network-1 Security Solutions, Inc.*, Case IPR2013-00495, slip op. at 3 (PTAB Sept. 16, 2013) (Paper 13) ("*Sony*"). 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).

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