

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 IPR2017-00923
Patent 6,197,696 B1

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

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

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

CHAGNON, *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

I. INTRODUCTION

GlobalFoundries U.S. Inc. (“Petitioner”) filed a Petition for *inter partes* review of claims 13 and 14 (“the challenged claims”) of U.S. Patent No. 6,197,696 B1 (Ex. 1001, “the ’696 patent”). Paper 1 (“Pet.”). Petitioner also filed a Motion for Joinder with Case IPR2016-01378 (“the -1378 Case”). Paper 2 (“Mot.”). Godo Kaisha IP Bridge 1 (“Patent Owner”) filed an Opposition to Petitioner’s Motion for Joinder (Paper 7, “Opp.”) and a Preliminary Response (Paper 9, “Prelim. Resp.”). Petitioner filed a Reply to Patent Owner’s Opposition. Paper 8 (“Reply”).

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 13 and 14 of the ’696 patent, and grant Petitioner’s Motion for Joinder.

A. Related Proceedings

On July 12, 2016, Taiwan Semiconductor Manufacturing Company, Ltd. (“TSMC”) filed a petition in the -1378 Case requesting an *inter partes* review of the challenged claims of the ’696 patent. On January 18, 2017, we instituted an *inter partes* review. *Taiwan Semiconductor Mfg. Co., Ltd. v. Godo Kaisha IP Bridge 1*, Case IPR2016-01378 (PTAB Jan. 18, 2017) (Paper 11) (“-1378 Inst. Dec.”). Patent Owner filed its Patent Owner Response on April 14, 2017, and TSMC filed its Reply on July 21, 2017.

On February 13, 2017, Petitioner filed a petition in Case IPR2017-00882 requesting an *inter partes* review of the challenged claims

IPR2017-00923
Patent 6,197,696 B1

based on the same asserted grounds as the petition in the -1378 Case, along with a Motion for Joinder. The petition listed Petitioner as the sole real party-in-interest. *See* IPR2017-00882, Paper 1, 53. Petitioner subsequently filed its Petition and Motion for Joinder in the instant proceeding on February 16, 2017, listing itself and GlobalFoundries, Inc. (Petitioner’s corporate parent) as real parties-in-interest. *See* Pet. 53. On April 25, 2017, we dismissed the petition in Case IPR2017-00882. *See* IPR2017-00882, Paper 9.

B. The Applied References and Evidence

Petitioner relies on the following references.

Reference	Date	Exhibit
U.S. Patent No. 6,140,226 (“Grill”)	Oct. 31, 2000	Ex. 1005
U.S. Patent No. 5,592,024 (“Aoyama”)	Jan. 7, 1997	Ex. 1018
U.S. Patent No. 5,920,790 (“Wetzel”)	July 6, 1999	Ex. 1019

Petitioner further relies on the Declaration of Bruce W. Smith, Ph.D. (Ex. 1002).

C. The Asserted Grounds

Petitioner sets forth its challenges to claims 13 and 14 as follows. Pet. 20–53.

Reference(s)	Basis	Claim(s) Challenged
Grill	§ 102(e)	13, 14
Grill and Aoyama	§ 103	13, 14
Grill and Wetzel	§ 103	14
Grill, Aoyama, and Wetzel	§ 103	14

II. DISCUSSION

A. *The Petition*

Petitioner asserts the same grounds of unpatentability as those that we considered in the -1378 Case. *See* Pet. 20–53; -1378 Inst. Dec. 26–44. Further, Petitioner presents the same arguments as those made by TSMC in its petition in the -1378 Case. *Compare* Pet. *generally*, with IPR2016-01378, Paper 2 *generally*; *see also* Mot. 1 (Petitioner representing that the asserted grounds “are essentially the same”). Patent Owner’s Preliminary Response also presents the same arguments as those made in its preliminary response in the -1378 Case. *Compare* Prelim. Resp. *generally*, with IPR2016-01378, Paper 6 *generally*.

We incorporate our previous analysis regarding the asserted grounds of unpatentability, and conclude, for the same reasons, that Petitioner has demonstrated a reasonable likelihood of prevailing on the ground challenging claims 13 and 14 under 35 U.S.C. § 103 as obvious in view of Grill and Aoyama, but has not demonstrated a reasonable likelihood of prevailing on the ground challenging claims 13 and 14 under 35 U.S.C. § 102(e) as anticipated by Grill. *See* -1378 Inst. Dec. 11–43. Likewise, we also do not reach, and decline to institute a trial on, Petitioner’s alternative grounds including Wetzel for claim 14. *See id.* at 43–44.

B. *The Motion for Joinder*

The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“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).

As the moving party, Petitioner has the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b).

A motion for joinder should (1) set forth the reasons why joinder is appropriate; (2) identify any new ground(s) of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *See Sony*, at 3; Mot. 4–5. Petitioner should address specifically how briefing and/or discovery may be simplified to minimize schedule impact. *See Kyocera Corp. v. SoftView LLC*, Case

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