

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

**AMENDED REPLY TO PATENT OWNER'S OPPOSITION TO MOTION
FOR JOINDER TO *INTER PARTES* REVIEW IPR2016-01264**

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I. INTRODUCTION

The Board has waived the one-month requirement under 37 C.F.R. § 42.122(b) and granted joinder where: 1) the Petitioner's asserted grounds and arguments are identical to those already at issue in the existing proceedings, 2) joinder would require no change to the trial schedule, 3) joinder would impose no added burden on the existing parties because the Petitioners were willing to have only a limited "understudy" role, and 4) the Petitioner attempted previously within the one-month requirement to be joined. All four criteria are met here. *See Sony Corporation of America et al., v. Network-1 Security Solutions, Inc.*, IPR2013-00495, Paper 13 (PTAB September 16, 2013).

II. ARGUMENTS

Under 37 C.F.R. § 42.5(b), the Board "may waive or suspend a requirement of [part 42 of the Board's rules] and may place conditions on the waiver or suspension." *See* IPR2013-00495, Paper 13 at page 4 *citing* 37 C.F.R. § 42.5(b). As discussed below, consistent with the Board's decision in IPR2013-00495, Petitioner respectfully requests that the Board waive the one-month requirement under 37 C.F.R. § 42.122(b) and grant joinder to IPR2016-01264.

A. Substantive Issues

The Petition and Motion for Joinder raise no new substantive issues, which favors granting joinder:

- 1) Joinder will not impact the Board's ability to complete the proceedings in one year because the Petition does not raise any issues that are not already before the Board. *See* Motion for Joinder, Paper 3 at page 6.
- 2) The Petition asserts the same grounds of unpatentability as those on which a trial was instituted in case IPR2016-01264. *See* Petition, Paper 1.
- 3) Petitioner's arguments regarding the asserted prior art references are identical to the arguments made by Taiwan Semiconductor Manufacturing Company Limited (TSMC) in IPR2016-01264. *See* Petition, Paper 1.
- 4) Petitioner submitted the same Expert Declaration as submitted by TSMC in IPR2016-01264. *See* Exhibit 1003.

B. Procedural Issues

The Petition and Motion for Joinder raise no new procedural issues, which favors granting joinder:

- 1) Joinder will not require any change to the trial schedule or affect timely completion of the review. *See* Motion for Joinder, Paper 3 at page 6. Hence, the Patent Owner will not be prejudiced by the Board permitting joinder. *See* Motion for Joinder, Paper 3 at pages 7 and 8.
- 2) Petitioner has agreed to have only a limited "understudy" role if joined with case IPR2016-01264 and, therefore, the procedural impact on the

instituted proceedings will be minimal, if any. *See* Motion for Joinder, Paper 3 at page 7.

C. Other Considerations

A previous petition including the same grounds as in this case and a motion for joinder to IPR2016-01264 was timely filed according to 37 C.F.R. § 42.122(b) in the name of GLOBALFOUNDRIES, INC., one of the real parties in interest in this case. *See* IPR2017-00757, Papers 2 and 3. The petition in IPR2017-00757 was dismissed in favor of this petition, which includes an additional real party in interest GLOBALFOUNDRIES U.S. INC. *See* IPR2017-00757, Paper 15 and IPR2017-00920, Paper 1.

In IPR2013-00495, the Board recognized the petitioner's previous attempts to be joined within the one-month period as a special circumstance that weighed in favor of waiving the one-month requirement under 37 C.F.R. § 42.122(b) and the granting of joinder. In this case, the timely filed motion for joinder in IPR2017-00757 by one of the real parties in interest in this case should be considered a previous attempt to be joined within the one-month period under 37 C.F.R. § 42.122(b).

D. Additional Real Party In Interest

The Patent Owner has raised an unsupported and illusory issue regarding the identified real parties in interest ("RPI") in this case based on RPIs in two other

IPRs.¹ *See* PO's Combined Opposition to Petitioner's Motion for Joinder and Preliminary Response, Paper 8 at pages 4 and 10. *See* also IPR2017-00757 and IPR2017-00903. This argument is entirely speculative and illusory.

With respect to IPR2017-00757, the Petition in this case was filed out of an abundance of caution and added a second real party in interest, GLOBALFOUNDRIES U.S. INC., which is a subsidiary of GLOBALFOUNDRIES, INC., with the intent of avoiding burdening the parties and the Board with potential issues regarding the real party in interest. Simply adding a second real party in interest to the Petition does not raise an issue regarding the real party in interest as asserted by the Patent Owner. With respect to IPR2017-00903, the fact that the real parties in interest in IPR2017-00903 are the same as the real parties in interest for this case suggests instead that there is no issue with the real parties in interest in this case. Hence, the Patent Owner's argument concerning an alleged issue regarding the real party in interest is not only speculative and unsupported by any evidence, but inconsistent with the existing facts. Giving any weight to the Patent Owner's "red herring" threatens the Board's objective of conducting the proceeding in an efficient manner.

Finally, Petitioner should not suffer the disproportionate penalty of denial of

¹ Patent Owner also referred to IPR2017-00849 and IPR2017-00850.

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