

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

**REPLY TO PATENT OWNER'S OPPOSITION TO MOTION FOR
JOINER TO *INTER PARTES* REVIEW IPR2016-01378**

Mail Stop "PATENT BOARD"

Patent Trial and Appeal Board U.S.

Patent and Trademark Office P.O.

Box 1450

Alexandria, VA 22313-1450

I. INTRODUCTION

The Board routinely grants motions for joinder where the party seeking joinder presents identical arguments to those raised in the existing proceeding and agrees to reasonable limits on its role in the joined proceeding. See, e.g., *Perfect World Entertainment, Inc., v. Uniloc USA, Inc. and Uniloc Luxembourg S.A.*, IPR2015-01026, Paper 10, (PTAB Aug. 3, 2015); *ION Geophysical Corporation and Ion International S.A.R.L. v. WesternGeco LLC*, IPR2015-00567, Paper 14, (PTAB Apr. 23, 2015); *Fujitsu Semiconductor Limited v. Zond, LLC*, IPR2014-00845, Paper 14 (PTAB Oct. 2, 2014); *Enzymotec Ltd. V. Neptune Technologies & Bioresources, Inc.*, IPR2014-00556, Paper 19 (PTAB Jul. 9, 2014). Such is the situation here and joinder should be granted consistent with the Board’s “policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding.” *Enzymotec*, Paper 19, p. 6 citing 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (“The Office anticipates that joinder will be allowed as of right – if an inter partes review is instituted on the basis of a petition, for example, a party that files an identical petition will be joined to that proceeding, . . .”) (emphasis added).

II. ADDITIONAL CONDITIONS PROPOSED BY PATENT OWNER

In Petitioner’s motion for joinder, Petitioner has already proposed that:

- 1) As long as TSMC remains in the joined IPR, Petitioner agrees to remain

in a circumscribed “understudy” role without a separate opportunity to actively participate.

2) Petitioner will not file additional written submissions, nor will Petitioner pose questions at depositions or argue at oral hearing without the prior permission of TSMC.

3) Only in the event that TSMC settles will Petitioner seek to become active in the joined IPR.

Essentially, Petitioner agrees to not pursue an active role (i.e., a circumscribed “understudy” role without a separate opportunity to actively participate) in the joined case unless TSMC settles. *See* Motion for Joinder, Paper 2 at pages 6 and 7.

However, the Patent Owner argues that the Board should require the Petitioner to abide by various additional conditions as a joined party in IPR2016-01378. *See* PO’s Opposition to Petitioner’s Motion for Joinder and Preliminary Response, Paper 6. The Petitioner believes that such additional conditions are not warranted as the Petitioner is willing to have only a limited “understudy” role. However, Petitioner is willing to abide by such additional conditions as the Board deems appropriate.

III. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that its Petition for *Inter Partes* Review of U.S. Patent No. 6,197,696 be instituted and that the

proceedings be joined with *Taiwan Semiconductor Manufacturing Company Limited* (“TSMC”) v. *Godo Kaisha IP Bridge 1*, Case No. IPR2016-01378.

RESPECTFULLY SUBMITTED,

White & Case LLP

Date: April 12, 2017

/Christopher P. Carroll/

Christopher P. Carroll (Reg. No. 55776)
75 State Street
Boston, MA 02109-1814
Telephone: 617-979-9342
Fax: 617-979-9301
christopher.carroll@whitecase.com

Lead Counsel for Petitioner
GLOBALFOUNDRIES U.S. INC.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing REPLY TO PATENT OWNER'S OPPOSITION TO MOTION FOR JOINDER TO INTER PARTES REVIEW IPR2016-01378 was served on April 12, 2017, via email directed to counsel of record for the Patent Owner at the following:

Andrew.thomases@ropesgray.com
sbaughman@paulweiss.com
Jordan.rossen@ropesgray.com
James.l.davis@ropesgray.com

/Christopher Carroll/
White & Case LLP
75 State Street
Boston, MA 02109-1814
Telephone: (617) 979-9342
Facsimile: (617) 439-6702
Lead Counsel for Petitioner