

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: *IPR2017-00926*

Patent 7,126,174 B1

**REPLY TO PATENT OWNER'S OPPOSITION TO MOTION FOR
JOINER TO *INTER PARTES* REVIEW IPR2016-01247**

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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 Corp. and Ion Int'l S.A.R.L. v. WesternGeco LLC*, IPR2015-00567, Paper 14, (PTAB Apr. 23, 2015); *Fujitsu Semiconductor Ltd v. Zond, LLC*, IPR2014-00845, Paper 14 (PTAB Oct. 2, 2014); *Enzymotec Ltd. V. Neptune Techs. & 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).

Further, 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 e.g., Sony Corp. of Amer., et al., v. Network-1 Security Soln’s, Inc.*, IPR2013-00495, Paper 13, (PTAB September 16, 2013).

II. FACTS

The petition and motion for joinder in this case were filed on February 17, 2017, which was more than one month after institution of *inter partes* review in IPR2016-01247, the case for which joinder has been requested. *See* IPR2017-00926, Papers 1 and 3. However, a previous petition containing the same grounds as in this case and a motion for joinder to IPR2016-01247 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* IPR2017-00850, Papers 2 and 3. The petition in IPR2017-00850 was dismissed in favor of this petition, which includes an additional real party in interest GLOBALFOUNDRIES U.S. INC. *See* IPR2017-00850, Paper 12 and IPR2017-00926, Paper 1.

III. 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 IPP2013-00495,

Petitioner respectfully requests that the Board waive the one-month requirement under 37 C.F.R. § 42.122(b) and grant joinder to IPR2016-01247.

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 pages 4 and 5.
- 2) The Petition asserts the same grounds of unpatentability as those on which a trial was instituted in case IPR2016-01247. *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 IPR2016-01247. *See* Petition, Paper 1.
- 4) Petitioner submitted the same Expert Declaration as submitted by TSMC in IPR2016-01247. *See* Exhibit 1004.

Thus, the Petition raises no new substantive issues beyond those already before the Board in the instituted proceedings, which weighs in favor of joinder. *See* IPR2013-00495, Paper 13 at page 5 *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, and thus allowed to file its own briefs and make its own arguments.”) (emphasis added).

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 pages 4 and 5. As stated in the Petitioner’s motion for joinder, joinder is likely more convenient and efficient for IP Bridge by providing a single trial on the ‘174 patent. By allowing all grounds of invalidity to be addressed in a single proceeding, the interests of all parties and the Board will be well served. Hence, the Patent Owner will not be prejudiced by the Board permitting joinder. *See* Motion for Joinder, Paper 3 at pages 5 and 6.
- 2) Petitioner has agreed to have only a limited “understudy” role if joined with case IPR2016-01247 and, therefore, the procedural impact on the instituted proceedings will be minimal, if any. *See* Motion for Joinder, Paper 3 at page 5.

Because joinder will not require a change to the existing trial schedule and because the Petitioner has agreed to a limited “understudy” role, the procedural

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