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Paper No. 9
Entered: April 16, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WISTRON CORPORATION,
Petitioner,

v.

ALACRITECH, INC.,
Patent Owner.

Case IPR2018-00328
Patent 7,337,241 B2

Before STEPHEN C. SIU, DANIEL N. FISHMAN, and CHARLES J. BOUDREAU, *Administrative Patent Judges*.

FISHMAN, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review and
Granting Petitioner's Motion for Joinder
35 U.S.C. § 314(a); 37 C.F.R. §§ 42.108, 42.122

I. INTRODUCTION

Wistron Corporation ("Wistron" or "Petitioner") filed a Petition (Paper 1, "Pet.") for *inter partes* review of claims 1–24 of U.S. Patent No. 7,337,241 B2 ("the '241 Patent") (Ex. 1001) pursuant to 35 U.S.C. §§ 311–319. Contemporaneous with the filing of the Petition, Petitioner filed a

Motion for Joinder. Paper 3 ("Joinder Motion" or "Mot."). The Joinder Motion seeks to join Wistron as a Petitioner in *Intel Corp. and Cavium, Inc. v. Alacritech, Inc.*, Case IPR2017-01392[1] ("the 1392 IPR"). Mot. 1. The Joinder Motion indicates Intel Corp. ("Intel") and Cavium, Inc. ("Cavium"), current Petitioners in the 1392 IPR, do not oppose Wistron's request to join that proceeding. *Id.*

Alacritech, Inc. ("Patent Owner") did not file an Opposition to the Joinder Motion. Instead, Patent Owner filed a Preliminary Response that is silent regarding the Joinder Motion. Paper 8 ("Prelim. Resp.").

As explained further below, we institute trial in this *inter partes* review on the same grounds as instituted in the 1392 IPR, and we grant Petitioner's Joinder Motion.

II. DISCUSSION

A. Institution of Trial

In the 1392 IPR, Intel and Cavium challenge the patentability of claims 1–24 of the '241 Patent on the following grounds:

References	**Basis**	**Claims challenged**
Erickson,[2] Tanenbaum96,[3] and Alteon[4]	§ 103	1–8, 18, 22, and 23
Erickson and	§ 103	9–17, 19–21, and 24

[1] Cavium, Inc., which filed a petition and motion for joinder in Case IPR2017-01728, has been joined as a petitioner in the 1392 IPR.
[2] U.S. Patent No. 5,768,618. ("Erickson," Ex. 1005).
[3] Andrew S. Tanenbaum, *Computer Networks*, Third Edition, 1996 ("Tanenbaum96," Ex. 1006).
[4] Alteon Networks Inc., *Gigabit Ethernet Technical Brief: Achieving End-to-End Performance*, 1996. ("Alteon," Ex. 1033).

Tanenbaum96		

IPR2017-01392, Paper 4, 14–15.

After considering the Petition and Patent Owner's Preliminary Response in the 1392 IPR, we instituted trial for the above-identified grounds of unpatentability. *See* IPR2017-01392, Paper 11, 26. Petitioner here, Wistron, represents that the present Petition is substantively identical to the Petition in the 1392 IPR, challenges the same claims based on the same grounds, and is supported by "substantially the same expert declaration." Mot. 4. We have considered the relevant Petitions and we agree with Petitioner's representation that this Petition is substantially identical to the Petition in the 1392 IPR. *Compare* Pet., *with* IPR2017-01392, Paper 4.

Patent Owner's Preliminary Response does not expressly identify any differences from its Preliminary Response in the 1392 IPR. However, after reviewing Patent Owner's Preliminary Responses here and in the 1392 IPR, we find the two responses to be substantially identical, with one exception. We note that, here, Patent Owner argues that Intel should have been named as a real party-in-interest because Intel is a supplier and indemnitor to Wistron and is an intervenor in Patent Owner's litigation against Wistron. Prelim. Resp. 29–30. In the 1392 IPR, Patent Owner presented a similar argument in its Preliminary Response that Petitioner Intel should have named Cavium and Dell Inc. ("Dell") as real parties-in-interest because of alleged supplier-indemnitor relationships between Intel and Dell and between Cavium and Dell. IPR2017-01392, Paper 10, 28–38. Here, Patent Owner argues the supplier/indemnitor relationship between Intel and

Wistron requires that Intel be named as a real party-in-interest. Prelim. Resp. 28–37.

We have reviewed Patent Owner's arguments. On the record before us and for purposes of this Decision, and for the similar reasons as in the 1392 IPR, we determine there is insufficient evidence that Intel controlled, or had the opportunity to control, *this* Petition and, thus, that Intel is not a real party-in-interest. *See* IPR2017-01392, Paper 11, 21–25. Moreover, the issue Patent Owner raises is not jurisdictional. *See Lumentum Holdings, Inc. v. Capella Photonics, Inc.*, Case IPR2015-00739, slip op. at 6 (PTAB March 4, 2016) (Paper 38) (precedential). As in the 1392 IPR, Patent Owner does not allege that naming additional real parties-in-interest such as Intel would bar Petitioner in the instant proceeding. *See* IPR2017-01392, Paper 11, 23–24.

Accordingly, for essentially the same reasons stated in our Decision to Institute in the 1392 IPR, we conclude Petitioner has established a reasonable likelihood of prevailing with respect to at least one challenged claim and we institute trial in this proceeding for claims 1–24 on the same grounds as in that case.

B. Motion for Joinder

Based on authority delegated to us by the Director, we have discretion to join a petitioner for *inter partes* review as a party to a previously instituted *inter partes* review. 35 U.S.C. § 315(c). Section 315(c) provides, in relevant part, that "[i]f 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. . . ." *Id.*

Without opposition to the Joinder Motion from any party, we grant Petitioner's Motion for Joinder with the 1392 IPR subject to the condition that:

> In the joined proceeding, Petitioner here (i.e., Wistron Corporation) will be bound by all substantive and procedural filings and representations of current Petitioners in IPR2017-01392 (i.e., Intel Corp. and Cavium, Inc.), without a separate opportunity to be heard, whether orally or in writing, unless and until the joined proceeding is terminated with respect to both Intel and Cavium in IPR2017-01392.

In view of the foregoing, we determine that joinder based upon the above-noted condition will have little or no impact on the timing, cost, or presentation of the trial on the instituted grounds. Moreover, discovery and briefing will be simplified if Wistron is joined as a petitioner in the 1392 IPR.

III. ORDER

After due consideration of the record before us, and for the foregoing reasons, it is:

ORDERED that pursuant to 35 U.S.C. § 314, an *inter partes* review is hereby instituted for claims of the '241 Patent as follows: (1) claims 1–8, 18, 22, and 23 as obvious under 35 U.S.C. § 103(a) over Erickson, Tanenbaum96, and Alteon and (2) claims 9–17, 19–21, and 24 as obvious under 35 U.S.C. § 103(a) over Erickson and Tanenbaum96;

FURTHER ORDERED that Petitioner's Motion for Joinder with IPR2017-01392 is *granted* and Wistron Corporation is joined as a petitioner in IPR2017-01392 pursuant to 37 C.F.R. § 42.122(b), on the condition that: In the joined proceeding, Petitioner here (i.e., Wistron Corporation) will be

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