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Paper No. 8
Entered: December 15, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAVIUM, INC.,
Petitioner,

v.

ALACRITECH, INC.,
Patent Owner.

Case IPR2017-01735
Patent 7,124,205 B2

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

SIU, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review and
Granting Petitioner's Motion for Joinder
35 U.S.C. §§ 314(a), 315(c); 37 C.F.R. §§ 42.108, 42.122

I. INTRODUCTION

Cavium, Inc. ("Cavium" or "Petitioner"), filed a Petition (Paper 1, "Pet.") for *inter partes* review of claims 3, 9, 10, 16, 22, 24–33, 35, and 36 of U.S. Patent No. 7,124,205 B2 ("the '205 Patent") (Ex. 1001) pursuant to 35 U.S.C. §§ 311–319. Within days of filing the Petition, Petitioner filed a Motion for Joinder. Paper 3 ("Joinder Motion" or "Mot."). The Joinder Motion seeks to join Petitioner as a party to *Intel Corp. v. Alacritech*, Case IPR2017-01405 ("the 1405 IPR"). Mot. 1. The Joinder Motion indicates Intel Corp. ("Intel"), Petitioner in the 1405 IPR, does not oppose Cavium's request to join that proceeding. *Id.*

As explained further below, we institute trial in this *inter partes* review on the same grounds as instituted in IPR2017-01405 for claims 3, 9, 10, 16, 22, 24–30, 35, and 36 and we grant Petitioner's Motion for Joinder.

II. DISCUSSION

A. Institution of Trial

In IPR2017-01405, Petitioner Intel challenges the patentability of claims 3, 9, 10, 16, 22, 24–33, 35, and 36 of the '205 Patent on the following grounds:

Reference(s)	Basis	Claims challenged
Thia,[1] Satran I,[2] and Satran II[3]	§ 103	3, 9, 10, 16, 22, 27–33, 35, and 36
Thia, Satran I, Satran II, and Carmichael[4]	§ 103	24–26

IPR2017-01405, Paper 1.

After considering the Petition and the Patent Owner's Preliminary Response in IPR2017-01405, we instituted trial for claims 3, 9, 10, 16, 22, 27–30, 35, and 36 under 35 U.S.C. § 103(a) as unpatentable over Thia, Satran I, and Satran II and claims 24–26 under 35 U.S.C. § 103(a) as unpatentable over Thia, Satran I, Satran II, and Carmichael. *See* IPR2017-01405, Paper 8. Petitioner here (Cavium) represents that this Petition is substantively identical to the Petition in IPR2017-01405 and challenges the same claims based on the same grounds. Mot. 1. We have considered the relevant Petitions and we agree with Petitioner's representation that this Petition is substantially identical to the Petition in IPR2017-01405. *Compare* Pet., *with* IPR2017-01405, Paper 1.

Patent Owner's Preliminary Response does not point out any differences from its Preliminary Response in the 1405 IPR. However, after reviewing Patent Owner's Preliminary Response here and in the 1405 IPR, we find the two responses to be substantially identical, with one exception.

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[1] Y.H. Thia and C.M. Woodside, "A Reduced Operation Protocol Engine (ROPE) for a Multiple-Layer Bypass Architecture," 1995 ("Thia," Ex. 1015).
[2] J. Satran, et al., "SCSI/TCP (SCSI over TCP)," 2000 ("Satran I," Ex. 1056).
[3] J. Satran, et al., "iSCSI (Internet SCSI)," 2000 ("Satran II," Ex. 1057).
[4] US Patent 5,894,560, issued April 13, 1999 ("Carmichael," Ex. 1053).

We note that, here, Patent Owner argues that QLogic, Inc. ("QLogic") should have been named as a real party-in-interest because QLogic, a wholly owned subsidiary of Cavium, is a supplier to, and indemnitor of, Dell (the defendant in related infringement litigation), and Cavium's only interest in the '205 patent is that of its subsidiary QLogic. *See* Prelim. Resp. 28–36. In the 1405 IPR, Patent Owner presented a similar argument in its Preliminary Response that Petitioner Intel should have named Cavium and Dell as real parties-in-interest because of the alleged supplier-indemnitor relationship between Intel and Dell and Cavium and Dell. IPR2017-01405, Paper 7. Here, Patent Owner argues the parent/subsidiary relationship between Petitioner and QLogic and the supplier/indemnitor relationship between QLogic and Dell require that QLogic be named as a real party-in-interest. *See* Prelim. Resp. 28–36.

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 1405 IPR, we determine there is insufficient evidence that QLogic controlled, or had the opportunity to control, this Petition and, thus, is not a real party-in-interest. *See* Case IPR2017-01405, Paper 8, 15–19. Moreover, as in the 1405 IPR, there is no allegation that naming additional real parties-in-interest such as QLogic or Dell would bar Petitioner in the instant proceeding. *See id*. Accordingly, 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).

Accordingly, for essentially the same reasons stated in our Decision to Institute in IPR2017-01405, 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 3, 9, 10, 16, 22, 24–30, 35, and 36 on the same grounds as in IPR2017-01405.

B. Motion for Joinder

Based on authority delegated to us by the Director, we have discretion to join a petitioner for *inter partes* review 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 1405 IPR, subject to the condition that Cavium will be bound by all substantive and procedural filings and representations of Intel in the 1405 IPR, without a separate opportunity to be heard, whether orally or in writing, unless and until the proceeding is terminated with respect to Intel.

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 Cavium is joined as a party to the 1405 IPR.

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