

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL INC.,
Petitioner,

v.

ALACRITECH, INC.,
Patent Owner.

Case IPR2018-01307
Patent 8,805,948 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. § 42.122

I. INTRODUCTION

Dell Inc. (“Dell”) filed a Petition (Paper 2, “Pet.”) for *inter partes* review of claims 1, 3, 6–8, 17, 19, 21, and 22 of U.S. Patent No. 8,805,948 B2 (Ex. 1001, “the ’948 patent”) pursuant to 35 U.S.C. §§ 311–319. Concurrent with the Petition, Petitioner filed a Motion for Joinder. Paper 3 (“Joinder Motion” or “Mot.”). The Joinder Motion seeks to join Dell as a petitioner in *Intel Corp. v. Alacritech*, Case IPR2018-00234 (“the 234 IPR”), to which Cavium LLC (formerly Cavium, Inc.) (“Cavium”) has also been joined as a petitioner. Mot. 1; *see* IPR2018-00403, Paper 10. The Joinder Motion indicates Intel Corp. (“Intel”) and Cavium do not oppose Dell’s request to join the 234 IPR. *Id.* Alacritech, Inc. (“Alacritech” or “Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”), but did not file a timely opposition to the Joinder Motion.

As explained further below, we institute trial in this *inter partes* review on the same ground as instituted in the 234 IPR, and we grant Dell’s Motion for Joinder.

II. DISCUSSION

A. *Institution of Trial*

In the 234 IPR, Intel and Cavium challenge claims 1, 3, 6–8, 17, 19, 21, and 22 as unpatentable under 35 U.S.C. § 103(a) over the combined

disclosures of Thia,¹ Tanenbaum96,² and Stevens2.³ IPR2018-00234, Paper 2, 18. After considering the Petition and the Patent Owner's Preliminary Response in the 234 IPR, we instituted trial on this ground of unpatentability. *See* IPR2018-00234, Paper 7 ("234 IPR Dec. on Inst."). Dell represents that the present Petition is substantively identical to the Petition in the 234 IPR ("234 IPR Petition") challenging the same claims on the same ground. Mot. 1. We have considered the relevant Petitions and we agree with Dell's representation that this Petition is substantially identical to the 234 IPR Petition. *Compare* Pet., with IPR2018-00234, Paper 2.

After comparing the Preliminary Response in this proceeding and the 234 IPR, we find the present Preliminary Response repeats from the 234 IPR certain background statements concerning the '948 patent and the prior art, as well as arguments concerning the prior art status of the Stevens2 reference. *Compare* Prelim. Resp., with IPR2018-00234, Paper 6. The present Preliminary Response, however, expands upon an argument, initially raised with respect to the 234 IPR Petition, that the presented challenge is time-barred. *Compare* Prelim. Resp., with IPR2018-00234, Paper 6. More particularly, Patent Owner contends the present Petition is time-barred under 35 U.S.C. § 315(b), because it was filed more than one year after Alacritech served Dell, Wistron Corporation, Wiwynn Corporation, SMS InfoComm

¹ Y. H. Thia and C. M. Woodside, *A Reduced Operation Protocol Engine (ROPE) for a Multiple-Layer Bypass Architecture*, Springer Science+Business Media Dordrecht (1995) ("Thia," Ex. 1015).

² Andrew S. Tanenbaum, *Computer Networks*, Prentice Hall PTR 3rd ed. (1996) ("Tanenbaum96," Ex. 1006).

³ W. Richard Stevens and Gary R. Wright, *TCP/IP Illustrated Volume 2: The Implementation*, Addison-Wesley (1995) ("Stevens2," Ex. 1013).

Corporation, CenturyLink Inc., Tier 3, Inc., Savvis Communications Corp., and CenturyLink Communications LLC (collectively, “the Dell, Wistron, and CenturyLink entities”) with complaints for infringement of the ’948 patent. *See* Prelim. Resp. 1, 30–45.⁴ Although § 315(b) expressly provides that the “1 year” time limitation set forth therein does not apply to a request for joinder under § 315(c), Patent Owner’s arguments are premised on the Dell, Wistron, and CenturyLink entities being undisclosed real parties in interest in the 234 IPR as a result of indemnification obligations owed to them by Intel, such that the 234 IPR Petition was time-barred. *Id.* at 30–31, 31 n.7.

In our Decision to Institute in the 234 IPR, we preliminarily considered such arguments to the extent they were presented in the 234 IPR and were not persuaded by the evidence then of record that the 234 IPR Petition was time-barred. *See* 234 IPR Dec. on Inst. 15–19. Further, although we note that the record is subject to further development, particularly given that the alleged indemnification obligations are the subject of ongoing additional discovery recently authorized in the 234 IPR (*see* IPR2018-00234, Paper 31), we conclude, for the reasons stated in our Decision to Institute in the 234 IPR, that Dell has established on the record currently before us a reasonable likelihood of prevailing with respect to at least one challenged claim. Accordingly, we institute trial in this proceeding

⁴ Section 315(b) provides that “[a]n inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent. The time limitation set forth in the preceding sentence shall not apply to a request for joinder under [35 U.S.C. § 315(c)].”

for claims 1, 3, 6–8, 17, 19, 21, and 22 on the same ground as in the 234 IPR.

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 Dell’s Motion for Joinder with the 234 IPR subject to the condition that, in the joined proceeding, Dell will be bound by all substantive and procedural filings and representations of Intel and Cavium in the 234 IPR, without a separate opportunity to be heard, whether orally or in writing, unless and until the proceeding is terminated with respect to both Intel and Cavium.

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 ground. Moreover, discovery and briefing will be simplified if Dell is joined as a petitioner in the 234 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 of the ’948 patent is hereby instituted to determine obviousness of claims 1, 3, 6–8, 17, 19, 21, and 22 over Thia, Tanenbaum⁹⁶, and Stevens²; and

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