UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

XILINX, LLC,
Petitioner,

v.

FG SRC LLC,
Patent Owner

Case IPR2021-00633
Patent No. 7,149,867

PETITIONER'S REPLY TO PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION FOR JOINDER

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PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION FOR ADDITIONAL DISCOVERY

I. INTRODUCTION AND REQUEST FOR RELIEF

Petitioner's Motion for Joinder (Paper 3) proposed a silent understudy role in Case No. IPR2021-01449 (the Intel IPR) with no new issues, briefing, or discovery regarding patentability of the '867 Patent. Unable to dispute these points, Patent Owner's Opposition (Paper 7) attempts to complicate an otherwise routine matter by contending that the one-year time bar precludes joinder because Amazon is an unnamed RPI or privy. Patent Owner is wrong on both counts. Amazon is not Petitioner's RPI/privy, and joinder is an exception to the time bar. Patent Owner's suggestion that joinder necessarily will infect the Intel IPR with a new RPI/privity issue is also wrong. If Patent Owner raises that ineffectual issue in the Intel IPR, it will be because Patent Owner chose to do so, not because joinder imposed the issue.

Petitioner requests the following relief: **(1)** a finding that the time bar does not preclude or impede joinder; **(2)** a finding that joinder will not negatively impact the Intel IPR; **(3)** a rejection of Patent Owner's discovery requests as premised on a fundamental misunderstanding of the time bar; and **(4)** a show cause order requiring Patent Owner to explain how a POPR will not unjustly delay joinder after the Board considers the RPI/privity and time bar issues raised in the Opposition.

II. DENIAL OF JOINDER IS UNWARRANTED

A. The Time Bar Does Not Preclude or Impede Joinder

1. The time bar is irrelevant because Amazon is not an RPI/privy

The undisputed operative facts portray a straightforward customer-supplier

relationship between Petitioner and Amazon, not an RPI or privy relationship.

Petitioner is a supplier of Amazon for certain FPGA products. On October 18, 2017, Patent Owner sued Amazon for direct infringement of the '867 Patent based on the custom manner in which Amazon chooses to configure Petitioner's products. *See* EX1019, 12-16, 26-27, 34-43. Patent Owner deliberately chose not to name Petitioner in this suit, despite full knowledge of the customer-supplier relationship between Amazon and Petitioner. *Id*. Patent Owner also chose not to accuse Petitioner after demanding documents from Petitioner via subpoena in 2018. *See* EX1024, 10-11. Amazon, the only party accused of infringement at the time, petitioned for IPR of the '867 Patent in July 2018 (Case No. IPR2018-01395).

On April 30, 2020, Patent Owner sued Petitioner on a new theory that Petitioner's FPGA products, separate and apart from their unique deployment by Amazon, directly infringe the '867 Patent. EX1020, 4-7, 12-13. Patent Owner's surprise suit came years after it first became aware of Petitioner's accused products. Petitioner reasonably relied on Patent Owner's prolonged silence as confirmation that Patent Owner was accusing Amazon's customization and not Petitioner's products in general. But Patent Owner was really just lying in wait. Patent Owner's surprise suit is why Petitioner did not initiate an IPR sooner and why Petitioner presently seeks joinder. Petitioner did not communicate, much less coordinate, with Amazon in any way regarding the filing of this IPR or regarding joinder.

The Board's precedent makes clear that an RPI relationship does not manifest from a mere pre-existing relationship with a non-party who will benefit tangentially from invalidation of the challenged claims. *See RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128 at 30-31 (Oct. 2, 2020) (precedential) ("The inquiry does not end there[.]"). An RPI relationship further requires that the petitioner "can be said to be ***representing [the non-party's] interest***." *Id*. at 31. Here, these critical puzzle pieces are missing.

Petitioner's actions at the PTAB are consistent with a party representing its own interests and nothing more. For one, Petitioner did not seek IPR of the '867 Patent until after Patent Owner's surprise suit. Timing aside, the joinder mechanism corroborates that Petitioner is not representing Amazon. Amazon does not need Petitioner to act for it. Nothing prevents Amazon from pursuing joinder itself. *See* 35 U.S.C. 315(b)-(c) (noting joinder as an exception to the one-year time bar); 35 U.S.C. 315(e)(1) (limiting IPR estoppel to petitioners that receive a final decision).

Patent Owner turns a blind eye to the plain fact that its own litigation tactics are the impetus for Petitioner's Joinder Motion. And Patent Owner's circumstantial reasoning to support its RPI allegation strains credulity. First, Patent Owner contends that Petitioner and Amazon devised a "divide-and-conquer strategy" because Petitioner previously sought IPR of U.S. 9,153,311, one out of five patents asserted against Amazon. *See* Opp., 3; EX1019, 4. But there is a simpler

explanation than Patent Owner's conspiracy theory: The '311 Patent's claims are different from those of the '867 Patent, which led Petitioner to conduct a different analysis. For example, Petitioner was aware of prior art describing its FPGA products and construed that art as invalidating the '311 Patent. This fact made petitioning for IPR of the '311 Patent efficient and inexpensive. To be clear, though, Petitioner did not expect Patent Owner to assert either patent, otherwise Petitioner would have searched for additional art and also petitioned for IPR of the '867 Patent.

Next, Patent Owner infers an RPI relationship based on a supposed existence of an indemnity obligation between Petitioner and Amazon. Opp., 4. The mere existence of such an obligation is irrelevant, though. The relevant question is whether indemnity is driving Petitioner to pursue joinder. It is not. The Amazon case has been stayed for years, and Petitioner has little concern about any potential indemnity claim. Petitioner's Joinder Motion is entirely responsive to Patent Owner's surprise suit. Again, Petitioner has never discussed this with Amazon.

Patent Owner further contends that coordination between Petitioner and Amazon is sufficient to infer an RPI relationship. Opp., 5-6. No so. Again, the simple explanation is the right one. Petitioner and Amazon have coordinated on technical matters because Amazon is a customer and because Patent Owner's suit against Amazon involves Petitioner's products. This fact lends no support to Patent Owner's conclusion that Petitioner somehow represents Amazon's interests.

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