

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

XILINX, INC.,
Petitioner,

v.

FG SRC LLC,
Patent Owner.

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

Before KALYAN K. DESHPANDE, GREGG I. ANDERSON, and
KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

SZPONDOWSKI, *Administrative Patent Judge*.

ORDER

Denying Patent Owner's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)

On March 15, 2021, Petitioner Xilinx, Inc. (“Petitioner” or “Xilinx”) filed a Petition requesting *inter partes* review of claims 1–19 of U.S. Patent No. 7,149,867 (“’867 patent”) (Paper 2, “Petition” or “Pet.”). Petitioner also filed a Motion for Joinder, pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.22(b), requesting to join *Intel Corp. v. FG SRC LLC*, IPR2020-01449, which also concerns claims 1–19 of the ’867 patent (Paper 3, “Motion for Joinder”). Patent Owner FG SRC LLC (“Patent Owner”) filed an Opposition to Petitioner’s Motion for Joinder and Motion for Additional Discovery (Paper 7, “Motion”). Petitioner filed a Reply to Patent Owner’s Opposition to Petitioner’s Motion for Joinder and Petitioner’s Opposition to Patent Owner’s Motion for Additional Discovery (Paper 9, “Opp.”). Patent Owner filed a Sur-reply In Support of its Opposition to Petitioner’s Motion for Joinder and Reply in Support of its Motion for Additional Discovery (Paper 10, “Reply”).

This Order addresses Patent Owner’s Motion for Additional Discovery (Paper 7). Petitioner’s Motion for Joinder (Paper 3) will be addressed separately at a later date. For the following reasons, we deny Patent Owner’s Motion for Additional Discovery.

I. BACKGROUND

In October 2017 and February 2018, in separate lawsuits that were later consolidated, Patent Owner asserted the ’867 patent and U.S. Patent No. 9,153,311 (“the ’311 patent”) against Xilinx’s customer Amazon.com, Inc. and Amazon Web Services, Inc. (“Amazon”) relating to Amazon’s use of Xilinx’s FPGA products (“Amazon cases”). Motion 2–3; Opp. 2. Xilinx was not accused of infringement at that time, but was served with a

subpoena in these cases in January 2018. Motion 3; Opp. 2; Pet. 5. The Amazon cases are currently stayed. Pet. 5.

On July 13, 2018, Xilinx filed a petition for *inter partes* review in IPR2018-01395 against the '311 patent, which was later denied. Motion 3–4. On October 19, 2018, Amazon filed a petition for *inter partes* review in IPR2019-00103 against the '867 patent, which was also later denied. Motion 3–4; Opp. 2. In April 2020, Patent Owner asserted the '867 patent against Xilinx. Pet. 5; Paper 5, 2.

II. ANALYSIS

In its Mandatory Notices, Petitioner Xilinx identifies itself as the real party in interest (“RPI”). Pet. 1. Xilinx further states:

As to the related matters below, Amazon and Xilinx have a customer/supplier relationship. Although Xilinx Ultrascale+ FPGAs and its Vivado Design Suite are referenced in a pending SRC Labs complaint against Amazon (identified below), Xilinx has not assumed the defense of any claim against Amazon in litigation and exercises no control over Amazon’s litigation defense. Similarly, Amazon does not exercise control over this Petition, has not funded this Petition, and has not participated in Xilinx’s preparation and filing of this Petition.

*Id.*¹

Patent Owner argues that “Amazon should have been listed as a real party in interest (“RPI”) or privy to Xilinx’s '867 petition,” which “would have time barred the petition” and, therefore “requests discovery that goes to

¹ In a nearly identical statement, Xilinx identified only itself as the real party in interest in IPR2018-01395. IPR2018-01395, Paper 1 at 2–3. Amazon likewise identified only itself as the real party in interest in IPR2019-00103. IPR2019-00103, Paper 1 at 1–2.

the status of Xilinx as a RPI and/or privy of Amazon.”² Motion 5, 8. Patent Owner seeks the following documents:

- (1) the supplier contract[s] and any amendments or supplements thereto between Amazon and Xilinx concerning the Xilinx UltraScale+FPGA and Vivado Design Suite;
- (2) any communications between Amazon and Xilinx relating to the '867 or '311 patents, or the products specifically identified and accused in the Amazon litigations (*i.e.*, the Xilinx UltraScale+ FPGA and Vivado Design Suite) between Oct. 18, 2017 (the filing date of the first Amazon suit) and March 15, 2021 (the filing date of the current Petition); and
- (3) any confidentiality, joint defense, or indemnification agreements related to the Amazon litigations.

Motion 14.

Patent Owner argues that, under the factors set forth in *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6–7 (PTAB Mar. 5, 2013), the interests of justice support production of the foregoing documents. Motion 9. Petitioner opposes. *See Opp.*

A. Relationship to the Motion for Joinder

Patent Owner's arguments in opposition to the Motion for Joinder are solely based upon Amazon's alleged status as a real party in interest or privy. *See* Motion 4–8; Reply 1–2, 8. In authorizing further briefing on Patent Owner's Motion for Additional Discovery, we requested that the Parties “explain the impact of a determination [that Amazon should have been listed as a real party in interest or privy to the Petition],” that is, “the

² We note that Patent Owner refers to “the status of Xilinx as a RPI and/or privy of Amazon,” but the proper inquiry is the reverse – whether Amazon is an RPI and/or privy of Xilinx.

issue of joinder as it relates to a party that is statutorily barred from an *inter partes* review under 35 U.S.C. § 315(b).”³ Paper 8, 3. There is no dispute that Amazon was served with a complaint alleging infringement of the ’867 patent more than one year before the Petition was filed. *See* Motion 2–3, 13; Opp. 2.

Patent Owner explains that the impact of Amazon being a real party in interest is that the Petition would have been time-barred under § 315(b) because Amazon should have been listed as a real party in interest or privy to Xilinx’s Petition. Motion 5, 8; *id.* at 13 (“the requested discovery goes to the threshold question of whether the IPR Petitions are time-barred under § 315(b).”).⁴ In the Reply, however, Patent Owner concedes that a time-barred party may be joined to an existing IPR under § 315(b), and appears to redirect its argument to deficiencies under § 312(a)(2).⁵ Reply 1–2, 10.

Petitioner argues that “[e]ven if Amazon were an unnamed RPI or privy . . . the one-year time bar would not preclude Petitioner’s Motion [for Joinder] because joinder is an exception to the time bar.” Opp. 6. Petitioner, therefore, argues “whether Amazon is an unnamed RPI or privy is of minimal importance to the Board’s decision on joinder.” *Id.* at 7.

We agree with Petitioner. Section 315(b) states 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,

³ Patent Owner did not request authorization to file its Motion for Additional Discovery before filing it, as required under 37 C.F.R. § 42.20(b). *See* Paper 8, n. 1. However, after conducting a conference with the Parties, we authorized Patent Owner’s Motion. *Id.*

⁴ Patent Owner refers to “IPR Petitions.” We assume this is a typographical error, as Xilinx has only filed one Petition.

⁵ Patent Owner cites incorrectly 35 U.S.C. § 312(b)(2). Reply 2.

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