

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FUJITSU SEMICONDUCTOR LIMITED and
FUJITSU SEMICONDUCTOR AMERICA, INC.,
Petitioner,

v.

ZOND, LLC,
Patent Owner.

Case IPR2014-00866
Patent 6,853,142 B2

Before KEVIN F. TURNER, DEBRA K. STEPHENS, JONI Y. CHANG,
SUSAN L. C. MITCHELL, and JENNIFER M. MEYER,
Administrative Patent Judges.

TURNER, *Administrative Patent Judge.*

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Fujitsu Semiconductor Limited and Fujitsu Semiconductor America, Inc. (collectively, “Fujitsu”) filed a Petition requesting *inter partes* review of claims 1, 3–10, 12, 15, 17–20, and 42 of U.S. Patent No. 6,853,142 B2 (“the ’142 Patent”). Paper 1 (“Pet.”). Zond, LLC (“Zond”) timely filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

Upon consideration of the information presented in the Petition and the Preliminary Response, we determine that there is a reasonable likelihood that Petitioner would prevail in challenging claims 1, 3–10, 12, 15, 17–20, and 42. Accordingly, pursuant to 35 U.S.C. § 314, we authorize an *inter partes* review to be instituted as to the challenged claims.

A. Related District Court Proceedings

Fujitsu indicates that the ’142 Patent was asserted in *Zond, LLC v. Fujitsu*, No.1:13-cv-11634-WGY (D. Mass.). Pet. 1. Fujitsu also identifies other proceedings in which Zond asserted the ’142 Patent. *Id.*

B. Related Inter Partes Reviews

The following Petitions for *inter partes* review also challenge the same claims, based on the same grounds of unpatentability as those in the instant proceeding: *Intel Corp. v. Zond, LLC.*, Case IPR2014-00494; *Taiwan Semiconductor Manuf. Co., v. Zond, LLC.*, Case IPR2014-00818;

The Gillette Co. v Zond, LLC, Case IPR2014-01012; and *Advanced Micro Devices, Inc. v. Zond, LLC*, Case IPR2014-01075.

In IPR2014-00494, we terminated the proceeding, prior to institution, in light of the Joint Motion to Terminate and Written Settlement Agreement filed by Intel and Zond in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). IPR2014-00494, Paper 7; Ex. 1018.

In IPR2014-00818, we instituted *inter partes* review of claims 1, 3–10, 12, 15, 17–20, and 42 of the ’142 Patent, based on the following grounds of unpatentability:

Claims	Basis	References
1, 3–7, 9, 10, 12, 15, 19, 20, and 42	§ 103(a)	Wang and Lantsman
8, 17, and 18	§ 103(a)	Wang, Lantsman, and Mozgrin

Fujitsu filed a revised Motion for Joinder with IPR2014-00818. Paper 9. In a separate Decision, we grant Fujitsu’s revised Motion, joining the instant proceeding with IPR2014-00818, and terminating the instant proceeding.

C. Prior Art Relied Upon

Fujitsu relies upon the following prior art references:

Lantsman	US 6,190,512 B1	Feb. 20, 2001	(Ex. 1004)
Wang	US 6,413,382 B1	July 2, 2002	(Ex. 1005)

D.V. Mozgrin, et al., *High-Current Low-Pressure Quasi-Stationary Discharge in a Magnetic Field: Experimental Research*, 21 PLASMA PHYSICS REPORTS 400–409 (1995) (Ex. 1003) (hereinafter “Mozgrin”).

D. Asserted Grounds of Unpatentability

Fujitsu asserts the following grounds of unpatentability:

Claims	Basis	References
1, 3–10, 12, 15, 17–20, and 42	§ 103(a)	Mozgrin and Lantsman
1, 3–7, 9, 10, 12, 15, 19, 20, and 42	§ 103(a)	Wang and Lantsman
8, 17, and 18	§ 103(a)	Wang, Lantsman, and Mozgrin

II. ANALYSIS

A. Claim Construction

The parties make the same claim construction arguments that Taiwan Semiconductor Manufacturing Company, Ltd. and TSMC North America Corp. (collectively, “TSMC”) and Zond made in IPR2014-00818. *Compare* Pet. 12–14, *with* ’818 Pet. 12–14; *compare* Prelim. Resp. 19–22, *with* ’818 Prelim. Resp. 19–22.

We construed several claim terms identified by TSMC and Zond in IPR2014-00818. *See* ’818 Dec. 5–7. For the purposes of the instant decision, we incorporate our previous analysis and apply those claim constructions here.

B. Obviousness over Wang and Lantsman

In its Petition, Fujitsu asserts the same ground of unpatentability based on the combination of Wang and Lantsman, as that on which a trial was instituted in IPR2014-00818. *See* Pet. 39–57; ’818 Dec. 23. Fujitsu’s arguments are substantively identical to the arguments made by TSMC in

IPR2014-00818. *Compare* Pet. 39–57, *with* ’818 Pet. 39–57. Fujitsu also proffers the same Declaration of Dr. Uwe Kortshagen that TSMC submitted in support of its Petition. *Compare* Ex. 1002, *with* IPR2014-00818 Ex. 1002. Zond’s arguments in the Preliminary Response are essentially identical to those arguments that it made in IPR2014-00818. *Compare* Prelim. Resp. 22–48, *with* ’818 Prelim. Resp. 22–48.

We incorporate our previous analysis regarding the asserted ground of unpatentability based on the combination of Wang and Lantsman (’818 Dec. 9–20), and determine that Fujitsu has demonstrated a reasonable likelihood of prevailing on this ground of unpatentability.

C. Obviousness over Wang, Lantsman, and Mozgrin

In its Petition, Fujitsu asserts the same ground of unpatentability based on the combination of Wang, Lantsman, and Mozgrin, as that on which a trial was instituted in IPR2014-00818. *See* Pet. 57–59; ’818 Dec. 23. Fujitsu’s arguments are substantively identical to the arguments made by TSMC in IPR2014-00818. *Compare* Pet. 57–59, *with* ’818 Pet. 57–59. Zond opposes this latter ground (Prelim. Resp. 52–53), but essentially relies upon the same arguments presented in connection with the prior ground that we do not find persuasive.

We incorporate our previous analysis regarding the asserted ground of unpatentability based on the combination of Wang, Lantsman, and Mozgrin (’818 Dec. 20–21), and determine that Fujitsu has demonstrated a reasonable likelihood of prevailing on this ground of unpatentability.

D. Other Asserted Ground of Unpatentability

Fujitsu also asserts that claims 1, 3–10, 12, 15, 17–20, and 42 are unpatentable on other grounds. The Board’s rules for *inter partes* review proceedings, including those pertaining to institution, are “construed to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b); *see also* 35 U.S.C. § 316(b) (regulations for *inter partes* review proceedings take into account “the efficient administration of the Office” and “the ability of the Office to timely complete [instituted] proceedings”). Therefore, we exercise our discretion and do not institute a review based on these other asserted grounds for reasons of administrative necessity to ensure timely completion of the instituted proceeding. *See* 37 C.F.R. § 42.108(a).

III. CONCLUSION

For the foregoing reasons, we determine that the information presented in the Petition shows that there is a reasonable likelihood that Fujitsu would prevail in challenging claims 1, 3–10, 12, 15, 17–20, and 42 of the ’142 Patent as unpatentable under 35 U.S.C. § 103(a). At this stage in the proceeding, we have not made a final determination with respect to the patentability of the challenged claims.

IV. ORDER

Accordingly, it is:

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted for the following grounds of unpatentability:

Claims	Basis	References
1, 3–7, 9, 10, 12, 15, 19, 20, and 42	§ 103(a)	Wang and Lantsman
8, 17, and 18	§ 103(a)	Wang, Lantsman, and Mozgrin

FURTHER ORDERED that no other ground of unpatentability asserted in the Petition is authorized for this *inter partes* review; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial will commence on the entry date of this decision.

IPR2014-00866
Patent 6,853,142 B2

For PETITIONER:

David M. O'Dell
David L. McCombs
Haynes and Boone, LLP
David.odell.ipr@haynesboone.com
david.mccombs.ipr@haynesboone.com

Richard C. Kim
Duane Morris, LLP
rckim@duanemorris.com

PATENT OWNER:

Gregory Gonsalves
The Gonsalves Law firm
gonsalves@gonsalveslawfirm.com

Bruce Barker
Chao Hadidi Stark & Barker LLP
bbarker@chsblaw.com