

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
Granting Revised Motion for Joinder
37 C.F.R. § 42.122

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.”). Pursuant to 37 C.F.R. § 42.122(b), Fujitsu also filed a revised Motion for Joinder, seeking to join the instant proceeding with *Taiwan Semiconductor Manuf. Co. v. Zond, LLC.*, Case IPR2014-00818 (PTAB) (“IPR2014-00818”). Paper 9 (“Mot.”).

Taiwan Semiconductor Manufacturing Company, Ltd. and TSMC North America Corp. (collectively, “TSMC”), the Petitioner in IPR2014-00818, does not oppose Fujitsu’s revised Motion for Joinder. Mot. 2. Patent Owner, Zond, LLC (“Zond”), filed a Preliminary Response to the Petition (Paper 8, “Prelim. Resp.”), and an Opposition to Fujitsu’s revised Motion for Joinder (Paper 10, “Opp.”). In a separate decision, we institute *inter partes* review as to the same claims on the same ground of unpatentability for which we instituted trial in IPR2014-00818. For the reasons set forth below, Fujitsu’s revised Motion for Joinder is *granted*.

ANALYSIS

The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”) permits joinder of like review proceedings. The Board, acting on behalf of the Director, has the discretion to join an *inter partes* review with another *inter partes* review. *See* 35 U.S.C. § 315(c). Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. When exercising its discretion, the Board is mindful that patent trial regulations, including the

rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b). The Board considers the impact of both substantive issues and procedural matters on the proceedings.

As the moving party, Fujitsu bears the burden to show that joinder is appropriate. 37 C.F.R. §§ 42.20(c), 42.122(b). In its revised Motion for Joinder, Fujitsu contends that joinder, in this particular situation, is appropriate because: (1) “it is the most expedient way to secure the just, speedy, and inexpensive resolution of the related proceedings” (Mot. 5); (2) Fujitsu’s Petition is substantively identical to TSMC’s Petition filed in IPR2014-00818 (*id.* at 5–6); (3) Fujitsu agrees to consolidated filings and discovery (*id.* at 6–7); (4) joinder would not affect the schedule in IPR2014-00818 (*id.* at 7–8); (5) joinder would streamline the proceedings, reduce the costs and burdens on the parties, and increase efficiencies for the Board without any prejudice to Zond (*id.* at 8).

We agree that the substantive issues in IPR2014-00818 would not be affected by joinder, because Fujitsu’s Petition is substantively identical to TSMC’s Petition filed in IPR2014-00818. Notably, Fujitsu’s Petition asserts identical grounds of unpatentability, challenging the same claims of the ’142 Patent. *Compare* Pet. 14–59, *with* IPR2014-00818, Paper 1 (“’818 Pet.”), 14–59. Fujitsu also submits identical proposed claim constructions, as well as the same Declaration of Dr. Uwe Kortshagen. *Compare* Pet. 12–14, *with* ’818 Pet. 12–14; *compare* Ex. 1002, *with* ’818 Ex. 1002. Moreover, we institute the instant trial based on the same ground for which we instituted trial in IPR2014-00818. Therefore, Fujitsu’s Petition raises no new issues beyond those already before us in IPR2014-00818.

In its Opposition, Zond indicates that it is *not opposed to joinder*.

Opp. 1. Rather, Zond proposes a procedure for the joined proceeding to consolidate the schedule, filings, and discovery. Opp. 2–3.

We agree with the parties that conducting a single joined proceeding for reviewing claims 1, 3–10, 12, 15, 17–20, and 42 of the '142 Patent is more efficient than conducting multiple proceedings, eliminating duplicate filings and discovery. As previously indicated, Fujitsu agrees to consolidated filings for all substantive papers. Mot. 6–7. Fujitsu further indicates that it will not file any paper with arguments separate from those advanced by the consolidated filings, eliminating duplicate briefing. *Id.* at 7. Fujitsu further agrees to consolidated discovery, as each Petitioner proffers the same Declaration of Dr. Kortshagen. *Id.* Fujitsu indicates that Petitioners collectively will designate an attorney to conduct the cross-examination of any witnesses produced by Zond and the redirect of any witnesses produced by Petitioners, within the timeframe normally allotted by the rules for one party. *Id.* Moreover, joinder will not require any change to the trial schedule in IPR2014-00818, allowing the trial still to be completed within one year. *Id.* at 7–8. Given that Fujitsu's Petition raises no new issues, and Petitioners agree to consolidated filings and discovery, the impact of joinder on IPR2014-00818 will be minimal, and joinder will streamline the proceedings, reducing the costs and burdens on the parties and the Board.

For the foregoing reasons, Fujitsu has met its burden of demonstrating that joinder of the instant proceeding with IPR2014-00818 is warranted under the circumstances.

ORDER

Accordingly, it is:

ORDERED that Fujitsu's Motion for Joinder with IPR2014-00818 is *granted*;

FURTHER ORDERED that the instant proceeding is joined with IPR2014-00818;

FURTHER ORDERED that the grounds of unpatentability on which a trial was instituted in IPR2014-00818 are unchanged;

FURTHER ORDERED that the Scheduling Order for IPR2014-00818 (Paper 10) shall govern the joined proceeding; the initial conference call for the joined proceeding is scheduled on November 25, 2014 at 3:00 PM ET;

FURTHER ORDERED that the instant proceeding is instituted, joined, and terminated under 37 C.F.R. § 42.72, and all further filings in the joined proceeding shall be made only in IPR2014-00818;

FURTHER ORDERED that, throughout IPR2014-00818, Petitioners (TSMC and Fujitsu) will file papers, except for motions which do not involve the other parties, as consolidated filings¹; TSMC will identify each such filing as a consolidated filing and will be responsible for completing all consolidated filings; the page limits set forth in 37 C.F.R. § 42.24 will apply to all consolidated filings; no individual Petitioner will receive any additional pages in addition to the page limits set forth in 37 C.F.R. § 42.24 for one party;

¹ The parties are directed to the Board's website, in particular FAQs C3, D5, and G8, for information regarding filings in the Patent Review Processing System (PRPS). See <http://www.uspto.gov/ip/boards/bpai/prps.jsp>.

FURTHER ORDERED that Zond will conduct the cross-examination of witnesses, as well as the redirect examination of any witness it produces, in the timeframes set forth in 37 C.F.R. § 42.53(c);

FURTHER ORDERED that Petitioners collectively will designate attorneys to conduct the cross-examination of any witnesses produced by Zond and the redirect examination of any witnesses produced by Petitioners, within the timeframes set forth in 37 C.F.R. § 42.53(c) for one party; no individual Petitioner will receive any cross-examination or redirect examination time in addition to the time normally allotted by 37 C.F.R. § 42.53(c) for one party;

FURTHER ORDERED that Petitioners collectively will designate attorneys to present at the oral hearing (if requested) as a consolidated presentation;

FURTHER ORDERED that the case caption in IPR2014-00818 shall be changed to reflect the joinder with the instant proceeding in accordance with the attached example; and

FURTHER ORDERED that a copy of this Decision be entered into the file of IPR2014-00818.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TAIWAN SEMICONDUCTOR MANUFACTURING COMPANY, LTD.,
TSMC NORTH AMERICA CORP., FUJITSU SEMICONDUCTOR
LIMITED, and FUJITSU SEMICONDUCTOR AMERICA, INC.,
Petitioner,

v.

ZOND, LLC,
Patent Owner.

Case IPR2014-00818¹
Patent 6,853,142 B2

¹ Case IPR2014-00866 has been joined with the instant proceeding.