

U.S. Patent No. 5,965,924 Claims 7-12, 15 and 17
Petitioner's Motion for Joinder

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED, GLOBALFOUNDRIES INC.,
GLOBALFOUNDRIES U.S. INC., GLOBALFOUNDRIES DRESDEN
MODULE ONE LLC & CO. KG, GLOBALFOUNDRIES DRESDEN MODULE
TWO LLC & CO. KG

Petitioner

v.

DSS Technology Management, Inc.
Patent Owner

Case IPR2016-01312
U.S. Patent No. 5,965,924

**PETITIONER'S MOTION FOR JOINDER
UNDER 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22, and 42.122(b)**

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I. STATEMENT OF RELIEF REQUESTED

The Petitioners for the present Petition are GLOBALFOUNDRIES Inc., GLOBALFOUNDRIES U.S. Inc., GLOBALFOUNDRIES Dresden Module One LLC & Co. KG, GLOBALFOUNDRIES Dresden Module Two LLC & Co. KG (collectively “GF”) and Qualcomm, Incorporated (“Qualcomm”), collectively referred to as “Petitioner.” Petitioner respectfully submits this Motion for Joinder together with a Petition for *Inter Partes* Review of claims 7-12, 15 and 17 of U.S. Patent No. 6,784,924 (the “Present Petition” or “Present IPR”). Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner requests *inter partes* review and joinder with *Intel Corporation v. DSS Technology Management, Inc.*, IPR2016-00290 (“Intel” and “the Intel IPR”), which was instituted on June 8, 2016. Joinder is appropriate because it will promote efficient and consistent resolution of the unpatentability grounds at issue and will not prejudice any of the parties to the Intel IPR.

This Motion for Joinder and accompanying Petition are being filed within one month of the decision instituting trial in the Intel IPR, and are therefore timely. Counsel for GF/Qualcomm has conferred with counsel for Intel, and Intel does not oppose joinder.

II. STATEMENT OF MATERIAL FACTS

1. On February 16, 2015, the owner of the '924 Patent, DSS Technology Management, Inc. ("DSS"), sued Intel and other companies (not including GF or Qualcomm) alleging infringement of the '924 Patent.

2. On July 16, 2015, DSS sued Qualcomm and other companies (not including GF) alleging infringement of the '924 Patent. Qualcomm is a co-petitioner to the present Petition.

3. On December 8, 2015, Intel, timely filed a Petition for *inter partes* review challenging claims 7-12, 15 and 17 of the '924 Patent, within a year of Intel being sued on the patent. *See Intel Corporation v. DSS Technology Management, Inc.*, IPR2016-00290, Paper 2 (PTAB Dec. 8, 2015).

4. On June 8, 2016, the Board instituted an *inter partes* review of claims 7-12, 15 and 17 of the '924 Patent. *See Intel*, IPR2016-00290, Paper 10.

5. Concurrently with this motion, GF/Qualcomm timely filed the Present Petition for *inter partes* review challenging claims 7-12, 15 and 17 of the '924 Patent, within a year of Qualcomm being sued on the patent. GF was not sued on the patent.

6. GF/Qualcomm's unpatentability grounds in the Present IPR are identical to the positions in the instituted Intel IPR.

III. STATEMENT OF REASONS FOR REQUESTED RELIEF

A. Legal Standards

The Board has authority under 35 U.S.C. § 315(c) to join a party who files a proper *inter partes* review petition to a previously-instituted *inter partes* review proceeding. This authority is discretionary. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122.

In exercising its discretion to grant joinder, the Board considers the impact of substantive and procedural issues on the proceedings, as well as other considerations, while being “mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” *Dell Inc. v. Network-1 Sec. Solutions, Inc.*, IPR2013-00385, Paper 17 at 3-4 (PTAB July 29, 2013). The Board should consider “the policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding.” *Id.* at 10. Under this framework, joinder of the Present IPR with the Intel IPR is appropriate.

The legislative history of the AIA suggests that the joinder may be granted as a matter of right where the later petitioner files an identical petition with identical grounds of unpatentability. *See* 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (“The Office anticipates that joinder will be

allowed *as of right*-if an *inter partes* review is instituted on the basis of a petition, for example, a party that files an identical petition will be joined to that proceeding, and thus allowed to file its own briefs and make its own arguments.”) (emphasis added).

The moving party has the burden of proof and “should: (1) set forth the reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified.” *Dell*, IPR2013-00385, Paper 17 at 4. Each of these is addressed fully below.

B. Joinder is Appropriate

Although joinder is discretionary, it is appropriate here because the Present Petition does “not present issues that might complicate or delay” the existing Intel IPR. *See Enzymotec Ltd. v. Neptune Techs & Bioresources, Inc.*, IPR2014-00556, Paper 19 at 6 (July 9, 2014) (“we are mindful of a policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding”). In fact, because the Present Petition contains the identical grounds on which the Intel IPR was instituted, joinder would secure the just, speedy, and inexpensive resolution of the related proceedings.

Additionally, while the Petitioner in the Present IPR and the Petitioner in the Intel IPR have relied upon testimony from separate experts in their respective petitions, the analysis and rationale of the experts are the same, and therefore present no additional burden on the part of the Patent Owner to address. Indeed, in circumstances such as these, the Board has permitted joinder. *See Apotex, Inc. and Mylan Pharmaceuticals Inc. v. Novartis AG and Mitsubishi Pharma Corp.*, IPR2015-00518, Paper 8 at 6 (Feb. 17, 2015) (granting motion for joinder where petition relied on substantially the same declaration but from a different expert). In short, joinder would have little, if any, impact on the Intel IPR because no new grounds would be added, the schedule would not be affected, and no additional burdens would be placed on Patent Owner, as detailed below.

Petitioner moves to join the Intel IPR to ensure that it reaches a final decision in the event Intel settles with Patent Owner and is dismissed from the review. In that regard, an *inter partes* review “shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner.” 35 U.S.C. § 317(a). The Board, at its discretion, “may terminate the review” if no petitioner remains. *Id.* In previous proceedings, the Board has exercised its discretion not to terminate a review after dismissing the petitioner because of a pending joinder motion in a related proceeding. *See MediaTek Inc., et. al. v.*

Bandspeed, Inc., IPR2015-00314, Paper 20 at 3 (PTAB Sept. 17, 2015) (“We exercise the discretion afforded under 35 U.S.C. § 317(a) to decline, at this time, to terminate these proceedings with respect to Patent Owner”). Specifically, in *MediaTek*, the Board, after noting that the Motion for Joinder was filed before the Motion to Terminate, chose to wait until after ruling on the Motion for Joinder to consider whether to terminate the review entirely. *Id.*

Here, if Intel moves to terminate its IPR and Intel is dismissed before the Board decides this Motion for Joinder, Petitioner respectfully requests that the Board exercise its discretion and decline to terminate the Patent Owner at least until the Board considers this motion. If the Intel IPR is completely terminated before joinder can be effectuated, a proceeding with identical grounds of unpatentability would begin anew requiring the parties to expend resources rearguing the same issues.

Accordingly, joinder is appropriate because it eliminates the possibility of duplicate efforts and ensures a just, speedy, and inexpensive resolution of these proceedings.

1. No New Grounds of Unpatentability in the Petition

The Present Petition is identical to the petition in the Intel IPR. In particular, the Present Petition challenges the same instituted claims (7-12, 15 and 17) under

the same grounds, while relying on the same arguments, substantially the same expert declaration (although different expert), and evidence. Accordingly, no new claims and no new grounds will be added to the Intel IPR as a result of the Board allowing joinder. Denial of joinder, however, would result in parallel proceedings involving identical grounds of unpatentability and needless duplication of effort.

2. Joinder Will Not Impact the Board's Ability to Complete the Review in a Timely Manner

Joinder in this case will not impact the Board's ability to complete its review in a timely manner. 35 U.S.C. § 316(a)(11) and associated rule 37 C.F.R. § 42.100(c) provide that inter partes review proceedings should be completed and the Board's final decision issued within one year of institution of the review. In this case, joinder will not affect the Board's ability to issue the decision within this required one-year timeframe because the Petition filed in the Present IPR contains the identical ground on which the Intel IPR was instituted.

In addition, if joined, Petitioner respectfully proposes procedures to simplify any further briefing and discovery, which will minimize any potential impact on the schedule or the volume of materials to be submitted to the Board. Given that all petitioners—Intel and GF/Qualcomm—will be addressing the identical grounds for challenging the claims at issue, the Petitioner in the Present IPR will not file

additional briefs outside of the consolidated filings, will not request any additional deposition time, and will not request any additional oral hearing time.¹ In the event the Intel IPR is terminated with respect to the petitioner, GF/Qualcomm intend to “step into the shoes” of the dismissed petitioner and materially participate in the joined proceedings.

Accordingly, for the reasons above, joinder of the Present IPR to the Intel IPR will not affect the Board's ability to complete its review and issue a final decision within the statutory time limits under 35 U.S.C. § 316(a)(11) and 37 C.F.R. § 42.100(c).

3. Briefing and Discovery Will be Simplified

It is noted that Petitioner would not be time barred from filing the present Petition without a corresponding motion for joinder. However, determining the same patentability questions concerning the '924 Patent in separate parallel proceedings would complicate/duplicate efforts and create a risk of inconsistent results and piecemeal review.

¹ While Petitioner will not materially participate in calls with the Board, depositions, and any oral hearing, Petitioner anticipates that its counsel will attend such events.

Given that the positions in the Present Petition are identical to Intel's positions in the instituted IPR, Petitioner agrees to consolidated filings for all substantive papers and to consolidated discovery in the joined proceeding. With respect to consolidated filings, any papers jointly submitted by petitioners will not exceed the normal word count or page limits for a single party set forth in the rules. Petitioner will not file, or request to file, any separate briefs beyond the consolidated filings. Petitioner will not request additional cross-examination or re-direct time. Additionally, with respect to any oral hearing, Intel will be responsible for the presentation before the Board. Petitioner will not request any additional time to independently argue before the Board or attempt to submit its own demonstratives.

Accordingly, if joinder is granted, briefing and discovery in the joined proceeding will be no more complex than if Petitioner had never been joined. Consolidated briefing and discovery will ensure a simplified and efficient joined proceeding.

4. No Prejudice to Patent Owner

Joinder to the Intel IPR will not create any additional burden on Patent Owner. The Patent Owner need not expend any additional resources above and beyond those required in the current Intel IPR. Moreover, joinder eliminates the

need for Patent Owner to participate in parallel *inter partes* review proceedings instituted upon identical grounds of patentability. By allowing the identical grounds of unpatentability to be addressed in a single proceeding, the interests of all parties and the Board will be well served.

IV. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Board institute the instant *inter partes* review upon the same grounds instituted in IPR2016-00290 and join the proceedings.

Respectfully submitted,

Dated: July 1, 2016
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CERTIFICATE OF SERVICE

The undersigned certifies that, in accordance with 37 C.F.R. § 42.6(e) and 37 C.F.R. § 42.105, service was made on Patent Owner as detailed below.

Date of service July 1, 2016

Manner of service Federal Express

Documents served Petitioner's Motion for Joinder Under 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22, and 42.122(b)

Persons served per Smith & Hopen (private clients)
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