Trials@uspto.gov
571-272-7822

Paper 7
Date Entered: August 29, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION
and
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 IPR2016-00290
Case IPR2016-01312
Patent 5,965,924

Before BRYAN F. MOORE, BRIAN J. McNAMARA, and MINN CHUNG, *Administrative Patent Judges.*

McNAMARA, *Administrative Patent Judge*.

DECISION GRANTING MOTION FOR JOINDER
37 C.F.R. § 42.22 AND 42.122(b)

BACKGROUND

On July 1, 2016, Qualcomm Incorporated, Globalfoundries Inc., Globalfoundries U.S. Inc., Globalfoundries Dresden Module One LLC & Co. KG, Globalfoundries Dresden Module Two LLC & Co. KG (collectively, "Petitioner") filed a petition, Paper 3 ("Pet."), to institute an *inter partes* review of claims 7–12, 15, and 17 (the "challenged claims") of U.S. Patent No. 5,965,924 ("the '924 Patent"). 35 U.S.C. § 311. Petitioner also timely filed a Motion for Joinder (Paper 4 ("Mot. For Joinder")) of this proceeding with *Intel Corporation v. DSS Technology Management, Inc.*, IPR2016-00290 ("Intel IPR2016-00290"), which is the subject of a Decision to Institute entered on June 8, 2016. Petitioner represents that the instant Petition "is identical to the petition in [Intel IPR2016-00290]."[1] Mot. For Joinder 2, 6. In a separate decision, entered today, we instituted *inter partes* review in this proceeding on the same grounds as those in Intel IPR2016-00290. For the reasons that follow, we also grant Petitioner's Motion for Joinder.

DISCUSSION

The Director has discretion to join as a party to an *inter partes* review any person who properly files a petition that, after receiving a preliminary response, the Director determines warrants the institution of *inter partes*

[1] We understand Petitioner to mean identical in all substantive matters, as the identity of the parties is different. Petitioner also acknowledges that it relies on the testimony of a different expert than the expert witness in Intel IPR2016-00290, but states that the testimony is essentially the same. Mot. For Joinder 7.

review. 35 U.S.C. § 315(c). Petitioner argues that we should exercise our discretion under 35 U.S.C. § 315(c) to authorize joinder in this case.

Petitioner states that the instant Petition challenges the same claims, under the same grounds, advances the same arguments and relies on substantially the same expert declaration (albeit from a different expert) as those on which we instituted *inter partes* review in Intel IPR2016-00290. Mot. For Joinder 6–7. Having not advanced any new grounds or theories of unpatentability in this proceeding, Petitioner contends that joinder will avoid inefficiencies that could result from parallel proceedings. *Id.* at 7.

Noting that its positions are identical to those advanced by Intel in the Intel IPR2016-00290, Petitioner also proposes consolidated discovery and consolidated filings of all substantive papers. *Id.* at 9. Petitioner agrees not to file any separate briefs. *Id.* at 8. Petitioner agrees not to request additional cross-examination or re-direct time. *Id.* Petitioner also proposes that Intel be responsible for presentation of argument before the Board at oral hearing and agrees not to submit any demonstratives of its own. *Id.*

During a teleconference on August 11, 2016, both Intel and Patent Owner stated that they have no objection to the proposed joinder. Petitioner also stated that, while Intel participates in the proceeding, Petitioner will rely on the testimony of Intel's expert. In the event that Intel's involvement in this proceeding is terminated, Petitioner agreed that it would make its own expert available for cross examination by Patent Owner.

We agree that joinder in this case would promote the just, speedy, and inexpensive resolution of IPR2016-01312 and IPR2016-00290. Therefore, we GRANT Petitioner's unopposed Motion for Joinder and authorize the joinder in accordance with the following order.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that IPR2016-01312 is joined with IPR2016-00290;

FURTHER ORDERED that the grounds on which trial was instituted in Intel IPR2016-00290 are unchanged and that no other grounds are authorized:

FURTHER ORDERED that the Scheduling Order entered in Intel IPR2016-00290 is unchanged;

FURTHER ORDRED that throughout the proceeding Petitioner and Intel will file papers, except for motions that do not involve the other party, e.g., pro hac vice motions, as consolidated filings and that all rules concerning filing papers, e.g., page and word limits, apply to such consolidated filings;

FURTHER ORDERED that each authorized cross-examination of Patent Owner's witnesses shall be conducted as though this matter concerned only a single petitioner;

FURTHER ORDERED that Qualcomm shall rely on the testimony of Intel's expert witness and, should Intel's involvement in the proceeding be terminated, Qualcomm shall make its own expert available to Patent Owner for cross-examination;

FURTHER ORDERED that IPR2016-01312 is terminated under 37 C.F.R. § 42.72 and all further filings in the joined proceeding shall be made in IPR2016-00290; and

FURTHER ORDERED that the case caption in IPR2016-00290 shall reflect the joinder with this proceeding.

PETITIONER:

David M. O'Dell
David L. McCombs
HAYNES AND BOONE, LLP
david.odell.ipr@haynesboone.com
david.mccombs.ipr@haynesboone.com

PATENT OWNER

Andriy Lytvyn
Anton J. Hopen
Nicholas Pfeifer
Smith & Hopen, P.A.
andriy.lytvyn@smithhopen.com
anton.hopen@smithhopen.com
nicholas.pfeifer@smithhopen.com