

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GLOBALFOUNDRIES U.S. INC.,
Petitioner,

v.

GODO KAISHA IP BRIDGE 1,
Patent Owner.

Case IPR2017-00921
Patent 6,197,696 B1

Before JUSTIN T. ARBES, MICHAEL J. FITZPATRICK, and
JENNIFER MEYER CHAGNON, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* CHAGNON.

Opinion Concurring-in-Part, Dissenting-in-Part filed by *Administrative Patent Judge* FITZPATRICK.

CHAGNON, *Administrative Patent Judge*.

DECISION

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

Granting Petitioner's Motion for Joinder
37 C.F.R. § 42.122

I. INTRODUCTION

GlobalFoundries U.S. Inc. (“Petitioner”) filed a Petition for *inter partes* review of claims 13 and 15 (“the challenged claims”) of U.S. Patent No. 6,197,696 B1 (Ex. 1001, “the ’696 patent”). Paper 2 (“Pet.”). Petitioner also filed a Motion for Joinder with Case IPR2016-01376 (“the -1376 Case”). Paper 3 (“Mot.”). Godo Kaisha IP Bridge 1 (“Patent Owner”) filed an Opposition to Petitioner’s Motion for Joinder (Paper 7, “Opp.”) and a Preliminary Response (Paper 9, “Prelim. Resp.”). Petitioner filed a Reply to Patent Owner’s Opposition. Paper 8 (“Reply”).

Pursuant to 35 U.S.C. § 314(a), the Director may not authorize an *inter partes* review unless the information in the petition and preliminary response “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons that follow, we institute an *inter partes* review as to claims 13 and 15 of the ’696 patent, and grant Petitioner’s Motion for Joinder.

A. Related Proceedings

On July 12, 2016, Taiwan Semiconductor Manufacturing Company, Ltd. (“TSMC”) filed a petition in the -1376 Case requesting an *inter partes* review of the challenged claims of the ’696 patent. On January 18, 2017, we instituted an *inter partes* review. *Taiwan Semiconductor Mfg. Co., Ltd. v. Godo Kaisha IP Bridge 1*, Case IPR2016-01376 (PTAB Jan. 18, 2017) (Paper 11) (“-1376 Inst. Dec.”). Patent Owner filed its Patent Owner Response on April 14, 2017, and TSMC filed its Reply on July 21, 2017.

On February 13, 2017, Petitioner filed a petition in Case IPR2017-00880 requesting an *inter partes* review of the challenged claims based on the same asserted grounds as the petition in the -1376 Case, along with a Motion for Joinder. The petition listed Petitioner as the sole real party-in-interest. *See* IPR2017-00880, Paper 1, 60. Petitioner subsequently filed its Petition and Motion for Joinder in the instant proceeding on February 16, 2017, listing itself and GlobalFoundries, Inc. (Petitioner's corporate parent) as real parties-in-interest. *See* Pet. 60. On April 25, 2017, we dismissed the petition in Case IPR2017-00880. *See* IPR2017-00880, Paper 9.

B. The Applied References and Evidence

Petitioner relies on the following references.

Reference	Date	Exhibit
U.S. Patent No. 6,140,226 ("Grill")	Oct. 31, 2000	Ex. 1005
U.S. Patent No. 5,592,024 ("Aoyama")	Jan. 7, 1997	Ex. 1018

Petitioner further relies on the Declaration of Bruce W. Smith, Ph.D. (Ex. 1002).

C. The Asserted Grounds

Petitioner sets forth its challenges to claims 13 and 15 as follows. Pet. 22–60.

Reference(s)	Basis	Claim(s) Challenged
Grill	§ 103	13
Grill and Aoyama	§ 103	13, 15

II. DISCUSSION

A. *The Petition*

Petitioner asserts the same grounds of unpatentability as those that we considered in the -1376 Case. *See* Pet. 22–60; -1376 Inst. Dec. 26–43. Further, Petitioner presents the same arguments as those made by TSMC in its petition in the -1376 Case. *Compare* Pet. *generally*, with IPR2016-01376, Paper 2 *generally*; *see also* Mot. 1 (Petitioner representing that the asserted grounds “are essentially the same”). Patent Owner’s Preliminary Response also presents the same arguments as those made in its preliminary response in the -1376 Case. *Compare* Prelim. Resp. *generally*, with IPR2016-01376, Paper 6 *generally*.

We incorporate our previous analysis regarding the asserted grounds of unpatentability, and conclude, for the same reasons, that Petitioner has demonstrated a reasonable likelihood of prevailing on the ground challenging claims 13 and 15 under 35 U.S.C. § 103 as obvious in view of Grill and Aoyama, but has not demonstrated a reasonable likelihood of prevailing on the ground challenging claim 13 under 35 U.S.C. § 103 as obvious in view of Grill. *See* -1376 Inst. Dec. 11–43.

B. *The Motion for Joinder*

The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), created administrative trial proceedings, including *inter partes* review, as an efficient, streamlined, and cost-effective alternative to district court litigation. 35 U.S.C. § 315(c) provides (emphasis added):

JOINDER.—If the Director institutes an inter partes review, *the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311* that the Director, after receiving a

preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

“Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested.” 37 C.F.R. § 42.122(b). Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. The Board determines whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations. *See Sony Corp. of Am. v. Network-1 Security Solutions, Inc.*, Case IPR2013-00495, slip op. at 3 (PTAB Sept. 16, 2013) (Paper 13) (“*Sony*”). 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).

As the moving party, Petitioner has the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b). A motion for joinder should (1) set forth the reasons why joinder is appropriate; (2) identify any new ground(s) of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *See Sony*, at 3; Mot. 4–5. Petitioner should address specifically how briefing and/or discovery may be simplified to minimize schedule impact. *See Kyocera Corp. v. SoftView LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15) (representative); Mot. 5.

1. Timeliness of the Motion for Joinder

We instituted an *inter partes* review in the -1376 Case on January 18, 2017, and Petitioner filed its Motion for Joinder in the instant proceeding on February 16, 2017. Thus, the Motion was filed within the one-month period set forth in 37 C.F.R. § 42.122(b).

2. Substantive Issues

Petitioner argues that joinder with the -1376 Case is appropriate because its asserted grounds and supporting evidence are “essentially the same” as in the -1376 Case. *See* Mot. 1; *see* Reply 2. Patent Owner does not dispute that the asserted grounds and evidence are identical to those on which a trial was instituted in the -1376 Case. Given the similarities in substantive issues between the instant proceeding and the -1376 Case, we conclude that the impact of joinder on the existing proceeding would be minimal.

3. Procedural Issues

Petitioner argues that because the asserted grounds and supporting evidence mirror what was presented in the -1376 Case, “joinder would not affect the pending schedule in [the -1376 Case] nor increase the complexity of that proceeding, minimizing costs.” Mot. 1. Petitioner further states that it “is willing to act as an ‘understudy’ to TSMC, only assuming an active role in the event TSMC settles with” Patent Owner. *Id.*; *see* Reply 2–3.

Specifically, Petitioner

proposes that as long as TSMC remains in the joined IPR, [Petitioner] agrees to remain in a circumscribed “understudy” role without a separate opportunity to actively participate. Thus, [Petitioner] will not file additional written submissions,

nor will [Petitioner] pose questions at depositions or argue at oral hearing without the prior permission of TSMC. Only in the event that TSMC settles will [Petitioner] seek to become active in the joined IPR.

Mot. 5; *see also* Reply 3 (“Petitioner is willing to abide by such additional conditions as the Board deems appropriate.”). Because joinder would require no change to the existing trial schedule and Petitioner agrees to have only a limited “understudy” role if joined, the procedural impact of joinder on the -1376 Case would be minimal, which weighs in favor of joinder.

Patent Owner argues that, if joinder is granted, we should impose additional conditions on Petitioner’s participation in the -1376 Case. Opp. 2–3. Much of what Patent Owner requests is already stated in Petitioner’s proposal above. We agree with Patent Owner, though, that given its “understudy” role, Petitioner should be permitted to file papers, engage in discovery, and participate in depositions and oral argument only after obtaining authorization from the Board, not TSMC. *See id.* Petitioner may request a conference call to obtain such authorization if necessary.

4. Conclusion

Based on all of the considerations above, we are persuaded that Petitioner has met its burden of demonstrating that joinder is warranted under the circumstances. Petitioner will have a limited role in the -1376 Case, as set forth in the Order below. If at some point the -1376 Case is terminated with respect to TSMC, the role of any remaining party or parties in the proceeding will be reevaluated.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that an *inter partes* review is instituted as to claims 13 and 15 of the '696 patent;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '696 patent is hereby instituted commencing on the entry date of this Decision, and 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;

FURTHER ORDERED that the trial is limited to the following ground of unpatentability, and no other grounds are authorized: Claims 13 and 15 under 35 U.S.C. § 103(a) as unpatentable over Grill and Aoyama;

FURTHER ORDERED that Petitioner's Motion for Joinder with Case IPR2016-01376 is granted, and GlobalFoundries U.S. Inc. is joined as a party to Case IPR2016-01376;

FURTHER ORDERED that Case IPR2017-00921 is instituted, joined, and terminated under 37 C.F.R. § 42.72, and all further filings in the joined proceeding shall be made in Case IPR2016-01376;

FURTHER ORDERED that unless given prior authorization by the Board, Petitioner is not permitted to file papers, engage in discovery, or participate in any deposition or oral argument in Case IPR2016-01376. Petitioner, however, is permitted to appear in Case IPR2016-01376 so that it receives notification of filings and may attend depositions and oral argument.¹ Should Petitioner believe it necessary to take any further action,

¹ Counsel for TSMC and Petitioner should refer to the Board's website for information regarding filings in the Patent Trial and Appeal Board End-to-End (PTAB E2E) system.

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Petitioner should request a conference call to obtain authorization from the Board; and

FURTHER ORDERED that a copy of this Decision be entered into the record of Case IPR2016-01376.

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FITZPATRICK, *Administrative Patent Judge*, concurring-in-part,
dissenting-in-part.

I concur with the majority’s decision to join GlobalFoundries U.S. Inc. (“Global”) as co-petitioner in the previously instituted *inter partes* review (Case IPR2016-01376). I dissent from the remainder of the majority’s decision, including the decision to grant the Motion for Joinder and to “institute[], join[], and terminate[]” Case IPR2017-00921.

I. The Motion For Joinder Should Not Be Granted

The Motion for Joinder seeks “joinder” of a Global-petitioned *inter partes* review with Case IPR2016-01376. Paper 3, 6–7 (“Global respectfully requests that its Petition for *Inter Partes* Review of U.S. Patent No. 6,197,696 B1 be granted and that the proceedings be joined with *Taiwan*

Semiconductor Manufacturing Company Limited (“TSMC”) v. Godo Kaisha IP Bridge 1, Case No. IPR2016-01376.”). But, the statutory sub-section under which Global seeks relief, 35 U.S.C. § 315(c), does not permit joining an *inter partes* review to another *inter partes* review. *Id.*; but *cf. id.* § 315(d) (referring to “consolidation” of a pending *inter partes* review and “another proceeding or matter involving the patent”). Section 315(c) refers to joining, rather, a “person” “as a party” to an instituted *inter partes* review. It states the following:

(c) JOINDER.—If the Director institutes an inter partes review, the Director, in his or her discretion, may *join as a party* to that inter partes review *any person who properly files a petition* under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

35 U.S.C. § 315(c) (emphasis added). Hence, although I concur in the decision to join Global as co-petitioner in Case IPR2016-01376, I do not agree with the majority’s decision to grant the Motion for Joinder, which seeks relief not authorized by § 315(c) and not properly labeled “joinder.”

II. The Petition Should Not be Granted

Granting a petition for an additional *inter partes* review is not necessary to grant joinder. 35 U.S.C. § 315(c). As a prerequisite to joining a person as a party to an instituted *inter partes* review, the statute requires us—as the Director’s delegates²—to determine that the person to be joined has properly filed a petition that “warrants the institution of an inter partes

² Although § 325(d) refers only to determinations by “the Director,” the Director has delegated institution authority to the Board. *See* 37 C.F.R. § 42.4(a).

review.” Granting the person’s petition (i.e., institution), however, is not a prerequisite to granting the person’s request for joinder.

And, “a petition to institute an inter partes review” (35 U.S.C. § 311(a)) is distinct from “a request for joinder” (35 U.S.C. § 315(b)). In fact, although “[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, or privy of the petitioner is served with a complaint alleging infringement of the patent,” that petitioner may still be joined to an instituted an *inter partes* review (if one exists) that was filed by a different petitioner. 35 U.S.C. § 315(b).

As the majority notes *supra*, the Petition before us presents the same grounds of unpatentability as those that were previously presented to the Office in Case IPR2016-01376. I would deny the Petition under 35 U.S.C. § 325(d). The majority implicitly recognizes that an additional *inter partes* review based on the Petition would be duplicative of Case IPR2016-01376 and, thus, it terminates the *inter partes* review that it institutes. But, the majority does not explain the legal basis for terminating it. Clearly, Case IPR2017-00921 is not being terminated under 35 U.S.C. § 317. Nor is a final written decision being entered pursuant to 35 U.S.C. § 318.

I concur with the majority’s decision to join Global as co-petitioner in Case IPR2016-01376, but I would not grant Global’s Motion for Joinder or its Petition.

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