

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: *To be Assigned*

Patent 6,197,696

MOTION FOR JOINDER PURSUANT TO

35 U.S.C. § 315 (c) 37 C.F.R. §§ 42.22 AND 42.122(b)

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TABLE OF CONTENTS

	<u>Page</u>
I. STATEMENT OF THE PRECISE RELIEF REQUESTED	1
II. STATEMENT OF MATERIAL FACTS	2
III. STATEMENT OF REASONS FOR RELIEF REQUESTED	3
A. Joinder will not impact the Board’s ability to complete the review in a timely manner.....	4
B. Joinder will promote efficiency by consolidating issues, avoiding duplicate efforts, and preventing inconsistencies	5
C. Joinder will not prejudice IP Bridge.....	5
IV. CONCLUSION.....	6

TABLE OF AUTHORITIES

	Page(s)
CASES	
<i>Dell, Inc. v. Network-1 Security Solutions, Inc.</i> , IPR2013-00385	4
STATUTES	
35 U.S.C. § 103	2
35 U.S.C. § 315(c)	1, 3
35 U.S.C. § 316(a)(1).....	6
35 U.S.C. § 316(a)(11).....	4
OTHER AUTHORITIES	
37 C.F.R. § 42.22	1, 2
37 C.F.R. § 42.100(c).....	4, 6
37 C.F.R. § 42.122(a).....	3
37 C.F.R. § 42.122(b)	1, 2

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

GlobalFoundries U.S. Inc. (“Global”) respectfully submits this Motion for Joinder, together with a Petition for *Inter Partes* Review of U.S. Patent No. 6,197,696 B1 (“the ’696 Patent”) (“Petition”). Pursuant to 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22 and 42.122(b), Global requests institution of an *inter partes* review and joinder with the *inter partes* review concerning the same patent in *Taiwan Semiconductor Manufacturing Company Limited (“TSMC”) v. Godo Kaisha IP Bridge 1*, Case No. IPR2016-01377 (the “Second TSMC IPR”), which was instituted on January 18, 2017.

Global submits that: (1) joinder is appropriate because it will promote efficient determination of the validity of the ’696 Patent without prejudice to Godo Kaisha IP Bridge 1 (“IP Bridge”); (2) Global’s Petition includes grounds that are essentially the same as the ground instituted in the Second TSMC IPR; (3) joinder would not affect the pending schedule in the Second TSMC IPR nor increase the complexity of that proceeding, minimizing costs; and (4) Global is willing to act as an “understudy” to TSMC, only assuming an active role in the event TSMC settles with IP Bridge. Thus, Petitioner does not seek to alter the grounds upon which the Board has already found support in instituting the Second TSMC IPR, and joinder will have no impact on the existing schedule in the Second TSMC IPR.

This Motion for Joinder is timely under 37 C.F.R. §§ 42.22 and 42.122(b), as it is submitted within one month of the date on which the First TSMC IPR was instituted.

II. STATEMENT OF MATERIAL FACTS

1. Godo Kaisha IP Bridge 1 is the owner of the '696 Patent.
2. On July 12, 2016, TSMC filed its petition for *inter partes* review of claims 10-12 of the '696 Patent.
3. On July 12, 2016, TSMC concurrently filed related petitions for *inter partes* review of various claims of the '696 Patent in IPR2016-01376 ("the First TSMC IPR"), IPR2016-01378 ("the Third TSMC IPR"), and IPR2016-01379 ("the Fourth TSMC IPR").
4. On January 18, 2017, a decision instituting *inter partes* review of claims 10-12 of the '696 Patent was entered in the Second TSMC IPR (Paper No. 11, IPR2016-01377) on the grounds that claims 10-12 were unpatentable over U.S. Patent No. 6,140,226 ("the '226 patent" or "Grill") in view of U.S. Patent No. 5,592,024 ("the '024 patent" or "Aoyama") under 35 U.S.C. § 103.
5. On January 18, 2017, a decision instituting *inter partes* review of claims 13 and 15 of the '696 Patent was entered in the First TSMC IPR (Paper No. 11, IPR2016-01376) on the grounds that claims 13 and 15 were unpatentable

over Grill in view of Aoyama, a decision instituting *inter partes* review of claims 13 and 14 of the '696 Patent was entered in the Third TSMC IPR (Paper No. 11, IPR2016-01378) on the grounds that claims 13 and 15 were unpatentable over Grill in view of Aoyama, and a decision instituting *inter partes* review of claims 10 and 12 of the '696 Patent was entered in the Fourth TSMC IPR (Paper No. 11, IPR2016-01379) on the grounds that claims 10 and 12 were unpatentable over Grill in view of Aoyama and U.S. Patent No. 5,920,790 ("the '790 patent" or "Wetzel") under 35 U.S.C. § 103.

6. Oral argument is currently scheduled for September 12, 2017 in the First TSMC IPR, Second TSMC IPR, Third TSMC IPR, and Fourth TSMC IPR.

7. Concurrently with this Motion for Joinder, Global is filing Petitions for *inter partes* review of various other claims of the '696 Patent, including grounds that are essentially the same as the grounds in the First TSMC IPR, Third TSMC IPR, and Fourth TSMC IPR.

8. The Petition includes grounds that are essentially the same as the grounds instituted in the Second TSMC IPR.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

The Leahy-Smith America Invents Act ("AIA") permits joinder of like review proceedings, *e.g.*, an *inter partes* review ("IPR") may be joined with another *inter partes* review. 37 C.F.R. § 42.122(a). The statutory provision

governing joinder of *inter partes* review proceedings is 35 U.S.C. § 315(c), which states:

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.

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.” *See Dell, Inc. v. Network-1 Security Solutions, Inc.*, Case IPR2013-00385, Paper No. 17 (July 29, 2013) at 3. 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 Petition with the Second TSMC IPR is appropriate.

“A motion for joinder 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.” *Id.* at 4. Each of these is addressed fully below.

A. 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 because Global will be joining the grounds on which the Second TSMC IPR has been instituted. In fact, Global’s grounds are essentially identical to the grounds for which the Board instituted the Second TSMC IPR.

In addition, Global respectfully proposes that as long as TSMC remains in the joined IPR, Global agrees to remain in a circumscribed “understudy” role without a separate opportunity to actively participate. Thus, Global will not file additional written submissions, nor will Global pose questions at depositions or argue at oral hearing without the prior permission of TSMC. Only in the event that TSMC settles will Global seek to become active in the joined IPR.

B. Joinder will promote efficiency by consolidating issues, avoiding

duplicate efforts, and preventing inconsistencies

Global would not be time barred from filing the present Petition without a corresponding motion for joinder. However, determining the same validity questions concerning the '696 Patent in separate concurrent proceedings would duplicate efforts, and create a risk of inconsistent results and piecemeal review. Proceeding with a consolidated *inter partes* review would avoid inefficiency and potential inconsistency and would result in a final written decision without any delay.

C. Joinder will not prejudice IP Bridge

Permitting joinder will not prejudice IP Bridge. If joinder is granted, Global will be joining the grounds instituted in the Second TSMC IPR, thus the primary issues will already be before the Board, such that joinder would not affect the timing of the Second TSMC IPR or the content of IP Bridge's Patent Owner response due on April 5, 2017. But, to the extent necessary, any extension to the schedule that may be required is permitted by law and the applicable rules. 35 U.S.C. § 316(a)(1); 37 C.F.R. § 42.100(c). In fact, joinder is likely more convenient and efficient for IP Bridge by providing a single trial on the '696 patent. By allowing all grounds of invalidity 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, 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. IPR2016-01377. Joinder will ensure a just, speedy and inexpensive resolution in both proceedings.

The Patent Trial and Appeal Board is hereby authorized to charge any additional fees associated with this filing to Deposit Account No. 50-3672.

RESPECTFULLY SUBMITTED,

White & Case LLP

Date: February 13, 2017

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**CERTIFICATION OF
SERVICE**

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on the 13th day of February 2017, a complete copy of the foregoing "MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22 AND 42.122(b)" and all supporting exhibits were served via Priority Mail Express® to the Patent Owner by serving the correspondence address of record for the '696 Patent to:

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Courtesy copies of the foregoing were also served via Priority Mail Express® on counsel of record for the Petitioner and Patent Owner in *Taiwan Semiconductor Manufacturing Company Limited ("TSMC") v. Godo Kaisha IP Bridge 1*, Case No. IPR2016-01377 as follows:

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