

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Cavium, Inc.,
Petitioner

v.

Alacritech, Inc.,
Patent Owner

U.S. Patent No. 8,805,948
Filing Date: September 26, 2013
Issue Date: August 12, 2014

Inter Partes Review No. 2017-01729

Title: Intelligent network interface system and method for protocol processing

MOTION FOR JOINDER

I. INTRODUCTION

Cavium, Inc. (“Cavium” or “Petitioner”) submits this motion for the petition for *inter partes* review of U.S. Patent No. 8,805,948 (“the ‘948 patent”) filed on July 1, 2017, Case No. IPR2017-01729 (the “Petition”). The Petition was based on the identical grounds that form the basis for the pending *inter partes* review initiated by Intel Corporation (“Intel”) concerning the same patent, Case No. IPR2017-01395 (the “Intel ‘948 IPR”).

Petitioner respectfully requests that the Petition be instituted and moves that the Petition be joined with the Intel ‘948 IPR pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b). Petitioner merely requests an opportunity to join with the Intel ‘948 IPR as an “understudy” to Intel, only assuming an active role in the event Intel no longer is a party to these proceedings. Petitioner does not seek to alter the grounds upon which the Board will institute the Intel ‘948 IPR, and joinder will have no impact on the Intel ‘948 IPR’s existing schedule. Petitioner has conferred with counsel for Intel, which does not oppose this motion. This motion is timely as the Intel ‘948 IPR petition was only recently filed and the Board has not yet issued an institution decision. 35 U.S.C. § 21(b); 37 C.F.R. § 42.122(b).

II. BACKGROUND AND RELATED PROCEEDINGS

Alacritech, the owner of the ‘948 patent, sued CenturyLink, Inc., Wistron Corp., and Dell Inc., in the District Court for the Eastern District of Texas in July

2015 for infringement of U.S. Pat. Nos. 7,124,205, 7,237,036, 7,337,241, 7,673,072, 8,131,880, 8,805,948, 9,055,104, and 7,945,699 (collectively, the “Asserted Patents”). The litigations are *Alacritech, Inc. v. CenturyLink, Inc.*, 2:16-cv-00693-JRG-RSP (E.D. Tex.); *Alacritech, Inc. v. Wistron Corp.*, 2:16-cv-00692-JRG-RSP (E.D. Tex.); and *Alacritech, Inc. v. Dell Inc.*, 2:16-cv-00695-RWS-RSP (E.D. Tex.).

In May and June 2017, Intel filed twelve petitions for *inter partes* review against the Asserted Patents. See IPR Case Nos. IPR2017-01391 (‘036 patent), -01392 (‘241 patent), -01393 (‘104 patent), -01395 (‘948 patent), -01402 (‘205 patent), -01405 (‘205 patent), -01406 (‘072 patent), -01409 (‘880 patent), -01410 (‘880 patent), -01559 (‘699 patent), -01705 (‘072 patent), and -01713 (‘241 patent). These IPRs are awaiting institution by the Board. In addition to this motion to join IPR2017-01395, Petitioner is filing related motions to join IPR Case Nos. IPR2017-01391, -01392, -01393, -01402, -01405, -01406, -01409, -01410, -01559, -01705, and -01713.

III. LEGAL STANDARD AND APPLICABLE RULES

Joinder is governed by 35 U.S.C. § 315(c), which reads as follows:

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.

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.” *See* Decision on Joinder, IPR2013-00385 (Paper No. 17, July 29, 2013); *see also* Order Authorizing Joinder, IPR2013-00004 (Paper No. 15, April 24, 2013.) Petitioner submits the factors outlined below in support of granting the present Motion for Joinder.

IV. PETITIONER MEETS THE REQUIREMENTS FOR MOTION FOR JOINDER

Petitioner submits that (1) joinder is appropriate because it will promote efficient determination of the validity of the ‘948 patent without prejudice to Alacritech, Inc.; (2) Petitioner’s petition raises the same grounds for unpatentability as does Intel ‘948 IPR petition and is based on the same testimony from the same technical expert; (3) joinder would not affect the expected schedule in the Intel ‘948 IPR nor would it increase the complexity of that proceeding; and (4) Petitioner is willing to accept an understudy role in the Intel ‘948 IPR to simplify discovery and minimize the burden on the parties and the Board. Absent joinder, the Board will be burdened with entertaining two separate IPRs against the ‘948 patent on identical grounds, wasting resources and losing efficiency, and the parties will be subject to redundant discovery obligations. Accordingly, joinder should be granted.

A. Joinder Will Promote the Efficient Determination of the ‘948 Patent’s Validity and Will Not Prejudice Alacritech

Granting joinder and allowing Petitioner to assume an understudy role will not prejudice Alacritech or burden the Board. The Petition does not raise any issues that are not already before the Board in the Intel ‘948 IPR and thus the Board would receive consolidated filings for the joined IPRs instead of redundant submissions in separate IPRs. Likewise, Alacritech would only need to respond to consolidated filings rather than respond to separate filings from the separate petitioners. The Board has granted motions for joinder in similar circumstances. *See, e.g.,* Decision on Joinder, IPR2014-00743 (Paper 10, June 18, 2014).

Joinder is appropriate here to promote judicial efficiency and avoid unnecessary expense to the parties.

B. Petitioner’s Petition Raises the Same Grounds as the Intel ‘948 IPR

The Petition asserts only grounds that are awaiting the Board’s institution in the Intel ‘948 IPR, supported by the same technical expert and the same testimony. There are no new arguments for the Board to consider. Likewise, the Petition relies on the same exhibits.

C. Joinder Will Not Affect the Schedule of the Intel ‘948 IPR

Because Petitioner filed its pending IPR and corresponding motion for joinder so soon after the filing of the Intel ‘948 IPR, allowing Petitioner to join the Intel ‘948

IPR will not impact the expected scheduling order for the Intel ‘948 IPR or the Board’s ability to complete its review within the statutory period. Section 316(a)(11) requires that IPR proceedings be completed and the Board’s final decision issued no later than one year after the date on which the Director notices the institution of the IPR. *See also* 37 C.F.R. § 42.100(c). Petitioner submits that Alacritech does not need to file a Patent Owner’s Preliminary Response, and requests that the Board proceed without one. This is consistent with the Board’s Order in IPR2013-00256 (Paper 8, June 13, 2013), which allowed the Patent Owner to file a preliminary response addressing only those points raised in the new petition that were different from those in the granted petition. Here, because the invalidity grounds in the Petition are identical to those raised in the Intel ‘948 IPR, there will be no new arguments for Alacritech to address. Alternatively, Petitioner requests that the Board accelerate the deadline for Alacritech’s Patent Owner’s Preliminary Response to respond to this Petition so the Board can address the institution of the current Petition concurrently with the Intel ‘948 IPR petition. Doing so would ensure that joinder would not impact any deadlines set in the Intel ‘948 IPR schedule.

D. Petitioner Agrees to Assume a Limited Role

Petitioner agrees to an understudy role and does not raise any issues that are not already before the Board. The invalidity grounds in the Petition are the same as those that are waiting the Board’s institution in the Intel ‘948 IPR and the expert

testimony in support of the grounds are the same. Given that Petitioner will assume an understudy role, joinder with this IPR proceeding will not introduce any additional arguments, briefing, or need for discovery. *See* Decision on Joinder, IPR2013-00495 (Paper 13, Sept. 16, 2013). To the contrary, joinder will eliminate the need of the parties to file redundant briefs and conduct redundant discovery, including redundant depositions of the parties' respective expert witnesses, in the separate IPRs.

As long as Intel remains in the joined IPR, Petitioner agrees to assume a limited "understudy" role. Petitioner would only take on an active role if Intel were no longer a party to the IPR. Discovery will be simplified in that there will be no need for redundant depositions of the parties' respective experts.

V. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that its Petition for Inter Partes Review of the '948 patent be granted and that the proceedings be joined with IPR2017-01395.

Date: July 6, 2017

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. Section 42.6, that a complete copy of the attached Motion for Joinder is being served via Federal Express on the 6th day of July, 2017, the same day as the filing of the above-identified document in the United States Patent and Trademark Office/Patent Trial and Appeal Board, upon the Patent Owner by serving the correspondence address of record with the USPTO as follows:

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and upon counsel of record for the Patent Owner in the litigation pending before the U.S. District Court for the Eastern District of Texas entitled Alacritech, Inc. v. Dell Inc., 2:16-cv-00695-RWS-RSP (E.D. Tex.) as follows:

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Dated: July 6, 2017

/ Patrick D. McPherson /
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