

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORP.,
Petitioner,

v.

ALACRITECH, INC.,
Patent Owner.

Case IPR2018-01352
Patent 7,945,699 B2

Before STEPHEN C. SIU, DANIEL N. FISHMAN, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and
Granting Petitioner's Motion for Joinder
35 U.S.C. § 314(a), 37 C.F.R. §§ 42.108, 42.122

I. INTRODUCTION

Intel Corp. (“Intel” or “Petitioner”), filed a Petition (Paper 1, “Pet.”) for *inter partes* review of claims 1–3, 6, 7, 10, 11, 13, 16, and 17 of U.S. Patent No. 7,945,699 B2 (“the ’699 Patent”) (Ex. 1001, 1) pursuant to 35 U.S.C. §§ 311–319. Petitioner also filed a Motion for Joinder. Paper 3 (“Joinder Motion” or “Mot.”). The Joinder Motion seeks to join Intel as a petitioner in *Cavium, LLC v. Alacritech*, Case IPR2018-00401 (“the 401 IPR”).¹ Mot. 1. The Joinder Motion indicates Cavium, Petitioner in the 401 IPR, does not oppose Intel’s request to join the proceeding. *Id.* at 1, 2.

Patent Owner filed Patent Owner’s Opposition to Petitioner’s Motion for Joinder (Paper 7), and Petitioner filed a Reply in Support of Motion for Joinder to Inter Partes Review IPR2018-00401 (Paper 9). Patent Owner also filed a Preliminary Response. Paper 10.

As explained further below, we institute trial in this *inter partes* review on the same grounds as instituted in IPR2018-00401 for claims 1–3, 6, 7, 10, 11, 13, 16, and 17, and we grant Petitioner’s Motion for Joinder.

II. DISCUSSION

A. *Institution of Trial*

In IPR2018-00401, Petitioner Cavium challenges the patentability of claims 1–3, 6, 7, 10, 11, 13, 16, and 17 of the ’699 as unpatentable under 35 U.S.C. § 103(a) over Kiyohara² and SMB.³ IPR2018-00401, Paper 1.

¹ Cavium, Inc. changed its name to Cavium, LLC. IPR2018-00401. Paper 17.

² US Patent 5,237,693, issued August 17, 1993 (“Kiyohara,” IPR2018-00401 Ex. 1089).

³ X/Open Company Ltd., *Protocols for X/Open PC Interworking: SMB, Version 2, Technical Standard*, 1992 (“SMB,” IPR2018-00401 Ex. 1055).

After considering the Petition and the Patent Owner's Preliminary Response in IPR2018-00401, we instituted trial for all the challenged claims on all proposed grounds. *See* IPR2018-00401, Paper 8. Petitioner here (Intel Corp.) represents that this Petition is substantively identical to the Petition in IPR2018-00401 and challenges the same claims based on the same grounds. Mot. 2. We have considered the relevant Petitions and we agree with Petitioner's representation that this Petition is substantially identical to the Petition in IPR2018-00401. *Compare* Pet., with IPR2018-00401, Paper 1.

Accordingly, for essentially the same reasons stated in our Decision to Institute in IPR2018-00401, we conclude Petitioner has established a reasonable likelihood of prevailing with respect to at least one challenged claim and we institute trial in this proceeding for claims 1–3, 6, 7, 10, 11, 13, 16, and 17 on the same ground as in IPR2018-00401.

B. Motion for Joinder

Based on authority delegated to us by the Director, we have discretion to join a petitioner for *inter partes* review to a previously instituted *inter partes* review. 35 U.S.C. § 315(c). Section 315(c) provides, in relevant part, that “[i]f 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.” *Id.*

Petitioner requests to “take the primary role in IPR2018-00401 with Cavium taking on the ‘understudy’ role and only assuming a primary role in the event Intel is no longer a party to this proceeding” (Mot. 1) in order to “promote efficiency” (*id.*) in view of Intel's primary role in related matters.

We agree with Petitioner that Intel assuming a primary role and Cavium assuming an “understudy” role (only assuming a primary role in the event Intel is no longer a party) would promote efficiency.

Patent Owner opposes the Motion for Joinder but “would not oppose joinder if . . . all filings by Intel . . . be consolidated with the filings of Cavium . . . Intel shall not be permitted to raise any new grounds . . . Intel shall not be permitted to introduce any argument or discovery not already introduced by Cavium; . . . Intel shall be bound by any agreement between Patent Owner and Cavium concerning discovery and/or depositions; and . . . Intel at deposition shall not receive any direct, cross examination or redirect time beyond that permitted for Cavium . . .” Paper 7, 1–2. Petitioner states that “only the party with the primary role . . . can introduce arguments or discovery” and that “Intel’s Petition has identical grounds to the existing IPR.” Paper 9, 2–3. It is also expected that the party that assumes the primary role (and not the party assuming an “understudy” role) would have agreements with Patent Owner regarding discovery or depositions and would receive any direct, cross examination, or redirect time. Also, upon joinder, filings are to be made by the party assuming the primary role (and not the party assuming the “understudy” role). Therefore, each of Patent Owner’s concerns regarding assigning Intel a “primary role” in the proceeding while assigning an “understudy” role to Cavium are moot.

We grant Petitioner’s Motion for Joinder with the 401 IPR subject to the condition that, in the joined proceeding, Cavium (original Petitioner in IPR2017-00401, now assuming an “understudy” role) will be bound by all substantive and procedural filings and representations of Intel Corp. (joined Petitioner in IPR2018-00401, now assuming a primary role), without a

separate opportunity to be heard, whether orally or in writing, unless and until the joined proceeding is terminated with respect to Petitioner Intel Corp. in IPR2018-00401.

In view of the foregoing, we determine that joinder based upon the above-noted condition will have little or no impact on the timing, cost, or presentation of the trial on the instituted grounds. Moreover, discovery and briefing will be simplified if the proceedings are joined.

III. ORDER

After due consideration of the record before us, and for the foregoing reasons, it is:

ORDERED that pursuant to 35 U.S.C. § 314, an *inter partes* review is hereby instituted for claims 1–3, 6, 7, 10, 11, 13, 16, and 17 of the '699 Patent as obvious under 35 U.S.C. § 103(a) over Kiyohara and SMB;

FURTHER ORDERED that Petitioner's Motion for Joinder with IPR2018-00401 is *granted* and Intel Corp. is joined as a petitioner in IPR2018-00401, pursuant to 37 C.F.R. §§ 42.72, 42.122, on the condition that, in the joined proceeding, Petitioner here (i.e., Intel Corp.) will assume a primary role in the proceeding and Petitioner in IPR2018-00401 (i.e., Cavium, LLC) will assume an understudy role, Cavium being bound by all substantive and procedural filings and representations of Intel Corp. without a separate opportunity to be heard, whether orally or in writing, unless and until the joined proceeding is terminated with respect to Petitioner Intel in IPR2018-00401;

FURTHER ORDERED that the grounds on which an *inter partes* review was instituted in Case IPR2018-00401 remain unchanged, and no

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other grounds are instituted in the joined proceedings;

FURTHER ORDERED that the Scheduling Order in place for IPR2018-00401 (Paper 9) shall govern the joined proceedings;

FURTHER ORDERED that IPR2018-01352 is terminated under 37 C.F.R. § 42.72, and that all future filings in the joined proceeding are to be made only in IPR2018-00401;

FURTHER ORDERED that the case caption in IPR2018-00401 for all further submissions shall be changed to add Petitioner (Intel Corp.) as a named Petitioner, and to indicate by footnote the joinder of Petitioner Intel Corp. to that proceeding, as indicated in the attached sample case caption; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2018-00401.

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Case IPR2018-00401⁴

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⁴ Cavium, who filed a Petition in Case IPR2018-00401, and Intel Corp., who filed a Petition in Case IPR2018-01352, have been joined as petitioners in this proceeding.