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Paper 16
Date: April 19, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL TECHNOLOGIES INC. and DELL INC.,
Petitioner,

v.

3D SURFACES, LLC,
Patent Owner.

IPR2023-00006
Patent RE42,534 E

Before JEFFREY S. SMITH, GEORGE R. HOSKINS, and ROBERT L. KINDER, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314
Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

In this proceeding, Dell Technologies Inc. and Dell Inc. (collectively, "Dell") filed a Petition (Paper 5, "Pet.") timely on October 3, 2022[1] to institute an *inter partes* review of U.S. Patent No. RE42,534 E (Ex. 1001, "the '534 patent"), claims 1–10. Dell also filed an Explanation (Paper 4) for filing two petitions against the '534 patent, ranking the present Petition ahead of the petition filed in IPR2023-00005. Dell further filed a Motion for Joinder (Paper 9, "Mot.") to join this proceeding with *Intel Corporation v. 3D Surfaces, LLC*, IPR2022-01591 ("Intel IPR"), which was filed by Intel Corporation ("Intel") on October 1, 2022.

3D Surfaces, LLC ("Patent Owner") filed a Preliminary Response (Paper 10) opposing institution of review. Patent Owner also filed a Response (Paper 11) to Petitioner's Explanation concerning the two petitions. Patent Owner has not opposed Dell's Motion for Joinder.

For the reasons set forth below, we: (1) institute an *inter partes* review based on the same grounds instituted in the Intel IPR; and (2) grant Dell's Motion for Joinder, subject to conditions detailed below.

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[1] Dell was served with a complaint alleging infringement of the '534 patent on October 26, 2021, in *3D Surfaces, LLC v. Dell Techs. Inc., et al.*, Case No. 1:22-cv-00854 (W.D. Tex.). *See* Pet. 81; Paper 6, 1 (explaining the litigation was previously Case No. 6:21-cv-01107); Paper 10, 33 (Patent Owner stating "[t]he district court complaint was served on October 26, 2021"). Therefore, based on the record before us, it appears the Petition was filed within the 1-year period specified by 35 U.S.C. § 315(b).

II. INSTITUTION OF *INTER PARTES* REVIEW

In the Intel IPR, in a decision entered contemporaneously with the present Decision, we are instituting review of the '534 patent based on the following grounds:

Ground	Claims Challenged	35 U.S.C. §[2]	References
1	1–10	103(a)	Sfarti[3], Foley[4]

Dell's Petition is substantially identical to the Intel IPR petition, challenging the same patent and claims, based on the same grounds of unpatentability, and relying on the same evidence (including the same prior art combinations supported by the same witness's testimony). *See* Mot. 1, 2–3. Dell seeks institution only of the same claims and ground for which the Board has instituted review in the Intel IPR. *Id.*

Patent Owner's Preliminary Response in this proceeding raises the same arguments that we have considered and determined to be unpersuasive in the decision granting institution in the Intel IPR.

Dell stipulates that, if institution of review and the Motion for Joinder are granted in this proceeding, Dell's participation will be limited to an "understudy" role, and Dell will assume an active role only in the event that Intel ceases to participate in the instituted IPR. *See* Mot. 1, 3–4. Dell also

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[2] The '534 patent issued in July 2011. *See* Ex. 1001, code (45). Therefore, the first-inventor-to-file provisions of the Leahy-Smith America Invents Act (Pub. L. No. 112-29, 125 Stat. 284 (2011)), which took effect in March 2013, do not apply here.

[3] Ex. 1009 (U.S. Pat. App. Pub. No. 2002/0033821 A1, pub. Mar. 21, 2002).

[4] Ex. 1007 (James D. Foley et al., *Computer Graphics: Principles and Practice, Second Edition* (Addison Wesley Pub. Co., pub. Jan. 1991)).

contends the proposed joinder will avoid multiplication of issues before the Board. *See id.* at 2–3. As such, Dell asserts the joinder will promote efficiency in determining patentability of the ’534 patent in the Intel IPR without prejudice to Patent Owner. *See id.* at 2–5.

In view of these representations by Dell, and having reviewed Dell’s Petition, we determine that, under the current circumstances, it is appropriate to exercise our discretion to institute *inter partes* review of the challenged claims based upon the same grounds authorized and for the same reasons discussed in our institution decision in the Intel IPR.

III. JOINDER OF *INTER PARTES* REVIEWS

An *inter partes* review may be joined with another *inter partes* review, as provided by 35 U.S.C. § 315(c):

> (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.

As the moving party, Dell bears the burden of proving it is entitled to the requested relief. *See* 37 C.F.R. § 42.20(c). A motion for joinder should: set forth the reasons joinder is appropriate; identify any new grounds of unpatentability asserted in the petition; and explain what impact (if any) joinder would have on the trial schedule for the existing review. *See, e.g.*, PTAB Consolidated Trial Practice Guide (Nov. 2019)[5], 76–77.

[5] Available at https://www.uspto.gov/TrialPracticeGuideConsolidated.

Dell timely filed its Motion for Joinder within one month of the institution of the Intel IPR, as required by 37 C.F.R. § 42.122(b). Dell also states it "will agree to consolidated filings for all substantive papers in the proceeding" and "to incorporate [Dell's] filings with those of Intel in a consolidated filing, subject to the ordinary rules for one party on page limits." Mot. 3–4. Dell represents that "Intel and [Dell] will be jointly responsible for the consolidated filings" and Dell "agrees not to be permitted any arguments separate from those advanced by [Dell] and Intel in the consolidated filings." *Id.* at 4. Further according to Dell, "Intel and Dell will designate an attorney to conduct the cross examination of any given witness produced by [Patent Owner] and the redirect of any given witness produced by Intel or Dell," and "Dell will not receive any separate cross-examination or redirect time." *Id.* at 6.

As discussed in Section II above, the instituted grounds in this proceeding are the same as those instituted in the Intel IPR. In light of that overlap, and the essentially identical timing of the two proceedings, and Dell's foregoing stipulations limiting its participation to an understudy role, we determine Dell has established persuasively that joinder is appropriate and will have little to no impact on the timing, cost, or complexity of briefing and/or discovery on the instituted grounds. Thus, in consideration of the foregoing, and in the manner set forth in the following Order, Dell's Motion for Joinder is *granted*.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is instituted for the ’534 patent, claims 1–10, on all grounds presented in Dell’s Petition; and

FURTHER ORDERED that, 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 in this proceeding, which commences on the entry date of this Decision; and

FURTHER ORDERED that Dell’s unopposed Motion for Joinder with IPR2022-01591 is *granted*;

FURTHER ORDERED that Dell is joined with Intel as a petitioner in IPR2022-01591, pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122;

FURTHER ORDERED that Dell’s role in the joined proceedings shall be limited as stated in Dell’s Motion for Joinder (Paper 9), unless and until Intel ceases to participate as a petitioner in the joined proceedings;

FURTHER ORDERED that the Scheduling Order entered in IPR2022-01591 shall govern the joined proceedings;

FURTHER ORDERED that all future filings in the joined proceedings are to be made only in IPR2022-01591;

FURTHER ORDERED that the case caption in IPR2022-01591 for all further submissions shall be changed to reflect the joinder of Dell, in accordance with the example case caption below; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2022-01591.

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Joined Case Caption

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IPR2022-01591[1]
Patent RE42,534 E

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[1] IPR2023-00006 has been joined with this proceeding.