

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL TECHNOLOGIES INC. AND DELL INC.,

Petitioners,

v.

GREENTHREAD LLC,

Patent Owner.

Case: IPR2023-00509

U.S. Patent No. 11,121,222

**MOTION FOR JOINDER TO
INTER PARTES REVIEW IPR2023-00420**

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US Patent and Trademark Office
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I. STATEMENT OF PRECISE RELIEF REQUESTED

Petitioners Dell Technologies Inc. and Dell Inc. (“Petitioners” or “Dell”) hereby move for joinder of Dell’s contemporaneously-filed petition for *Inter Partes* Review (“IPR”) of claims 1-9, 13-18, 20-28, 32-36, and 38-42 of U.S. Patent No. 11,121,222 (the “’222 Patent”) with a pending IPR filed by Intel Corporation against Greenthread LLC, IPR2023-00420 (“Intel IPR”).

The Intel IPR was filed on December 28, 2022, on the same patent and the same claims as this Petition. This Petition and supporting declaration are substantively identical to the petition and declaration submitted in the Intel IPR. More specifically, Petitioners here assert that the same claims are obvious over the same prior art based on the same arguments presented by the same expert as in the Intel IPR.

Intel has informed Petitioners that they do not oppose joinder. Petitioners here have agreed to take an “understudy” role if joined. Joinder will not cause any delay in the resolution of the Intel IPR. Joinder is therefore appropriate because it will promote the efficient and consistent resolution of the same patentability issues of the same patent. It will not delay any schedule in the Intel IPR trial schedule, and the parties in the Intel IPR will not be prejudiced.

II. STATEMENT OF MATERIAL FACTS

1. Greenthread LLC (“Patent Owner”) purportedly owns the ’222 Patent.

2. The following litigation or *inter partes* reviews related to the ’222 Patent are pending:

- *Greenthread, LLC v. Intel Corporation, Dell Inc., and Dell Technologies Inc.*, Civil Action No. 6:22-cv-105 in the Western District of Texas (“District Court Case”), filed January 27, 2022;
- *Intel Corporation v. Greenthread LLC*, IPR2023-00420, filed December 28, 2022;
- *Sony Group Corporation v. Greenthread, LLC*, IPR2023-00324, filed December 12, 2022;
- *Greenthread, LLC v. Intel Corporation*, Civil Action No. 3-22-cv-02001 in the District of Oregon, filed December 29, 2022;
- *Greenthread, LLC v. Intel Corporation*, Civil Action No. 6-22-cv-01293 in the Western District of Texas, filed December 21, 2022.

3. On December 28, 2022, Intel Corporation filed a petition challenging claims 1-9, 13-18, 20-28, 32-36, and 38-42 of the ’222 Patent in *Intel Corporation v. Greenthread LLC*, IPR2023-00420.

4. Along with this Motion for Joinder, Petitioners here have simultaneously filed a Petition for *inter partes* review, which argues, *inter alia*, that exactly the same claims of the '222 Patent are obvious over exactly the same grounds and reasons set out in the Intel IPR. The Petition is also supported by the expert declaration of Travis Blalock, the same expert who submitted an identical declaration in support of the Intel IPR.

5. The grounds proposed in the present Petition are therefore the same grounds of unpatentability. The Petition does not contain any additional arguments or evidence in support of the invalidity of claims 1-9, 13-18, 20-28, 32-36, and 38-42 of the '222 Patent.

6. The '222 Patent was asserted against both the petitioner in the Intel IPR and Petitioners here in *Greenthread, LLC v. Intel Corp. et al*, Case No. 6:22-cv-00105 (WDTX).

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Joinder is Timely.

The motion for joinder is timely because it is submitted within one month after the institution date of the Intel IPR. *See* 37 C.F.R. § 42.122(b). In fact, this motion is submitted prior to the institution date of the Intel IPR. *See Central Security Group – Nationwide, Inc. v. Ubiquitous Connectivity, LP*, IPR2019-01609, Paper 11 at 8–

9 (PTAB Feb. 26, 2020); citing *Dell Inc. v. Neodron Ltd.*, IPR2020- 00731, Paper 9 at 5 (PTAB July 31, 2020).

B. Joinder is Appropriate.

The Board has discretion to, and should, join this IPR with the Intel IPR. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b).

1. Legal Standard

In considering a motion for joinder, the Board considers the following factors: (1) the reasons why joinder is appropriate; (2) new grounds of unpatentability asserted in the petition; (3) the impact (if any) joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See Dell Inc. v Network-1 Security Solutions, Inc.*, IPR2013-00385, Paper No. 17 at 4 (PTAB July 29, 2013). All of these factors weigh in favor of joinder.

2. Joinder Is Appropriate Because Petitioner Proposes No New Grounds of Unpatentability.

Joinder is appropriate here because the Petition asserts the same grounds and relies on the same evidence for unpatentability presented in the Intel IPR. Specifically, the Petition relies on the same combinations of prior art references. Moreover, the same expert, Dr. Blalock, has submitted an identical supporting declaration in both IPRs. Thus, the arguments in both petitions are identical; there

are no new grounds of unpatentability asserted in this Petition. Accordingly, the Petition will not add any additional dimension to the substantive issues in the Intel IPR.

As the same issues will be at issue in both proceedings, joinder is the most efficient and economical manner to proceed. *See, e.g., Dell Inc. v. Alacritech, Inc.*, IPR2018-01307, Paper No. 8 (PTAB Jan. 11, 2019) (granting motion for joinder where the petition challenged the same claims on the same grounds.)

Finally, this is Petitioner’s first challenge of the ’222 Patent.¹ Accordingly, in the instant case there is no “potential for abuse of the review process by repeated attacks on patents.” *Apple Inc. v. Uniloc 2017, LLC*, IPR2020-00854, Paper 9 at 5

¹ While Dell was listed as an RPI in IPR2023-00324 filed by Petitioner Sony, Dell is not listed as a Petitioner in that IPR, Dell did not fund, review, or direct Sony’s IPR filing, and Sony’s IPR relies on different prior art and different grounds. Moreover, the Intel IPR that Dell is seeking to join and the Sony IPR were filed within a month of one another eliminating the possibility of using the Sony IPR as a roadmap. Given the lack of coordination related to the IPRs and the proximity in filing dates, the *General Plastic* factors weigh against exercising discretion to deny institution.

(PTAB Oct. 28, 2020) (precedential) (quoting *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16–17 (PTAB Sept. 6, 2017) (precedential)). Instead, allowing joinder would enable an efficient and appropriate use of the review process.

3. Joinder Will Not Impact Any Trial Schedule.

The Petition does not include any new grounds of unpatentability. As such, joinder will not introduce any new prior art, experts, or grounds for unpatentability into the Intel IPR. A schedule has not yet been set for the Intel IPR, but Petitioners consent to the schedule in the Intel IPR if instituted and will not request any alterations to any schedule that may issue in the Intel IPR based on the requested joinder. Further, Petitioners agrees to take an “understudy” role in the joined proceeding, so long as Intel remains an active party in the joined proceeding. Accordingly, joinder will not impact any schedule that may issue or otherwise prejudice the Patent Owner.

4. Joinder Would Simplify Briefing and Discovery.

As the prior art and bases for unpatentability in the petitions in both this IPR and the Intel IPR are the same, the same arguments will be made in both proceedings. Both Petitioners and the Intel IPR petitioner rely on the same expert to support identical arguments.

Petitioners and the Intel IPR petitioner have also agreed that Petitioners will maintain an “understudy” role in the proceeding, if joined. *See, e.g., Apple Inc. v. INVT SPE LLC*, IPR2019-00958, Paper 9 at 5–8 (PTAB May 30, 2019) (granting IPR where petitioners requested an “understudy” role). Petitioners will assume a primary role only if the Intel IPR petitioner cease to participate in the IPR.

This agreement removes any potential “complication or delay” caused by joinder, while providing the parties an opportunity to address all issues that may arise and avoiding any undue burden on Patent Owner, the Intel IPR petitioner, and the Board. *See, e.g., Motorola Mobility LLC v. SoftView LLC*, IPR2013-00256, Paper 10 at 8–10 (PTAB June 20, 2013). Therefore, briefing and discovery would be significantly simplified if joinder were granted.

IV. CONCLUSION

For the foregoing reasons, Petitioners Dell Technologies Inc. and Dell Inc. respectfully request that the Board institute its Petition for *Inter Partes* Review of U.S. Patent No. 11,121,222 and join this proceeding with *Intel Corp. v. Greenthread LLC*, IPR2023-00420.

Dated: January 27, 2023

Respectfully submitted,

By: /Christopher TL Douglas/

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CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §42.6(e) and §42.105 that on January 27, 2023, a true and correct copy of the **Motion for Joinder and Petition for *Inter Partes* Review of U.S. Patent No. 11,121,222** challenging claims 1-9, 13-18, 20-28, 32-36, and 38-42 was served via express mail on the Patent Owner at the following correspondence address of record as listed on the USPTO Patent Center:

Munck Wilson Mandala LLP
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Dallas, TX 752380

A courtesy copy was also served via electronic mail on Patent Owner's counsel of record in the Western District of Texas litigation:

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January 27, 2023
Date

By /Christopher TL Douglas/
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