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Paper No. 8
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAVIUM, INC.,
Petitioner,

v.

ALACRITECH, INC.,
Patent Owner.

Case IPR2017-01714
Patent 9,055,104 B2

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

FISHMAN, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review and
Granting Petitioner's Motion for Joinder
35 U.S.C. §§ 314(a), 315(c); 37 C.F.R. §§ 42.108, 42.122

I. INTRODUCTION

Cavium, Inc. ("Cavium" or "Petitioner"), filed a Petition (Paper 1, "Pet.") for *inter partes* review of claims 1, 6, 9, 12, 15, and 22 of U.S. Patent No. 9,055,104 B2 ("the '104 Patent") (Ex. 1001) pursuant to 35 U.S.C. §§ 311–319. Within days of filing the Petition, Petitioner filed a Motion for Joinder. Paper 3 ("Joinder Motion" or "Mot."). The Joinder Motion seeks to join Petitioner as a party to *Intel Corp. v. Alacritech*, Case IPR2017-01393 ("the 1393 IPR"). Mot. 1. The Joinder Motion indicates Intel Corp. ("Intel"), Petitioner in the 1393 IPR, does not oppose Cavium's request to join that proceeding. *Id.* However, the Joinder Motion is silent regarding Patent Owner's position regarding the Joinder Motion.

Alacritech, Inc. ("Patent Owner") did not file an Opposition to the Joinder Motion. Patent Owner filed a Preliminary Response that is silent regarding the Joinder Motion. Paper 7 ("Prelim. Resp.").

As explained further below, we institute trial in this *inter partes* review on the same grounds as instituted in IPR2017-01393, and we grant Petitioner's Motion for Joinder.

II. DISCUSSION

A. Institution of Trial

In IPR2017-01393, Petitioner Intel challenges the patentability of claims 1, 6, 9, 12, 15, and 22 of the '104 Patent on the following grounds:

Reference(s)	**Basis**	**Claims challenged**
Connery[1]	§ 103	1, 6, 9, 12, 15, and 22
Connery and Boucher[2]	§ 103	1, 6, 9, 12, and 15

[1] U.S. Patent No. 5,937,169 ("Connery," Ex. 1043).
[2] PCT Patent Publication No. WO 00/13091 ("Boucher," Ex. 1049).

IPR2017-01393, Paper 2, 15–16.

After considering the Petition and the Patent Owner's Preliminary Response in IPR2017-01393, we instituted trial for claims 1, 6, 9, 12, and 15 based on both of the above-identified grounds of unpatentability and denied review of claim 22. *See* IPR2017-01393, Paper 8, 2, 21. Petitioner here (Cavium) represents that this Petition is substantively identical to the Petition in IPR2017-01393 and challenges the same claims based on the same grounds. Mot. 1. We have considered the relevant Petitions and we agree with Petitioner's representation that this Petition is substantially identical to the Petition in IPR2017-01393. *Compare* Pet. *with* IPR2017-01393, Paper 2.

Patent Owner's Preliminary Response does not point out any differences from its Preliminary Response in the 1393 IPR. However, after reviewing Patent Owner's Preliminary Response here and in the 1393 IPR, we find the two responses to be substantially identical, with one exception. We note that, here, Patent Owner argues that QLogic, Inc. ("QLogic") should have been named as a real party-in-interest because QLogic, a wholly owned subsidiary of Cavium, is a supplier to, and indemnitor of, Dell (the defendant in related infringement litigation), and Cavium's only interest in the '104 patent is that of its subsidiary QLogic. *See* Prelim. Resp. 23–31. In the 1393 IPR, Patent Owner presented a similar argument in its Preliminary Response that Petitioner Intel should have named Cavium and Dell as real parties-in-interest because of the alleged supplier-indemnitor relationship between Intel and Dell and Cavium and Dell. IPR2017-01393, Paper 7. Here, Patent Owner argues the parent/subsidiary relationship between Petitioner and QLogic and the supplier/indemnitor relationship between

QLogic and Dell require that QLogic be named as a real party-in-interest. *See* Prelim. Resp. 23–31.

We have reviewed Patent Owner's arguments. On the record before us and for purposes of this Decision, and for the similar reasons as in the 1393 IPR, we determine there is insufficient evidence that QLogic controlled, or had the opportunity to control, this Petition and, thus, is not a real party-in-interest. *See* Case IPR2017-01393, Paper 8, 16–20. Moreover, as in the 1393 IPR, there is no allegation that naming additional real parties-in-interest such as QLogic or Dell would bar Petitioner in the instant proceeding. *See id.* at 19. Accordingly, the issue Patent Owner raises is not jurisdictional. *See Lumentum Holdings, Inc. v. Capella Photonics, Inc.*, Case IPR2015-00739, slip op. at 6 (PTAB March 4, 2016) (Paper 38) (precedential).

Accordingly, for essentially the same reasons stated in our Decision to Institute in IPR2017-01393, 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, 6, 9, 12, and 15 on the same grounds as in IPR2017-01393.

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.*

Without opposition to the Joinder Motion from any party, we grant Petitioner's Motion for Joinder with the 1393 IPR, subject to the condition that:

> Petitioner here (i.e., Cavium, Inc.) will be bound by all substantive and procedural filings and representations of current Petitioner in IPR2017-01393 (i.e., Intel Corp.), without a separate opportunity to be heard, whether orally or in writing, unless and until the proceeding is terminated with respect to Intel Corp..

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 Cavium is joined as a party to the 1393 IPR.

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 of the '104 Patent as follows: (1) claims 1, 6, 9, 12, and 15 as obvious under 35 U.S.C. § 103(a) over Connery and (2) claims 1, 6, 9, 12, and 15 as obvious under 35 U.S.C. § 103(a) over Connery and Boucher;

FURTHER ORDERED that Petitioner's Motion for Joinder with IPR2017-01393 is *granted*, and Cavium, Inc. is joined as a petitioner in IPR2017-01393;

FURTHER ORDERED that the grounds on which an *inter partes* review was instituted in Case IPR2017-01393 remain unchanged, and no other grounds are instituted in the joined proceedings;

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