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Paper No. 8
Entered: December 8, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAVIUM, INC.,
Petitioner,

v.

ALACRITECH, INC.,
Patent Owner.

Case IPR2017-01728
Patent 7,337,241 B2

Before STEPHEN C. SIU, DANIEL N. FISHMAN, and WILLIAM M. FINK, *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), 37 C.F.R. §§ 42.108, 42.122

I. INTRODUCTION

Cavium, Inc. ("Petitioner"), filed a Petition (Paper 1, "Pet.") for *inter partes* review of claims 1–24 of U.S. Patent No. 7,337,241 B2 ("the '241 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 this proceeding with *Intel Corp. v. Alacritech*, Case IPR2017-01392 ("the 1392 IPR"). Mot. 1. The Joinder Motion indicates Intel Corp., Petitioner in the 1392 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 IPR2017-01392 and we grant Petitioner's Motion for Joinder.

II. DISCUSSION

A. Institution of Trial

In IPR2017-01392, Petitioner Intel challenges the patentability of claims 1–24 of the '241 Patent on the following grounds:

Reference(s)	Basis	Claims challenged
Erickson,[1] Tanenbaum,[2] and Alteon[3]	§ 103	1–8, 18, 22, and 23
Erickson and Tanenbaum	§ 103	9–17, 19–21, and 24

IPR2017-01392, Paper 4, 14–15.

After considering the Petition and the Patent Owner's Preliminary Response in IPR2017-01392, we instituted trial for the above-identified grounds of unpatentability. *See* IPR2017-01392, Paper 11, 26. Petitioner here (Cavium) represents that this Petition is substantively identical to the Petition in IPR2017-01392 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 IPR2017-01392. *Compare* Pet. *with* IPR2017-01392, Paper 2.

Patent Owner's Preliminary Response does not point out any differences from its Preliminary Response in the 1392 IPR. However, after reviewing Patent Owner's Preliminary Response here and in the 1392 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 Petitioner (Cavium, Inc.) is a supplier to, and indemnitor of, Dell (the defendant in related infringement litigation) and

[1] U.S. Patent No. 5,768,618. ("Erickson," Ex. 1005).
[2] Andrew S. Tanenbaum, *Computer Networks*, Third Edition, 1996 ("Tanenbaum96," Ex. 1006).
[3] Alteon Networks Inc., *Gigabit Ethernet Technical Brief: Achieving End-to-End Performance*, 1996. ("Alteon," Ex. 1033).

Cavium's only interest in the '241 patent is that of its subsidiary QLogic. Prelim. Resp. 29–32. In the 1392 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. IPR2017-01392 Paper 2. Here, Patent Owner argues the parent child relationship between Petitioner and QLogic and the supplier/indemnitor relationship between QLogic and Dell requires that QLogic be named as a real party-in-interest. Prelim. Resp. 28–37.

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 1392 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 IPR2017-01392, Paper 11, 21–25. Moreover, 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). As in the 1392 IPR, Patent Owner does not allege that naming additional real parties-in-interest such as QLogic or Dell would bar Petitioner in the instant proceeding. *See* Case IPR2017-01392, Paper 11, 23–24.

Accordingly, for essentially the same reasons stated in our Decision to Institute in IPR2017-01392, 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 1–24 on the same grounds as in IPR2017-01392.

B. Motion for Joinder

Based on authority delegated to us by the Director, we have discretion to join an *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 1392 IPR subject to the condition that:

> In the joined proceeding, Petitioner here (i.e., Cavium, Inc.) will be bound by all substantive and procedural filings and representations of current Petitioner in IPR2017-01392 (i.e., 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 IPR2017-01392.

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 of the '241 Patent as follows: (1) claims 1–8, 18, 22, and 23 as obvious under 35 U.S.C. § 103(a) over Erickson,

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