

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ARM LTD. AND ARM, INC.,

v.

ADVANCED MICRO DEVICES, INC. AND ATI TECHNOLOGIES ULC,  
Patent Owner.

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Case IPR2018-01148  
Patent 7,633,506 B1

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JONI Y. CHANG, BRIAN J. McNAMARA, and  
PAUL J. KORNICZKY, *Administrative Patent Judges.*

McNAMARA, *Administrative Patent Judge.*

DECISION TO INSTITUTE  
AND GRANT OF MOTION FOR JOINDER  
*35 U.S.C. § 314(a), 37 C.F.R. § 42.122(b)*

*Introduction*

On April 27, 2018, we instituted *inter partes* review of claims 1–9 of U.S. Patent No. 7,633,506 B1 in *MediaTek v. Advanced Micro Devices*, Case IPR2018-00101 (PTAB April 27, 2018) (Paper 13) (“the MediaTek IPR”). On May 25, 2018, ARM Ltd. and ARM Inc. (collectively, “ARM”) filed the instant Petition for *inter partes* review of the same claims of the ’506 patent (“the ARM Petition”). Paper 2. With the instant Petition, ARM filed a timely Motion for Joinder with the MediaTek IPR. Paper 3. MediaTek has not opposed ARM’s Motion for Joinder. Advanced Micro Devices, Inc., and ATI Technologies ULC (“Patent Owner”) filed an Opposition to ARM’s Motion for Joinder (Paper 7, “Opp. To Mot. For Joinder”) and ARM filed a Reply (Paper 8, “Reply to Opp.”). Patent Owner also filed a corrected Preliminary Response to the instant Petition. Paper 11 (“Prelim. Resp.”).

*Institution of Inter Partes Review*

*Reasonable Likelihood of Success*

The substance of Patent Owner’s Corrected Preliminary Response in this proceeding corresponds closely to the substance of the Patent Owner Response in the MediaTek IPR. *See* MediaTek IPR, Paper 16. In the MediaTek IPR, we instituted trial on all challenged claims and all asserted grounds, as identified below:

Claim(s)	Statutory Basis	Challenge
1–3 and 5–9	35 U.S.C. § 103(a)	Obvious over Akeley <sup>1</sup> in view of Rich

<sup>1</sup> Reality Engine Graphics, Ex. 1004

4	35 U.S.C. § 103(a)	Obvious over Akeley in view of Rich <sup>2</sup> in further view of Greene <sup>3</sup>
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ARM asserts that “[t]he present Petition is largely a verbatim copy of the Petition in IPR2018-00101 with limited changes.” Mot. For Joinder 1–2. ARM notes the differences between the petition in the MediaTek IPR and ARM’s Petition concern the explanations of the real party-in-interest. *Id.* at 3. ARM also states that it has attached as Exhibit 1008 a copy of the public version of the Initial Determination in the related ITC investigation issued after the petition in the MediaTek IPR was filed. *Id.* ARM further states that it has adopted the construction of “unified shader” we applied in the MediaTek IPR and that it agrees with the other constructions proposed by MediaTek. *Id.*

The above differences in ARM’s Petition and the MediaTek petition are not substantial. Having determined that a reasonable likelihood of success exists on the grounds asserted in the MediaTek IPR, we find for the same reasons that there is a reasonable likelihood ARM will succeed in the same challenges to the same claims on the same grounds in this *inter partes* review.

*Issues Under 35 U.S.C. § 315(b)*

Patent Owner contends that ARM’s Petition is barred because ARM failed to name as real parties-in-interest or privies at least MediaTek, LG Electronics, Inc. (“MediaTek”), LG Electronics MobileComm USA, Inc. (“LG”), and Sigma Designs, Inc. (“Sigma Designs”), Prelim. Resp. 62, 67 (citing 35 U.S.C. § 312(a)(2) and 37 C.F.R. § 42.8(b)(1)). According to

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<sup>2</sup> U.S. Patent No. 5,808,690, Ex. 1005

<sup>3</sup> U.S. Patent No. 6,646,639, Ex. 1006

Patent Owner, discovery<sup>4</sup> will show that ARM is a privy with (1) MediaTek, who was served with an ITC Investigation action more than one year before the filing date of the present Petition, and (2) LG and Sigma Designs, who each were served with a complaint for infringement of the '506 patent in the U.S. District Court for the District of Delaware more than one year before the filing date of the Petition. *Id.* at 63. Citing a publicly available license agreement between ARM and GCT Semiconductor, which is not a party to any of these actions, Patent Owner contends that ARM likely entered into similar license agreements with MediaTek, LG, and Sigma Designs, and that these agreements include indemnification provisions allowing ARM, upon notice, to control litigation and settle lawsuits. *Id.* at 64. Patent Owner contends that, as a result of such agreements, MediaTek, LG, and Sigma Designs are real parties-in-interest with ARM and, therefore, ARM's Petition is subject to the one-year statutory bar imposed by 35 U.S.C. § 315(b). *Id.* at 67–68.

ARM's Petition is accompanied by a Motion for Joinder, as discussed further below. The provisions of 35 U.S.C. § 315(b) do not apply to a request for joinder. 35 U.S.C. § 315(c). Thus, ARM's Petition is not barred under 35 U.S.C. § 315(b).

Patent Owner also contends that there is no valid proceeding for ARM to join because the MediaTek IPR is barred under 35 U.S.C. § 315(b) as a result of the ITC action. Prelim. Resp. 62. *See*, MediaTek IPR, Patent

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<sup>4</sup> Patent Owner notes that prior to receiving Patent Owner's Preliminary Response, we authorized Patent Owner to file a Motion for Additional Discovery from MediaTek in IPR2018-00101 and a Motion for Discovery from ARM in this proceeding. Concurrently with this Decision, we enter decisions denying Patent Owner's discovery motions.

Owner's Motion for Discovery (Paper 23) 5, n.6, Petitioner's Opposition to Patent Owner's Motion for Discovery (Paper 24), 12. We are not persuaded by this argument because an administrative complaint, such as an ITC action, does not constitute a complaint under 35 U.S.C. § 315(b), *LG Elecs., Inc. v. Straight Path IP Group, Inc.*, Case IPR2015-00196, 2015 WL 2395601, at \*5 (PTAB May 15, 2015), and an ITC decision has no collateral estoppel or res judicata effect. See *Bio-Tech. Gen. Corp. v. Genentech, Inc.*, 80 F.3d 1553, 1564 (Fed. Cir. 1996). The Board has generally declined to apply § 315(b) to ITC complaints; *Robert Bosch Tool Corp. v. SD3, LLC*, IPR2016-01753 Paper 15 at 11-12 (PTAB Mar. 22, 2017) ("We decline to interpret §315(b) as including ITC complaints"). Accord, *Amkor Tech., Inc. v. Tessera, Inc.*, IPR2013-00242, Paper 98 at 6-19 (PTAB Jan. 31, 2014) (holding that §315(b) is only triggered by civil actions); *Brinkmann Corp. v. A & J Mfg., LLC*, IPR2015-00056, Paper 10 at 7-8 (PTAB Mar. 23, 2015) (§315(b) applies to "a complaint in a civil action for patent infringement" and does not apply to an ITC Complaint); *LG Elecs., Inc. v. Straight Path IP Group, Inc.*, IPR2015-00196, Paper 20 at 7-9 (PTAB May 15, 2015) (same).

*Issues Under 35 U.S.C. § 312(a)*

We now turn to Patent Owner's argument that the Petition is not entitled to a filing date and must be dismissed because, as a result of failing to name all real parties-in-interest, it fails to comply with 35 U.S.C. § 312(a). Prelim. Resp. 68. Patent Owner incorrectly conflates § 312(a)(2) with § 315(b) by applying § 312(a)(2) as part of the timeliness inquiry under § 315(b). *Id.* at 67-68 (arguing that correction of the real parties-in-interest, if necessary, would require assigning a new filing date that itself would

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