

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL INC.,
Petitioner,

v.

ALACRITECH, INC.,
Patent Owner.

Case IPR2018-00374
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

Dell Inc. (“Dell” or “Petitioner”), filed a Petition (Paper 2, “Pet.”) for *inter partes* review of claims 1, 6, 9, 12, and 15 of U.S. Patent No. 9,055,104 B2 (“the ’104 Patent”) (Ex. 1001) pursuant to 35 U.S.C. §§ 311–319. On the same day as filing the Petition, Dell filed a Motion for Joinder. Paper 3 (“Joinder Motion” or “Mot.”). The Joinder Motion seeks to join Dell as a party to *Intel Corp. v. Alacritech*, Case IPR2017-01393 (“the 1393 IPR”). Mot. 1. Another Petitioner, Cavium Inc. (“Cavium”), also filed a petition for *inter partes* review of the ’104 Patent and moved for joinder to the 1393 IPR (Case No. IPR2017-01714 (“the 1714 IPR”)). We instituted the 1714 IPR and joined Cavium as a party to the 1393 IPR. *See* IPR2017-01714 Paper 8.

The Joinder Motion indicates Intel Corp. (“Intel”) and Cavium, Petitioner in the 1393 IPR, do not oppose Dell’s motion to join the 1393 IPR. Mot. 1–2. The Joinder Motion is silent regarding Patent Owner’s position regarding the Joinder Motion. Alacritech, Inc. (“Patent Owner”) filed a Preliminary Response that was silent regarding specific reference to Dell’s Joinder Motion. Paper 8 (“Prelim. Resp.”).

As explained further below, we institute trial in this *inter partes* review on the same grounds as instituted in IPR2017-01393 and in IPR2017-1714, and we grant Petitioner’s Motion for Joinder.

II. DISCUSSION

A. *Institution of Trial*

In the 1393 IPR, Intel challenged 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

IPR2017-01393, 18-19.

After considering Intel’s Petition and the Patent Owner’s Preliminary Response in the 1393 IPR, we instituted trial for claims 1, 6, 9, 12, 15, and 22 based on both of the above-identified grounds of unpatentability and denied review of claim 22.³ Correspondingly, we instituted trial for the same grounds and claims in the 1714 IPR.

Petitioner here (Dell) represents that this Petition is substantively identical to Intel’s 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 Petitions in IPR2017-01393 and in IPR2017-01714. *Compare* Pet. with IPR2017-01393 Paper 2 and IPR2017-01714 Paper 1.

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

¹ U.S. Patent No. 5,937,169 (“Connery,” Ex. 1043).

² PCT Patent Publication No. WO 00/13091 (“Boucher,” Ex. 1049).

³ We instituted only claims 1, 6, 9, 12, and 15 on both grounds in our original Decision on Institution. IPR2017-01393 Paper 1, 9. In a later Order, we added claim 22 as a newly instituted claim to be reviewed. IPR2017-01393 Paper 38. We accept Dell’s Petition as seeking joinder as a party for all claims and grounds instituted in the 1393 IPR, including claim 22.

(Paper 7), we find the two responses to be substantially identical, with only one notable exception. We note that Patent Owner argues that Intel Corporation (“Intel”), for a variety of reasons, should have been named as a real party-in-interest in this Petition fundamentally because Intel is a supplier to, and indemnitor of, Dell (a defendant in related infringement litigation). Prelim. Resp. 23–30. In the 1393 IPR, Patent Owner presented a similar argument in its Preliminary Response that Intel should have named Cavium and Dell as real parties-in-interest because of the alleged supplier-indemnitor relationships between Intel and Dell and between Cavium and Dell. IPR2017-01393, Paper 7, 23–33.

We have reviewed Patent Owner’s arguments. On the record before us, for purposes of this Decision, and for similar reasons as in the 1393 IPR and in the 1714 IPR, we determine there is insufficient evidence that Intel 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 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, 15, and 22 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.*

We grant Petitioner’s Motion for Joinder with the 1393 IPR, subject to the condition that:

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

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 Dell 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, 15, and 22 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;

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.