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Paper No. 13
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

VLSI TECHNOLOGY LLC,
Patent Owner.

IPR2022-00479
Patent 7,523,373 B2

Before THOMAS L. GIANNETTI, BRIAN J. MCNAMARA, and JASON W. MELVIN, *Administrative Patent Judges*.

MELVIN, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

Intel Corporation ("Petitioner" or "Intel") filed a Petition (Paper 3, "Pet.") requesting institution of *inter partes* review of claims 1–13, 15, and 16 ("the challenged claims") of U.S. Patent No. 7,523,373 B2 (Ex. 1001, "the '373 patent"). Petitioner also filed a Motion for Joinder with *Patent Quality Assurance, LLC v. VLSI Tech. LLC*, IPR2021-01229 ("PQA IPR"). Paper 4 ("Mot."). VLSI Technology LLC ("Patent Owner") filed a Preliminary Response. Paper 12 ("Prelim. Resp."). Patent Owner also filed an Opposition to the Motion for Joinder. Paper 8 ("Opp."). Petitioner filed a Reply to Patent Owner's Opposition. Paper 10 ("Reply").

An *inter partes* review may not be instituted unless "the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a). For the reasons set forth below, we conclude that Petitioner has shown a reasonable likelihood it will prevail in establishing the unpatentability of at least one challenged claim, and we institute *inter partes* review.

We also have authority to consider Petitioner's joinder motion under 35 U.S.C. § 315(c), which provides that "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 that the Director . . . determines warrants the institution of an inter partes review under section 314."

For the reasons that follow, we (1) grant the Petition and institute *inter partes* review of the '373 patent; and (2) grant Petitioner's Motion for Joinder.

A. Related Matters

The parties both identify the following matters related to the '373 patent: *VLSI Technology LLC v. Intel Corporation*, No. 6:19-cv-00254 (W.D. Tex.) consolidated with other cases as 1:19-cv-00977 (W.D. Tex.) and later deconsolidated as 6:21-cv-00057, Dkt. 1 (W.D. Tex. Apr. 11, 2019) (trial concluded with jury verdict); *Intel Corp. v. VLSI Tech. LLC*, IPR2020-00158 (PTAB May 20, 2020) (institution denied), *cert. denied* 142 S. Ct. 1363 (2022) (No. 21-888); *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01056 (PTAB) (institution denied); *Pat. Quality Assurance, LLC v. VLSI Tech. LLC*, IPR2021-01229 (PTAB) ("PQA IPR") (trial instituted). Pet. 1; Paper 6. Patent Owner also identifies *VLSI Tech. LLC v. Intel Corp.*, No. 6:21-cv-00299 (W.D. Tex.) as a matter related to the '373 patent.

B. Asserted Grounds

Petitioner asserts the following grounds of unpatentability:

Claim(s) Challenged	35 U.S.C. §	References/Basis
1–7, 9–11, 13, 15–16	103	Harris,[1] Abadeer,[2] Zhang[3]
2, 11–12	103	Harris, Abadeer, Zhang, Cornwell[4]
8	103	Harris, Abadeer, Zhang, Bilak[5]

Pet. 4. Petitioner relies also on the Declarations of Dr. Adit Singh and Dr. Sylvia Hall-Ellis. Exs. 1002, 1027.

[1] US 5,867,719, issued Feb. 2, 1999 (Ex. 1003).
[2] US 2006/0259840 A1, published Nov. 16, 2006 (Ex. 1004).
[3] US 2003/0122429 A1, published July 3, 2003 (Ex. 1005).
[4] US 7,702,935 B2, issued Apr. 20, 2010 (Ex. 1006).
[5] US 2005/0188230 A1, published Aug. 25, 2005 (Ex. 1007).

C. Real Parties in Interest

Petitioner identifies only itself as the real party in interest. Pet. 1. Patent Owner identifies VLSI Technology LLC and CF VLSI Holdings LLC as real parties in interest. Paper 6.

II. DISCUSSION

In deciding whether to join a party to an *inter partes* review, § 315(c) requires "two different decisions," first "whether the joinder applicant's petition for IPR 'warrants' institution under § 314," and then whether to "exercise . . . discretion to decide whether to 'join as a party' the joinder applicant." *See Facebook, Inc. v. Windy City Innov., LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). "The statute makes clear that the joinder decision is made *after* a determination that a petition warrants institution, thereby affecting the manner in which an IPR will proceed." *Id.* (citing *Thryv v. Click-to-Call Techs., LP*, 140 S. Ct. 1367, 1377 (2020)).

A. Whether the Petition Warrants Institution

The Petition in this proceeding asserts substantially the same grounds of unpatentability as those upon which we instituted review in the PQA IPR. *Compare* Pet. 4, 24–73 (showing that both this Petition and Intel's original petition challenge claims 1–13, 15, and 16), *with* PQA IPR 13–24 (showing that the PQA IPR challenges claims 1–16). Indeed, Petitioner contends "that both petitions present substantively the same patentability challenges." Mot. 1. We agree that the Petition here asserts challenges and evidence nearly identical to those asserted in the PQA IPR.

Having already considered the merits of those challenges and evidence in the PQA IPR and having determined that the threshold for

institution of *inter partes* review has been met, we determine that the Petition here also presents a reasonable likelihood of prevailing on the challenges of at least one claim of the '373 patent. *See Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (Oct. 28, 2020) (precedential).

We conclude that the merits of the Petition warrant institution.

B. DISCRETIONARY DENIAL

Notwithstanding the merits of the Petition, Patent Owner argues that we should exercise our discretion to deny institution under 35 U.S.C. § 314(a) and, accordingly, also deny joinder. Prelim. Resp. 7–25; Opp. 6–15. Patent Owner's argument relies on the *Fintiv* and *General Plastic* factors. Opp. 6–11 (citing *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv*"); *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i) ("*General Plastic*")). Patent Owner also relies on 35 U.S.C. § 325(d), and specifically, on the Federal Circuit's application of § 325(d) in *In re Vivint, Inc.*, 14 F.4th 1342 (Fed. Cir. 2021). Prelim. Resp. 29–32.

Before determining whether to join Intel as a party to the PQA IPR, even though the Petition is a "me-too petition," we first determine whether the record warrants the exercise of our discretion to deny the Petition under § 314(a) or § 325(d).[6]

[6] Many of Patent Owner's arguments in the Preliminary Response do not distinguish between the issues of whether the Petition warrants institution and whether, if so, we should grant joinder. We therefore address those arguments here, and, below, separately address arguments directed solely at the joinder decision.

1. District-court litigation (Fintiv)

Patent Owner argues that we should deny institution under *Fintiv*. Prelim. Resp. 7–15. The argument is based on a prior litigation in which a jury determined that Intel infringed the '373 patent ("the Intel litigation"). Ex. 1031 (March 2, 2021, verdict).

Patent Owner addresses each of the six *Fintiv* factors for evaluating the effect of parallel litigation involving the challenged claims on discretionary denial. *See* Prelim. Resp. 7–15; *Fintiv*, Paper 11 at 5–6. Petitioner submits that the factors have limited applicability here because invalidity was not determined by the verdict in the Intel litigation. Prelim. Reply 3.

Fintiv factor 1 asks if there is a possibility of a stay in the parallel litigation. Because the Intel litigation is complete, there is no possibility of a stay. *See* Prelim. Resp. 8–9. Similarly, Intel was the defendant in the district court litigation, which has a known outcome and investment. *Id.* at 8–12 (discussing *Fintiv* factors 1, 2, 3, and 5). On the other hand, invalidity was not presented to the jury. *See id.* at 11–12; Pet. 5. There would be no overlap, therefore, between this proceeding and the issues that were tried in the Intel litigation. *See* Pet. 5; Mot. 12; Prelim. Resp. 11–12 (discussing *Fintiv* factor 4).

Here, the Intel litigation did not resolve issues related to invalidity, and thus did not resolve any issues presented by this proceeding, so there is no chance of an inconsistent outcome. Indeed, "redoing the work of another tribunal" (*Fintiv*, Paper 11 at 14) would only arise when that tribunal has resolved a dispute at issue before the Board. Patent Owner has not argued that resolving a dispute in this proceeding would conflict with any aspect of

the Intel litigation. Thus, we do not agree with Patent Owner that, because the litigation parties and the District Court invested "enormous effort," instituting review here would mean redoing the work of another tribunal. Opp. 10–11.

Patent Owner presents policy arguments in support of its position. *See* Prelim. Resp. 12–15 (discussing *Fintiv* factor 6). Patent Owner argues that instituting review here would lead to harassment of patent owners who prevail at trial, and that such an outcome fundamentally conflicts with Board precedent and policy. Prelim. Resp. 13–15. On the record before us, we do not agree that prevailing on infringement grounds in an earlier litigation insulates Patent Owner from further patentability challenges that were not resolved in the litigation.

Considering all of the *Fintiv* factors, we are persuaded that we should not exercise our discretion to deny institution in light of the Intel litigation.

2. Prior petitions (General Plastic)

On April 11, 2019, Intel was served with a complaint alleging infringement of the '373 patent. Ex. 2037. In IPR2020-00158, Intel challenged the '373 patent by filing a petition for *inter partes* review with the Board, but the Board denied institution, by which point Intel was barred under 35 U.S.C. § 315(b)[7] from filing any further petitions against the '373 patent. *Intel Corp. v. VLSI Technology LLC*, IPR2020-00158, Paper 16 (PTAB May 20, 2020) (the "Intel IPR"). Importantly, however, the Board

[7] Section 315(b) of 35 U.S.C. establishes a one-year time limit for a party to file a petition for *inter partes* review of a patent after service on that party of a complaint charging infringement of the patent. This one-year time limitation does not apply to a request for joinder. *See* 35 U.S.C. § 315(b).

denied institution applying *Fintiv*, based on parallel district-court litigation, not on the merits of the petition. *See* IPR2020-00158, Paper 16 at 4–14; Opp. 1 (acknowledging that the Board rejected Intel's prior petition challenging the '373 patent under *Fintiv*, "in view of a then-upcoming district court trial").

Following a jury verdict against Intel on March 2, 2021, PQA filed its petition challenging the '373 patent on July 7, 2021. IPR2021-01229, Paper 1. The Board granted that petition and instituted the PQA IPR on January 26, 2022. IPR2021-01229, Paper 10. Intel filed this Petition and its Motion for Joinder the same day.

Patent Owner argues that we should exercise discretion to deny institution because the Petition presents the same challenges as the prior petition (IPR2020-00158) for which the Board denied review. Prelim. Resp. 15–25; Opp. 6–9. In that regard, Patent Owner relies on the framework from *General Plastic*, Paper 19 at 16.

> *Factor 1: whether the same petitioner previously filed a petition directed to the same claims of the same patent;*
> *Factor 2: whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it; and*
> *Factor 3: whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition*

Patent Owner argues that *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9, supports denial when considering the second petition filed by a party. Prelim. Resp. 16. In *Uniloc*, the Board had denied Apple's first petition "because the evidence and arguments presented failed to meet

substantively the reasonable likelihood threshold required for institution." *Id.*; *Uniloc*, Paper 9 at 6. Here, Petitioner's first petition was denied in light of a potential overlap with district-court litigation. IPR2020-00158, Paper 16 at 4–14. The Board did not consider the substantive merits. *Id.* Thus, this case presents a situation notably different from *Uniloc*. The same is true of *General Plastic*, where the petitions that were denied followed a first wave of petitions by the same petitioner that were denied on the merits. *General Plastic*, Paper 9 at 2–3.

Although Petitioner has directed this Petition to the same claims and relies on the same art as in its first petition, that the Board did not substantively address the merits of the prior Intel petition, in our view, weighs against discretionary denial here. The district-court trial that led to the denial of its initial petition is over and did not resolve the challenges presented here. Allowing Petitioner the opportunity to pursue a decision on the merits from the Board at this time—by joining PQA's substantially identical petition—best balances the desires to improve patent quality and patent-system efficiency against the potential for abuse of the review process by repeated attacks on patents. *See General Plastic*, Paper 19 at 16–17.

Patent Owner argues that we should follow *HTC Corp. v. Ancora Techs., Inc.*, IPR2021-00570, Paper 17 at 9–10 (PTAB June 10, 2021), in applying *Uniloc* to a joinder petition. Opp. 6. In *HTC*, the petitioner's prior CBM petition was denied without reaching its substantive merits. *HTC*, Paper 17 at 8–9. Significantly, however, in *HTC*, the Board relied on that petitioner's failure to explain a four-year delay after that denial before filing an IPR petition. *Id.* at 9. Thus, the decision in *HTC* turned largely on the petitioner's delay. *Id.* As discussed below, we determine that Intel

adequately explains the time elapsed before filing the present Petition. Thus, the reasoning in *HTC* does not weigh in favor of denial here.

In *HTC*, the Board additionally noted that the petitioner benefited from other petitioners' filings during that delay. *Id.* at 9–10. Patent Owner argues that because Petitioner reviewed both Patent Owner's preliminary responses and also the Board's institution decisions from the first petition and PQA's IPR, *General Plastic* factor 3 strongly supports discretionary denial. Prelim. Resp. 18–22; Opp. 7. With respect to factor 3, "we are concerned here by the shifts in the prior art asserted and the related arguments in follow-on petitions." *General Plastic*, Paper 19 at 17 (finding that the petitioner had found new prior art as a result of two searches conducted after the Board issued its Decisions Denying Institution); *HTC*, Paper 17 at 10 (finding that the petitioner should have known of prior art cited for the first time in its follow-on petition at the time of filing its first petition).

Although we agree with Patent Owner that the opportunity for "roadmapping" existed due to the time gap in filing the PQA petition, we do not agree that roadmapping affects our decision here.[8] The PQA IPR presents challenges that are nearly identical to Intel's initial petition, and Intel's current petition follows them in step. Patent Owner points out some changes to the language describing the operation of one reference, Harris, in the PQA petition, but those changes are minor and do not alter

[8] "Roadmapping" refers to the practice of taking advantage of an opponent's prior filings to obtain a "roadmap" of the opponent's case. While excessive roadmapping is undesirable, public disclosures of a party's litigation positions are unavoidable whenever a lawsuit or a petition is filed.

fundamentally the way in which the Harris reference is being asserted. *See* Prelim. Resp. 19–21 (citing Pet. 41). Patent Owner also points to changes in how the Petition addresses Harris's failure operation, along with incorporating Zhang's voltage regulators. *Id.* at 21 (citing Pet. 45–46). When instituting review in the PQA IPR, however, we explained that we did not rely on that aspect of Petitioner's contentions. Inst. 18–19. In other words, to the extent that the timing of PQA's petition allowed access to Intel's initial petition and Patent Owner's preliminary response, it did not affect our decision to institute. And Intel's Petition makes no changes from the instituted PQA petition. Thus, the roadmapping concerns addressed in *General Plastic* and *HTC* are not present here.

In addition, we view substantive consideration of the merits of a petition as an important factor in maintaining the balance between improving patent quality and the potential for abuse. To determine otherwise would prioritize insulating patent owners from potential abuse without also addressing the public benefit to improving patent quality.

We conclude that factors 1–3 weigh against discretionary denial.

Factor 4: the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition; and
Factor 5: whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent

As noted in *General Plastic*, the Board considers factors 4 and 5 "to assess and weigh whether a petitioner should have or could have raised the new challenges earlier." *General Plastic*, Paper 19 at 18. Applied to the present facts, however, those factors have limited relevance. The PQA IPR,

to which Petitioner Intel seeks joinder, raises the same prior art asserted in Intel's initial petition.[9] Thus, there are no "new challenges" at issue here.

Although the Petition raises no new challenges, this proceeding arises substantially after Intel's initial IPR petition. Unlike the delay that the Board found important in *HTC*, however, the timing here is not due to Petitioner's delay. *See HTC*, IPR2021-00570, Paper 17 at 9. Because Intel was time-barred under § 315(b), Intel did not have an opportunity to file an IPR petition after its initial petition was denied. Indeed, that opportunity did not arise for Intel until we instituted review in the PQA IPR. Petitioner argues that it was reasonable for it to file its Petition and Motion for Joinder after the Board instituted the PQA IPR because Petitioner was otherwise time barred. Mot. 8–9. That justification is consistent with the statute, which expressly provides an exception to the time bar for a request for joinder. 35 U.S.C. § 315(b).

Because the delay between Intel's initial petition and the present one resulted from our earlier refusal to consider the merits of Intel's challenge, along with the pendency of the district-court trial, we do not weigh that delay against Intel. We determine that Intel has adequately explained the time between its initial petition and the present joinder request.

Patent Owner argues that because Intel had the opportunity to present invalidity to a jury, but chose not to, it would receive an unfair benefit from participating in this proceeding. Prelim. Resp. 17–18; Opp. 8–9. We are not persuaded that Intel's decision weighs in favor of exercising our discretion to deny institution. We acknowledge that Intel had the opportunity to present

[9] As we determined when instituting the PQA IPR, the timing for PQA's petition was reasonable. IPR2021-01229, Paper 10 at 9–10.

its invalidity contentions to the jury at trial and chose not to do so; however, we will not second-guess Intel's trial strategy. Rather, we focus on the fact that Petitioner's first petition was denied under § 314(a), and the Intel litigation did not resolve issues presented by this proceeding. Accordingly, there is no possibility of duplicative efforts or conflicting decisions, which was the concern when the Board denied Petitioner's first petition. *See* IPR2020-00158, Paper 16.

Patent Owner also argues that Petitioner could have sought to avoid redundancies and obtain institution of review by stipulating not to raise the grounds asserted here at trial. Prelim. Resp. 17–18; Opp. 8–9. The Board's decision denying institution of Intel's initial petition occurred before the Board decided either *Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A) or *Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC*, Case IPR2019-01393, Paper 24 (PTAB June 16, 2020) (informative). Thus, Patent Owner uses the benefit of hindsight in arguing that Petitioner should have stipulated not to raise these grounds at trial. While that option was available to Petitioner, the significance of doing so was not clear until the precedential and informative decisions on the issue.

Because Petitioner has adequately explained the time gap between its petitions and is not broadening the challenge or causing delay by seeking to join the PQA IPR, we conclude that factors 4 and 5 weigh against discretionary denial.

Factor 6: the finite resources of the Board; and
Factor 7: the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review

We are not persuaded that instituting this Petition will significantly affect the resources of the Board or our ability to issue a final determination within the one-year statutory timeline. We instituted the PQA IPR because we found the challenges reasonably likely to be successful, and we will continue expending resources to decide the merits of the PQA IPR regardless of joinder.

Patent Owner argues that "[l]ike in *Uniloc*, joinder in this circumstance would allow Petitioner [Intel] to continue a proceeding even after settlement with the primary petitioner." Opp. 9 (alterations in original) (quoting *HTC*, IPR2021-00570, Paper 17 at 13); *accord* Prelim. Resp. 23–24. That statement is true for all joinder authorized by § 315(c). We are not persuaded to weigh it in favor of exercising our discretion to deny joinder here. Noting that PQA, who has not been accused of infringement, lacks standing to appeal a decision in this IPR, Patent Owner opposes joining Intel, who is accused of infringement and has standing to appeal, because "allowing joinder would even make what is non-appealable appealable." Prelim. Resp. 24; *accord* Opp. 14–15. We do not consider Intel's right to appeal our final decision to be a factor in assessing whether to grant Intel's motion for joinder.

In addition, we are not persuaded that joining Petitioner would add significant issues or evidence burdening the Board. First, Patent Owner argues that joinder would implicate issues of estoppel and identification of real parties in interest ("RPI"). Opp. 13–15. To the extent that Patent Owner

wishes to raise estoppel and RPI issues, the burden will be borne by Petitioner and Patent Owner primarily. The Board is experienced in handling such issues in a timely manner, so we are not persuaded that this weighs in favor of exercising our discretion to deny joinder.

Second, Patent Owner contends that the Petitioner has already added evidence to this case, but we see no indication of that in the record. Opp. 14. In contrast, Petitioner argues that joinder would assist the Board in resolving the IPR, while also stipulating that it would participate only "as an understudy." Mot. 10 n.3, 15. We acknowledge that joining Intel may require some minor adjustments to accommodate an additional party, but Intel's understudy role will not meaningfully increase the burden on the Board. Accordingly, we conclude that factors 6 and 7 weigh against discretionary denial.

Summary

Having considered all the *General Plastic* factors, based on the present record, we determine not to exercise our discretion to deny institution under § 314(a).

3. Consistent exercise of discretion (Vivint)

Patent Owner argues that we should deny institution under 35 U.S.C § 325(d) because *Vivint* "confirms that denial under § 325(d) is required here." Prelim. Resp. 30. We do not agree.

In *Vivint*, the Federal Circuit held that "the Patent Office, when applying § 325(d), cannot deny institution of IPR based on abusive filing practices then grant a nearly identical reexamination request that is even more abusive." *In re Vivint, Inc.*, 14 F.4th at 1354. The Federal Circuit found

it important in *Vivint* that, when the Board denied Alarm.com's IPR petition, the Board considered Alarm.com's earlier petitions and reasoned that "allowing similar, serial challenges to the same patent, by the same petitioner, risks harassment of patent owners and frustration of Congress's intent in enacting the [AIA]." *Id.* at 1353 (quoting IPR2016-01091, Paper 11 at 12). Particularly, in *Vivint*, the same petitioner filed three petitions challenging the same patent, of which the Board denied two on the merits and the third for "undesirable, incremental petitioning," "us[ing] prior Board decisions as a roadmap to correct past deficiencies." *Id.* at 1346 (quoting IPR2016-01091, Paper 11 at 12).

The facts here do not invoke *Vivint*. The Intel IPR was not denied on the merits or for abusive filing practices, but rather was denied to avoid overlap with a parallel district-court litigation. *See* IPR2020-00158, Paper 16 at 4–14. We instituted the PQA IPR after reasoning that the petition there presented challenges reasonably likely to be successful and that applying our framework for evaluating requests for discretionary denial did not counsel against institution for that case. Although this proceeding involves a petitioner that has before petitioned for review of the '373 patent, this Petition seeks to join the existing PQA IPR because the Board has not substantively addressed the merits of the challenge. In addition, this Petition does not benefit from prior Board decisions identifying deficiencies. In denying Intel's initial petition, we did not find that there were potentially abusive filing practices by the same challenger, as was at issue in *Vivint*.

Patent Owner has not identified how instituting review would be inconsistent with any prior decision on this patent. As explained above, in part because no invalidity issues were presented for the '373 patent at trial,

we reach a different conclusion under *Fintiv* than the previous application. Thus, instituting review would not amount to an abusive filing practice under *Vivint*.

C. WHETHER TO GRANT JOINDER

Patent Owner argues that, even if the Petition warrants institution, we should deny Intel's motion for joinder. Opp. 11–15. As Patent Owner notes, "the decision to grant joinder is discretionary." *Id.* at 11 (quoting *LG Elecs., Inc. v. ATI Techs. ULC*, IPR2015-01620, Paper 10 at 5 (PTAB Feb. 2, 2016)). Patent Owner's Opposition to joinder raises many of the same arguments raised in the Preliminary Response and discussed above. *See* Opp. 2–11. We have addressed those arguments above in concluding that the Petition warrants institution.

According to Patent Owner, neither Intel's "rush" in filing its joinder request, nor its reliance on grounds unchanged from its initial IPR petition favors joinder. *Id.* at 12–13. We do not agree. Petitioner's timeliness in filing the Petition and requesting joinder minimized the potential disruption to an existing proceeding if joinder is granted. Although not determinative *per se*, those aspects of Petitioner's approach support granting joinder.

Patent Owner argues also that joinder here would disrupt the schedule and add new issues. *Id.* at 13–15. But Patent Owner does not explain how joining Intel will disrupt the schedule. As for new issues, Patent Owner asserts that joining Intel will "raise anew the question of Intel's relationship with PQA and the unknown persons controlling PQA." *Id.* at 14. Other than speculation, Patent Owner does not point to anything, in the record or otherwise, indicating that such a relationship exists.

Finally, Patent Owner argues that we may allow joinder of otherwise time-barred parties "only in limited circumstances." Opp. 15 (quoting *Proppant*, IPR2018-00914, Paper 38 at 19). *Proppant*, however, expressed that narrow view of joinder only in the context of considering the impact of a time bar "on the first two questions" considered (same-party and new-issue joinder). *Proppant*, IPR2018-00914, Paper 38 at 3, 16; *accord id.* at 19 (tying limited exercise of joinder discretion to instances "when an otherwise time-barred petitioner requests same party and/or issue joinder"). We do not consider *Proppant* as limiting our discretion here, where neither same-party joinder nor new issues are involved.

Petitioner has properly filed a petition under 34 U.S.C § 311, and we are not persuaded that "[j]oining Intel 'would obviate the careful statutory balance' and 'effectively circumvent the time limitation in § 315(b),'" because the statute provides for an exception to the time bar for joinder. Opp. 5 (quoting *Proppant*, IPR2018-00914, Paper 38 at 18).

III. CONCLUSION

For the reasons discussed above and in our decision instituting the PQA IPR, we conclude that Petitioner has shown a reasonable likelihood of prevailing with respect to at least one claim. We have also evaluated all of the parties' submissions and determine that the record supports institution. We conclude that instituting review in this proceeding is in the interest of efficient administration of the Office and the integrity of the patent system. *See* 35 U.S.C. § 316(b). Accordingly, we institute *inter partes* review of all challenged claims under all grounds set forth in the Petition.

Our determination at this stage of the proceeding is based on the evidentiary record currently before us. This decision to institute trial is not a

final decision as to patentability of any claim for which *inter partes* review has been instituted. Our final decision will be based on the full record developed during trial.

Upon considering the parties' arguments and the evidence presented, we are persuaded that it is appropriate under these circumstances to join Petitioner to the PQA IPR. Joinder to the PQA IPR will result in the just, speedy, and inexpensive resolution of Petitioner's challenge. *See* 37 C.F.R. § 42.1(b). Accordingly, for the reasons discussed above, we grant Petitioner's Motion for Joinder and join Petitioner as a party to the PQA IPR.

IV. ORDER

Accordingly, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '373 patent is instituted on the claims and grounds set forth in the Petition;

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial commencing on the entry date of this decision;

FURTHER ORDERED that Petitioner's Motion for Joinder with IPR2021-01229 is granted, and Petitioner is hereby joined as a petitioner in IPR2021-01229;

FURTHER ORDERED that there are no changes to the grounds on which trial in IPR2021-01229 was instituted, and no other grounds are added in IPR2021-01229;

FURTHER ORDERED that the Scheduling Order entered in IPR2021-01229 (Paper 15), including any schedule changes agreed by the

parties in that proceeding pursuant to the Scheduling Order, shall govern the trial schedule in Case IPR2021-01229;

FURTHER ORDERED that Petitioner's role in IPR2021-01229 shall be limited as stated by Petitioner in the Motion for Joinder (Paper 4 at 10 n.3, 15) unless and until PQA is terminated from that proceeding;

FURTHER ORDERED that the case caption in IPR2021-01229 shall be changed to reflect joinder of Intel Corporation as petitioner in accordance with the attached example;

FURTHER ORDERED that a copy of this Decision be entered into the record of IPR2021-01229; and

FURTHER ORDERED that this proceeding is terminated under 37 C.F.R. § 42.72 and 37 C.F.R. § 42.122, and all further filings shall be made in IPR2021-01229.

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[Sample Case Caption]

UNITED STATES PATENT AND TRADEMARK OFFICE

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PATENT QUALITY ASSURANCE, LLC,
INTEL CORPORATION,
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v.

VLSI TECHNOLOGY LLC,
Patent Owner.

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Patent 7,523,373 B2

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* Intel Corporation, which filed a petition in IPR2022-00479, has been joined as a party to this proceeding.