UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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INTEL CORPORATION,
Petitioner,

v.

ALACRITECH, INC.,
Patent Owner.
_____

Case IPR2017-01393
Patent 9,055,104 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
37 C.F.R. § 42.108

I. INTRODUCTION

Intel Corporation ("Petitioner") requests *inter partes* review of claims
1, 6, 9, 12, 15, and 22 (the "challenged claims") of U.S. Patent No.

9,055,104 B2 ("the '104 patent," Ex. 1001) pursuant to 35 U.S.C. §§ 311 *et seq.* Paper 2 ("Pet."). Alacritech, Inc. ("Patent Owner") filed a preliminary response. Paper 7 ("Prelim. Resp."). Institution of an *inter partes* review is authorized by statute when "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); *see* 37 C.F.R. § 42.108. Upon consideration of the Petition and Preliminary Response, we conclude the information presented shows there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claims 1, 6, 9, 12, and 15 of the '104 patent. We deny the Petition with respect to claim 22.

A. Related Matters

We are informed that the '104 patent is presently related to the following: *Alacritech, Inc. v. CenturyLink, Inc.,* Case No. 2:16-cv-00693-JRG-RSP (E.D. Tex.); *Alacritech, Inc. v. Wistron Corp.,* Case No. 2:16-cv-00692-JRG-RSP (E.D. Tex.); and *Alacritech, Inc. v. Dell Inc.,* Case No. 2:16-cv-00695-RWS-RSP (E.D. Tex.). Pet. 4; Paper 3, 0.

B. The '104 Patent

The '104 patent describes a system and method for accelerating data transfer from a host system to a network by sending the host an indication that data has been transmitted to the network prior to receiving an acknowledgement (ACK) from the network. Ex. 1001, Abstract. According to the '104 patent, prior network interface devices waited until an ACK was received from the network before indicating to the host computer that a requested transmission had completed. *See id.* at 2:10–37. The '104 patent asserts that this prior technique causes delays in the transmission of data

from a host to a network. *Id.* at 2:41–44. According to the '104 patent, "this problem is solved by sending, from the device to the host, a signal that the data has been sent from the device to the network, prior to receiving, by the device from the network, an ACK that all the data has been received." *Id.* at 2:45–49.

C. Illustrative Claim

Claims 1, 12, 22, and 23 are the independent claims of the '104 patent. Claim 1, reproduced below, is illustrative of the claimed subject matter:

> 1. A method for communication involving a computer, a network, and a network interface device of the computer, the network interface device being coupled to the network, the method comprising:
>
> receiving, by the network interface device from the computer, a command to transmit application data from the computer to the network;
>
> sending, by the network interface device to the network, data corresponding to the command, including prepending a transport layer header to at least some of the data;
>
> sending, by the network interface device to the computer, a response to the command indicating that the data has been sent from the network interface device to the network, prior to receiving, by the network interface device from the network, an acknowledgement (ACK) that all the data corresponding to the command has been received; and
>
> maintaining, by the network interface device, a Transport Control Protocol (TCP) connection that the command, the data and the ACK correspond to.

Id. at 6:43–62.

D. Asserted Grounds of Unpatentability

Petitioner asserts that the challenged claims are unpatentable based on the following grounds (Pet. 15–16):

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
	§ 112, 2nd paragraph[3]	22

Petitioner relies on the testimony of Dr. Robert Horst (Ex. 1003) in support of its assertions.

II. DISCUSSION

A. Claim Construction

As a step in our analysis for determining whether to institute a review, we determine the meaning of the claims for the purpose of this Decision. In an *inter partes* review, a claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears. 37 C.F.R. § 42.100(b); *see also In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278 (Fed. Cir. 2015) ("We conclude that Congress implicitly approved the broadest reasonable interpretation standard in enacting the AIA."). Under the broadest reasonable construction standard, claim terms are given their ordinary and customary meaning, as

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[1] U.S. Patent No. 5,937,169. ("Connery," Ex. 1043).
[2] PCT Patent Publication No. WO 00/13091. ("Boucher," 1049).
[3] Under 37 C.F.R. § 42.104(b)(2), we are not authorized to address patentability issues under 35 U.S.C. § 112, second paragraph.

would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Any special definition for a claim term must be set forth in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). We must be careful not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993). Only terms that are in controversy need to be construed and only to the extent necessary to resolve the controversy. *See Wellman, Inc. v. Eastman Chem. Co.,* 642 F.3d 1355, 1361 (Fed. Cir. 2011); *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

Use of the word "means" in a claim gives rise to a rebuttable presumption that 35 U.S.C. § 112(6) analysis applies to interpret the claim. *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1348 (Fed. Cir. 2015). Construing a means-plus-function claim term is a two-step process, wherein we first identify the claimed function and then determine what structure, if any, disclosed in the specification corresponds to the claimed function. *Id.* at 1351; *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1210 (Fed. Cir. 2003); *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1119 (Fed. Cir. 2002). Our rules specifically require that a petition for *inter partes* review identify how each challenged claim is to be construed, including identification of the corresponding structure for means-plus-function limitations. In particular, "[w]here the claim to be construed contains a means-plus-function . . . limitation as permitted under 35 U.S.C. 112[(6)], the construction of the claim must identify the specific

portions of the specification that describe the structure, material, or acts corresponding to each claimed function." 37 C.F.R. § 42.104(b)(3). Moreover, "structure disclosed in the specification is 'corresponding' structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim." *Golight, Inc. v. Wal-Mart Stores, Inc.*, 355 F.3d 1327, 1334 (Fed. Cir. 2004); *Cardiac Pacemakers*, 296 F.3d at 1113.

1. Claim 22 Means Elements

Claim 22 recites four elements in mean-plus-function form: "means for receiving," "means for sending . . . data," "means for prepending," and "means for sending . . . an indication." There is a rebuttable presumption that § 112(6) means-plus-function analysis applies to these elements. *Williamson*, 792 F.3d at 1348.

Regarding the "means for sending . . . data" element, Petitioner argues the elements should be construed under 35 U.S.C. § 112(6) because the claim recites insufficient structure. Pet. 35. Petitioner further argues the Specification fails to provide a corresponding algorithm or structure for performing the function and, thus, the claim term is indefinite. *Id.* Petitioner notes that in prior related litigation, Patent Owner argued this term is *not* subject to 112(6) interpretation and identifies the network interface device as the structure. *Id.* at 36 (citing Ex. 1040, .030). Petitioner contends, in the alternative, if we determine § 112(6) analysis applies to this element, the corresponding structure is the network interface device. *Id.* at 37. Petitioner presents the same arguments for all other recited means elements. *Id.* at 33–34, 36–38.

Patent Owner disagrees that this means element of claim 22 is indefinite but argues Petitioner has failed to meet its burden to define the claim terms. Prelim. Resp. 15–16.

We determine this element is subject to § 112(6) analysis because neither party presents persuasive evidence to rebut the presumption that § 112(6) applies based on use of the phrase "means for." Petitioner's alternative proposal that, if § 112(6) analysis applies, the corresponding structure is the network interface device falls short of the burden of persuasion to "identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function." 37 C.F.R. § 104(b)(3); *see also Golight*, 355 F.3d at 1334. Simply stating that the network interface device is the corresponding structure without identifying support in the Specification for the alleged correspondence is insufficient to meet Petitioner's burden to identify where the Specification clearly links or associates the network interface device to the recited function.

Lacking a sufficient explanation of the disclosed structure providing the recited function, we are unable to construe this means element without resort to speculation. Therefore, we cannot apply claim 22 to the asserted prior art references because doing so would require speculation as to the scope of the claimed invention. *See United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236–37 (1942) (holding that "the claims must be reasonably clear-cut to enable courts to determine whether novelty and invention are genuine"); *In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) (holding that where a claim's meaning is indefinite under 35 U.S.C. § 112 ¶ 2, any ground based on prior art is improperly based on speculation);

Blackberry Corp. v. MobileMedia Ideas, LLC, Case IPR2013-00036, slip op. at 20 (PTAB Mar. 7, 2014) (Paper 65). Because we cannot determine the scope of claim 22 without speculation, we cannot compare the claim to the asserted prior art without speculation.

Accordingly, we are unable to reach a determination as to whether Petitioner has demonstrated a reasonable likelihood of prevailing with respect to the prior art ground asserted against claim 22 and, thus, the Petition is denied as to claim 22.

2. Other Terms

At this stage of the proceeding, we determine that it is not necessary to provide an express interpretation of any other terms of the claims.

B. Cited Prior Art References
1. Overview of Connery

Connery is directed to improving performance of transmissions from a host computer to a network by generating, at a network interface device, a plurality of smaller packets for transmission in response to receipt of a larger datagram from the host computer. Ex. 1043, Abstract (.001).

2. Overview of Boucher

Boucher describes an intelligent network interface that offloads protocol processing from a host computer using a fast-path and protocol processing logic on the network interface. *See generally* Ex. 1049, Abstract (.001).

C. Obviousness over Connery

Petitioner contends claims 1, 6, 9, 12, and 15 are unpatentable under 35 U.S.C. § 103(a) as obvious over Connery and the knowledge of the ordinarily skilled artisan or in the alternative are unpatentable under

35 U.S.C. § 103(a) as obvious over the combination of Connery and Boucher. *See* Pet. 43–87.

At this preliminary stage of the proceeding and on the record before us, Petitioner has accounted sufficiently for the limitations of at least one of the claims challenged in the Petition. For example, regarding claim 1, Petitioner argues Connery teaches or suggests all limitations. *See* Pet. 44–68. Patent Owner argues the Petition is insufficient with respect to recitations of claim 1 as discussed below.

1. Independent Claims 1 and 12
a. Prepending

Claim 1 recites "sending, by the network interface device to the network, data corresponding to the command, including prepending a transport layer header to at least some of the data." Petitioner asserts Connery discloses this feature by its network interface sending the datagram supplied by the host to the network as a plurality of packets, each packet generated from a segment of a larger host-supplied datagram. *Id.* at 50–51 (citing Ex. 1043, 3:59–60, 6:49–7:2; Ex. 1003 Appendix (A-8)). Petitioner further asserts Connery discloses prepending a transport layer header to the data by adding a TCP packet header to each segment of data of the host supplied datagram to generate a packet for transmission. *Id.* at 52 (citing Ex. 1043, Abstract ("[t]he plurality of packets include respective headers, such as TCP/IP headers")); *id.* at 52–53 (citing Ex. 1043, 3:52–55 ("[t]he plurality of packets is composed from the datagram by executing processes in the network interface to provide respective TCP/IP headers")); *id.* at 53 (citing Ex. 1043, 13:15–57 ("[a]s the segments are pulled, a header is produced from the template header and checksums are computed (step 207).")). The

Petition argues Connery discloses each packet includes both a TCP (transport) header and an IP (network) header. *Id.* at 54–55 (citing Ex. 1043, 7:13–17, 8:27–30; Ex. 1003 Appendix (A-13–A-14)).

Specifically regarding "prepending" these headers to the data as claimed, Petitioner contends the ordinarily skilled artisan would have been motivated to prepend the header to the data because "it would require moving less data than if one instead appended the data to the header." *Id.* at 55 (citing Ex. 1003 Appendix (A-14)). Petitioner further contends "it would be more efficient to move the smaller header to the front of the larger data payload, rather than moving the data to the rear of the header." *Id.* at 56 (citing Ex. 1003 Appendix (A-14)).

Patent Owner asserts the Petition improperly relies solely on "unasserted, non-proven prior art discussed only in an expert declaration." Prelim. Resp. 19. Patent Owner further asserts "the Petition relies solely on unproven 'POSA' knowledge from Dr. Horst's declaration for the disclosure of a claim element, [which] is an insufficient evidentiary basis to assuage Petitioner's institution-stage burden." *Id.* at 20.

We are not persuaded by Patent Owner's argument. We discern no reliance in the Petition on "unasserted" prior art. The Petition cites specific portions of Connery that recite combining a header with a segment of data to generate a packet. Although Connery does not specifically disclose that the header is *pre*pended to the data, the Petition relies on Dr. Horst's opinion that it would have been obvious to the ordinarily skilled artisan to prepend the header to the data, rather than appending the data to the header, to reduce the movement of the larger data relative to the smaller header. Pet. 55–56 (citing Ex. 1003 Appendix (A-14)).

We further note that the header and data to be transmitted are both stored in the memory of the network interface device and would be combined to form a packet in one of two obvious manners—either the header is prepended to the data or the data is appended to the header. *See id.* Given the evidence of a small number of known solutions to combining the header and data, Petitioner has shown sufficiently for purposes of this Decision that it would have been obvious to try prepending the header to the data to transmit the packet. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) (noting that if there are a finite number of identified, predictable solutions to solve a problem, a person of ordinary skill in the art has good reason to pursue the known options within his or her technical grasp).

b. *"Sending . . . a Response to the Command"*

Claim 1 further recites "sending, by the network interface device to the computer, a response to the command indicating that the data has been sent from the network interface device to the network." Petitioner contends Connery discloses interrupting the host computer only once after transmitting multiple segmented packets of the host supplied datagram (rather than one interrupt per packet) and further contends this single interrupt discloses the recited "response to the command indicating that the data has been sent from the network interface device to the network." *See* Pet. 56–60. More specifically, Petitioner argues Connery discloses an interrupt of the host system may be used to indicate to the host computer that a packet transmission is complete, acknowledgements of packets have been received, and for other events. *Id.* at 57 (citing Ex. 1043, 4:54–58).

As above regarding "prepending," Patent Owner argues the Petition is deficient in this regard in that it fails to cite Connery for this feature and, instead, relies solely on Dr. Horst's testimony. Prelim. Resp. 21.

For the same reasons as discussed *supra*, we are not persuaded by Patent Owner's argument. The Petition cites specific disclosure in Connery that one type of interrupt generated by the network interface is to signal the host computer that a packet transmission has completed. Pet. 57–58 (citing Ex. 1043, 4:54–58). The Petition contends, in view of Connery's purpose of reducing the number of interrupts, that it would have been obvious to the ordinarily skilled artisan that a single interrupt would be generated after completing transmission of all packets that comprise a host supplied datagram—i.e., a response to the received command. Pet. 58–60 (citing Ex. 1003 Appendix (A16–A18)).

c. "Prior to Receiving . . . an Acknowledgement"

The above-identified step of sending a response further recites that the response is sent "prior to receiving, by the network interface device from the network, an acknowledgement (ACK) that all the data corresponding to the command has been received." The Petition argues Connery discloses that an ACK is received at the network interface and forwarded to the host system after packets are received and processed at the destination on the network and asserts it would have been obvious to the ordinarily skilled artisan to send Connery's response (interrupting the host computer when datagram transmission is complete) to the host computer prior to receipt of the ACK. *See* Pet. 60–65. Petitioner argues that the ordinarily skilled artisan would have understood that receipt of the ACK has a much longer latency than the interrupt signaling completion of the transmission because the ACK is

delayed until the destination receives the packet(s) and has processed the packets. *Id.* at 62–63 (citing Ex. 1003 Appendix (A20–A21)).

As above, Patent Owner argues the Petition is deficient in this regard in that it fails to cite Connery for this feature and, instead, relies solely on Dr. Horst's testimony. Prelim. Resp. 22.

We are not persuaded by Patent Owner's argument. The Petition cites specific portions of Connery that disclose the receipt and processing of an ACK. *See* Pet. 61–62 (citing Ex. 1043, 1:56–67, 3:59–61, 9:56, 15:24–48, 16:16–18). Petitioner relies on Dr. Horst's opinion that it would have been obvious to the ordinarily skilled artisan that sending the response to the command (Connery's single interrupt of the host following transmission of multiple packets) would precede receipt of the ACK because all packets must be sent by the network interface before they could be received and processed at the destination. *Id.* at 62–65. Dr. Horst cites another reference as support for his opinion. Ex. 1003 Appendix (A-21 (citing Ex. 1044 ("Petersen"))).

d. Conclusion Regarding Obviousness of Claims 1 and 12 over Connery

For the above reasons, on the record before us and for purposes of this Decision, we are persuaded Petitioner has established a reasonable likelihood of prevailing in showing that independent claim 1 is unpatentable as obvious over Connery. Independent claim 12 is similar to claim 1, Petitioner provides similar analysis of claim 12 (Pet. 76–77), and Patent Owner presents essentially the same arguments regarding the limitations of claim 12 as presented for claim 1 (Prelim. Resp. 21–22). Thus, for the same reasons as claim 1, on the record before us and for purposes of this Decision, we are persuaded Petitioner has established a reasonable likelihood of

prevailing in showing that independent claim 12 is unpatentable as obvious over Connery.

2. *Obviousness of Dependent Claims 6, 9, and 15 over Connery*

Claim 9 depends from claim 1 and further recites "wherein receiving, by the network interface device from the computer, a command to transmit data includes receiving, by the network interface device from the computer, a pointer to the command." Petitioner argues Connery discloses that the MSS (size of segments to be extracted by the network interface from the larger datagram received from the host) may be sent "as part of a structure by passing a pointer." Pet. 75 (citing Ex. 1043, 10:7–17). Petitioner further contends, Dr. Horst opines that using a pointer to send and receive the command would have been an obvious choice among a limited number of solutions to transmit data between the host system and the network interface. *Id.* (citing Ex. 1003 Appendix (A-35)).

Patent Owner argues, as above, that the Petition fails to cite evidence in Connery and, instead, relies solely on Dr. Horst's opinion. Prelim Resp. 22–23.

We are not persuaded by Patent Owner's argument. The Petition cites Connery as disclosing the use of a pointer to a structure for sending at least one parameter relating to a command and relies on Dr. Horst's opinion that the ordinarily skilled artisan would have found it an obvious choice to use a pointer (such as disclosed by Connery) to send the command itself to the network interface.

For the above reasons, on the record before us and for purposes of this Decision, we are persuaded Petitioner has established a reasonable

likelihood of prevailing in showing that dependent claim 9 is unpatentable as obvious over Connery.

Claim 6 depends from claim 1 and further recites that an ACK is received at the network interface and is sent to the host system. Claim 15 depends from claim 12 and recites limitations similar to claim 6. Petitioner identifies these features in disclosures of Connery with support from Dr. Horst. *See* Pet. 68–74, 77. Patent Owner does not address these arguments by Petitioner. We have reviewed Petitioners assertions regarding claims 6 and 15 and we are persuaded Petitioner has established a reasonable likelihood of prevailing in showing that dependent claims 6 and 15 are unpatentable as obvious over Connery.

3. Conclusion Regarding Obviousness Over Connery

In view of the above, we conclude that Petitioner has established a reasonable likelihood of prevailing with respect to its obviousness challenge to claims 1, 6, 9, 12, and 15 over Connery.

D. Obviousness Over Connery and Boucher

Claim 1 includes the recitation, "maintaining . . . a Transport Control Protocol (TCP) connection." Claim 12 includes a similar recitation. The Petition identifies these features in Connery (Pet. 65–68, 77) but argues, in the alternative, to the extent this feature is deemed insufficiently taught or suggested by Connery, Boucher in combination with Connery provides such a feature (Pet. 82–87). The Petition argues Boucher and Connery are in the same field of endeavor. Pet. 82. The Petition further argues Connery's state information is directed primarily to unidirectional transmission (from the host system through the network interface to the destination) and, thus, need

not maintain full state information for a TCP connection in the other direction (packets received through the network interface destined to the host system). *Id.* at 83–84. The Petition further asserts Boucher maintains more complete state information regarding bidirectional TCP communications through an intelligent network interface. *Id.* at 85–86. The Petitioner contends the ordinarily skilled artisan would have been motivated to combine Boucher and Connery in order to "gain the benefit of more efficient bidirectional data flows." *Id.* at 87.

Patent Owner does not address Petitioner's arguments regarding this recitation of claims 1 and 12 or Petitioner's arguments regarding motivation to combine Connery and Boucher.

For the above reasons, on the record before us and for purposes of this Decision, we are persuaded Petitioner has established a reasonable likelihood of prevailing in showing claims 1, 6, 9, 12, and 15 are unpatentable as obvious over the combined teachings of Connery and Boucher.

E. Real Parties in Interest

Intel Corporation identifies itself as a real party in interest in these proceedings and represents that "[n]o other parties exercised or could have exercised control over this Petition; no other parties funded or directed this Petition." Pet. 4. Patent Owner argues "the Petition . . . fails to identify at least Dell Inc. ('Dell') and Cavium Inc. ('Cavium')" as real parties-in-interest and that "[t]he Board should deny institution . . . because the Petition fails to identify all real parties in interest [under] 35 U.S.C. § 312(a)(2) and 37 CFR § 42.8(b)(1)." Prelim. Resp. 23–24. We disagree.

As an initial matter, as Patent Owner points out, in determining

whether a party is a real party-in-interest "[a] common consideration is whether the non-party exercised or could have exercised control over a party's participation in a proceeding." Prelim. Resp. 25 (citing Office Patent Trial Practice Guide, 77 Fed. Reg. at 48759-60). Patent Owner further argues that: "Intel has agreed to defend and partially indemnify Dell" (*id.* at 27); "Intel is Dell's supplier with regard to Dell's accused products" (*id.*); "Intel also admitted that it would have to work closely with Dell in . . . litigation" (*id.*), "Intel also admitted that it has a close relationship to Dell financially in the district court case" (*id.*); "Intel chose . . . to *passively* reimburse Dell [and also] play[ed] an *active* role to assist, protect, and defend Dell" (*id.* at 28); "Dell [was] originally accused of infringing the '104 patent in the district court case, not Intel" (*id.*); "Intel's products were not accused in the original pleading" (*id.* at 29); "Dell desires review of the '104 Patent" (*id.*); "Dell and Intel have repeatedly coordinated their invalidity theories" (*id.*); "Dell and Intel also shared a technical expert Mr. Mark Lanning" (*id.* at 30); and that "Intel has effective choice of invalidity theories and proofs" (*id.*).

In summary, Patent Owner contends that because Intel allegedly
1) supplies products to,
2) works closely with,
3) has a close financial relationship with,
4) coordinated invalidity theories with,
5) shared a technical expert with,
6) plays an "active" role to assist, protect and defend Dell, and
7) has agreed to defend and partially indemnify Dell,

that Dell must have "exercised or could have exercised control over [Intel's] participation in" this *inter partes* review proceeding (i.e., exercised control over Intel's preparation or filing of the present Petition). Even accepting all

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of these contentions, we are not persuaded that Dell exercised or could have exercised control over the preparation or filing of the present Petition. Indeed, the alleged financial relationship, with Intel as the indemnitor of Dell, suggests that if anything Intel would control the preparation and filing of the present Petition. Patent Owner's reliance on *General Electric Company (GE) v. Oklahoma Gas & Electric Company (OG&E)*, Case IPR2014-01380, slip op. 8 (PTAB April 5, 2015) (Paper 8) is misplaced. Prelim. Resp. 25–26. There, a specific clause in the indemnification agreement in which GE agreed to indemnify OG&E required GE to "solicit OG&E's input and assent on all material decisions in the case." IPR2014-01380, slip op. at 8–9 (quoting IPR2014-01380 Ex. 2015, GE-00001). Thus, OG&E had some degree of control or at least the opportunity to control material decisions such as the filing or arguments in the petition GE filed. On the record before us, there is no persuasive evidence that Intel was required to seek Dell's input or assent to any decisions.

The other assertions relating to coordinating theories and sharing experts are common activities between cooperating co-defendants and are not suggestive of control of *this* petition. *See Weatherford Int'l, LLC,* et al. *v. Packers Plus Energy Services, Inc.*, Case IPR2016-01514, slip op. 12–16 (PTAB Feb. 22, 2017) (Paper 23). However, these common activities do not evidence control or an opportunity to control *this* proceeding.

Accordingly, on the record before us and for purposes of this Decision, we are not persuaded by Patent Owner's argument that Dell should have been identified as a real party-in-interest.

Patent Owner further argues that "Cavium is also a supplier of Dell," "petitions filed by Intel and Cavium also share an identical declaration from

the expert, Dr. Robert Horst," and "Cavium also filed an almost verbatim petition." Pet. 30–31. Accordingly, for similar reasons as previously discussed, we are not persuaded by Patent Owner's argument that Cavium should have been identified as a real party-in-interest.

Furthermore, we reject Patent Owner's argument that we deny institution for an additional reason. The Board's jurisdiction to consider a petition is not contingent upon a "correct" identification of all real parties in interest in a petition. *Lumentum Holdings, Inc. v. Capella Photonics, Inc*., Case IPR2015-00739, slip op. at 6 (PTAB March 4, 2016) (Paper 38) (precedential); *Blue Coat Sys., Inc. v. Finjan, Inc.*, Case IPR2016-01444, slip op. 10 (PTAB July 18, 2017) (Paper 11) ("Evidence [of failure to identify all real parties in interest] is, at best, suggestive of an issue that is not jurisdictional."). Consequently, even if Dell and Cavium are real parties-in-interest, as Patent Owner alleges, it simply does not follow that failure to identify them as such at the time the Petition was filed requires us to terminate the proceeding. Indeed, later PTAB decisions indicate that a petition may be corrected after institution of trial to add a real party in interest if warranted without assigning a new filing date to the petition. *E.g.*, *Axon EP, Inc., et al. v. Derrick Corp.*, Case IPR2016-00642, slip op. at 3 (PTAB November 21, 2016) (Paper 17).

We have considered Patent Owner's argument that "[f]inding that Dell and Cavium are real parties in interest is . . . consistent with the express legislative intent concerning the need for quiet title." Prelim. Resp. 32–33. For example, Patent Owner contends that

> If Intel were to be able to institute this IPR without adding Dell
> and Cavium as real parties in interest, Dell and Cavium would be
> able to use the same prior art relied upon here in other cases even

if the patent is held to be valid in this IPR. This would be harassment through repeated litigation in violation of legislative intent, as Intel, Dell, and Cavium would be able to "double dip" and use the same invalidity theories to defend the same accused products twice. Indeed, Cavium has already filed almost identical IPR petitions.

Id.

We disagree. Notwithstanding our preliminary determination here that Dell and Cavium have not been shown to be real parties-in-interest, our decision does not preclude Patent Owner from defending itself in a later, notional IPR filed by Dell or Cavium on the basis that either party was a real party-in-interest of Intel in this proceeding.[4] *See* 35 U.S.C. § 315(e).

F. 35 U.S.C. 325(d)

Patent Owner argues that institution should be denied under 35 U.S.C. § 325(d) because each of Connery and Boucher was a reference of record during the prosecution of the '104 Patent. Prelim. Resp. 34–35.

Patent Owner does not identify any specific evidence that either of these references was substantively considered during prosecution alone or in combination. On the face of the '104 patent, it appears each reference was submitted on Information Disclosure Statements during prosecution. *See* Ex. 1001, .002–.003. However, even assuming the references were listed on Information Disclosure Statements submitted to the Examiner, Patent Owner has not identified evidence that the references were applied against the claims of the '104 patent. Having considered Patent Owner's arguments and

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[4] Although we point out that Cavium has moved to join this proceeding (*see* IPR2017-01714) and Dell would be time-barred in any event. Prelim. Resp. 24 n.5.

the particular facts and circumstances in the record before us at this preliminary stage, we decline to exercise our discretion to deny the Petition under 35 U.S.C. § 325(d).

III. CONCLUSION

For the foregoing reasons, we determine that the information presented establishes a reasonable likelihood that Petitioner would prevail in showing that at least one of claims 1, 6, 9, 12, and 15 of the '104 patent is/are unpatentable. At this preliminary stage, we have not made a final determination with respect to the patentability of the challenged claims or any underlying factual and legal issues.

IV. ORDER

Accordingly, it is:

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted as to claims 1, 6, 9, 12, and 15 of the '104 patent on the following grounds of unpatentability:

Reference(s)	Basis	Claims challenged
Connery	§ 103	1, 6, 9, 12, and 15
Connery and Boucher	§ 103	1, 6, 9, 12, and 15

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, which commences on the entry date of this decision; and

FURTHER ORDERED that the trial is limited to the grounds identified immediately above, and no other ground is authorized.

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