UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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OPENSKY INDUSTRIES, LLC
Petitioner,

v.

VLSI TECHNOLOGY LLC
Patent Owner.

_____

Case IPR2022-00645
Patent 7,523,373

_____

PATENT OWNER'S OPPOSITION TO OPENSKY INDUSTRIES, LLC'S MOTION FOR JOINDER TO *PAT. QUAL. ASSURANCE, LLC V. VLSI TECH. LLC*, IPR2021-01229

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2001-2002	Reserved
2003	Rebuttal Expert Report of Dr. Thomas M. Conte Regarding Validity of the '759 and '373 Patents in *VLSI Technology LLC v. Intel Corp.*, 1:19-cv-977-ADA (W.D. Tex.) [Conte Report]
2004	Email from Jeffrey A. Dennhardt (Tuesday, February 9, 2021, 6:45 AM) [Dennhardt Email]
2005	Matthew Bultman, *Intel, VLSI Patent Jury Trial Kicks Off in Waco After Delay Bid*, BLOOMBERG LAW NEWS (Feb. 22, 2021, 3:13 PM) [Bultman Bloomberg Article]
2006	Reserved
2007	Expert Report of Dennis Sylvester, Ph.D. Regarding Invalidity of U.S. Patent No. 7,523,373 in *VLSI Technology LLC v. Intel Corp.*, 1:19-cv-977-ADA (W.D. Tex.) (July 21, 2020) [Sylvester Report].
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2029	Email from Christopher D. Ivey (Wednesday, February 23, 2022, 2:23:12 PM)
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2035	Alliance of U.S. Startups and Inventors for Jobs, Precedential Opinion Panel (POP) Amicus Request Form, Exhibit 3008 in *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064
2036	Cornell University, Precedential Opinion Panel (POP) Amicus Request Form, Exhibit 3009 in *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064

After a jury found infringement and validity of the ’759 and ’373 patents in the VLSI-Intel trial (Ex. 2007), petitioner-movant OpenSky was formed to extract a payout by copying and refiling Intel’s previously denied petitions against those patents. IPR2021-01056 (’373); IPR2021-01064 (’759). OpenSky has no apparent business other than extortion, and certainly does not make any products or have any other business reason to be concerned about the patents’ existence. OpenSky’s petition against the ’759 was instituted, but its petition against the ’373 was denied. Because its harassment has not yet yielded a payout, OpenSky is now trying to boost its leverage by filing a second petition against the ’373—a copy of its first (itself a copy of Intel’s), this time coupled with a joinder request.

OpenSky would have the Office believe that its latest attack “is necessary to instill confidence in the integrity of the patent system.” Pet., 3. But incredibly, just two days prior to filing this petition, in its instituted IPR, OpenSky proposed in writing to VLSI that, in exchange for money, OpenSky would work in secret to ***undermine*** the integrity of the patent system. Specifically, OpenSky proposes to secure “defeat of” OpenSky’s grounds against that patent, sabotage evidence by withholding expert fees, and then, payoff in hand, terminate the case once it is no longer winnable. Ex. 2029. OpenSky’s serial attack against the ’373 in the present case is filed to crank up pressure on VLSI to agree to OpenSky’s demands. OpenSky is right about one thing (Pet., 2): “the integrity of the patent system” *is* at

stake here. The Board should protect that integrity by denying the joinder request of a shakedown artist that has offered to run a sham IPR.

OpenSky already filed a petition just like this one, with the same grounds, against the same patent. The Office considered that petition and denied review, finding its evidentiary showing insufficient to meet OpenSky's merits burden. The present petition presents the same grounds against the same claims. Not only does it simply seek a second bite at the apple for OpenSky, it seeks joinder to another case—so that it can stand in line for a potential payout in that case, too. The Motion ignores Board precedent, which establishes that serial harassment like this is disfavored, especially in discretionary joinder, and that it is "not…efficient use of Board resources to institute an *inter partes* review where all…[c]hallenged [c]laims have already been adjudicated by an Article III court." *Snap Inc. v. BlackBerry Ltd.*, IPR2020-00391, Paper 8, 17 (July 13, 2020) ("*Snap*").

Discretionary denial of joinder is used "to prevent *inter partes* review from being 'used as a tool for harassment'" and "ensure 'quiet title to patent owners.'" *Proppant Express Invs., LLC v. Oren Techs., LLC*, IPR2018-00914, Paper 38, 18 (POP Mar. 13, 2019) (precedential) ("*Proppant*") (quoting H.R. Rep. No. 112-98, pt. 1, 48 (June 1, 2011)), *rev'd in other respects*, *Facebook, Inc. v. Windy City Innovs., LLC*, 973 F.3d 1321, 1332 (Fed. Cir.), *reh'g denied*, 819 Fed. App'x 936 (Fed. Cir. 2020). The "conduct of the parties and attempts to game the system may

also be considered" in "carefully balanc[ing] the interest in preventing harassment [of patent owners] against fairness and prejudice concerns." *Id.*, 18-19. Here, OpenSky's conduct and attempt to game the system could hardly be more brazen: offering to sabotage its own instituted IPR for money, while simultaneously refiling a previously-denied IPR petition on the fraudulent pretext that its joinder "is necessary to instill confidence in the integrity of the patent system." Pet., 3.

I. OPENSKY'S JOINDER PETITION SHOULD BE DENIED.

A. OpenSky's Proposal To Commit Fraud On The Office Supports Denial Of This Joinder Request.

VLSI is compelled to notify the Office of disturbing conduct by OpenSky in the ongoing IPR proceeding between VLSI and OpenSky implicating significant rule violations by OpenSky, including the rules of professional responsibility. OpenSky claims that it is filing its cases to protect "the integrity of the patent system." *E.g.*, *id.* Yet its written proposal just presented to VLSI "for discussion" demonstrates quite the opposite. These facts are submitted pursuant to at least 37 C.F.R. § 11.303(b), and also illustrate why this joinder request should be denied.

In VLSI's preliminary responses to OpenSky's prior attacks against both the '759 and '373 patents, VLSI observed that the newly-formed OpenSky's apparent motive is a "shakedown" to extract a "payoff." 01064, Paper 9, 11, 25, 29; 01056, Paper 9, 10, 26, 31 (same). OpenSky responded by insisting that "allegations of 'nefarious intent' and 'seeking a payoff' are unfounded" and that its petitions were

filed because "OpenSky felt that the patent system integrity demanded consideration of the prior art." 01064, Paper 13, 5; 01056, Paper 14, 5-6 (same).

In its 01064 Institution Decision, the Board accepted OpenSky's explanation:

> We determine that OpenSky has offered a reasonable explanation for the timing of the Petition. Here, it was reasonable for OpenSky to take interest in the '759 patent after a substantial damages award, and choose to challenge the patent at that time.

01064 Paper 17, 13; *see also* 01064 Paper 2 (Pet.), 9 (asserting that "the Board needs to institute review to maintain the integrity of the patent system[] because a jury found that [the '759] patent is worth" the significant damages award, but its "validity" has yet to be "double-checked"); 01056 Paper 2 (Pet.), 8 (same, as to '373). Thus, OpenSky's '759 petition was instituted based on OpenSky's "reasonable explanation" that it sought to protect the "integrity" of the patent system by, *inter alia*, "double-check[ing] the validity of the '759 patent." 01064 Paper 2, 9; Paper 13, 5. But OpenSky's recent statements and actions show that OpenSky is no defender of the patent system. It just wants money.

On February 23, 2022, two days before filing this joinder motion, OpenSky's counsel emailed VLSI a proposal (Ex. 2029) to secretly settle with VLSI, but keep the 01064 IPR going as a sham—specifically to ***sabotage that case for any joiners***:

> … if OpenSky and VLSI were to reach an agreement to dismiss OpenSky's petition, VLSI will still have to address the joinder

petitions…. [T]here is a risk that the Board will sit on OpenSky's motion to dismiss [the 01064] until after it takes up PQA's joinder motion. However, a well-timed settlement between VLSI and OpenSky can account for this unlikely outcome and still leave VLSI in a strong position should that occur. PQA would be joining the OpenSky trial in the state that OpenSky had left it. If PQA were to join a trial where VLSI had already filed its patent owner response, and if a deposition of OpenSky's expert witness had not occurred, PQA would be joining a trial with a potentially fatal evidentiary omission that PQA would be unable to remedy. By that point, it would be too late for PQA to provide a deposition of the expert and VLSI would have a very strong objection to PQA's reliance on expert testimony. We know this is a strong objection because even the potential existence of this evidentiary issue kept the Board from instituting OpenSky's other IPR.

With all that out of the way, here is a construct for discussion purposes related to this petition proposed by OpenSky:

- Parties agree to work together to secure dismissal or defeat of the petition.
- OpenSky agrees not to negotiate with Intel or PQA
- VLSI takes full three months to oppose PQA joinder
- VLSI files its patent owner response
- OpenSky refuses to pay expert for time at deposition so expert does not appear for deposition
- The day after VLSI files response, OpenSky and VLSI file motion to dismiss

Payment structure:

- First payment upon execution of agreement

- Second payment upon denial of both joinder petitions. There could be an alternative second payment if joinder is granted but claims affirmed because of OpenSky's refusal to produce witnesses.

Under this collusive framework "proposed by OpenSky," OpenSky and VLSI would not terminate the case when they settle, but would instead "work together" to ***pretend*** to litigate 01064 to secure "defeat of the petition"—OpenSky's own petition—in exchange for a payoff by VLSI. Like the infamous 1919 "Black Sox," OpenSky would tank its own case to ensure its own grounds fail. OpenSky suggests "a well-timed settlement" to "account" for the "risk" of joinder to 01064 by "leav[ing] VLSI in a strong position" by pretending to continue litigating the case while ***undermining*** it, "refus[ing] to produce witnesses," even "refus[ing] to pay [the] expert…so [the] expert does not appear," so as to leave any ***joining party*** with an "evidentiary omission that [they] would be unable to remedy," and only filing to terminate "after VLSI files [its] response" and opposition to joinder. *Id.*

OpenSky's actions cannot be squared with its claims to be protecting "patent system integrity" by "double-check[ing]" validity, much less its insistence that it is not "seeking a payoff." 01064 Paper 2, 9; *id.*, Paper 13, 5. OpenSky's briefs insist "OpenSky is willing to reasonably compensate [Intel's] expert for" deposition and even that "the duty of candor and good faith (37 C.F.R. 42.11(a) appears to prohibit practitioners from entering agreements to block evidence in patent office proceedings." 01064, Paper 13, 9-10; 01056, Paper 19, 15 (same). This rhetoric

was only meant to mislead. The proposal above proves OpenSky does not care about system integrity or double-checking validity. It is offering to ***undermine*** the system's integrity, run a ***sham*** IPR trial**,** and ***sabotage*** checking validity, for pay.

The POP holds that discretionary joinder should be granted "only in limited circumstances." *Proppant*, 18. Allowing use of IPR as "'a tool for harassment'" after a jury trial, by an extortionist willing to undermine the integrity of a system it says it is trying to protect, is not such a circumstance. The panel should protect "the careful statutory balance," *id.*, 11, and reject OpenSky's joinder request.

B. The Board's Joinder Precedents—Which The Motion Ignores—Show That A Grant Of OpenSky's Request Is Inappropriate.

In addition to the fundamentally fraudulent nature of this joinder attack as detailed above, the Motion ignores current law. In the past, the Board routinely granted "me-too" or "copycat" joinder requests (*i.e.*, petitions that are the same as the petition they seek to join), saying that "the *General Plastic* factors [we]re not particularly relevant" to such requests. *Central Sec. Grp.—Nationwide, Inc. v. Ubiquitous Connectivity, LP*, IPR2019-01609, Paper 11, 8 (Feb. 26, 2020) (quoted in Mot., 3). The Office announced a new standard in *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (Oct. 28, 2020) (designated precedential Dec. 4, 2020) ("*Uniloc*"), clarifying that discretionary § 314(a) factors are directly relevant to "a 'me-too petition'" like this one, and must be analyzed to determine whether such joinder requests should be rejected. *Uniloc*, 4-5 (holding that "before

determining whether to join ..., ***even though the Petition is a 'me-too petition,'*** we first determine whether application of the *General Plastic* factors warrants the exercise of discretion to deny the Petition under § 314(a).") (emphasis added). The *Fintiv* discretionary factors, like the *General Plastic* factors, furnish another basis to deny this "'me-too'" joinder request, under "a holistic view of whether efficiency and integrity of the system are best served" by rejecting it—particularly where a joinder petitioner is attacking a patent it already attacked before. *E.g., LG Elecs., Inc. v. Ancora Techs. Inc.*, IPR2021-00581, Paper 16, 7 (June 10, 2021) ("*LG*") (applying *Fintiv*, denying me-too joinder request). Notably, such requests may be rejected even when the joinder petitioner's second petition raises different grounds than its first. *Uniloc*, 8-11. All the more so if their grounds are the ***same***.

C. The *General Plastic* Factors Warrant Discretionary Denial.

The *GP* factors individually and collectively favor denial of this request.

Factor 1: This factor addresses prior petitions "directed to the same claims of the same patent." This is OpenSky's second petition, and the fifth overall, asserting these grounds against the same claims of the patent: OpenSky's IPR2021-01056, Intel's IPR2020-00158 & IPR2022-00479, and PQA's IPR2021-01229.

Moreover, OpenSky's first petition was ***not*** denied as a matter of discretion. It was denied because its support for its grounds "d[id] not warrant institution":

> It is Petitioner's burden to show unpatentability, and in support of its case Petitioner has brought forth the testimony of an expert that…

would likely be excluded.

IPR2021-01056, Paper 18, 8-9 (Dec. 23, 2021). Accordingly, this serial second petition by OpenSky should be denied. *E.g.*, *HTC Corp. v. Ancora Techs., Inc.*, IPR2021-00570, Paper 17, 7-13 (June 10, 2021) ("*HTC*") (applying *Uniloc*, finding factor 1 favored denial of joiner's "second petition challenging the [] patent" even though ***first*** petition was CBM petition denied on CBM grounds).

Factor 2: The joinder petition copies the grounds in OpenSky's ***first*** petition. So, "at the time of filing of the first petition[s] the petitioner knew of the prior art asserted in the [later] petition." *GP*, 16-18. What is more, like the petition it seeks to join, it copies the grounds in ***Intel***'s own denied petition. When Intel's was filed in 2019, OpenSky knew of the art and grounds asserted, "or should have." *GP*, 9. While OpenSky "was not formed until after the Intel litigation verdict,… [its] members' knowledge before forming the entity is nonetheless relevant to [the *GP*] inquiry." IPR2021-01229, Paper 10, 9 (Jan. 26, 2022); *see GP*, 16-18; *HTC*, 10-12 (raising of grounds in earlier litigation favored denial, because petitioner "should have known" of basis of challenge for years, "instead of waiting … to join").

Factor 3 strongly favors denial. "[A]t the time of filing of [this] petition [OpenSky] already received the [POPR] to [its] first petition," ***and*** "the Board's decision on whether to institute review in the first petition." *GP*, 9; *HTC*, 11.

Factors 4 and 5: These factors "weigh whether a petitioner should have or

could have raised the new challenges earlier," *GP*, 18, and strongly favor denial. Intel's 00158 petition raising these grounds was denied institution over 1½ years ago. OpenSky is using delay of the review process as a tool for harassment. It waited until after the VLSI-Intel verdict to file its ***first*** challenge, even though the VLSI-Intel litigation was widely reported as "the first in-person patent jury trial in America" in months due to the escalating pandemic. *See LG Elecs., Inc., v. Bell N. Rsch., LLC*, IPR2020-00108, Paper 14, 8 (May 20, 2020) ("advanced state of a district court proceeding…weighs in favor of denying…Petition under § 314(a)."); Ex. 2005, 1; Ex. 2014, 1. OpenSky should have known about Intel's petition, and its denial, denial of rehearing, and appeals. Yet it waited until after the jury trial was over. Granting this request would reward OpenSky for waiting until after the Board denied the grounds ***and*** the patent experienced an Article III trial. *See Snap*, 17 (rejecting joinder request under *Fintiv* and *General Plastic* "where all remaining Challenged Claims have already been adjudicated by an Article III court."). Even if (especially if) those controlling OpenSky closed their eyes to events, they should not "be rewarded for delaying the filing of" their attacks. *NetApp Inc. v. Realtime Data LLC*, IPR2017-01196, Paper 10, 14 (Oct. 13, 2017).

Factors 6 and 7: "[T]he finite resources of the Board" and the § 316(a)(11) deadline favor denial. OpenSky's pledge "to participate as an understudy" to the extent of starting in "a second-chair role," Mot., 8-9, is not a pledge to not

participate at all, *id.*, 9-10. OpenSky's assertion that joinder raises "no new issues for the Board or parties to address," *id.*, 8, is untrue, as discussed in Section II.C.

D. *Fintiv* And The Totality Of The Circumstances Warrant Denial.

These grounds were already denied institution and rehearing under *Fintiv*. IPR2020-00158, Papers 17, 20-1, 20-2. The fact that the grounds are being re-raised in a joinder request now, by a newly-formed entity claiming to not be affiliated with Intel, after the claims have been through jury trial, is not a reason to change course. The totality of the circumstances and all *Fintiv* factors favor denial.

Factor 1 strongly favors denial. The district court trial concluded long ago.

Factor 2 also strongly favors denial. Any final written decision here would occur only ***years after the trial's verdict***. *See LG*, 8 (trial "ha[d] already started").

Factor 3: The "time invested by the parties and the district court" support denial. *LG*, 9. "As a matter of petition timing, ... it may impose unfair costs to a patent owner if the petitioner ... waits until the [parallel] district court trial has progressed significantly before filing a petition at the Office." *Fintiv*, 11. "If ... the evidence shows that the petitioner did not file the petition expeditiously, ... or even if the petitioner cannot explain the delay in filing its petition, these facts have favored denial." *Id.*, 11-12. Here, VLSI, the original petitioner of these grounds (Intel), and the district court invested enormous effort in a completed court trial, in which Intel—which knew these grounds' strengths and weaknesses better than

anyone—voluntarily dropped them from the case just before they reached the jury.

Factors 4-5: The "overlap between issues raised in the petition and in the parallel [district court] proceeding" is total. VLSI and Intel exchanged voluminous discovery on the '373's validity, including these grounds. Ex. 2007 (80+ pages of Intel expert report on this art and grounds); Ex. 2003 (70+ pages of rebuttal expert report). Intel elected to drop these grounds just before the jury was empaneled. Ex. 2004 [Counsel Email]. What matters is not whether Intel chose to ask the jury to decide the grounds, but "the extent to which ***the investment in the district court proceeding relates to issues of patent validity***." *LG*, 9 (emphasis added). And although OpenSky and Intel, the defendant in the jury trial, are not the same entity, it was Intel that originally presented these grounds to the Office, and OpenSky, like PQA in the case OpenSky seeks to join, merely selected and copied Intel's work, ensuring a significant relationship with Intel's petitions.

Factor 6: This "catch-all" factor "takes into account any other relevant circumstances." *LG*, 11. "Events in other proceedings related to the patent," "attempts to game the system," and whether "Petitioner's own conduct created the need for it to request joinder" affect whether it is fair to grant OpenSky's joinder request. *Proppant*, 19-20. The decision instituting PQA's 01229 petition, which OpenSky now seeks to join, rejected VLSI's *Fintiv*-based arguments. But that does not mean that this request, raising the same grounds yet again, should reach

the same result. *See Great W. Cas. Co. v. Intellectual Ventures II LLC*, IPR2016-01534, Paper 13 (Feb. 15, 2017) (denying joinder request, where "granting [a] fifth challenge against the same claims would be inequitable"). Quite simply, no public interest is served by allowing yet another newly formed entity, facing no threat of infringement, to further harass a prevailing patent owner in the hopes of extracting a payout, particularly one like OpenSky. As the Ranking Member of the Senate committee on intellectual property has commented, OpenSky is a "bad actor" (*see* Exs. 2025, 2026), and its extortion racket poses a substantial threat to the patent system. This sentiment is echoed by seven amici, including universities, public interest organizations, and law professors. Exs. 2030-2036. Such piling on by opportunistic parties facing no infringement risk and interested only in harassment should not be encouraged.

II. EVEN IF OPENSKY'S PETITION MAY OTHERWISE BE FOUND TO WARRANT INSTITUTION, JOINDER SHOULD BE DENIED.

Even if this petition warranted institution, which it does not as explained above, discretion should ***not*** be exercised to grant joinder under 35 U.S.C. § 315(c). *LG Elecs., Inc. v. ATI Techs. ULC*, IPR2015-01620, Paper 10, 5 (Feb. 2, 2016) (McNamara, J.) ("*ATI*") ("Joinder may be authorized when warranted, but the decision to grant joinder is discretionary."); 35 U.S.C. § 315(c); *Uniloc*, 4.

A. OpenSky's Delay Favors Denial Of Joinder.

While OpenSky filed its joinder motion within the one month permitted after

institution of PQA's IPR, delay still matters. There was nothing expedited about OpenSky's challenge, which arose only after the claims had been through a completed, highly publicized Article III trial—and after OpenSky already had a full opportunity to raise these grounds against these claims, did so, and was denied.

B. OpenSky's Reassertion Of Its Own Grounds Favors Denial.

OpenSky's grounds are the same as PQA's, as in all me-too petitions, but OpenSky already petitioned them once unsuccessfully. And OpenSky relies on much the same expert testimony as its first petition—which was denied on the basis that it failed to show that that testimony would not be excluded. *See supra*, 8.

C. Joinder Would Add Issues.

Joining OpenSky will add issues to PQA's case. *See ESET, LLC v. Finjan, Inc.*, IPR2017-01969, Paper 8, 8-10 (Jan. 9, 2018) (denying joinder that "would disrupt the progress of [first] proceeding by adding additional issues"). Aside from the evidentiary issues above, joinder may raise anew the question of OpenSky's relationship with Intel. *See ARM Ltd. v. AMD, Inc.*, IPR2018-01148, Paper 16, 7 (Dec. 12, 2018) ("As a result of the request for joinder, [the original] and [joinder petitioners] are real parties-in-interest to the joined proceeding"); *Unified Patents Inc. v. C-Cation Techs., LLC*, IPR2015-01045, Paper 15, 7 (Oct. 7, 2015) (denying joinder where it could add new RPI discovery disputes). Finally, OpenSky's offer to conduct sham litigation in proceedings relating to the VLSI-Intel trial raises a

hornet's nest of concerns. Joining OpenSky could greatly complicate this case.

D. There Is No Consent To Joinder.

"[T]he Office may consider ... [the] consent of the patent owner[]." *ATI*, 5. VLSI opposes joinder.[1] Nor does OpenSky assert that PQA consents to joinder.

III. CONCLUSION

The fears expressed by VLSI, Senator Tillis, and *amici* in OpenSky's instituted case of a threat to the integrity of the patent system from OpenSky's bad acts are becoming reality. OpenSky, trying to extract a payout, has now suggested in writing that VLSI and OpenSky "work together" to "defeat" OpenSky's instituted IPR against VLSI's other claims-at-trial, where OpenSky would collude to conduct sham litigation, and sabotage the record by refusing to produce (or even pay) Intel's expert witness, so no one joining the case can successfully litigate OpenSky's instituted grounds. At the same time, OpenSky requests discretionary institution and joinder to the instituted case of Patent Quality Assurance LLC—the very party whose joinder OpenSky seeks to sabotage in its own case. Even without these recent developments, but especially now that they have come to light, OpenSky's copycat, serial joinder petition should be denied institution and joinder.

[1] In no event should OpenSky be joined unless it promises to take no action in the case, absent specific "authorization from the Board." *GlobalFoundries U.S. Inc. v. Godo Kaisha IP Bridge I*, IPR2017-00919, Paper 12, 8-9 (June 9, 2017).

Respectfully submitted,

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Date: March 2, 2022

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following documents were served by electronic service, by consent, on the date signed below:

PATENT OWNER'S OPPOSITION
TO OPENSKY INDUSTRIES, LLC'S MOTION FOR JOINDER
TO *PAT. QUAL. ASSURANCE, LLC V. VLSI TECH. LLC*, IPR2021-01229

EXHIBITS 2003-2005, 2007, 2014, 2025, 2026, 2029-2036

The names and address of the parties being served are as follows:

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Respectfully submitted,

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Date: March 2, 2022