

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOSHIBA CORPORATION AND TOSHIBA MEMORY
CORPORATION,
Petitioner,

v.

LONE STAR SILICON INNOVATIONS, LLC,
Patent Owner.

Case IPR2018-00081
Patent 5,912,188

Before GRACE KARAFFA OBERMANN,
JENNIFER MEYER CHAGNON, and ELIZABETH M. ROESEL,
Administrative Patent Judges.

ROESEL, *Administrative Patent Judge.*

DECISION

Granting Institution of *Inter Partes* Review
37 C.F.R. § 42.108

Granting Petitioner's Unopposed Motion for Joinder
37 C.F.R. § 42.122

I. INTRODUCTION

Toshiba Corporation and Toshiba Memory Corporation (collectively, “Petitioner” or “Toshiba”) filed a Petition requesting *inter partes* review of claims 1–5, 7–13, 15–23, and 25–29 of U.S. Patent No. 5,912,188 (Ex. 1001, “the ’188 patent”). Paper 1 (“Pet.”). Petitioner subsequently filed a Motion for Joinder requesting that Petitioner be joined as a party to *Micron Technology, Inc. v. Lone Star Silicon Innovations, LLC*, IPR2017-01560. Paper 7 (“Joinder Motion” or “Joinder Mot.”). Petitioner represents that Patent Owner (Lone Star Silicon Innovations, LLC) does not oppose Petitioner’s Joinder Motion, subject to certain procedural conditions agreed upon by both parties.

At Petitioner’s request, a conference call regarding the Joinder Motion was conducted on January 18, 2018, among Michael Burns, counsel for Petitioner; Nicholas Peters and David Gosse, counsel for Patent Owner; Jeremy Jason Lang, counsel for Micron Technology, Inc. (“Micron”), Petitioner in IPR2017-01560; and Administrative Patent Judges Obermann, Chagnon, and Roesel.

Following the conference call, Patent Owner filed a paper waiving a preliminary response to the Petition in view of the Joinder Motion. Paper 8.

II. DISCUSSION

A. *The Petition*

Petitioner represents that the Petition “challenges the same claims of the ’188 Patent using the same grounds” as Micron’s petition in IPR2017-01560. Joinder Mot. 2. Petitioner further represents that the Petition is “substantially identical” to Micron’s petition and “presents no new issues.” *Id.*; *see also id.* at 1 n.2 (acknowledging that the petitions differ with respect

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to identification of “petitioners, real parties in interest, related matters, and the like”).

Petitioner states that it relies on the same expert and the same expert declaration as filed Micron’s petition in IPR2017-01560. *Id.* at 4. More specifically, Petitioner states that it refiled the declaration prepared and filed by Micron in IPR2017-01560. *Id.* at 6 n.3.

As noted above, Patent Owner waived a Preliminary Response to the Petition. Paper 8.

During the January 18th conference call, Petitioner represented that it seeks joinder and institution only as to the grounds of unpatentability that were instituted in IPR2017-01560.

On the question of whether to institute *inter partes* review based on the Petition, we incorporate our analysis from our institution decision in IPR2017-01560. IPR2017-01560, Paper 10 (“Dec.”), 4–33. For the same reasons, we conclude that Petitioner has demonstrated a reasonable likelihood of prevailing on the following grounds of unpatentability:

Claims 1–5, 8–13, 15, 18, and 19 as obvious in view of Hashimoto; and

Claim 20 as obvious in view of Hashimoto and Sung.

Dec. 4–26; Pet. 28–62. Because Petitioner does not seek institution based on the grounds not instituted in IPR2017-01560 and for the same reasons as stated in our institution decision in IPR2017-01560 (Dec. 26–32), we do not institute review of claims 7, 16, 17, 21–23, and 25–29.

B. Motion for Joinder

Based on authority delegated to us by the Director, we have discretion to join a party to another *inter partes* review, subject to certain exceptions

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not present here. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. As the moving party, Petitioner has the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b). A motion for joinder should: (1) set forth the reasons why joinder is appropriate; (2) identify any new ground(s) of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address how briefing and/or discovery may be simplified to minimize schedule impact. *See* Joinder Mot. 3; *Kyocera Corp. v. SoftView LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15) (representative).

Here, Petitioner represents that the Petition is “substantially identical” to Micron’s petition in IPR2017-01560 and challenges the same claims of the ’188 patent based on the same grounds and the same declaration testimony as Micron’s petition in IPR2017-01560. Joinder Mot. 1, 2, 4, 6 n.3. Furthermore, during the January 18th conference call, Petitioner represented that it seeks joinder only as to the grounds that were instituted in IPR2017-01560. Petitioner argues that, “since the grounds and prior art are identical to those instituted in IPR2017-01560, there are no new issues for Patent Owner to address.” *Id.* at 5.

Petitioner further represents that, if joined as a petitioner, it would take an “understudy” role in the proceeding. Joinder Mot. 1, 5, 6. More specifically, Petitioner represents that Patent Owner does not oppose Petitioner’s Joinder Motion, subject to the following conditions, which Petitioner accepts: (1) the schedule in IPR2017-01560 remains in place; and (2) Petitioners’ participation in briefing, depositions, and oral argument is limited to sharing the briefing and time allotted to Micron in IPR2017-

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01560. *Id.* at 2, 3, 5. During the January 18th conference call, Patent Owner confirmed that it does not oppose joinder under the conditions set forth in Petitioner’s Joinder Motion. Micron stated that it does not object to joinder or to the conditions agreed upon by Petitioner and Patent Owner.

Petitioner further represents that, because its Petition relies upon the same declarant (Dr. Fair) as Micron’s petition in IPR2017-01560, joinder “will allow for common discovery with regard to Dr. Fair (e.g., a common date for depositions).” Joinder Mot. 6. In addition, Petitioner represents that “so long as Micron maintains its IPR, all filings by Petitioner[] in the joined proceeding will be consolidated with the filings of Micron, unless a filing solely concerns issues that do not involve Micron.” *Id.* Petitioner agrees not to introduce any argument or discovery not introduced by Micron. *Id.* Petitioner also agrees to allow counsel for Micron to conduct the examination of any Patent Owner witness and to defend any common witness at any depositions in the joined proceeding. *Id.* at 6–7. During the January 18th conference call, Micron stated that it agrees to Petitioner’s request to attend depositions.

Based on its representations in the Joinder Motion, Petitioner argues “[t]he requested joinder here will serve to secure the just, speedy, and inexpensive resolution of these proceedings.” Joinder Mot. 4. Petitioner additionally argues that joinder should not have any impact on the trial schedule and will simplify briefing and discovery in IPR2017-01560. *Id.* at 4, 6.

Based on Petitioner’s representations in the Joinder Motion and the representations of Petitioner, Patent Owner, and Micron during the January 18th conference call, as summarized above, we determine that Petitioner has

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