

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STMICROELECTRONICS, INC.,
Petitioner,

v.

LONE STAR SILICON INNOVATIONS, LLC,
Patent Owner.

Case IPR2018-00435
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
Granting Petitioner's Unopposed Motion for Joinder
35 U.S.C. § 314(a); 37 C.F.R. § 42.122

I. INTRODUCTION

STMicroelectronics, Inc. (“Petitioner” or “STMicro”) 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 2 (“Petition” or “Pet.”). Concurrent with its Petition, Petitioner 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 3 (“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. Joinder Mot. 2. Patent Owner waived a preliminary response to the Petition in view of the parties’ stipulation regarding conditions for joinder. Paper 6.

This is the second time a party has sought to join Case IPR2017-01560. In Case IPR2017-00081, we granted a motion for joinder filed by Toshiba Corporation and Toshiba Memory Corporation (collectively, “Toshiba”), and Toshiba has been joined as a party to Case IPR2017-01560. IPR2017-01560, Paper 11.

II. DISCUSSION

A. *The Petition*

Petitioner represents that the Petition is “substantially identical” to Micron’s petition in IPR2017-01560 and contains “the same grounds (based on the same prior art combinations and supporting evidence) against the same claims.” Joinder Mot. 1. Petitioner further represents that the Petition “challenges the same claims of the same patent, relies on the same expert declaration, and is based on the same grounds and combinations of prior art” as the Micron Petition. *Id.* at 5. Petitioner submits a redline comparison

IPR2018-00435
Patent 5,912,188

between the Petition and Micron's Petition in IPR2017-01560. Ex. 1021. Exhibit 1021 is consistent with Petitioner's representation that the petitions are substantially identical.

As noted above, Patent Owner waived a Preliminary Response to the Petition. Paper 6.

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, 4–33. For the same reasons, we conclude that Petitioner has demonstrated a reasonable likelihood that it would establish that at least one of the challenged claims of the '188 patent is unpatentable. Furthermore, we incorporate our order modifying our IPR2017-01560 Decision in view of *SAS Inst. Inc. v. Iancu*, No. 16-969, 2018 WL 1914661 (U.S. Apr. 24, 2018) to institute on all of the challenged claims on all of the grounds presented in Micron's petition in IPR2017-01560. IPR2017-01560, Paper 17. Although the Joinder Motion states "STMicro seeks institution only as to the grounds of invalidity already instituted by the Board in the Micron IPR," the Petition challenges the same claims on the same grounds as asserted by Micron in IPR2017-01560. We interpret STMicro's statement as seeking institution with respect to all claims and all grounds as have been instituted in IPR2017-01560.

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 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

IPR2018-00435
Patent 5,912,188

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. 4; *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, 5, 7. Petitioner argues that “joinder with the Micron IPR is appropriate because the STMicro Petition introduces identical arguments and the same grounds raised in the existing Micron proceeding.” *Id.* at 5.

Petitioner further represents that, if joined as a petitioner, it would take an “understudy” role in the proceeding. Joinder Mot. 2, 4, 7, 8. 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 IPR2017-01560. *Id.* at 2, 7–8; *see also* Paper 6, 1.

Petitioner represents that “so long as Micron remains an active party in IPR2017-01560, all filings by Petitioner in the joined proceeding will be consolidated with the filings of Micron, unless a filing solely concerns issues that involve only STMicro.” Joinder Mot. 8. Petitioner agrees not to

IPR2018-00435
Patent 5,912,188

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.*

Based on its representations in the Joinder Motion, Petitioner argues that its request for joinder is consistent with the just, speedy, and inexpensive resolution of *inter partes* reviews. Joinder Mot. 1, 5–6. 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 6, 7.

Based on Petitioner’s representations in the Joinder Motion and the representations of Patent Owner in its paper waiving a preliminary response (Paper 6), as summarized above, we determine that Petitioner has met its burden to show that joinder of Petitioner as a party in IPR2017-01560 is appropriate. We rely in particular, on Petitioner’s representation that its Petition is “substantially identical” to the petition in IPR2017-01560 and challenges the same claims based on the same prior art and the same grounds of unpatentability as are already asserted in IPR2017-01560. We also rely on Petitioner’s agreement that the existing schedule IPR2017-01560 will remain in place and that its participation in the joined proceeding will be limited to an “understudy” role. We also rely on Petitioner’s representation that Patent Owner does not oppose Petitioner’s Joinder Motion subject to certain procedural conditions and on Patent Owner’s representation that it agrees to these procedural conditions for joinder. Under these circumstances, we conclude that Petitioner has demonstrated that joinder of Petitioner as a party to IPR2017-01560 will secure the just, speedy, and

Explore Litigation Insights

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

Real-Time Litigation Alerts



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

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

Advanced Docket Research



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

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

Analytics At Your Fingertips



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

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

API

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

LAW FIRMS

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

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

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.