UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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STMICROELECTRONICS, INC.,
Petitioner,

v.

MONTEREY RESEARCH, LLC,
Patent Owner.

_____

Case IPR2021-00355
Patent 6,651,134 B1

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Before KRISTEN L. DROESCH, JOHN F. HORVATH, 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

Petitioner, STMicroelectronics, Inc., filed a Petition (Paper 1, "Pet.") requesting *inter partes* review of claims 1–21 of U.S. Patent No. 6,651,134 B1 (Ex. 1001, "the '134 patent"). Patent Owner, Monterey Research, LLC, did not file a Preliminary Response.

Petitioner also filed a Motion for Joinder to join as a petitioner in IPR2020-00985. Paper 3 ("Mot."). Petitioner filed the Petition and Motion for Joinder on December 23, 2020, within one month after we instituted trial in IPR2020-00985.

As explained further below, we determine institution is warranted on the same grounds as in IPR2020-00985 and grant Petitioner's Motion for Joinder.

A. RELATED MATTERS

As required by 37 C.F.R. § 42.8(b)(2), Petitioner identifies a district-court proceeding in which the '134 patent is asserted against Petitioner, *Monterey Research, LLC v. STMicroelectronics, Inc.*, Case No. 20-0089-NIQA-LAS (D. Del.). Pet. 4. Patent Owner identifies that case along with others asserting the '134 patent. Paper 4, 1. Patent Owner also notes that the '134 patent is the subject of IPR2020-00985 and IPR2020-01492.[1] *Id.*

B. IPR2020-00985

In IPR2020-00985, Advanced Micro Devices, Inc. ("AMD") challenged claims 1–21 of the '134 patent. We instituted review. *Advanced*

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[1] Patent Owner also includes IPR2021-00167 in its list of related matters. Paper 4, 1. We declined to institute review in that proceeding. IPR2021-00167, Paper 7.

Micro Devices, Inc. v. Monterey Research, LLC, IPR2020-00985 (PTAB Dec. 2, 2020) (Paper 13, "AMD Inst."). The instituted review in IPR2020-00985 involves the following grounds of unpatentability:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–3, 8, 12, 13, 16, 17	102	Wada[2]
1–4, 8, 12–14, 16, 17	103	Wada
1–4, 8, 12–14, 16, 17	103	Wada, Barrett[3]
4–7, 18–20	103	Wada, Fujioka[4]
4–7, 18–20	103	Wada, Barrett, Fujioka
9–10, 14, 21	103	Wada, Reeves[5]
9–10, 14, 21	103	Wada, Barrett, Reeves
11, 15	103	Wada, Lysinger[6]
11, 15	103	Wada, Barrett, Lysinger

AMD Inst. 6–7. AMD also relied on the Declaration of Dr. Jacob Baker, Ph.D., P.E. (IPR2020-00985, Ex. 1002). *See id.* at 7.

II. DISCUSSION

Petitioner's Motion for Joinder states that, in this proceeding, the "Petition and supporting expert declaration are substantively identical to the petition and expert declaration submitted in the AMD IPR."[7] Mot. 1; *accord*

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[2] U.S. Patent No. 6,115,280 (Ex. 1005).
[3] U.S. Patent No. 5,584,033 (Ex. 1010).
[4] U.S. Patent No. 6,185,149 (Ex. 1006).
[5] U.S. Patent No. 6,226,755 (Ex. 1008).
[6] U.S. Patent No. 5,748,331 (Ex. 1009).
[7] The AMD IPR refers to IPR2020-00985.

id. ("Petitioner here asserts that the same claims are anticipated and/or obvious over the same prior art based on the same arguments supported by the same expert as in the AMD IPR."). Patent Owner did not file a Preliminary Response in this proceeding. Thus, for the same reasons stated in our Decision on Institution in IPR2020-00985, we determine institution is warranted here. *See generally* AMD Inst.

Having determined that institution is warranted, we consider Petitioner's Motion for Joinder. Section 315(c) provides, in relevant part, that "[i]f the Director institutes an inter partes review, 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." 35 U.S.C. § 315(c). When determining whether to grant a motion for joinder, we consider factors such as timing and impact of joinder on the trial schedule, cost, discovery, and potential simplification of briefing. *See Kyocera Corp. v. SoftView, LLC*, IPR2013-00004, Paper 15, 4 (PTAB Apr. 24, 2013).

Under the circumstances of this case, we determine that joinder is appropriate. Because the present Petition does not include any issues beyond those in IPR2020-00985, it will have minimal impact on that proceeding. Petitioner agrees "to take an 'understudy' role if joined." Mot. 1; *accord id.* at 5. In that role, Petitioner requests no changes to the schedule of IPR2020-00985. *Id.* at 5. Further, Petitioner relies on the same declaration testimony as the petitioner in IPR2020-00985, so Petitioner asserts that "joinder will eliminate duplicative expert discovery and trial testimony." *Id.* at 6. Patent Owner did not file an opposition to the joinder motion.

Under these circumstances, we agree with Petitioner that joinder is appropriate and will not unduly impact the ongoing trial in IPR2020-00985.

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We limit Petitioner STMicroelectronics's participation in IPR2020-00985, such that (1) AMD alone is responsible for all petitioner filings in the joined proceeding until such time that it is no longer an entity in the joined proceeding, and (2) STMicroelectronics is bound by all filings by AMD in the joined proceeding, except for (a) filings regarding termination or settlement and (b) filings where STMicroelectronics receives permission to file an independent paper. STMicroelectronics must obtain prior Board authorization to file any paper or to take any action on its own in the joined proceeding, so long as AMD remains as a non-terminated petitioner in the joined proceeding. This arrangement promotes the just and efficient administration of the ongoing trial in IPR2020-00985 and protects the interests of AMD, as original petitioner in that proceeding, and of Patent Owner.

For the foregoing reasons, and with the limitations discussed above, Petitioner's Motion for Joinder is *granted*.

III.   ORDER

Accordingly, it is:

ORDERED that *inter partes* review of claims 1–21 of the '134 patent is instituted on the grounds in the Petition;

FURTHER ORDERED that Petitioner's Motion for Joinder with IPR2020-00985 is granted, and STMicroelectronics, Inc., is joined as petitioner in that case pursuant to 37 C.F.R. § 42.122, based on the conditions discussed above;

FURTHER ORDERED that the Scheduling Order in place for IPR2020-00985 (Paper 14) shall govern the joined proceeding;

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