

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STMICROELECTRONICS, INC.,
Petitioner,

v.

MONTEREY RESEARCH, LLC,
Patent Owner.

Case IPR2021-00702
Patent 6,651,134 B1

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 1–7 and 9–21 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 IPR2020-01492. Paper 3 (“Mot.”). Petitioner filed the Petition and Motion for Joinder on April 2, 2021, within one month after we instituted trial in IPR2020-01492 (March 8, 2021).

As explained further below, we determine institution is warranted on the same grounds as in IPR2020-01492 and grant Petitioner’s Motion for Joinder.

A. RELATED MATTERS

As required by 37 C.F.R. § 42.8(b)(2), the parties identify a district-court proceeding in which the ’134 patent is asserted against Petitioner, *Monterey Research, LLC v. STMicroelectronics NV et al.*, Case No. 1:20-00089 (D. Del.). Pet. 4; Paper 4, 1. They additionally identify others asserting the ’134 patent. Pet. 3–4; Paper 4, 1. They further note that the ’134 patent is the subject of IPR2020-00985 and IPR2020-01492. Pet. 4, Paper 4, 2.

B. IPR2020-01492

In IPR2020-01492, Qualcomm, Inc. challenged claims 1–7 and 9–21 of the ’134 patent. We instituted review. *Qualcomm, Inc. v. Monterey Research, LLC*, IPR2020-01492 (PTAB Mar. 8, 2021) (Paper 9, “Qualcomm

Inst.”). The instituted review in IPR2020-01492 involves the following grounds of unpatentability:

Claim(s) Challenged	35 U.S.C. §	References/Basis
1–5, 7, 9, 10, 12–18, 20, 21	102	Schaefer ¹
1–7, 9, 10, 12–21	103	Schaefer, Fujioka ²
11	103	Schaefer, Lysinger ³
11	103	Schaefer, Lysinger, Fujioka

Qualcomm Inst. 6. Qualcomm also relied on the Declaration of Robert Murphy (IPR2020-01492, Ex. 1015). *See id.*

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 Qualcomm IPR.”⁴ Mot. 1; *accord 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 Qualcomm IPR.”). Patent Owner did not file a Preliminary Response in this proceeding. Thus, for the same reasons stated in our Decision on Institution in IPR2020-01492, we determine institution is warranted here. *See generally* Qualcomm Inst.

Having determined that institution is warranted, we consider Petitioner’s Motion for Joinder. Section 315(c) provides, in relevant part,

¹ U.S. Patent No. 5,600,605 (Ex. 1017).

² U.S. Patent No. 6,185,149 (Ex. 1006).

³ U.S. Patent No. 5,784,331 (Ex. 1009).

⁴ The Qualcomm IPR refers to IPR2020-01492.

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 IPR2020-01492, 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 IPR2020-01492. *Id.* at 5. Further, Petitioner relies on the same declaration testimony as the petitioner in IPR2020-01492, and “will not be involved” in briefing or discovery unless Qualcomm exits the proceeding. *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 IPR2020-01492. We limit Petitioner STMicroelectronics’s participation in IPR2020-01492, such that (1) Qualcomm 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 Qualcomm 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

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the joined proceeding, so long as Qualcomm remains as a non-terminated petitioner in the joined proceeding. This arrangement promotes the just and efficient administration of the ongoing trial in IPR2020-01492 and protects the interests of Qualcomm, 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 1–7 and 9–21 of the '134 patent is instituted on the grounds stated in the Petition;

FURTHER ORDERED that Petitioner's Motion for Joinder with IPR2020-01492 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 IPR2020-01492 (Paper 11) shall govern the joined proceeding;

FURTHER ORDERED that all future filings in the joined proceeding shall be made only in IPR2020-01492;

FURTHER ORDERED that the case caption in IPR2020-01492 for all further submissions shall be changed to add STMicroelectronics, Inc., as a named Petitioner after Qualcomm and to indicate by footnote the joinder of STMicroelectronics to IPR2020-01492, as indicated in the attached sample case caption; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2020-01492.

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