

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STMICROELECTRONICS, INC.,

Petitioner,

v.

MONTEREY RESEARCH, LLC,

Patent Owner.

Case No. IPR2021-00702

U.S. Patent No. 6,651,134

MOTION FOR JOINDER TO *INTER PARTES* REVIEW IPR2020-01492

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I. STATEMENT OF PRECISE RELIEF REQUESTED

Petitioner STMicroelectronics, Inc. (“Petitioner” or “ST”) moves for joinder of its contemporaneously-filed Petition for *Inter Partes* Review (“IPR”) of claims 1-7 and 9-21 of U.S. Patent No. 6,651,134 (“the ’134 patent”) with a pending IPR, *Qualcomm, Inc. v. Monterey Research, LLC*, IPR2020-01492 (“the Qualcomm IPR” or “the Qualcomm proceeding”), which the Board instituted on March 8, 2021.

The Qualcomm IPR concerns the same patent and the same claims as ST’s Petition. ST’s Petition and supporting expert declaration are substantively identical to the petition and expert declaration submitted in the Qualcomm IPR. 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.

Petitioner agrees to take an “understudy” role if joined. Joinder will not cause any delay in the resolution of the Qualcomm IPR. The Qualcomm IPR petitioner and Patent Owner do not oppose this motion. Joinder, therefore, is appropriate because it will resolve the same patentability issues of the same patent, it will not delay the schedule that the Board has issued in the Qualcomm IPR, and the parties in the Qualcomm IPR will not be prejudiced.

II. STATEMENT OF MATERIAL FACTS

1. Monterey Research, LLC (“Patent Owner”) purports to own the ’134 patent.

2. Patent Owner has asserted the ’134 patent against Petitioner, the Qualcomm IPR petitioner, and others in co-pending lawsuits in the District of Delaware: *Monterey Research, LLC v. STMicroelectronics, Inc.*, Case No. 20-0089-NIQA-LAS (D. Del.); *Monterey Research, LLC v. Advanced Micro Devices, Inc.*, No. 1:19-cv-02149-NIQA (D. Del.); *Monterey Research, LLC v. Qualcomm Inc.*, No. 1:19-cv-02083-NIQA (D. Del.); *Monterey Research, LLC v. Nanya Tech. Corp.*, No. 1:19-cv-02090-NIQA (D. Del.); *Monterey Research, LLC v. Marvell Tech. Grp. Ltd.*, No. 1:20-cv-00158-NIQA (D. Del.).

3. On August 20, 2020, Qualcomm filed the Qualcomm IPR, requesting cancellation of claims 1-7 and 9-21 of the ’134 patent. IPR2020-01492, Paper 1.

4. On December 10, 2020, Patent Owner filed a Preliminary Response. IPR2020-01492, Paper 6.

5. On March 8, 2021, the Board instituted the Qualcomm IPR as to claims 1-7 and 9-21 and entered a Scheduling Order. IPR2020-01492, Papers 9 and 11.

6. The Board previously instituted review as to claims 1-21 of the ’134 patent in a separate proceeding. *See Advanced Micro Devices, Inc. v. Monterey*

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