

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLIED MATERIALS, INC.,
Petitioner,

v.

OCEAN SEMICONDUCTOR LLC,
Patent Owner.

IPR2021-01342 (Patent 6,968,248 B1)
IPR2021-01344 (Patent 6,907,305 B2)

Before MIRIAM L. QUINN, JOHN D. HAMANN, and DAVID COTTA,
Administrative Patent Judges.

QUINN, *Administrative Patent Judge.*

JUDGMENT

Consolidated Final Written Decision
Determining All Challenged Claims Unpatentable
Granting-in-part Petitioner's Motion to Strike
35 U.S.C. § 318(a); 37 C.F.R. §§ 42.20, 42.23(b)

I. INTRODUCTION

We instituted *inter partes* review pursuant to 35 U.S.C. § 314 to review claims 1–22 of U.S. Patent No. 6,968,248 B1 (“the ’248 patent”) and to review claims 1–25 and 33–53 of U.S. Patent No. 6,907,305 B2 (“the ’305 patent”) owned by Ocean Semiconductor LLC (“Patent Owner”). We have jurisdiction under 35 U.S.C. § 6(c). This Consolidated Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 47.73. For the reasons discussed below, Applied Materials, Inc. (“Petitioner”) has shown by a preponderance of the evidence that all the challenged claims of the ’248 and ’305 patents are unpatentable.

II. CONSOLIDATION OF PROCEEDINGS

The two captioned proceedings (IPR2021-01342¹ and IPR2021-01344²) involve related patents. The 1342 IPR involves the ’248 patent,³ which is a continuation of the ’305 patent,⁴ involved in the 1344 IPR. Both of these patents have a common disclosure. The proceedings have the same asserted prior art, present the same expert testimony, and involve the same threshold issues. For instance, the arguments presented by Patent Owner for both proceedings are identical as they primarily focus on limitations recited in the independent claims, which recite substantively identical subject matter. Given the significant overlap of arguments and evidence across both proceedings, consolidation is appropriate because the Board can more efficiently handle the common issues and evidence, and also remain

¹ Hereinafter referred to as “the 1342 IPR.”

² Hereinafter referred to as “the 1344 IPR.”

³ Filed as Exhibit 1001 in the 1342 IPR.

⁴ Filed as Exhibit 1001 in the 1344 IPR, and as Exhibit 1002 in the 1342 IPR.

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consistent across proceedings. Under 35 U.S.C. § 315(d), the Director may determine the manner in which these pending proceedings may proceed, including “providing for stay, transfer, consolidation, or termination of any such matter or proceeding.” *See also* 37 C.F.R. § 42.4(a) (“The Board institutes the trial on behalf of the Director.”). And more specifically, Rule 122(a) specifically authorizes the Board to consolidate multiple proceedings involving the patent that is before the Office. 37 C.F.R. § 42.122(a). Out of an abundance of caution, and because the proceedings do not involve the same patent, the Board inquired whether the parties object to consolidation and neither party raised objections to consolidation of these proceedings. Tr. 33:6–13. Therefore, for a more efficient disposition of these proceedings, we consolidate the 1342 IPR and 1344 IPR for rendering this consolidated Final Written Decision.

III. BACKGROUND

Petitioner filed the 1342 and 1344 petitions requesting *inter partes* review as follows:

(a) in the 1342 IPR, Petitioner requested review of claims 1–22 of the ’248 patent (1342 IPR, Paper 1 (“1342 Pet.”)); and

(b) in the 1344 IPR, Petitioner requested review of claims 1–25, 33–53 of the ’305 patent (1344 IPR, Paper 1 (“1344 Pet.”)).

Patent Owner filed a Preliminary Response in both proceedings, presenting substantially the same arguments. IPR2021-01342, Paper 10; IPR2021-01344, Paper 10. After considering the merits of the Petition and the arguments presented against institution by Patent Owner, we instituted *inter partes* review. 1342 IPR, Paper 17 (“1342 Dec. on Inst.”); 1344 IPR, Paper 17 (“1344 Dec. on Inst.”).

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During the trial phase, Patent Owner filed a substantively identical Response in each proceeding. 1342 IPR, Paper 21 (“1342 PO Resp.”); 1344, Paper 21 (“1344 PO Resp.”). Petitioner filed a Reply in each proceeding. 1342 IPR, Paper 30 (“1342 Reply”); 1344 IPR, Paper 30 (“1344 Reply”). Subsequently, Patent Owner filed a Sur-reply in each proceeding. 1342 IPR, Paper 41 (“1342 Sur-reply”); 1344 IPR, Paper 41 (“1344 Sur-reply”).⁵

During trial, Petitioner filed a Motion to Strike seeking exclusion of certain Patent Owner Sur-reply arguments. 1342 IPR, Paper 46; 1344 IPR, Paper 46 (hereinafter referred to as “Motion” or “Mot.” because the Motion is identical in both proceedings). Patent Owner opposes the Motion. 1342 IPR, Paper 49; 1344 IPR, Paper 49 (hereinafter referred to as “Opposition” or “Opp.” because the Opposition is substantively identical in both proceedings). Petitioner filed a reply responding to Patent Owner’s arguments in opposition. 1342 IPR, Paper 53; 1344 IPR, Paper 53 (hereinafter referred to as “Reply to Opposition” or “Reply to Opp.” because the Reply to Opposition is identical in both proceedings).

A single oral argument was held for both captioned proceedings, the transcript of which is filed in the record. 1342 IPR, Paper 60 (“Tr.”) (identical copy filed as Paper 58 in the 1344 IPR).

A. Related Matters

The parties indicate that the ’248 and ’305 patents have been asserted in the following proceedings: *Ocean Semiconductor LLC v. Analog Devices*, No. 1:20-cv-12310 (D. Mass); *Ocean Semiconductor LLC v.*

⁵ These are titled “Amended Sur-reply” because after filing the initial Sur-reply, Patent Owner sought leave to update its brief with citations to the final transcript of the deposition of Dr. Shanfield. Ex. 2044 (dated September 22, 2022). We refer to the Amended Sur-reply throughout this proceeding.

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Infineon, No. 1:20-cv-12311 (D. Mass.); *Ocean Semiconductor LLC v. Huawei*, No. 4:20-cv-911 (E.D. Tex.); *Ocean Semiconductor LLC v. MediaTek*, No. 6:20-cv-1210 (W.D. Tex.); *Ocean Semiconductor LLC v. NVIDIA*, No. 6:20-cv-1211 (W.D. Tex.); *Ocean Semiconductor LLC v. NXP*, No. 6:20-cv-1212 (W.D. Tex.); *Ocean Semiconductor LLC v. Renesas*, No. 6:20-cv-1213 (W.D. Tex.); *Ocean Semiconductor LLC v. Silicon Labs*, No. 6:20-cv-1214 (W.D. Tex.); *Ocean Semiconductor LLC v. ST Micro*, No. 6:20-cv-1215 (W.D. Tex.); and *Ocean Semiconductor LLC v. Western Digital*, No. 6:20-cv-1216 (W.D. Tex.). 1342 Pet. 1–2; Paper 5, 2; 1344 Pet. 1–2; Paper 5, 2.

B. The Challenged Patents

The '305 patent issued from U.S. App. No. 10/135,145 (“parent ’145 application”) filed April 30, 2002. 1342 IPR, Ex. 1002 (the '305 patent, which is also filed as Ex. 1001 in the 1344 IPR).⁶ The '248 patent issued from U.S. App. No. 11/151,098 (“’098 application”), which claims priority to the parent ’145 application. Ex. 1001 (the '248 patent); Ex. 1002.

1. Prosecution History

During the prosecution of the parent ’145 application, the Examiner found all pending claims anticipated or obvious in view of U.S. Patent No. 5,444,632 (“Kline”), which discloses a method and a computer system with a scheduler module in an automated manufacturing environment. 1342 IPR, Ex. 1006, 152–54. In response, the Applicant argued that Kline fails to teach that its wafer specification module is “anything other than an information provider.” Ex. 1006, 164. The Applicant also argued that Kline

⁶ Hereinafter, all citations refer to the papers and exhibits filed in the 1342 IPR, unless stated otherwise.

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