IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STMICROELECTRONICS, INC.

Petitioner,

v.

OCEAN SEMICONDUCTOR LLC,

Patent Owner.

IPR2022-00681

U.S. Patent No. 6,968,248

REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

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Ocean advances two arguments in its preliminary response, but one is moot and the other is meritless. Ocean first conditions its non-opposition to joinder on ST's petition not "contain[ing] any arguments different from the Petition in the AMAT IPR." Paper 7 at 6-7. Ocean does not dispute, however, that ST's petition includes no new arguments. Paper 7 at 3; Paper 3 at 4-5. Of course, after joinder ST reserves the right to respond to Ocean's arguments if Applied Materials exits IPR2021-01342 before the Board issues a final written decision and ST therefore assumes a "primary" rather than "understudy" role in that IPR. Paper 3 at 5-6.

Second, Ocean argues the Board "must ***not***" permit ST to proceed as the petitioner in IPR2021-01342 should Applied Materials withdraw because doing so would "flout multiple Federal statutes, P.T.A.B. precedential opinions, and Supreme Court precedent." Paper 7 at 6 (emphasis in original). That is wrong. To begin, ST has followed the controlling statutes and regulations for IPR joinder. ST properly filed a petition and motion for joinder within one month of the institution date of the AMAT IPR. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b). Ocean concedes as much. Paper 7 at 6. And while Ocean suggests ST did something untoward regarding the one-year bar imposed by 35 U.S.C. § 315(b) and 37 C.F.R. § 42.101(b), both the statute and the rule explicitly note that the bar does not apply to joinder. 35 U.S.C. § 315(b) ("The time limitation set forth in the preceding sentence **shall not apply to a request for joinder** under subsection

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(c).") (emphasis added); 37 C.F.R. § 42.122(b) ("The time period set forth in § 42.101(b) **shall not apply** when the petition is accompanied by **a request for joinder**.") (emphasis added). In moving for joinder, ST complied with the law.

By contrast, Ocean asks the Board to depart from controlling statutes and regulations and create a new rule that a joined petitioner otherwise time-barred under § 315(b) must "be ordered to withdraw its asserted Grounds" if the original petitioner exits a joined IPR. Paper 7 at 6-7. That is not what the IPR statutes and regulations provide; nor is there any support for Ocean's proposal in the statutory framework relating to IPRs. Ocean has invented the concept in an attempt to limit ST's rights to proceed with IPR2021-01342 if Applied Materials withdraws. Congress placed no such limits on joined petitioners, and Ocean cannot unilaterally add the requirement to the rules.

Moreover, Ocean has cited to case law that does not support its position that, as a precondition for joinder, ST must withdraw from IPR2021-01342 if Applied Materials withdraws. Ocean relies heavily on and quotes from *Apple Inc. v. UNILOC 2017 LLC*, IPR2020-00854, Paper 9 (PTAB Oct. 28, 2020), but omits critical text from its quotation. Specifically, Ocean leaves out the text in bold below, including through use of a carefully placed ellipsis.

> Petitioner's understudy argument is not persuasive here where **the copied petition is Petitioner's second chal-**

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> **lenge to the patent, and** should Microsoft settle, Petitioner would stand in to continue a proceeding that would otherwise be terminated. **In effect, it would be as if Apple had brought the second challenge to the patent in the first instance. This is the kind of serial attack that *General Plastic* was intended to address.**"

Apple, IPR2020-00854, Paper 9 at 4; Paper 7 at 4-5. Ocean fails to mention that, unlike ST here, Apple had earlier filed an unsuccessful first petition before submitting a second petition and request to join an instituted IPR on the same patent. *Apple*, IPR2020-00854, Paper 9 at 5-7. For that reason, the Board denied institution based on *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017)—a decision that Ocean cites in its preliminary response (Paper 7 at 4). *Apple*, IPR2020-00854, Paper 9 at 8-13. The driving force behind the decision in *Apple* (and in *General Plastic*) was the existence of serial attacks by the same petitioner on the same patent, not the fact that proceedings would continue rather than terminate if joinder was granted, as Ocean suggests. Paper 7 at 4-5. Here, ST has filed just one petition regarding the '248 patent so the concern at play in *Apple* and *General Plastic* is absent. Further, *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018), which Ocean also cites, is irrelevant. Paper 7 at 5. It says nothing about joinder.

ST requests institution and joinder without Ocean's conditions.

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Respectfully submitted,

/ Tyler R. Bowen /

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