UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STMicroelectronics, Inc.,

Petitioner

v.

Ocean Semiconductor LLC,

Patent Owner

Case IPR2022-00681
Patent No. 6,968,248

PATENT OWNER'S AUTHORIZED SUR-REPLY PURSUANT TO THE BOARD'S JUNE 23, 2022 ORDER

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
Submitted Electronically via PTAB E2E

TABLE OF EXHIBITS

Exhibit	Description
2001	2022-02-09 Decision Granting Institution of Inter Partes Review
2002	Petitioner's Final Invalidity Contentions, *Ocean Semiconductor LLC v. STMicroelectronics, Inc.*, No. 6:20-cv-01215-ADA (W.D. Tex.)
2003	Petitioner's Preliminary Invalidity Contentions, *Ocean Semiconductor LLC v. STMicroelectronics, Inc.*, No. 6:20-cv-01215-ADA (W.D. Tex.)
2004	Proof of Service of Process, *Ocean Semiconductor LLC v. STMicroelectronics, Inc.*, No. 6:20-cv-01215-ADA (W.D. Tex.)

Patent Owner Ocean Semiconductor LLC ("Patent Owner" or "Ocean") submits this Sur-Reply, pursuant to the Board's June 23, 2022, Order. Petitioner STMicroelectronics, Inc.'s ("Petitioner" or "ST") Reply fails to address its lack of diligence in bringing the Petition underlying the joinder motion. Because Petitioner seeks only to skirt the statutory one-year bar under 35 U.S.C. § 315(b), Petitioner should not be permitted this prejudicial second bite at the apple.

I. PETITIONER OFFERS NO EXPLANATION WHY ITS MOTION SHOULD BE GRANTED IN VIEW OF FAIRNESS AND PREJUDICE CONCERNS

Petitioner relies on 35 U.S.C. § 315(b) and 37 C.F.R. § 42.122 for the proposition that it should be permitted to join and continue asserting its Petition even if the AMAT IPR is terminated. Paper 8 at 1-2. But Petitioner ignores that its Petition identifies the ***same*** prior art references as those ***already*** asserted by Petitioner in its Preliminary and Final Invalidity Contentions served in the pending district court proceeding. *See* IPR2021-01342, Paper 1 at 26 (laying out the complete overlap as to claims and prior art references raised in the original petition and in the parallel proceedings including that involving Petitioner as a defendant); *see also* Ex. 2002 at 30-50.

Accordingly, such a joinder (where Petitioner would be permitted to join and continue if and when AMAT exits) would not only offer Petitioner a second bite at asserting invalidity against the same patent but also impose undue prejudice on

Patent Owner. *See, e.g.*, *Code200, UAB et al. v. Bright Data Ltd.,* IPR2021-01503, Paper 13 at 8 (P.T.A.B. Mar. 13, 2022) (allowing joinder would offer Petitioner a second bite at asserting invalidity . . . [and] would not be in the interest of justice . . . ."). This is particularly true where Petitioner never disputed that it is a real party-in-interest in the original petition filed by AMAT. *See, Applied Materials, Inc. v. Ocean Semiconductor LLC*, IPR2021-01339, Paper 1 at 1-2 (P.T.A.B.); *Applied Materials, Inc. v. Ocean Semiconductor LLC*, IPR2021-01340, Paper 1 at 1-2 (P.T.A.B.). Petitioner was sued on the '248 patent in 2020 (*see* IPR2021-01344, Paper 13, Ex. 2006) and could have filed an IPR against the '248 patent at that time as it then already knew of these same prior art references (*see* Ex. 2003 at 39-45). But Petitioner did not do so in the one-year time frame following service of the Complaint. (*See* Ex. 2004). Now, twenty months later after commencement of the lawsuit, Petitioner seeks to challenge the '248 patent via its joinder motion and attempts to skirt around the statutory one-year time bar. Neither Petitioner's lack of diligence nor the fundamental policy of fairness allows this type of harassment and prejudice against Patent Owner. *See Code200*, IPR2021-01503, Paper 13 at 8 (denying joinder where "Petitioner provides no explanation for not filing for review when it could have earlier done so in the one-year window" and "Petitioner also does not provide an explanation why fairness now requires joinder").

Indeed, in denying the motion for joinder, the Board in *Proppant Express*

Invs. v. Oren Techs., IPR2018-00914, Paper 38 at 18 (P.T.A.B. Mar. 13, 2019) (precedential) emphasized that the time-bar exception under § 315(b) "does not mean, however, that the exception should swallow the [one-year] rule." Where "an otherwise time-barred petitioner requests same party and/or issue joinder," discretion to allow joinder can be exercised "only in limited circumstances" but not where "petitioner's mistakes or omissions" are implicated, which is the case here as evident by Petitioner's own negligence to file. (*Id.* at 19.) "Because Petitioner's own conduct created the need for it to request joinder" (and not because of any "late addition of newly asserted claims" in the parallel litigation), the Board must "carefully balance the interest in preventing harassment against fairness and prejudice concerns" against Patent Owner. For the same reasons adopted in *Proppant*, the Board should deny this joinder.

In its veiled attempt to distinguishing over the *Apple* case, Petitioner fails to address the same policy reason enumerated above—that a party cannot make use of joinder as a means ***to "stand in to continue a proceeding that would otherwise be terminated***." *Apple Inc. v. UNILOC 2017 LLC*, IPR2020-00854, Paper 9 at 4, 12 (P.T.A.B. Oct. 28, 2020),

II. CONCLUSION

Ocean opposes the Motion for Joinder to the extent Petitioner does not agree to withdraw should AMAT withdraw from the AMAT IPR.

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.