

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STMICROELECTRONICS, INC.
Petitioner,

v.

SEMCON IP INC.,
Patent Owner.

Case IPR2017-01432
Patent 5,978,876

Before BRYAN MOORE, STACEY G. WHITE, and KIMBERLY
McGRAW, *Administrative Patent Judges*.

McGRAW, *Administrative Patent Judge*.

DECISION
Denying Joinder
37 C.F.R. § 42.122(b)

I. BACKGROUND

On May 12, 2017, Petitioner, STMicroelectronics, Inc. (“ST”), filed a petition for *inter partes* review of claims 1–19 of U.S. Patent No. 5,978,876 (“the ’876 patent”). On December 4, 2017, the Board denied institution of *inter partes* review of claims 2–19, finding that ST did not demonstrate a reasonable likelihood that it would prevail as to these claims, but did institute *inter partes* review of claim 1. Paper 7, 2. On December 4, the Board also granted a petition for *inter partes* review of the ’876 patent filed by Texas Instruments Inc. (“TI”) and instituted *inter partes* review of claims 2, 5, 11, and 13–18 of the ’876 patent (“the 1425 IPR”). *Texas Instruments Inc. v. Semcon IP Inc.*, Case IPR2017-01425, slip op. 2 (PTAB Dec. 4, 2017) (Paper 9).

On December 27, 2017, ST timely filed a motion for joinder (Paper 9, “Mot.”), requesting that this proceeding be joined with the 1425 IPR. *See* 37 C.F.R. § 42.122(b). Patent Owner has not yet filed a response to the motion for joinder. However, following the filing of ST’s motion for joinder, Texas Instruments and Patent Owner agreed to settle the 1425 IPR and moved to terminate the 1425 IPR. Case IPR2017-01425, Paper 11.

For the reasons discussed below, we deny ST’s motion for joinder.

II. ANALYSIS

35 U.S.C. § 315(c) states in relevant part:

(c) JOINDER.— If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join as a party to that [instituted] *inter partes* review any person who properly files a petition under section 311 that the Director . . . determines warrants the institution of an *inter partes* review under section 314.

Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b). When exercising that discretion, the Board is mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. 37 C.F.R. § 42.1(b).

ST argues that joinder “will increase efficiency” because doing so “would efficiently resolve the common question in both IPRs—the patentability of the instituted claims of the ’876 patent over the Lambrecht references.” Mot. 3–4. ST further contends that joinder is appropriate because both proceedings involve “substantively similar prior art and claim constructions” and doing so would result in “consolidated filings and discovery.” Mot. 4–6.

We do not agree with ST that joinder is warranted in the present circumstances. First, as noted above, TI and Patent Owner have filed a joint motion to terminate the 1425 IPR proceeding. If the motion to terminate is granted, there are no efficiencies to be gained by joining the present proceeding to a proceeding that will be terminated.

Moreover, even if the 1425 IPR is not terminated, ST has not met its burden to show why joinder is appropriate. Although the proceedings may involve similar prior art and claim constructions, there is no overlap of instituted claims between the two proceedings. Additionally, the petitions presented different unpatentability arguments, including reliance upon different embodiments in the Lambrecht references. Significantly, the differences in arguments and evidence presented in each petition resulted in a finding that ST did not establish a reasonable likelihood that claims 2–19 would be unpatentable (Paper 7, 2–3, 28–32) while TI did establish a

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reasonable likelihood that claims 2, 5, 11, and 13–18 would be unpatentable (IPR2017-01425, Paper 9, 2, 17–31). Petitioner’s motion does not address the substantive difference between the petitions, including the differences between the parties’ characterization of the prior art.

We also disagree with ST that joinder would not prejudice Patent Owner. Mot. 7. ST argues that joinder would “prevent the Patent Owner and the Board from unnecessarily addressing two separate claim construction briefs.” *Id.* at 5. However, requiring Patent Owner to prepare a single response to two petitions that present different arguments would prejudice Patent Owner by reducing the number of pages available to respond to the different challenges presented in each petition.

In view of the facts and circumstances of this case, including the differences between the claims and the arguments of unpatentability that are at issue in each proceeding, joinder of the present proceeding with 1425 IPR is not warranted and Petitioner’s motion for joinder is denied.

III. ORDER

Accordingly, it is:

ORDERED that Petitioner’s motion for joinder is *denied*.

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