IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARDS

MICRON TECHNOLOGY, INC., MICRON SEMICONDUCTOR PRODUCTS, INC., and MICRON TECHNOLOGY TEXAS LLC

Petitioners,

v.

NETLIST, INC.,

Patent Owner.

Case No. IPR2023-00882
U.S. Patent No. 8,787,060

PETITIONERS' MOTION FOR JOINDER UNDER 35 U.S.C. §315(c) AND 37 CFR § 42.122(b)

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I. INTRODUCTION

Petitioners Micron Technology, Inc.; Micron Semiconductor Products, Inc.; and Micron Technology Texas LLC (collectively "Micron"), respectfully submit this Motion for Joinder ("Motion") together with a Petition ("Micron Petition") for *Inter Partes* Review of U.S. Patent No. 8,787,060 ("060 Patent"). The Board instituted *inter partes* review of claims 1-34 of the 060 Patent in *Samsung Electronics Co., Ltd. v. Netlist, Inc.*, IPR2022-01428 ("Samsung IPR") on April 12, 2023. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Micron respectfully requests institution of *inter partes* review of the same claims of the 060 Patent based on the same grounds presented in the Samsung IPR and further requests joinder with the Samsung IPR.

Micron's request for joinder is timely because it is made no later than one month after the April 12, 2023 institution date of the Samsung IPR. Further, Micron's joinder will not unduly burden or prejudice the parties to the Samsung IPR and will efficiently resolve the patentability of the 060 Patent in a single IPR proceeding. The Micron Petition is substantively identical to Samsung Electronics Co. Ltd.'s petition ("Samsung Petition") in the Samsung IPR. The Micron Petition seeks review of the same patent claims challenged in the Samsung IPR, advances the same grounds for unpatentability that were instituted in the Samsung IPR, and relies on the same evidence (including expert declarations) as the Samsung IPR.

Additionally, Micron proposes streamlining the proceedings by taking an "understudy" role (unless Samsung Electronics Co., Ltd. is terminated from the proceedings). Finally, Petitioner in the Samsung IPR does not oppose Micron's joinder. Accordingly, Micron respectfully requests that the Board institute the Micron Petition and join this IPR with the Samsung IPR.

II. BACKGROUND AND RELATED PROCEEDINGS

A. Related District Court Litigation

The 060 Patent is the subject of the following litigation:

- *Netlist, Inc. v. Samsung Electronics Co., Ltd. et al.*, No. 2:21-cv-00463 (E.D. Tex. filed Dec. 20, 2021);
- *Netlist, Inc. v. Micron Technology, Inc. et al.*, No. 2:22-cv-00203 (E.D. Tex. filed June 10, 2022)
- *Samsung Electronics Co., Ltd. v. Netlist, Inc.*, IPR2022-01428

B. Related IPR Proceedings

The Samsung IPR is the only IPR challenging the claims of the 060 Patent. Samsung Electronics Co. Ltd. filed its petition for *inter partes* review of the 060 Patent on August 26, 2022. IPR2022-001428, Paper 1. The Board instituted review in the Samsung IPR on April 12, 2023. IPR2022-01428, Paper 13.

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III. ARGUMENTS

The Board may join as a party to an instituted *inter partes* review a person who has properly filed a petition for *inter partes* review that warrants institution. 35 U.S.C. § 315(c). Any request for joinder must be filed "no later than one month after the institution date of any inter partes review for which joinder is requested." 37 C.F.R. § 42.122(b). A petition for *inter partes* review is not subject to the one-year statutory time bar if the petition is accompanied by a request for joinder. 35 U.S.C. § 315(b); 37 C.F.R. § 42.122(b).

"A motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified." *Samsung Elecs., Co. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 5 (PTAB Aug. 24, 2016) (citing *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013)).

A. Micron's Motion for Joinder Is Timely

Micron's Motion for Joinder is timely because it is being filed within one month of the April 12, 2023 institution of the Samsung IPR. *See* 37 C.F.R. § 42.122(b). Micron's Petition is not subject to the one-year statutory time bar

because it is accompanied by a request for joinder. *See* 35 U.S.C. § 315(b); 37 C.F.R. § 42.122(b).

B. Joinder Is Warranted under *Kyocera*

1. Factor 1: Joinder is appropriate

Joinder with the Samsung IPR is appropriate because the Micron Petition involves the same patent, challenges the same claims, and is based on the same grounds and supported by the same technical expert declaration and evidence as the Samsung Petition. Additionally, as noted below, the Micron Petition raises *only* the grounds from the Samsung IPR. In short, the Micron Petition is substantively identical to the Samsung Petition. The only minor changes include changes necessary for proper identification of the party filing the petition and corresponding documents. On the merits, the Micron Petition should therefore be instituted for at least the same reasons that the Board instituted the Samsung IPR. Further, good cause exists to allow joinder, given that the Micron Petition is substantively identical to the Samsung Petition, and joinder would allow the Board to effectively resolve the identical challenges raised by both parties in a single proceeding.

Additionally, Micron is currently involved in litigation based on Patent Owner's allegation that Micron's products infringe the 060 Patent. *See* EX1046 (*Netlist, Inc. v. Micron Technology Inc. et al.*, 2:22-cv-00203, Dkt. No. 1

(Complaint) (E.D. Tex. July 8, 2022)). Micron therefore has a particular interest in the substantial questions of invalidity surrounding the 060 Patent. Joinder is also appropriate for the additional reason that the invalidity grounds as to the challenged claims can be resolved through Micron's continued participation in the IPR process, even if the original petitioner in IPR2022-01428 were to reach a settlement with Patent Owner, or otherwise cease participation in that proceeding. The public interest in "permitting full and free competition in the use of ideas which are in reality a part of the public domain." *Lear, Inc. v. Adkins*, 395 U.S. 653, 670 (1969), favors allowing joinder in this case, as joinder would allow Micron to continue participating in the IPR process if Samsung ceases participation.

2. Factor 2: Micron's petition proposes no new grounds for unpatentability

The Micron Petition does not present any new grounds or arguments regarding unpatentability. It is substantively identical to the Samsung Petition. The Board "routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding." *BlackBerry Corp. v. Uniloc 2017 LLC*, IPR2019-01283, Paper 10 at 8 (PTAB Nov. 5, 2019) (quoting *Samsung*, IPR2016-00962, Paper 12 at 9). This factor therefore favors joinder.

3. Factor 3: Joinder will not unduly burden or negatively impact the Samsung IPR trial schedule

Joinder will not unduly burden Patent Owner. Because the Micron Petition presents the same grounds and arguments as the Samsung Petition, there are no new issues for Patent Owner to address. *See Sony Corp. v. Memory Integrity*, *LLC*, IPR2015-01353, Paper 11 at 6 (PTAB Oct. 15, 2015) (granting motion for joinder and instituting IPR where "joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]"). Indeed, the Patent Owner's Preliminary Response in the Samsung IPR is sufficient to address the Micron Petition because the issues presented are substantively identical. *See* Patent Owner's Preliminary Response, Case No. IPR2022-01428, Paper 6 (Jan. 19, 2023).

Likewise, joinder will not negatively impact the Samsung IPR trial schedule. Micron expressly consents to the existing trial schedule. Further, as described below, Micron agrees to take an "understudy" role in the joined proceeding, so long as Samsung remains an active part in the joined proceeding. *See, e.g.*, *Apple Inc. v. INVT SPE LLC*, IPR2019-00958, Paper 9 at 6–8 (PTAB May 30, 2019) (granting motion for joinder where the movant presented a substantively identical petition and agreed to take an "understudy" role in the joined proceeding); *Intel Corp. v. Alacritech, Inc.*, IPR2018-01352, Paper 11 at 3–5 (PTAB Jan. 8, 2019) (same).

Finally, the Micron Petition relies on the same technical expert declaration as the Samsung Petition. Ex. 1003 (Decl. of Dr. Andrew Wolfe). Therefore, joinder will not increase the complexity of the proceeding. Indeed, the Board typically grants joinder where a petitioner presents a different witness with a substantially similar declaration. *See, e.g.*, *Pfizer Inc. v. Sanofi-Aventis Deutschland GmbH*, IPR2019-00980, Paper 12 at 3–4, 6–7 (PTAB Aug. 15, 2019); *Everlight Electronics Co., Ltd.*, IPR2018-01260, Paper 12 at 4, 6–7 (PTAB Nov. 14, 2018); *Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11 (Oct. 30, 2018).

4. Factor 4: Procedures to simplify briefing and discovery

Micron agrees to take an "understudy" role in the joined proceeding, absent termination of the original petitioner as a party. Specifically, Micron agrees to the following conditions regarding the joined proceeding, so long as Samsung remains an active party in the joined proceeding:

1. Micron will not be making any substantive filings, and Micron agrees that Samsung alone will be responsible for all substantive petitioner filings in the joined proceeding;
2. Micron agrees to be bound by all filings by Samsung in the joined proceeding, except for filings regarding termination and settlement;

3. Micron must obtain prior Board authorization to file any paper or to take any action on its own in the joined proceeding;

4. Micron shall not be permitted to raise any new grounds not already instituted by the Board in the Samsung IPR, or introduce any argument or discovery not already introduced by Samsung;

5. Micron shall be bound by any agreement between Patent Owner and Samsung concerning discovery and depositions;

6. Micron will not cross-examine or defend any witness at deposition;

7. Samsung will be responsible for any oral hearing presentation, including the preparation of demonstrative exhibits.

Only if Samsung ceases participation in the proceeding:

8. Micron would assume a primary role, meaning it would take over the role previously filled by Samsung.

See Ericsson Inc. v. Uniloc 2017 LLC, IPR2020-00376, Paper 16 at 10 (granting a motion for joinder with the same conditions).

The eight conditions listed above are intended to capture Petitioner's proposed "understudy" role. This list of conditions was provided to Samsung prior to filing, and Samsung stated it does not oppose Micron's joinder under the conditions specified above. The conditions are also consistent with the Board's stated conditions of joinder in other cases. *Id.*; *see also AT&T Servs., Inc. v.*

Convergent Media Solutions, LLC, IPR2017-01235, Paper 11 at 36–37 (PTAB May 9, 2017) (Lee, J.) (granting joinder with similar limitations on an understudy).

The Board has consistently found that the acceptance of an "understudy" role removes any undue complications or delay that might allegedly result from joinder. *See, e.g.*, *Apple*, IPR2019-00958, Paper 9 at 6–8 (granting motion for joinder where the movant presented a substantively identical petition and agreed to take an "understudy" role in the joined proceeding); *Intel Corp.*, IPR2018-01352, Paper 11 at 3–5 (same); *Sony Corp.*, IPR2015-01353, Paper 11 at 6–7. As such, this factor also favors joinder.

IV. CONCLUSION

For the reasons above, Micron respectfully requests that the Board grant joinder with *Samsung Electronics Co. Ltd. v. Netlist, Inc.*, Case No. IPR2022-01428.

Dated: May 8, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(a), this is to certify that on May 8, 2023, I caused to be served a true and correct copy of the foregoing "**PETITIONERS' MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)**" by FedEx on the Patent Owner at the correspondence address of record for U.S. Patent No. 8,787,060:

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A courtesy copy of this Motion was also served upon litigation counsel for Patent Owner via email, as follows:

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