

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TEXAS INSTRUMENTS INCORPORATED,
Petitioner,

v.

BELL SEMICONDUCTOR, LLC,
Patent Owner.

IPR2024-01010
Patent 7,345,245 B2

Before JEFFREY W. ABRAHAM, JOHN D. HAMANN, and BRIAN D.
RANGE, *Administrative Patent Judges*.

RANGE, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314
Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

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I. INTRODUCTION

Texas Instruments Incorporated (“Petitioner” or “TI”) filed a Petition (Paper 1, “Pet.”) seeking *inter partes* review of claims 1–6 and 8 (the “Challenged Claims”) of U.S. Patent No. 7,345,245 B2 (“the ’245 patent”), assigned to Bell Semiconductor LLC (“Patent Owner” or “PO”). Petitioner also filed a motion for joinder to be joined as a petitioner to *NXP USA, Inc. v. Bell Semiconductor, LLC*, IPR2024-00168, filed November 9, 2023, and instituted May 8, 2024 (“the NXP IPR” with the Petitioners in that matter referred to herein as “NXP”). Paper 2 (“Mot.”).

Patent Owner filed a Response to Petitioner’s Motion for Joinder and, therein, conditionally waives opposition to Joinder. Paper 8, 1 (“Should Petitioner decide that it will no longer be an ‘understudy,’ Patent Owner reserves all rights to challenge Petitioner’s participation in proceedings that would deviate from the conditions set forth in the Motion.”). Patent Owner also filed an Election to Waive Preliminary Response and, therein, categorically waives filing a Preliminary Response. Paper 7.

For the reasons described below, we institute an *inter partes* review of the challenged claims and grant Petitioner’s Motion for Joinder.

II. RELATED PROCEEDINGS

Petitioner states that the ’245 patent is asserted in the following actions: the NXP IPR (identified above); *Bell Semiconductor, LLC v. Texas Instruments Incorporated*, Case No. 4:23-cv-00609, pending in the Eastern District of Texas; and *Bell Semiconductor, LLC v. NXP USA, Inc. et al*,

Case No. 8:22-cv-02133-HDV-ADS, pending in the Central District of California. Pet. 2.

In the NXP IPR, the Board instituted an *inter partes* review of claims 1–6 and 8 (*see infra* nn. 1, 4, 6 (noting disclaimed claims)) of the ’245 patent on the following grounds:

Petitioner Ground #	Claims Challenged	35 U.S.C. §	References/Basis
1	7, 8, 10, 11	103(a) ¹	Devnani ² , AAPA ³
2	9	103(a) ⁴	Devnani, AAPA, Pillai ⁵
3	12	103(a) ⁶	Devnani, AAPA, Tanahashi ⁷
4	1, 2, 4, 5	103(a)	Devnani, AAPA
5	3	103(a)	Devnani, AAPA, Pillai
6	6	103(a)	Devnani, AAPA, Tanahashi
7	1, 2, 5	103(a)	Chung ⁸ , Celeron ⁹
8	3	103(a)	Chung, Celeron, Pillai
9	4	103(a)	Chung, Celeron, AAPA
10	6	103(a)	Chung, Celeron, Tanahashi
11	1, 2, 5	103(a)	Devnani, Celeron

¹ We did not address disclaimed claims 7, 10, and 11.

² US 2003/0183919 A1, published Oct. 2, 2003, Ex. 1005 (“Devnani”).

³ For brevity, the phrase “applicant’s admitted prior art” as set forth in the ’245 patent is abbreviated as “AAPA.”

⁴ We did not address disclaimed claim 9.

⁵ US 6,680,530 B1, issued Jan. 20, 2004, Ex. 1007 (“Pillai”).

⁶ We did not address disclaimed claim 12.

⁷ US 6,172,305 B1, issued Jan. 9, 2001, Ex. 1009 (“Tanahashi”).

⁸ US 2003/0003705 A1, published Jan. 2, 2003, Ex. 1006 (“Chung”).

⁹ “Mobile Intel Celeron Processor (0.13 μ) in Micro-FCBGA and Micro-GCPGA Packages,” Datasheet, Intel Corp., April 2003, Ex. 1008 (“Celeron”).

Petitioner Ground #	Claims Challenged	35 U.S.C. §	References/Basis
12	6	103(a)	Devnani, Celeron, Tanahashi
13	7	103(a) ¹⁰	Dunkerton ¹¹ , Devnani, CRTA ¹²

NXP IPR, Paper 10, 45–46 (PTAB May 8, 2024) (“NXP Dec.”).

III. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same grounds of unpatentability as the ones on which we instituted review in the NXP IPR. *Compare* Pet. 3–5, with NXP Dec. 2, 6–7. Indeed, Petitioner contends that the Petition “challenges the same claims on the same grounds, relies on the same prior art, and includes the exact same substantive arguments as the NXP IPR.” Mot. 1. Petitioner further contends that all “supporting materials—including its supporting expert declaration, exhibits, and exhibit numbering—are identical to those presented in the NXP IPR.” *Id.* at 6.

Petitioner acknowledges that the Petition relies on “different arguments regarding discretionary denial under *Fintiv* based on the specific facts relevant to TI, including the *Sotera* stipulation TI served on Patent Owner.” *Id.* at n.1. However, in both the NXP IPR and the present IPR, Patent Owner waives its preliminary response and does not address denial

¹⁰ We do not reach the ground, because claim 7 is disclaimed.

¹¹ Dunkerton, et al., “A Review of Ball Grid Arrays for Electronic Assembly,” The 1998 International Conference on Advances in Welding Technology, Sept. 30–Oct. 2, 1998, Ex. 1018 (“Dunkerton”).

¹² “Critical Review and Technology Assessments ’91–’92,” Reliability Analysis Center, AD-A278 419, 1994, Ex. 1016 (“CRTA”).

under *Fintiv* or contest the *Sotera* stipulation. *See, e.g.*, NXP IPR, Paper 7 (Preliminary Response).

Thus, for the same reasons set forth in our institution decision in the NXP IPR, we determine that the information presented in the Petition shows a reasonable likelihood that Petitioner would prevail in showing that claims 1–6 and 8 are unpatentable. *See* NXP Dec. Accordingly, we institute an *inter partes* review of the same claims on the same grounds as the ones on which we instituted review in the NXP IPR. 35 U.S.C. § 314(a).

IV. MOTION FOR JOINDER

The Petition in this proceeding was accorded a filing date of June 7, 2024. *See* Paper 4. The NXP IPR was instituted on May 8, 2024. NXP Dec. Petitioner filed a Motion for Joinder on June 7, 2024. Mot. Thus, Petitioner’s Motion for Joinder is timely because joinder was requested no later than one month after the institution date of the NXP IPR. *See* 37 C.F.R. § 42.122(b).

The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads:

If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join as a party to that *inter partes* review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

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. *See Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, 4 (PTAB Apr. 24, 2013) (Paper 15).

The Petition in this case asserts the same unpatentability grounds on which we instituted review in the NXP IPR. *See* Mot. 1. Petitioner states that its Petition “challenges the same claims on the same grounds, relies on the same prior art, and includes the exact same substantive arguments as the NXP IPR.” *Id.* Thus, this *inter partes* review does not present any ground or matter not already at issue in the NXP IPR.

Petitioner agrees that, if joinder is granted, it will have an “understudy role.” *Id.* at 2–3, 6–8. Petitioner agrees to various restrictions as an understudy. *Id.* Along these lines, Petitioner will abide by the following conditions so long as NXP is actively participating in this proceeding:

- (a) TI shall not make any substantive filing and shall be bound by the filings of Petitioner NXP, unless a filing concerns termination and settlement, or issues solely involving TI;
- (b) TI shall not present any argument or make any presentation at oral argument unless an issue solely involves TI, or when addressing Board-approved motions that do not affect Petitioner NXP or its respective position;
- (c) TI shall not seek to cross-examine or defend the cross-examination of any witness, unless the topic of cross-examination concerns issues solely involving TI;
- (d) TI shall not seek discovery from Patent Owner on issues not solely involving TI;
- (e) TI will not rely on expert testimony beyond that submitted by Petitioner NXP unless Petitioner NXP is terminated from the case. If Petitioner NXP is not terminated from the case, TI agrees to rely entirely on, and be bound by, the expert declarations and depositions in the NXP IPR.

Mot. 6–7. In sum, TI “will not assume an active role unless Petitioner NXP ceases to participate in the proceeding.” Mot. 2.¹³

The conditions above mean that joinder will have no impact on the NXP IPR trial schedule and will not complicate the NXP IPR briefing or discovery. These understudy provisions are consistent with the provisions imposed by, for example, *Ecobee Techs. ULC v. EcoFactor, Inc.*, IPR 2022-01460, IPR2022-00473, Paper 7 (PTAB Jan. 24, 2023) and *Apple Inc. v. INVT SPE LLC*, IPR2019-00959, Paper 8 (PTAB May 30, 2019).

Patent Owner “does not oppose Petitioner’s Motion for Joinder (Paper No. 2) (the “Motion”) on the conditions set forth in the Motion.” Paper 8, 2. Patent Owner, however, “reserves all rights to challenge Petitioner’s participation in proceedings that would deviate from the conditions set forth in the Motion.” *Id.*

We agree with Petitioner that joinder with the NXP IPR is appropriate under the circumstances. Accordingly, we *grant* Petitioner’s Motion for Joinder.

If NXP ceases to actively participate in the NXP IPR, then the Board will consider what procedural modifications, if any, are necessary. We ask the parties to inform us expeditiously if NXP ceases to actively participate in the NXP IPR or if NXP reaches settlement, formal or informal, with regard to the NXP IPR.

¹³ If special circumstances arise such that Petitioner seeks an exception to one of these conditions, Petitioner must seek authorization from the Board after conducting a meet-and-confer with Patent Owner and NXP.

V. CONCLUSION

For the above reasons, we institute an *inter partes* review. 35 U.S.C. § 314(a).

VI. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted as to claims 1–6 and 8 of the '245 patent based on all grounds set forth in the Petition;

FURTHER ORDERED that Petitioner's Motion for Joinder with IPR2024-00168 is GRANTED, and Petitioner is hereby joined as a Petitioner in IPR2024-00168;

FURTHER ORDERED that the grounds on which trial in Case IPR2024-00168 were instituted are unchanged and no other grounds are added in IPR2024-00168;

FURTHER ORDERED that the Scheduling Order entered in IPR2024-00168 along with any schedule changes agreed by the parties are not affected by joinder;

FURTHER ORDERED that Petitioner will abide by the conditions stated above;

FURTHER ORDERED that if special circumstances arise such that Petitioner seeks an exception to one of these conditions, Petitioner must seek authorization from the Board after conducting a meet-and-confer with Patent Owner and NXP;

FURTHER ORDERED that the parties will inform the Board within four business days if NXP reaches settlement, formal or informal, with

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regard to IPR2024-00168 or otherwise ceases to actively participate in the IPR2024-00168;

FURTHER ORDERED that the case caption in IPR2024-00168 shall be changed to reflect joinder of all joined, as indicated in the attached sample case caption;

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2024-00168; and

FURTHER ORDERED that all further filings shall be made in IPR2024-00168.

[Sample Case Caption]

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¹⁴ Texas Instruments Incorporated filed a motion for joinder and a petition in IPR2024-01010 and have been joined as petitioners in this proceeding.

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