

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

NETLIST, INC.,
Patent Owner.

Case No. IPR2024-00370
Patent No. 10,268,608

PATENT OWNER PRELIMINARY RESPONSE

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STATEMENT OF MATERIAL FACTS IN DISPUTE

Petitioner did not submit a statement of material facts in this Petition. Accordingly, no response is due pursuant to 37 C.F.R. § 42.23(a), and no facts are admitted.

I. INTRODUCTION

This is Micron's second IPR petition against the '608 patent. Micron's first petition was rejected on the merits after the Board determined that claim 1 "requires the data path include the delay circuit," but that Micron had failed to demonstrate that the prior art (Osanai) satisfies that limitation. *Micron Technology, Inc. et al. v. Netlist, Inc.*, IPR2022-00237 (P.T.A.B., July 19, 2022) ("Micron -0237"), Paper 15 at 19-20. Micron is now time barred, but seeks to join an IPR initiated by Samsung based on prior art that is substantively the same as what Micron used in its first IPR petition.

The Board should deny Micron's petition under 35 U.S.C. § 314(a) and its precedential decisions which made clear that a time-barred party should not get even a second bite at the apple. *See Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9, 4 (Oct. 28, 2020) (precedential) ("*Uniloc*") (denying institution of joinder petition that presented a reasonable likelihood of prevailing where time-barred petitioner brought second IPR challenge mutually reinforcing reasons.); *Apple Inc.*

v. Koss Corp., IPR2022-00053, Paper 10, 3 (Apr. 4, 2022) (same, applying *Uniloc* and *General Plastic*).¹

Micron provides no good reason why it should be given a second chance after the time bar and its first IPR has been denied on the merits. As analyzed below, all seven *General Plastic* factors favor denial. *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, 16-17 (Sept. 6, 2017) (precedential).

II. FACTUAL BACKGROUND

On December 23, 2021, Micron filed an IPR petition challenged claims 1-5 of the '608 patent. *See Micron Technology, Inc. et al. v. Netlist, Inc.*, IRP2022-00237 (“Micron -0237”). The Micron -0237 petition included the following grounds:

Ground	Claims	Basis for Unpatentability
1	1 and 4	Anticipated by Osanai (Ex. 1005)
2	1–5	Obvious over Osanai (Ex. 1005) in view of Tokuhiro (Ex. 1006)
3	1–5	Obvious over Osanai (Ex. 1005) in view of Tokuhiro (Ex. 1006), in further view of Takefman

¹ While Patent Owner strongly believes Micron’s grounds also lack technical merit, in view of the Board’s Institution Decision in IPR2023-00847, Patent Owner is not including technical merits arguments in its Preliminary Response.

EX2001 (Micron -0237 Petition), 4.

The Board denied institution in Micron -0237 on the merits, finding that claim 1 “requires the data path include the delay circuit,” but that Micron had failed to demonstrate that Osanai satisfies that limitation. EX2002 (Micron -0237 Institution Decision), 19-20.

Micron sought rehearing of the Board’s institution decision, which was denied on September 16, 2022. *See* EX2003 (IPR2022-00237, Paper 17). Specifically, the Board found that that Micron’s rehearing contentions “were never made in the Petition and, to the extent that they were, are now newly being reframed to support an argument that was also never made in the Petition. A request for rehearing is not an opportunity to present new arguments.” *Id.*, 4.

Seven months later on April 27, 2023, Samsung filed a petition against the claims of the ’608 patent based on substantially the same prior art as the Micron -0237 IPR. *See Samsung Electronics Co., Ltd. v. Netlist, Inc.*, IRP2023-00847 (“Samsung -0847”). Netlist argued that the Board should discretionarily deny institution under 35 U.S.C. § 325(d) because the Samsung -0847 petition presents substantially the same prior art and arguments previously considered by the Office. Although the Board elected not to use its discretion to deny the Samsung -0847 petition under Section 325(d), it found that “substantially the same prior art was

previously before the Board” in Micron -0237. EX2004 (Samsung -0847 Institution Decision) at 12.

On January 10, 2024, over two years after filing its first IPR petition, Micron filed the present petition—it’s second—with a motion seeking joinder to the Samsung -0847 IPR. Micron’s second petition is a copy of the Samsung -847 petition which, as the Board found, presents “substantially the same prior art” as Micron originally did in Micron -0237. *See id.*

III. THE *GENERAL PLASTIC* FACTORS STRONGLY FAVOR DENIAL

This is a “copycat” or “me-too” petition by a time-barred petitioner, Micron, whose first challenge against the ‘608 patent failed on the merits. Micron now uses the Board’s reasoning as a roadmap to craft new arguments in this second (joinder) petition.

In *Uniloc*, the Office clarified that discretionary § 314(a) factors are directly relevant to “a ‘me-too petition’” like this one, and must be analyzed to determine whether such joinder requests should be rejected. *Uniloc*, 4-5 (holding that “before determining whether to join ..., even though the Petition is a ‘me-too petition,’ we first determine whether application of the *General Plastic* factors warrants the exercise of discretion to deny the Petition under § 314(a).”). Such discretionary factors apply under “a holistic view of whether efficiency and integrity of the system are best served” by rejecting it—particularly where a joinder petitioner is attacking

a patent it already attacked before. *E.g., LG Elecs., Inc. v. Ancora Techs. Inc.*, IPR2021-00581, Paper 16, 7, 8-10 (June 10, 2021) (denying me-too joinder request).

In *Uniloc*, the petitioner argued joinder was appropriate because the petitioner would start out in an “understudy” role. But the Court in *Uniloc* rejected this argument because it was petitioner’s “second challenge to the patent” and joinder in *Uniloc*, as here, would allow the petitioner, if joined, to continue a case that might otherwise terminate:

Although a joinder request is usually an efficient mechanism by which to become a petitioner in an IPR, in this case, Apple’s understudy role argument is not persuasive. Rather, we agree with Patent Owner that **because this is Apple’s second petition, should Microsoft settle, Apple would stand in to continue a proceeding that would otherwise be terminated.** Joinder in this circumstance would allow Apple to continue a proceeding, even after settlement with the primary petitioner, based on a second attempt by Apple.

Uniloc, 4, 12 (emphasis added). “In effect, it would be as if [the time-barred joinder petitioner] had brought the second challenge to the patent in the first instance.” *Id.*, 4. So, joinder was denied. *Id.*; accord *HTC Corp. v. Ancora Techs., Inc.*, IPR2021-00570, Paper 17, 13 (June 10, 2021) (“*HTC*”) (“Like in *Uniloc*, joinder in this circumstance would allow Petitioner HTC to continue a proceeding even after settlement with the primary petitioner, based on a second attempt by...HTC.”); *Apple Inc. v. Koss Corp.*, IPR2022-00053, Paper 10, 6 (Apr. 4. 2022) (finding

“Petitioner’s understudy argument is not persuasive here where the copied Petition is Petitioner’s third challenge to the patent, and should Bose settle, Petitioner would stand in to continue a proceeding that would otherwise be terminated.”).

In *Proppant Express Invs., LLC v. Oren Techs., LLC*, IPR2018-00914, Paper 38 (POP Mar. 13, 2019) (“*Proppant*”), the Court explained that when deciding whether to grant joinder requests, “[e]vents in other proceedings related to the patent at issue,” discretionary § 314(a) factors, and “[t]he conduct of the parties and attempts to game the system may also be considered” in “carefully balanc[ing] the interest in preventing harassment against fairness and prejudice concerns.” *Proppant*, 18-19. Joining Petitioner here “would obviate the careful statutory balance” and “effectively circumvent the time limitation in § 315(b).” *Proppant*, 18. The time-barred Petitioner seeks joinder to another’s case after Petitioner already had its own grounds considered and rejected on the merits.

Uniloc and its progeny stands for the proposition that a time-barred party should not get two bites at the apple. Micron should not get a second bite here.

A. General Plastic Factor #1: Micron Previously Filed A Petition Challenging The Same Claims

Factor #1—“whether the same petitioner previously filed a petition directed to the same claims of the same patent”—strongly favors denial. Here, the Micron -

0237 petition challenged the same claims using substantially the same grounds,² and was denied on the merits. That Micron’s petition is a “follow-on petition” is of no import. *See Uniloc* at 8 (“[T]he *General Plastic* factors are relevant to our determination whether denial is warranted under § 314(a), even when the petition filed is a follow-on petition and Petitioner is not seeking an active role in the ongoing IPR.”); *see also* at *Koss* at 12.

B. *General Plastic* Factors #2, 4: Micron Is Refiling Its Own Rejected Grounds Filed Over Two Years Ago

The second and fourth factors are (2) “whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it” and (4) “the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition.” *General Plastic*, 16-17. Together, these factors strongly favor denial. There can be no doubt that Micron has been aware of these grounds for over two years because the grounds raised here and in Samsung -0847 are substantively the same grounds raised and rejected in Micron -0237.

² That substantially the same grounds are at issue here as those previously presented by Micron is described in more below under Factor 2.

Specifically, Osanai from Micron -0237 is substantively the same as the Hiraishi reference at issue here in all material respects, as the Board found in Samsung -847. *See* EX2004 (Samsung -0847 Institution Decision) at 11 (“Patent Owner asserts, and Petitioner does not dispute, that the Hiraishi reference is essentially the same as the Osanai reference asserted in the Micron ’237 IPR. **We agree.**”). The Board also found “that although Butt is a named secondary reference [in Samsung -0847], Hiraishi is the main reference relied upon for the teachings of the claim limitations, and **Butt is used to provide further explanations or interpretations of the teachings of Hiraishi and/or to explain the knowledge of one of ordinary skill in the art.**” *Id.* at 11-12 (emphasis added). That is, the Board found that Butt was not relied on to satisfy any limitation, but instead was only used to explain Hiraishi and/or as evidence of the knowledge of a POSA. Moreover, the Tokuhiko reference of Ground 2 is the same reference relied on in Micron -0237. In fact, in addressing whether Samsung -0847 should be discretionarily denied under Section 325(d), the Board agreed that the first part of the *Advanced Bionics* framework was met because “substantially the same prior art was previously before the Board.” *Id.* at 12.

Moreover, although one of the grounds in Micron -0237 was based on anticipation, the Board did consider the teachings of Osanai/Hiraishi in the context of obviousness because two of the three grounds in Micron -0237 were obviousness

challenges. *See* EX2002 (-0237 Institution Decision) at 20-21. Specifically, the Micron -0237 petition asserted anticipation against only claims 1 and 4, while asserting two additional obviousness challenges against claims 1-5. *See* EX2001 (Micron -0237 Pet.) at 13 (“The challenged claims are unpatentable based on three different grounds. Ground 1 establishes that claims 1 and 4 are anticipated by Osanai. Ground 2 establishes that claims 1–5 are obvious over Osanai in view of Tokuhiko. Ground 3 establishes that claims 1–5 are obvious over Osanai in view of Tokuhiko, in further view of Takefman.” As such, Micron already had an opportunity to present the same prior art issues as those presented in Samsung -0847, including obviousness in the context of the teaching of Osanai/Hiraishi.

Micron argues that *Uniloc* does not apply simply because it was “not aware of the critical prior art used in Samsung’s ’608 IPR, which this petition seeks to join, when filing its original petition.” Pet., 112. That is an irrelevant argument, however, since the standard is not what Micron actually knew, but it reasonably could have known. To the extent that Micron did not know of Butt when it filed its first petition, that is only evidence of lack of diligence because the reference was readily available, as evidence from the fact that Micron itself identified the reference *before* Samsung’s -0847 IPR. In short, Micron’s apparent lack of awareness of the Butt reference at the time of its first IPR petition does not alter the fact that General Plastic Factors #2 and 4 strongly favor denial for several reasons.

First, Micron’s argument that it lacked knowledge of the Butt reference ignores most of *Uniloc*’s reasoning, including *Uniloc*’s holding that a time-barred joinder petitioner who has already attacked the patent should not be allowed to join a later attack such that it can block termination due to settlement as if it had brought the later attack in the first instance. *See supra*.

Second, the question is not whether Micron knew of the Butt reference, but whether it **should have known** of it. *See, e.g., HTC*, 10-12 (raising of grounds in earlier litigation favored denial, because petitioner “should have known” of basis of challenge for years, “instead of waiting ... to join”). While Micron argues it did not know about the Butt reference at the time of its first petition, it’s petition expressly relies on the argument that “Hiraishi and Butt are analogous art to the ’608 Patent, as each is directed to solving the problem of accurate timing of data transmissions for memory transactions.” Pet. 36. Micron provides no justification for why it could not have reasonably located the Butt reference given that Butt is a U.S. Patent application whose subject matter, according to Micron, is analogous to the ’608 patent and Hiraishi. *Id.* Moreover, Micron did identify Butt before the Samsung - 847 IPR. Specifically, it identified Butt no later than November 21, 2022 when it filed invalidity contentions for the ’506 patent, which is a direct continuation of the ’608 patent at issue here.

Table 1-A: Prior Art Patents and Printed Publications for the '506 patent

Ex.	Patent No. or Title (Primary Inventor/Author)	Date of Issue/ Publication	Filing Date
RA-1	Asserted Patent's Admitted Prior Art (APA)		
RA-2	U.S. Patent App. Pub. No. 2010/0312956 (Hirashi)	Dec. 9, 2010	June 3, 2010
RA-3	U.S. Patent App. Pub. No. 2007/0008791 (Butt)	Jan. 11, 2007	July 7, 2005
RA-4	U.S. Patent No. 8,020,022 (Tokuhiro)	Sept. 13, 2011	Sept. 12, 2008
RA-5	U.S. Patent App. Pub. No. 2006/0277355 (Ellsberry)	Dec. 7, 2006	June 1, 2005
RA-6	U.S. Patent No. 7,024,518 (Halbert)	April 4, 2006	Mar. 13, 2002

EX2005 (Micron's Invalidity Contentions) at 7. Micron's apparent later discovery of the Butt reference in connection with the '506 continuation application is clear evidence that Micron **should have known** of the Butt reference when it filed its first IPR petition

Third, as noted above, the Board found that the Butt reference is not relied on to disclose any of the claim limitations in the Samsung -0847 petition which is identical to the petition here. *See* EX2004 (Samsung -0847 Institution Decision) at 11-12. Instead, Butt is relied on in Samsung -0847 and the present petition to explain Hiraishi and/or as evidence of the knowledge of a POSA, as the Board concluded. *See* -0847 ID at 11-12. Specifically, the petitions cite to the annotated figure from Butt below, contending that it "is an implementation of a 'data path.'"

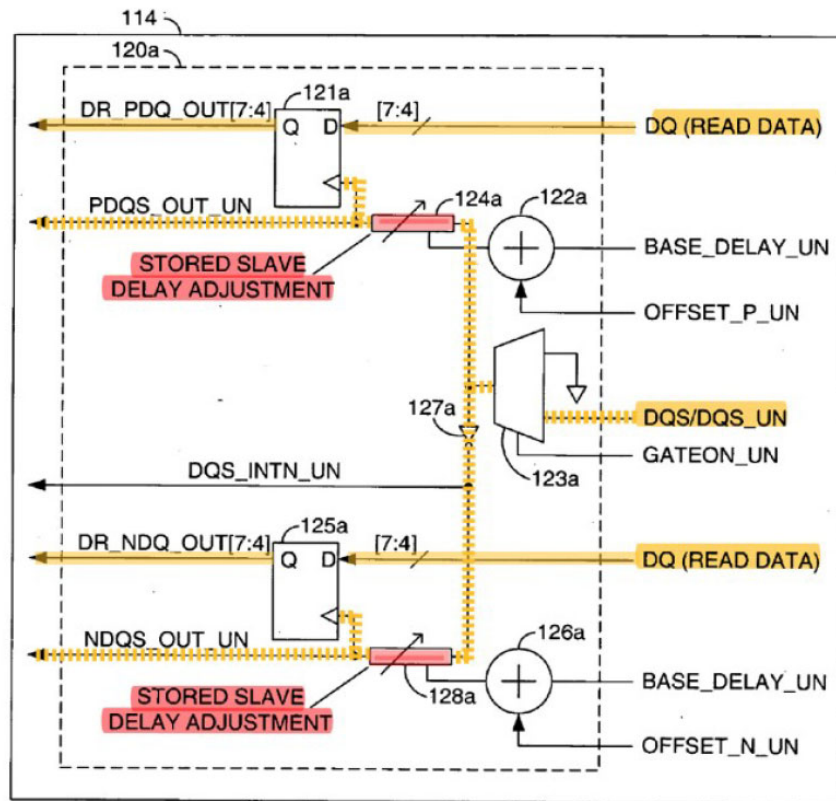


FIG. 3A

Pet. 36; Samsung -0847 Pet. 36. Both petitions further add that a “POSITA would have understood from the disclosure of Butt that Hiraishi’s data register buffer 300 includes “data paths” (orange) where data strobe signals sample the data and the data samples are buffered in respective FIFO circuits.” *Id.* (both citing Dr. Wedig’s declaration in support at EX1003, ¶ 144). In other words, Micron relies on Butt because it allegedly uses the term “data path” to include both data signals and strobe signals, as Dr. Wedig confirmed. *See* EX2006 (Samsung -0847, EX2012 (Deposition of Dr. Wedig), 51:1-4 (“Q. ...The Butt reference uses the term "data path" to include both data signals and strobe signals. Is that your position? A. That's -- yes, that's my

position.”). But Dr. Wedig—the same expert in Samsung -0847 and the present IPR—was asked whether this notion is unique to Butt, and he confirmed that at least in his opinion it was not.

Q. Outside of the Butt reference, have you ever seen another reference describe a strobe signal as being sent over a data path or as part of a data path?

A. I'm sure that I have. Because I think one of ordinary skill would understand that a strobe signal is part of a data path. It travels from the memory controller to the memory device, and it also travels from the memory device back to the memory controller to facilitate data transfer. So I'm sure I've seen it.

I mean, I gave the -- it's like -- I gave the references that I did, but I'd have to go through all of my papers, all of my books in order to show you where it's also shown. I mean, I cited to the ones that I thought were the most relevant.

Id., 51:5-18.

Thus, Micron's own expert disputes its contention that Butt is “critical prior art” or that Micron's lack of awareness of that specific reference is material.

In sum, Factors #2 and #4 strongly favor denial for the reason above, particularly because the evidence shows that Micron should have known of the Butt reference when it filed its first IPR petition, and Micron has not shown why any alleged lack of knowledge of Butt is material.

C. General Plastic Factor #3: The Present Petition Used the Board's Institution Decision in Micron -0237 as a Roadmap for the New Petition

Factor #3—“whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition”—strongly favors denial. Indeed, the petition in Samsung -0847, which Micron has copied here, is designed with the -0237 Institution Decision squarely in mind.

Per General Plastics:

[F]actor 3 is directed to Petitioner’s potential benefit from receiving and having the opportunity to study Patent Owner’s Preliminary Response, as well as our institution decisions on the first-filed petitions, prior to its filing of follow-on petitions. ... Multiple, staggered petitions challenging the same patent and same claims raise the potential for abuse. The absence of any restrictions on follow-on petitions would allow petitioners the opportunity to strategically stage their prior art and arguments in multiple petitions, **using our decisions as a roadmap**, until a ground is found that results in the grant of review. All other factors aside, **this is unfair to patent owners and is an inefficient use of the *inter partes* review process ...**

General Plastic, 17-18 (internal citation and footnote omitted).

The Board has repeatedly found that petitioners who modify and tailor arguments in view of a preliminary response—called “roadmapping”—strongly

favours denial. *Am. Honda Motor Co., Inc. v. Intellectual Ventures II LLC*, IPR2018-00349, Paper 9, 17 (June 27, 2018) (“Petitioner ... appears to have used Patent Owner’s ‘preliminary responses in the earlier-filed IPRs as a roadmap to attempt to improve [Petitioner’s] position in this Petition.’ ... Accordingly, this factor **weighs strongly against institution.**”); *Metall Zug AG v. Carl Zeiss Meditec AG*, IPR2020-01074, Paper 8, 8-9 (Jan. 5, 2021) (similar); *Google LLC v. Uniloc Luxembourg S.A.*, IPR2017-01665, Paper 10, 22 (Jan. 11, 2018) (“Petitioner took the opportunity to attempt to correct deficiencies alleged by Patent Owner in Amazon’s petition. This is precisely the type of roadmapping *General Plastic* counsels against.”).

Such disfavored “roadmapping” is precisely what occurred here. Patent Owner’s Preliminary Response in Micron -0237 was filed on April 25, 2022 and the -0237 Institution Decision denying institution issued on July 19, 2022, months before the petition in Samsung -0847, now copied by Micron, was filed. While Micron contends there is no evidence of “roadmapping,” the record is replete with evidence. For example, in Micron -0237 for the “delay circuit” Micron identified Osanai’s write level circuitry 322 and read leveling circuitry 3232, and argued that the write level circuitry 322 delays the output timing of the DQS sent from the data register buffer 300, thus creating DQS-Post and that the read leveling circuitry similarly delays signals. *See* EX2002 (-0237 Institution Decision”) at 19 (citing Micron -0237 Pet. 43). The Board found that Micron had failed to show that “the

write and read leveling circuitry are included in any one of the data paths that are relied upon by Petitioner,” or how those “circuits would be included in the recited data path.” *See* EX2002 (-0237 Institution Decision”) at 19.

Micron then sought rehearing of the -0237 Institution Decision, contending that the Board had overlooked that Micron allegedly did identify a data circuit in a data path. *See* EX2007 (-0237 Rehearing Request). In particular, Micron argued on rehearing that the denied Micron -0237 petition:

- (1) explained that each buffer circuit has two different data paths for reading and writing operations (-0237 Rehearing Request at 5);
- (2) stated that certain components, such as selectors 331–334 and input/output terminals 341 and 342 are included in the data paths for read and write operations (-0237 Rehearing Request at 6);
- (3) that the Petition cites paragraph 97 of Osanai which explains that the read and write data paths include FIFO (Write) circuit 301 and FIFO (Read) circuit 302 (-0237 Rehearing Request at 6);
- (4) that the components in these data paths, such FIFO (Write) and FIFO (Read) circuits, use local clocks LCLKR and LCLKW (-0237 Rehearing Request at 7);
- (5) that LCLKR and LCLKW are used for timing read and write operations (-0237 Rehearing Request at 7–8);

- (6) that local clocks LCLKR and LCKLW originate from their respective read and write leveling circuitries (-0237 Rehearing Request at 8–9); and
- (7) that because FIFO (Read) and FIFO (Write) circuits use these local clocks LCLKR and LCKLW, that the data paths include a delay circuit (read and write leveling circuits) (-0237 Rehearing Request at 11).

However, the Board in Micron -0237 was unpersuaded, finding these contentions “were never made in the Petition and, to the extent that they were, are now newly being reframed to support an argument that was also never made in the Petition.” EX2003 (-0237 Rehearing Decision) at 4. Specifically, the Board found that “one of Petitioner’s primary assertions above is that Osanai’s read and write data paths include a FIFO (Write) and FIFO (Read) circuit,” but that the Petition “makes no mention of these FIFO circuits.” *Id.* The Board also found that Micron’s rehearing argument “that the FIFO circuits use the local clocks LCKLR and LCKLW” was missing from the petition. *Id.*

The new petition does just that—arguing that Hiraishi’s allegedly discloses a “delay circuit” which includes Hiraishi’s FIFO (Write) Circuit 301 and FIFO (Read) Circuit 302. *See* Pet. 39, 47. Unsurprisingly, the new petition also contends that the local clocks LCKLR and LCKLW are used for “timing the output of the delayed data and strobe signals.” *Id.* In fact, nearly every one of the seven “contentions” found missing from the petition in Micron -0237 has found their way in some form

into the new petition. This is clear roadmapping and precisely what *General Plastic* was intended to protect against.

Finally, Micron attempts to support its claim of no “roadmapping” by arguing that its “Petition makes no changes from the instituted [Samsung] petition” Pet., 112. But that misses the point because the Samsung -0847 petition itself is already fully roadmapped based on the -0237 Institution Decision.³ *See Uniloc*, 10 (rejecting time-barred petitioner’s understudy argument as “unpersuasive”).

D. General Plastic Factor #5: Micron Provides No Adequate Explanation For The Time Elapsed Before Its Petition.

Factor #5— “whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent”—favors denial. Micron admits it would have been time-barred but for the possibility of joining the Samsung -0847 petition. That does not excuse its *original* delay in filing the Micron -0237 petition.

This factor should not favor institution because doing so would reward petitioners who wait until close to the one-year bar to file a first petition or who do

³ Patent Owner vigorously disagrees that the prior art in Samsung -0847 renders obvious the claims of the ’608 patent for at least the reasons set forth in the Patent Owner Response. *See generally*, Samsung -0847, Paper 20.

not include prior art they should have known about, and then when that first attempt fails argue that it had no time to file a second petition.

E. General Plastic Factor #6: If Samsung Settles, Micron, A Time-Barred Party, Would Be Able To Continue The IPR As If Micron Had Brought The Present Challenge In The First Instance.

Factor 6—“the finite resources of the Board”—favors denial. Here, were Samsung to settle with Netlist, Micron would be able to continue the IPR in its stead despite the fact that it would be time-barred otherwise. As the Board found in the precedential *Uniloc* decision

[W]e agree with Patent Owner that because this is Apple’s second petition, should Microsoft settle, Apple would stand in to continue a proceeding that would otherwise be terminated. Joinder in this circumstance would allow Apple to continue a proceeding even after settlement with the primary petitioner, based on a second attempt by Apple. On balance, we conclude that this sixth *General Plastic* factor weighs in favor of denying institution of the proceeding.

Uniloc, 12; *id.*, 4 (“the copied petition is Petitioner’s second challenge 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.”); *see also HTC* at 13 (“Like in *Uniloc*, joinder in this circumstance would allow Petitioner HTC to continue a proceeding even after settlement with the primary petitioner, based on a

second attempt by Petitioner HTC.... Therefore, we determine the sixth General Plastic factor weighs in favor of denying institution.”).

Just as in *Uniloc* and *HTC*, Micron, a time-barred party, should not be permitted to prolong this IPR.

F. General Plastic Factor #7: Allowing Micron To Join Complicates The Ability To Reach A Final Determination Within The One Year Period.

Factor 7—“the requirement under 35 U.S.C. 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review”—is at best neutral. *See Koss* at 13 (finding Factor 7 is neutral even when “there is no evidence or persuasive argument towards this factor”).

Finally, Micron’s argument that *Uniloc* is distinguishable makes no sense. *See* Pet., 114. Micron admits that the *General Plastic* factors do apply in the case of joinder, and applies each factor. *See id.* (note that in *Uniloc* “the petitioner failed to address a majority of the General Plastic factors, claiming they were simply irrelevant or inapplicable,” but that here “Petitioners do not argue that *General Plastic* does not apply, and alternatively applies each factor.”). But because the *General Plastic* factors do apply and Micron has not overcome the reasoning underlying *Uniloc*, Micron’s second petition should be denied.

IV. CONCLUSION

Based on the foregoing, the Board should deny the Petition and Micron’s

motion to join the -0847 IPR.

Dated: April 25, 2024

Respectfully submitted,

By: /Jonathan M. Lindsay/

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CERTIFICATE OF WORD COUNT

I hereby certify, pursuant to 37 C.F.R. section 42.24, that the foregoing Patent Owner Preliminary Response contains 4,392 words, excluding the words in the table of contents, table of authorities, exhibit list, this certificate of word count, and certificate of service. The word count is based on the word count of the Microsoft Word program used to prepare the Patent Owner Preliminary Response.

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. section 42.6, that on April 25, 2024, a complete copy of the foregoing document **PATENT OWNER PRELIMINARY RESPONSE** and **EXHIBITS 2001 – 2007** were served by electronic mail, as agreed to by the parties, upon the following:

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