

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TEXAS INSTRUMENTS INCORPORATED

Petitioner

v.

BELL SEMICONDUCTOR, LLC

Patent Owner

Patent No. 7,345,245

**PETITIONER'S MOTION FOR JOINDER UNDER
35 U.S.C. § 315(c), 37 C.F.R. § 42.22, AND § 42.122(b)**

I. STATEMENT OF PRECISE RELIEF REQUESTED

Texas Instruments Incorporated (“Petitioner” or “TI”) respectfully submits this Motion for Joinder concurrently with a Petition (“TI Petition”) for *inter partes* review of U.S. Patent No. 7,345,245 (“the ’245 Patent”).

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b), TI requests institution of an *inter partes* review and joinder with IPR2024-00168, *NXP USA, Inc. v. Bell Semiconductor, LLC* (“NXP IPR”), instituted May 8, 2024. This Motion for Joinder and the currently filed Petition are being filed within a month of institution, pursuant to 37 C.F.R. 42.122(b). NXP does not oppose TI’s joinder to the NXP IPR. TI’s 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 IPR¹, and therefore, would create no additional burden for the Board, Petitioner NXP, or Patent Owner if joined. Joinder would therefore lead to an efficient resolution of the patentability of the ’245 Patent.

TI is currently named as a defendant in *Bell Semiconductor, LLC v. Texas Instruments Incorporated*, Case No. 4:23-cv-00609, pending in the Eastern District

¹ The TI Petition includes different arguments regarding discretionary denial under *Fintiv* based on the specific facts relevant to TI, including the *Sotera* stipulation TI served on Patent Owner.

of Texas, where Patent Owner is asserting the '245 Patent against TI. TI has not previously filed a petition for IPR challenging the patentability of the '245 Patent.

TI stipulates that if joinder is granted, it will act as an “understudy” and will not assume an active role unless Petitioner NXP ceases to participate in the proceeding. Petitioner NXP will maintain the lead role in the proceeding so long as it remains in the proceeding. These limitations will avoid lengthy and duplicative briefing. TI also will not seek additional depositions or deposition time. Joinder will not impact the trial schedule because TI agrees to be bound by the scheduling order in the NXP IPR proceeding.

In fact, joinder will help efficiently resolve the disputes among the parties. By joinder, a single Board decision may dispose of the issues raised in the NXP IPR for all interested parties.

Joinder will not unduly prejudice any party. Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or needlessly increase filings, any additional costs on Patent Owner will be minimal. On the other hand, denial of joinder would prejudice TI. TI's interests may not be adequately protected if Petitioner NXP settles with Patent Owner and the NXP IPR is terminated. TI should be allowed to join in a proceeding affecting a patent asserted against it.

Given the similarities of the proceedings, the lack of undue prejudice to Patent Owner, and the potential benefit to the public and to the Board that would accrue by

TI's cooperative participation, in an understudy role, the Board should institute IPR and grant TI's Motion for Joinder.

II. ARGUMENT

A. Legal Standards and Applicable Rules

A petitioner may request joinder, without prior authorization, up to one month after the institution date of the proceeding to which joinder is requested. 37 C.F.R. § 42.122(b); *Taiwan Semiconductor Mfg. Co., Ltd. v. Zond LLC*, IPR2014-00781 and IPR2014-00782, Paper 5 at 3 (PTAB May 29, 2014).

The Board has discretion to grant a motion for joinder of a petitioner for *inter partes* review to another *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). In determining whether to exercise its discretion to grant a motion for joinder, the Board considers: (1) reasons why joinder is appropriate; (2) any new grounds of unpatentability asserted in the petition; (3) what impact (if any) joinder would have on the trial schedule for the existing review; and (4) specifically how briefing and discovery may be simplified. *See Dell, Inc. v. Network-I Security Solutions, Inc.*, IPR201300385, Paper 17 at 3 (July 29, 2013).

B. TI's Motion for Joinder is Timely

Joinder may be requested "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). TI's motion for joinder is timely, as it is being filed within a month of the May 8,

2024 institution date of the NXP IPR.

C. Petitioner NXP Does Not Oppose Joinder

TI has conferred with Petitioner NXP, and NXP does not oppose TI's joinder to the NXP IPR.

D. The Four Factors Favor Joinder

Each of the four factors weighs in favor of granting TI's Motion for Joinder. TI's Petition is substantively identical to the petition in the NXP IPR; it presents no new grounds of unpatentability. Joinder will have no impact on the pending schedule of the NXP IPR. Moreover, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

1. Joinder of TI Is Appropriate Because It Will Promote an Efficient Determination of the Patentability of the '245 Patent Without Prejudice to Any Party

TI seeks to join the NXP IPR in order to ensure that an accused infringer with an active interest in the proceeding remains a party to this IPR if Petitioner NXP's participation is terminated prior to completion. Thus, joining TI to the NXP IPR is the most practical way to secure the just, speedy, and inexpensive resolution of the challenge to the '245 Patent. *See* 37 C.F.R. § 42.1(b).

If TI is joined as a party, the patentability of the grounds raised in the NXP IPR can be determined in a single proceeding. Joinder is also appropriate because TI's petition challenges the patentability of the same claims of the '245 Patent on identical grounds to those in the NXP IPR. There are no substantive differences

between TI's and Petitioner NXP's Petition in this respect. *See*, IPR2024-00168, Paper 1. TI also relies on the same supporting evidence in its Petition as is relied on in the NXP IPR. A consolidated proceeding, including TI and Petitioner NXP, will therefore be more efficient and less wasteful, as only a single trial on these common grounds would be required. *See, e.g., Oracle America Inc. v. Realtime Data LLC*, IPR2016-01672, Paper 13 at 7 (PTAB Mar. 7, 2017) (noting that "joining Oracle's identical challenges to those in the 1002 IPR will lead to greater efficiency while reducing the resources necessary from both Realtime and the Board"). The Board "routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding." *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016- 00962, Paper 12 at 9 (PTAB Aug. 24, 2016) (internal quotations and citations omitted).

Joining TI as a party to the NXP IPR would promote the public interest relating to the unpatentability of the '245 Patent and not cause any undue prejudice to Patent Owner or Petitioner NXP. The Patent Owner must respond to the common grounds of unpatentability identified in NXP's and TI's Petitions regardless of joinder.

2. TI's Petition Does Not Raise Any New Grounds of Unpatentability and Therefore Does Not Add Additional Complexity to the Grounds in the NXP IPR

TI's Petition challenges the patentability of the '245 Patent on identical

grounds to those in the NXP IPR. *See* IPR2024-00168, Paper 1. TI's supporting materials—including its supporting expert declaration, exhibits, and exhibit numbering—are identical to those presented in the NXP IPR. *See supra* n.2. Accordingly, no new grounds are being introduced. *See Sony Corp. v. Memory Integrity, LLC.*, IPR2015-01353, Paper No. 11 at 5-6 (PTAB Oct. 5, 2015).

Therefore, consolidation of this proceeding with NXP's via joinder of TI's Petition will not raise any new issues of unpatentability and will not impose any additional burden on the Board or Patent Owner, or add additional complexity to the case.

3. Joinder Will Not Affect the Schedule in the NXP IPR

Given that TI agrees to adhere to all applicable deadlines set forth in the NXP IPR Scheduling Order, joinder of TI would not affect the schedule in any potential forthcoming trial.

4. Joinder Will Simplify Briefing Because TI Has Agreed to an Understudy Role if the NXP Petitioner Remains

To further prevent joinder from imposing any burden on Petitioner NXP, Patent Owner, or the Board and to further ensure that there are no changes in the potential trial schedule, TI has agreed, as long as Petitioner NXP remains a party to the NXP IPR, to take an understudy role, which will simplify briefing and discovery. In this role, TI agrees to the following conditions:

- (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. Unless and until the Petitioner NXP ceases to participate in the instituted NXP IPR, TI will not assume an active role.

Accordingly, due to TI taking only an “understudy” role, Patent Owner will only need to respond to one principal set of papers, will not require additional time to address additional arguments raised by TI, and can thus proceed with the existing trial schedule. These steps will minimize or eliminate any potential

complications or delay that could potentially result from joinder. *See Sony*, Paper No. 11 at 6-7 (granting motion because “joinder would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board” where second petitioner agreed to “understudy” role). TI will also abide by any additional conditions the Board deems appropriate for an “understudy” role.

5. Joinder Will Result in No Prejudice to Patent Owner

As noted above, TI’s joining of the NXP IPR proceeding should not result in any prejudice to Patent Owner. No additional grounds or arguments are being introduced, no new evidence or issues are being added, and no additional discovery or briefing or oral argument should be necessary as a result of TI’s joinder. Thus, Patent Owner would not need to expend any additional resources beyond those required in the current NXP IPR.

III. INSTITUTION IS APPROPRIATE UNDER *GENERAL PLASTIC*

General Plastic does not apply here because TI has not previously challenged the ’245 Patent and seeks to join the NXP IPR in an understudy role. *See General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 15-19 (PTAB Sept. 6, 2017); *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00224, Paper 10 at 4-5 (PTAB Apr. 6, 2020).

Factor 1: Under *General Plastic*, factor 1 considers “whether the same

petitioner previously filed a petition directed to the same claims of the same patent.” *General Plastic* at 16. Here, TI has not previously filed a petition against the ’245 Patent.

TI and Petitioner NXP are separate, unrelated petitioners, and are not similarly situated for purposes of Factor 1. This factor weighs in favor of institution and against discretionary denial.

Factors 2, 4 and 5: As to the timing examined in these factors, TI did not previously file a first petition prior to its current petition, and while TI became aware of the prior art references in the NXP IPR, it made no serial attack on the ’245 Patent and has filed this petition for IPR prior to institution. These factors weigh in favor of institution and against discretionary denial.

Factor 3: As TI did not previously file a first petition, this factor weighs in favor of institution and against discretionary denial.

Factors 6 and 7: As stated above, TI seeks to join the NXP IPR and is not raising arguments beyond those raised by the NXP petition. These factors thus weigh in favor of institution, as there should be no material impact on the Board’s finite resources or its ability to issue a final determination on the NXP petition within one year.

IV. CONCLUSION

For the foregoing reasons, TI respectfully requests that its Petition for *Inter*

partes review of the '245 Patent be instituted and that TI be joined to the NXP IPR proceeding IPR2024-00168.

Respectfully submitted,

Dated: June 7, 2024

/Joshua A. Griswold/

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on June 7, 2024, a complete and entire copy of this Petitioner's Motion for Joinder was provided by Express Mail, to the Patent Owner, by serving the correspondence address of record as follows:

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