

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.

IPR2024-00370
Patent 10,268,608 B2

Before JON M. JURGOVAN, SHEILA F. McSHANE, and
KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

McSHANE, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

Denying Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

Micron Technology, Inc., Micron Semiconductor Products, Inc., and Micron Technology Texas LLC (collectively “Petitioner” or “Micron”) filed a Petition requesting *inter partes* review of claims 1–12 of U.S. Patent No. 10,268,608 B2 (Ex. 1001, “the ’608 patent”), along with the supporting Declaration of Dr. Robert Wedig. Paper 1 (“Pet.”); Ex. 1003. Petitioner filed a Motion for Joinder with *Samsung Electronics Co., Ltd. v. Netlist, Inc.*, IPR2023-00847 (“Samsung IPR”). Paper 3. (“Mot.”).

Netlist, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

We have authority under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

For the reasons described below we do not institute an *inter partes* review of the challenged claims and we deny Petitioner’s Motion for Joinder.

A. Real Parties-in-Interest

Petitioner identified itself, Micron Technology, Inc., Micron Semiconductor Products, Inc., and Micron Technology Texas LLC, as the real parties-in-interest. Pet. xv.

Patent Owner identifies the real party-in-interest as Netlist, Inc. Paper 5, 1.

B. Related Matters

The parties identify these related matters:

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Samsung Electronics Co., Ltd. v. Netlist, Inc., IPR2023-00847;
Netlist, Inc. v. Micron Technology, Inc., No. 1:22-cv-00136 (W.D. Tex.);
Netlist, Inc. v. Micron Technology, Inc., No. 2:22-cv-00203 (E.D. Tex.);
Netlist, Inc. v. Samsung Electronics Co., Ltd., No. 2:22-cv-00293 (E.D. Tex.);
Netlist, Inc. v. Micron Technology, Inc., 2:22-cv-00294 (E.D. Tex.);
Netlist, Inc. v. Samsung Electronics Co., Ltd., No. 2:21-cv-00463 (E.D. Tex.);
Micron Technology, Inc. v. Netlist, Inc., IPR2022-00237 (“Micron IPR”);
Micron Technology, Inc. v. Netlist, Inc., IPR2022-00236;
Samsung Electronics Co., Ltd. v. Netlist, Inc., IPR2022-00711;
Micron Technology, Inc. v. Netlist, Inc., IPR2023-00205; and
SK hynix Inc. v. Netlist, Inc., IPR2017-00730.

Pet. xv–xvi; Paper 5, 1–2.

As discussed in the Decision on Institution in the Samsung IPR, because Patent Owner disclaimed claims 6–12 of the ’608 patent, we instituted *inter partes* review of claims 1–5 in that proceeding. IPR2023-00847, Paper 13 at 6–8 (PTAB Dec. 12, 2023) (Decision on Institution), Ex. 2001 (Samsung IPR). In this proceeding, Petitioner asserts the same grounds as those in the Samsung IPR. *Compare* Pet. 1, with IPR2023-00847, Paper 1, 1. In view of Patent Owner’s disclaimer of claims 6–12, the challenges that remain in the Samsung IPR, as well as in this proceeding, are:

Ground	Claim(s) Challenged	35 U.S.C §	Reference(s)/Basis
1	1–5	103(a) ¹	Hiraishi ² , Butt ³
2	1–5	103(a)	Ground 1, Tokuhiro ⁴
3	5	103(a)	Ground 1 or 2, Ellsberry ⁵

Pet. 1.

C. The '608 Patent

The '608 patent, titled “Memory Module with Timing-Controlled Data Paths in Distributed Data Buffers,” relates to a memory system which controls timing of memory signals based on timing information. Ex. 1001, codes (54), (57). Figure 2A, reproduced below, illustrates a memory module. *Id.* at 2:43–45, 4:65–66.

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 103, and was effective on March 16, 2013. Because the '608 patent claims priority before the effective date of the applicable AIA amendments (*see* Ex. 1001, code (60)), we refer to the pre-AIA version of 35 U.S.C. § 103.

² US 2010/0312956 A1, published December 9, 2010 (Ex. 1005, “Hiraishi”).

³ US 2007/0009791 A1, published January 11, 2007 (Ex. 1029, “Butt”).

⁴ US 8,020,022 B2, issued September 13, 2011 (Ex. 1006, “Tokuhiro”).

⁵ US 2006/0277355 A1, published December 7, 2006 (Ex. 1007, “Ellsberry”).

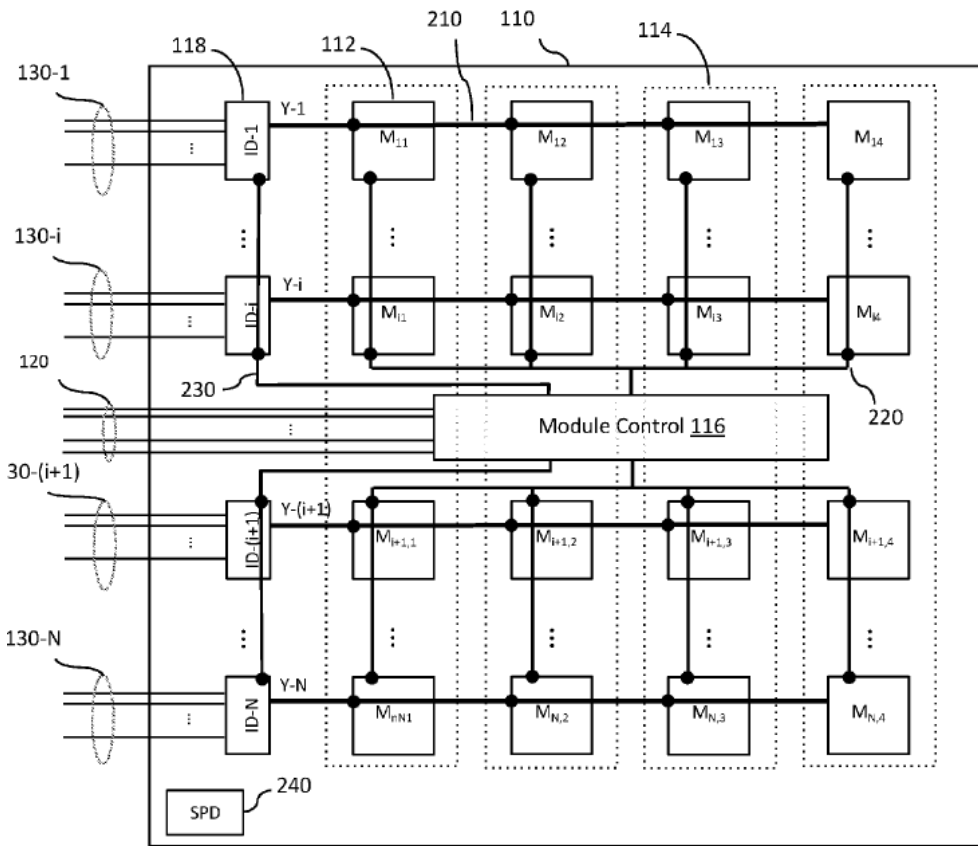


FIG. 2A

As shown in Figure 2A, above, memory module 110 includes module control device 116 and a plurality of memory devices 112. Ex. 1001, 4:65–66, 6:4–5. Memory module 110 further includes control/address signal lines 120 and data/strobe signal lines 130, which are coupled to a memory controller (MCH) (not shown). *Id.* at 4:20–23, 4:65–5:4. Respective groups of data/strobe signal lines 130 are also coupled to respective isolation devices, or buffers, 118, that is, the group of data/strobe signal lines 130-1 is coupled to isolation device ID-1, for example. *Id.* at 4:23–25; *see id.* at 6:20–25. Furthermore, each isolation device 118 is associated with, and coupled to, a respective group of memory devices via module data/strobe lines 210. *Id.* at 6:17–20, 6:30–32. As an example, along the top of memory module 110 shows isolation device ID-1 “is associated with [a] first group of

memory devices M_{11} , M_{12} , M_{13} , and M_{14} , and is coupled between the group of system data/strobe signal lines 130-1 and the first group of memory devices” via module data/strobe lines 210. *Id.* at 6:20–25.

In operation, memory module 110 “perform[s] memory operations in response to memory commands (e.g., read, write, refresh, precharge, etc.)” Ex. 1001, 3:29–32. Those commands are transmitted over control/address signal lines 120 and data/strobe signal lines 130 from the memory controller. *Id.* at 3:32–34, 4:66–5:3. For example, “[w]rite data and strobe signals from the controller are received and buffered by the isolation devices 118 before being transmitted to the memory devices 112 by the isolation devices 118.” *Id.* at 7:63–66. And “read data and strobe signals from the memory devices are received and buffered by the isolation devices before being transmitted to the MCH via the system data/strobe signal lines 130.” *Id.* at 7:66–8:3.

As can be seen in Figure 2A, and as the ’608 patent explains, there are “unbalanced” lengths of control wires to respective memory devices which causes a “variation of the timing” of signals due to the variation in wire length. *See* Ex. 1001, 2:20–31; *see also id.* at 8:22–55. To account for timing issues, each isolation device, or data buffer, 118 is “responsible for providing a correct data timing” and “providing the correct control signal timing.” *Id.* at 8:56–9:3. In particular, “isolation devices 118 includes [a] signal alignment mechanism to time the transmission of read data signals based on timing information derived from a prior write operation.” *Id.* at 15:23–26. For example, because write signals are received by isolation device 118, isolation device 118 uses that knowledge and determines timing information which is used to “properly time transmission” of a later-read operation. *Id.* at 15:45–50.

Claim 1 is the only independent claim. Claim 1, which is illustrative, is reproduced below, with bracketed letters provided by Petitioner (*see* Pet. xii) added to limitations for reference purposes.

1. [pre] A memory module operable to communicate with a memory controller via a memory bus, the memory bus including signal lines, the signal lines including a set of control/address signal lines and a plurality of sets of data/strobe signal⁶ lines, the memory module comprising:

1[a] a module board having edge connections for coupling to respective signal lines in the memory bus;

1[b] a module control device mounted on the module board and configured to receive system command signals for memory operations via the set of control/address signal lines and to output module command signals and module control signals in response to the system command signals, the module control device being further configured to receive a system clock signal and output a module clock signal; and

1[c] memory devices mounted on the module board and configured to receive the module command signals and the module clock signal, and to perform the memory operations in response to the module command signals, the memory devices including a plurality of sets of memory devices corresponding to respective sets of the plurality of sets of data/strobe signal lines; and

1[d] a plurality of buffer circuits corresponding to respective sets of the plurality of sets of data/strobe signal lines, 1[e] wherein each respective buffer circuit of the plurality of buffer circuits is mounted on the module board, coupled between a respective set of data/strobe signal lines and a respective set of memory devices, and configured to receive the module control signals and the module clock signal, the each respective buffer circuit including a data path corresponding to each data signal line in

⁶ Data signal lines are referred to as “DQ” signal lines, and data strobe lines are referred to as “DQS” signal lines. *See* Ex. 1001, 10:31–35.

the respective set of data/strobe signal lines, and a command processing circuit configured to decode the module control signals and to control the data path in accordance with the module control signals and the module clock signal, 1[f] wherein the data path corresponding to the each data signal line includes at least one tristate buffer controlled by the command processing circuit and a delay circuit configured to delay a signal through the data path by an amount determined by the command processing circuit in response to at least one of the module control signals.

Ex. 1001, 19:14–55.

II. DISCRETIONARY DENIAL

A. Background

In a petition filed on December 23, 2021, Petitioner previously challenged claims 1–5 of the '608 patent in *Micron Technology, Inc. v. Netlist, Inc.*, IPR2022-00237 (“Micron IPR”), based on grounds different than those asserted here. *See* Ex. 2001, 4. In the previous Micron IPR, institution was denied on the merits because the Board found that Petitioner had not sufficiently demonstrated that the prior art disclosed limitation 1[f], that is, “the data path . . . includes . . . a delay circuit.” *See* Ex. 2002, 19–20. Subsequently, a Petition was filed by Samsung Electronics Co., Ltd. in the Samsung IPR on April 27, 2023, and institution was granted on December 12, 2023. IPR2023-00847, Paper 1, Paper 13. The instant Petition was filed in this proceeding on January 10, 2024, and Petitioner seeks joinder with the Samsung IPR.⁷ Paper 1, Paper 3.

Petitioner asserts the same challenges to the same claims as those in

⁷ Petitioner was time barred from filing a petition on the '608 patent after April 28, 2022 under 35 U.S.C. § 315(b), but may be joined as a party to an instituted review under 35 U.S.C. § 315(c). *See* Pet. 113.

the Samsung IPR. *Compare* Pet. 1, with IPR2023-00847, Paper 1, 1. Petitioner asserts that the Petition submitted here “is substantively identical to Samsung Electronics Co. Ltd.’s petition (‘Samsung Petition’) in the Samsung IPR,” and Patent Owner does not dispute this representation. Mot. 1; *see generally* PO Prelim. Resp. Having already considered the merits of the challenges in the Samsung IPR, we similarly find that the challenges here similarly present a reasonable likelihood of prevailing on the challenge of at least one claim of the ’608 patent.

Patent Owner argues, however, that we should exercise our discretion and deny institution and joinder under *General Plastic*. Prelim. Resp. 4–20 (citing *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i) (“*General Plastic*”). Patent Owner cites to the *Uniloc* case to support its assertion that discretionary denial applies to joinder requests for “me-too petitions” like the one here. *Id.* at 1–2, 4–6 (citing *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 at 4 (PTAB Oct. 28, 2020) (precedential) (“*Uniloc*”). Petitioner argues that the petitioner in *Uniloc* argued that *General Plastic* did not apply and failed to address the majority of its factors, but here Petitioner does not argue that *General Plastic* does not apply and also presents arguments on its factors.⁸ Pet. 114 (citing *Uniloc*, 4–5).

We agree that under *Uniloc*, “[t]hat Petitioner seeks to join . . . does not obligate us to institute this proceeding without first considering whether

⁸ Petitioner refers to the decision in *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9, as the “*Apple*” decision. We refer to it as the “*Uniloc*” decision herein.

to exercise discretion under § 314(a).” *Uniloc*, 4–5. Accordingly, “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).” *Id.* at 5.

B. General Plastic Factors

There is no requirement that we institute an *inter partes* review. 35 U.S.C. § 314; *see Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an [*inter partes* review] proceeding.”). Rather, a decision whether to institute is within the Director’s discretion. *See* 37 C.F.R. § 42.4(a) (2018); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); Consolidated Trial Practice Guide (“CTPG”)⁹, 55 (“Sections 314(a) and 324(a) provide the Director with discretion to deny a petition.” (citations omitted)).

In *General Plastic*, the Board articulated a list of factors to be considered in evaluating whether to exercise discretion under 35 U.S.C. § 314(a) to deny a petition that challenges a patent that was previously challenged before the Board. *General Plastic*, 15–16; *see also* CTPG at 55–58 (stating that the Board will consider the *General Plastic* factors when determining whether to institute a trial). These factors are:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew

⁹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

of the prior art asserted in the second petition or should have known of it;

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;
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;
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;
6. the finite resources of the Board; and
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.

General Plastic, 16 (citing *NVIDIA Corp. v. Samsung Elecs. Co.*, IPR2016-00134, Paper 9 at 6–7 (PTAB May 4, 2016)); *see also* CTPG at 56–57. Both Petitioner and Patent Owner address these factors (*see* Pet. 111–115; Prelim. Resp. 6–21), and we now apply the *General Plastic* factors to the facts of this case.

C. General Plastic Factor Evaluation

1. Factor 1

The first *General Plastic* factor asks “whether the same petitioner previously filed a petition directed to the same claims of the same patent.” *General Plastic*, 16. Petitioner asserts that *General Plastic*’s factors 1, 2, and 3 should be considered together. Pet. 111–112 (citing *CODE200, UAB v. Bright Data Ltd.*, IPR2022-00861, Paper 18 at 5 (Aug. 23, 2022) (“*CODE200*”). Petitioner contends that it is “simply adopt[ing] the Samsung IPR petition” and is acting as an understudy. *Id.* at 112. Patent

Owner argues that Petitioner previously filed a petition in the Micron IPR, and the issue that the instant Petition is a follow-on petition to that in the Samsung IPR “is of no import.” Prelim. Resp. 6–7.

The first factor simply asks whether the same petitioner previously filed a petition directed to the same claims of the same patent. Petitioner previously filed such a petition in the Micron IPR, so we find that this factor favors discretionary denial.

2. Factors 2 and 4

The second *General Plastic* factor asks whether at the time of the filing the petitioner knew or should have known of the prior art. *General Plastic*, 9. The fourth factor asks what is 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. *Id.*

Petitioner argues that evidence of “road-mapping” concerns should be considered in the assessment of these factors. Pet. 111–112 (citing *CODE200*, 5). Petitioner contends that there is no evidence of road-mapping because there is no evidence that it modified its earlier petition in the Micron IPR—rather, Petitioner contends, it has “simply adopted the Samsung IPR petition essentially verbatim.” *Id.* at 112. Petitioner contends that because it has not made any changes from the petition in the Samsung IPR, “the roadmapping concerns addressed in *General Plastic* . . . are not present here.” *Id.* at 112 (quoting *Intel Corporation v. VLSI Technology LLC*, IPR2022-00366, Paper 14 at 11 (June 8, 2022) (“*Intel*”)).

Petitioner additionally asserts that the petition in the Samsung IPR introduced a new reference, Butt, and that Petitioner had no knowledge of that reference at the time it filed its petition in the Micron IPR. Pet. 112–

113. Petitioner contends that the Butt reference did not show up in its previous prior art searches and was not in its invalidity contentions. *Id.* at 113. Petitioner therefore argues that factor 4 weighs against discretionary denial. *Id.* Petitioner further argues that its representation about its lack of knowledge of Butt distinguishes it from *Uniloc* because in that case the petitioner did not address the issue, but rather argued that the factor did not apply. *Id.* at 114–115 (citing *Uniloc*, 8; *Google LLC v. Express Mobile Inc.*, IPR2022-00791, Paper 15 at 7–8 (PTAB Oct. 7, 2022)).

We address the issue of road mapping in the discussion of factor 3 below. But the issue we consider for the assessment of factor 2 is whether Petitioner should have known of the prior art at the time of the filing of the petition in the Micron IPR. *See General Plastic* at 19–20. Patent Owner argues, and we agree, that Petitioner does not provide sufficient explanation why it could not have been aware of Butt at the time of its earlier petition in the Micron IPR. Prelim. Resp. 9–10. As *General Plastic* states: “[t]he relevant issue under factor 2 is whether [the prior art references] could have been found with reasonable diligence. . . . [A] petitioner is free to explain why a reasonably diligent search could not have uncovered the newly applied prior art.” *General Plastic*, at 20. Petitioner provides no support explaining the nature and extent of the prior searching done for the Micron IPR, but rather states in a perfunctory manner that the Butt reference was not found in the searching. Pet. 112–113. Therefore, in view of the dearth of evidence provided, there is little to support and demonstrate that a reasonably diligent search had been previously done.

As to factor 4, the length of time elapsed between the time the petitioner learned of the second petition’s prior art and the filing of the

second petition, Petitioner represents that it did not have knowledge of Butt at the time of the first Micron petition, the reference never showed up in any of Petitioner’s prior art searches, and Petitioner did not disclose Butt in its invalidity contentions. Pet. 112–113. In response, Patent Owner argues that Petitioner had identified Butt in its invalidity contentions in a litigation involving a related patent, U.S. Patent No. 10,860,560 (a continuation of the ’608 patent), on November 21, 2022, which is prior to the time of the filing of the Samsung IPR. Prelim. Resp. 10–11 (citing Ex. 2005, 7). Although related patents may implicate different prior art, we agree with Patent Owner (*id.* at 11) that the evidence of knowledge of the reference in another case provides support that Petitioner reasonably could have had earlier knowledge of Butt.

Accordingly, we find that factors 2 and 4 favor discretionary denial.

3. *Factor 3*

The third *General Plastic* factor asks “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.” *General Plastic*, at 16. The Board explained the relevance of this factor in *General Plastic* in terms of unfair benefit to petitioners from follow-on petitions:

[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 All

other factors aside, this is unfair to patent owners and is an inefficient use of the *inter partes* review process and other post-grant review processes.

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

Petitioner contends that we should consider whether there is any evidence of “road-mapping” concerns here. Pet. 111–112 (citing *CODE200*, 5; *General Plastic*, 17). More specifically, Petitioner argues that there is no evidence of “road mapping” because Petitioner “simply adopted the Samsung IPR petition essentially verbatim” and agrees to act as an understudy. *Id.* at 112. Petitioner asserts that the factors weigh against discretionary denial because that there is no evidence that there was strategic staging of prior art and arguments using prior decisions as a roadmap—thus, there are no road mapping concerns. *Id.* (citing *General Plastic*, 17; *Intel* at 11).

We disagree. In our earlier decision in the Micron IPR, institution was denied because petitioner did not demonstrate sufficient support that the asserted anticipatory reference disclosed that write and read leveling circuitry were included in the data paths, as the independent claim recited. Ex. 2002, 19–20. In the Samsung IPR, the petitioner there asserts an obviousness challenge rather than an anticipation challenge to the independent claim, and a secondary reference, Butt, was added to address the deficiencies of the petition of the previous Micron IPR petition. The challenge in the Samsung IPR was modified in a manner that was directed to the deficiencies of the Micron IPR, and therefore appears to be an attempt to use the information gained in the Micron IPR to improve the possible success of the later petition. In other words, the Samsung IPR appears to use our prior decision as a roadmap. *See General Plastic*, 17–18. By moving

for joinder to the Samsung IPR, Petitioner is also therefore seeking to capitalize on the benefits of this road mapping. As *Uniloc* states, “the copied petition is Petitioner’s second challenge to the patent” and “[i]n effect, it would be as if [petitioner] brought the second challenge to the patent,” wherein “[t]his is the kind of serial attack that *General Plastic* was intended to address.” *Uniloc*, 4 (citing *General Plastic* at 17).

Petitioner cites to decisions in *CODE200* and *Intel* in its arguments on road mapping issues. See Pet. 111–112 (citing *CODE200* at 5; *Intel* at 11). Those cases are distinguishable from the situation here. Here, as discussed, the merits were reached in Micron’s first petition and, accordingly, road mapping is considered. In *CODE200* and *Intel*, institutions were discretionarily denied for the petitioners’ first respective petitions and the merits were not reached, so potential road mapping was not at issue in those cases. See *CODE200* at 5; *Intel* at 8.

Accordingly, we find that factor 3 favors discretionary denial.

4. Factor 5

The fifth *General Plastic* factor queries “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.” *General Plastic*, at 16.

Petitioner asserts that it was time barred from filing a petition after April 28, 2022, and upon the institution of the Samsung IPR, it sought joinder. Pet. 113. Petitioner argues that “[b]ecause the present petition is filed within the one-month allowed window, and Petitioner[] could not have joined the Samsung IPR petition earlier than this window, this factor weighs against discretionary denial.” *Id.*

Patent Owner responds that Petitioner’s explanation does not excuse its original delay in filing the petition in the Micron IPR. Prelim. Resp. 18. Patent Owner further asserts that “[t]his 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 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.” *Id.* at 18–19.

Because Petitioner provides at least some explanation for the time elapsed between the filings of the petitions,¹⁰ we find that this factor does not favor discretionary denial.

5. Factor 6

The sixth *General Plastic* factor considers “the finite resources of the Board.” *General Plastic* at 16. Petitioner asserts that “instituting Petitioners’ review would require expending minimal additional Board resources, given this petition presents the same grounds and arguments as the already instituted Samsung IPR, and Petitioners agreed to take an understudy role.” Pet. 113. Patent Owner disagrees, arguing that denial is favored because if “Samsung [were] 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.” Prelim. Resp. 19.

We agree with Patent Owner on this issue. As *Uniloc* states:

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

¹⁰ In *Uniloc*, although factor 5 was found to weigh in favor of discretionary denial, Petitioner provided no explanation for the time elapsed. *See Uniloc* at 11.

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 at 12.

The circumstances in this case are similar to those in the *Uniloc* case; if Samsung were to settle, Micron could step into their shoes and allow the case to continue.

Accordingly, we find that factor 6 favors discretionary denial.

6. *Factor 7*

The seventh *General Plastic* factor considers “the requirement . . . to issue a final determination not later than 1 year after the date on which the Director notices institution of review.” *General Plastic*, at 16.

Petitioner asserts that factor 7 “ha[s] limited relevance [here], as the Board noted that the one year statutory time period may be adjusted for a joined case under 35 U.S.C. § 316(a)(11).” Pet. 113 (quoting *CODE200*, 6). Patent Owner similarly asserts that this factor “is at best neutral.” Prelim. Resp. 20.

We agree that factor 7 is neutral.

7. *Summary*

In summary, we determine that factors 1–4 and 6 weigh against institution, factor 5 weighs in favor of institution, and factor 7 is neutral.

Considering these factors as a whole, and on this record, we determine that it is appropriate to exercise our discretion under 35 U.S.C. § 314(a) to deny institution of an *inter partes* review of the challenged claims of the

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'608 patent.

III. MOTION FOR JOINDER

The Director may join a party to an ongoing *inter partes* review only if the filed petition warrants institution under § 314. *See* 35 U.S.C. § 315(c). Because we are exercising discretion to deny institution under § 314, we deny Petitioner's Motion for Joinder.

IV. ORDER

Accordingly, it is:

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review is *denied*; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 315(c), Petitioner's motion for joinder is *denied*.

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