

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WINTEK CORPORATION,
Petitioner,

v.

TPK TOUCH SOLUTIONS, INC.,
Patent Owner.

Case IPR2013-00567
Case IPR2014-00541
Patent 8,217,902 B2

Before JOSIAH C. COCKS and RICHARD E. RICE, *Administrative Patent Judges*.

COCKS, *Administrative Patent Judge*.

DECISION
Motion for Joinder
37 C.F.R. § 42.122(b)

I. INTRODUCTION

Petitioner, Wintek Corporation (“Wintek”), filed a Motion for Joinder in connection with *inter partes* review proceeding IPR2014-00541 pursuant to 37 C.F.R. §§ 22 and 122(b). Paper 3. In the Motion, Wintek requests joinder of IPR2014-00541 with either related proceeding IPR2013-00567 or related proceeding IPR2013-00568. All of the noted proceedings involve U.S. Patent No. 8,217,902 B2 (“the ’902 patent”), and each involves the same parties.

In a separate “Joint Motion To Modify Schedule” (e.g., IPR2014-00541, Paper 10), the parties jointly requested revised scheduling for the IPR2013-00567 and IPR2013-00568 proceedings. The parties also indicated that, in the event that trial is instituted in IPR2014-00541, the parties will follow the scheduling set forth in IPR2013-00567 and IPR2013-00568. E.g., IPR2014-00541, Paper 10, 2. The Joint Motion further indicates that Patent Owner, TPK Touch Solutions Inc. (“TPK”), does not oppose Wintek’s Motion for Joinder should the Board institute trial in IPR2014-00541. *Id.*

For the reasons set forth below, we grant Wintek’s Motion for Joinder, to the extent that we join IPR2014-00541 with IPR2013-00567.

II. DISCUSSION

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

(c) JOINDER.--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.

In a Decision on Institution of *Inter Partes* Review (IPR2014-00541, Paper 13) entered concurrently with this Decision on Motion for Joinder, we determine to institute trial of claims 20, 23, 28, and 30 of the '902 patent. In that regard, we institute trial on the basis that Wintek has shown a reasonable likelihood of prevailing in its assertion that those claims are unpatentable over Binstead¹, Miller², and Honeywell³. Paper 13, 25. The '902 patent is involved in each of IPR2014-00541 and IPR2014-00567, as noted above, and there is overlap in the cited prior art in the two proceedings. Wintek's Motion for Joinder was filed timely, and, as noted above, is not opposed by TPK. We also do not discern prejudice to either party in joining the IPR2014-00541 and IPR2014-00567 proceedings. Accordingly, we conclude that the record reflects factors favorable to granting Wintek's Motion for Joinder.

As noted above, the parties have agreed to follow the scheduling set forth in IPR2013-00567, in connection with IPR2014-00541. The scheduling is set forth in the "Revised Due Date Appendix" that is included with the Decision on Joint Motion to Modify Schedule (IPR2013-00567, Paper 21). As set forth in that Decision, TPK's Patent Owner response to the petition and any motion to amend the patent is due June 20, 2014 (Due Date 1). Due Date 1 is approaching rapidly. Should TPK need additional time to file its Patent Owner response, the parties are reminded that, as was set forth in the original Scheduling Order (IPR2013-00567, Paper 11), the parties may stipulate to changes in Due Dates 1-3 without authorization from the Board. The parties are encouraged to work together in that

¹ US 6,137,427 issued October 24, 2000 (Ex. 1005).

² US 5,374,787, issued December 20, 1994 (Ex. 1008).

³ Japanese Patent Application 61-84729, published April 30, 1986 (Ex. 1010)—translation Ex. 1011.

regard. In the event that TPK needs more time, and if the parties cannot stipulate to changes in Due Dates 1-3, the parties should arrange a conference call with the Board.

III. ORDER

For the foregoing reasons given, it is:

ORDERED that Wintek's Motion for Joinder is granted;

FURTHER ORDERED that this proceeding (IPR2014-00541) is joined with IPR2014-00567;

FURTHER ORDERED that the Schedule as set forth in the "Revised Due Date Appendix" that is included with the Decision on Joint Motion to Modify Schedule (IPR2013-00567, Paper 21) shall hereafter govern the schedule of the joined proceedings;

FURTHER ORDERED that the IPR2014-00541 proceeding is terminated under 37 C.F.R. § 42.72 and all further filings in the joined proceedings shall be made in IPR2013-00567; and

FURTHER ORDERED that the case caption in IPR2012-00567 shall be changed to reflect the joinder with this proceeding in accordance with the attached example.

Case IPR2014-00541
Patent 8,217,902 B2

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