

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

PATENT: RE43,707

INVENTOR: TOM KIMPE ET AL.

FILED: DECEMBER 28, 2011      ISSUED: OCTOBER 2, 2012

TITLE: METHODS, APPARATUS, AND DEVICES FOR NOISE REDUCTION

CASE NO.: IPR2014-00778

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**MOTION FOR JOINDER TO RELATED INTER PARTES REVIEW (37  
C.F.R. § 42.122(b))**

Petitioner Eizo Corporation (“Eizo”) files this Motion for Joinder of *inter partes* review, Case No. IPR2014-00778 (“Second Petition”), with the *inter partes* review, Case No. IPR2014-00358 (“First Petition”), pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b).

No fee is required for consideration of this Motion. Petitioner Eizo has paid the fee for the First and Second Petitions for *inter partes* review. Should this be incorrect, the Patent Office is authorized to charge the necessary fee Quinn Emanuel Urquhart & Sullivan deposit account no. 505708.

## **I. APPLICABLE RULES**

37 C.F.R. § 42.122(b) states in pertinent part:

Request for joinder. Joinder may be requested by a patent owner or petitioner. Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested.

## **II. RELIEF REQUESTED**

In this Motion, Petitioner Eizo requests that the Second Petition be joined with the First Petition.

## **III. STATEMENT OF MATERIAL FACTS**

1. Patent Owner Barco N.V. (“Barco”) filed a patent infringement action against Eizo on September 2, 2011, alleging infringement of U.S. Patent No.

7,639,849 ("the '849 patent") in the Northern District of Georgia, Atlanta Division, Case No. 1:11-CV-2964 ("the Litigation"). Over three months later, Patent Owner surrendered its patent and filed a broadening reissue application of the '849 patent in the United States Patent & Trademark Office ("USPTO") on December 28, 2011. The broadening reissue application sought to add new claims 38-115 while leaving original claims 1-37 unchanged.

2. In light of the reissue initiated by Barco, Eizo asked the Court to stay the proceedings of the Litigation. Eizo's reasons for seeking the stay included: (1) with the patent under review by the USPTO, the scope of the patent and number/scope of final claims were unsettled; (2) until the scope of the patent is settled by the USPTO, litigation is premature, a waste of resources, and would force the parties to litigate a patent that could well be gone by the conclusion of the litigation; (3) courts routinely grant stays when no trial date has been set and the case is in the early stages of discovery; and (4) there is no prejudice to either party to litigate the case once the patent has been finalized. The Court agreed with Eizo and stayed the matter on April 20, 2012. The stay remains in place.

3. Eizo prepared and filed a request for *inter partes* reexamination (the "IP Reexam") on July 18, 2012, seeking reexamination of all 37 of the original claims of the '849 patent.

4. While the decision on whether or not to grant the request for the IP Reexam remained pending, the USPTO issued a first action Notice of Allowance in the broadening reissue application on August 2, 2012, finding all 115 claims allowable without rejecting any of the claims over prior art. The broadening reissue application issued as U.S. Patent No. RE 43,707 (“the ‘707 patent”) on October 2, 2012, with the original claims 1-37 and newly added claims 38-115 unchanged during prosecution.

5. Since the '707 patent issued prior to the grant of the IP Reexam, the USPTO considered whether to grant the request for the IP Reexam based on the original claims 1-37 as well as claims 38-115 added in the reissue. The USPTO issued an Order on October 15, 2012 granting reexamination of original claims 1-35 and 37 as well as claims 38-45, 47-53, 55-63, 83, 84, 89, 90, 95-97, 105, 106 and 108-115 added by reissue concurrently with an Office Action rejecting the claims. Barco filed a Response on December 17, 2012, adding new claims 116-120.

6. At the time that the IP Reexam was granted on October 15, 2012, *inter partes* reexamination was no longer an available procedure at the USPTO. In addition, under the Rules at the time, an *inter partes* review of the ‘707 patent was unavailable until nine months after its issue date of October 2, 2012, which was July 2, 2013.

7. With no option to file an *inter partes* procedure for any of the claims of the '707 patent until July 2, 2013, Eizo filed a request on December 28, 2012, for an *ex parte* reexamination ("Ex Parte Reexam") of claims 36, 46, 54, 64-82, 85-88, 91-94, 98-104, and 107 of the '707 patent (collectively, the "Ex Parte Reexam Claims"), which were the claims not included in the IP Reexam.

8. On January 17, 2013, Barco amended its complaint in the Litigation, asserting infringement of the '707 patent for the first time.

9. On March 19, 2013, the USPTO granted the request for Ex Parte Reexam on all grounds and issued a Non-Final Office Action rejecting all of the Ex Parte Reexam Claims.

10. Barco filed a Response to the Non-Final Office Action in the Ex Parte Reexam on May 18, 2013 that amended claims 66, 67, 76, 80-82, 85, 91, 100 and 101, canceled claim 92, and added new claims 121-135. Claims 121-135 were renumbered as claims 116-130, respectively.

11. On September 20, 2013, the USPTO issued a Final Office Action in the Ex Parte Reexam in which claims 64, 65, 67-73, 77-79, 81, 82, 91, 98 and 99 remained rejected, new claims 116-118 were rejected, claims 36, 46, 54, 66, 74-76, 80, 85-88, 93, 94, 100-104 and 107 were confirmed, and new claims 119-130 were found patentable.

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