

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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EIZO CORPORATION  
Petitioner

v.

BARCO N.V.  
Patent Owner

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Case IPR2014-00778  
Patent No. US RE43,707 E

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PATENT OWNER'S OPPOSITION TO  
PETITIONER'S MOTION FOR JOINDER

## I. INTRODUCTION

Petitioner's Motion for Joinder filed July 21, 2014 seeks to join this proceeding to Case IPR2014-00358. Patent Owner Barco N.V. respectfully submits its opposition to that motion, said opposition being compliant with the time limits of Rule 42.25(a)(1) and the page limits of Rule 42.24(b)(3).

Rule 42.1 states that Part 42 "shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding."

Rule 42.20(c) reads as follows: "*Burden of proof*. The moving party has the burden of proof to establish that it is entitled to the requested relief."

The Office has stated that a motion for joinder "should address the reasons why joinder is appropriate, identify any new ground(s) of unpatentability asserted in the petition, and explain what impact (if any) joinder would have on the schedule for the existing review." Frequently Asked Question ("FAQ") H5 on the Board's website at <http://www.uspto.gov/ip/boards/bpai/prps.jsp>.

## II. RESPONSE TO ALLEGED MATERIAL FACTS

Alleged fact 2 is denied as to its representations of the Court's reasons for staying the litigation pending resolution of the reissue proceedings. Those reasons are set forth in the Court's own words in the two-page order of Exhibit 2001. In

this order, the Court specifically concluded “that a stay would not unduly prejudice the plaintiffs” and “would simplify the issues in this case.” The Court also noted “that no trial date has been set” and that “the plaintiffs have broadened their reissue application since filing its complaint.”

Alleged fact 6 is denied. Public Law 112-274 (the “Technical Corrections Act”) became effective on January 14, 2013, such that *inter partes* review of the ‘707 Patent was available to the Petitioner by statute more than five months before the July 2, 2013 date it argues.

Alleged fact 7 is denied. An *inter partes* procedure on the ‘707 Patent -- the *inter partes* reexamination requested by the Petitioner itself -- was already in progress when the Petitioner filed its request for *ex parte* reexamination.

Alleged fact 8 is denied. All claims that were asserted to be infringed in the original complaint, which was served on the Petitioner on October 7, 2011, continued unamended in the ‘707 Patent. Under Section 252, the civil action continued on those claims of the ‘707 Patent, unaffected by the surrender and reissue.

Alleged fact 15 is denied as to its representations of the Petitioner’s reasons for its actions and omissions, and also for the reasons set forth in the denial of alleged fact 8.

Alleged fact 20 is denied. In fact, claims 64 and 65 were among the claims challenged by the Petitioner in its first petition.

### III. STATEMENT OF ADDITIONAL MATERIAL FACTS

1. The Technical Corrections Act was enacted and became effective on January 14, 2013: less than three weeks after the Petitioner filed its request for *ex parte* reexamination.

2. Even before the Petitioner filed its request for *ex parte* reexamination, it was common knowledge that a technical amendment to address the so-called “dead zone” was about to be enacted. See, e.g., Exhibits 2002, 2003.

3. Patent Owner’s Amended Complaint was deemed filed as of January 17, 2013 and was served on the Petitioner electronically via the District Court’s CM/ECF (Case Management / Electronic Case Filing) system. Exhibits 2004, 2005.

4. The Technical Corrections Act was already in effect when the amended complaint was served on the Petitioner on January 17, 2013.

5. The Office’s final rules to implement the Technical Corrections Act became effective on March 25, 2013: less than one week after the Petitioner’s

request for *ex parte* reexamination was granted, and nearly six months before a Final Office Action was issued in that proceeding.

6. More than one year after the Technical Corrections Act became effective on January 14, 2013, the Petitioner filed its first petition on January 17, 2014.

7. The Petitioner never requested a stay of the *ex parte* reexamination it had initiated in the '707 Patent.

8. The Petitioner's second petition was filed on May 20, 2014: more than sixteen months after the amended complaint was served on the Petitioner.

#### **IV. RESPONSE TO PETITIONER'S ARGUMENTS**

##### **A. EFFICIENCY COMPELS DENIAL OF THE MOTION**

On page 8 of its motion, the Petitioner argues that joinder is proper because "it would be a waste of resources to have separate proceedings handled by different panels to conduct the review of the two Petitions." The Patent Owner respectfully notes that this statement is misleading at best. In fact, there cannot be a separate review of the second petition, at least because it was filed more than one year after service of the amended complaint on the Petitioner. Standing alone, this petition is time-barred. In truth, therefore, the most efficient solution would clearly be to

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