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Paper 18
Entered: 10 October 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EIZO CORPORATION,
Petitioner,

v.

BARCO N.V.,
Patent Owner.

Case IPR2014-00358
Patent RE43,707 E

Before KALYAN K. DESHPANDE, JAMES B. ARPIN, and DAVID C. McKONE, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* DESHPANDE.

Opinion Concurring filed by *Administrative Patent Judge* McKONE.

DESHPANDE, *Administrative Patent Judge*.

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

I. INTRODUCTION

Eizo Corporation ("Petitioner") filed a corrected Petition (Paper 6, "Pet.") requesting an *inter partes* review of claims 64–66, 68–76, 80, 85–88, 91, 98–100, and 116–129 of U.S. Patent No. RE43,707 E (Ex. 1001, "the '707 patent"). Subsequently, Petitioner filed a Motion for Joinder (Paper 11, "Mot."), seeking to join this proceeding with *Eizo Corp. v. Barco N.V.*, Case IPR2014-00358 (PTAB) ("the '358 proceeding"). Patent Owner filed an Opposition (Paper 12, "Opp.") to Petitioner's Motion for Joinder. Petitioner submitted a Reply (Paper 16, "Reply") to Patent Owner's Opposition to Petitioner's Motion for Joinder. For the reasons that follow, Petitioner's Motion for Joinder is *denied*. As a result of this denial, separately, we deny *inter partes* review, as requested in the corrected Petition, as time-barred under 35 U.S.C. § 315(b). Paper 18, 3–4.

II. LEGAL STANDARDS

The Leahy-Smith America Invents Act, Pub. L. No. 112-29 (2011), permits joinder of like review proceedings. Thus, an *inter partes* review may be joined with another *inter partes* review. The statutory provision governing joinder of *inter partes* review proceedings is 35 U.S.C. § 315(c), which provides:

> 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.

(emphasis added).

As the movant, Petitioner bears the burden to show that joinder is appropriate. 37 C.F.R. § 42.20(c). We also consider that the Board's rules for AIA proceedings "shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding." 37 C.F.R. § 42.1(b); *see* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,758 (Aug. 14, 2012).

III. ANALYSIS

As discussed further below, Petitioner's argument and evidence are insufficient to persuade us to exercise our discretion to join the instant Petition and the '358 proceeding. In its Motion for Joinder, Petitioner contends that joinder is appropriate because: (1) "it will be more efficient to conduct the *inter partes* review [of this proceeding and the '358 proceeding] as part of a single proceeding;" (2) "there is no discernible prejudice to either party;" and (3) "Petitioner has been diligent and timely in filing the motion [for joinder] and Second Petition." Mot. 7–9.

1. Efficiency

Petitioner argues that both the instant Petition and the '358 proceeding include "the same patent, the same parties, common claim limitations and common prior art" and, therefore, granting joinder will be more efficient for the Board and both parties. *Id.* 7–8. Petitioner further identifies common

claim limitations between "[e]very single claim in the Second Petition and every single claim being reviewed in IPR2014-00358." Reply 2–3.

Patent Owner argues, however, that the instant Petition "raises numerous substantive issues that are not before the Board in Case IPR2014-00358." Opp. 6–8. Specifically, Patent Owner argues that the instant Petition raises different issues than those in the '358 proceeding because it: "(1) challenges thirty-five new claims (claims 64–66, 68–76, 80, 85–88, 91, 98–100, and 116–129); (2) asserts eleven new grounds of unpatentability; and (3) asserts nine prior art references, only two of which are at issue in the existing proceeding." *Id.* at 6.

We are not persuaded by Petitioner that granting joinder between the instant Petition and the '358 proceeding will increase efficiency. We agree with Patent Owner that the instant Petition challenges claims not present in the '358 proceeding and asserts several new grounds of unpatentability. We also agree with Patent Owner that the instant Petition includes several prior art references that were not considered in our Institution Decision for the '358 proceeding. Although Petitioner contends that several claim limitations overlap between the instant Petition and the '358 proceeding, we determine that the number of new claims challenged, the number of new asserted grounds of unpatentability, and the number of new prior art references will complicate the case and decrease, rather than increase, the efficiency of the proceedings, if joined.

2. Prejudice to Parties

Petitioner argues that the instant Petition and the '358 proceeding involve many of the same prior art references, similar claim limitations, and the same number of issues; and, therefore, the parties are not prejudice by joining the two proceedings. Mot. 8–9. We are not persuaded by this argument for the same reasons discussed above with respect to efficiency.

3. Diligent and Timely in Filing

Petitioner argues that it has been diligent and timely in filing the instant Petition and the Motion for Joinder because the instant Petition challenges claims that "only became subject to a potential *inter partes* review when they issued in the Reexamination Certificate," and Petitioner "prepared and filed the Second Petition less than two months after the issue date of the Reexamination Certificate and within four months of the filing date of the First Petition." Mot. 9. Patent Owner argues, however, that Petitioner waited over sixteen months to file the instant Petition and Petitioner filed several other proceedings prior to filing the instant Petition and, therefore, Petitioner was not diligent and timely. Opp. 8–9.

We determine that Petitioner was timely in filing its Motion for Joinder. 37 C.F.R. § 42.122(b). However, we need not decide whether Petitioner was diligent and timely in filing the instant Petition in order to decide Petitioner's Motion for Joinder. Even if we consider Petitioner to have been diligent and timely in filing the instant Petition and the Motion for Joinder, in view of our discussion in the preceding and following Sections of

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