

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.,
Petitioner,

v.

INNOVATIVE DISPLAY TECHNOLOGIES LLC,
Patent Owner.

Case IPR2015-00490
Patent 7,300,194 B2

Before LORA M. GREEN, THOMAS L. GIANNETTI, and
BEVERLY M. BUNTING, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and Grant of Motion for Joinder
37 C.F.R. § 42.108
37 C.F.R. § 42.122(b)

I. INTRODUCTION

LG Electronics, Inc. (“Petitioner” or “LG Electronics”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1, 4–6, 16, 22, 23, 27, 28, and 31 (“the challenged claims”) of U.S. Patent No. 7,300,194 B2 (Ex. 1001, “the ’194 patent”), and concurrently filed a Motion for Joinder (Paper 3, “Mot.”). The Motion for Joinder seeks to join this proceeding with *LG Display Co., Ltd. v. Innovative Display Technologies LLC*, Case IPR2014-01097 (“the LGD IPR”). Mot. 1. Patent Owner filed a Preliminary Response (Paper 8), as well as an Opposition to the Motion for Joinder (Paper 7). For the reasons described below, we institute an *inter partes* review of all the challenged claims and grant Petitioner’s Motion for Joinder.

II. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same grounds as those on which we instituted review in the IPR2014-01097. On January 13, 2015, we instituted a trial in the IPR2014-01097 on the following grounds:

Reference(s)	Basis	Claims Challenged
Pristash ¹	§ 103	1, 4–6, and 28
Funamoto ²	§ 102	1, 16, 22, 23, 27, and 31
Funamoto	§ 103	4, 5, and 6
Kobayahi ³	§ 102	28
Nishio ⁴	§ 102	1, 4–6, and 28

¹ Pristash, U.S. Patent No. 5,005,108, issued Apr. 2, 1991 (Ex. 1006).

² Funamoto, U.S. Patent No. 5,619,351, issued Apr. 8, 1997 (Ex. 1007).

³ Kobayashi, U.S. Patent No. 5,408,388, issued Apr. 18, 1995 (Ex. 1011).

LG Display Co., Ltd. v. Innovative Display Technologies LLC, Case IPR2014-01097, slip. op. at 18 (PTAB January 13, 2015) (Paper 9) (“‘1097 Decision”).

In view of the identity of the challenge in the instant Petition and in the petition in the IPR2014-01097, we institute an *inter partes* review in this proceeding on the same grounds as those on which we instituted *inter partes* review in IPR2014-01097. We do not institute *inter partes* review on any other grounds.

III. REAL PARTY-IN-INTEREST

Patent Owner contends that the Petition does not meet the requirements of 35 U.S.C. § 312(a) as it does not name all the real parties-in-interest. Prelim. Resp. 10. Specifically, Patent Owner contends that LG Display Co., Ltd. and LG Display America, Inc., should have been named as real party in interests. *Id.*

Patent Owner made a similar assertion in the IPR2014-01097, as well as IPR2014-01096, with respect to Petitioner.⁵ For the reasons stated in Decision Instituting *inter partes* Review the IPR2014-01096, slip. op. at 16–17 (PTAB January 13, 2015) (Paper 11), we conclude that Patent Owner’s Preliminary Response fails to provide convincing evidence that the Petition should be denied on the grounds that it fails to name LG Display Co., Ltd., and LG Display America, Inc., as real parties-in-interest.

⁴ Nishio, U.S. Patent No. 5,598,280, issued Jan. 28, 1997 (Ex. 1012).

⁵ In both IPR2014-01096 and IPR2014-01097, Patent Owner contended that the Petitioner here, LG Electronics, Inc., should have been named as a real party-in-interest, along with LG Display. IPR2014-01096, Paper 9, 18–20; IPR2014-01097, Paper 7, 2–4.

IV. GRANT OF MOTION FOR JOINDER

An *inter partes* review may be joined with another *inter partes* review, subject to the provisions of 35 U.S.C. § 315(c), which governs joinder of inter partes review proceedings:

(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 parties review under section 314.

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder should: (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *See* Frequently Asked Question H5,

<http://www.uspto.gov/patentsapplication-process/appealing-patentdecisions/trials/patent-reviewprocessing-system-prps-0>.

The Petition in this proceeding has been accorded a filing date of December 29, 2014 (Paper 6), which is before the date of institution in IPR2014-01097, which was instituted on January 13, 2015. The Petition, therefore, satisfies the joinder requirement of being filed within one month of our instituting a trial in IPR2014-01097. 37 C.F.R. § 42.122.

In its Motion for Joinder, Petitioner contends that the grounds asserted in the instant Petition are

the same grounds of unpatentability [LG Display Co. Ltd. ("LGD")] asserted in the LGD IPR; Petitioner's arguments regarding the asserted references are identical to the arguments

LGD raised in the LGD IPR; and Petitioner has submitted, in support of their petition, the same declaration of the technical expert that LGD submitted in support of its petition (excluding some minor changes made to reflect Petitioner's engagement of the same expert). Thus, this proceeding does not raise any new issues beyond those already before the Board in the LGD IPR.

Mot. 6. Petitioner represents that joinder will not prevent the Board from completing its review in “the statutorily prescribed timeframe,” and that “joinder will ensure the Board’s efficient and consistent resolution of issues surrounding the invalidity of the ’194 patent.” *Id.* at 1. According to Petitioner, the Board can accomplish this by requiring “consolidated filings and coordination among petitioners.” *Id.* at 2. Thus, Petitioner contends, the instant proceeding does not raise any issues that have not already been raised in IPR2014-01097. *Id.* at 6.

Patent Owner opposes joinder, contending that Petitioner argues only that the grounds asserted in the instant Petition and the one asserted in the IPR2014-01097 are identical, and has not provided any additional reasoning as to why joinder is appropriate. Paper 7, 6–7 (citing *Unified Patents, Inc. v. Personalweb Technologies, LLC* and *Level 3 Communications, LLC*, Case IPR2014-00702, slip. op. at 4 (PTAB January 13, 2015) (Paper 12)).

As discussed above, joinder is discretionary. In *Unified Patents*, cited by Patent Owner, the panel noted that joinder is not automatic, but is discretionary based on the particular circumstances of each proceeding. In the instant proceeding, we agree with Petitioner that joinder with IPR2014-01097 would promote the efficient resolution of those proceedings. Petitioner has brought the same challenges as presented in IPR2014-01097, thus, the substantive issues in IPR2014-01097 would not be unduly complicated by joining with this proceeding because joinder merely

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