

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.,
Petitioner,

v.

INNOVATIVE DISPLAY TECHNOLOGIES LLC,
Patent Owner.

Case IPR2016-00914
Patent No. 7,537,370 B2

Before THOMAS L. GIANNETTI, MIRIAM L. QUINN, and
BEVERLY M. BUNTING, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review
37 C.F.R. § 42.108

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

I. INTRODUCTION

VIZIO, Inc. (“Petitioner”) filed a Petition pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 29 and 47 of U.S. Patent No. 7,537,370 (“the ’370 patent”). Paper 1 (“Pet.”). Concurrently, Petitioner filed a Motion for Joinder. Paper 3 (“Joinder Motion”). The Joinder Motion seeks to join this proceeding with *K.J. Pretech Co., Ltd. v. Innovative Display Technologies LLC*, IPR2015- 01867 (“the ’1867 IPR”), which concerns the ’370 patent at issue here. Joinder Motion 1. Innovative Display Technologies LLC (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”). We instituted trial in the ’1867 IPR on March 17, 2016. ’1867 IPR, Paper 15 (“’1867 Institution Decision”). For the reasons described below, we institute an *inter partes* review of all challenged claims and grant Petitioner’s Motion for Joinder.

II. INSTITUTION OF *INTER PARTES* REVIEW

A. References

Petitioner relies on the same two references for which trial was instituted in the ’1867 IPR:

Pristash	US 5,005,108	Apr. 2, 1991	Ex. 1007
Suzuki	JP H03-189679	Aug. 19, 1991	Ex. 1008 ¹

Petitioner also states that it is relying on Admitted Prior Art (“APA”) from the ’370 patent specification. Pet. 9 (citing Ex. 1001, col. 2, ll. 58–65). Petitioner also relies on the same Declaration of Thomas L. Credelle as was filed in the ’1867 IPR. Ex. 1004.

B. Grounds Asserted

The Petition in this proceeding asserts the same grounds as those on which we instituted review in the '1867 IPR. Those are:

References	Basis	Claims Challenged
Suzuki	§ 103(a)	29
Suzuki and Pristash	§ 103(a)	47

C. Real Parties-in-Interest

Petitioner contends that VIZIO, Inc. is the real party-in-interest. Pet. 2. Patent Owner does not challenge this assertion.

D. Related Matters

Petitioner identified several lawsuits involving the '370 patent brought by Patent Owner and several other *inter partes* review proceedings involving the '370 patent and related patents. Pet. 2–3.

E. Decision

In view of the identity of the challenges to the '370 patent in this Petition and in the petition in the '1867 IPR, we institute an *inter partes* review in this proceeding on the same grounds as those on which we instituted *inter partes* review in the '1867 IPR.

We have considered the arguments advanced by Patent Owner in the Preliminary Response. Prelim. Resp. 3–14. We are not persuaded by those arguments for at least the reasons stated in our '1867 Institution Decision. We are not persuaded by Patent Owner's additional argument that the Petition is untimely. Prelim. Resp. 1. The Petition was timely filed under 37 C.F.R. § 42.122. *See infra*.

We do not institute *inter partes* review on any other grounds.

III. 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):

(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.

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).

To be considered timely, a motion for joinder must be filed no later than one month after the institution date of the *inter partes* review for which joinder is requested. 37 C.F.R. § 42.122(b). The Petition in this proceeding has been accorded a filing date of April 18, 2016. Paper 4. This date is within one month of the date of institution in the '1867 IPR, which was instituted on March 17, 2016. The Petition, therefore, is timely.

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/patents-application-process/appealing-patent-decisions/trials/patent-review-processing-system-prps-0#heading-13> (last visited July 2, 2015).

Petitioner contends that joinder with the '1867 IPR is appropriate because the Petition here presents grounds of unpatentability that are identical to the grounds on which the Board instituted trial in the '1867 IPR,

relying on the same prior art, the same substantive arguments, and the same expert testimony as the '1867 IPR Petition and our Institution Decision.

Joinder Motion 4. Petitioner states the only differences are that the Petition here omits the grounds on which the Board did not institute review as well as formalities of different parties filing a petition. *Id.*

Petitioner contends it would be prejudiced if joinder is denied, for example, if the petitioner in the '1867 IPR, K.J. Pretech Co., Ltd. ("K.J. Pretech"), were to cease participating. *Id.* at 4–5. On the other hand, Petitioner contends that the parties to the '1867 IPR would not be prejudiced if joinder were granted. *Id.* at 5. Petitioner states: "Given that [Petitioner] is relying on the same art, arguments, and evidence as [the petitioner in the '1867 IPR], its joinder in an understudy role will not impact Patent Owner, put it to any additional expense, or create any delay." *Id.*

Petitioner contends joinder will not negatively impact the trial schedule in the '1867 IPR. Joinder Motion 6. Also, Petitioner contends discovery and briefing in the '1867 IPR can be simplified because Petitioner "explicitly agrees to take an 'understudy role.'" *Id.* at 6–7.

While opposing granting of the Petition, Patent Owner has not opposed joinder.

As discussed above, joinder is a matter within the Board's discretion based on the particular circumstances of each proceeding. In this proceeding, we are persuaded that Petitioner has demonstrated that joinder with the '1867 IPR would avoid duplication and promote the efficient resolution of both proceedings. Petitioner has brought the same challenges presented by the '1867 IPR; thus, the substantive issues would not be unduly complicated by joining the proceedings. Joinder merely introduces the same

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