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Paper No. 9
Filed: July 7, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.,
Petitioner,

v.

NICHIA CORPORATION,
Patent Owner.

Case IPR2017-00551
Patent 7,915,631 B2

Before BRIAN J. McNAMARA, STACEY G. WHITE, and NABEEL U. KHAN, *Administrative Patent Judges*.

WHITE, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Vizio, Inc. ("Petitioner") filed a Petition (Paper 2, "Pet.") seeking to institute an *inter partes* review of claims 1–4, 7, 8, 10, and 11 of U.S. Patent No. 7,915,631 B2 (Ex. 1001, "the '631 patent") pursuant to 35 U.S.C. §§ 311–319. Nichia Corporation ("Patent Owner") filed a Preliminary Response. (Paper 8, "Prelim. Resp."). We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition."

Petitioner contends the challenged claims are unpatentable under 35 U.S.C. § 103 on the following specific grounds (Pet. 15–57):

References	Claims Challenged
Baretz[1]	1, 2, 10, and 11
Baretz and Matoba[2]	1, 2, 10, and 11
Baretz and Pinnow[3]	3, 4, 7, and 8
Baretz, Matoba, and Pinnow	3, 4, 7, and 8

For reasons discussed below, we deny Petitioner's request to institute *inter partes* review of claims 1–4, 7, 8, 10, and 11 of the '631.

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[1] U.S. Patent No. 6,600,175 (Ex. 1004, "Baretz").

[2] JP Patent Pub. No. H7-99345 with certified translation (Ex. 1005, "Matoba").

[3] U.S. Patent No. 3,699,478 (Ex. 1006, "Pinnow").

B. Related Proceedings

We have been informed that *Nichia Corp. v. VIZIO, Inc.*, C.A. No. C.A. No. 8:16-cv-545 (C.D. Cal.), may be impacted by this proceeding. Pet. 5. In addition, Petitioner has filed petitions seeking *inter partes* review of several related patents, 7,901,959 (IPR2017-00552), 7,855,092 (IPR2017-00556), and 8,309,375 (IPR2017-00558). *See id.*

A. The '631 patent

The '631 patent describes a light emitting diode ("LED") containing phosphor. Ex. 1001, 1:28–31. LEDs "emit[] light of clear color with high efficiency" and are free from such trouble as burn-out and are durable enough to endure repetitive ON/OFF operations. *Id.* at 1:33–37. As described in the specification, prior attempts to emit white light from LEDs had unsatisfactory results due to "variations in the tone, luminance and other factors of the light emitting component" and in addition, it was sometimes necessary to use complex circuitry to compensate for variations between materials used to create the LEDs. *Id.* at 1:55–61. The '631 patent purports "to solve the problems described above and provide a light emitting device which experiences only extremely low degrees of deterioration in emission light intensity, light emission efficiency and color shift over a long time of use with high luminance." *Id.* at 3:1–7. Figure 1 of the '631 patent is reproduced below.

Fig.1

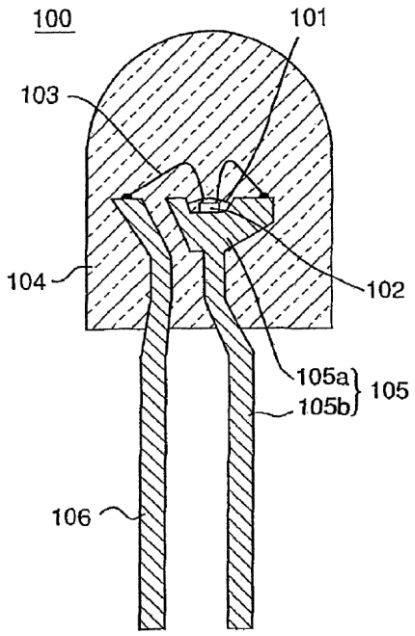

Figure 1 is a schematic sectional view of a lead type LED. *Id.* at 4:53–55. LED 100 has light emitting component 102, which is installed in cup 105a. *Id.* at 8:34–35. Coating resin 101 fills cup 105a and the resin contains a specified phosphor to cover light emitting component 102. *Id.* at 8:35–37. Light emitting component 102, which is also known as an LED chip, "excites the phosphor contained in the coating resin 101 to generate fluorescent light having a wavelength different from that of LED light, so that the fluorescent light emitted by the phosphor and LED light which is output without contributing to the excitation of the phosphor are mixed and output." *Id.* at 8:45–50. Thus, LED 100 emits light having a different wavelength than the light emitted by the LED chip. *Id.* at 8:50–53.

C. Illustrative Claim

Petitioner challenges claims 1–4, 7, 8, 10 and 11 of the '631 patent, of which claim 1 is independent. Claim 1 is illustrative of the challenged claims and is reproduced below:

> 1. A light emitting diode comprising:
>
> an LED chip having an electrode;
>
> a transparent material covering said LED chip, and a phosphor contained in said transparent material and absorbing a part of light emitted by said LED chip and emitting light of wavelength different from that of the absorbed light;
>
> wherein the main emission peak of said LED chip is within the range from 400 nm to 530 nm,
>
> a concentration of said phosphor in the vicinity of said LED chip is larger than a concentration of said phosphor in the vicinity of the surface of said transparent material, and
>
> said phosphor diffuses the light from said LED chip and suppresses a formation of an emission pattern by a partial blocking of the light by said electrode.

Ex. 1001, 30:59–31:6.

D. Identification of Real Parties-in-interest

Petitioner declares that it is the real party-in-interest ("RPI") pursuant to 37 C.F.R. § 42.8(b)(1). Pet. 5. That rule requires the Petition to "[i]dentify *each* real party-in-interest." 37 C.F.R. § 42.8(b)(1) (emphasis added). Patent Owner questions whether this is a complete listing of RPIs because "facts presently available to Nichia suggest that TCL Multimedia Technology Holdings Ltd. and its subsidiary, TTE Technology, Inc. (together, 'TCL'), may also be real parties-in-interest." Prelim. Resp. 7.

Patent Owner contends that Petitioner conspicuously failed to list as a related matter Patent Owner's suit against TCL in Delaware (*Nichia Corp. v. TCL Multimedia Tech. Holdings Ltd.*, Case 1:16-cv-00681 fled Aug. 8, 2016) (Ex. 2008), also alleging infringement of the '631 patent. *Id.* TCL engaged as its litigation counsel the same law firm that Petitioner engaged in

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