

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC,
Petitioner,

v.

NICHIA CORPORATION,
Patent Owner.

Case IPR2017-00556
Patent 7,855,092 B2

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

McNAMARA, *Administrative Patent Judge*.

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

BACKGROUND

Vizio, Inc. (“Petitioner”) filed a petition, Paper 2 (“Pet.”), to institute an *inter partes* review of claims 1–3, 7–9, 12, and 13 (the “challenged claims”) of U.S. Patent No. 7,855,092 (“the ’092 Patent”). 35 U.S.C. § 311. Nichia Corporation (“Patent Owner”) timely filed a Preliminary Response, Paper 8 (“Prelim. Resp.”), contending that the petition should be denied as to all challenged claims. We have jurisdiction under 37 C.F.R. § 42.4(a) and 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Having considered the arguments and the associated evidence presented in the Petition and the Preliminary Response, for the reasons described below, we decline to institute *inter partes* review.

PENDING LITIGATION

The Petition states that Patent Owner has asserted Petitioner infringes the ’092 Patent in Case No. 8:16-cv-00545 in the Central District of California (“California Matter”). Pet. 2.

REAL PARTIES-IN-INTEREST

Petitioner identifies itself as the sole real party-in-interest. Pet. 2. Patent Owner contends that Petitioner conspicuously failed to list as a related matter Patent Owner’s suit against TCL Multimedia Technology Holdings Ltd. and its subsidiary, TTE Technology, Inc. (together, “TCL”) in Delaware (*Nichia Corp. v. TCL Multimedia Tech. Holdings Ltd.*, Case 1:16-cv-00681, filed Aug. 8, 2016) (Ex. 2008), also alleging infringement of the ’092 Patent. Prelim. Resp. 7. In that suit, TCL engaged as its litigation

counsel the law firm Petitioner engaged for the California matter and thus, Petitioner and TCL share the same lead trial counsel. *Id.* at 7–8. Noting that in the Delaware case TCL responded to discovery requests concerning preparation and filing of the Petition by asserting the joint defense privilege and common interest doctrine, Patent Owner contends that TCL essentially acknowledges it was communicating with counsel for third parties, likely including Petitioner’s counsel concerning the preparation and filing of the Petition. *Id.* at 8 (citing Ex. 2011, Response Request 50).

In this proceeding, Petitioner is represented by a law firm and named counsel that is different from the firm and counsel engaged by Petitioner and TCL in the district court cases. As Patent Owner notes, it is Petitioner’s burden to establish it has complied with the statutory requirement to identify all real parties-in-interest. *Amazon.com, Inc. v. Appistry, Inc.*, Case IPR2015-00480, slip op. at 6 (PTAB July 13, 2015) (Paper 18). The mere existence of a joint defense agreement between parties represented by the same trial counsel, however, is not enough to establish that a single Petitioner represented by different counsel in an *inter partes* review has failed to name all real parties-in-interest. There is no bright line test for determining the necessary quantity or degree of participation to qualify as a real party in interest, although whether the unnamed party could have exercised control over a party’s participation is a common consideration. Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 58 (Aug. 14, 2012). In this case, Patent Owner has offered no evidence that TCL assisted in preparation or financing of the Petition or exerted any control over its filing or content. TCL’s assertion of the joint defense privilege in the district court, in and of itself, does not indicate that TCL participated in this

proceeding in such a manner as to be a real party-in-interest. TCL's response to Patent Owner's discovery request is in the form of an objection and states that subject to its objections, TCL will produce relevant, non-privileged documents responsive to this request that are in TCL's possession, custody, and control that are located after a reasonably diligent search. Ex. 2011, Request Response 50. Patent Owner does not state whether any such documents have been received, whether TCL has refused to produce any such documents, or whether there are any other indications that TCL exercised control over the filing or content of the Petition. We are not persuaded that the circumstances raise sufficient doubt about whether Petitioner has satisfied its obligation to name all real parties in interest.

THE '092 PATENT (EXHIBIT 1001)

The '092 Patent discloses that light emitting diodes (LEDs) are effective light emitting devices for generating individual colors (e.g., red, green, and blue high luminance, high efficiency LEDs), but there was no satisfactory source capable of emitting white light using such light emitting components. Ex. 1001, 1:40–46; 2:3–7. The '092 Patent states that its applicant had “previously developed light emitting diodes which convert the color of light which is emitted by light emitting components” to white and other colors using a fluorescent material. *Id.* at 2:8–16 (citing Japanese Patent Kokai Nos. 5-152609, 7-99345, 7-176794 and 8-7614). The '092 Patent states that by “mixing the light of a plurality of sources,” the applicants had obtained white light by molding a light emitting component capable of emitting blue light with a resin including a fluorescent material that absorbs light emitted by a blue light emitting component, causing the resin containing the fluorescent material to emit yellowish light. *Id.* at 2:25–

31. The '092 Patent, however, notes that conventional LEDs caused deterioration of the fluorescent material leading to color tone deviations and reductions in light extracting efficiency. *Id.* at 2:32–35.

The '092 Patent discloses a white light emitting device in which the light emitting component is a nitride compound semiconductor capable of emitting light of high luminance, preferably a gallium nitride semiconductor including indium (In) as the light emitting layer, and a phosphor that has high resistance against light so that its fluorescent properties change little even when used over a long period of time. *Id.* at 3:37–65. The phosphor preferably contains a yttrium-aluminum-garnet fluorescent material in which yttrium (Y) and Aluminum (Al) enable it to increase the luminance of the light emitting device and part of the Al is substituted by gallium (Ga) and part of the yttrium-aluminum-garnet fluorescent is substituted by gadolinium (Gd). *Id.* at 4:9–12; 4:61–5:6. The light generated by mixing blue light emitted by the light emitting component and the fluorescent light of the fluorescent material is a white light. *Id.* at 5:7–12. A fluorescent material that absorbs light of a short wavelength and emits light of a long wavelength has a higher efficiency than fluorescent material that absorbs long wavelengths and emits short wavelengths. *Id.* at 6:29–33. To improve efficiency and extend life, in the LED of the '092 Patent, the main emission peak of the light emitting component is set to a relatively short wavelength between 400 nm and 520 nm in the visible light region, and the emission wavelength of the phosphor is set longer than the main emission peak of the light emitting component. *Id.* at 6:36–43. The '092 Patent describes a first embodiment using a garnet phosphor activated with cerium to emit yellow light when excited by a blue light component that “can emit white light by

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