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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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JIAWEI TECHNOLOGY (HK) LTD.
JIAWEI TECHNOLOGY (USA) LTD.
AND
SHENZHEN JIAWEI PV LIGHTING CO., LTD.
Petitioners,
v.
LIGHTING SCIENCE GROUP CORP.
Patent Owner.

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Case No. TBD
Patent 8,672,518

MOTION FOR JOINDER UNDER
35 U.S.C. § 315(c) AND 37 C.F.R. § 42.22 AND § 42.122(b)

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I. INTRODUCTION

Jiawei Technology (HK) Ltd., Jiawei Technology (USA) Ltd., and Shenzhen Jiawei Photovoltaic Lighting Co, Ltd. ("Joinder Petitioners"), submits, concurrently with this motion, a petition for *inter partes* review ("Joinder Petition") of claims 1, 3–8, and 11–14 of U.S. Patent No. 8,672,518 ("the '518 patent") (Ex. 1001). Petitioner respectfully requests joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) of the Joinder Petition with a pending *inter partes* review filed by Technical Consumer Products, Inc., Nicor Inc., and Amax Lighting ("Original Petitioners"), IPR2017-01285 (the "'1285 IPR"). Joinder is appropriate because it will promote efficient and consistent resolution of the validity of a single patent and will not prejudice any of the parties to the '1285 IPR. Petitioner's request for joinder is timely because it was filed "no later than one month after the institution date of any inter partes review for which joinder is requested." 37 C.F.R. § 42.122(b).

II. BACKGROUND

On April 17, 2017, Original Petitioners requested review of claims 1, 3–8, and 10–14 in the '1285 IPR. On November 1, 2017, the Board instituted review of claims 1, 3–8, and 11–14, but denied review of claim 10. The instituted grounds consisted of the following:

References	Basis	Claims Challenged
Soderman and Wegner	§ 103	1, 3, 6–8, 11, 12, and 14
Soderman, Wegner, and Silescent	§ 103	4, 5, and 13
Zhang and Wegner[1]	§ 103	1, 3, 5–8, 11, 12, and 14
Zhang, Wegner, and Silescent	§ 103	4 and 13

Today, concurrent with the instant motion for joinder, Petitioner filed the Joinder Petition asserting identical arguments and grounds of unpatentability against the same patent claims as in the '1285 IPR, except for claim 10.

III. ARGUMENT

A. Legal Standard

The Board has authority to join as a party any person who properly files a petition for *inter partes* review to an instituted *inter partes* review. 35 U.S.C. § 315(c). A motion for joinder must be filed within one month of institution of any *inter partes* review for which joinder is requested. 37 C.F.R. § 42.122(b). In deciding whether to grant a motion for joinder, the Board considers several factors including: (1) the reasons why joinder is appropriate; (2) whether the party to be joined has presented any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See, e.g.*, *Hyundai Motor Co. v. Am.*

[1] Note that page 28 of the decision on institution mistakenly states this ground uses the combination of Soderman and Silescent, but the remainder of the decision makes clear the ground is as the petition proposed.

Vehicular Sciences LLC, IPR2014-01543, Paper No. 11 at 3 (Oct. 24, 2014); *Macronix Int'l Co. v. Spansion*, IPR2014-00898, Paper 15 at 4 (Aug. 13, 2014) (quoting *Kyocera Corporation v. Softview LLC*, IPR2013- 00004, Paper 15 at 4 (April 24, 2013)).

B. Petitioners' Motion for Joinder is Timely

This Motion for Joinder is timely because it is filed within one month of the November, 1 2017, decision on institution in the '1285 IPR. *See* 37 C.F.R. § 42.122(b). The one-year bar under 37 C.F.R. § 42.101(b) does not apply because the Petition is filed concurrently with this Motion for Joinder. 37 C.F.R. § 42.122(b). *See Teva Pharmaceuticals USA, Inc. v. Allergan, Inc.*, IPR2017-00579, paper 9, at 4–5.

C. Each Factor Weighs in Favor of Joinder

Each of the four factors considered by the Board weighs in favor of joinder here. The Joinder Petition is substantively identical to the Original Petition as to the subset of claims and grounds at issue and does not present any new prior art, grounds of unpatentability, exhibits, or arguments. Joinder is also appropriate so that Joinder Petitioners can maintain the proceeding, in which the Original Petitioners presented a reasonable likelihood of prevailing, in the event that Original Petitioners cease to participate. Joinder will have minimal, if any, impact on the trial schedule, as the Joinder Petition presents no new prior art analysis or

expert testimony. Discovery and briefing will be simplified because Joinder Petitioners are willing to accept a limited "understudy" role so long as Original Petitioner remains a participating party. Accordingly, joinder is appropriate and warranted here.

1. Joinder is Appropriate because No New Grounds or Issues Are Raised

The Board "routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding." *Samsung v. Raytheon*, IPR2016-00962, Paper 12, at 9 (internal quotations and citations omitted) (emphases in original).[2] Here, joinder with the pending '1285 IPR is appropriate because the Joinder Petition relies on identical arguments and the same instituted grounds at issue in the instituted proceeding. The Joinder Petition relies on the same expert declaration and other supporting

[2] *See also Sony Corp. et al. v. Memory Integrity, LLC*, IPR2015-01353, Paper 11, at 5–6 (granting institution of IPR and motion for joinder where petitions relied "on the same prior art, same arguments, and same evidence, including the same expert and a substantively identical declaration" (citations omitted)); *Perfect World Entm't, Inc. v. Uniloc USA, Inc.*, IPR2015-01026, Paper 10; *Fujitsu Semiconductor Ltd. v. Zond, LLC*, IPR2014-00845, Paper 14; *Enzymotec Ltd. v. Neptune Techs. & Bioresources, Inc.*, IPR2014-00556, Paper 19.

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