

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.,
Petitioner,

v.

NICHIA CORP.,
Patent Owner.

Case IPR2018-00386
Patent 9,490,411 B2

Before SALLY C. MEDLEY, WILLIAM V. SAINDON, and
NATHAN A. ENGELS, *Administrative Patent Judges*.

ENGELS, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

VIZIO, Inc. (“Petitioner”) filed a Petition under 35 U.S.C. § 311 requesting *inter partes* review of claims 1–3, 5–8, 10, 13, and 15–20 of U.S. Patent No. 9,490,411 B2 (Ex. 1001, “the ’411 patent”). Paper 1 (“Pet.”). Nichia Corporation (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”).

We have authority under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition and the Preliminary Response 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.” 35 U.S.C. § 314; *see also* 37 C.F.R. § 42.4(a) (“The Board institutes the trial on behalf of the Director.”). Having considered Petitioner’s Petition and Patent Owner’s Preliminary Response, we conclude that the information presented in the Petition establishes a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims. Accordingly, we institute an *inter partes* review for claims 1–3, 5–8, 10, 13, and 15–20 of the ’411 patent.

II. BACKGROUND

A. *Real Party-in-Interest*

Among other requirements, 35 U.S.C. § 312(a)(2) provides that a petition for *inter partes* review “may be considered only if . . . the petition identifies all real parties in interest.” There is no bright line test for determining whether an unnamed entity qualifies as a real party-in-interest, although a common consideration is whether the unnamed entity could have exercised control over a party’s participation in an *inter partes* review.

Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 58 (Aug. 14, 2012);

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see also Zoll Lifecor Corp. v. Philips Elects. N. Am. Corp., Case IPR2013-00609 (PTAB Mar. 20, 2014) (Paper 15) (“The non-party’s participation may be overt or covert, and the evidence may be direct or circumstantial, but the evidence as a whole must show that the non-party possessed effective control from a practical standpoint.”).

Petitioner identifies VIZIO, Inc. as the sole real party-in-interest. Pet. 5. Patent Owner contends Petitioner failed to disclose all real parties-in-interest based on a report that lists the same business address and phone number for VIZIO and AmTRAN Technology Co., Ltd. (Prelim. Resp. 29–30 (citing Ex. 2008)) and “[d]ocuments filed by V[IZIO] with the SEC in October 2015 [that] indicate that AmTran is a ‘related party’” (Prelim. Resp. 28 (citing Ex. 2007)). Further, Patent Owner states that “publicly available information suggest that V[IZIO] does not itself manufacture televisions.” Prelim. Resp. 28.

The evidence suggesting that VIZIO and AmTRAN may have (or have had in 2015) a business relationship does not establish that AmTRAN should have been named a real party-in-interest. Patent Owner has not directed us to any evidence that AmTRAN assisted in, financed, or exerted any control over the Petition filed in this proceeding.

We note that Patent Owner has presented the same evidence and arguments in other *inter partes* review proceedings. *See VIZIO, Inc. v. Nichia Corp.*, Case IPR2017-01623, Paper 8 at 60–61 (PTAB Oct. 13, 2017); *VIZIO, Inc. v. Nichia Corp.*, Case IPR2017-01623, Paper 8 at 59–61 (PTAB Oct. 13, 2017). Consistent with previous decisions from the Board and based on the current record in this proceeding, we determine that the evidence currently of record is not sufficient to support an allegation that Petitioner has failed to satisfy its obligation to name all real parties-in-

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interest. See *VIZIO, Inc. v. Nichia Corp.*, Case IPR2017-01608, Paper 10 at 2–4 (PTAB Jan. 11, 2018); *VIZIO, Inc. v. Nichia Corp.*, Case IPR2017-01623, Paper 11 at 3–4 (PTAB Jan. 11, 2018).

B. Related Proceedings

Petitioner identifies the following matters related to the '411 patent: *Nichia Corp. v. VIZIO, Inc.*, No. 2:16-cv-1453-JRG (E.D. Tex.) (lead), consolidated with Nos 2:16-cv-1452-JRG, 2:16-cv-1454-JRG, 2:16-cv-1455-JRG, 2:16-cv-616-JRG, 2:16-cv-875-JRG, 2:16-cv-00246-JRG, 2:16-cv-00613-JRG, 2:16-cv-00615-JRG, 2:16-cv-00616-JRG, and 2:16-cv-00875-JRG. Pet. 5.

Petitioner also states that Patent Owner has asserted U.S. Patent No. 8,530,250, which is related to the '411 patent, against a different party in *Nichia Corp. v. Everlight Electrics Co.*, No. 2:13-cv-702-JRG (E.D. Tex.); Appeal No. 16-1585, 16-1618 (Fed. Cir.), and Petitioner has challenged claims of the '250 patent in *VIZIO, Inc. v. Nichia Corp.*, IPR2017-01608, IPR2017-01623. Pet. 5–6. Petitioner has also challenged claims of U.S. Patent No. 9,537,071, which is also related to the '411 patent, in *VIZIO, Inc. v. Nichia Corp.*, IPR2017-00437.

C. The '411 Patent (Ex. 1001)

The '411 patent “relates to a light emitting device . . . and to a method for manufacturing a light emitting device.” Ex. 1001, 1:18–22. The method of manufacturing a light emitting device described in the '411 patent includes sandwiching a lead frame between two molds and transfer-molding a thermosetting resin into the molds to form a “resin-molded body.” The resin-molded body is then cut along notches in the lead frame to “singulate”

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the resin-molded body into individual “resin packages,” each resin package having resin molded to leads. Ex. 1001, 3:44–55.

The ’411 patent states that similar methods in the prior art had problems of inadequate adhesion between the resin and the leads such that the resin compositions could become detached from the leads after singulation. Ex. 1001, 1:42–2:37. To improve adhesion between the resin and the leads, some embodiments described in the ’411 patent include a lead frame that has been etched. *See* Prelim. Resp. 7. According to Patent Owner:

This etching may result in concavities in the side surfaces of the notches [of the lead frame]. Moreover, when singulated, resin is present in the regions below the exposed metal leads at the outer lateral surfaces in some embodiments. This improves adhesion of the resin part to the metal leads, which is one of the stated goals of the ’411 patent.

Prelim. Resp. 7 (citing Ex. 1001, 2:32–37, 9:37–42, 16:51–54).

D. Challenged Claims

Petitioner challenges claims 1–3, 5–8, 10, 13, and 15–20 of the ’411 patent. Independent claim 1 is the only independent claim challenged and is reproduced below.

1. A light emitting device comprising:
 - a resin package comprising a resin part and a metal part including at least two metal plates, said resin package having four outer lateral surfaces and having a concave portion having a bottom surface; and
 - a light emitting element mounted on the bottom surface of the concave portion and electrically connected to the metal part,wherein at least a portion of an outer lateral surface of the resin part and at least a portion of an outer lateral surface of the metal part are coplanar at an outer lateral surface of the resin package,

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