

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NICHIA CORPORATION,
Petitioner,

v.

DOCUMENT SECURITY SYSTEMS, INC.,
Patent Owner.

Case IPR2018-01166
Patent 7,256,486 B2

Before SCOTT C. MOORE, AMBER L. HAGY, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

HAGY, *Administrative Patent Judge*.

DECISION TO INSTITUTE
35 U.S.C. § 314(a)

I. INTRODUCTION

Nichia Corporation (“Petitioner”)¹ filed a Petition (Paper 2, “Pet.”) to institute an *inter partes* review of claims 1–6 (the “challenged claims”) of U.S. Patent 7,256,486 B2 (Ex. 1001, the “’486 patent”). Document Security Systems, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”).

Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any 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(a). A decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018).

After considering the evidence and arguments presented in the Petition and Preliminary Response, we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing unpatentability of claims 1–6 of the ’486 patent, and we institute on all challenged claims and on all grounds.

A. Related Proceedings

Petitioner states the ’486 patent has been asserted by Patent Owner against Nichia Corporation and Nichia America Corporation in *Document Security Systems, Inc. v. Nichia America Corporation, et al.*, No. 2:17-cv-

¹ Petitioner, Nichia Corporation, identifies Nichia America Corporation as a real party-in-interest. Pet. 1.

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08849, pending in the Central District of California. Pet. 1; *see also* Paper 5, 2.

Petitioner also states the '486 patent has been asserted by Patent Owner in several other court proceedings: *Document Security Systems, Inc. v. Everlight Americas Inc., et al.*, No. 2:17-cv-00310 (E.D. Tex.); *Document Security Systems, Inc. v. Everlight Americas Inc., et al.*, No. 2:17-cv-04273 (C.D. Cal.); *Document Security Systems, Inc. v. Cree, Inc.*, No. 2:17-cv-00309 (E.D. Tex.); *Document Security Systems, Inc. v. Cree, Inc.*, No. 2:17-cv-04263 (C.D. Cal.); *Document Security Systems, Inc. v. Seoul Semiconductor Co., Ltd., et al.*, No. 2:17-cv-00308 (E.D. Tex.); *Document Security Systems, Inc. v. Seoul Semiconductor Co., Ltd., et al.*, No. 8:17-cv-00981 (C.D. Cal.); *Document Security Systems, Inc. v. OSRAM GmbH, et al.*, No. 2:17-cv-05184 (C.D. Cal.); and *Document Security Systems, Inc. v. Lite-On Tech. Corp., et al.*, No. 2:17-cv-06050 (C.D. Cal.). *Id.* at 1–2; Paper 5, 2–3.

Petitioner also states the '486 patent is subject to the following pending petition for *inter partes* review: *Seoul Semiconductor Co., Ltd. v. Document Security Systems, Inc.*, No. IPR2018-00333 (“the '333 Petition”). Pet. 2; Paper 5, 3. On June 21, 2018, the Board instituted review in that proceeding. IPR2018-00333, Paper 9.

Patent Owner additionally identifies the following *inter partes* review proceedings as ones that may also affect or be affected by a decision in this proceeding: IPR2018-00265 (U.S. Patent No. 6,949,771) (trial instituted, Paper 23); IPR 2018-00522 (U.S. Patent No. 7,524,087) (trial instituted, Paper 10); IPR2018-00965 (U.S. Patent No. 7,919,787) (trial instituted, Paper 15); IPR2018-00966 (U.S. Patent No. 7,652,297) (trial instituted,

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Paper 14); IPR2018-01165 (U.S. Patent No. 7,524,087); IPR2018-01167 (U.S. Patent No. 6,949,771); IPR2018-01205 (U.S. Patent No. 7,256,486) (instituted, joined with IPR2018-00333, Paper 11); IPR2018-01220 (U.S. Patent No. 7,256,486) (institution denied, Paper 9); IPR2018-01221 (U.S. Patent No. 7,524,087) (institution denied, Paper 9); IPR2018-01222 (U.S. Patent No. 6,949,771) (institution denied, Paper 11); IPR2018-01223 (U.S. Patent No. 6,949,771) (institution denied, Paper 11); IPR2018-01225 (U.S. Patent No. 7,256,486) (trial instituted, joined with IPR2018-00333, Paper 14); IPR2018-01226 (U.S. Patent No. 7,524,087) (trial instituted, joined with IPR2018-00522, Paper 15); IPR2018-01244 (U.S. Patent No. 6,949,771) (trial instituted, joined with IPR2018-00265, Paper 15); IPR2018-01260 (U.S. Patent No. 7,919,787) (trial instituted, Paper 12).
Paper 5, 3–4.

B. The '486 Patent

The '486 patent generally relates to a semiconductor packaging device. Ex. 1001, Abstract. The semiconductor packaging device can include a light emitting diode (LED). *Id.* at 5:20–22. A semiconductor device is illustrated in Figures 2A and 2B, reproduced below. *Id.* at 3:5–8.

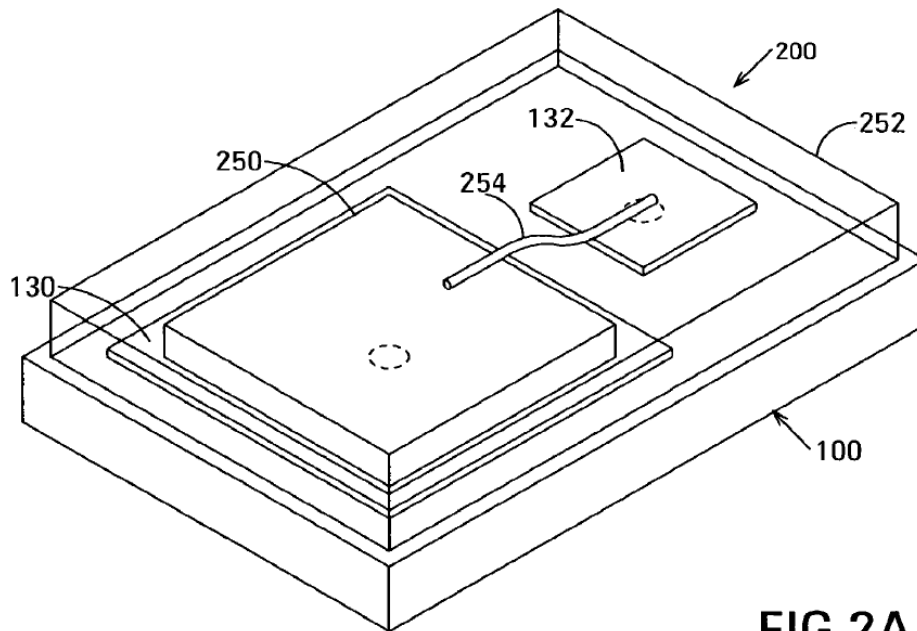


FIG. 2A

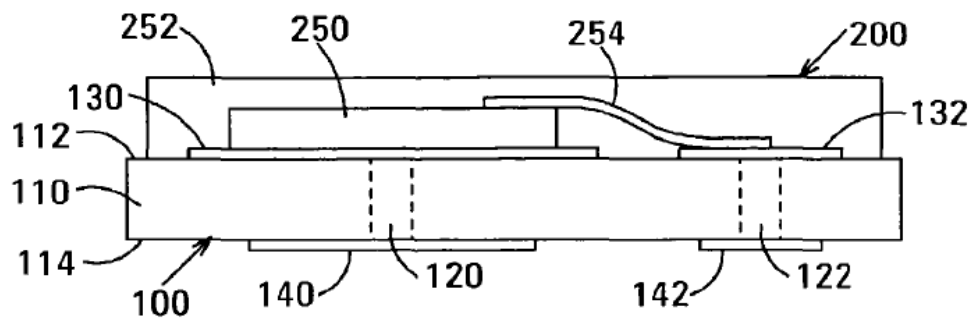


FIG. 2B

Figure 2A shows a perspective view of semiconductor device 200, including semiconductor die/LED 250. Ex. 1001, 3:5–8, 6:5–7. Figure 2B is a side view of semiconductor device 200. *Id.* at 3:5–8. Substrate 110, having major surfaces 112, 114, is shown having mounting pad 130 and bonding pad 132 on top major surface 112, and connecting pads 140, 142 on bottom major surface 114. *Id.* at 3:43–57, 4:64–66. Interconnecting elements 120, 122 pass through substrate 110 and connect mounting pad 130

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