

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EVERLIGHT ELECTRONICS CO., LTD.
Petitioner

v.

DOCUMENT SECURITY SYSTEMS, INC.
Patent Owner

Case No. IPR2018-01225
U.S. Patent No. 7,256,486

**PETITIONER'S MOTION FOR JOINDER UNDER
37 C.F.R. §§ 42.22 AND 42.122(b)**

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CERTIFICATE OF SERVICE

I. STATEMENT OF RELIEF REQUESTED

Everlight Electronics Co., Ltd. (“Everlight” or “Petitioner”) respectfully requests to join, pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), its recently filed *Inter Partes* Review of U.S. Patent No. 7,256,486 (“the ‘486 patent”), IPR2018-01225 (“Everlight’s IPR”), with pending *Inter Partes* review, *Seoul Semiconductor Co. Ltd. And Seoul Semiconductor, Inc. v. Document Security Systems, Inc.*, IPR2018-00333 (“Seoul Semiconductor's IPR”), which was filed on December 21, 2017. Everlight’s Petition is substantively identical to the petition in Seoul Semiconductor’s IPR – challenging the same claims of the ‘486 patent on the same grounds while relying on the same prior art, arguments, and evidence. This Motion for Joinder and accompanying Petition are timely, being filed within one month of the Decision instituting trial in Seoul Semiconductor’s IPR (Paper No. 9 issued June 21, 2018). On Friday June 22, 2018, counsel for Everlight asked patent owner and petitioner’s counsel in Seoul Semiconductor’s IPR whether they oppose the motion, but has not yet received a response.

Joinder is appropriate here because (i) Everlight’s IPR is substantively identical to Seoul Semiconductor’s IPR and (ii) Everlight agrees to a complete “understudy role,” simplifying briefing and discovery. Joinder will thus provide for a just, speedy, and inexpensive determination of related proceedings.

Accordingly, Everlight respectfully requests that the Board grant this Motion for Joinder.

II. STATEMENT OF MATERIAL FACTS

1. The owner of the '486 patent, Document Security Systems, Inc. (“Document Security Systems” or “Patent Owner”), sued Everlight alleging infringement of the '486 patent in the Central District of California. Everlight was served with Document Security Systems’ Complaint on June 20, 2017.

2. On December 21, 2017, Seoul Semiconductor Co., Ltd. and Seoul Semiconductor, Inc. (collectively “Seoul Semiconductor”) timely filed a Petition for *Inter Partes* Review challenging claims 1-3 of the '486 patent. *See Seoul Semiconductor Co. Ltd. And Seoul Semiconductor, Inc. v. Document Security Systems, Inc.*, IPR2018-00333 (Petition, Dec. 21, 2017).

3. Everlight’s Petition for IPR was filed on June 8, 2018, and this motion are being filed within one month of the Decision instituting Seoul Semiconductor’s IPR (Paper No. 9 June 21, 2018).

III. STATEMENT OF REASONS FOR REQUESTED RELIEF

A. Legal Standards

The Leahy-Smith America Invents Act (AIA) permits joinder of *inter partes* review (IPR) proceedings. Joinder is governed by 35 U.S.C. § 315(c), which states:

(c) JOINDER. – If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

A motion for joinder should “(1) set forth the reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified.” *See Dell Inc. v. Network-1 Sec. Solutions, Inc.*, IPR2013-00385, Paper 17 (PTAB July 29, 2013).

B. Everlight’s Motion is Timely

A Motion for Joinder is timely if the moving party files within one month of institution of the *Inter Partes* Review for which joinder is requested. 37 C.F.R. § 42.122(b). Because Everlight files this motion within a month of the Decision instituting Seoul Semiconductor’s IPR, this motion is timely. *See, e.g., LG Electronics, Inc., et al. v. Fundamental Innovations Systems International LLC*, IPR2018-00461, Paper 10 (PTAB May 29, 2018).

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