

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. IPR2018-01260
U.S. Patent No. 7,919,787

**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. 7,919,787 (“the ‘787 patent”), IPR2018-01260 (“Everlight’s IPR”), with pending *Inter Partes* review, *Nichia Corporation v. Document Security Systems, Inc.*, IPR2018-00965 (“Nichia’s IPR”), which was filed May 10, 2018, assuming Nichia’s IPR is instituted. Everlight’s Petition is substantively identical to the petition in Nichia’s IPR – challenging the same claims of the ‘787 patent on the same grounds while relying on the same prior art, arguments, and evidence. This Motion was authorized by the PTAB in an Order (Paper No. 7 in IPR2018-01260) dated September 18, 2018. This Motion is timely in that it is filed before the Decision on Institution in Nichia’s IPR (The Decision on Institution of Nichia’s IPR is expected by November 10, 2018). 37 CFR 42.122(b)(“... Any request for joinder must be filed, as a motion under § 42.22, **no later than** one month after the institution date of any *inter partes* review for which joinder is requested. The time period set forth in § 42.101(b) shall not apply when the petition is accompanied by a request for joinder.”) (emphasis added)

On September 7, 2018, counsel for Everlight asked counsel for patent owner for Nichia, whether they will oppose the motion. Both Patent Owner and Nichia

have indicated that they will oppose joinder.

Joinder is appropriate here because (i) Everlight's IPR is substantively identical to Nichia'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 '787 patent, Document Security Systems, Inc. ("Document Security Systems" or "Patent Owner"), sued Everlight's subsidiary Everlight Americas, Inc., alleging infringement of the '787 patent in the E.D. of Texas on April 13, 2017, but voluntarily dismissed its Complaint without prejudice on June 8, 2017.

2. Patent Owner then sued Everlight Americas Inc. in the Central District of California. Everlight Americas Inc. was served with the Complaint on June 20, 2017.

3. On May 10, 2018, Nichia Corporation timely filed a Petition for *Inter Partes* Review challenging claims 1-14 of the '787 patent. *See Nichia Corporation v. Document Security Systems, Inc.*, IPR2018-00965.

4. The litigation in the Central District of California was stayed on July

27, 2018, pending resolution of certain IPRs against the asserted patents, including the '787 patent. Everlight agreed to be estopped by the results of Nichia's IPR in connection with the stay of the litigation.

5. Everlight's Petition for IPR was filed on June 15, 2018, and this motion is being filed prior to the Decision on Institution for Nichia's IPR (expected by November 10, 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

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