

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 IPR2018-01260
Patent 7,919,787 B2

**PATENT OWNER'S OPPOSITION TO EVERLIGHT'S
MOTION FOR JOINDER**

PATENT OWNER'S LIST OF EXHIBITS

Exhibit Number	Exhibit Description
2001-2099	Reserved
2100	Complaint for Patent Infringement in <i>Document Security Systems, Inc. v. Everlight Electronics Co., Ltd., and Everlight Americas, Inc.</i> , Case 2:17-cv-00310 (E.D. Tex.)
2101	Notice of Service in <i>Document Security Systems, Inc. v. Everlight Electronics Co., Ltd., and Everlight Americas, Inc.</i> , Case 2:17-cv-00310 (E.D. Tex.)
2102	Complaint for Patent Infringement in <i>Document Security Systems, Inc. v. Everlight Electronics Co., Ltd., and Everlight Americas, Inc.</i> , Case 2:17-cv-04273 (C.D. Cal.)
2103	Notice of Dismissal in <i>Document Security Systems, Inc. v. Everlight Electronics Co., Ltd., and Everlight Americas, Inc.</i> , Case 2:17-cv-00310 (E.D. Tex.)
2104-2112	Reserved

IPR2018-01260 Patent Owner's Opposition to Everlight's Motion for Joinder

Pursuant to 37 C.F.R. § 42.23, Patent Owner Document Security Systems, Inc. ("DSS" or "Patent Owner") opposes Everlight's Motion for Joinder of Everlight's IPR (IPR2018-01260) with Nichia Corporation's IPR (IPR2018-00965). Everlight's Petition in this case was not properly accompanied by a request for joinder as required by the Board's regulations, and therefore Everlight has not satisfied the exception to the time bar provided in 37 C.F.R. § 42.122(b).

I. EVERLIGHT'S PETITION FOR IPR IS TIME-BARRED

A real party-in-interest to the Petition, Everlight Americas, Inc., was first served with a complaint alleging infringement of the '787 patent on April 26, 2017, more than one year before Everlight filed its petition for IPR on June 15, 2018. Specifically, on April 26, 2017, admitted real party-in-interest Everlight Americas, Inc. (*see* Pet., 1) was served with a complaint dated April 13, 2017 ("Texas Complaint"), alleging infringement of '787 patent in the Eastern District of Texas. *See* Ex. 2100, ¶¶26-32; Ex. 2101, 2.

Because this named real party-in-interest to the Petition was served with "a complaint," namely the Texas Complaint, alleging infringement of the patent-at-issue more than one year prior to the filing of Everlight's Petition for IPR, Everlight's Petition is time-barred. *See* 35 U.S.C. § 315(b); 37 C.F.R. § 42.101(b) ("A person who is not the owner of a patent may file with the Office a petition to institute an *inter partes* review of the patent unless ... The petition requesting

IPR2018-01260 Patent Owner’s Opposition to Everlight’s Motion for Joinder the proceeding is filed more than one year after the date on which the petitioner, the petitioner's real party-in-interest, or a privy of the petitioner is served with a complaint alleging infringement of the patent ...”).

Although DSS dismissed the Texas Complaint without prejudice on June 8, 2017 (*see* Ex. 2103, 2), the plain language of the 35 U.S.C. 315(b) and governing Federal Circuit law make clear that subsequent dismissal of the complaint is irrelevant to whether Everlight Americas, Inc. was served with the complaint alleging infringement of the ’787 patent, and therefore whether Petitioner was barred from filing a petition for *inter partes* review of the ’787 patent after April 26, 2018. *See Click-to-Call Tech., LP v. Ingenio, Inc.*, 899 F.3d 1321, 1328 (Fed. Cir. 2018).¹

II. EVERLIGHT’S PETITION WAS NOT ACCOMPANIED BY A REQUEST FOR JOINDER AND IS NOT EXEMPT FROM THE TIME BAR

Everlight cannot salvage its time-barred and improperly-filed petition by later-filing a motion for joinder. The PTO’s regulations expressly prohibit the

¹ “The principal question on appeal is whether the Board erred in interpreting the phrase ‘served with a complaint alleging infringement of [a] patent’ recited in § 315(b) such that the voluntary dismissal without prejudice of the civil action in which the complaint was served ‘does not trigger’ the bar. Final Written Decision, slip op. at 12. We hold that it did.” *Click-to-Call*, 899 F.3d at 1328.

IPR2018-01260 Patent Owner’s Opposition to Everlight’s Motion for Joinder *filing* of a time-barred petition, and only provide an exception for *filing* a time-barred petition where the petition is “accompanied” by a motion for joinder: “[t]he time period set forth in § 42.101(b) shall not apply when the petition *is accompanied by* a request for joinder.” 37 C.F.R. § 42.122(b) (emphasis added). Everlight’s Petition was *not* accompanied by a motion for joinder, which was filed on October 2, 2018, nearly three months after Everlight’s Petition was improperly filed. Therefore, Everlight’s Petition was improperly filed.

Notably, Everlight offers no explanation in its Motion for how its Petition was allegedly “accompanied by a request for joinder,” when the two filings were separated by nearly three months. Mot., 3. Everlight simply alleges that its “Motion is timely in that it is filed before the Decision on Institution in Nichia’s IPR” and cites to 37 C.F.R. § 42.122(b). Mot., 3. Everlight ignores that 37 C.F.R. § 42.122(b) requires the petition to be *accompanied by* a request for joinder in order to qualify for the time-bar exemption.²

² The Board has concluded in other matters that this “rule does not set forth a specific time before which a motion for joinder can be filed.” *See, e.g., Everlight Electronics Co., Ltd. v. Document Security Systems, Inc.*, IPR2018-01225, slip op. at 8 (PTAB Sept. 27, 2018) (Paper 14). But the rule does state that the petition must be accompanied by a request for joinder to be exempt from the time period of § 42.101(b). Thus, even if a non-time-barred petition could be filed separately

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