

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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EVERLIGHT ELECTRONICS CO., LTD,  
Petitioner,

v.

DOCUMENT SECURITY SYSTEMS, INC.,  
Patent Owner.

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Case IPR2018-01260  
Patent 7,919,787 B2

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Before SALLY C. MEDLEY, SCOTT C. MOORE, and  
BRENT M. DOUGAL, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

DECISION  
Institution of *Inter Partes* Review  
*35 U.S.C. § 314(a)*  
Petitioner's Motion for Joinder  
*37 C.F.R. § 42.122(b)*

## I. INTRODUCTION

Everlight Electronics Co., Ltd. (“Petitioner”)<sup>1</sup> filed a Petition for *inter partes* review of claims 1–14 of U.S. Patent No. 7,919,787 B2 (Ex. 1001, “the ’787 patent”). Paper 1 (“Pet.”). Petitioner also filed a Motion for Joinder with *Nichia Corporation v. Document Security Systems, Inc.*, Case IPR2018-00965 (“the Nichia IPR”). Paper 8 (“Mot.”). The petitioner in the Nichia IPR — Nichia Corporation — does not oppose the Motion for Joinder. Paper 11, 2. Document Security Systems, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Patent Owner also filed an Opposition to the Motion for Joinder. Paper 9 (“Opposition or Opp.”). Petitioner filed a Reply to the Opposition. Paper 10 (“Reply”). We have authority under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

For the reasons described below, we institute an *inter partes* review of the challenged claims and grant Petitioner’s Motion for Joinder.

## II. RELATED PROCEEDINGS

The parties indicate that the ’787 patent is the subject of several court proceedings. Pet. 1; Paper 3, 2. The ’787 patent also is the subject of the Nichia IPR. Application 11/838,301, which was filed August 14, 2007 and issued as the ’787 patent, claims to be a continuation-in-part of Application 10/608,605 (“the ’605 application”), filed June 27, 2003, which issued as

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<sup>1</sup> Petitioner, Everlight Electronics Co., Ltd., identifies Everlight Americas, Inc. as a real party-in-interest. Pet. 1.

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U.S. Patent No. 7,256,486 B2 (“the ’486 patent”). The ’486 patent is involved in IPR2018-00333, IPR2018-01166, IPR2018-01205, IPR2018-01220, and IPR2018-01225.

In the Nichia IPR, we instituted an *inter partes* review of claims 1–14 of the ’787 patent on the following grounds:

References	Basis	Challenged Claims
Lumbard <sup>2</sup> and Weeks <sup>3</sup>	§ 103(a)	1–14
Lumbard and Wirth <sup>4</sup>	§ 103(a)	1–14
Lumbard and Negley <sup>5</sup>	§ 103(a)	1–14
Ishidu <sup>6</sup> and Weeks	§ 103(a)	1 and 5–7
Ishidu and Wirth	§ 103(a)	1 and 5–7
Ishidu and Negley	§ 103(a)	1 and 5–7
Ogawa <sup>7</sup> and Weeks	§ 103(a)	1–14
Ogawa and Wirth	§ 103(a)	1–14
Ogawa and Negley	§ 103(a)	1–14

*Nichia Corporation v. Document Security Systems, Inc.*, Case IPR2018-00965, slip op. at 5, 31 (PTAB October 29, 2018) (Paper 15) (“Nichia Dec.”).

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<sup>2</sup> U.S. Patent No. Re. 36,614, issued Mar. 14, 2000 (Ex. 1006, “Lumbard”).

<sup>3</sup> U.S. Patent No. 6,611,002, filed Feb. 23, 2001, issued Aug. 26, 2003 (Ex. 1007, “Weeks”).

<sup>4</sup> WO 2005/081319, filed Feb. 18, 2005, issued Sept. 1, 2005 (Ex. 1008, “Wirth”).

<sup>5</sup> U.S. Patent Application Publication No. 2004/0217360 A1, filed Apr. 6, 2004, published Nov. 4, 2004 (Ex. 1009, “Negley”).

<sup>6</sup> U.S. Patent Application Publication No. 2006/0198162 A1, filed Mar. 15, 2004, published Sept. 7, 2006 (Ex. 1010, “Ishidu”).

<sup>7</sup> U.S. Patent Application Publication No. 2006/0113906 A1, filed Nov. 29, 2005, published June 1, 2006 (Ex. 1011, “Ogawa”).

### III. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same grounds of unpatentability as the ones on which we instituted review in the Nichia IPR. *Compare* Pet. 16–79, with Nichia Dec. 5, 31. Indeed, Petitioner contends that the Petition “is substantively identical to the petition in Nichia’s IPR.” Mot. 4; *see also, id.* at 6. Petitioner acknowledges that the Petition relies on a different expert; however, Petitioner asserts that “Everlight’s expert reviewed and agreed with the expert declaration supporting Nichia’s IPR, and Everlight’s expert declaration is substantially identical to Nichia’s expert declaration.” *Id.*

Patent Owner’s Preliminary Response does not address Petitioner’s prior art, arguments, or evidence. *See generally*, Prelim. Resp. However, Patent Owner contends that the Petition is time barred. *Id.* at 1–5; *see also* Opp. 1–4. Patent Owner asserts that Petitioner’s real party-in-interest, Everlight Americas, Inc., was 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. Prelim. Resp. 1–2. Thus, Patent Owner argues that under 35 U.S.C. § 315 (b) Everlight’s Petition is time barred. *Id.*

35 U.S.C. § 315 (b) states:

(b) Patent Owner’s Action.—

An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent. The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).

As discussed in more detail below, a Motion for Joinder was filed in the present case. Thus, the time bar does not apply as the Petition falls under the explicit exception in 35 U.S.C. § 315(b): “The time limitation set forth in the preceding sentence shall not apply to a request for joinder.” Patent Owner acknowledges as much in its Opposition to the Motion for Joinder. Opp. 5 (“Everlight can only participate in an IPR against the ’787 patent through joinder.”).

For the same reasons set forth in our institution decision in the Nichia IPR, we determine that the information presented in the Petition shows a reasonable likelihood that Petitioner would prevail in showing that claims 1–14 are unpatentable. *See Nichia Dec.* 8–31. Accordingly, we institute an *inter partes* review on the same grounds as the ones on which we instituted review in the Nichia IPR.

#### IV. GRANT OF MOTION FOR JOINDER

The Petition in this proceeding was accorded a filing date of June 15, 2018. *See Paper 5.* The Nichia IPR was instituted on October 29, 2018. Petitioner filed a Motion for Joinder on October 2, 2018. Thus, Petitioner’s Motion for Joinder is timely because joinder was requested no later than one month after the Nichia IPR. *See 37 C.F.R. § 42.122 (b).*

The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads:

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.

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