

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL INC.; DELL PRODUCTS LP;
LENOVO (UNITED STATES) INC.; and
HP INC.,
Petitioner,

v.

NEODRON LTD.,
Patent Owner.

IPR2020-00731
Patent 9,024,790 B2

Before MIRIAM L. QUINN, PATRICK M. BOUCHER, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314
Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

INTRODUCTION

A. Background and Summary

Dell Inc., Dell Products LP, Lenovo (United States) Inc., and HP Inc. (collectively, “Petitioner”) filed (1) a Petition to institute an *inter partes* review (Paper 4, “Pet.”) of claims 1–24 of U.S. Patent No. 9,024,790 B2 (Ex. 1001, “the ’790 patent”); and (2) a Motion for Joinder (Paper 5, “Mot.”) with *Samsung Electronics Co. v. Neodron Ltd.*, IPR2020-00515 (“Samsung IPR”). We instituted an *inter partes* review of the Samsung IPR on July 1, 2020. Samsung IPR, Paper 8. Neodron Ltd. (“Patent Owner”) did not file a Patent Owner Preliminary Response or an Opposition to Petitioner’s Motion for Joinder in this proceeding.

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 reasons discussed below, we institute an *inter partes* review of claims 1–24 and grant Petitioner’s Motion for Joinder.

B. Real Parties in Interest

Petitioner identifies Dell Products LP, Dell Inc., Lenovo (United States) Inc., and HP Inc. as real parties in interest. Pet. 2. Petitioner also identifies Dell Technologies Inc., Lenovo Group Ltd., and Microsoft Corp. as real parties in interest without admitting that those parties are in fact real parties in interest. *Id.*

C. Related Matters

The parties identify the following proceedings in which the ’790 patent is asserted. *Neodron Ltd. v. Dell Technologies, Inc.*, No. 6:19-cv-00318-ADA (W.D. Tex.); *Neodron Ltd. v. HP Inc.*, 6-19-cv-00319-ADA

(W.D. Tex.); *Neodron Ltd. v. Lenovo Group Ltd. et al*, 6-19-cv-00320 (W.D. Tex.); *In the matter of Certain Touch-Controlled Mobile Devices, Computers, and Components Thereof*, Inv. No. 337-TA-1162 (ITC); and *Neodron Ltd. v. Samsung Electronics Co., Ltd.*, No. 6:19-cv-00398-ADA (W.D. Tex.). Pet. 3; Paper 7, 2 (Patent Owner’s Mandatory Notices).

Petitioner further identifies a pending *inter partes* review of the ’790 patent, proceedings asserting U.S. Patent No 8,102,286 (the ’286 patent), which is a parent of the ’790 patent, and an *inter partes* review petition relating to the ’286 patent. Pet. 3–4.

D. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–24 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. § ¹	Reference(s)/Basis
1, 7, 8, 13, 14, 19–24	102(b) ²	Jahier ³
1, 2, 5–8, 12–14, 18–24	103(a)	Jahier
4, 10, 11, 16, 17	103(a)	Jahier, Senk ⁴

¹ The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. §§ 102, 103 that became effective on March 16, 2013. Because the ’790 patent issued from an application filed before March 16, 2013, we apply the pre-AIA versions of the statutory bases for unpatentability.

² Although the Petition only identifies section 103 as a basis for unpatentability in the section titled “Precise Relief Requested,” the Petition sets forth that claims 1, 7, 8, 13, 14, and 19–24 are either anticipated or rendered obvious by Jahier. *Compare* Pet. 5 (Precise Relief Requested) (arguing claims 1, 2, 5–8, 12–14, and 18–24 are obvious) *with id.* at 19–40 (arguing claims 1, 7, and 13 are either anticipated or obvious), 46–52 (arguing Jahier discloses the additional limitations recited in claims 8, 14, and 19–24).

³ US 5,525,908, issued June 11, 1996 (Ex. 1005).

⁴ US 5,760,715, issued June 2, 1998 (Ex. 1006).

Claim(s) Challenged	35 U.S.C. § ¹	Reference(s)/Basis
5, 12, 18	103(a)	Jahier, QT60161 ⁵
3, 9, 15	103(a)	Jahier, West ⁶

Petitioner also relies on a Declaration of Dr. Benjamin B. Bederson, Ph.D., filed as Exhibit 1002 (“Bederson Declaration”).

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 Samsung IPR. *Compare* Pet. 19–69, with Samsung IPR, Paper 8 at 6. Indeed, Petitioner contends that the Petition “is a carbon copy of the original Samsung IPR petition in all material respects. The only substantive changes are in the introduction to identify the correct Petitioner and the mandatory notices under 37 C.F.R. § 42.8(b).” Mot. 1; *see also id.* at 5–6.

Patent Owner did not file a Preliminary Response in the instant proceeding.

For the same reasons set forth in our institution decision in the Samsung IPR, we determine that the information presented in the Petition shows a reasonable likelihood that Petitioner would prevail in showing that claims 1–24 are unpatentable. *See* Samsung IPR, Paper 8 at 10–17. Accordingly, we institute an *inter partes* review on the same grounds as the ones on which we instituted review in the Samsung IPR.

⁵ Quantum Research Group QT60161 16 Key QMatrix Keypanel Sensor IC Datasheet (2002) (Ex. 1007)

⁶ US 5,831,597, issued Nov. 3, 1998 (Ex. 1008).

GRANT OF MOTION FOR JOINDER

We instituted trial in the Samsung IPR on July 1, 2020. Samsung IPR, Paper 8. Petitioner filed a Motion for Joinder on March 30, 2020. Mot. Thus, Petitioner’s Motion for Joinder is timely because joinder was requested no later than one month after trial was instituted in the Samsung IPR. *See* 37 C.F.R. § 42.122(b) (2020).

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.

A motion for joinder should (1) set forth 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 Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, Paper 15, (PTAB Apr. 24, 2013).

The Petition in this case asserts the same unpatentability grounds on which we instituted review in the Samsung. *See* Mot. 1–2. Petitioner relies “on the same grounds relying on the same prior art and evidence, including a declaration that is from the same expert.” *See id.* Indeed, the Petition is nearly “a carbon copy” of the petition filed by the petitioner in the Samsung IPR. *See id.* at 1. Thus, this *inter partes* review does not present any ground or matter not already at issue in the Samsung IPR.

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