

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

SOLAS OLED, LTD.,
Patent Owner.

IPR2020-01059
Patent 6,072,450 B2

Before SALLY C. MEDLEY, JESSICA C. KAISER, and JULIA HEANEY,
Administrative Patent Judges.

HEANEY, *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(b)

I. INTRODUCTION

A. Background

On June 8, 2020, Apple Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–9, 11–13, and 15–18 (“the challenged claims”) of U.S. Patent No. 6,072,450 B2 (Ex. 1001, “the ’450 patent”). Concurrently with the Petition, Petitioner filed a Motion for Joinder (Paper 3, “Mot.”), requesting that this proceeding be joined with *Samsung Display Co., Ltd. v. Solas OLED, Ltd.*, Case IPR2020-00140 (“0140 IPR”). Mot. 1. Solas OLED, Ltd. (“Patent Owner”) did not file an Opposition to the Motion for Joinder or a Preliminary Response.

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

B. Related Proceedings and Asserted Grounds of Unpatentability

In the 0140 IPR, we instituted *inter partes* review of the ’450 patent on the following four grounds:

1. Claims 1, 2, 4–8, 15, and 16 under 35 U.S.C. § 102(e) as unpatentable over Utsugi¹;
2. Claims 1, 2, 4–8, 15, and 16 under 35 U.S.C. § 103(a) as unpatentable over Utsugi;
3. Claim 3 under 35 U.S.C. § 103(a) as unpatentable over Utsugi and Manabe²;

¹ US Patent No. 5,670,792 to Utsugi et al., issued Sept. 23, 1997 (Ex. 1003).

² JP H05-3079 to Manabe et al. (Ex. 1004). A Japanese language copy of Manabe was provided as Exhibit 1009.

4. Claims 9, 11–13, 17, and 18 under 35 U.S.C. § 103(a) as unpatentable over Utsugi and Eida³;
0140 IPR, Paper 8, 9.

The Petition in this proceeding challenges the same claims on identical grounds of unpatentability, and relies on the same evidence, including the same declarant testimony, as presented in the 0140 IPR. Pet. 5–6; Mot. 5.

II. ANALYSIS

An *inter partes* review may be joined with another *inter partes* review, subject to certain statutory provisions:

(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.

35 U.S.C. § 315(c); *see also* 37 C.F.R. § 42.122 (“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.”).

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, e.g., Kyocera Corp. v. Softview LLC*,

³ WO 96/25020 to Eida et al. (Ex. 1005). A Japanese language copy of Eida was provided as Exhibit 1010.

IPR2013-00004, Paper 15 (April 24, 2013). As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief.

37 C.F.R. § 42.20(c).

As an initial matter, the present Motion for Joinder meets the requirements of 37 C.F.R. § 42.122(b) because the Motion was filed on June 8, 2020, which is not later than one month after the 0140 IPR was instituted on May 8, 2020.

In addition and as noted above, the present Petition challenges the same claims on the same grounds of unpatentability, and relies on the same evidence, including the same declarant testimony, as presented in the 0140 IPR. Pet. 5–6; Mot. 5.

Petitioner asserts that the *General Plastic* factors are inapplicable here, where the Petitioner seeks to join as a party to the 0140 IPR and take an understudy rule. Mot. 7–10. We need not determine the applicability of the *General Plastic* factors, however, because Petitioner has confirmed that it has not previously filed a petition requesting *inter partes* review of the '450 patent. *Id.* at 10.

For the above reasons, and in particular the fact that the present Petition is virtually identical to the petition in the 0140 IPR, we determine Petitioner has demonstrated sufficiently under 35 U.S.C. § 315(c) that its Petition in this case warrants the institution of an *inter partes* review under 35 U.S.C. § 314(a).

Petitioner further contends joinder will not affect the schedule in the 0140 IPR, agrees to assume an “understudy” role, and provides the following conditions that would apply as long as Solas OLED, Ltd. and Samsung Display Co., Ltd. (“the 0140 Petitioner”) remain active parties:

- (a) all filings by Petitioner in the joined proceeding be consolidated with the filings of the 0140 Petitioner, unless a filing solely concerns issues that do not involve the 0140 Petitioner;
- (b) Petitioner shall not be permitted to raise any new grounds not already instituted by the Board in the 0140 IPR, or introduce any argument or discovery not already introduced by the 0140 Petitioner;
- (c) Petitioner shall be bound by any agreement between Patent Owner and the 0140 Petitioner concerning discovery and/or depositions; and
- (d) Petitioner at deposition shall not receive any direct, cross examination or redirect time beyond that permitted for the 0140 Petitioner alone under either 37 C.F.R. § 42.53 or any agreement between Patent Owner and the 0140 Petitioner.

Mot. 8–9. Based on these conditions, Petitioner contends “[t]hese steps will minimize any potential complications or delay that potentially may result by joinder.” *Id.* at 9.

Based on the facts and circumstances discussed above, we determine Petitioner has established good cause for joining this proceeding with the 0140 IPR. Specifically, we find that joinder of this proceeding with the 0140 IPR is unlikely to require any delay or modification to the scheduling order already in place for the 0140 IPR. We also determine that Patent Owner will not be prejudiced unduly by the joinder of this proceeding. Thus, we determine that granting the Motion for Joinder under these circumstances would help “secure the just, speedy, and inexpensive resolution” of these proceedings. *See* 37 C.F.R. § 42.1(b). For the above reasons, we conclude that the Motion for Joinder should be granted.

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