

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HP INC.,
Petitioner

v.

LARGAN PRECISION CO., LTD,
Patent Owner

U.S. Patent No. 8,988,796

Case No.: IPR2021-00641

MOTION FOR JOINDER PURSUANT TO 35 U.S.C. § 315(c), AND 37

C.F.R. §§ 42.22, AND 42.122(b)

Mail Stop *Inter Partes* Review
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

I. STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c), and 37 C.F.R. §§ 42.22, 42.102, 42.122(b), and 42.222 HP Inc. respectfully submits this Motion for Joinder, together with a petition for *inter partes review* of U.S. Patent 8,988,796 (“the ’796 patent”), seeking cancellation of claims 1-11 and 15-25 of the ’796 patent, and joinder of this proceeding with *Ability Opto-Electronics Co., Ltd. v. Largan Precision Co., Ltd.*, Case IPR2020-01339 (“the Ability IPR”).

This Motion for Joinder is timely under 37 C.F.R. §§ 42.22 and 42.122(b), as it is submitted within one month of February 22, 2021, the date on which the Ability IPR was instituted. *See* Ability IPR, Paper 10. HP submits that joinder is appropriate because it will: (1) promote efficient determination of the validity of the ’796 patent in a single proceeding without prejudice to first petitioner Ability or patent owner Largan because HP’s petition raises the *identical* grounds of unpatentability instituted by the Board in the Ability IPR; (2) not affect the schedule of the Ability IPR, nor increase the complexity of that proceeding; and (3) minimize burden because HP will agree to follow the same schedule as the petition that was already instituted.

Accordingly, joinder in this proceeding is appropriate and HP’s Motion should be granted.

II. STATEMENT OF MATERIAL FACTS

Petitioner is involved in litigation concerning the '796 patent in the action styled *Largan Precision Co., Ltd. v. Ability Opto-Electronics Technology Co., Ltd. and HP Inc.*, No. 3:20-cv-6607-JD, filed by Patent Owner Largan Precision Co., Ltd.. The case was initially filed in the Eastern District of Texas, but was subsequently transferred to the Northern District of California, where it is now pending.

On July 21, 2020, Ability filed its petition for *inter partes review* seeking cancellation of claims 1-11 and 15-25 of the '796 patent. (Ability IPR, Paper 1):

- Ground 1: Claims 1-11 and 15-25 under 35 U.S.C. § 103 based on U.S. Patent No. 9,097,860 (“Yu”).
- Ground 2: Claims 1–11, 15–16, 19–24 under 35 U.S.C. § 103 based on U.S. Patent Application Publication No. 2004/0012861 (“Yamaguchi”) and Yu.

On November 23, 2020, Largan filed a preliminary response. (Ability IPR, Paper 7).

On February 22, 2021, the Board instituted review of claims 1-11 and 15-25 of the '796 patent with respect to Grounds 1-2. (Ability IPR, Paper 10).

On February 22, 2021, the Board entered a scheduling order in the Ability IPR, setting Oral Argument for December 2, 2021. (Ability IPR, Paper 11).

On March 8, 2021, HP first learned about Ability and Largan’s settlement, when Largan filed a notice of dismissal with prejudice against Ability in the co-

pending district court action. Largan did not offer HP a dismissal with prejudice of the district court case. Given that more than a year has elapsed between the filing of the action by Largan, the only way for HP to challenge the invalidity of the '796 patent in an IPR proceeding is by stepping into Ability's shoes in the IPR already instituted by the PTAB.

HP's petition in this proceeding seeks cancellation of claims 1-11 and 15-25 of the '796 patent based on Grounds 1-2 as set forth in the Ability IPR petition.

HP's petition in this proceeding proposes the same claim construction positions as the petition in the Ability IPR, and relies upon the same exhibits.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

Joinder of this proceeding with the Ability IPR will not enlarge the Ability IPR, nor negatively affect its case schedule. Instead, in view of the Joint Motion to Terminate filed by Largan and Ability, joinder of this proceeding with the Ability IPR is the only way that HP can ensure that its interests in the outcome of the Ability IPR are addressed. Thus, joinder here is appropriate.

A. Legal Standard

The Leahy-Smith America Invents Act (AIA) permits joinder of inter partes review proceedings. The statutory provision governing joinder of *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads as follows:

(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.

Under 35 U.S.C. § 315(c), the Board has authority to join a second *inter partes* review proceeding to an instituted first *inter partes* review proceeding. The motion for joinder must be filed within one month of institution of the first *inter partes* review proceeding. 37 C.F.R. § 42.122(b).

In exercising its discretion to grant joinder, the Board considers the impact of substantive and procedural issues on the proceedings, as well as other considerations, while being “mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” See *Dell, Inc. v. Network-1 Security Solutions, Inc.*, Case IPR2013-00385, Paper No. 17 (July 29, 2013) at 3. The Board should consider “the policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding.” *Id.* at 10. Under this framework, joinder of the present IPR with the Ability IPR is appropriate.

“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

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