

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TCL INDUSTRIES HOLDINGS CO., LTD.,

Petitioners,

v.

ATI TECHNOLOGIES ULC,

Patent Owner.

PTAB Case No. IPR2024-00366

U.S. Patent No. 8,760,454 B2

TCL'S MOTION FOR JOINDER TO IPR2023-00922

TABLE OF CONTENTS

	Page
I. STATEMENT OF PRECISE RELIEF REQUESTED	1
II. STATEMENT OF MATERIAL FACTS	1
III. STATEMENT OF REASONS FOR RELIEF REQUESTED	2
IV. CONCLUSION	5

I. STATEMENT OF PRECISE RELIEF REQUESTED

Petitioner TCL Industries Holdings Co, Ltd. (“TCL”) moves for joinder of its contemporaneously-filed Petition for *inter partes* review (“IPR”) of claims 1–11 of U.S. Patent No. 8,760,454 (“the ’454 patent”) with a pending IPR, *Realtek Semiconductor Corp. v. ATI Technologies ULC*, No. IPR2023-00922 (“the Realtek IPR”), which the Board instituted on December 1, 2023.

The Realtek IPR concerns the same patent and the same claims as TCL’s Petition. TCL’s Petition and supporting expert declaration are substantively identical to the petition and expert declaration submitted in the Realtek IPR. TCL here asserts that the same claims are obvious over the same prior art based on the same arguments supported by the same expert opinions as in the Realtek IPR.

TCL agrees to take an “understudy” role if joined. Joinder will not cause any delay in the resolution of the Realtek IPR. Joinder, therefore, is appropriate because it will resolve the same patentability issues of the same patent, it will not delay the schedule that the Board has issued in the Realtek IPR, and the parties in the Realtek IPR will not be prejudiced.

II. STATEMENT OF MATERIAL FACTS

ATI Technologies ULC (“ATI”) purports to own the ’454 patent.

On May 5, 2022, ATI asserted the ’454 patent against TCL in the following case: *Certain Graphics Systems, Components Thereof, and Digital Televisions*

Containing The Same, Inv. No. 337-TA-1318 (U.S. International Trade Commission).

On May 6, 2022, ATI asserted the '454 patent against TCL in the following case: *Advanced Micro Devices, Inc. et al. v. TCL Industries Holdings Co., LTD., et al.*, Case No. 2:22-cv-00134 (E.D. Tex.).

On May 19, 2023, Realtek filed the Realtek IPR, requesting cancellation of claims 1–11 of the '454 patent. IPR2023-0922, Paper 1.

On December 1, 2023, the Board instituted the Realtek IPR and entered a Scheduling Order. IPR2023-0922, Papers 10 and 11.

Along with this Motion for Joinder, TCL simultaneously files the Petition, which argues, among other things, that the same claims of the '454 patent are obvious based on the same grounds and for the same reasons as set forth in the Realtek IPR petition.

The grounds proposed in the Petition are the same as those described in the Realtek IPR petition—the Petition does not contain any additional arguments or evidence in support of the unpatentability of claims 1–11 of the '454 patent.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Joinder is timely

This request is being submitted within the time period set forth in 37 C.F.R. § 42.122(b).

B. The *Kyocera* factors support joinder

The Board has discretion to join this IPR with the Realtek IPR. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); *HTC v. Parthenon Unified Memory Architecture LLC*, IPR2017-00512, Paper 12 at 6 (PTAB June 1, 2017). In evaluating a motion for joinder, the Board considers the following factors: (1) the reasons why joinder is appropriate; (2) whether the petition raises any new grounds of unpatentability; (3) any impact joinder would have on the cost and trial schedule for the existing review; and (4) whether joinder will add to the complexity of briefing or discovery. *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013); Consolidated Trial Practice Guide 76 (Nov. 2019), <https://go.usa.gov/xpvPF>. These factors weigh in favor of joinder. As a result, the Board should exercise its discretion to allow joinder here.

1. Joinder is appropriate because TCL proposes no new grounds of unpatentability (factors 1 and 2)

The Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.” *Samsung Elecs. Co. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (PTAB Aug. 24, 2016) (internal quotations and citations omitted) (emphasis original). Joinder is appropriate here because the Petition asserts the same grounds and relies on the same evidence for unpatentability presented in the Realtek IPR. Specifically, the Petition and the Realtek IPR petition rely on the same prior art

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.