

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.,
Petitioner,

v.

MULTIMEDIA TECHNOLOGIES PTE. LTD.,
Patent Owner.

IPR2024-00694
Patent 9,510,040 B2

Before ST. JOHN COURTENAY III, MICHAEL R. ZECHER, and
SHARON FENICK, *Administrative Patent Judges*.

ZECHER, *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

I. INTRODUCTION

On March 14, 2024, Petitioner, VIZIO, Inc. (“VIZIO”), filed a Petition requesting an *inter partes* review (“IPR”) of claims 1–6, 11–16, 21, and 22 of U.S. Patent No. 9,510,040 B2 (Ex. 1001, “the ’040 patent”). Paper 1 (“Petition” or “Pet.”). VIZIO filed its Petition along with a Motion for Joinder requesting that we join VIZIO as a party with *LG Electronics, Inc. v. Multimedia Technologies Pte. Ltd.*, IPR2024-00351 (“LG IPR”). Paper 3 (“Mot. for Joinder”).

On May 21, 2024, we entered a Decision on Institution in the LG IPR, in which we instituted an IPR as to claims 1–6, 11–16, 21, and 22 of the ’040 patent. *See* LG IPR, Paper 9 (“LG IPR Dec. on Inst.”). The Petition and supporting evidence filed in this proceeding are substantively identical to the petition and supporting evidence filed in the LG IPR. *Compare* LG IPR, Paper 1 (“LG IPR Petition”), 1–103, *and* Exs. 1001–1013, *with* Pet. 1–102, *and* Exs. 1001–1013. Moreover, VIZIO represents that it is willing to limit the asserted grounds of unpatentability (“grounds”) to the same grounds asserted in the LG IPR. Mot. for Joinder 5–6. VIZIO also represents that, if it is allowed to join the LG IPR, it will assume an “understudy” role (i.e., a passive role) and will assume an active role only in the event that the petitioner in the LG IPR, LG Electronics, Inc. and LG Electronics U.S.A., Inc. (collectively, “LG”), ceases to participate in the LG IPR and the LG IPR terminates only with respect to LG.¹ Mot. for Joinder 8.

¹ For example, in its understudy role, VIZIO may not file any paper or exhibit in the LG IPR separate and apart from LG, absent our express authorization.

In this proceeding, Patent Owner Multimedia Technologies Pte. Ltd. (“Multimedia”) did not file an opposition to VIZIO’s Motion for Joinder, nor did Multimedia elect to file a Preliminary Response. Ex. 3002.

Under 35 U.S.C. § 314(a), an IPR may not be instituted unless the information presented in the Petition shows “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 we discuss below, we institute an IPR as to claims 1–6, 11–16, 21, and 22 of the ’040 patent, and we *grant* VIZIO’s Motion for Joinder.

II. INSTITUTION OF IPR

In the LG IPR, we instituted an IPR as to 1–6, 11–16, 21, and 22 of the ’040 patent based on the asserted grounds set forth in the table below. LG IPR Dec. on Inst. 37–38.

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–5, 11–15, 21	§ 103(a) ²	Kim, ³ Lee-1, ⁴ Choi ⁵
2, 3, 6, 12, 13, 16, 22	§ 103(a)	Kim, Lee-1, Choi, Lee-2 ⁶

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103, effective March 16, 2013. Because the ’040 patent claims the benefit of U.S. Patent Provisional Application No. 61/684,672, which was filed on August 17, 2012, the pre-AIA version of § 103 applies. Ex. 1001, code (60).

³ Kim, US 2012/0054791 A1 (published Mar. 1, 2012; filed Mar. 9, 2011).

⁴ Lee et al. (“Lee-1”) US 9,008,190 B2 (issued Apr. 14, 2015; filed Jan. 4, 2010).

⁵ Choi, US 2013/0057764 A1 (published Mar. 7, 2013; filed June 28, 2012).

⁶ Lee et al. (“Lee-2”) US 9,398,339 B2 (issued July 19, 2016; filed Dec. 16, 2010).

As we indicate previously, the Petition and supporting evidence filed in this proceeding are essentially the same as the LG IPR Petition and supporting evidence filed in the LG IPR, and VIZIO is willing to limit the asserted grounds in this proceeding to the same grounds asserted in the LG IPR. Mot. for Joinder 5–6.

As we explain below, we grant VIZIO’s Motion for Joinder. Given that we are granting VIZIO’s Motion for Joinder, we determine that the information presented in the Petition establishes that there is a reasonable likelihood that VIZIO would prevail in challenging claims 1–6, 11–16, 21, and 22 of the ’040 patent as unpatentable as obvious under § 103(a) for the same reasons already set forth in the Decision on Institution in the LG IPR. *See* LG IPR Dec. on Inst. Pursuant to § 314, we institute an IPR as to these claims of the ’040 patent.

III. GRANTING VIZIO’S MOTION FOR JOINDER

Based on authority delegated to us by the Director, we have discretion to join a petitioner requesting an IPR as a party to another IPR, subject to certain exceptions not present here. 35 U.S.C. § 315(c). The regulatory provisions governing an IPR address the appropriate timeframe for filing a motion for joinder. Section 42.122(b) of Title 37 of the Code of Federal Regulations provides, in relevant part, “[a]ny 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.”

The Petition in this proceeding was accorded a filing date of March 14, 2024 (Paper 4 (Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response), 1), and the Motion for Joinder

was filed on the same day. As such, VIZIO's Motion for Joinder was timely because joinder was requested no later than one month after May 21, 2024, the institution date of the LG IPR. *See* LG IPR Dec. on Inst.

In its Motion for Joinder, VIZIO contends that joinder is appropriate because this proceeding and the LG IPR are substantively identical (i.e., they involve the same claims, the same patent, the same prior art references, the same expert declaration, and the same arguments and evidence). *See* Mot. for Joinder 4–6. Stated differently, VIZIO asserts that the Petition and supporting evidence filed in this proceeding do not raise any new substantive or procedural issues. *See id.* VIZIO further argues that, because it is willing to work with counsel for LG (i.e., as an understudy) to consolidate all filings and discovery, joinder will not impact the schedule of the LG IPR, thereby allowing us to complete a single consolidated proceeding in a timely manner. *Id.* at 6–9. VIZIO also argues that, if it is joined as a party with the LG IPR, Multimedia will not suffer any prejudice because granting joinder under these circumstances will not add new issues for consideration by or costs to Multimedia above and beyond those already presented in the LG IPR, nor will granting joinder affect the issues, briefing, or discovery in the LG IPR, as they will remain the same. *Id.* at 9–10.

Given that Multimedia did not oppose VIZIO's Motion for Joinder (Ex. 3002), and VIZIO agrees to consolidate all filings and discovery with LG (Mot. for Joinder 6–9), VIZIO has demonstrated that joinder will not unduly complicate or delay the LG IPR. *See* 37 C.F.R. § 42.1(b) (providing for “the just, *speedy*, and inexpensive resolution of *every proceeding*” (emphases added)). We, therefore, grant VIZIO's Motion for Joinder and, as a result, join VIZIO as a party with the LG IPR.

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