

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.,
Petitioner,

v.

INNOVATIVE DISPLAY TECHNOLOGIES LLC,
Patent Owner.

Case IPR2016-00910
Patent 7,434,974 B2

Before THOMAS L. GIANNETTI, MIRIAM L. QUINN, and
BEVERLY M. BUNTING, *Administrative Patent Judges*.

BUNTING, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review
37 C.F.R. § 42.108

Grant of Motion for Joinder
37 C.F.R. § 42.122(b)

I. INTRODUCTION

VIZIO, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1, 3–5, 7–8, and 10–11 (“the challenged claims”) of U.S. Patent No. 7,434,974 B2 (Ex. 1001, “the ’974 patent”), and concurrently filed a Motion for Joinder (Paper 3, “Mot.”). The Motion for Joinder seeks to join this proceeding with *K.J. Pretech Co., Ltd. v. Innovative Display Technologies LLC*, Case IPR2015-01868 (“the ’1868 IPR”). Mot. 1. Patent Owner filed a Preliminary Response. (Paper 7, “Prelim. Resp.”). For the reasons described below, we institute an *inter partes* review of all the challenged claims and grant Petitioner’s Motion for Joinder.

II. INSTITUTION OF *INTER PARTES* REVIEW

A. *Grounds Asserted*

The Petition in this proceeding asserts the same four grounds as those on which we instituted review in the ’1868 IPR. On March 17, 2016, we instituted a trial in the ’1868 IPR on the following grounds:

| Reference(s) | Basis | Claims Challenged |
|--|----------|--------------------------|
| Kisou ¹ | § 102(a) | 1, 5, 7, 8, 10, and 11 |
| Kisou | § 103(a) | 5, 10, and 11 |
| Kisou and Yagi ² | § 103(a) | 3 and 4 |
| Furuya ³ and Niizuma ⁴ | § 103(a) | 1, 3–5, 7, 8, 10, and 11 |

¹ Kisou, JP H7-64078A, March 10, 1995 (Ex. 1006).

² Yagi, U.S. Patent 4,017,155, issued April 12, 1977 (Ex. 1008).

³ Furuya, JP 6-214230, August 5, 1994 (Ex. 1009).

⁴ Niizuma, JP H5-45651, June 18, 1993 (Ex. 1007).

K.J. Pretech Co., Ltd. v. Innovative Display Technologies LLC, Case IPR2015-01868, slip. op. at 25 (PTAB March 17, 2016) (Paper 15) (“’1868 Decision”).

B. Real Parties-In-Interest

Petitioner contends that VIZIO, Inc. is the real party-in-interest. Pet. 1. Patent Owner does not challenge this assertion.

C. Related Matters

Petitioner identifies several lawsuit involving the ’974 patent brought by Patent Owner and several other *inter partes* review proceedings involving the ’974 patent and related patents. Pet. 1–3.

D. Decision

In view of the identity of the challenge in the instant Petition and in the petition in the ’1868 IPR, we institute an *inter partes* review in this proceeding on the same grounds as those on which we instituted *inter partes* review in the ’1868 IPR.

We have considered the arguments advanced by Patent Owner in the Preliminary Response. Prelim. Resp. 3–23. We are not persuaded by those arguments for at least the reasons stated in our ’1868 IPR Institution Decision. We are also not persuaded by Patent Owner’s additional argument that the Petition is untimely. Prelim. Resp. 1. The Petition was timely filed under 37 C.F.R. § 42.122. *See infra*.

We do not institute *inter partes* review on any other grounds.

III. MOTION FOR JOINDER

An *inter partes* review may be joined with another *inter partes* review, subject to the provisions of 35 U.S.C. § 315(c), which governs joinder of inter partes review proceedings:

(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.

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). A motion for joinder should: (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. See Frequently Asked Question H5, <http://www.uspto.gov/patentsapplication-process/appealing-patentdecisions/trials/patent-reviewprocessing-system-prps-0>.

Noting that Petitioner was served with a lawsuit asserting the '974 patent on January 2, 2014, Patent Owner argues that we should deny the Petition due to Petitioner's delay in filing. Prelim. Resp. 1. The instant Petition, however, has been accorded a filing date of April 18, 2016⁵ (Paper 4), which is within one month of the March 17, 2016 institution date in the '1868 IPR. The Petition, therefore, satisfies the joinder requirement of being

⁵ Petitioner states that April 17, 2016 was a Sunday, giving Petitioner until the next business day, April 18, 2016, to file under the provisions of 37 C.F.R. § 1.7(a). Mot. 3.

filed within one month of our instituting a trial in the '1868 IPR. 37 C.F.R. § 42.122. As such, we decline to exercise our discretion and deny this petition under 35 U.S.C. § 325(a).

In its Motion for Joinder, Petitioner contends that joinder is appropriate because (1) the grounds asserted in the instant Petition are the same as in the '1868 IPR; (2) Petitioner's arguments regarding the asserted references are identical to the arguments raised in the '1868 IPR; and (3) Petitioner has submitted, in support of its petition, the same declaration of the technical expert as submitted in support of the '1868 IPR. Mot. 4. Petitioner contends it would be prejudiced if joinder is denied, for example, if the petitioner in the '1868 IPR, K.J. Pretech Co., Ltd. ("K.J. Pretech"), were to cease participating. *Id.* On the other hand, Petitioner contends that the parties to the '1868 IPR would not be prejudiced if joinder were granted. *Id.* at 5. Petitioner states: "Given that [Petitioner] is relying on the same art, arguments, and evidence as [the petitioner in the '1868 IPR], its joinder in an understudy role will not impact Patent Owner, put it to any additional expense, or create any delay." *Id.*

Further, Petitioner represents that joinder will not negatively impact the trial schedule in the '1868 IPR (*Id.* at 3), and that "the Board can efficiently resolve all grounds in both the K.J. Pretech IPR Petition and VIZIO Petition in a single proceeding" (*id.* at 4). According to Petitioner, the Board can accomplish this because Petitioner "explicitly agrees to take an 'understudy' role, and coordinate any involvement through counsel for K.J. Pretech." *Id.* at 6. Petitioner concludes that the instant proceeding does not raise any issues that have not already been raised in the '1868 IPR. *Id.* at 6.



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