

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CREE, INC.,  
Petitioner,

v.

DOCUMENT SECURITY SYSTEMS, INC.,  
Patent Owner.

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Case IPR2019-00506  
Patent 7,256,486 B2

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Before SCOTT C. MOORE, AMBER L. HAGY, and  
BRENT M. DOUGAL, *Administrative Patent Judges*.

HAGY, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review  
35 U.S.C. § 314

Petitioner's Motion for Joinder  
37 C.F.R. § 42.122(b)

## I. INTRODUCTION

### A. Introduction

Cree, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 1–6 (the “challenged claims”) of U.S. Patent 7,256,486 B2 (Ex. 1001, the “’486 patent”). 35 U.S.C. § 311. Concurrently with its Petition, Petitioner filed a Motion for Joinder with *Nichia Corporation v. Document Security Systems, Inc.*, Case IPR2018-01166 (“the Nichia IPR”). Paper 3 (“Mot.”). Petitioner represents that the petitioner in the Nichia IPR—Nichia Corporation (“Nichia”)—does not oppose the Motion for Joinder. Mot. 2. Document Security Systems, Inc. (“Patent Owner”) did not file a preliminary response or an opposition to the Motion for Joinder.

We have authority under 35 U.S.C. § 314(a), which provides that an *inter partes* review may be instituted where “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” A decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018).

For the reasons described below, we institute an *inter partes* review of claims 1–6 of the ’486 patent and grant Petitioner’s Motion for Joinder.

### B. Related Proceedings

Petitioner states the ’486 patent has been asserted by Patent Owner against Petitioner in two district court proceedings: *Document Security Systems, Inc. v. Cree, Inc.*, No. 2:17-cv-00309 (E.D. Tex.) and *Document*

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*Security Systems, Inc. v. Cree, Inc.*, No. 2:17-cv-04263 (C.D. Cal.). Paper 1, 1. Patent Owner also identifies these proceedings. Paper 5, 2.

Petitioner also states the '486 patent has been asserted by Patent Owner in several other district court proceedings: *Document Security Systems, Inc. v. Everlight Americas Inc., et al.*, No. 2:17-cv-00310 (E.D. Tex.); *Document Security Systems, Inc. v. Everlight Americas Inc., et al.*, No. 2:17-cv-04273 (C.D. Cal.); *Document Security Systems, Inc. v. Nichia Corporation et al.*, No. 2:17-cv-08849 (C.D. Cal.); *Document Security Systems, Inc. v. Seoul Semiconductor Co., Ltd., et al.*, No. 2:17-cv-00308 (E.D. Tex.); *Document Security Systems, Inc. v. Seoul Semiconductor Co., Ltd., et al.*, No. 8:17-cv-00981 (C.D. Cal.); *Document Security Systems, Inc. v. OSRAM GmbH, et al.*, No. 2:17-cv-05184 (C.D. Cal.); and *Document Security Systems, Inc. v. Lite-On Tech. Corp., et al.*, No. 2:17-cv-06050 (C.D. Cal.). Paper 1, 1. Patent Owner also identifies these proceedings. Paper 5, 2.

Petitioner also states the '486 patent is subject to the following instituted petitions for *inter partes* review: *Seoul Semiconductor Co., Ltd. v. Document Security Systems, Inc.*, No. IPR2018-00333 (“the '333 Petition”); *Nichia Corporation et al. v. Document Security Systems, Inc.*, No. IPR2018-01166 (“the '1166 Petition”); *Cree, Inc. v. Document Security Systems, Inc.*, No. IPR2018-01205 (“the '1205 Petition”); and *Everlight Electronics Co., Ltd. et al. v. Document Security Systems, Inc.*, No. IPR2018-01225 (“the '1225 Petition”). Paper 1, 2. Patent Owner also identifies these proceedings. Paper 5, 2. The '1205 Petition and the '1225 Petition have been joined with the '333 Petition. Petitioner further states the '486 patent was subject to the following denied petition for *inter partes* review: *Cree,*

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*Inc. v. Document Security Systems, Inc.*, No. IPR2018-01220 (“the ’1220 Petition”). Paper 1, 2. Patent Owner also identifies this proceeding. Paper 5, 2. Petitioner further identifies the following *inter partes* review matters challenging U.S. Patent No. 7,919,787, which is a continuation-in-part of the ’486 patent: IPR2018-00965 filed by Nichia Corporation; and IPR2018-01260 filed by Everlight Electronics Co., Ltd. Paper 1, 2. Patent Owner also identifies these proceedings. Paper 5, 2.

Patent Owner additionally identifies the following *inter partes* review proceedings as ones that may also affect or be affected by a decision in this proceeding: IPR2018-00265 (U.S. Patent No. 6,949,771) (final decision issued April 18, 2019, Paper 34); IPR 2018-00522 (U.S. Patent No. 7,524,087) (trial instituted, Paper 10); IPR2018-00965 (U.S. Patent No. 7,919,787) (trial instituted, Paper 15); IPR2018-00966 (U.S. Patent No. 7,652,297) (trial instituted, Paper 14); IPR2018-01165 (U.S. Patent No. 7,524,087); IPR2018-01167 (U.S. Patent No. 6,949,771); IPR2018-01205 (U.S. Patent No. 7,256,486) (instituted, joined with IPR2018-00333, Paper 11); IPR2018-01220 (U.S. Patent No. 7,256,486) (institution denied, Paper 9); IPR2018-01221 (U.S. Patent No. 7,524,087) (institution denied, Paper 9); IPR2018-01222 (U.S. Patent No. 6,949,771) (institution denied, Paper 11); IPR2018-01223 (U.S. Patent No. 6,949,771) (institution denied, Paper 11); IPR2018-01225 (U.S. Patent No. 7,256,486) (trial instituted, joined with IPR2018-00333, Paper 14); IPR2018-01226 (U.S. Patent No. 7,524,087) (trial instituted, joined with IPR2018-00522, Paper 15); IPR2018-01244 (U.S. Patent No. 6,949,771) (trial instituted, joined with IPR2018-00265, Paper 15); IPR2018-01260 (U.S. Patent No. 7,919,787) (trial instituted, Paper 12); IPR2019-00397 (U.S. Patent No. 6,949,771)

(institution denied, Paper 10); and IPR2019-00398 (U.S. Patent No. 6,949,771) (institution denied, Paper 10). Paper 5, 3–4.

*C. Nichia IPR*

In the Nichia IPR, we instituted *inter partes* review of the '486 patent under 35 U.S.C. § 103(a)<sup>1</sup> based on the following grounds:

| Ground | References                                   | Claim(s) challenged |
|--------|--|---------------------|
| 1      | Nakajima <sup>2</sup> and Weeks <sup>3</sup> | 1–5                 |
| 2      | Nakajima and Kish <sup>4</sup>               | 1–5                 |
| 3      | Nakajima and Edmond <sup>5</sup>             | 1–5                 |
| 4      | Rohm <sup>6</sup> and Weeks                  | 1–3                 |
| 5      | Rohm and Kish                                | 1–3                 |
| 6      | Rohm and Edmond                              | 1–3                 |
| 7      | Rohm, Weeks, and Nakajima                    | 4 and 5             |

<sup>1</sup> The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended several provisions of 35 U.S.C., including § 102 and § 103. Because the '486 patent has an effective filing date prior to the effective date of the applicable AIA amendments, we refer herein to the pre-AIA versions of § 102 and § 103.

<sup>2</sup> Japanese Patent App. No. 2002-232017, pub. Aug. 16, 2002 (Ex. 1004, “Nakajima”).

<sup>3</sup> U.S. Patent No. 6,611,002, filed Feb. 23, 2001, issued Aug. 26, 2003 (Ex. 1007, “Weeks”).

<sup>4</sup> U.S. Patent No. 5,376,580, Dec. 27, 1994 (Ex. 1008, “Kish”).

<sup>5</sup> U.S. Patent No. 5,523,589, June 4, 1996 (Ex. 1009, “Edmond”).

<sup>6</sup> Japanese Pat. Pub. 2003-17754, Jan. 17, 2003 (Ex. 1005, “Rohm”).

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