

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCEDES-BENZ USA, LLC and
MERCEDES-BENZ U.S. INTERNATIONAL, INC.,

Petitioners,

v.

INNOVATIVE DISPLAY TECHNOLOGIES LLC,

Patent Owner.

Inter Partes Review of U.S. Patent No. 6,755,547

IPR Case No.: *To Be Assigned*

**MOTION FOR JOINDER PURSUANT TO 35 U.S.C. § 315(c)
AND 37 C.F.R. § 42.122(b)**

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), petitioners Mercedes-Benz USA, LLC and Mercedes-Benz U.S. International, Inc. (collectively, “Petitioners”) respectfully request that they be joined as parties to the following pending (but not yet initiated) *inter partes* review proceeding concerning the same patent at issue here, U.S. Patent No. 6,755,547 (“the ‘547 Patent”): *LG Display Co., Ltd. v. Innovative Display Technologies LLC*, IPR2014-01357 (the “LG IPR”). Petitioners have filed concurrently herewith a “Petition for *Inter Partes* Review of Claims 1-4, 16, and 26 of U.S. Patent No. 6,755,547,” in which they assert the same grounds of invalidity as have been raised in the LG IPR. This Motion is timely under 37 C.F.R. §§ 42.22 and 42.122(b) because it is being submitted before the LG IPR has been instituted. *See Taiwan Semiconductor Mfg. Co. v. Zond, LLC*, IPR2014-00781, -00782, Paper 5 (May 29, 2014) at 3; 37 C.F.R. § 42.122(b).

Petitioners respectfully submit that joinder of these proceedings is appropriate. Joinder will not impact the Board’s ability to complete its review in the statutorily prescribed timeframe. Indeed, the invalidity grounds raised in this IPR are identical to the invalidity grounds raised in the LG IPR. Accordingly, joinder will ensure the Board’s efficient and consistent resolution of the issues surrounding the invalidity of the ‘547 Patent. Moreover, joinder will not

prejudice the LG IPR parties because the scope and timing of the LG IPR proceeding should remain the same. Finally, the Board can implement procedures that are designed to minimize any impact to the schedule of the LG IPR, by requiring, for example, consolidated filings and coordination among petitioners. For these reasons and the reasons outlined herein, joinder should be granted.

II. STATEMENT OF MATERIAL FACTS

1. On April 24, 2014, Innovative Display Technologies LLC (“IDT” or “Patent Owner”) filed a complaint in the United States District Court for the Eastern District of Texas accusing Petitioners of infringing several patents, including the ‘547 Patent. *See Innovative Display Technologies LLC v. Mercedes-Benz U.S. International, Inc. and Mercedes-Benz USA, LLC*, 2:14-cv-00535-JRG (E.D. Tex.) (hereinafter, “the Underlying Litigation”).

2. In its Complaint, IDT purports to be the owner of the ‘547 Patent. *See id.*

3. LG Display Co., Ltd. (“LG”) filed a petition for *inter partes* review of the ‘547 Patent on August 21, 2014 (the “LG Petition”). *See* IPR2014-01357, Paper 1 (Aug. 21, 2014).

4. IDT has asserted the ‘547 Patent against LG in co-pending litigation in the United States District Court for the District of Delaware. *See id.* at 1.

5. The LG Petition includes the following five grounds for invalidity:

- a) Claims 1-4 and 26 are Unpatentable Under 35 U.S.C. § 102 as Anticipated by Ohe;
- b) Claims 1, 3, 4, and 16 are Unpatentable Under 35 U.S.C. § 102(e) as Being Anticipated by Nishio;
- c) Claims 1-4, 16, and 26 are Unpatentable Under 35 U.S.C. § 103(a) as Being Obvious in View of Pristash;
- d) Claims 1-4, 16, and 26 are Unpatentable Under 35 U.S.C. § 103(a) as Obvious Over Kobayashi in View of Ohe; and
- e) Claims 1-4 and 26 are Unpatentable Under 35 U.S.C. § 103(a) as Obvious Over Pristash in View of Matsumoto.

See id. at i.

6. The five invalidity grounds raised in Petitioners' Petition filed in the present IPR proceeding are identical to the five invalidity grounds raised in the LG IPR Petition:

- a) Claims 1-4 and 26 are Unpatentable Under 35 U.S.C. § 102 as Anticipated by Ohe;
- b) Claims 1, 3, 4, and 16 are Unpatentable Under 35 U.S.C. § 102(e) as Being Anticipated by Nishio;

- c) Claims 1-4, 16, and 26 are Unpatentable Under 35 U.S.C. § 103(a) as Being Obvious in View of Pristash;
- d) Claims 1-4, 16, and 26 are Unpatentable Under 35 U.S.C. § 103(a) as Obvious Over Kobayashi in View of Ohe; and
- e) Claims 1-4 and 26 are Unpatentable Under 35 U.S.C. § 103(a) as Obvious Over Pristash in View of Matsumoto.

See Mercedes-Benz USA, LLC and Mercedes-Benz U.S. International, Inc. v. IDT, Case No. *to be assigned*, Paper 1 at i.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

Joinder of *inter partes* review proceedings is permitted under 35 U.S.C. § 315(c), which provides:

(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.

35 U.S.C. § 315(c).

In deciding whether to allow joinder, the Board takes into account “the particular facts of each case, substantive and procedural issues, and other considerations,” while remaining “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 Sols., Inc.*, IPR2013-00385, Paper No. 17 (July 29, 2013) at 3. The Board also takes into account “the policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding.” *Id.* at 10 (citing 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (“The Office anticipates that joinder will be allowed as of right – if an inter partes review is instituted on the basis of a petition, for example, a party that files an identical petition will be joined to that proceeding, and thus allowed to file its own briefs and make its own arguments.”))).

“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 may be simplified.” *Id.* at 4. An analysis of each of these issues supports joinder.

A. Joinder is appropriate because it will not impact the Board’s ability to complete the review in a timely manner.

Joinder is appropriate because it will not impact the Board’s ability to complete its review of the LG IPR within the statutorily prescribed timeframe. First, this *inter partes* review proceeding does not raise any new grounds of unpatentability over what has been asserted in the LG IPR. Specifically, Petitioners assert in their petition the same grounds of unpatentability LG asserted

in the LG IPR; Petitioners’ arguments regarding the asserted references are identical to the arguments LG raised in the LG IPR; and Petitioners have submitted, in support of their petition, the same declaration of the technical expert that LG submitted in support of its petition (excluding some minor changes made to reflect Petitioners’ engagement of the same expert). Thus, this proceeding does not raise any new issues beyond those already before the Board in the LG IPR, and this weighs in favor of joinder. *See, e.g., Dell Inc. v. Network-1 Security Sols., Inc.*, IPR2013-00385, Paper 17 (July 29, 2013) at 7, 10 (granting joinder where unpatentability grounds identical and noting “policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding”); *Sony Corp. of Am. and Hewlett-Packard Co. v. Network-1 Security Sols., Inc.*, IPR2013-00495, Paper 13 (Sept. 16, 2013) at 5 (same); *SAP Am. Inc. v. Clouding IP, LLC*, IPR2014-00306, Paper 13 (May 19, 2014) at 4.

In addition, the LG IPR has not yet been instituted, and therefore, no scheduling order has been entered, yet. Accordingly, joinder of this proceeding with the LG IPR will not require a change to any existing schedule, and this weighs in favor of joinder.

B. Joinder will promote efficiency by consolidating issues, avoiding duplicate efforts, and preventing inconsistencies.

Further, joinder is appropriate because it will promote efficiency by avoiding duplicative reviews and filings of the same invalidity issues across

multiple PTAB proceedings. Joinder will also eliminate any risk of inconsistent results and piecemeal review. This also weighs in favor of joinder.

C. Joinder will not prejudice IDT or LG.

Permitting joinder will not prejudice IDT or LG. Petitioners' proposed grounds for instituting an IPR are identical to those proposed by LG in its petition, and therefore, joinder will not impact the scope or timing of the LG IPR. Petitioners and LG are relying on the same testimony of the same technical expert to support their respective petitions, further avoiding any potential delay.

Moreover, joinder is likely more convenient and efficient for IDT because it will provide a single trial on the '547 Patent. By allowing all grounds of invalidity to be addressed in a single proceeding, the interests of all parties and the Board will be well served.

Further, briefing and discovery can be simplified to minimize any impact on the participants and to streamline the filings for the Board. For example, upon granting joinder, the Board can adopt procedures similar to those adopted in *Dell Inc.*, IPR2013-00385 and *SAP America Inc.*, IPR2014-00306. In those proceedings, the Board required that the petitioners make consolidated filings, for which the first petitioner was responsible, and allowed the new petitioner to file an additional seven-page paper addressing only points of disagreement with points asserted in the consolidated filing. *See* IPR2013-00385, Paper 17 at 11; IPR2014-

00306, Paper 13 at 5. The Board also permitted the patent owner to respond to any separate filing, limiting the page limit to that used in the separate filing. *See* IPR2013-00385, Paper 17 at 11; IPR2014-00306, Paper 13 at 5. Adopting a similar procedure in this case will minimize any delay that could arise from lengthy briefing submitted by each party, while at the same time providing all parties an opportunity to be heard. *See* IPR2013-00385 at 8.

As in these prior cases, LG and Petitioners can also coordinate their questioning at depositions to avoid redundancy. *See* IPR2013-00385, Paper 17 at 12; IPR2014-00306, Paper 13 at 6.

For these reasons, joinder will not prejudice any party, but rather will promote the just, speedy, and inexpensive resolution of these proceedings involving the ‘547 Patent.

D. Without joinder, Petitioners may be prejudiced.

Petitioners would be prejudiced if they are not permitted to join and participate in the LG IPR, impacting not only Petitioners’ pending *inter partes* review petition, but also the Underlying Litigation. Any decision in the LG IPR will likely simplify, or even resolve, the issues in the Underlying Litigation. Joinder is necessary to allow Petitioners -- parties to the Underlying Litigation -- to protect their interests with respect to matters that are at issue in both the *inter partes* review proceedings and the Underlying Litigation.

IV. CONCLUSION

For the foregoing reasons, Petitioners respectfully request that their Petition for *Inter Partes* Review of U.S. Patent No. 6,755,547 be instituted and that this proceeding be joined with *LG Display Co., Ltd. v. Innovative Display Technologies LLC*, IPR2014-01357.

Although Petitioners believe that no fee is required for this Motion, the Commissioner is hereby authorized to charge any additional fees that may be required for this Motion to Deposit Account No. 11-0980.

Dated: December 4, 2014

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that, on this 4th day of December, 2014, a true and correct copy of the foregoing MOTION FOR JOINDER PURSUANT TO 35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b) was served by UPS NEXT DAY AIR on the attorney of record for the patent owner, with a courtesy copy being sent by electronic mail to the attorneys of record in the co-pending litigation, at the following addresses:

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