

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

JIAWEI TECHNOLOGY (HK) LTD., JIAWEI TECHNOLOGY (USA) LTD., SHENZHEN JIAWEI PHOTOVOLTAIC LIGHTING CO., LTD., ATICO INTERNATIONAL (ASIA) LTD., ATICO INTERNATIONAL USA, INC., CHIEN LUEN INDUSTRIES CO., LTD., INC. (CHIEN LUEN FLORIDA), CHIEN LUEN INDUSTRIES CO., LTD., INC. (CHIEN LUEN CHINA), COLEMAN CABLE, LLC, NATURE'S MARK, RITE AID CORP., SMART SOLAR, INC., AND TEST RITE PRODUCTS CORP.  
Petitioner,

v.

SIMON NICHOLAS RICHMOND  
Patent Owner.

---

Case IPR2015-TBD  
Patent 7,429,827

---

**Petitioner's Motion for Joinder to Related  
*Inter Partes* Review of U.S. Patent No. 7,429,827 (IPR2014-00938)**

<b>I.</b>	<b>APPLICABLE STATUTES AND RULE .....</b>	<b>1</b>
<b>II.</b>	<b>RELIEF REQUESTED .....</b>	<b>3</b>
<b>III.</b>	<b>STATEMENT OF FACTS .....</b>	<b>3</b>
<b>IV.</b>	<b>LEGAL STANDARD .....</b>	<b>4</b>
<b>V.</b>	<b>ARGUMENT .....</b>	<b>5</b>
<b>VI.</b>	<b>35 U.S.C. § 315(C) ALLOWS FOR JOINDER OF ISSUES .....</b>	<b>11</b>
<b>VII.</b>	<b>CONCLUSION .....</b>	<b>14</b>

Jiawei Technology (HK) Ltd., Jiawei Technology (USA) Ltd., and Shenzhen Jiawei Photovoltaic Lighting Co., Ltd., Atico International (Asia) Ltd., and Atico International USA, Inc., Chien Luen Industries Co., Ltd., Inc. (Chien Luen Florida), and Chien Luen Industries Co., Ltd., Inc. (Chien Luen China), Coleman Cable, LLC, Nature's Mark, Rite Aid Corp., Smart Solar, Inc., and Test Rite Products Corp. (collectively "Petitioner") respectfully requests the Board to join the trial resulting from the second petition for *inter partes* review of the '827 patent (filed with this motion) with IPR2014-00938 ("the '938 IPR") because the second petition is limited to one ground, which matches an instituted ground in the '938 IPR, relies on testimony from the same expert witness, involves the same patent with the same parties, and the petitioner expeditiously petitioned for review of the '827 patent. Accordingly, there is good cause for granting this motion for joinder. In addition, joinder would enable a just, speedy, and efficient determination of the patentability of the claims of the '827 patent.

## **I. APPLICABLE STATUTES AND RULE**

### ***35 U.S.C. § 316(b)***

#### **(b) Considerations. —**

In prescribing regulations under this section, the Director shall consider the effect of any such regulation on the economy, the integrity of the patent system, the efficient administration of the

Office, and the ability of the Office to timely complete proceedings instituted under this chapter

**35 U.S.C. § 315(c)–(d)**

**(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.

**(d) Multiple Proceedings. —**

Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of an inter partes review, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the inter partes review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, or termination of any such matter or proceeding.

**35 U.S.C. § 325(d)**

**(d) Multiple Proceedings. —**

Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of any post-grant review under this chapter, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the post-grant review or other proceeding or matter may proceed, including providing for the

stay, transfer, consolidation, or termination of any such matter or proceeding. In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.

**37 C.F.R. § 42.122(b)**

Request for joinder. Joinder may be requested by a patent owner or petitioner. Any 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 time period set forth in § 42.101(b) shall not apply when the petition is accompanied by a request for joinder.

**II. RELIEF REQUESTED**

Petitioner requests the Board to join the second petition with the '938 IPR.

**III. STATEMENT OF FACTS**

1. On or after June 11, 2013, patent owner served petitioners with a complaint alleging infringement of, *inter alia*, U.S. patent nos. 7,429,827 ("827 patent") and 8,362,700 ("700 patent").

2. On June 11, 2014, the petitioner filed petitions for *inter partes* review of the '477 patent in IPR2014-00936, the '700 patent in IPR2014-00937 ("937 IPR"), and '827 patent in the '938 IPR.

3. On June 30, 2014, the petitioner filed a revised petition for *inter partes* review of the '827 patent ("first petition").

4. The petition asserted that, *inter alia*, Chliwnyj and Wu rendered obvious claims 27–29 and 31–35 of the '827 patent, and that Chliwnyj, Wu and Lau rendered obvious claim 30.

5. The patent owner filed a preliminary response on September 30, 2014.

6. On December 16, 2014, the Board instituted review of claims 24–30 and 35 of the '827 patent. Importantly, the Board found that claim 30 was obvious over Chliwnyj in view of Wu, and Lau, but denied review of claims 31–34 on any of the proposed grounds.

7. The petitioner requested rehearing on December 31, 2014.

8. On January 13, 2015, the Board denied the request for rehearing.

9. The petitioner filed a second petition for *inter partes* review of claims 31–34 of the '827 patent on January 16, 2015 ("second petition"), one month from the December 16, 2014, decision to institute.

#### **IV. LEGAL STANDARD**

Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b). When exercising that discretion, the Board is mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of

every proceeding. 37 C.F.R. § 42.1(b). As stated in the legislative history, the Board will determine whether to grant joinder on a case-by-case basis, considering of the particular facts of each case. *See* 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (when determining whether and when to allow joinder, the Office may consider factors including the breadth or unusualness of the claim scope, claim construction issues, and consent of the patent owner).

## **V. ARGUMENT**

The '938 IPR includes review of claim 30 of the '827 patent as obvious over Chliwnyj in view of Wu and Lau. The second petition, which the petitioner seeks to join with the '938 IPR, relies on the same ground, but applied to different claims. Joinder would simply add three claims (31–34) to the already instituted ground applied to claim 30 in the '938 IPR.

The second petition strikes a balance between 35 U.S.C. § 325(d) (“the Director may ... reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office”) and 35 U.S.C. § 316(d) (“the Director shall consider ... the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings”). The second petition relies on the same ground as applied to claim 30 in the '938 IPR, but raises substantially different arguments that address the patent owner’s argument that unforeseeably imported a

repetition requirement, *i.e.*, requiring one “*continuous color changing cycle*” to repeat, and the Board appeared to agree largely with this construction. ’938 IPR, paper 19 at 23–24, paper 20 at 7, and paper 27 at 3.

The patent owner made inconsistent statements necessitating the second petition. The patent owner neither raised the issue of repetition in litigation nor expressly in the ’827 patent. Ex. 1112 at 34–35 (n.23). The patent owner raised this issue for the first time in the ’938 IPR, and in the related ’937 IPR the patent owner supplied a dictionary definition of “*cycle*” that required repetition. ’938 IPR, paper 19 at 23–24, and ’937 IPR, ex. 2011. The Board then seemed to agree with this argument when it cited a different definition of cycle also requiring repetition and stated, “A ‘cycle’ implies some pattern or scheme; some phenomenon that happens and can happen again.” ’938 IPR, paper 20 at 16 (citing ex. 1113 (ex. 3001 in the ’938 IPR)). Because the patent owner’s change in position was unforeseeable, the petitioner could not have reasonably anticipated it, and the Board should grant this motion for joinder.

In addition to relying on matching grounds, albeit different asserted claims, the ’938 IPR and second petition involve the same parties, the same patent, and the same expert. Indeed, the claims 31–34 recite many of the same limitations as, for example, claims 24–25, under review in the ’938 IPR. Although the second petition seeks review of new claims, the patent owner admitted that the slight



differences between the claims “mean[] substantially the same thing,” and he continues to argue them as if the stand or fall together. Ex. 1109 at 24. Though the second petition raises minimal new issues, much of the claim construction remains the same, the prior art and ground is the same, and as the same declarant provides related testimony in both cases, cross-examination can be accomplished with a single deposition. Thus, joinder will have minimal impact on the ’938 IPR.

The petitioner expeditiously filed its second petition, which includes merely one new issue, *i.e.*, “*continuous color changing cycle*,” to ensure the just, speedy, and inexpensive resolution of a proceeding joined with the ’938 IPR. The Board issued a scheduling order on December 22, 2014, less than one month before the filing date of the second petition. During the initial conference call for the ’938 IPR, the petitioner notified the Board of its intent to file this second petition and is working proactively with the patent owner to ensure minimal impact on the ’938 IPR. The expeditious filing of the second petition enables the Board to decide promptly whether to institute and join a second petition with the ’938 IPR. As such, the scheduling order requires minimal changes, proposed below, to dates that the rules already allow the parties change by stipulation; the remaining dates can stay unchanged.

	Current	Proposed
<b>Prelim. Resp. in Second IPR</b>	Late April	Late Feb./Early March
<b>'938 IPR DUE DATE 1</b>	March 23, 2015	May 13, 2015
<b>'938 IPR DUE DATE 2</b>	June 22, 2015	June 30, 2015
<b>'938 IPR DUE DATE 3</b>	July 22, 2015	July 30, 2015

The impact on the patent owner will be minimal as the only issues that differ from the '938 IPR are the construction of “*continuous color changing cycle*” and the applying ground of Chliwnyj, Wu and Lau to three claims (31–34), instead of just claim 30. The almost two-month extension to the patent owner response in the '938 IPR gives the patent owner sufficient time to address a single issue that, by his own admission, is “substantially the same.” Ex. 1109 at 24. The patent owner has already argued this term in the '937 IPR preliminary response regarding Chliwnyj and Wu and must already address the ground of Chliwnyj, Wu and Lau in the '937 IPR. Therefore, though the arguments are not substantially the same, there are a small number of issues for the patent owner to address, and the Board may therefore reduce the time for the patent owner’s preliminary response to about one month. This timeline is consistent with similar joined IPRs, and therefore the Board previously agreed that this timeline will give the patent owner sufficient time to prepare a response and allow the Board to meet its one-year deadline. *See, e.g.*, IPR2014-00557, papers 9 and 10. The petitioner is open to changing the

proposed schedule and will work with the patent owner to agree on stipulated changes. The minimal additional work to address one new issue is outweighed by the public interest in judicial economy and consistency of outcome concerning substantially the same subject matter.

The only rationale reason for the patent owner to oppose joinder is that it desires parallel proceedings in a forum that he perceives to be more favorable. This is because the patent owner admitted that, to the extent that the overlapping limitations did not make it obvious, the claims “mean[] substantially the same thing.” Ex. 1109 at 24. The patent owner gains by having the patentability of substantially the same claims finally decided at the PTAB because, if successful, the petitioner will be estopped from raising any ground it “raised or reasonably could have raised.” 35 U.S.C. § 315(e)(1). If parallel proceedings exist, the petitioner will attack the claims using at least some of the arguments contained in the second petition. It would be more efficient for the Board to provide one just, speedy, and inexpensive proceeding, instead of force the parties to litigate substantially the same issues in multiple forums, which would favor the patent owner due to the possibility of inconsistent results.

The petitioner respectfully requests that the Board joins the IPRs to eliminate the burdens that parallel proceedings would impose on the petitioner, the patent owner, the Patent Office, and the District Court. Parallel proceedings could

happen in two ways. First, the accused infringers will offer a defense challenging the validity of claims 31–34 in District Court, which are similar to, for example, claims 24–45 currently under review in the '938 IPR. Granting and joining the second petition will decrease the likelihood of parallel proceedings in District Court, thus achieving judicial economy and minimizing the opportunity of obtaining inconsistent results. Second, the petitioner plans to request *ex parte* reexamination of at least claims 31–34 of the '827 patent. If the Board grants the second petition, the petitioner will request authorization to file a motion to stay the *ex parte* reexamination. Accordingly, the petitioner urges the Board to join the '938 IPR with the trial resulting from the second petition in the interest of judicial economy and to avoid parallel proceedings that might reach inconsistent results.

Congress enacted the AIA trials to allow for a just, speedy, and inexpensive resolution to questions of patentability. The Board cannot accomplish this objective without comprehensively reviewing all asserted claims of the '827 patent, which by the patent owner's own admission are substantially the same. Ex. 1109 at 24. Conducting a trial for some claims of the '827 patent in the Patent Office while litigating the validity of substantially the same claims in District Court is not in the best interest judicial economy and the efficient administration of the Patent Office. Thus, the petitioner urges the Board to grant this motion for

joinder to conserve not only the Patent Office's resources, but also those of the District Court and the parties.

## **VI. 35 U.S.C. § 315(c) ALLOWS FOR JOINDER OF ISSUES**

*Target Corp. v. Destination Maternity Corp.*, held that § 315(c) does not allow for joinder of issues, but two prior and three subsequent opinions agree that it does. IPR2014-00508, paper 18; *see also Samsung Electronics Co Ltd. V. Virginia Innovation Sciences, Inc.*, IPR2014-00557, paper 10, *Ariosa Diagnostics v. Isis Innovation Ltd.*, IPR2012-00022, paper 166; *Medtronic, Inc. et al. v. Norred*, IPR2014-00823, paper 12, *Medtronic, Inc. et al. v. Endotach LLC*, IPR2014-00695, paper 18; and *Standard Innovation Corp. v. Lelo, Inc.*, IPR2014-00907, paper 10. The petitioner agrees with and relies on the Board's analysis from IPR2014-00823, paper 12, quoted below:

[T]he majority in *Target* found that the use of the word “any” did not render the statute ambiguous, and concluded that the language in § 315(c) excludes from “any person” at least two persons from among those who may be joined to a proceeding. Specifically, the phrase “who properly files a petition under section 311” excludes the patent owner, and “as a party,” excludes persons who are already a party. *Target*, Paper 18 at 5. n.2. The phrase “as a party,” however, does not render the joinder provision of § 315(c) unambiguous. The only person excluded unambiguously from the scope of “any person” under § 315(c) is the patent owner, via reference to § 311. Otherwise, § 315(c) simply is labeled “Joinder”—as opposed to “Joinder of parties”

as in 35 U.S.C. § 299—and, while the phrase “join as a party” is used, § 315(c) also contains language that suggests that the decision on whether to join is made after consideration of issues presented in a petition.

... Section 315(c), via reference to § 314, only includes language referring to challenges of patent claims and makes no reference to other procedural requirements discussed in *Target*. In any case, the statute does not clearly guide us away from considering challenges to the claims of the patent. On the contrary, § 315(c) asks the Director to consider whether the petition contains information showing that the petitioner would prevail with respect to at least one claim, and gives the Director discretion to join the party if there is merit to the information presented in the petition.

The majority in *Target* further reasoned that the one-year time bar under § 315(b) does not apply “to a request for joinder,” such that a time-barred petitioner may be permitted to join an existing inter partes review, but may not successfully petition for inter partes review. *Target*, Paper 18 at 10. In reaching this conclusion, the *Target* majority reads the request for joinder as a separate filing, one that does not require a petition. Again, however, the joinder statute itself makes reference to both the petition and preliminary response, indicating that the merits of the petition that accompanies the request for joinder are to be considered—that is, a motion for joinder must include a petition satisfying the threshold of § 314 before a party successfully may be joined. The request for joinder cannot be treated as a separate filing because a properly filed request for joinder must

be accompanied by a petition that meets the standard of § 314. Section 315(c) gives discretion as to whether to join a person who properly files a petition, and it is the Director's discretion that guards against patent owner harassment and/or over-burdening Office resources.

The concurrence also reasons that, in contrast to joinder under § 315(c), § 315(d) relates to the consolidation of issues. A review of the legislative history of the America Invents Act ("AIA"), however, does not clearly lead one to conclude that Congress used "joinder" narrowly to refer solely to party joinder. Rather, throughout the Senate Debates "joinder" is used in the context of issue joinder. *See e.g.*, 157 Cong. Rec. S 1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) ("If a party seeking joinder also presents additional challenges to validity that satisfy the threshold for instituting a proceeding, the Office will either join that party and its new arguments to the existing proceeding, or institute a second proceeding for the patent."); 157 Cong. Rec. S 9988 (daily ed. Sept. 27, 2008) (statement of Sen. Kyl) ("[A]dditional petitions can be joined only if, among other things, they are properly filed."); *id.* ("[A] procedurally proper successive petition for second-period review may be joined to a pending proceeding at the discretion of the Director, even if the 329(b)(2) deadline has not been met, so long as the Director determines that the petition satisfies the threshold set in section 327(c).") "Consolidation," as used in § 315(d), on the other hand, is used to refer to the consolidation of different proceeding before the Office. *See* 157 Cong. Rec. S 9988 (daily ed. Sept. 27, 2008) (statement of Sen. Kyl) ("Section 325(c) gives the PTO broad discretion to

consolidate, stay, or terminate any PTO proceeding involving a patent if that patent is the subject of a post-grant review proceeding. It is anticipated, for example, that if a second-period proceeding is instituted and reexam is sought, the Director would be inclined to stay the post-grant review during exhaustion of the reexam. On the other hand, if a post-grant review is near completion, the Director may consolidate or terminate any other PTO proceeding that is initiated with regard to that patent.”) Thus, the legislative history does not unambiguously support a conclusion that Congress clearly intended to address joinder of parties under § 315(c) and consolidation of issues under § 315(d).

(some internal citations omitted, decision joined by Judge Grossman). The Board is currently deciding a request for rehearing in *Target*. The petitioner agrees with and has nothing to add to the Board’s thorough analysis above.

## **VII. CONCLUSION**

There is good cause to grant this motion for joinder because the second petition and the ’938 IPR addresses substantially the same claim limitations with matching grounds. Having parallel proceedings wastes the Office’s resources and those of the petitioner, patent owner, and the District Court. Separate proceedings also might cause inconsistent decisions in either the Central Reexamination Unit or the District Court. Granting this motion to join will ensure a just, speedy, and inexpensive resolution to whether the claims of the ’827 patent are unpatentable.



Respectfully submitted,

**DENTONS U.S. LLP**

Dated: \_\_January 16, 2015\_\_

\_\_\_\_Mark Nelson\_\_\_\_

Mark C. Nelson

Reg. No. 43,830

Lissi Mojica

Reg. No. 63,421

Kevin Greenleaf

Reg. No. 64,062

Daniel Valenzuela

Reg. No. 69,027

233 South Wacker Drive  
Suite 7800  
Chicago, IL 60606-6306

**CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))**

The undersigned hereby certifies that the foregoing Petitioner's Motion to Join Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) was served on the Attorney of record in U.S. Patent No. 7,429,827 and IPR2014-00938 via Fedex Priority Overnight on January 16, 2015.

**THEODORE SHIELLS**  
SHIELLS LAW FIRM P.C.  
1201 Main Street - Suite 2470  
Dallas, Texas 75202

Respectfully submitted,

Dated: \_\_January 16, 2015\_\_

\_\_\_\_/Nona Durham/\_\_\_\_\_  
Nona Durham