UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HP INC.,
Petitioner

v.

LARGAN PRECISION CO., LTD,
Patent Owner

U.S. Patent No. 8,988,796

Case No.: IPR2021-00641

MOTION FOR JOINDER PURSUANT TO 35 U.S.C. § 315(c), AND 37 C.F.R. §§ 42.22, AND 42.122(b)

Mail Stop *Inter Partes* Review
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

I. STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c), and 37 C.F.R. §§ 42.22, 42.102, 42.122(b), and 42.222 HP Inc. respectfully submits this Motion for Joinder, together with a petition for *inter partes review* of U.S. Patent 8,988,796 ("the '796 patent"), seeking cancellation of claims 1-11 and 15-25 of the '796 patent, and joinder of this proceeding with *Ability Opto-Electronics Co., Ltd. v. Largan Precision Co., Ltd.*, Case IPR2020-01339 ("the Ability IPR").

This Motion for Joinder is timely under 37 C.F.R. §§ 42.22 and 42.122(b), as it is submitted within one month of February 22, 2021, the date on which the Ability IPR was instituted. *See* Ability IPR, Paper 10. HP submits that joinder is appropriate because it will: (1) promote efficient determination of the validity of the '796 patent in a single proceeding without prejudice to first petitioner Ability or patent owner Largan because HP's petition raises the ***identical*** grounds of unpatentability instituted by the Board in the Ability IPR; (2) not affect the schedule of the Ability IPR, nor increase the complexity of that proceeding; and (3) minimize burden because HP will agree to follow the same schedule as the petition that was already instituted.

Accordingly, joinder in this proceeding is appropriate and HP's Motion should be granted.

II. STATEMENT OF MATERIAL FACTS

Petitioner is involved in litigation concerning the '796 patent in the action styled *Largan Precision Co., Ltd. v. Ability Opto-Electronics Technology Co., Ltd. and HP Inc.*, No. 3:20-cv-6607-JD, filed by Patent Owner Largan Precision Co., Ltd.. The case was initially filed in the Easten District of Texas, but was subsequently transferred to the Northern District of California, where it is now pending.

On July 21, 2020, Ability filed its petition for *inter partes review* seeking cancellation of claims 1-11 and 15-25 of the '796 patent. (Ability IPR, Paper 1):

- Ground 1: Claims 1-11 and 15-25 under 35 U.S.C. § 103 based on U.S. Patent No. 9,097,860 ("Yu").
- Ground 2: Claims 1–11, 15–16, 19–24 under 35 U.S.C. § 103 based on U.S. Patent Application Publication No. 2004/0012861 ("Yamaguchi") and Yu.

On November 23, 2020, Largan filed a preliminary response. (Ability IPR, Paper 7).

On February 22, 2021, the Board instituted review of claims 1-11 and 15-25 of the '796 patent with respect to Grounds 1-2. (Ability IPR, Paper 10).

On February 22, 2021, the Board entered a scheduling order in the Ability IPR, setting Oral Argument for December 2, 2021. (Ability IPR, Paper 11).

On March 8, 2021, HP first learned about Ability and Largan's settlement, when Largan filed a notice of dismissal with prejudice against Ability in the co-

pending district court action. Largan did not offer HP a dismissal with prejudice of the district court case. Given that more than a year has elapsed between the filing of the action by Largan, the only way for HP to challenge the invalidity of the '796 patent in an IPR proceeding is by stepping into Ability's shoes in the IPR already instituted by the PTAB.

HP's petition in this proceeding seeks cancellation of claims 1-11 and 15-25 of the '796 patent based on Grounds 1-2 as set forth in the Ability IPR petition.

HP's petition in this proceeding proposes the same claim construction positions as the petition in the Ability IPR, and relies upon the same exhibits.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

Joinder of this proceeding with the Ability IPR will not enlarge the Ability IPR, nor negatively affect its case schedule. Instead, in view of the Joint Motion to Terminate filed by Largan and Ability, joinder of this proceeding with the Ability IPR is the only way that HP can ensure that its interests in the outcome of the Ability IPR are addressed. Thus, joinder here is appropriate.

A. Legal Standard

The Leahy-Smith America Invents Act (AIA) permits joinder of inter partes review proceedings. The statutory provision governing joinder of *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads as follows:

> (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.

Under 35 U.S.C. § 315(c), the Board has authority to join a second *inter partes* review proceeding to an instituted first *inter partes* review proceeding. The motion for joinder must be filed within one month of institution of the first *inter partes* review proceeding. 37 C.F.R. § 42.122(b).

In exercising its discretion to grant joinder, the Board considers the impact of substantive and procedural issues on the proceedings, as well as other considerations, while being "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 Solutions, Inc.*, Case IPR2013-00385, Paper No. 17 (July 29, 2013) at 3. The Board should consider "the policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding." Id. at 10. Under this framework, joinder of the present IPR with the Ability IPR is appropriate.

"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 and *Macronix Int'l Co. v. Spansio*n, IPR2014-00898, Paper 15 at 4 (Aug. 13, 2014). The Board should also consider "the policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding." *See Dell, Inc. v. Network-1 Security Solutions, Inc.*, Case IPR2013-00385, Paper No. 17 (July 29, 2013) at 3. Under this framework, joinder of the present petition with the Ability IPR is appropriate.

The fact that the Ability IPR appears likely to terminate should not prevent joinder. In *Qualcomm Inc. v. Bandspeed, Inc.*, No IPR2015-00314, -01577, joinder of a follow-on petition that raised no new grounds was permitted even though the original IPR proceeding was terminated while the motion for joinder was pending. (Paper 21 at 8). There, the Board found that joinder would not discourage settlement, nor would it hinder a "just, speedy, and inexpensive resolution of the parties' dispute." *Id.* The same is true here.

B. Joinder Will Not Impact the Existing IPR Schedule

Joinder in this case will not impact the Board's ability to complete its review of the '796 patent in a timely manner. 35 U.S.C. § 316(a)(11) and associated rule 37 C.F.R. § 42.100(c) provide that *inter partes* review proceedings should be completed and the Board's final decision issued within one year of institution of the review. In this case, joinder will not affect the Board's ability to issue the

decision within this required one-year timeframe because HP's Petition is substantially identical to the Ability IPR.

HP raises no issues or grounds that are not already before the Panel in the Ability IPR. HP challenges the same claims as the Ability IPR, and does so based on the same grounds raised in the Ability IPR. Indeed, the petition filed by HP is essentially ***identical*** to that filed by Ability. There are no substantive differences.

HP also relies on a substantially ***identical*** declaration from the same expert used in the Ability IPR.[1] And HP has included the same exhibits, and given them the same exhibit numbers as in the Ability IPR.

Moreover, because Ability has already signaled its intent to withdraw from the Ability IPR proceeding, HP's presence in the proceeding carries no risk of duplicative or superfluous briefing or motion practice. HP agrees to adopt ***all***

[1] HP has filed a declaration of Dr. William Plummer concurrently with this motion and its IPR Petition. (Exhibit 1007). The Plummer declaration is substantially identical to the Plummer declaration filed along with the Ability IPR. (Ability IPR, Exhibit 1007). At the preference of the Panel, HP would be willing to withdraw its own Plummer declaration if it is permitted instead to rely on the previously-filed Plummer declaration in the Ability IPR.

arguments and positions previously raised by Ability (except for termination), and now merely seeks to step into Ability's shoes to continue the IPR proceeding.

C. No New Grounds of Unpatentability Are Asserted

As noted above, HP has not asserted any new grounds of unpatentability, and instead raises the identical grounds challenging the identical claims as the Ability IPR. Indeed, not only are the grounds the same, but HP's arguments supporting those grounds are also ***identical*** to the arguments set forth in the Ability IPR.

D. Joinder Will Not Prejudice Any Party

No party will be prejudiced by joining HP as a Petitioner to the Ability IPR. Instead, a substantial risk of prejudice will be avoided. As Largan and Ability have now reached a settlement of their dispute in the district court, and have likewise jointly moved to terminate the Ability IPR, refusal to join HP to the Ability IPR to replace Ability as Petitioner will result in the Ability IPR being terminated before reaching a final written decision, thereby prejudicing HP. As HP remains a party to the district court litigation brought by Largan, HP also has a clear interest in resolving the patentability of the '796 patent by allowing the IPR proceeding involving the '796 patent to reach a final written decision.

Joinder also will not prejudice Largan or Ability. Ability has settled its dispute with Largan, and thus no longer has any interest in the disposition of the

Ability IPR. Moreover, as noted above, HP's Petition raises no new grounds or arguments beyond those already raised in the Ability IPR, and thus creates no additional burden for Largan beyond that which it already faced as a patent owner. Continuing these proceedings even stand to benefit Largan, as they will resolve questions of patentability related to the '796 patent in a shorter and less costly manner than litigation.

IV. CONCLUSION

For the foregoing reasons, HP respectfully requests that this proceeding be joined with the Ability IPR.

Date: March 9, 2021

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