

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.
Petitioner

v.

MAXELL, LTD
Patent Owner

IPR2023-00316
U.S. PATENT NO. 8,170,394 B2

**PETITIONER VIZIO'S MOTION FOR JOINDER
TO *INTER PARTES* REVIEW IPR2022-01348**

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

VIZIO, Inc. (“Petitioner” or “VIZIO”) respectfully submits this Motion for Joinder, concurrently with its Petition for *inter partes* review of U.S. Patent No 8,170,394 B2 (“the ’394 Patent”), pursuant to 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22 and 42.122(b). This request is being submitted within the time set forth in 37 C.F.R. § 42.122(b).

On August 18, 2022, Motorola Mobility LLC (“Motorola”) filed its Petition for IPR in *Motorola Mobility, LLC v. Maxell, Ltd.*, Case No. IPR2022-01348 (“the Motorola IPR”). On February 24, 2023, the Board instituted the Motorola IPR. VIZIO’s petition challenges the same claims (2–9) and presents the same prior art and invalidity grounds at issue in the Motorola IPR.

VIZIO’s request for joinder is timely because it is filed less than one month after the institution of the Motorola IPR. Further, VIZIO’s request is consistent with the policy surrounding *inter partes* reviews, as it is the most expedient way “to secure the just, speedy, and inexpensive resolution of every proceeding.” *See* 37 C.F.R. § 42.1(b); *see also HTC v. Parthenon Unified Memory Architecture LLC*, IPR2017-00512, Paper No. 12 at 5-6 (June 1, 2017). VIZIO’s petition and the petition in the Motorola IPR are substantively identical with respect to the asserted grounds, based on the same prior art combination and supporting evidence, and challenge the same claims (*i.e.*, VIZIO’s Petition is a “copycat” petition). Upon

joining the Motorola IPR, VIZIO will act as an “understudy” and will not assume an active role unless Motorola settles with Patent Owner (or otherwise ceases to participate in the IPR).

Accordingly, the proposed joinder will neither unduly complicate the Motorola IPR nor delay its schedule. As such, the joinder will promote judicial efficiency in determining the patentability of the '394 Patent without prejudice to Patent Owner.

VIZIO has met and conferred with Motorola's counsel of record in IPR2022-01348. Motorola does not oppose VIZIO's motion for joinder.

II. STATEMENT OF MATERIAL FACTS

1. The '394 Patent is at issue in a patent enforcement proceeding against VIZIO in the U.S. International Trade Commission, Investigation No. 337-TA-1338.
2. The '394 Patent is also at issue in the following pending actions:
 - *Certain Mobile Electronic Devices*, Inv. No. 337-TA-1324 (U.S.I.T.C.) (“Lenovo ITC Action”);
 - *Maxell, Ltd. v. Lenovo Group Limited*, C.A. No. 6:22-cv-00334-ADA (W.D. Tex.) (“Lenovo WDTX Action”); and
 - *Motorola Mobility, LLC v. Maxell, Ltd. f/k/a Maxell Holdings, Ltd.*, IPR2022-01348 (PTAB) (the Motorola IPR).

3. The '394 Patent was formerly at issue in the following terminated actions:
 - *Certain Mobile Electronic Devices*, Inv. No. 337-TA-1312 (U.S.I.T.C.);
 - *BlackBerry Corporation et al. v. Maxell, Ltd. f/k/a Hitachi Maxell, Ltd.*, IPR2019-00089 (PTAB) (“the Blackberry IPR”); and
 - *Maxell, Ltd. v. BlackBerry Corporation et al.*, C.A. 1:17-cv-01446 (DDE).
4. On October 15, 2018, Blackberry Corp. (“Blackberry”) filed a petition for *inter partes* review in the Blackberry IPR requesting cancellation of claims 2–9 of the '394 Patent.
5. On March 24, 2019, the Board instituted the Blackberry IPR as to all claims and all grounds.
6. On April 29, 2019, the Board granted the parties' joint motion to terminate the Blackberry IPR pursuant to a settlement agreement.
7. On August 18, 2022, Motorola filed its petition for *inter partes* review in IPR2023-01348 requesting cancellation of claims 2–9 of the '394 Patent. The Motorola IPR challenges the same claims and presents the same prior art and grounds as the Blackberry IPR.
8. On February 24, 2023, the Board instituted the Motorola IPR with respect to all challenged claims and all grounds presented.

9. VIZIO's petition and the Motorola's petition in the Motorola IPR are substantively identical. Both petitions contain the same grounds (based on the same prior art combinations and supporting evidence) against the same claims, using the same evidence and arguments.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Board may grant a motion for joining an *inter partes* review petition with another *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). A petitioner may request joinder up to one month after the institution date of the proceeding to which joinder is requested, without prior authorization. 37 C.F.R. § 42.122(b). The Board, in determining whether to exercise its discretion to grant a motion for joinder, considers: (1) Petitioner's explanation why joinder is appropriate, (2) whether any new grounds of unpatentability are asserted in the second petition, (3) what impact, if any, joinder would have on the cost and schedule for the existing proceeding, and (4) whether granting joinder will add to the complexity of briefing and/or discovery. *Samsung Elecs. Co. Ltd., v. Demaray LLC*, IPR2021-01091, Paper 8 at 9-10 (PTAB Dec. 20, 2021) (citing Consolidated Trial Practice Guide, 76 (Nov. 2019) (<https://www.uspto.gov/TrialPracticeGuideConsolidated>) (citing *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013))).

B. VIZIO's Motion is Timely

VIZIO's Motion for Joinder is timely because it is being filed less than one month after the institution of the Motorola IPR. *See* 37 C.F.R. § 42.122(b).

As noted in VIZIO's Petition, the '394 Patent is one of four patents asserted against VIZIO in U.S. International Trade Commission ("ITC") Investigation 337-TA-1338 ("the 1338 Investigation"). VIZIO was served with only the Complaint in the 1338 Investigation on October 18, 2022. There is no corresponding district court action in which the '394 Patent (or any other patent at issue in the 1338 Investigation) is asserted against VIZIO. Accordingly, the provisions of 35 U.S.C. § 315 do not apply here because ITC investigations are not "civil actions" within the purview of § 315. *See Robert Bosch Tool Corp. v. SD3, LLC*, IPR2016-01753, Paper 15 at 9-12 (PTAB Mar. 22, 2017); *The Brinkmann Corp. v. A&J Mfg., LLC*, IPR2015-00056, Paper 10 at 7-8 (PTAB Mar. 23, 2015).

C. All Four Joinder Factors Weighs in Favor of VIZIO

VIZIO's petition is substantively identical to the petition in the Motorola IPR. Further, VIZIO does not present any new grounds of unpatentability. Additionally, as VIZIO will act as an "understudy" with respect to Motorola, joinder will have minimal or no impact on the pending schedule of the Motorola IPR. *See Sony Corp. et al. v. Memory Integrity, LLC.*, IPR2015-01353, Paper No. 11 at 6 (PTAB Oct. 15, 2015) (granting motion for joinder where petitioners requested an "understudy")

role). Moreover, the briefing and discovery will be simplified by resolving all issues in a single proceeding. Accordingly, joinder is appropriate.

1. Joinder with the Motorola IPR Is Appropriate

The Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.” *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper No. 12 at 9 (PTAB Aug. 24, 2016) (internal quotations and citations omitted).

Here, joinder with the Motorola IPR is appropriate because VIZIO's petition introduces identical arguments and the same grounds raised in the Motorola IPR. VIZIO challenges the same claims of the same patent, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the Motorola IPR.

Other than minor differences, such as differences related to formalities of a different party filing the petition and discretionary denial analysis specific to VIZIO, there are no changes to the facts, citations, evidence, or arguments in Motorola's petition.¹ Because these proceedings are substantively identical, good cause exists for joinder with the Motorola IPR, consistent with 37 C.F.R. § 42.1(b), so that the

¹ For example, VIZIO's Petition contains a brief discussion of *Advanced Bionics* with respect to discretionary denial under 35 U.S.C. § 325(d) as it pertains to VIZIO. See VIZIO's Petition at 14.

Board can efficiently “secure the just, speedy, and inexpensive resolution” of VIZIO’s and Motorola’s petitions in a single proceeding.

2. Petitioner Does Not Propose New Grounds

As noted above, VIZIO’s petition is substantively identical to the petition in the Motorola IPR. It challenges the same claims of the ’394 Patent, presents the same grounds and combinations of prior art, and relies on the same expert declaration submitted in the Motorola IPR. *See Sony*, IPR2015-01353, Paper No. 11 at 5 (granting institution of IPR and motion for joinder where petitioners relied “on the same prior art, same arguments, and same evidence, including the same expert and a substantively identical declaration”); *see also Par Pharm., Inc. v. Novartis AG*, IPR2016-01023, Paper No. 20 at 14 (PTAB Oct. 27, 2016) (granting motion for joinder where petitioners “do not assert any new ground of unpatentability that is not already being considered in [an instituted IPR proceeding], rely on the same arguments and evidence, and do not require any modification to the existing schedule”).

3. Joinder Will Not Negatively Impact the Motorola IPR Trial Schedule

Joinder will have minimal impact, if any, on the Motorola IPR’s trial schedule because VIZIO’s petition presents no new issues or grounds of unpatentability. *See Sony*, IPR2015-01353, Paper No. 11 at 6 (granting IPR and motion for joinder where “joinder should not necessitate any additional briefing or discovery from Patent

Owner beyond that already required in [the original IPR]”). Further, Petitioner expressly agrees that it will consent to the Motorola IPR trial schedule. Thus, there are no new issues for the Board to address, and Patent Owner will not be required to present any additional responses or arguments.

The Patent Owner's Response will also not be negatively impacted because the issues presented in VIZIO's petition are identical to the issues presented in the Motorola IPR. Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in responding to the petition in the Motorola IPR. As VIZIO's petition relies on the same expert declaration as Motorola, only a single deposition is needed for the proposed joined proceeding.

Accordingly, joinder with the Motorola IPR will not unduly burden or negatively impact the existing trial schedule.

4. Procedures to Simplify Briefing and Discovery

VIZIO explicitly agrees to take an “understudy” role, which will simplify briefing and discovery. VIZIO only contemplates that it would assume the role of primary petitioner in the Motorola IPR if: (1) Motorola is terminated as a party to the proceeding or (2) Motorola ceases participating in the proceeding such that the proceeding is no longer “meaningfully adversarial,” contrary to the public interest. *See ZTE (USA), Inc. v. CyWee Grp. Ltd.*, IPR2019-00143, Paper 50 at 7-9 (PTAB July 17, 2020) (allowing a joinder petitioner to assume the role of primary petitioner

with respect to a motion to amend because the “trial no longer appears to be meaningfully adversarial” where the primary petitioner did not oppose revised amended claims).

As an understudy, VIZIO agrees, upon joining the Motorola IPR, that the following conditions shall apply so long as Motorola remains an active party in IPR2022-01348:

- a) VIZIO shall not make any substantive filings and shall be bound in the proceeding by the filings of Motorola, unless a filing concerns termination and settlement, or issues solely involving VIZIO;²
- b) VIZIO shall not seek to cross-examine or defend the cross-examination of any witness, unless the topic of cross-examination concerns issues solely involving VIZIO;
- c) VIZIO shall not present any argument or make any presentation at the oral hearing on issues not solely involving VIZIO;³ and
- d) VIZIO shall not seek discovery from Maxell on issues not solely involving VIZIO.

² Circumstances may require VIZIO to request and file separate papers with respect to its individual status as petitioner in the proceeding—*e.g.*, a motion to terminate.

³ While VIZIO will not materially participate in calls with the Board, depositions, and any oral hearing, VIZIO anticipates that its counsel will attend such events.

See, e.g., Noven Pharm., Inc. v. Novartis AG, IPR2014-00550, Paper No. 38 at 5 (PTAB Apr. 10, 2015). Unless and until Motorola ceases to participate in the Motorola IPR proceeding, VIZIO will not assume an active role therein.

Thus, VIZIO's acceptance of an understudy role will allow the Motorola IPR to proceed without any delay or needing any duplicative efforts by the Board or the Patent Owner. *See Sony*, IPR2015-01353, Paper No. 11 at 6-7 (granting IPR and motion for joinder because "joinder would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board" where petitioners agreed to an "understudy" role). VIZIO is further willing to agree to any other reasonable conditions the Board deems necessary.

IV. GENERAL PLASTIC IS INAPPLICABLE

As explained in VIZIO's petition, application of the *General Plastic* analysis is not appropriate here as it relates to the Motorola IPR. *See VIZIO Petition*, Paper No. 1 at §V.B.

In *General Plastic*, the Board set forth a series of factors that may be analyzed with respect to "follow-on" petitions to help conserve the finite resources of the Board and prevent a subsequent petitioner from gaining a strategic advantage from filing a later petition. *See General Plastic Indus. Co., Ltd. v. Canon Kabushiki*

Kaisha, IPR2016-01357, slip op. at 16 (PTAB Sept. 6, 2017) (Paper 19) (precedential as to § II.B.4.i).

VIZIO submits that *General Plastic* does not apply in this circumstance. VIZIO's petition is not a "follow-on," at least because: (1) VIZIO has not previously filed an IPR against any claim of the '394 Patent, (2) VIZIO's petition is substantively identical to the petition in the Motorola IPR, and (3) VIZIO seeks to join the Motorola IPR as an understudy. As such, this is not the type of "serial" petition to which *General Plastic* applies.

However, in the event the Board does analyze the *General Plastic* factors, those factors heavily weigh in favor of instituting the present IPR, as discussed in detail in §V.B of VIZIO's Petition.

V. CONCLUSION

For the reasons discussed above, VIZIO respectfully requests that the Board grant VIZIO's petition and grant joinder with IPR2022-01348.

Date: March 3, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§42.6(e), 42.8(b)(4), and 42.105, the undersigned certifies that that a copy of the foregoing Motion for Joinder was served by filing this document through the P-TACTS System on March 3, 2023, as well as delivering a copy via overnight mail on the correspondence address of record for the subject patent:

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