

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SPACETIME3D, INC.,
Patent Owner.

IPR2023-00579
Patent 9,304,654 B2

Before HUBERT C. LORIN, DAVID C. McKONE, and MINN CHUNG,
Administrative Patent Judges.

CHUNG, *Administrative Patent Judge.*

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314
Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

LG Electronics Inc., LG Electronics U.S.A., Inc., and Google LLC filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–19 (the “challenged claims”) of U.S. Patent No. 9,304,654 B2 (Ex. 1001, “the ’654 patent”) owned by SpaceTime3D, Inc. (“Patent Owner”). Pursuant to our authorization, LG Electronics Inc. and LG Electronics U.S.A., Inc. (“LGE”) and Patent Owner filed a Joint Motion to Terminate Proceeding as to LGE (Paper 8), which was granted, terminating LGE from this proceeding. Paper 13. As the result, Google LLC (“Petitioner” or “Google”) remains as the only Petitioner in this proceeding.

Concurrently with the filing of the Petition, Petitioner filed a Motion for Joinder seeking to be joined as a party to *Apple Inc. v. SpaceTime3D, Inc.*, IPR2023-00343 (“Apple IPR”). Paper 1 (“Mot.”). Petitioner represents that the petitioner in the Apple IPR—Apple Inc. (“Apple”)—does not oppose the Motion for Joinder. Mot. 1. Patent Owner filed a Preliminary Response in this proceeding (Paper 11 (“Prelim. Resp.”)) but did not oppose the Motion for Joinder.

Upon considering the information presented, for reasons discussed below, we determine institution of *inter partes* review of all challenged claims of the ’654 patent is warranted on the same grounds instituted in the Apple IPR, and we grant Petitioner’s Motion for Joinder.

II. BACKGROUND

A. Real Party-in-Interest

Petitioner identifies itself as the real party-in-interest. Pet. 90. Patent Owner identifies itself as the sole real party-in-interest. Paper 6, 2.¹

B. Related Matters

According to the parties, the '654 patent is the subject of the following district court litigation: *SpaceTime3D, Inc. v. LG Electronics Inc.*, No. 2:22-cv-00049 (E.D. Tex.) and *SpaceTime3D, Inc. v. Apple Inc.*, No. 6:22-cv-00149 (W.D. Tex.). Pet. 90; Paper 6, 2. The parties also indicate that the '654 patent was involved in *SpaceTime3D, Inc. v. Samsung Electronics Co.*, No. 2:19-cv-00372 (E.D. Tex.), which has been terminated. Pet. 90; Paper 6, 2.

Petitioner indicates that the '654 patent was the subject of IPR2020-01418, whereas Patent Owner identifies IPR2020-0148 as related matter. Pet. 90; Paper 6, 2. It appears that the '654 patent was involved in IPR2020-01418, in which the petition was dismissed prior to institution. *See* IPR2020-01418, Paper 12.

¹ Paper 6, as filed, does not include page numbering as required by our rules. For purposes of this decision, we number the first page (the caption page) as page number 1. Although the error here is harmless, the parties are reminded to format all papers and exhibits in accordance with 37 C.F.R. §§ 42.6 and 42.63.

III. DISCUSSION

A. Institution of Inter Partes Review

In the Apple IPR, Apple challenges the patentability of claims 1–19 of the '654 patent on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–5, 7, 8, 10–13, 15–17, 19	103(a)	Anthony, ² Hanggie ³
6, 9, 14, 18	103(a)	Anthony, Hanggie, Matthews ⁴
1–5, 7, 8, 10–13, 15–17, 19	103(a)	Hanggie, Anthony
6, 9, 14, 18	103(a)	Hanggie, Anthony, Matthews

Apple IPR, Paper 2 at 4. Apple supports its challenge with a declaration from Henry Fuchs, Ph.D. Apple IPR, Ex. 1003. After considering the petition, Patent Owner’s preliminary response, and additional briefing from the parties in the Apple IPR, we instituted trial. *See* Apple IPR, Paper 11 (“Institution Decision”) at 73–74 (PTAB July 6, 2023).

Petitioner here, Google, represents that the present Petition is “based on the same grounds and combinations of prior art that are at issue in the Apple IPR” and that Petitioner “has substantially copied the substance of Apple’s petition and accompanying declaration.” Mot. 5. Specifically,

² U.S. Patent Application Publication No. 2005/0091596A1, published Apr. 28, 2005 (Ex. 1007, “Anthony”).

³ U.S. Patent Application Publication No. 2005/0088447 A1, published Apr. 28, 2005 (Ex. 1006, “Hanggie”).

⁴ U.S. Patent Publication Application No. 2006/0107229 A1, published May 18, 2006 (Ex. 1008, “Matthews”).

Petitioner challenges the patentability of claims 1–19 of the ’654 patent on the same grounds as the Apple IPR petition, “relying on the same prior art and evidence, including the same declaration identical in substance from the same expert.” *Id.* at 2; Pet. 4.

We have reviewed the Petition, the petition filed in the Apple IPR, and the evidence relied on in both petitions, and we agree with Petitioner that the instant Petition is in substance essentially identical to Apple’s petition in the Apple IPR with respect to the patentability of the challenged claims of the ’654 patent. *Compare* Pet. 4–84, *with* Apple IPR, Paper 2 at 4–84. Accordingly, regarding the underlying patentability challenges, there are no additional issues presented by Petitioner.

Patent Owner’s Preliminary Response in this proceeding contains the same arguments as those included in its preliminary response filed in the Apple IPR. *Compare* Prelim. Resp., *with* Apple IPR, Paper 6 at 1–3, 9–55. Although the Preliminary Response additionally incorporates Patent Owner’s arguments regarding discretionary denial under 35 U.S.C. § 325(d) from Patent Owner’s Preliminary Sur-reply in the Apple IPR (*compare* Prelim. Resp. 3–8, *with* Apple IPR, Paper 8 at 1–7), no new arguments are presented by Patent Owner’s Preliminary Response in this proceeding with respect to discretionary denial under § 325(d) or the patentability of the challenged claims.

Consequently, for substantially the same reasons discussed in our Institution Decision in the Apple IPR, which we incorporate expressly herein, we find Petitioner has demonstrated a reasonable likelihood of showing that at least one challenged claim of the ’654 patent is unpatentable. *See* Apple IPR, Paper 11. In addition, for substantially the same reasons

discussed in our Institution Decision in the Apple IPR, we decline to exercise our discretion to deny the Petition under 35 U.S.C. § 325(d). *See id.* at 11–18.⁵ We, therefore, find that the Petition warrants institution of *inter partes* review of all challenged claims on the grounds asserted in the Petition.

B. Motion for Joinder

Based on authority delegated to us by the Director, we have discretion to join a petitioner for *inter partes* review as a party to a previously instituted *inter partes* review. 35 U.S.C. § 315(c). Section 315(c) provides, in relevant part, that “[i]f 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” *Id.*

Procedurally, a motion for joinder must be filed “no later than one month after the institution date of any *inter partes* review for which joinder is requested.” 37 C.F.R. § 42.122(b) (2022). Petitioner filed its Motion for Joinder on February 10, 2023, prior to our July 6, 2023, Institution Decision in the Apple IPR. Mot. 1; Apple IPR, Paper 11. Thus, Petitioner’s Joinder Motion has been timely filed.

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder should (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; and (3) explain what

⁵ Patent Owner has not raised any arguments for exercising discretion under § 314(a) based on a parallel proceeding. *See generally*, Prelim. Resp. We decline to address this issue any further. *See* Pet. 86 (“Google is not a Defendant in the parallel proceeding.”), 87–88.

impact (if any) joinder would have on the trial schedule for the existing review. *Kyocera Corp. v. SoftView LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

As discussed above, we find that the Petition here: (1) is substantively identical to the petition in the Apple IPR; (2) contains the same grounds based on the same evidence as the Apple petition; and (3) relies on the same declaration of Henry Fuchs, Ph.D., relied upon in the Apple petition. Mot. 2, 5; Ex. 1003. And no new grounds or patentability issues are presented by the Petition.

Petitioner also represents that it “will assume an understudy role” in the joined proceeding. Mot. 2. Specifically, Petitioner agrees that Petitioner will: (1) assume “a second-chair role as long as Apple remains in the proceeding”; (2) adhere to all applicable deadlines in the Apple IPR; (3) submit “consolidated” filings with Apple for all substantive papers; (4) refrain from requesting or reserving any additional depositions or deposition time; and (5) refrain from requesting or reserving additional oral hearing time. *Id.* at 6. In addition, Petitioner asserts that “joinder would not adversely impact the trial schedule, briefing, or discovery in the Apple IPR.” *Id.* at 8.

As noted above, Patent Owner did not file an opposition to the Joinder Motion.

On this record, we determine that joinder would result in the just, speedy, and inexpensive resolution of Petitioner’s challenge. *See* 37 C.F.R. § 42.1(b). For the reasons discussed above, joinder with the Apple IPR is appropriate under the circumstances and we grant Petitioner’s Joinder Motion.

IV. ORDER

Accordingly, it is:

ORDERED that pursuant to 35 U.S.C. § 314, an *inter partes* review is hereby instituted as to claims 1–19 of the '654 patent on all grounds presented in the Petition;

FURTHER ORDERED that the Motion for Joinder with IPR2023-00343 is *granted*, and Petitioner is joined as a petitioner to IPR2023-00343;

FURTHER ORDERED that Petitioner's role in IPR2023-00343 shall be limited as stated by Petitioner in the Motion for Joinder unless and until Apple ceases to participate in IPR2023-00343;

FURTHER ORDERED that all future filings in the joined proceeding are to be made only in IPR2023-00343;

FURTHER ORDERED that the Scheduling Order in IPR2023-00343, and any modifications thereto, shall govern the schedule of the joined proceeding;

FURTHER ORDERED that the case caption in IPR2023-00343 for all further submissions shall be changed to reflect joinder of Google LLC as a petitioner, as indicated in the attached sample case caption; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2023-00343.

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¹ Google LLC, which filed a petition in IPR2023-00579, has been joined as a petitioner in this proceeding.