

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TCL INDUSTRIES HOLDINGS CO., LTD.,

Petitioners,

v.

ATI TECHNOLOGIES ULC,

Patent Owner.

PTAB Case No. IPR2024-00366

U.S. Patent No. 8,760,454 B2

TCL'S MOTION FOR JOINDER TO IPR2023-00922

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I. STATEMENT OF PRECISE RELIEF REQUESTED

Petitioner TCL Industries Holdings Co, Ltd. (“TCL”) moves for joinder of its contemporaneously-filed Petition for *inter partes* review (“IPR”) of claims 1–11 of U.S. Patent No. 8,760,454 (“the ’454 patent”) with a pending IPR, *Realtek Semiconductor Corp. v. ATI Technologies ULC*, No. IPR2023-00922 (“the Realtek IPR”), which the Board instituted on December 1, 2023.

The Realtek IPR concerns the same patent and the same claims as TCL’s Petition. TCL’s Petition and supporting expert declaration are substantively identical to the petition and expert declaration submitted in the Realtek IPR. TCL here asserts that the same claims are obvious over the same prior art based on the same arguments supported by the same expert opinions as in the Realtek IPR.

TCL agrees to take an “understudy” role if joined. Joinder will not cause any delay in the resolution of the Realtek IPR. Joinder, therefore, is appropriate because it will resolve the same patentability issues of the same patent, it will not delay the schedule that the Board has issued in the Realtek IPR, and the parties in the Realtek IPR will not be prejudiced.

II. STATEMENT OF MATERIAL FACTS

ATI Technologies ULC (“ATI”) purports to own the ’454 patent.

On May 5, 2022, ATI asserted the ’454 patent against TCL in the following case: *Certain Graphics Systems, Components Thereof, and Digital Televisions*

Containing The Same, Inv. No. 337-TA-1318 (U.S. International Trade Commission).

On May 6, 2022, ATI asserted the '454 patent against TCL in the following case: *Advanced Micro Devices, Inc. et al. v. TCL Industries Holdings Co., LTD., et al.*, Case No. 2:22-cv-00134 (E.D. Tex.).

On May 19, 2023, Realtek filed the Realtek IPR, requesting cancellation of claims 1–11 of the '454 patent. IPR2023-0922, Paper 1.

On December 1, 2023, the Board instituted the Realtek IPR and entered a Scheduling Order. IPR2023-0922, Papers 10 and 11.

Along with this Motion for Joinder, TCL simultaneously files the Petition, which argues, among other things, that the same claims of the '454 patent are obvious based on the same grounds and for the same reasons as set forth in the Realtek IPR petition.

The grounds proposed in the Petition are the same as those described in the Realtek IPR petition—the Petition does not contain any additional arguments or evidence in support of the unpatentability of claims 1–11 of the '454 patent.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Joinder is timely

This request is being submitted within the time period set forth in 37 C.F.R. § 42.122(b).

B. The *Kyocera* factors support joinder

The Board has discretion to join this IPR with the Realtek IPR. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); *HTC v. Parthenon Unified Memory Architecture LLC*, IPR2017-00512, Paper 12 at 6 (PTAB June 1, 2017). In evaluating a motion for joinder, the Board considers the following factors: (1) the reasons why joinder is appropriate; (2) whether the petition raises any new grounds of unpatentability; (3) any impact joinder would have on the cost and trial schedule for the existing review; and (4) whether joinder will add to the complexity of briefing or discovery. *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013); Consolidated Trial Practice Guide 76 (Nov. 2019), <https://go.usa.gov/xpvPF>. These factors weigh in favor of joinder. As a result, the Board should exercise its discretion to allow joinder here.

1. Joinder is appropriate because TCL proposes no new grounds of unpatentability (factors 1 and 2)

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. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (PTAB Aug. 24, 2016) (internal quotations and citations omitted) (emphasis original). Joinder is appropriate here because the Petition asserts the same grounds and relies on the same evidence for unpatentability presented in the Realtek IPR. Specifically, the Petition and the Realtek IPR petition rely on the same prior art

references, alone and/or in the same combination of references. Moreover, the Petition and the Realtek IPR petition rely on the same expert opinions in the declaration of Dr. Pfister. The arguments in both petitions are identical; there are no new grounds of unpatentability asserted in the Petition.

As the same issues will be addressed in both proceedings, joinder makes sense. *See, e.g., HTC*, IPR2017-00512, Paper 12 at 7 (granting motion for joinder where the second petition involved “the same claims, the same patent, the same prior art references, the same expert declaration, and the same arguments and rationales”); *STMicroelectronics, Inc. v. Lone Star Silicon Innovations, LLC*, IPR2018-00436, Paper 7 at 5 (PTAB May 4, 2018) (similar).

By permitting joinder of TCL to the Realtek IPR in an “understudy” role, the Board will allow TCL to challenge these asserted claims while not creating any additional burdens on ATI or the Board. TCL warrants that this result is both fair and efficient, and therefore appropriate. *See also* Petition (Paper 1), § VIII (discussing *General Plastic* factors and other related frameworks relevant to institution).

2. Joinder will not impact the trial schedule or cost of the joined proceeding (factor 3)

Joinder will not prejudice the parties to the Realtek IPR. TCL will not request any alterations to the trial schedule that the Board issued in the Realtek IPR (IPR2023-00922, Paper 11) on the basis of joinder, leaving that schedule

unchanged.

TCL also agrees to adopt a secondary, “understudy” role in the Realtek IPR, if joined. *See, e.g., Garmin Int’l, Inc. v. Philips North Am. LLC*, IPR2020-00910, Paper 8 at 45, 47–50 (PTAB Nov. 19, 2020) (granting joinder where petitioners agreed to accept an “understudy” role); *STMicroelectronics*, IPR2018-00436, Paper 7 at 5 (similar). TCL will assume a primary role only if the Realtek IPR petitioner ceases its participation in that proceeding. TCL’s agreement to take an “understudy” role removes any potential complication or delay caused by joinder, while providing the parties an opportunity to address all issues that may arise. *See, e.g., Mylan Pharms. Inc. v. Novartis AG*, IPR2014-00550, Paper 38 at 5-6 (PTAB Apr. 10, 2015). Thus, joinder will not affect the cost of the Realtek IPR for ATI, the Realtek IPR petitioner, and the Board.

3. Joinder will not complicate briefing and discovery (factor 4)

This factor favors joinder. If joinder is granted, TCL agrees to take on an understudy role. Accordingly, joinder will not affect briefing and discovery. Those activities will proceed in the same way with or without joinder. In either case, Realtek will file briefing and conduct discovery. TCL will make filings and conduct discovery only if Realtek exits the proceeding.

IV. CONCLUSION

For the foregoing reasons, TCL respectfully requests that the Board institute

its Petition for *Inter Partes* Review of U.S. Patent No. 8,760,454 and join this proceeding with the Realtek IPR.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of this TCL'S MOTION FOR JOINDER TO IPR2023-00922 was served by FedEx® mail delivery service in its entirety on the date indicated below on Patent Owner at the correspondence address of record at the U.S. Patent and Trademark Office as follows:

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A courtesy copy of this Motion was also served via electronic mail on Patent Owner's counsel of record in a related district court litigation:

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