UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.,
Petitioner,

v.

MULTIMEDIA TECHNOLOGIES PTE. LTD.,
Patent Owner.

Case IPR2024-00696
Patent 9,247,174

PETITIONER'S MOTION FOR JOINDER
UNDER 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22, and 42.122(b)

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I. STATEMENT OF RELIEF REQUESTED

VIZIO, Inc. ("VIZIO" or "Petitioner") respectfully submits this Motion for Joinder, concurrently with a Petition ("VIZIO's Petition") for *inter partes* review of U.S. Patent No. 9,247,174.

Pursuant to 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22, and 42.122(b), VIZIO requests *inter partes* review and joinder with *LG Electronics, Inc., LG Electronics U.S.A., Inc. v. Multimedia Technologies Pte. Ltd.*, IPR2024-00352 ("the LG IPR"), which was filed on December 20, 2023. VIZIO's Petition is substantively identical to the petition in the LG IPR—challenging the same claims of the '174 patent on the same grounds while relying on the same prior art, arguments, and evidence. This Motion for Joinder and accompanying Petition are timely being filed before a decision instituting trial in the LG IPR. Counsel for VIZIO has conferred with petitioner's counsel in the LG IPR, and LG does not oppose this Motion for Joinder.

VIZIO is currently being sued by Patent Owner for alleged infringement of the '174 patent in an action styled *Multimedia Technologies Pte. Ltd. v. VIZIO Inc.*, No. 2:23-cv-00124-JRG-RSP (E.D. Tex.). VIZIO has not previously filed any petitions before the PTAB challenging the validity of the '174 patent.

Joinder is appropriate here because (i) VIZIO's Petition is substantively identical to the petition in the LG IPR, (ii) VIZIO agrees to an "understudy role,"

and (iii) VIZIO relies upon the same expert declaration as relied upon in the LG IPR, simplifying briefing and discovery. Accordingly, joinder will provide for a just, speedy, and inexpensive determination of related proceedings.

Therefore, VIZIO respectfully requests that the Board grant this Motion for Joinder.

II. STATEMENT OF MATERIAL FACTS

1. The owner of the ’174 patent, Multimedia Technologies Pte. Ltd. (“MMT”), sued VIZIO alleging infringement of the ’174 patent in the United States District Court for the Eastern District of Texas.

2. VIZIO was served with MMT’s (“MMT”) complaint on March 27, 2023.

3. On December 20, 2023, LG Electronics, Inc., LG Electronics U.S.A., Inc. (collectively, “LG”), which had also been served with a complaint alleging infringement of the ’174 patent, timely filed a Petition for *inter partes* review challenging claims 1-14 of the ’174 patent. *See LG Electronics, Inc., LG Electronics U.S.A., Inc. v. Multimedia Technologies Pte. Ltd.*, IPR2024-00352, Paper 1 (PTAB Dec. 20, 2023).

4. VIZIO’s Petition and this Motion for Joinder are being filed before a decision on institution of the LG IPR.

III. STATEMENT OF REASONS FOR REQUESTED RELIEF

A. Legal Standards

A petitioner may request joinder, without prior authorization, up to one month after the institution date of the proceeding to which joinder is requested. 37 C.F.R. § 42.122(b); *Taiwan Semiconductor Mfg. Co., Ltd. v. Zond LLC*, IPR2014-00781 and IPR2014-00782, Paper 5 at 3 (PTAB May 29, 2014).

The Board may grant a motion seeking to join a petitioner for *inter partes* review to another *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). In determining whether to exercise its discretion to grant a motion for joinder, the Board considers the following: (1) reasons why joinder is appropriate; (2) any new grounds of unpatentability asserted in the petition; (3) what impact (if any) joinder would have on the trial schedule for the existing review; and (4) specifically how briefing and discovery may be simplified. *See Dell, Inc. v. Network-1 Security Solutions, Inc.*, IPR2013-00385, Paper 17 at 4 (PTAB July 29, 2013).

Further, the legislative history of the AIA suggests that joinder may be granted as a matter of right where the later petitioner files an identical petition with identical grounds of unpatentability. *See* 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) ("The Office anticipates that joinder will be allowed ***as of right***-if an *inter partes* review is instituted on the basis of a petition, for example, a party that files an identical petition will be joined to that

proceeding, and thus allowed to file its own briefs and make its own arguments.") (emphasis added).

B. VIZIO's Motion for Joinder Is Timely

A motion for joinder is timely if the moving party files within one month of institution of the *inter partes* review for which joinder is requested. 37 C.F.R. § 42.122(b). Because VIZIO files this Motion before a decision on the institution of the LG IPR, this Motion is timely. *Id*. Additionally, this Motion is being filed before any motions have been filed requesting termination of the LG IPR.

C. The *Dell* Factors Favor Joinder

Each of the four *Dell* factors weighs in favor of granting VIZIO's Motion for Joinder. *Dell*, IPR2013-00385, Paper 17 at 4. Specifically, VIZIO's Petition does "not present issues that might complicate or delay" the LG IPR. *See Enzymotec Ltd. v. Neptune Techs & Bioresources, Inc.*, IPR2014-00556, Paper 19 at 6 (PTAB July 9, 2014) ("we are mindful of a policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding"). In fact, because VIZIO's Petition is substantively identical to the petition in the LG IPR, joinder would secure the just, speedy, and inexpensive resolution of the related proceedings. *See, e.g.*, *Oracle America Inc. v. Realtime Data LLC*, IPR2016-01672, Paper 13 at 7 (PTAB Mar. 7, 2017) (noting that "joining Oracle's

identical challenges to those in the 1002 IPR will lead to greater efficiency while reducing the resources necessary from both Realtime and the Board.”).

Joinder would have little, if any, impact on the LG IPR because, as detailed below, no new grounds would be added, the schedule would not be affected, no additional briefing or discovery would be required, and no additional burdens would be placed on Patent Owner. 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 12 at 9 (PTAB Aug. 24, 2016) (internal quotations and citations omitted).

Further, if LG moves to terminate the LG IPR and is dismissed before the Board decides this Motion for Joinder, VIZIO respectfully requests that the Board exercise its discretion and decline to terminate the LG IPR at least until the Board considers this Motion.

Accordingly, joinder is appropriate because it eliminates the possibility of duplicate efforts and ensures a just, speedy, and inexpensive resolution of these related proceedings.

1. No New Grounds of Unpatentability in the VIZIO Petition

VIZIO’s Petition is substantively identical to the petition in the LG IPR. VIZIO’s Petition challenges the same claims, under the same grounds, while

relying on the same arguments, expert declaration, and evidence. Accordingly, no new claims and no new grounds will be added to the LG IPR as a result of the Board allowing joinder. Denial of joinder, however, would result in parallel proceedings involving identical grounds of unpatentability and needless duplication of effort.

2. No Impact on the Schedule for the LG IPR Proceeding

Because VIZIO's Petition challenges no additional claims and raises no new grounds of unpatentability, joinder should have no impact on any trial schedule issued in the LG IPR. Further, VIZIO will adhere to all applicable deadlines set forth in any LG IPR Scheduling Order and will coordinate with LG's counsel to consolidate filings. Additionally, no additional expert discovery will be needed as VIZIO's Petition relies upon the same declaration testimony from the same expert, Dr. Andrew Lippman, as relied upon by the petition in the LG IPR.

Additionally, if joined, VIZIO will not file additional briefs outside of the consolidated filings, will not request any additional deposition time, and will not request any additional oral hearing time.[1] In the event the LG IPR is terminated

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

with respect to the LG petitioners, VIZIO intends to "step into the shoes" of the dismissed LG petitioners and materially participate in the joined proceedings.

Accordingly, for the reasons above, joinder of VIZIO to the LG IPR will not affect the Board's ability to complete its review and issue a final decision within the statutory time limits under 35 U.S.C. § 316(a)(11) and 37 C.F.R. § 42.100(c).

3. Briefing and Discovery Will Be Simplified

Given that VIZIO's positions in its petition are identical to the positions in the LG IPR, VIZIO agrees to consolidated filings for all substantive papers and to consolidated discovery in the joined proceeding. VIZIO explicitly agrees to take an "understudy" role, described by the Board in other proceedings as follows:

(a) VIZIO shall not make any substantive filing and shall be bound by the LG Petitioners, unless a filing concerns termination and settlement, or issues solely involving VIZIO.

(b) VIZIO shall not present any argument or make any presentation at oral hearing unless an issue solely involves VIZIO, or when addressing Board-approved motions that do not affect the LG Petitioners, or their respective position;

Additionally, VIZIO's role does not foreclose communication between VIZIO and the petitioners in the LG IPR.

(c) 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;

(d) VIZIO shall not seek discovery from Patent Owner on issues not solely involving VIZIO;

(e) VIZIO will not rely on expert testimony beyond that submitted by the LG Petitioners unless the LG Petitioners are terminated from the case prior to any necessary depositions. If the LG Petitioners are not terminated from the case prior to any necessary depositions, VIZIO agrees to rely entirely on, and be bound by, the expert declarations and depositions in the LG IPR.

See, e.g., *Noven Pharm., Inc. v. Novartis AG*, IPR2014-00550, Paper 38 at 5 (PTAB April 10, 2015).

Unless and until the LG petitioners cease to participate in the LG IPR proceeding, VIZIO will not assume an active role. VIZIO will assume the primary role only if LG ceases to participate in the LG IPR and the LG IPR terminates. The petitioners in the LG IPR have no objection to VIZIO joining in an "understudy" role.

Accordingly, due to VIZIO taking only an "understudy" role, Patent Owner and the LG Petitioners will only need to respond to one principal set of papers, will not require additional time to address additional arguments, and can thus proceed

with the existing trial schedule. These steps will minimize or eliminate any potential complications or delay that could potentially result from joinder. *See Sony Corp. v. Memory Integrity, LLC.*, IPR2015-01353, Paper 11 at 7 (PTAB Oct. 5, 2015) (granting motion 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 second petitioner agreed to "understudy" role). VIZIO will also abide by any additional conditions the Board deems appropriate for an "understudy" role.

By accepting an "understudy" role, VIZIO can comply with any schedule in the LG IPR and avoid any duplication of effort by the Board or the Patent Owner. These steps will minimize any potential complications or delay that potentially may have resulted by joinder.

4. No Prejudice to Patent Owner

Joinder of VIZIO to the LG IPR will not create any additional burden on Patent Owner. No additional grounds or arguments are being introduced, no new evidence or issues are being added, and no additional discovery or briefing or oral argument should be necessary because of VIZIO's joinder. Thus, the Patent Owner would not need to expend any additional resources beyond those required in the current LG IPR proceeding.

Moreover, joinder eliminates the need for Patent Owner to participate in parallel *inter partes* review proceedings instituted upon identical grounds of patentability.

IV. CONCLUSION

For the foregoing reasons, VIZIO respectfully requests that the Board institute the instant inter partes review upon the same grounds set forth in IPR2024-00352 and join the proceedings.

Dated: March 14, 2024

Respectfully Submitted,

/Steven W. Hartsell/
Steven W. Hartsell (Reg. No. 58,788)
SKIERMONT DERBY LLP
1601 Elm Street, Suite 4400
Dallas, TX 75201
Tel: (214) 978-6600
Fax: (214) 978-6601
VIZIO_SDTeam@skiermontderby.com
Lead Counsel for Petitioner

Rex Hwang (Reg. No. 56,206)
Skiermont Derby LLP
633 W. Fifth Street, Suite 5800
Los Angeles, CA 90071
Tel: (213) 788-4500
Fax: (213) 788-4545
VIZIO_SDTeam@skiermontderby.com
Back-Up Counsel for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that I caused to be served on counsel for Patent Owner a true and correct copy of the foregoing Petitioner's Motion for Joinder Under 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22, and 42.122(b) on March 14, 2024 by delivering a copy to the attorneys of record for Patent Owner as follows:

Per USPTO records via Federal Express:

Sheridan Ross P.C.
1560 Broadway, Suite 1200
Denver, CO 80202

By electronic mail:

Timothy K. Gilman tim.gilman@srz.com
Christoper M. Gerson chris.gerson@srz.com
Saunak K. Desai saunak.desai@srz.com
Gregory R. Springsted gregory.springsted@srz.com
John P. Mixon john.mixon@srz.com
Ramya A. Sundaram raymy.sundaram@srz.com
Robert Christopher Bunt rcbunt@pbatyler.com
Charles Ainsworth charley@pbatyler.com
MultimediaTechnologiesLitigations@srz.com

Dated: March 14, 2024

Respectfully Submitted,

/Steven W. Hartsell/
Steven W. Hartsell (Reg. No. 58,788)
Lead Counsel for Petitioner