

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC., LG ELECTRONICS U.S.A., INC.,
Petitioners

v.

MULTIMEDIA TECHNOLOGIES PTE. LTD.,
Patent Owner

IPR2025-00300
Patent No. 9,578,384 B2

**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

LG Electronics, Inc., LG Electronics U.S.A. Inc., (collectively “LGE” or “Petitioners”) respectfully submit this Motion for Joinder together with a Petition for *Inter Partes* Review of U.S. Patent No. 9,578,384 (“LGE’s Petition”). Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), LGE requests *inter partes* review and joinder with *Vizio, Inc. v. Multimedia Technologies, PTE. LTD.*, IPR2024-00723 (“the Vizio IPR”), which was filed on March 22, 2024. LGE’s Petition is substantively identical to the petition in the Vizio IPR—challenging the same claims of the ’384 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 no later than one month after the institution date, November 22, 2024, of the Vizio IPR. Counsel for LGE has conferred with petitioner’s counsel in the Vizio IPR, and this Motion for Joinder is not opposed.

Joinder is appropriate here because (i) LGE’s Petition is substantively identical to the petition in the Vizio IPR and (ii) LGE agrees to an “understudy role” and relies upon the same expert declaration as relied upon in the Vizio IPR, simplifying briefing and discovery. Accordingly, joinder will provide for a just, speedy, and inexpensive determination of related proceedings.

Accordingly, LGE respectfully requests that the Board grant this Motion for

Joinder.

II. STATEMENT OF MATERIAL FACTS

1. The owner of the '384 Patent, Multimedia Technologies, PTE. LTD. ("Multimedia"), sued LGE alleging infringement of the '384 Patent in the United States District Court for the Eastern District of Texas.
2. LGE was served with Multimedia's complaint on December 23, 2022.
3. On March 22, 2022, Vizio, which had also been served with a complaint alleging infringement of the '384 Patent on March 24, 2023, timely filed a Petition for *inter partes* review challenging claims 1-12 of the '384 Patent. *See Vizio, Inc. v. Multimedia Technologies, PTE. LTD.*, IPR2024-00723, Paper 1 (PTAB Mar. 22, 2024).
4. LGE's Petition and this motion are being filed within one month of the Board's decision instituting the Vizio IPR.

III. STATEMENT OF REASONS FOR REQUESTED RELIEF

A. Legal Standards

The Board may join as a party to an instituted *inter partes* review a person who has properly filed a petition for *inter partes* review that warrants institution. 35 U.S.C. § 315(c). Any request 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). A petition for *inter partes* review is not subject to the one-

year statutory time bar if the petition is accompanied by a request for joinder. 35 U.S.C. § 315(b); 37 C.F.R. § 42.122(b).

“A motion for joinder should: set forth the reasons joinder is appropriate; identify any new grounds of unpatentability asserted in the petition; and explain what impact (if any) joinder would have on the trial schedule for the existing review.” *Hyundai Motor Am. V. Stratosaudio, Inc.*, IPR2022-00224, Paper 11 at 7 (PTAB June 2, 2022) (citing *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013)).

B. LGE'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 LGE files this motion within one month of the institution date, November 22, 2024, of the Vizio IPR, this Motion for Joinder is timely. Additionally, this Motion for Joinder is being filed before any motions have been filed requesting termination of the Vizio IPR.

C. Joinder is Appropriate

Although joinder is discretionary, it is appropriate here because LGE's Petition does “not present issues that might complicate or delay” the existing Vizio IPR. See *Enzymotec Ltd. v. Neptune Techs & Bioresources, Inc.*, IPR2014-00556,

Paper 19 at 6 (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 LGE’s Petition is substantively identical to the petition in the Vizio IPR, joinder would secure the just, speedy, and inexpensive resolution of the related proceedings. Joinder would have little, if any, impact on the Vizio IPR because 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, as detailed below.

Further, if Vizio moves to terminate the Vizio IPR and is dismissed before the Board decides this Motion for Joinder, LGE respectfully requests that the Board exercise its discretion and decline to terminate with respect to the Patent Owner 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 proceedings.

1. No New Grounds of Unpatentability in the Petition

LGE’s Petition is substantively identical to the petition in the Vizio IPR. In particular, LGE’s Petition challenges the same claims (1-12) 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 Vizio 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 Existing IPR Proceeding

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

Additionally, if joined, LGE 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 Vizio IPR is terminated

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

with respect to the petitioner, LGE intends to “step into the shoes” of the dismissed petitioner and materially participate in the joined proceedings.

Accordingly, for the reasons above, joinder of LGE to the Vizio 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 LGE's positions in its petition are identical to the positions in the Vizio IPR, LGE agrees to consolidated filings for all substantive papers and to consolidated discovery in the joined proceeding. LGE explicitly agrees to take an “understudy” role, described by the Board in other proceedings:

- (a) all filings by [LGE] in the joined proceeding be consolidated with [the filings of the petitioners in the Vizio IPR], unless a filing solely concerns issues that do not involve [the petitioners in the Vizio IPR];
- (b) [LGE] shall not be permitted to raise any new grounds not already instituted by the Board in the [Vizio IPR], or introduce any argument or discovery not already introduced by [the petitioners in the Vizio IPR];
- (c) [LGE] shall be bound by any agreement between [Patent Owner] and [the petitioners in the Vizio IPR] concerning discovery

Additionally, LGE's role does not foreclose communication between LGE and other the petitioner in the Vizio IPR.

and/or depositions; and (d) [LGE] at deposition shall not receive any direct, cross-examination or redirect time beyond that permitted for [the petitioners in the Vizio IPR] alone under either 37 C.F.R. § 42.53 or any agreement between [Patent Owner] and [the petitioners in the Vizio IPR].

See IPR2014-00384, No. 38 at 5 (P.T.A.B. Apr. 10, 2015). LGE will assume the primary role only if Vizio cease to participate in the Vizio IPR. LGE is essentially asking the Board to join them as a party to the Vizio IPR. *Target Corp. v.*

Destination Maternity Corp., IPR2014-00508, Paper 18, pp. 10-11. The petitioners in the Vizio IPR have no objection to LGE joining in an “understudy” role.

By accepting an “understudy” role, LGE can comply with the current schedule 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 LGE to the Vizio IPR will not create any additional burden on Patent Owner. The Patent Owner need not expend any additional resources above and beyond those required in the current Vizio IPR. 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, LGE respectfully requests that the Board institute the instant *inter partes* review upon the same grounds in IPR2024-00723 and join the proceedings.

Respectfully submitted,

Dated: December 17, 2024
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CERTIFICATE OF SERVICE

The undersigned certifies that, in accordance with 37 C.F.R. § 42.6(e) and 37 C.F.R. § 42.105, service was made on Patent Owner as detailed below.

Date of service December 17, 2024

Manner of service FEDERAL EXPRESS

Documents served **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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