

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

IPR2023-00316
Patent 8,170,394 B2

Before TERRENCE W. McMILLIN, KEVIN C. TROCK, and JASON W.
MELVIN, *Administrative Patent Judges*.

McMILLIN, *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

Vizio, Inc. (“Petitioner”) filed a Petition to institute an *inter partes* review (Paper 1, “Pet.”) of claims 2–9 of U.S. Patent No. 8,170,394 B2 (Ex. 1001, “the ’394 patent”). 35 U.S.C. § 311. Concurrently with the Petition, Petitioner filed a Motion for Joinder in which it sought to join IPR2022-01348 as a party. Paper 3, 11 (“Mot.” or “Motion”). Petitioner “challenges the same claims (2–9) and presents the same prior art and invalidity grounds at issue” in IPR2022-01348. Mot. 1.

Maxell, Ltd. (“Patent Owner”) has not filed a Preliminary Response or any response to the Motion.¹

For the reasons set forth below, we institute an *inter partes* review as to the challenged claims of the ’394 patent on the grounds of unpatentability presented and grant the Motion.

II. INSTITUTION OF INTER PARTES REVIEW

Institution of an *inter partes* review is authorized by statute when “the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Petitioner challenges claims 2–9 of the ’394 patent based on the same grounds advanced in IPR2022-01348 as follows:

¹ In a paper filed in IPR2022-01348, Patent Owner acknowledged that its Preliminary Response in this proceeding was due on June, 27, 2023, and that the Motion was pending in this proceeding. IPR2022-01348, Paper 22, 4. Patent Owner also recognized that the Board may grant the Petition, institute this proceeding, and grant the motion for joinder. *Id.*

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
2, 4, 5, 7, 8	102(a) or (e)	Phillips ²
2, 4, 5, 7, 8	103(a)	Phillips, Ackley ³
2, 4, 5, 7, 8	103(a)	Phillips, Wallis ⁴
3, 6, 9	103(a)	Phillips, Uchida ⁵
3, 6, 9	103(a)	Phillips, Wallis, Uchida
2, 4, 5, 7, 8	103(a)	Russ, ⁶ McElhatten ⁷
3, 6, 9	103(a)	Russ, McElhatten, Uchida

Compare Pet. 8–9 with IPR2022-01348, Paper 2 (Petition). 8.

Petitioner contends that the Petition “and the petition in . . . IPR[2022-01348] 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).” Mot. 1. Based on our comparison of the Petition in this proceeding to the petition filed in IPR2022-01348, we agree with Petitioner. *Compare* Pet. 4–9, 15–85, with IPR2022-01348, Paper 2 (Petition), 4–9, 13–83. Accordingly, for the reasons expressed in our Decision Instituting Review in IPR2022-01348 (Paper 7), we determine that the Petition in this proceeding also warrants institution of *inter partes* review.

² U.S. Patent No. 7,293,276 B2, issued Nov. 6, 2007 (Ex. 1005, “Phillips”).

³ U.S. Patent No. 8,112,711 B2, issued Feb. 7, 2012 (Ex. 1007, “Ackley”).

⁴ U.S. Patent Application. Pub. No. 2005/0188408 A1, published Aug. 25, 2005 (Ex. 1006, “Wallis”).

⁵ U.S. Patent No. 8,773,360 B2, issued July 8, 2014 (Ex. 1010, “Uchida”).

⁶ U.S. Patent No. 8,181,205 B2, issued May 15, 2012 (Ex. 1008, “Russ”).

⁷ U.S. Patent No. 7,073,189 B2, issued July 4, 2006 (Ex. 1009, “McElhatten”).

III. MOTION FOR JOINDER

Petitioner requests joinder pursuant to 35 U.S.C. § 315(c), which provides as follows:

If 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 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

Section 315(c) “authorizes joinder of a person as a party, not ‘joinder’ of two proceedings” and “does not authorize the joined party to bring new issues from its new proceeding into the existing proceeding.” *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1335 (Fed. Cir. 2020). 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).

Petitioner makes an unopposed showing that joinder is appropriate. The Motion states:

Here, joinder with . . . IPR2022-01348 is appropriate because VIZIO’s petition introduces identical arguments and the same grounds raised in the [1348] 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 [1348] 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 [the

1348] petition. Because these proceedings are substantively identical, good cause exists for joinder with the [1348] IPR, consistent with 37 C.F.R. § 42.1(b), so that the Board can efficiently “secure the just, speedy, and inexpensive resolution” of VIZIO’s and [1348]’s petitions in a single proceeding.

Mot. 5–6 (footnote omitted).

The Motion for Joinder is timely because it was filed less than one month after the institution of IPR2022-01348. *See* 37 C.F.R. § 42.122(b). IPR2022-01348 was instituted on February 24, 2023. IPR2022-01348, Paper 7. The Petition (Paper 1) and Motion for Joinder (Paper 3) were filed on March 3, 2023.

We determine that Petitioner’s Motion requests no more than the statute allows and is routinely granted. Based on our review of the record before us, we grant Petitioner’s Motion and add it as a party to the IPR2022-01348.

IV. ORDER

For the reasons given, it is:

ORDERED that *inter partes* review of claims 2–9 of U.S. Patent No. 8,170,394 B2 is *instituted* with respect to all grounds of unpatentability set forth in the Petition;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of U.S. Patent No. 8,170,394 B2 is instituted commencing on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is given of the institution of a trial; and

FURTHER ORDERED that the Motion for Joinder is *granted*, and Vizio, Inc. is hereby joined as a petitioner in IPR2022-01348;

FURTHER ORDERED that the grounds on which trial was instituted in IPR2022-01348 are unchanged, and no other grounds are added;

FURTHER ORDERED that all future filings are to be made only in IPR2022-01348;

FURTHER ORDERED that the case caption in IPR2022-01348 shall be changed to reflect the joinder of Vizio, Inc.; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2022-01348.

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[Sample Case Caption]

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Patent 8,170,394 B2

* Vizio, Inc., which filed a petition in IPR2023-00316, has been joined as a party to this proceeding.