

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HYUNDAI MOTOR COMPANY LTD., HYUNDAI MOTOR AMERICA,
HYUNDAI MOTOR MANUFACTURING ALABAMA, LLC, KIA
MOTORS CORPORATION, KIA MOTORS AMERICA, INC.,
KIA MOTORS MANUFACTURING GEORGIA, INC., NISSAN NORTH
AMERICA, INC., NISSAN MOTOR CO., LTD., and AMERICAN
HONDA MOTOR CO., INC.,
Petitioner,

v.

BLITZSAFE TEXAS, LLC,
Patent Owner.

Cases IPR2016-01533, IPR2016-01557, IPR2016-01560
Patent 8,155,342 B2

Before JAMESON LEE, THOMAS L. GIANNETTI, MIRIAM L. QUINN,
and KERRY BEGLEY, *Administrative Patent Judges*.¹

QUINN, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and Grant of Motion for Joinder
37 C.F.R. § 42.108 and 37 C.F.R. § 42.122(b)

¹ This is not a decision by an expanded panel of the Board. Judges Quinn

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I. INTRODUCTION

Various Hyundai and Kia entities, listed in the caption above, filed a Petition (IPR2016-01557, Paper 1) requesting *inter partes* review of claims 49–57, 62–64, 66, 68, 70, 71, 73–80, 94, 95, 97, 99–103, 106, 109–111, 113, 115, and 120 (“the challenged claims”) of U.S. Patent No. 8,155,342 B2 (Ex. 1001, “the ’342 patent”), and concurrently filed a Motion for Joinder (IPR2016-01557, Paper 8, “Mot.”). The Nissan entities captioned above filed a substantively identical Petition (IPR2016-01560, Paper 3), and a Motion for Joinder (IPR2016-01560, Paper 4). Finally, American Honda Motor Co. also filed a substantively identical Petition (IPR2016-01533, Paper 2) and a Motion for Joinder (IPR2016-01533, Paper 3).

The pending Motions for Joinder seek joinder of these proceedings with *Toyota Motor Corporation v. Blitzsafe Texas, LLC.*, Case IPR2016-00418 (“the Toyota IPR”). Mot. 1.² Patent Owner filed Oppositions to the Motions for Joinder. Paper 13 (“Opp.”).³ Petitioner replied to Patent Owner’s opposition. Paper 14 (“Reply”). Patent Owner did not file a Preliminary Response. For the reasons described below, we institute an

² Given the similarities in the filed motions for joinder, we refer hereinafter to the Motion for Joinder filed in IPR2016-01557.

³ Patent Owner filed Oppositions in IPR2016-01557 and IPR2016-01533 but did not file an Opposition to the Motion for Joinder in IPR2016-01560. For ease of reference, hereinafter we refer to the Opposition filed in IPR2015-01557.

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inter partes review of the challenged claims and *grant* the Motions for Joinder.

II. INSTITUTION OF *INTER PARTES* REVIEW

The Petitions in these proceeding assert the same grounds as those we considered in the Toyota IPR, filed by Toyota Motor Corporation (“Toyota Petitioner”), in which we instituted *inter partes* review of the ’342 patent on July 8, 2016 based on all asserted grounds. *See* Mot. 1, 8; Pet. 5.⁴ Indeed, according to Petitioner the instant Petitions are “intentionally identical to the petition in the Toyota IPR in all substantive aspects.” Mot. 6. There is no dispute otherwise, and our inspection of the filings reveal that the grounds (and prior art) upon which the requested reviews of the ’342 patent are presented in these proceedings are identical to the grounds on which we instituted trial in the Toyota IPR. The Petitions in these proceedings also are supported by a declaration of Dr. Thomas Matheson (Ex. 1016) that is “substantively identical” to the declaration of Dr. Thomas Matheson filed in the Toyota IPR. Mot. 6.

Accordingly, for essentially the same reasons set forth in our Decision on Institution⁵ in the Toyota IPR, we hereby *grant* the instant Petitions on all asserted grounds.

III. GRANT OF MOTION FOR JOINDER

Joinder in *inter partes* review is subject to the provisions of 35 U.S.C. § 315(c):

⁴ We refer hereinafter to the Petition filed in IPR2015-01557.

⁵ TOYOTA IPR, Paper 13.

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(c) JOINDER.—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.

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 impact (if any) joinder would have on the trial schedule for the existing review. *See* Frequently Asked Question H5, <http://www.uspto.gov/patentsapplication-process/appealing-patentdecisions/trials/patent-reviewprocessing-system-prps-0>.

Petitioner asserts that joinder is appropriate as all the claims challenged in these proceedings, the grounds, prior art, and evidence submitted in support of the Petition are the same as in the Toyota IPR. Mot. 6. Joinder, thus, would avoid duplicate efforts and “secure the just, speedy, and inexpensive resolution of these related proceedings.” *Id.* at 6–7. Petitioner further asserts that no impact to the trial schedule would ensue if joinder is granted. Mot. 9. In particular, Petitioner agrees to adhere to the deadlines set in the ongoing trial in the Toyota IPR. *Id.* Petitioner also agrees to consolidated discovery and consolidated filings. *Id.* at 8.

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Patent Owner opposes the joinder on the basis that estoppel provisions under 35 U.S.C. § 315(b)⁶ would be violated if joinder were granted.

Opp. 1. In particular, Patent Owner argues that Petitioner “filed its joinder Petitioner more than one year after it had been served with a complaint alleging infringement” of the ’342 patent. *Id.* Citing § 315(b), Patent Owner takes the position that Petitioner is barred from filing the Petition and joinder motion. *Id.* at 2.

Patent Owner also argues that joining Petitioner with the Toyota IPR would result in the Hyundai/Kia entities and the Honda entities being allowed to “simultaneously argue two different positions” because these entities filed another petition for *inter partes* review concerning the ’342 patent (IPR2016-01476 and IPR2016-01473, respectively). Opp. 2–3. At this time, we note that the Board has not made a determination with respect to other petitions in IPR2016-01476 and IPR2016-01473. At this juncture, there is no evidence of inconsistent positions. Should such inconsistencies arise, the panel will address those at the appropriate time.

We are not persuaded by Patent Owner’s argument that the time bar codified in § 315(b) prevents joinder. Although we recognize that, in enacting the one-year time-bar provision applicable to *inter partes* review, a concern was repeated harassment of patent holders, that concern does not inform our understanding of whether joinder is proper under the circumstances argued here. Specifically, we note that § 315(b), the statutory

⁶ Patent Owner also cites § 316(a)(11), but fails to argue how this statute would be violated by granting joinder in this proceeding.

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