

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AMERICAN HONDA MOTOR CO., INC.,  
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,  
Patent Owner.

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Case IPR2018-00441  
Patent 7,067,944 B2

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Before KRISTEN L. DROESCH, JOHN A. HUDALLA, and  
AMANDA F. WIEKER, *Administrative Patent Judges*.

WIEKER, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and  
Granting Petitioner's Motion for Joinder  
*35 U.S.C. § 314(a) and 37 C.F.R. §§ 42.108, 42.122*

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American Honda Motor Co., Inc. (“Honda”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 3, 9, 10, and 11 of U.S. Patent No. 7,067,944 B2 (Ex. 1001, “the ’944 patent”). Honda also filed a Motion for Joinder (“Joinder Mot.”) requesting that we join Honda as a party with Aisin Seiki Co., Ltd. and Toyota Motor Corp. in *Aisin Seiki Co., Ltd. v. Intellectual Ventures II LLC*, Case IPR2017-01536 (“Aisin IPR”). Paper 3.

In the Aisin IPR, we instituted an *inter partes* review as to claims 3, 9, 10, and 11 of the ’944 patent on four grounds of unpatentability. Aisin IPR, Paper 11, 22. Honda’s Petition filed in this proceeding is essentially the same as the Petition filed in the Aisin IPR, and it seeks *inter partes* review based on the same four grounds instituted in the Aisin IPR. Joinder Mot. 1, 3–4. Honda also represents that, if it is allowed to join the Aisin IPR, it will assume a passive or “understudy” role and will only assume an active role if Petitioner in the Aisin IPR, namely, Aisin Seiki Co., Ltd. and Toyota Motor Corp., ceased to participate. *Id.* at 6–8. Honda indicates that Aisin Seiki Co., Ltd. and Toyota Motor Corp. do not oppose Honda’s Motion for Joinder. *Id.* at 1.

Patent Owner, Intellectual Ventures II LLC (“IV”), filed a Preliminary Response and Statement of Consent to Joinder (“Prelim. Resp.”). Paper 6.

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a). Under 35 U.S.C. § 314(a), we may not authorize an *inter partes* review unless the information in the petition and any preliminary response “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.” For the reasons that follow, we institute an *inter partes* review as to claims 3, 9, 10, and 11 of the

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'944 patent on the same grounds instituted in the Aisin IPR. We also *grant* Honda's Motion for Joinder.

## I. INSTITUTION OF INTER PARTES REVIEW

In the Aisin IPR, we instituted an *inter partes* review as to claims 3, 9, 10, and 11 of the '944 patent on the following grounds of unpatentability:

- (1) claim 3 under 35 U.S.C. § 102(b) as anticipated by Nakahara;<sup>1</sup>
- (2) claim 3 under 35 U.S.C. § 103(a) as obvious over Itaya<sup>2</sup> and Konishi;<sup>3</sup>
- (3) claims 9–11 under 35 U.S.C. § 103(a) as obvious over Bramm<sup>4</sup> and Watterson;<sup>5</sup> and
- (4) claims 10 and 11 under 35 U.S.C. § 103(a) as obvious over Trago.<sup>6</sup>

Aisin IPR, Paper 11, 22. As mentioned above, the Petition filed in this proceeding is essentially the same as the Petition filed in the Aisin IPR, and Honda limited the asserted grounds in this proceeding to only those grounds

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<sup>1</sup> Japanese Patent Application No. JP 10-271721, published Oct. 9, 1998 (Ex. 1004).

<sup>2</sup> Japanese Patent Application No. JP 59-000592, published Jan. 5, 1984 (Ex. 1005).

<sup>3</sup> Japanese Patent Application No. JP 10-238491, published Sept. 8, 1998 (Ex. 1006).

<sup>4</sup> U.S. Patent No. 4,994,748, issued July 31, 1990, filed Mar. 30, 1999 (Ex. 1007).

<sup>5</sup> U.S. Patent No. 6,227,797 B1, issued May 8, 2001, filed Sept. 18, 1998 (Ex. 1008).

<sup>6</sup> U.S. Patent No. 5,806,169, issued Sept. 15, 1998, filed Apr. 3, 1995 (Ex. 1009).

instituted in the Aisin IPR. Joinder Mot. 3–4; *compare* Pet. 3–60, with Aisin IPR, Paper 1, 4–68.

In its Preliminary Response, IV consents to institution and joinder. Prelim. Resp. 2. Given that we are granting Honda’s Motion for Joinder below; the Petition is essentially the same as, and only pertains to the instituted grounds in, the Aisin IPR; and IV consents to institution, we conclude that the information presented in the Petition establishes that there is a reasonable likelihood that Honda would prevail on its assertions that (1) claim 3 is anticipated by Nakahara; (2) claim 3 would have been obvious over Itaya and Konishi; (3) claims 9–11 would have been obvious over Bramm and Watterson; and (4) claims 10 and 11 would have been obvious over Trago. Pursuant to § 314, we institute an *inter partes* review as to these claims of the ’944 patent on the same grounds instituted in the Aisin IPR for the reasons stated in our Institution Decision from the Aisin IPR. *See* Aisin IPR, Paper 11.

## II. GRANTING HONDA’S MOTION FOR JOINDER

The AIA created administrative trial proceedings, including *inter partes* review, as an efficient, streamlined, and cost-effective alternative to district court litigation. 35 U.S.C. § 315(c) provides (emphasis added):

*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.*

“Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which

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joinder is requested.” 37 C.F.R. § 42.122(b). Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. The Board determines whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations. *See Sony Corp. of Am. v. Network-1 Security Solutions, Inc.*, Case IPR2013-00495, slip op. at 3 (PTAB Sept. 16, 2013) (Paper 13) (“*Sony*”). When exercising its discretion, the Board is mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b).

As the moving party, Honda has the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b). A motion for joinder should (1) set forth the reasons why joinder is appropriate; (2) identify any new ground(s) 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 Sony* at 3; Joinder Mot. 3. Petitioner should address specifically how briefing and/or discovery may be simplified to minimize schedule impact. *See Kyocera Corp. v. SoftView LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15) (representative).

Honda’s Motion is timely because it was filed on January 12, 2018, which is within one month of our December 13, 2017, institution of the Aisin IPR. *See* 37 C.F.R. § 42.122 (“Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested.”); Joinder Mot. 3.

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