

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN HONDA MOTOR CO., INC.,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

Case IPR2018-00443
Patent 7,928,348 B2

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 24–27 of U.S. Patent No. 7,928,348 B2 (Ex. 1001, “the ’348 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 IPR2017-01538 (“Aisin IPR”). Paper 3.

In the Aisin IPR, we instituted an *inter partes* review as to claims 24–27 of the ’348 patent on three grounds of unpatentability. Aisin IPR, Paper 11, 27. 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 three grounds instituted in the Aisin IPR. Joinder Mot. 1, 3. 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 24–27 of the ’348 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 24–27 of the '348 patent on the following grounds of unpatentability:

- (1) claims 24–27 under 35 U.S.C. § 103(a) as unpatentable over Konishi;¹
- (2) claims 24–27 under 35 U.S.C. § 103(a) as unpatentable over Umeda,² Raible,³ and Neal;⁴
- (3) claims 24–27 under 35 U.S.C. § 103(a) as unpatentable over Bramm⁵ and Watterson.⁶

Aisin IPR, Paper 11, 27. 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 instituted in the Aisin IPR. Joinder Mot. 3–4; *compare* Pet. 3–46, with Aisin IPR, Paper 1, 3–54.

In its Preliminary Response, IV consents to institution and joinder. Prelim. Resp. 2. Given that we are granting Honda's Motion for Joinder

¹ Japanese Patent Application Publication JP H10-238491, filed Feb. 26, 1997, published Sept. 8, 1998 (Ex. 1003).

² Japanese Patent Application Publication JP H11-166500, filed Dec. 3, 1997, published June 22, 1999 (Ex. 1004).

³ U.S. Patent No. 5,368,438, filed June 28, 1993, issued Nov. 29, 1994 (Ex. 1010).

⁴ U.S. Patent No. 6,362,554 B1, filed Dec. 22, 1999, issued Mar. 26, 2002 (Ex. 1014).

⁵ U.S. Patent No. 4,944,748, filed May 9, 1988, issued July 31, 1990 (Ex. 1008).

⁶ U.S. Patent No. 6,227,797 B1, filed Mar. 30, 1999, issued May 8, 2001 (Ex. 1009).

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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 claims 24–27 would have been obvious over Konishi; Umeda, Raible, and Neal; or Bramm and Watterson. Pursuant to § 314, we institute an *inter partes* review as to these claims of the '348 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 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

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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.

In its Motion for Joinder, Honda contends that joinder is appropriate “because the Aisin Petition involves the same patent, challenges the same claims, relies on a declaration from the same expert, and is based on the same grounds and combinations of prior art.” Joinder Mot. 3. Honda further contends its “Petition does not present any new grounds of unpatentability, and is substantively identical to the Aisin Petition.” *Id.* at 5.

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