

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 IPR2018-00444
Patent 7,683,509 B2

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

DROESCH, *Administrative Patent Judge*.

DECISION

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

I. INTRODUCTION

American Honda Motor Co. Inc. (“Honda,” “Petitioner”) filed a Petition requesting an *inter partes* review of claims 1, 2, 7, 14, and 15 (“the challenged claims”) of U.S. Patent No. 7,683,509 B2 (Ex. 1001, “the ’509 Patent”). Paper 1 (“Pet”). Petitioner also filed a Motion for Joinder, seeking joinder as petitioner with Aisin Seiki Co., Ltd. (“Aisin Seiki”) and Toyota Motor Corp. (“Toyota”) in *Aisin Seiki Co., Ltd. v. Intellectual Ventures II LLC*, Case No. IPR2017-01539 (“1539 IPR”). Paper 3 (“Mot.” or “Motion for Joinder”). Intellectual Ventures II LLC (“Patent Owner”) filed a Preliminary Response and Statement of Consent to Joinder with IPR2017-01539. Paper 6 (“Prelim. Resp. & Consent”).

We have authority under 35 U.S.C. § 314 and 37 C.F.R. § 42.4. An *inter partes* review may not be instituted unless it is determined that “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).

After considering the Petition, Motion for Joinder, and Preliminary Response & Consent, we institute *inter partes* review of claims 1, 2, 7, 14, and 15 and grant Petitioner’s Motion for Joinder for the reasons below.

II. INSTITUTION OF *INTER PARTES* REVIEW

We instituted an *inter partes* review in the '1539 IPR of the following claims of the '509 Patent on the following grounds and prior art ('1539 IPR, slip op. at 30–31 (PTAB Dec. 13, 2017) (Paper 10)):

| Claims | Statutory Basis | References |
|---------------------|-----------------|--|
| 1, 2, 7, 14, and 15 | § 103 | Umeda ¹ , Raible ² , and Neal ³ |
| 1, 2, 14, and 15 | § 103 | Bramm ⁴ and Watterson ⁵ |

The Petition in this proceeding asserts the same grounds as those we instituted in the '1539 IPR. *Compare* Pet. 4, with '1539 IPR, slip op. at 30–31 (PTAB Dec. 13, 2017) (Paper 10). Petitioner also relies on a Declaration of Dr. David L. Trumper (Ex. 1002), which Petitioner asserts is substantively identical to Dr. Trumper's Declaration filed in the '1539 IPR. *See* Mot. 6. Patent Owner consents to institution of *inter partes* review and joinder of Honda as a petitioner to the '1539 IPR. *See* Prelim. Resp. & Consent 2–3. In view of the fact that the issues in the instant Petition and in the '1539 IPR are identical, and that we have already considered Patent Owner's arguments in the '1539 IPR, pursuant to § 314, we institute *inter partes* review as to claims 1, 2, 7, 14, and 15 in this proceeding on the grounds presented in the Petition for the same reasons stated in our Decision on Institution in the '1539 IPR. *See* '1539 IPR, slip op. at 12–31 (PTAB Dec. 13, 2017) (Paper 10).

¹ Ex. 1004, 16–28, JP H11–16550, published June 22, 1999 (“Umeda”).

² Ex. 1010, U.S. Patent No. 5,368,438, issued Nov. 29, 1994 (“Raible”).

³ Ex. 1014, U.S. Patent No. 6,362,554 B1, issued Mar. 26, 2002 (“Neal”).

⁴ Ex. 1008, U.S. Patent No. 4,944,748, issued July 31, 1990 (“Bramm”).

⁵ Ex. 1009, U.S. Patent No. 6,227,797 B1, issued May 8, 2001 (“Watterson”).

III. GRANT OF MOTION FOR JOINDER

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

(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.

“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 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 within one month of institution of the '1539 IPR. *See* Mot. 3 (citing 37 C.F.R. § 42.122). In its Motion for Joinder, Honda contends that joinder is appropriate "because the Toyota 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." *Id.* Honda further contends its "Petition does not present any new grounds of unpatentability, and is substantively identical to the Toyota Petition." *Id.* at 5; *see id.* at 3–4. Honda further argues that joinder will not impact the schedule of the '1539 IPR, particularly because "Patent Owner will not be required to present any additional responses or arguments." *Id.* at 5.

Honda also agrees to be bound by the following conditions in its "understudy" role if it is joined to the '1539 IPR:

- (a) all filings by Honda in the joined proceeding [shall] be consolidated with the filings of Aisin Seiki Co., Ltd. and Toyota Motor Corp., unless a filing solely concerns issues that do not involve Aisin Seiki Co., Ltd. and Toyota Motor Corp.[:];
- (b) Honda shall not be permitted to raise any new grounds not already instituted by the Board, or introduce any argument or discovery not already introduced by Aisin Seiki Co., Ltd. and Toyota Motor Corp.[:];
- (c) Honda shall be bound by any agreement between Patent Owner and Aisin Seiki Co., Ltd. and Toyota Motor Corp. concerning discovery and/or depositions; and

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