

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORPORATION

Petitioner

Patent No. 6,772,057

Issue Date: Aug. 3, 2004

Title: VEHICULAR MONITORING SYSTEMS USING IMAGE PROCESSING

**MOTION FOR JOINDER
PURSUANT TO 35 U.S.C. § 315(C) AND
37 C.F.R. §§ 42.22 AND 42.122(B)**

Case No. IPR2013-00419

Pursuant to 35 U.S.C. § 315(c), 37 C.F.R. § 42.22, and 37 C.F.R. § 42.122(b), Petitioner Toyota respectfully requests joinder of an *Inter Partes* Review it filed, IPR2013-0419 (the “Toyota IPR”), with a recently instituted IPR filed by Mercedes-Benz USA LLC (“Mercedes”): *Mercedes-Benz USA, LLC, v. American Vehicular Sciences, LLC*, Case No. IPR2014-00646 (the “Mercedes IPR,” or “Mercedes’ IPR”). Both proceedings relate to U.S. Patent No. 6,772,057 (“the ’057 patent”), cover substantially identical claim sets, and are primarily based on the same prior art reference—U.S. Patent No. 6,553,130 to Lemelson (“Lemelson”). This is the second joinder motion that Toyota has filed with respect to the Mercedes IPR; Toyota has separately filed a motion to join a new petition—IPR2015-00261—with the Mercedes IPR.

Although the Toyota IPR was filed much earlier than the Mercedes IPR, and is due for a final written decision in less than two months, there are practical and equitable reasons why the Board should join the two proceedings and issue a single final written decision covering the combined issues raised in both proceedings.

First, the Toyota IPR and Mercedes IPRs challenge mostly the same claims of the ’057 patent based primarily on the Lemelson reference. Joinder of the Toyota IPR and Mercedes IPR would simply consolidate the issues such that the patentability of the claims over Lemelson is resolved all at once (i.e., in October 2015 when a final written decision will be due in the Mercedes IPR) and on a complete and harmonized record.

Second, in the event that the Board concluded that one or more claims were not unpatentable based on the record in the Toyota IPR, granting this joinder motion will ensure that Toyota can participate throughout the Mercedes IPR without the need for the Board to address possible disputes regarding the scope of estoppel under 35 U.S.C. § 315(e)(1), in either district court or in connection with Toyota’s new petition—IPR2015-00261—if it is joined with the Mercedes IPR. Toyota does not believe that estoppel would apply in any event, since the obviousness arguments presented in the IPR2015-00261 petition are not those that it “raised or could have raised” during the Toyota IPR. But, joinder of the Toyota IPR and the Mercedes IPR would avoid any need to engage in briefing and analysis of complicated estoppel issues.

Toyota is not trying to re-argue any of the same positions it took in the Toyota IPR. Toyota simply requests the procedural opportunity to argue that claims containing the “generated from” language would have been obvious in view of Lemelson, to the extent it has been effectively barred from arguing this obviousness position during the Toyota IPR. Joining the Toyota IPR and the Mercedes IPR provides the Board with the procedural vehicle to give Toyota that opportunity without having to resolve complicated estoppel issues.

Finally, the America Invents Act contemplates extending the deadline for issuance of a final written decision in these types of circumstances. 35 U.S.C. § 316(a)(11) indicates that the statutory deadline for completing a final determination

may be adjusted in the event of joinder under 35 U.S.C. § 315(c). *See also* 37 C.F.R. § 42.100(c). Joinder would also further Congressional goals of ensuring the “integrity of the patent system” and the “efficient administration of the Office.” It would ensure that the Board hears evidence from both sides now that Mercedes and AVS have resolved their disputes and moved to terminate. *See* IPR2014-00646, Paper 18. And, most importantly, it would give the Board the opportunity to issue just a single, harmonized written decision that is based on a complete record, rather than possibly having to issue two separate opinions, each based on partial records concerning the same claims and the same prior art reference.

Accordingly, the Board should grant this motion to join the Toyota IPR and the Mercedes IPR.

I. BACKGROUND AND RELATED PROCEEDINGS

The '057 patent is owned by AVS. On June 25, 2012, AVS filed a complaint with the U.S. District Court for the Eastern District of Texas alleging that Toyota and a number of related entities infringes certain claims of the '057 patent.

On July 12, 2013, Toyota filed an IPR petition that ultimately resulted in the Toyota IPR. Toyota's petition sought review of claims 1-4, 7-10, 30-34, 37-41, 43, 46, 48, 49, 56, 59-62, and 64. (*See* IPR2013-0419, Paper No. 3.) Toyota's petition was granted, and this IPR was instituted on January 13, 2014. (*See* IPR2013-0419, Paper No. 19.) The grounds instituted for review are as follows:

- Claims 1-4, 7-10, 40, 41, 46, 48, 49, 56, 59-61, and 64 as anticipated by U.S. 6,553,130 to Lemelson (“Lemelson”);
- Claims 30-34, 37-39, and 62 as obvious over Lemelson and U.S. 5,245,422 to Borcherts (“Borcherts”);
- Claims 4, 43, and 59 as obvious over Lemelson and U.S. 5,214,408 to Asayama (“Asayama”);
- Claim 34 as obvious over Lemelson, Borcherts and Asayama; and
- Claims 30, 32, and 37-39 as obvious over Japanese Unexamined Patent Application Publication No. H06-124340 to Yamamura (“Yamamura”) and Borcherts.

(*Id.* at 38.)

In responding to these proposed grounds of unpatentability, AVS argued that Lemelson purportedly fails to disclose the “pattern recognition algorithm generated from data of possible exterior objects and patterns of received waves from the possible exterior objects” of claims 1-4, 7-10, 31, 41, 56, 59-61, 62 and 64 (the “generated from” phases). (*See* IPR2013-0419, Paper 33, at 10-14.) According to AVS, these claim limitations require a pattern recognition algorithm trained with data from actual objects (i.e., “real” data), as opposed to simulated data and, therefore, the claims are patentable over Lemelson. (*Id.* at 14-19.) On May 9, 2014, the Board issued an order in which it prohibited Toyota from seeking discovery regarding “the

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