UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORPORATION

Petitioner

Patent No. 5,845,000
Issue Date: December 1, 1998
Title: OPTICAL IDENTIFICATION AND MONITORING SYSTEM USING PATTERN RECOGNITION FOR USE WITH VEHICLES

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

Case No. IPR2013-00424

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, IPR2013-0424 (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. IPR2014-00647 (the "Mercedes IPR," or "Mercedes' IPR"). Both proceedings relate to U.S. Patent No. 5,845,000 ("the '000 patent"), cover nearly 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—IPR2015-00262—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, both IPRs cover claims 10, 11, 16, 17, 19, 20 and 23 of the '000 patent, and are primarily based 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—IPR2015-00262—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 IPR2015-00262 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* IPR2014-00647, Paper 17. 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 '000 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 '000 patent.

On July 12, 2013, Toyota filed an IPR petition that ultimately resulted in the Toyota IPR. Toyota's petition sought review of claims with claims 10, 11, 16, 17, 19, 20, and 23. (*See* IPR2013-0424, Paper No. 2.) Toyota's petition was granted, and this IPR was instituted on January 14, 2014. (*See* IPR2013-0424, Paper No. 16.) The grounds instituted for review are as follows:

- Claims 10, 11, 19, and 23 as anticipated by U.S. 6,553,130 to Lemelson ("Lemelson");

- Claims 10, 11, 19, and 23 as obvious over Lemelson and U.S. 5,214,408 to Asayama ("Asayama"); and
- Claims 16, 17, and 20 as obvious over Lemelson and Japanese Unexamined Patent Application Publication No. S62-131837 to Yanagawa ("Yanagawa").

(*Id.* at 45.)

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 electromagnetic illumination from the possible exterior objects" of claims 10, 11, 19, and 23 and the "pattern recognition algorithm generated from data of possible sources of radiation including lights of vehicles and patterns of received radiation from the possible sources" of claims 16, 17, and 20 (the "generated from" phrases) (*See* IPR2013-0424, Paper 29, at 12-14). 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.*) On May 9, 2014, the Board issued an order in which it prohibited Toyota from seeking discovery regarding "the obviousness to one with ordinary skill in the art of the trained pattern recognition claim feature in light of Lemelson." (*See* IPR2013-0424, Paper No. 33, at 1.) Oral argument in this proceeding was heard on August 18,

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