

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORPORATION

Petitioner

v.

AMERICAN VEHICULAR SCIENCES LLC

Patent Owner

Patent No. 5,845,000

Issue Date: December 1, 1998

Title: OPTICAL IDENTIFICATION AND MONITORING SYSTEM USING
PATTERN RECOGNITION FOR USE WITH VEHICLES

PATENT OWNER'S OPPOSITION TO MOTION FOR JOINDER

Case No. IPR2013-00424

Toyota Motor Corporation's ("Toyota's") motion to join the nearly-completed IPR2013-00424 with IPR2014-00647 (recently filed by third party Mercedes-Benz USA, LLC) should be denied on its face for four statutorily-compelled reasons:

(1) The only parties to IPR2014-00647 (patent owner American Vehicular Sciences and petitioner Mercedes-Benz USA, LLC) have already settled and moved to terminate the IPR proceeding, rendering Toyota's motion to join moot as there will be no proceeding to join. *See, e.g., Google, Inc. et al v. Personalweb Tech. et al*, Case IPR2014-00977 at Paper 10 (P.T.A.B. 2014) (where the parties to the IPR that Google sought to join settled after Google filed its motion to join, but before the Board decided the motion, the Board found that "[g]iven that [the IPR] is no longer pending, it cannot serve as a proceeding to which another proceeding may be joined. As such, the termination of [the IPR] renders Google's Motion for Joinder moot.") (emphasis added).

(2) Allowing Toyota to join IPR2014-00647 would violate the estoppel provisions of 35 U.S.C. §315(e)(1). More than sixteen months ago, Toyota filed its own IPR petition on the same patent, which is the present IPR2013-00424. In IPR2013-00424, depositions were taken, all substantive papers have been filed, and an oral argument was held. All that remains is a Final Written Decision. That final decision will issue by January 14, 2015. Because a final decision will issue,

Toyota cannot “maintain a proceeding before the Office with respect to that claim or any ground that the petitioner raised or reasonably could have raised during that *inter partes* review.” 35 U.S.C. §315(e)(1) (emphasis added). Here, it is undisputed that each of the grounds that Toyota raises in its new petition were grounds that it reasonably could have raised in its earlier one. This statutory provision is intended to bar precisely what Toyota is trying to do by virtue of its motion for joinder—get a second bite at the apple where it fears that it will lose its first IPR. It would also circumvent the requirement of a “just, speedy, and inexpensive” resolution of Toyota’s first IPR.

(3) Toyota’s attempt to get a second bite at the apple would circumvent the statutory requirement for completing an IPR proceeding within one year of institution, as well as the statutory bar for filing an IPR petition within one year of service of a lawsuit. Toyota’s petition in IPR2013-00424 was filed on July 12, 2013 (within one year of the July 26, 2012 service date of a co-pending lawsuit between Toyota and AVS). Here, in view of the settlement between Mercedes and AVS, if Toyota is allowed to join IPR2014-00647, it would be the only petitioner, achieving the same result as if Toyota simply filed a new IPR more than sixteen months after the statutory bar date. Such a loop-hole would be plainly contrary to Congressional intent.

(4) Further and notwithstanding the foregoing, Toyota's request for joinder is something that falls squarely within the Board's discretion to deny to avoid gamesmanship and to prevent a party from improperly seeking a "do-over" of a failed IPR. Toyota should not be allowed to endlessly re-litigate the same patent, raising new arguments only after seeing its initial arguments fail. *See, e.g., Medtronic, Inc. et al v. EndoTach, LLC*, Case IPR2014-00695, Paper 18 (P.T.A.B. Sept. 25, 2014) ("We are not persuaded that Petitioner has shown that joinder is justified in this instance. . . . This case represents a 'second bite at the apple' for Petitioner, who has received the benefit of seeing our Decision to Institute in the prior case involving the same parties and patent claims.") Further, because Toyota seeks to use a different expert declarant, joining Toyota to the IPR originally filed by Mercedes would require still additional work even if Mercedes had not settled. *See Samsung Elec. Co., Ltd. v. Arendi S.A.R.L.*, Case IPR2014-01142, Paper 11 (P.T.A.B. Oct. 2, 2014) (denying request to join because Petitioner did not adequately show need for its own expert declarant).

For these reasons, which are discussed in more detail below, the Board should deny Toyota's motion for joinder. Toyota already had its chance to attack the '057 patent, and nothing in the statute or Rules allows endless "do-overs."

1. *The Termination of IPR2014-00647 Renders Toyota's Motion for Joinder Moot*

Toyota's motion to join should first of all be denied on its face for a simple reason—the parties to IPR2014-00647 have already settled and moved to terminate the proceeding, leaving nothing for Toyota to join. This is the exact scenario that was faced by the Board in *Google, Inc.*, Case IPR2014-00977. There, the Board denied Google's request to join in part because Google filed its motion to join late, but also because after Google moved to join, the parties to the IPR settled and moved to terminate. *See id.*

In fact, the parties in *Google, Inc.*, Case IPR2014-00977 settled several months after Google filed its motion to join, as opposed to here, where AVS and Mercedes were already in the process of negotiating a settlement before Toyota filed its joinder motion, and finalized the settlement mere days after Toyota's motion. The timing in *Google, Inc.*, Case IPR2014-00977 was as follows:

- 4/15/14 – Rackspace's IPR petition against PersonalWeb patent granted.
- 6/18/14 - Google filed its motion to Join (late).
- 10/16/14 - Rackspace and PersonalWeb settled and requested termination.
- 10/30/14 – the Board issued its decision denying the motion to join.

In denying Google's Motion for Joinder, the Board stated that “[g]iven that IPR2014-00059 is no longer pending, it cannot serve as a proceeding to which

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