

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NISSAN NORTH AMERICA, INC., TOYOTA MOTOR NORTH AMERICA, INC., SUBARU OF AMERICA, INC., AMERICAN HONDA MOTOR CO., INC., FORD MOTOR COMPANY, JAGUAR LAND ROVER NORTH AMERICA, LLC, and VOLVO CARS OF NORTH AMERICA, LLC,
Petitioner,

v.

CRUISE CONTROL TECHNOLOGIES LLC,
Patent Owner.

Case IPR2014-00289
Patent 6,324,463

Before JOSIAH C. COCKS, HYUN J. JUNG, and GEORGE R. HOSKINS,
Administrative Patent Judges.

HOSKINS, *Administrative Patent Judge.*

DECISION
Motion for Joinder
37 C.F.R. § 42.122

On April 10, 2014, following a conference call, we authorized Patent Owner to file a motion to join this proceeding with four other related *inter partes* review proceedings. *See* Paper 10. The five related proceedings are IPR2014-00279, IPR2014-00280, IPR2014-00281, IPR2014-00289, and IPR2014-00291 (“the five subject proceedings”). *See id.* Patent Owner accordingly filed a Motion for Joinder (Paper 11, “Motion” or “Mot.”) on April 24, 2014. Petitioner filed an Opposition to the Motion for Joinder (Paper 12, “Opposition” or “Opp.”) on May 8, 2014.

As an initial matter, we note that under our Rules, “[a] motion will not be entered without Board authorization.” 37 C.F.R. § 42.20(b) (2013). Our April 10, 2014 Order authorized Patent Owner only to file a motion to join the five subject proceedings. *See* Paper 8, 5. While the Motion accordingly requests such a joinder, it also requests “an order requiring Petitioner to identify a single lead counsel authorized to speak on its behalf and a backup counsel designated to speak for Petitioner and lead counsel.” Mot. 1. The Motion further requests, if joinder is opposed by Petitioner or if we deny the Motion, that we deny each Petition in the five subject proceedings for Petitioner’s alleged failure to comply with 37 C.F.R. § § 42.10(a) and alleged violation of what Patent Owner describes as a “one petitioner, one voice rule.” *Id.* We deny these requests pursuant to Rule 42.20(b) as an unauthorized motion, and turn to the authorized portion of the Motion request joinder of the five subject proceedings.

Board’s Authority to Join the Five Subject Proceedings

The parties dispute whether we have the authority to join the five subject proceedings into one proceeding *before* deciding whether to institute

a trial in any of the five subject proceedings. Patent Owner contends 37 C.F.R. § 42.122 (2013) gives us such authority. *See* Mot. 14. Petitioner contends 35 U.S.C. § 315(c) explicitly prohibits pre-institution joinder of *inter partes* review proceedings. *See* Opp. 14. We need not resolve this dispute because, even if we do have the authority to join multiple *inter partes* review proceedings prior to instituting any trials, we are not persuaded by the Motion to do so in this case.

Whether to Join the Five Subject Proceedings

As Patent Owner contends, the five subject proceedings have many similarities. They each concern the same patent, U.S. Patent No. 6,324,463 (“the ’463 patent”). *See* Mot. 2–3 (¶¶ 1–5). The Petitioner in each case is the same group of parties, as identified above in the caption of this decision. *See id.* Each subject proceeding was filed on either December 20, 2013 or December 23, 2013. *See id.* There is a significant amount of overlap among the ’463 patent claims being challenged in each of the five subject proceedings, and the five Petitions identify the same constructions for the same four claim terms. *See id.* at 2–3 (¶¶ 1–7). There is also some overlap in the prior art being cited in the five subject proceedings.¹ Substantially the same group of people is identified as lead and back-up counsel among the five subject proceedings, although a different person is identified as lead

¹ Specifically, alleged Admitted Prior Art is raised in two proceedings (*see* IPR2014-00281, Paper 1, 36–37; IPR2014-00289, Paper 3, 48–60), a Toyota Celsior Owner’s Manual is raised in two proceedings (*see* IPR2014-00280, Ex. 1010; IPR2014-00291, Ex. 1009), Nagashima is raised in two proceedings (*see* IPR2014-00281, Ex. 1009; IPR2014-00289, Ex. 1010), and Narita is raised in two proceedings (*see* IPR2014-00281, Ex. 1004; IPR2014-00291, Ex. 1006).

counsel for Petitioner in each proceeding. *See id.* at 3–5 (¶¶ 9–13). The Petitions in three of the five subject proceedings (IPR2014-00279, IPR2014-00289, and IPR2014-00291) include a Declaration executed by the same person, David A. McNamara, in support of the Petition. *See id.* at 3 (¶ 8).

The Motion asserts that having to defend against each of the five subject proceedings separately will prejudice Patent Owner, which allegedly would be alleviated by joinder. *See Mot.* 11–13. Patent Owner contends five separate proceedings “means five of everything at five times the cost — five separate filings, five separate expert declarations, five separate oral hearings . . . , [and] at least five depositions of Petitioner’s declarants” *Mot.* 12. Patent Owner also asserts that, with five separate proceedings, Patent Owner will have to coordinate with five separate counsel to schedule depositions. *See id.* (citing IPR2013-00250, Paper 25, p. 4 (Sept. 3, 2013) as “explaining that ‘joinder of the proceedings will allow for a single deposition, rather than multiple depositions, of the same witnesses’”). Petitioner by contrast contends that maintaining five separate proceedings would not unduly prejudice Patent Owner, because Patent Owner “placed the burden of defending the validity of its patent against multiple parties on itself” by filing separate lawsuits against each of the parties identified as a petitioner in the five subject proceedings. *Opp.* 9. Petitioner also contends that joinder is not appropriate because of many differences among the five subject proceedings, including different grounds of unpatentability, different prior art, and different declarants. *See Opp.* 3–6.

As the moving party, Patent Owner has the burden of proof to establish that it is entitled to joinder of the five subject proceedings. 37 C.F.R. § 42.20(c) (2013). We are not persuaded by the Motion that joining

the five subject proceedings would reduce, in any material manner, the burden(s) placed upon Patent Owner in defending the validity of the '463 patent before the Board. Regardless of whether the five subject proceedings are joined or not joined, Patent Owner will still have to defend against the same number of parties (regardless of whether they are identified as one Petitioner or multiple co-Petitioners), and prepare brief(s) addressing the same ground(s) upon which we institute review, if any. Patent Owner presents no credible evidence or argument in support of its statement that five separate proceedings “means five of everything at five times the cost” versus one joined proceeding which would involve the same substantive issues as the five separate proceedings. The alleged discovery burden(s) imposed by five separate proceedings can be alleviated substantially by entering the same schedule in each case, in conjunction with cooperation between the parties and motion practice in the event of disputes — which is no different than what would happen in one joined proceeding. Moreover, we agree with Petitioner that Patent Owner invited a multi-front battle concerning the validity of the '463 patent when it filed ten separate infringement lawsuits on December 21, 2012, with another five lawsuits following on January 15, 2013. *See* Opp. 8; Paper 1, 3–4; Paper 5, 2–4.

The Motion also contends joinder of the five subject proceedings before institution of any trial(s) in response to the Petitions would benefit the Board. *See* Mot. 13. Joinder is said to “put[] the Board in a better position to assess inter-petition redundancy of the more than 180 separate alleged grounds of unpatentability and address any inconsistent statements.” *Id.* Petitioner disagrees. *See* Opp. 12–14. We are not persuaded that joinder in the present case, whether before or after institution of trial(s), materially

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