

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Hyundai Motor Company
Petitioner

v.

American Vehicular Sciences LLC
Patent Owner

Patent No. 6,738,697
Filing Date: July 3, 2002
Issue Date: May 18, 2004
Title: TELEMATICS SYSTEM FOR VEHICLE DIAGNOSTICS

Inter Partes Review No. Unassigned

**MOTION FOR JOINDER
UNDER 35 U.S.C. §§ 42.22 AND 42.122(b)**

Hyundai Motor Company (“Hyundai”) submits at the same time as this motion a Petition for *Inter Partes* Review of claims 1, 2, 5, 6, 10, 17-22, 26, 27, 32, 40, and 61 of U.S. Patent No. 6,738,697 (“the ’697 patent”) (“Petition”).

Hyundai respectfully requests that its Petition be granted and that the proceedings be joined in accordance with 35 U.S.C. § 315(c), 37 C.F.R. § 42.22, and 37 C.F.R. § 42.122(b) with the pending *inter partes* review initiated by Honda Motor Co. (“Honda”) concerning the same patent: *American Honda Motor Co. Inc., v. American Vehicular Sciences, LLC*, Case No. IPR2014-00634 (the “Honda IPR”).

Joinder is appropriate because: (1) it will promote efficient resolution of the validity of the ’697 patent without prejudice to American Vehicular Sciences, LLC (“AVS”) or Honda; (2) Hyundai’s petition raises only the same grounds of unpatentability as those in Honda’s petition that were instituted for trial; (3) joinder would not affect the pending schedule in the Honda IPR nor increase the complexity of that proceeding, minimizing costs; and (4) Hyundai is willing to agree to consolidated filings with Honda to minimize burden and schedule impact. Absent joinder, Hyundai could be prejudiced if the Honda IPR is terminated before a final written decision is issued, as it would have to litigate the same positions at the District Court under a higher burden of proof. Accordingly, joinder should be granted.

I. BACKGROUND AND RELATED PROCEEDINGS

American Vehicular Sciences, LLC (“AVS”) is the owner of the ’697 patent. On October 15, 2012, AVS sued Hyundai Motor Company, Hyundai Motor America, and Hyundai Motor Manufacturing Alabama, LLC (collectively “Hyundai”) in the Eastern District of Texas for allegedly infringing the ’697 patent (the “Underlying Litigation”). On April 15, 2014, Honda filed a petition for *inter partes* review of the ’697 patent. The Board instituted trial in the Honda IPR on August 26, 2014 (Honda IPR, Paper No. 8, at 27-28) on claims 1, 2, 5, 6, 10, 17-22, 26, 27, 32, 40, and 61. The Board set October 27, 2014, as the date for AVS’s response to the petition (Honda IPR, Paper No. 9, at 6). Concurrently with this Motion, Hyundai is filing a Petition for *inter partes* review of the ’697 patent.

II. ARGUMENT

Hyundai’s Petition and this motion for joinder are timely under 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), as they are being submitted within one month of August 26, 2014, the date that the Honda IPR was instituted. A party may file a motion requesting joinder “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). The one-year time limitation prescribed by 35 U.S.C. § 315(b) does not apply when a party moves to join another IPR proceedings. *See* 35 U.S.C. § 315 (b) (“The time limitation set forth in the preceding sentence shall not apply to a request for joinder

under subsection (c).”); *see also Dell Inc. v. Network-1 Solutions, Inc.*, IPR2013-00385, Paper No. 17, at 5 (“The one-year bar, therefore, does not apply to Dell because it filed a motion for joinder with its Petition”).

A. Joinder will not impact the Board’s ability to complete the review in a timely manner

Joinder in this case will not impact the Board’s ability to complete its review in a timely manner. 35 U.S.C. § 316(a)(11) and associated rule 37 C.F.R. § 42.100(c) provide that *inter partes* review proceedings should be completed and the Board’s final decision issued within one year of institution of the review. The same provisions provide the Board with flexibility to extend the one-year period by up to six months for good cause, or in the case of joinder.

In this case, joinder should not affect the Board’s ability to issue its final determination within one year because Petitioner does not raise any issues that are not already before the Board. Hyundai’s Petition is based on the same grounds and same combinations of prior art as those on which a trial was instituted in the Honda IPR. Indeed, Hyundai has not raised one of the grounds on which a trial was instituted (anticipation of Claims 1, 6, and 19-21 under 35 U.S.C. § 102(a) by Fry discussed at pages 25-27 of Paper 8 in the Honda IPR), thereby further minimizing any impact of Hyundai’s joinder. Hyundai’s arguments regarding the asserted prior art references are also identical to those made by Honda. *Compare* Pet. 6-37, with IPR2013-00634, Paper 1 at 5-24, 38-48, 50-52. Further, Hyundai has retained

and submitted a declaration from the same declarant as Honda, Christopher Wilson, with the only difference being that Hyundai has removed testimony regarding prior art references on which a trial was not instituted in the Honda IPR and testimony relating to the Fry prior art reference. *Compare* Ex. 1008, with IPR2014-00634, Ex. 1010. Accordingly, AVS should not need any additional discovery of Mr. Wilson beyond that which it has already asked for in the Honda IPR.

In circumstances such as these, the Board has routinely granted joinder. *See, e.g., Dell Inc. v. Network-1 Solutions, Inc.*, Case No. IPR2013-00385, Paper No. 17, at 6-7 (Jul. 29, 2013) (finding that Dell's assertion of the same grounds of unpatentability as Avaya and Dell's submission of a declaration from the same declarant as Avaya weighed in favor of granting Dell's motion to join Avaya's IPR).

The first deadline in Honda's IPR is the due date for AVS's response to Honda's petition (37 C.F.R. § 42.120) and any motion to amend the patent (37 C.F.R. § 42.121), which is currently set for October 27, 2014, more than one month after the date of this motion. Because Hyundai's IPR petition does not raise any new issues, AVS's response would not require any analysis beyond what AVS is already required to undertake to respond to Honda's petition.

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