

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. 8,036,788

Filing Date: August 9, 2007

Issue Date: October 11, 2011

Title: VEHICLE DIAGNOSTIC OR PROGNOSTIC MESSAGE
TRANSMISSION SYSTEMS AND METHODS

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 1-7, 13, and 20 of U.S. Patent No. 8,036,788 (“the ‘788 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. IPR2014-00629 (the “Honda IPR”).

The Board recently granted a similar motion filed by Hyundai requesting joinder with another IPR initiated by Honda involving a related American Vehicular Sciences, LLC (“AVS”) patent. *Hyundai Motor Co. v. Am. Veh. Scis.*, Case No. IPR2014-01543, Paper No. 11 at 3-6 (Oct. 24, 2014). The present motion presents the same set of circumstances as Hyundai’s earlier motion that was granted by the Board, namely: (i) each ground proposed by Hyundai is identical to a ground that has been instituted for trial in the Honda IPR; (ii) Hyundai did not even propose all of the grounds that have been instituted for trial in the Honda IPR; (iii) Hyundai’s arguments are identical to those made by Honda in the Honda IPR; (iv) with respect to the grounds it has proposed, Hyundai relies on the same declaration testimony of Mr. Christopher Wilson, albeit submitted in a separate declaration, as was relied on by Honda for those same grounds; (v)

Hyundai agrees to have consolidated filings with Honda, and to be limited to separate filings, if any, of no more than seven pages directed only to points of disagreement with Honda with the understanding that it will not be permitted any separate arguments in furtherance of those advanced in Honda's consolidated filings; and (vi) because Hyundai does not expect that it will have any points of disagreement with Honda, it does not believe that it is likely to make any separate filings.

Given these circumstances, joinder is appropriate here for the same reasons found by the Board in its earlier decision in Case No. IPR2014-01543.

Specifically, the Board found that the impact of joinder on the Honda IPR would be minimal, joinder would enhance efficiency, avoid duplication of efforts, and reduce the potential of inconsistency among proceedings.

I. BACKGROUND AND RELATED PROCEEDINGS

AVS is the owner of the '788 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 '788 patent (the "Underlying Litigation"). On April 15, 2014, Honda filed a petition for *inter partes* review of the '788 patent. The Board instituted trial in the Honda IPR on September 29, 2014 (Honda IPR, Paper No. 8, at 21-22) on claims 1-7, 13, and 20. The Board set December 1, 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 '788 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 September 29, 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 trial has been instituted in the Honda IPR. Hyundai's arguments regarding the asserted prior art references are identical to those made by Honda in its petition (*Compare* Pet. 8-32, with IPR2013-00629, Paper 1 at 10-19, 29-36, 51-58). 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. *Compare* Ex. 1008, with IPR2014-00629, Ex. 1011. Accordingly, AVS should not need any additional discovery of Mr. Wilson beyond what it has already asked for in the Honda IPR. As noted above, the Board recently granted Hyundai's request to join an IPR initiated by Honda involving a different AVS patent under the same circumstances. *Hyundai Motor Co. v. Am. Veh. Scis.*, Case No. IPR2014-01543, Paper No. 11 at 3-6 (Oct. 24, 2014).

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

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