

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HYUNDAI MOTOR COMPANY
Petitioner

v.

AMERICAN VEHICULAR SCIENCES LLC
Patent Owner

Case IPR2015-00176
Patent 8,036,788

Before JAMESON LEE, BARBARA A. PARVIS, and
GREGG I. ANDERSON, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

DECISION ON
MOTION FOR JOINDER
37 C.F.R. § 42.122(b)

I. INTRODUCTION

On October 28, 2014, Hyundai Motor Company (“Hyundai”) filed a petition (“Pet.”) for *inter partes* review of U.S. Patent No. 8,036,788 B2 (Ex. 1001, “the ’788 patent”). Paper 1. Also on October 28, 2014, Hyundai filed a Motion for Joinder (“Mot”) to join this proceeding with *American Honda Motor Co., Inc. v. American Vehicular Sciences LLC*, Case IPR2014-00629 (“the Honda IPR”) in which the Board already instituted *inter partes* review of the ’788 patent. Paper 3. Hyundai indicates that Patent Owner (“AVS”) has asserted the ’697 patent against Hyundai in an action for patent infringement, in the U.S. District Court for the Eastern District of Texas. Mot. 2. Despite having been given authorization to do so, neither American Honda Motor Co., Inc. (“Honda”), the Petitioner in the Honda IPR, nor AVS filed an opposition to Hyundai’s Motion for Joinder. In a separate decision, entered concurrently herewith, we institute trial in this proceeding.

The Motion for Joinder is granted.

II. DISCUSSION

An *inter partes* review may be joined with another *inter partes* review. The statutory provision governing joinder of *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads as follows:

(c) JOINDER. -- If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join as a party to that *inter partes* review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

As the movant, Hyundai bears the burden to show that joinder is appropriate. 37 C.F.R. § 42.20(c). A motion for joinder should: (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See* Frequently Asked Question (“FAQ”) H5 on the Board’s website at <http://www.uspto.gov/ip/boards/bpai/prps.jsp>.

Hyundai represents that it does not raise any issues that are not already before the Board and 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. Mot. 4. Each ground proposed by Hyundai is “identical” to a ground that has been instituted for trial in the Honda IPR. *Id.* Hyundai also represents that its arguments are “identical” to those made by Honda in the Honda IPR. *Id.* Hyundai further indicates that with respect to the grounds it has proposed, it 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. *Id.*

Under these circumstances, Hyundai indicates that joinder would not affect the timing, i.e., the Scheduling Order, the Honda IPR, and would not impact the due date of the next Due Date, the Patent Owner’s response, due December 1, 2014. Mot. 7. Hyundai states that “AVS should not need any additional discovery of Mr. Wilson beyond that which it has already asked for in the Honda IPR,” and that “AVS’s response would not require any analysis beyond what AVS is already required to undertake to respond to Honda’s petition.” Mot. 4.

Hyundai further agrees to have consolidated filings with Honda, in case of joinder, to minimize burden and impact of joinder. Mot. 1.

Specifically, Hyundai states:

Hyundai is willing to adopt the same procedures ordered by the Board in IPR2014-01543 and IPR2014-00634, limiting Hyundai to separate filings, if any, of no more than seven pages directed only to points of disagreement with Honda, with the understanding that Hyundai will not be permitted any separate arguments in furtherance of those advance in Honda's consolidated filings. *Hyundai Motor Corp. v. Am. Veh. Scis.*, IPR2014-01543, Paper No. 11, at 4-6 (Oct. 24, 2014).

Mot. 5.¹ Hyundai further states: “Given that Hyundai and Honda will be addressing the same prior art and the same bases for rejection using the same expert, Hyundai does not envision any differences in position with Honda, and does not believe that it is likely to make any separate filings.” *Id.*

Despite having been authorized to file a stipulation to further limit Hyundai's participation (Order – Conduct of the Proceedings (Paper 5)), the parties have not filed such a stipulation.

Given the representations of Hyundai as noted above, we are persuaded that the impact of joinder on the Honda IPR will be minimal. Also, joinder will enhance efficiency, avoid duplication of efforts, and reduce the potential of inconsistency among proceedings.

¹ We understand Hyundai's representation to be that in case its Motion for Joinder is granted, Honda will be in control of the contents of the consolidated or joint filings of Honda and Hyundai as Petitioners, and that Hyundai, to the extent it has any disagreement with a position in a joint filing, will be limited to a separate filing of much limited page length.

III. ORDER

It is

ORDERED that IPR2015-00176 is joined with IPR2014-00629;

FURTHER ORDERED that, subsequent to joinder, the grounds for trial in the joined proceedings are the same as those for which trial was instituted in IPR2013-00629;

FURTHER ORDERED that the Scheduling Order in place for IPR2013-00629 is unchanged, and as modified by any authorized stipulation by the parties;

FURTHER ORDERED that, in the joined proceeding, Honda and Hyundai will file papers, except for motions which do not involve the other party, as consolidated filings; Honda will identify each such filing as a Consolidated Filing and will be responsible for completing all consolidated filings; Hyundai may file an additional paper, concurrent with each consolidated filing, not to exceed seven pages, which may address only points of disagreement with positions asserted in the consolidated filing; any such filing by Hyundai must specifically identify and explain each point of disagreement; Hyundai may not file separate arguments in support of points made in Honda's consolidated filing;

FURTHER ORDERED that, in addition to responding to any consolidated filing, AVS may respond separately, but concurrently, to any separate Hyundai filing; any such response by AVS to a Hyundai filing may not exceed seven pages in length and is limited to issues raised in the Hyundai filing;

FURTHER ORDERED that Honda and Hyundai will designate attorneys to conduct the cross-examination of any witnesses produced by

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