

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TOYOTA MOTOR CORPORATION,  
Petitioner,

v.

AMERICAN VEHICULAR SCIENCES LLC,  
Patent Owner.

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Case IPR2015-00261  
Patent 6,772,057 B2

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Before JAMESON LEE, TREVOR M. JEFFERSON, and  
LYNNE E. PETTIGREW, *Administrative Patent Judges*.

PETTIGREW, *Administrative Patent Judge*.

DECISION

Denying *Inter Partes* Review and Joinder  
37 C.F.R. §§ 42.108 and 42.122(b)

I. BACKGROUND

Toyota Motor Corporation (“Petitioner” or “Toyota”) filed a Petition for *inter partes* review of claims 1–4, 7–10, 31, 41, 56, 59–62, and 64 of U.S. Patent No. 6,772,057 B2 (Ex. 1101, “the ’057 patent”). Paper 1 (“Pet.”). Along with the Petition, Petitioner filed a Motion for Joinder,

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seeking to join with *Mercedes-Benz USA, LLC v. American Vehicular Sciences LLC*, IPR2014-00646. Paper 3 (“Mot.”). American Vehicular Sciences LLC (“Patent Owner” or “AVS”), filed a Preliminary Response and an Opposition to the Motion for Joinder. Paper 9 (“Prelim. Resp.”); Paper 7 (“Opp.”). Petitioner filed a Reply to Patent Owner’s Opposition to the Motion for Joinder. Paper 8. We have jurisdiction under 35 U.S.C. § 314.

For the reasons discussed below, we deny Petitioner’s Motion for Joinder and do not institute an *inter partes* review as to the challenged claims of the ’057 patent.

#### A. *Related Proceedings*

Petitioner states that the ’057 patent is the subject of the following district court proceeding: *American Vehicular Sciences LLC v. Toyota Motor Corp.*, No. 14-CV-13019 (E.D. Mich.). Pet. 2. Petitioner previously filed a petition for *inter partes* review of the ’057 patent in *Toyota Motor Corp. v. American Vehicular Sciences LLC*, IPR2013-00419. See Pet. 2. Also, the parties indicate that Petitioner filed a request for *ex parte* reexamination of the ’057 patent on November 13, 2014, which has been assigned Reexamination Control No. 90/020,077. Pet. 3; Paper 6, 2.

*B. Asserted Grounds of Unpatentability*

Petitioner contends that the challenged claims are unpatentable based on the following grounds (Pet. 8–27):

Reference(s)	Basis	Claims
Lemelson <sup>1</sup>	35 U.S.C. § 103(a)	1–4, 7–10, 41, 56, 59–61, and 64
Lemelson and Nishio <sup>2</sup>	35 U.S.C. § 103(a)	1–4, 7–10, 41, 56, 59–61, and 64
Lemelson and Borcherts <sup>3</sup>	35 U.S.C. § 103(a)	31 and 62

II. ANALYSIS

*A. Motion for Joinder*

We first address Petitioner’s Motion for Joinder under 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) seeking to join with *Mercedes-Benz USA, LLC v. American Vehicular Sciences LLC*, IPR2014-00646. Petitioner timely filed the Motion within one month after the institution of IPR2014-00646. *See* 37 C.F.R. § 42.122(b).

Joinder of parties is permitted in related review proceedings as set forth in 35 U.S.C. § 315(c), which provides:

(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

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<sup>1</sup> U.S. Patent No. 6,553,130, issued Apr. 22, 2003 (Ex. 1102).

<sup>2</sup> European Patent Application Publication No. 0582236A1, published Feb. 9, 1994 (Ex. 1104).

<sup>3</sup> U.S. Patent No. 5,245,422, issued Sept. 14, 1993 (Ex. 1105).

time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

Although 35 U.S.C. § 315(b) bars *inter partes* review when a petition is filed more than one year after the petitioner (or the petitioner's real party-in-interest or privy) is served with a complaint alleging infringement of the patent, *see* 37 C.F.R. § 42.101(b), the one-year time bar does not apply to a request for joinder. 35 U.S.C. § 315(b) (stating that "[t]he time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c)" of 35 U.S.C. § 315); 37 C.F.R. § 42.122(b).

In the present case, Petitioner was served with a complaint alleging infringement of the '057 patent more than one year prior to filing the Petition in this proceeding. *See* Pet. 2. Thus, absent joinder of this proceeding with IPR2014-00646, institution of *inter partes* review is barred.

As a moving party, Petitioner has the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b). A motion for joinder should: (1) set forth the reasons why 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) specifically address how briefing and discovery may be simplified. *See, e.g., Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15); FAQ H5 on the Board's website at <http://www.uspto.gov/ip/boards/bpai/prps.jsp> (last visited Jan. 23, 2015).

Petitioner seeks joinder with *Mercedes-Benz USA, LLC v. American Vehicular Sciences LLC*, IPR2014-00646. In that proceeding, we authorized an *inter partes* review to be instituted as to claims 1, 2, 4, 7, 16, 30, 31, 40,

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41, 43, 46, 56, 59–62, 77, 78, and 81–83 of the '057 patent. *Mercedes-Benz USA, LLC v. American Vehicular Sciences LLC*, Case IPR2014-00646 (Paper 13). Thereafter, Mercedes-Benz USA, LLC and AVS filed a joint motion to terminate IPR2014-00646, along with a true copy of the written settlement agreement between the parties, in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). *Mercedes-Benz USA, LLC v. American Vehicular Sciences LLC*, Case IPR2014-00646 (Paper 18; Ex. 2001). Upon consideration of the motion, we entered judgment terminating IPR2014-00646. *Mercedes-Benz USA, LLC v. American Vehicular Sciences LLC*, Case IPR2014-00646 (Paper 25). Because IPR2014-00646 is no longer pending, it cannot serve as a proceeding to which another proceeding may be joined. We, therefore, must deny Petitioner's Motion for Joinder.

Even if IPR2014-00646 had not been terminated, other considerations weigh in favor of denying Petitioner's Motion for Joinder. In its Motion, Petitioner asserts that the issues raised in its Petition are “substantively identical” to the issues in IPR2014-00646. Mot. 11. Petitioner acknowledges, however, that there are some differences between its Petition and the petition in IPR2014-00646. *Id.* One significant difference is that the arguments in the Petition rely on the declaration of Dr. Nikolaos Papanikolopoulos (Ex. 1106), who did not offer testimony in IPR2014-00646. *See id.* at 12; Pet. 6, 9–15, 24–27. Petitioner provides no justification for why another declarant would be necessary in a joined proceeding. Although Petitioner asserts that its declarant “arrives at the same conclusions for the same reasons as Mercedes'[s] expert,” Mot. 12, the declaration of Dr. Papanikolopoulos nonetheless constitutes new evidence

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