

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORPORATION

Petitioner

Patent No. 6,772,057

Issue Date: Aug. 3, 2004

Title: VEHICULAR MONITORING SYSTEMS USING IMAGE PROCESSING

**MOTION FOR JOINDER
PURSUANT TO 35 U.S.C. § 315(C) AND
37 C.F.R. §§ 42.22 AND 42.122(B)**

Case No. IPR2015-00261

Contemporaneously with this motion, Toyota Motor Corporation (“Toyota” or “Petitioner”) has filed a Petition for *Inter Partes* Review (“IPR”) of claims 1-4, 7-10, 31, 41, 56, 59-62, and 64 of U.S. Patent No. 6,772,057 (“the ’057 patent”). Toyota 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 an already instituted IPR filed by Mercedes-Benz USA LLC (“Mercedes”) that also relates to the ’057 patent: *Mercedes-Benz USA, LLC, v. American Vehicular Sciences, LLC*, Case No. IPR2014-00646 (the “Mercedes IPR,” or “Mercedes’ IPR”).

Toyota’s petition challenges a subset of the independent claims (and mostly the same dependent claims) on grounds that are the same as those that are now part of the Mercedes IPR. In its decision instituting the Mercedes IPR, the Board concluded that claims 1, 31, 41, and 56 (and certain claims depending therefrom) of the ’057 patent are likely to be found unpatentable as obvious in view of U.S. 6,553,130 to Lemelson (“Lemelson”). Even though the Board found that Lemelson does not expressly disclose the claim limitation requiring that the trained pattern recognition means (or algorithm) be “generated from data of possible exterior objects and patterns of received waves from possible exterior objects...,” the Board noted that this limitation would be obvious from Lemelson in view of the knowledge of a person skilled in the art and/or other prior art. (IPR2014-00646, Paper 13, at 15-16, 18-19, 21-22.)

In an earlier filed and presently pending IPR, (IPR2013-00419), Toyota contends that the same independent claims 1 and 56 of the '057 patent at issue in the Mercedes IPR (and certain claims depending therefrom), and dependent claims 31 and 41 (depending from claims 30 and 40), are anticipated by Lemelson. The patent owner, American Vehicular Sciences, LLC (“AVS”), has responded that these claims are not anticipated because Lemelson fails to disclose the “generated from” limitation discussed above. In reply, however, Toyota was not allowed during discovery to interrogate AVS’s expert about whether this limitation would be obvious, or indeed, whether the AVS expert was effectively admitting this limitation would be obvious, because Toyota had not anticipated AVS’s response based on the “generated from” limitation and, therefore, had not included an argument that this limitation was obvious in the original petition. Now that Mercedes, with prior knowledge of the proceedings in Toyota’s earlier IPR, has squarely placed the obviousness of the “generated from” limitation in issue, and now that the Board has found that claims 1, 31, 41 and 56 (and certain dependent claims) of the '057 patent are likely to be found unpatentable for that reason, this critically important obviousness issue should be finally resolved on the merits. These are the only grounds for unpatentability raised by Toyota’s current petition: the obviousness of the '057 patent’s claims over Lemelson itself, or Lemelson combined with other prior art.

The Board should exercise its discretion and authorize joinder in this case.

Joinder is appropriate and will ensure the just, speedy, and inexpensive resolution of

both the Mercedes IPR and Toyota's petition. Most importantly, joinder will avoid the possibly conflicting results, inequity, and undue prejudice. For instance, AVS has dropped its infringement claims against Mercedes making it likely that the Mercedes IPR will terminate prior to the issuance of a final written decision. (*See* IPR2014-00646, Paper 16, at 2.) This will force Toyota to litigate obviousness issues raised by the Mercedes IPR (which the Board has already determined are likely to render the '057 patent unpatentable, and which Toyota was unable to raise in the instituted - 00419 proceeding) in district court. Joinder will avoid this by allowing Toyota to continue pursuing obviousness grounds raised by the Mercedes IPR even if Mercedes itself withdraws. Joinder would also be highly efficient and appropriate for other reasons. For instance, the Lemelson-based obviousness issues raised by Toyota's petition are virtually identical to those in the Mercedes IPR. While Toyota's petition does include a few additional dependent claims asserted against Toyota but not Mercedes, it is based on the very same prior art, analyses, and grounds for unpatentability as the Mercedes IPR. Thus, joinder will avoid unnecessary duplication. Indeed, while Toyota reserves its rights to participate to the extent it deems necessary, to the extent Mercedes continues to press forward with its IPR, Toyota does not anticipate it will need to participate actively, take separate discovery beyond the defense of its expert, or add duplicative filings to the proceedings.

Joinder should also not significantly affect the schedule in the Mercedes IPR, or increase the complexity of that proceeding in any significant or meaningful way.

And, joinder will allow for a substantially reduced volume of filings and discovery.

Last, neither patent owner American Vehicular Sciences, LLC (“AVS”) nor Mercedes will be unduly prejudiced by joinder.

Finally, if the Board issues its final written decision in connection with Toyota’s first IPR (IPR2013-00419) and finds some of the claims at issue to be not unpatentable on the grounds instituted, it is possible that AVS may argue that in view of that decision, 35 U.S.C. § 315(e)(1) would somehow require that Toyota be estopped from maintaining its second IPR or joining the Mercedes IPR . This is not the case. Estoppel extends only to “any ground that the petitioner raised or reasonably could have raised during” the earlier IPR that reached final written decision. Here, Toyota was prevented from addressing the obviousness of the “generated from” limitation during its first IPR. Toyota also did not anticipate AVS’s argument regarding the “generated from” language at least in part because it believed that, if real data, simulated data and partial data were equally possible ways to train a pattern recognition system, as AVS has argued, then Toyota believed that the “generated from” language would become a non-limiting process limitation in an apparatus claim that merely specifies the process by which the apparatus’s algorithm is generated without affecting the ultimate structure of the algorithm. Accordingly, the obviousness of the “generated from” limitation is not an issue or grounds that Toyota “raised or reasonably could have raised” during the earlier IPR, and estoppel does not apply.

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