

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NISSAN NORTH AMERICA, INC.,
Petitioner,

v.

SIGNAL IP, INC.,
Patent Owner.

Case IPR2016-00113
Patent 6,012,007

Before MEREDITH C. PETRAVICK, JEREMY M. PLENZLER, and
JAMES A. TARTAL, *Administrative Patent Judges*.

PLENZLER, *Administrative Patent Judge*.

DECISION
Instituting *Inter Partes* Review
37 C.F.R. § 42.108
Granting Motion for Joinder
37 C.F.R. § 42.122(b)

I. INTRODUCTION

A. Background

Nissan North America, Inc. (“Nissan” or “Petitioner”) filed a Petition to institute an *inter partes* review of claims 1–3, 5, 9, and 17–21 (“the challenged claims”) of U.S. Patent No. 6,012,007 (Ex. 1001, “the ’007 patent”). Paper 2 (“Pet.”). Concurrently, Petitioner filed a Motion for Joinder. Paper 1 (“Mot.”). The Motion seeks to join this proceeding with *American Honda Motor Co., Inc. v. Signal IP, Inc.*, Case IPR2015-01004 (“the ’1004 IPR”), which concerns the ’007 patent at issue here.¹ Mot. 2.

Signal IP, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 9, “Prelim. Resp.”), as well as an Opposition to Joinder (Paper 6, “Opp.”). Petitioner filed a Reply to Patent Owner’s Opposition (Paper 8, “Reply”).

For the reasons described below, we institute an *inter partes* review of claims 1–3, 5, 9, and 17–21 and grant Petitioner’s Motion for Joinder.²

II. INSTITUTION OF INTER PARTES REVIEW

A. Asserted Grounds of Unpatentability and Evidence of Record

Petitioner asserts the same grounds in this proceeding as those instituted in the ’1004 IPR. Pet. 1, 5–6, 9–40.

References	Basis	Claims Challenged
Schousek ³	§ 102	1–3, 5, 9, 17, 20, and 21

¹ This decision references the petitioner in the ’1004 IPR as “Honda.”

² Concurrent with this decision, we enter our decision in IPR2016-00115, which additionally joins Kia Motors America, Inc. (“Kia”) as a petitioner in the ’1004 IPR.

³ U.S. Pat. No. 5,474,327, iss. Dec. 12, 1995 (Ex. 1004, “Schousek”).

References	Basis	Claims Challenged
Schousek and Blackburn ⁴	§ 103	18 and 19

Petitioner relies on a declaration from Kirsten Carr, Ph.D. Ex. 1003 (“the Carr Declaration”).

B. Decision

We have reviewed the Petition, the Preliminary Response, and the evidence cited therein. Petitioner states, and Patent Owner does not dispute, that the grounds asserted in this Petition are substantively identical to the grounds of unpatentability instituted in the ’1004 IPR, and that the Carr Declaration is substantively identical to the declaration submitted by Honda in the ’1004 IPR. Mot. 6–9.

We have considered the arguments raised by Patent Owner, including any differences between the arguments presented in the Preliminary Response and those presented in the preliminary response filed in the ’1004 IPR, and determine on the present record that Petitioner has shown a reasonable likelihood of prevailing. For example, in the Preliminary Response, Patent Owner contends that Schousek does not allow airbag deployment when the relative weight parameter is above the first threshold, as required by claim 17, but acknowledges that in Schousek “if the seat sensors determine that the total weight of the seat occupant is greater than the minimum weight of an occupied infant seat” and “the center of weight distribution is determined to be not forward of a reference line—a condition indicative of a forward-facing infant seat—[] air bag deployment [is] permitted.” Prelim. Resp. 12. Patent Owner’s additional argument that the

⁴ U.S. Pat. No. 5,232,243, iss. Aug. 3, 1993 (Ex. 1005, “Blackburn”).

maximum weight value of an occupied infant seat in Schousek is not equivalent to the “first threshold” (*id.* at 14–17) does not appear to address Petitioner’s contentions, which rely on Schousek’s *minimum* weight value to meet the claimed “first threshold” (*see* Pet. 17–18). The “lock flag” limitation was addressed in detail in the ’1004 Institution Decision, and we are apprised of no error in that analysis based on the arguments presented in the Preliminary Response. *See* Prelim. Resp. 17–21.

Accordingly, in view of the identity of the challenges to the ’007 patent in this Petition and in the petition in the ’1004 IPR, we institute an *inter partes* review in this proceeding on the same grounds as those on which we instituted *inter partes* review in the ’1004 IPR.

III. MOTION FOR JOINDER

The controlling statute regarding joinder for *inter partes* reviews 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 moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). To be considered timely, a motion for joinder must be filed no later than one month after the institution date of the *inter partes* review for which joinder is requested. 37 C.F.R. § 42.122(b). The Petition in this proceeding has been accorded a filing date of October 30, 2015. Paper 4, 1. This date is within one month after the

IPR2016-00113
Patent 6,012,007

date of institution in the '1004 IPR, which was instituted on October 1, 2015. The Petition, therefore, is timely.

A motion for joinder should: (1) set forth the reasons joinder is appropriate; (2) identify any new ground(s) of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *See Kyocera Corporation v. Softview LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

Petitioner contends that joinder will not require any modification to the trial schedule for the '1004 IPR. Mot. 8–9. Petitioner further contends that the grounds asserted in this Petition are substantively identical to the grounds of unpatentability instituted in the '1004 IPR, and that the Carr Declaration is substantively identical to the declaration submitted by Honda in the '1004 IPR. *Id.* at 6–9. Petitioner proposes no separate filings or depositions of any witnesses, and will accept an “understudy” role. *Id.* at 10–11. Petitioner acknowledges that it will assume a leading role only if Honda ceases to participate in the '1004 IPR. *Id.* at 11. Petitioner represents that Honda has no objection to Petitioner joining that proceeding in an “understudy” role. *Id.*

Patent Owner opposes joinder, contending that “joinder at this late stage would require delaying the schedule in '1004 IPR proceeding if trial were instituted on the present petition.” Opp. 3. Patent Owner also contends that “joinder would introduce complications that would interfere with the just, speedy, and inexpensive resolution of the '1004 proceeding” because if Honda and Patent Owner were to reach a settlement, “termination would not be possible . . . if the present petitioner were joined to the '1004 proceeding because at least one petitioner would remain.” *Id.* at 3.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.