

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NISSAN NORTH AMERICA, INC.,

Petitioner,

v.

SIGNAL IP, INC.,

Patent Owner.

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Case IPR2016-00113

Patent 6,012,007

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PATENT OWNER'S OPPOSITION  
TO MOTION FOR JOINDER

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Patent Owner SIGNAL IP, INC. submits the following opposition to Petitioners' motion for joinder.

## **BACKGROUND**

Petitioner seeks joinder with IPR2015-01004. Mot. at 2. Trial in that case was instituted Oct. 1, 2015, and Patent Owner's response is due Jan. 4, 2016. *American Honda Motor Co., Inc. v. Signal IP, Inc.*, IPR2015-01004, Scheduling Order, Paper 12, slip op. at 6 (PTAB Oct. 1 2015). Cross-examination of the '1004 IPR Petitioner's expert is set for Dec. 1, 2015. IPR2015-01004, Notice of Deposition of Dr. Carr, Paper 13, at 2. Yet, Petitioner waited until the last possible moment on Oct. 30, 2015, to file its petition and motion for joinder. Mot. at 2, 12. As a result, Patent Owner's preliminary response in this proceeding is not due until Feb. 5, 2016. Notice of Filing Date, Paper 4, slip op. at 1 (setting a three-month period for patent owner to file its preliminary response from Nov. 5, 2015).

## **ARGUMENT**

The Board, acting on behalf of the Director, has the discretion to join one *inter partes* review with another *inter partes* review. 35 U.S.C. § 315. Section 315(c) provides:

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.

Thus, joinder may be authorized when warranted, but the decision to grant joinder is discretionary. See 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. The Board determines whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations. See 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl). In exercising its discretion in such matters, the Board has remained mindful that the regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. See 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b).

In this case, joinder is inappropriate and should be denied. The ‘1004 IPR proceeding to which Petitioner proposes to join the instant petition is already in the period for Patent Owner’s response. Discovery in the ‘1004 IPR proceeding will be concluded and Patent Owner’s response filed fully

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