

Filed on behalf of Petitioners
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HYUNDAI MOTOR AMERICA, INC., HYUNDAI MOTOR COMPANY,
KIA MOTORS CORPORATION & KIA MOTORS AMERICA, INC.
Petitioners

v.

PAICE LLC &
ABELL FOUNDATION, INC.
Patent Owners

Case: To Be Assigned
U.S. Patent No. 8,214,097

**MOTION FOR JOINDER UNDER
35 U.S.C. 315(c) AND 37 C.F.R. §§ 42.22 AND 42.122(b)
TO *INTER PARTES* REVIEW OF IPR2015-00792**

TABLE OF CONTENTS

- I. STATEMENT OF PRECISE RELIEF REQUESTED 1
- II. STATEMENT OF MATERIAL FACTS 2
- III. STATEMENT OF REASONS FOR RELIEF REQUESTED 3
 - A. Legal Standard 3
 - B. Petitioners’ Motion for Joinder is Timely 4
 - C. Each Factor Weighs in Favor of Joinder 4
 - 1. Joinder is Appropriate and Petitioners Present No New Grounds 5
 - 2. Joinder Will Not Negatively Impact the Ford IPR Trial Schedule 6
 - 3. Procedures to Simplify Briefing and Discovery 7
 - D. Joinder Will Not Prejudice the Parties to the Ford IPR 8
- IV. CONCLUSION 9

I. STATEMENT OF PRECISE RELIEF REQUESTED

Hyundai Motor America, Inc., Hyundai Motor Company, Kia Motors Corporation and Kia Motors America, Inc. (“Petitioners”) respectfully submit this Motion for Joinder, together with a petition (the “Hyundai-Kia Petition”) for *Inter Partes* Review of U.S. Patent No. 8,214,097 (the “’097 patent”) filed contemporaneously herewith. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioners request institution of an *inter partes* review and joinder with *inter partes* review in *Ford Motor Co. v. Paice LLC, et al.*, IPR2015-00792 (the “Ford IPR”), which was instituted on October 26, 2015 and concerns the same ‘097 patent. Petitioners timely filed the Hyundai-Kia Petition and this motion within one month of the institution of the Ford IPR. 37 C.F.R. § 42.122(b).

Joinder will efficiently resolve the challenges to the ‘097 patent in the Ford IPR, and will neither impact the substantive issues or schedule in that proceeding, nor prejudice the parties. Intentionally, the Hyundai-Kia Petition is narrowly tailored to the same grounds of unpatentability on which the Ford IPR was instituted, and relies on the same claims, prior art, arguments and evidence presented in Ford’s petition. Indeed, in an effort to avoid multiplication of issues before the Board, the Petition is nearly word-for-word identical to the challenges that are presented on the instituted grounds in the Ford IPR and it relies on the same supporting expert declaration. In addition, Petitioners explicitly agree to consolidated dis-

covery and briefing as described below, and are willing to accept a limited role allowing Ford's counsel to act as the lead counsel as long as Ford remains in the proceeding. Accordingly, Petitioners submit that joinder is appropriate because it will not prejudice the parties or impact the substantive issues and schedule in the Ford IPR, while efficiently resolving in a single proceeding the question of the '097 patent's validity based on the instituted grounds of the Ford IPR.

II. STATEMENT OF MATERIAL FACTS

1. The '097 patent is entitled "Hybrid Vehicles" and lists Alex J. Severinsky and Theodore Louckes as inventors. The '097 patent issued on July 3, 2012. Paice LLC and The Abell Foundation, Inc. (the "Patent Owners") are believed to be co-owners to all right, title, and interest in '097 patent.

2. On February 16, 2012, Patent Owners filed a civil action asserting certain patents against Hyundai Motor America, Inc., Hyundai Motor Company, Kia Motors Corporation and Kia Motors America, Inc. in Civil Action No. 1-12-cv-00499. The '097 patent was asserted against these parties in a second amended complaint dated December 17, 2013 in this action. A jury trial was completed on October 1, 2015 in this action, and the parties are currently engaged in post-trial briefing.

3. On February 19, 2014, Patent Owners filed a civil action asserting the '097 patent, along with other patents, against Ford Motor Company ("Ford") in

Civil Action No. 1-14-cv-00492.

4. On February 22, 2015, Ford filed a petition for *inter partes* review requesting cancellation of claims 1, 3, 4, 7, 9, 11, 13, 14, 17, 19, 21, 23, 24, 27, 28, 30, 32, 33, 37, and 38 of the '097 patent (the "Ford Petition"), which was subsequently assigned Case No. IPR2015-00792.

5. On October 26, 2015, the Board instituted *inter partes* review in Case No. IPR2015-00792, finding that a reasonable likelihood existed that the Ford Petition would prevail in showing the unpatentability of all challenged claims of the '097 patent.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Board has the authority under 35 U.S.C. § 315(c) to join a properly filed *inter partes* review petition to an instituted *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). Any request for joinder must be filed no later than one month after the institution date of any *inter partes* review for which joinder is requested. *See* 37 C.F.R. § 42.122(b). In deciding whether to exercise its discretion, the Board considers factors including: (1) the reasons why joinder is appropriate; (2) whether the new petition presents any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See Macronix Int'l Co. v. Span-*

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