

UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE PATENT TRIAL AND APPEAL BOARD

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American Honda Motor Co., Inc.,  
Petitioner

v.

Blitzsafe Texas, LLC,  
Patent Owner  
U.S. Patent Number 8,155,342

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**PATENT OWNER'S OPPOSITION TO MOTION FOR JOINDER**

## **I. Introduction.**

Blitzsafe Texas LLC (“Patent Owner”) opposes American Honda Motor Co., Inc.’s (“Petitioner”) motion to join *inter partes* review (“IPR”) number IPR2016-01533 (“Honda IPR”) to an earlier IPR filed by Toyota Motor Corporation (“Toyota”) IPR2016-00418 (“Toyota IPR”). Joinder should be denied for the following reasons.

## **II. Joinder would violate statutory estoppel provisions under 35 U.S.C. §§ 315(b), 316(a)(11) and the Board should use its discretion to deny the motion for joinder**

As the movant, Honda bears the burden to show that joinder is appropriate. 37 C.F.R. § 42.20(c). In order to find joinder, the rules state that the Board is to consider the impact of both substantive issues and procedural matters on the proceedings and other discretionary considerations. Joinder should be denied here for both substantive and procedural reasons.

Honda filed its joinder Petition more than one year after it had been served with a complaint alleging infringement of U.S. Patent No. 8,155,342 (“the ’342 Patent”) and both the Petition and joinder should be denied. Statutory estoppel provisions seek to “protect patent owners from harassment via successive petitions by the same or related parties, to prevent parties from having a ‘second bite at the apple’ and to protect the integrity of both the USPTO and Federal Courts by assuring that all issues are promptly raised and vetted.” 77 FR 48759. Section

315(b) bars institution “if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” This Petition was filed outside of the one year bar window and accordingly, only discretion of the Board can save the Petition.

Honda already petitioned the Board on the same patent in IPR2016-01473 (The -01473 Petition”). The -01473 Petition was filed on July 21, 2016 and Honda alleges that it was served with a complaint as early as July 22, 2015. Despite its explicit acknowledgement of its one year bar date, Honda waited until August 05, 2016 to file the instant Petition—several weeks after its bar date had passed. Honda is a large company with extensive resources. There is no reason to employ discretion to save Honda from negligently failing to abide by the rules and Honda’s reckless disregard of the one year window could serve no purpose other than to delay and otherwise mire the proceedings.

Moreover, by allowing joinder, Honda will effectively be afforded the opportunity to simultaneously argue two different positions. Honda’s earlier filed -01473 Petition includes some of the same prior art at issue in the Toyota IPR. By joining this proceeding, Honda will be allowed to argue its case relying on different positions related to some of the same prior art references and to potentially benefit from contradictory positions.

Accordingly, the Petition should be denied institution based on the statutory bar and the motion for joinder should not allow Petitioner to circumvent the rules put in place to prevent conflicting findings and waste of judicial resources.

### **III. Conclusion**

For the reasons stated above, the motion for joinder should be denied.

Respectfully submitted,

Dated September 7, 2016

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**CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6(e)(4) & 42.105(b)**

A copy of PATENT OWNER'S OPPOSITION TO MOTION FOR  
JOINDER has been served on Petitioner at the correspondence of the Petitioner as  
follows:

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