

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

American Honda Motor Co., Inc.

v.

Blitzsafe Texas, LLC,
Patent Owner

U.S. Patent No. 8,155,342
Filing Date: June 27, 2006
Issue Date: April 10, 2012
Title: Multimedia Device Integration System

Inter Partes Review No.: IPR2016-01533

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

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I. INTRODUCTION

Petitioner has moved for joinder of this *inter partes* review (Case No. IPR2016-01533, “Honda IPR”) to an earlier *inter partes* review filed by Toyota Motor Corporation (“Toyota”) (Case No. IPR2016-0418, “Toyota IPR”). The Honda IPR is intentionally identical to the Toyota IPR in all substantive aspects. Ignoring the clear statutory language and the rules of the Board, Blitzsafe Texas LLC (“Patent Owner”) opposed Petitioner’s motion alleging the petition and the request for joinder were untimely.¹ Patent Owner’s arguments are misplaced. Under 37 C.F.R. § 42.122(b) and 35 U.S.C. § 315(b)-(c), the Honda IPR was timely filed and Petitioner respectfully requests that the Board join the Toyota IPR and Honda IPR.

II. JOINDER IS PROPER UNDER 37 C.F.R. § 42.122(b) & 35 U.S.C. § 315(b)

Both the relevant statute and the rules of this Board are unambiguously clear: a petition accompanied by a request for joinder to an earlier instituted proceeding is timely when filed within one month after the institution date of the earlier proceeding. 37 C.F.R. § 42.122(b) permits joinder to be requested, without

¹ At the time Honda filed its request for joinder, Toyota had not made a decision of whether or not to oppose Honda’s request. However, Toyota did not file an opposition to Honda’s motion for joinder.

prior authorization, up to one month after the institution date of the proceeding to which joinder is requested. 37 C.F.R. § 42.122(b) (addressing timing to request joinder); *Taiwan Semiconductor Mfg. Co., Ltd. v. Zond LLC*, IPR2014-00781 and IPR2014-782, Paper 5 at 3 (May 29, 2014) (prior authorization not required before one month deadline). In the event joinder is so requested, § 42.122(b) states “The time period set forth in § 42.101(b) shall not apply”² The Board’s rules implement the clear statutory scheme set forth by Congress that excepts requests for joinder from the prohibition on filing an IPR petition more than one (1) year after a complaint asserting the patent against the petitioner was served. 35 U.S.C. § 315(b)-(c). Indeed, 35 U.S.C. § 315(b) provides:

An inter partes review may not be instituted 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. ***The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).***

35 U.S.C. § 315(b) (emphasis added).

² 37 CFR §42.101(b) – “A person who is not the owner of a patent may file with the Office a petition to institute an *inter partes* review of the patent unless . . . [t]he petition requesting the proceeding is filed more than one year after the date on which the petitioner, the petitioner's real party-in-interest, or a privy of the petitioner is served with a complaint alleging infringement of the patent.”

The joinder rules facilitate resolution of issues in a single proceeding which reduces costs on the parties (including the patent owner) and the burden on the Board. Indeed, the rules “shall be construed so as to ensure the just, speedy, and inexpensive resolution of every proceeding” and joinder may serve the “statutory objective of decreasing litigation costs and conserving judicial resources.” *Target Corp. v. Destination Maternity Corp.*, Case IPR2014–00508, Paper 28 at 12-13 (Feb. 12, 2015). Further, “[d]uring the Senate’s March 2011 debates on the AIA, Senator Kyl explained that the USPTO expected to allow liberal joinder of reviews.” *Id.* at 10.

Here, Honda is seeking joinder pursuant to § 42.122(b) to the Toyota IPR that was instituted on July 8, 2016. Paper 13. As the Honda IPR and accompanying motion for joinder were filed on August 5, 2016, less than one month after the institution date of the Toyota IPR, the request is timely and falls squarely within the exceptions set forth in § 42.122(b) and 35 U.S.C. 315(b). Accordingly, the Patent Owner’s opposition, which relies solely upon a misreading of the relevant rules and statute, fails to identify any supportable reason why Honda’s request for joinder should not be granted.

III. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests institution of *Inter Partes* Review of claims 49-57, 62-64, 66, 68, 70, 71, 73-80, 94, 95, 97, 99-103,

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