

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NIDEC CORPORATION and AMERICAN HONDA MOTOR CO., INC.,

Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

Case IPR2018-00598
Patent 7,067,952 B2

Before KRISTEN L. DROESCH, JOHN A. HUDALLA, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and
Grant of Motion for Joinder
37 C.F.R. §§ 42.108, 42.122(b)

I. INTRODUCTION

Nidec Corporation and American Honda Motor Co. Inc. (“Nidec and Honda,” collectively, “Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–6 and 8–14 (“the challenged claims”) of U.S. Patent No. 7,067,952 B2 (Ex. 1001, “the ’952 Patent”). Paper 1 (“Pet”). Petitioner also filed a Motion for Joinder, seeking joinder as petitioner with Denso Corporation (“Denso”) and Toyota Motor Corp. (“Toyota”) in *Denso Int’l Amer. Inc. v. Intellectual Ventures II LLC*, Case No. IPR2017-01631 (“1631 IPR”). Paper 4 (“Mot.” or “Motion for Joinder”). Intellectual Ventures II LLC (“Patent Owner” or “IV”) filed a Preliminary Response and Statement of Consent to Joinder with IPR2017-01631. Paper 8 (“Prelim. Resp. & Consent”).

We have authority under 35 U.S.C. § 314 and 37 C.F.R. § 42.4. An *inter partes* review may not be instituted unless it is determined that “the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

After considering the Petition, Motion for Joinder, and Preliminary Response & Consent, we institute *inter partes* review of claims 1–6 and 8–14 and grant Petitioner’s Motion for Joinder for the reasons provided below.

II. INSTITUTION OF *INTER PARTES* REVIEW

We instituted an *inter partes* review in the '1631 IPR of the following claims of the '952 Patent on the following grounds and prior art ('1631 IPR, slip op. at 39 (PTAB Jan. 17, 2018) (Paper 11)):

| Claims | Statutory Basis | Reference(s) |
|------------------------------|-----------------|--|
| 10 and 14 | § 102 | Calsonic ¹ |
| 11 | § 103 | Calsonic and Dunfield ² |
| 10, 12, and 14 | § 103 | DENSO ³ and Calsonic |
| 1, 2, 4, 6, 8, 9, 12, and 13 | § 103 | Calsonic and Matsushita ⁴ |
| 3 and 5 | § 103 | Calsonic, Matsushita, and knowledge of a person of ordinary skill in the art |

The Petition in this proceeding asserts the same grounds as those instituted in the '1631 IPR. *Compare* Pet. 74, with '1631 IPR, slip op. at 39 (PTAB Jan. 17, 2018) (Paper 11). Petitioner also relies on a Declaration of Dr. Thomas R. Brinner (Ex. 1013), which Petitioner asserts is substantively identical to Dr. Brinner's Declaration filed in the '1631 IPR. *See* Mot. 4. Patent Owner consents to institution of *inter partes* review and joinder of Nidec and Honda as petitioner to the '1631 IPR. *See* Prelim. Resp. & Consent 2. In view of the fact that the issues in the instant Petition and in the '1631 IPR are identical, and that we have already considered Patent Owner's arguments in the '1631 IPR, pursuant to § 314, we institute *inter partes* review as to claims 1–6 and 8–14 in this proceeding on the grounds presented in the Petition for the same reasons stated in our Decision on

¹ Ex. 1003, JP 2000-184635 A, published June 30, 2000 (“Calsonic”).

² Ex. 1010, U.S. Patent No. 5,694,268, issued Dec. 2, 1997 (“Dunfield”).

³ Ex. 1005, JP S60-278563, published June 20, 1987 (“DENSO”).

⁴ Ex. 1008, JP H11-341717 A, published Dec. 10, 1999 (“Matsushita”).

Case IPR2018-00598

Patent 7,067,952 B2

Institution in the '1631 IPR. *See* '1631 IPR, slip op. at 14–39 (PTAB Jan. 17, 2018) (Paper 11).

III. GRANT OF MOTION FOR JOINDER

Joinder in *inter partes* review is subject to the provisions of 35 U.S.C. § 315(c):

(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 parties review under section 314.

“Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested.” 37 C.F.R. § 42.122(b). 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 Sony Corp. of Am. v. Network-1 Security Solutions, Inc.*, Case IPR2013-00495, slip op. at 3 (PTAB Sept. 16, 2013) (Paper 13) (“*Sony*”). When exercising its discretion, the Board is mindful that patent trial 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).

As the moving party, Nidec and Honda have the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c),

42.122(b). A motion for joinder should (1) set forth the reasons why 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 Sony* at 3; Mot. 3–4. Petitioner should address specifically how briefing and/or discovery may be simplified to minimize schedule impact. *See Kyocera Corp. v. SoftView LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15) (representative).

Nidec and Honda’s Motion is timely because it was filed within one month of institution of the ’1631 IPR. *See* Mot. 4 (citing 37 C.F.R. § 42.122). In their Motion for Joinder, Nidec and Honda contend that joinder is appropriate because “[t]he Petition is substantively identical to the [’1631] Petition, presenting the same grounds of rejection, based on the same evidence and supporting declaration.” *Id.* Nidec and Honda further contend their “Petition does not present any new grounds of unpatentability.” *Id.* Nidec and Honda further argue that joinder will not impact the schedule of the ’1631 IPR, particularly because Patent Owner “will not be required to present any additional responses or arguments.” *Id.* at 5.

Nidec and Honda also agree to be bound by the following conditions in their “understudy” role if they are joined to the ’1631 IPR:

- (a) all filings by Nidec and Honda in the joined proceeding [shall] be consolidated with the filings of Toyota and Denso, unless a filing solely concerns issues that do not involve Toyota or Denso;
- (b) Nidec and Honda shall not be permitted to raise any new grounds not already instituted by the Board, or introduce any

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.