UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DAIMLER AG,

Petitioner,

v.

BLITZSAFE TEXAS, LLC,

Patent Owner.

Patent No. 8,155,342
Filing Date: June 27, 2006
Issue Date: April 10, 2012

Inventor: Ira Marlowe
Title: MULTIMEDIA DEVICE INTEGRATION SYSTEM

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

Case No. IPR2018-01209

I. LEGAL STANDARD

Institution of the proceeding to which a party seeks joinder must occur prior to a request for joinder. *See* 35 U.S.C. § 315(c) ("If the Director institutes an *inter partes* review…"); *see also* 37 C.F.R. § 42.122(b) ("Any request for joinder must be filed…after the institution date of an *inter partes* review for which joinder is requested."). "It is clear from both the statute and the rule that a request for joinder is appropriate only if a decision granting institution has been entered in the *inter partes* review for which joinder is requested." *Linear Tech. Corp. v. In-Depth Test LLC*, Case No. IPR2015-01994, slip op. at 4, (P.T.A.B. Oct. 20, 2015) (Paper 7).

II. THE MOTION MUST BE DENIED AS PREMATURE

On June 6, 2018, Petitioner, Daimler AG ("DAG") filed a petition requesting *inter partes* review ("1209-IPR") of claims 49-57, 62-64, 66, 68, 70, 71, 73-80, 83, 86-88, 94, 95, 97, 99-103, 106, 109-111, 113, 115, 120 (the "Challenged Claims") of U.S. Patent No. 8,155,342 (the "'342 Patent"). Petitioner concurrently filed a motion to join a non-instituted proceeding, IPR2018-00544 (the "544-IPR"), submitting that the 1209-IPR and 544-IPR petitions are "substantively identical." As set forth herein, Petitioner's motion should be denied as premature because the motion requests joinder to a non-instituted petition.

Petitioner concedes that the Board has not instituted the 544-IPR. Patent Owner filed a preliminary response to the 544-IPR petition on May 15, 2018,

making it likely that the Board will issue an institution decision on or around August 15, 2018. Petitioner contends that the joinder motion is timely based on a statement in a Board decision that prior authorization for a motion filed prior to one month after institution is not required. *See Taiwan Semiconductor Manufacturing Co., Ltd. v. Zond, LLC,* IPR2014-00781, Paper 5 at 3. Petitioner does not cite to any authority for the proposition that it is entitled to joinder to a petition which has not been instituted, as required by 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b). Accordingly, the motion for joinder must be denied as premature.

III. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION AND TO DENY JOINDER

This petition is the **15th**[1] *inter partes* review challenge against the '342 Patent. DAG is the latest in a long line of petitioners seeking to impermissibly benefit from an extensive history of prior arguments and decisions at the expense of Patent Owner's and the Board's limited resources. No efficiencies will be gained by instituting another petition and allowing Petitioner to insert itself into the 544-IPR. Patent Owner respectfully urges the Board to deny the request for

[1] The following IPR2016-00118 (Instituted Denied); IPR2016-00418 (Terminated); IPR2016-00419 (Institution Denied); IPR2016-01445 (Terminated); IPR2016-01449 (Terminated); IPR2016-01473 (Institution Denied); IPR2016-01476 (Terminated); IPR2016-01533 (Terminated); IPR2016-01557 (Terminated); IPR2016-01560 (Terminated); IPR2018-00090 (Institution Denied); IPR2018-00544 (Pending); IPR2018-00926 (Pending); IPR2018-00927 (Pending); IPR2018-01209 (Pending)

joinder and the underlying petition before Patent Owner and the Board waste additional resources.[2]

Despite conceding that the 544-IPR and 1209-IPR petitions are substantively identical, Petitioner proposes participating in a limited-but-active role in the 544-IPR. Rather than commit to simplifying procedures for briefing and discovery, Petitioner states that it "does not anticipate that its presence will introduce any additional arguments, briefing or need for discovery" while retaining the right to do so. Mot. at 7-8. Petitioner apparently plans to take depositions and argue at oral hearing. Mot. at 8. Petitioner does not explain how it plans to "consolidate filings" and appears to retain the right to substantive briefing. *See id.* Petitioner's commitment to refrain from raising any new grounds is illusory because Petitioner is already precluded from adding new grounds by the rules and statutes governing IPRs. That said, Petitioner does not waive its right to request authorization to file supplemental information. It is clear that Petitioner intends to retain an active role in the proceeding, which would unduly burden and unfairly prejudice Patent Owner. Patent Owner will incur additional costs and expend additional resources in defending its patent rights against a fifteenth challenge.

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[2] As noted herein, Patent Owner intends to submit a preliminary response addressing *General Plastic* factors and additional reasons why the Board should deny institution. However, the Board is well-aware of the record of the 544-IPR and the related proceedings. Patent Owner respectfully requests the Board exercise its discretion to deny institution before the preliminary response becomes due.

IV. PETITIONER HAS IDENTIFIED NO LEGITIMATE REASON FOR JOINDER

Joinder should be denied because Petitioner fails to identify a legitimate basis to join the 544-IPR. Petitioner identifies overall commonality (*i.e.*, "substantially identical") as a basis for meeting each factor relating to joinder, conceding that the 1209-IPR involves redundant grounds on the same prior art and same claims. However, commonality is not a legitimate reason for joinder.

Petitioner has the burden of establishing entitlement to joinder and articulating a reason to join the proceeding. *Kyocera Corp. v. Softview LLC*, Case No. IPR2013-00004, Paper 15 at 2–3. For example, in *Kyocera*, the joining party expressed its belief that joinder was the only option to participate in the review of the challenged patents and that the petitioner's reliance on the joining party's expert's testimony in the proceeding necessitated the joining party's participation in any cross-examination of its expert. Here, Petitioner presents no such rationale. For instance, Petitioner does not argue that it was unaware of the 544-IPR prior art until the day of expiration of its one-year statutory period. Petitioner presents no reason why it is entitled to joinder.

Petitioner asserts commonality between the 544-IPR and the 1209-IPR as a basis for meeting each of the four factors required in a motion for joinder. Commonality alone must not compel automatic joinder. Reasserting commonality to satisfy each independent factor renders Factor 1, and the analysis itself,

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