

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCEDES-BENZ GROUP AG and MERCEDES-BENZ USA, LLC,
Petitioner,

v.

ARIGNA TECHNOLOGY LTD.,
Patent Owner.

IPR2022-00776
Patent 8,289,082 B2

Before GARTH D. BAER, SHARON FENICK, and IFTIKHAR AHMED,
Administrative Patent Judges.

FENICK, *Administrative Patent Judge.*

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b)

I. INTRODUCTION

A. Background

Mercedes-Benz Group AG and Mercedes-Benz USA, LLC (“Petitioner”) filed a Petition (Paper 2, “Pet.”) to institute an *inter partes* review of claims 1–32 of U.S. Patent No. 8,289,082 B2 (Ex. 1001, “the ’082 patent”). Concurrently, Petitioner filed a Motion for Joinder seeking to join Petitioner as a party to *Volkswagen Group of America, Inc. v. Arigna Technology Ltd.*, IPR2021-01531 (PTAB) (“Volkswagen IPR”). Paper 3 (“Mot.”). Arigna Technology Ltd. (“Patent Owner”) filed a Preliminary Response, (Paper 7, “Prelim. Resp.”).

We have authority under 37 C.F.R. § 42.4(a) and 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition “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.” For the reasons described below, we institute *inter partes* review of all the challenged claims, and grant Petitioner’s Motion for Joinder.

B. Related Proceedings

The ’082 patent is at issue in *Arigna Technology Limited v. Volkswagen AG et al.*, Case No. 2:21-cv-00173 (E.D. Tex.) (“related district court proceeding”) and ITC Proceeding 337-TA-1267 (“ITC proceeding”). Pet. 76; Paper 5 (Patent Owner’s Mandatory Notices), 2. The ’082 is also at issue in the Volkswagen IPR and in IPR2022-00737 (“the BMW Joinder IPR”), in which joinder with the Volkswagen IPR has already been requested and granted. Pet. 77; Paper 5, 2; IPR2022-00737, Papers 1

(Petition, filed March 23, 2022), 3 (Motion for Joinder, filed March 23, 2022), 9 (granting institution and joinder, issued September 8, 2022).

C. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability.¹ Pet. 2.

Reference(s)	Challenged Claims	35 U.S.C. §
Soneda ²	1–6, 11, 13, 14, 16–22, 27, 29–32	§ 103
Soneda, Kozisek ³	1–6, 8–11, 13, 14, 16–22, 24–27, 29–32	§ 103
Soneda, Palmisano ⁴	7, 23	§ 103
Soneda, Kozisek, Palmisano	7, 23	§ 103
Soneda, Gutzki ⁵	12, 15, 28, 31	§ 103
Soneda, Kozisek, Gutzki	12, 15, 28, 31	§ 103

Petitioner also relies on a declaration from Dr. Peter R. Kinget (Ex. 1015), whose declaration adopts the opinions set forth in the declaration of Laurence W. Nagel, Ph.D. submitted by petitioner in the Volkswagen IPR (Ex. 1003). *See* Pet. 1 n.1. The Petition cites Dr. Nagel’s declaration but

¹ We note that this chart differs from the chart provided in the Petition. *See* Volkswagen IPR, Paper 7 at 7 nn.3, 7 (explaining the difference between the chart provided in the Volkswagen IPR institution decision and the chart in the Volkswagen IPR petition).

² Soneda, JP 62-171212, published July 28, 1987 (Ex. 1005, original at pp. 12–15, translation at pp. 2–11, affidavit of translator at p. 1 (*see* 37 C.F.R. § 42.63(b))).

³ Kozisek et al., US 6,049,246, issued Apr. 11, 2000 (Ex. 1006).

⁴ Palmisano, G., Palumbo, G., & Pennisi, S., CMOS CURRENT AMPLIFIERS (1999) (Ex. 1007).

⁵ Gutzki et al., US 7,405,614 B2, issued July 29, 2008 (Ex. 1008).

states that “there are corresponding, identical opinions in Dr. Kinget’s declaration.” *Id.*

II. DISCUSSION

A. Institution of Inter Partes Review

1. Discretionary Denial

In its Preliminary Response, Patent Owner contends we should deny the Petition under § 314(a), based on “the combination of the pending EDTX Proceeding and nearly completed ITC Proceeding. Prelim. Resp. 68. Patent Owner acknowledges (*id.*) the recent issuance of an Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation⁶ (“Guidance”), in which the Director explained that “the PTAB no longer discretionarily denies petitions based on applying *Fintiv* to a parallel ITC proceeding” (Guidance at 7). Patent Owner thus focuses on the related district court proceeding, including the effect of the ITC Proceeding on the proceeding in the district court.

For the reasons that follow, we decline to exercise our discretion to deny the Petition based on the related district court proceeding.

The Board’s precedential decision in *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”), identifies a non-exclusive list of factors parties may consider addressing where there is a related, parallel district court action to determine whether such action provides any basis for discretionary denial. *Fintiv*, Paper 11 at 5–16. Those factors include:

⁶ Available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Id. at 5–6.

In evaluating the factors, we take a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.

Id. at 6.

a. Factor 1

The district court stayed the related district court litigation pending the related ITC investigation. Prelim. Resp. 69. Patent Owner argues that “[t]he logical expectation is that the EDTX Proceeding will promptly resume after completion of the ITC Proceeding, and there is no evidence that the EDTX Proceeding would be stayed pending resolution of this IPR.” *Id.* As the related district court litigation is currently stayed and there is no indication from the district court relating to whether a stay would or would not be granted pending resolution of an *inter partes* review, this factor is neutral or weighs against exercising our discretion to deny the Petition.

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