

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORPORATION,
Petitioner,

v.

AMERICAN VEHICULAR SCIENCES LLC,
Patent Owner.

Case IPR2013-00419
Patent 6,772,057 B2

Before JAMESON LEE, TREVOR M. JEFFERSON, and
LYNNE E. PETTIGREW, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

DECISION ON
MOTION FOR JOINDER
37 C.F.R. § 42.122(b)

I. INTRODUCTION

Toyota Motor Corporation (“Toyota”) filed a petition for *inter partes* review of U.S. Patent No. 6,772,057 B2 (Ex. 1001, “the ’057 Patent”) on July 12, 2013. Paper 3 (“Pet.”). On January 13, 2014, the Board instituted *inter partes* review on all of the challenged claims of the ’057 Patent. Paper 19 (“Toyota IPR”). American Vehicular Sciences LLC (“AVS”) filed a Patent Owner Response on March 20, 2014. Paper 33. Toyota filed a Reply on May 27, 2014. Paper 40. Oral argument was held on August 18, 2014. Paper 47. The statutory due date for a final written decision is January 13, 2015, which is one year from the date of institution of trial. *See* 35 U.S.C. § 316(a)(11). The Board can issue a final written decision prior to the January 13, 2015 due date. At this point, trial before the Board in the Toyota IPR is over except for the issuance of a final written decision.

More than three months after the date of oral argument, and less than two months from the statutory due date of a final written decision, Toyota filed a Motion for Joinder (Paper 52, “Mot”) on November 20, 2014, requesting that this proceeding be joined with IPR2014-00646. In IPR2014-00646, the Board instituted *inter partes* review of the ’057 Patent on October 23, 2014, on a petition filed by Mercedes-Benz USA, LLC (“Mercedes-Benz”). The trial for IPR2014-00646 (“Mercedes IPR”) is in its beginning stage, still six months away from the scheduled date of oral argument in that proceeding. On November 19, 2014, in IPR2014-00646, Mercedes-Benz and AVS filed a Joint Motion to Terminate.

For reasons discussed below, Toyota's Motion for Joinder is *denied*.¹

II. DISCUSSION

The statutory provision governing joinder of *inter partes* review proceedings is 35 U.S.C. § 315(c). As the movant, Toyota bears the burden to show that joinder is appropriate. 37 C.F.R. § 42.20(c). Guidance with respect to what a motion for joinder should discuss is provided in Frequently Asked Question ("FAQ") H5 on the Board's website at <http://www.uspto.gov/ip/boards/bpai/prps.jsp>. Toyota correctly states:

The applicable rules governing the filing and progress of IPRs, including the rules relating to joinder, are meant to "secure the just, speedy, and inexpensive resolution of every proceeding." 37 C.F.R. § 42.1(b).

Mot. 8. We are unpersuaded, however, by Toyota's contention that "[j]oinder of this proceeding with the Mercedes IPR will further these goals [i.e., the just, speedy, and inexpensive resolution of every proceeding]." *Id.*

1.

Toyota asserts: "Joinder of the Toyota IPR and Mercedes IPR would simply consolidate the issues such that the patentability of the claims over Lemelson [U.S. Patent No. 6,553,130] is resolved all at once (i.e., in October 2015 when a final written decision will be due in the Mercedes IPR) and on a complete and harmonized record." Mot. 1. The assertion is misplaced.

In this proceeding, Toyota has participated in a full trial and simply is waiting for the issuance of a final written decision by the Board. In contrast, the trial in the Mercedes IPR is only just starting. Joinder of the Toyota IPR

¹ This decision is rendered without consideration of AVS's Opposition.

and the Mercedes IPR would not “resolve[] all [the issues] at once” by having a common trial in the first instance, but instead it would dilute the effects and consequences of a first trial by mixing the already complete record of this proceeding with that to be developed in the Mercedes IPR. The Mercedes IPR involves some of the same grounds involved in this proceeding for some claims, as well as grounds not involved in this proceeding. Essentially, Toyota is asking for a new trial in which the records of this proceeding will be incorporated. Such a proposal does not promote any one of the three above-stated goals of obtaining a just, speedy, and inexpensive resolution of every proceeding.

The Board is in the midst of preparing the final written decision in this proceeding, which is expected to issue prior to the statutory due date of January 13, 2015, without any further cost to either party. Toyota does not explain adequately how it would be just to allow Toyota to escape the consequences of the trial Toyota requested and engaged in, and to start over again with a new trial in which to raise new issues and receive new evidence. Toyota states:

Toyota is not trying to re-argue any of the same positions it took in the Toyota IPR. Toyota simply requests the procedural opportunity to argue that claims containing the “generated from” language would have been obvious in view of Lemelson, to the extent it has been effectively barred from arguing this obviousness position during the Toyota IPR.

Mot. 2. Allowing Toyota, who is otherwise precluded from raising a new substantive matter in this proceeding, to join the Mercedes IPR, in which that matter is not precluded, prejudices AVS, particularly when the parties in the Mercedes IPR have filed a Joint Motion to Terminate. Toyota has

participated fully in this trial, from beginning to end, and offers no persuasive reason for the Board to grant Toyota, in effect, a new trial.

Whether or not Toyota intends to “re-argue” in the Mercedes IPR the points it already made in this trial, if the Motion for Joinder is granted, the record established by Toyota in this trial will not be preserved in isolation for subsequent decision. Rather, it will be mixed with the developing record in the Mercedes IPR. Toyota incorrectly refers to that as acquiring a complete and harmonious record (Mot. 1, 3). It is, instead, inappropriate mixing of the records of two trials, effectively nullifying the consequences of the first trial. Contrary to the assertion of Toyota (Mot. 1), such an approach is neither practical nor equitable. Moreover, even if, hypothetically, a scheme can be devised to preserve the record of this trial, in isolation, for subsequent decision when the Mercedes IPR is ready for issuance of a final written decision, that amounts to a stay of this proceeding and a resulting delay of ten months or more, without good cause.

2.

Toyota also argues: “[J]oinder of the Toyota IPR and the Mercedes IPR would avoid any need to engage in briefing and analysis of complicated estoppel issues.” Mot. 2. Specifically, Toyota states:

Second, in the event that the Board concluded that one or more claims were not unpatentable based on the record in the Toyota IPR, granting this joinder motion will ensure that Toyota can participate throughout the Mercedes IPR without the need for the Board to address possible disputes regarding the scope of estoppel under 35 U.S.C. § 315(e)(1), in either district court or in connection with Toyota’s new petition—IPR2015-00261—if it is joined with the Mercedes IPR.

Mot. 2. To provide context for the above-quoted text, we note that Toyota has filed a new petition for *inter partes* review of the '057 patent, in IPR2015-00261, and has filed a motion for joinder in that proceeding to have IPR2015-00261 joined with the Mercedes IPR. The estoppel issues referred to by Toyota stem from 35 U.S.C. § 315(e)(1), which provides:

(e) Estoppel.—

(1) Proceedings before the office.—The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

We understand Toyota's concern about potential estoppel effects of any final written decision in this proceeding on its newly filed petition in IPR2015-00261, and recognize that the estoppel issue potentially may arise during the course of proceeding in IPR2015-00261 or in related district court action between the parties. Nevertheless, the Board cannot favor either the Petitioner or Patent Owner, in any case and under any circumstance. It would be inappropriate for the Board to moot an issue which only can adversely impact one party, on the basis of administrative convenience, i.e., avoiding a need to consider what the motion characterizes as "complicated estoppel issues," if and when such issues arise. That rationale is not well founded.

3.

Toyota further asserts that joining the Toyota IPR and the Mercedes IPR would further the "efficient administration of the Office" because it would allow the Board to issue just a single final written decision regarding

the patentability of the challenged claims of the '057 patent. Mot. 13. That is not the case, for several reasons. First, as discussed above, this proceeding is already complete except for the issuance of a final written decision, while the Mercedes IPR is just beginning. Second, there is some, but not a substantial overlap between this proceeding and the Mercedes IPR. Most of the alleged grounds in the Mercedes IPR are not involved in this proceeding, and most of the grounds involved in this proceeding are not involved in the Mercedes IPR. Third, neither allowing Toyota to argue more issues at this stage nor allowing Mercedes to argue more issues than it alleged in the Mercedes IPR promotes “efficient administration of the Office.”

III. CONCLUSION

For the foregoing reasons, Toyota’s Motion for Joinder is *denied*.

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