

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HM ELECTRONICS, INC.,
Petitioner,

v.

3M INNOVATIVE PROPERTIES COMPANY,
Patent Owner.

Case IPR2015-00482
Patent 8,694,040 B2

Before JAMES P. CALVE, RICHARD E. RICE, and DAVID C. MCKONE,
Administrative Patent Judges.

CALVE, *Administrative Patent Judge.*

Decision on Motion for Joinder
37 C.F.R. § 42.122(b)

On December 23, 2014, Petitioner HM Electronics, Inc. (“HME”) filed a Petition (“Pet.”; Paper 3) in the instant proceeding seeking *inter partes* review of claims 1–32 of U.S. Patent No. 8,694,040 B2 (“the ’040 patent”). Patent Owner 3M Innovative Properties Company (“3M”) filed a Preliminary Response (“PO Prelim. Resp.”; Paper 11). On July 14, 2015, we instituted *inter partes* review of claims 1–32. Decision (Paper 12).

On December 23, 2014, HME filed a second Petition (“Pet.”; Paper 3) in IPR2015-00491 seeking *inter partes* review of claims 1–13, 15–28, and 30–32 of the ’040 patent based on different grounds of unpatentability than HME asserted in this proceeding (IPR2015-00482). 3M filed a preliminary response (“PO Prelim. Resp.”; Paper 13). On June 25, 2015, we instituted *inter partes* review of claims 1–13, 15–28, and 30–32. Decision (Paper 14).

On July 23, 2015, HME filed a Motion for Joinder (“Motion”) to join this proceeding with IPR2015-00491. IPR2015-00482, Paper 14. 3M has filed an Opposition to HME’s Motion for Joinder. Opposition (Paper 16).

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(b). As indicated in the legislative history, the Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case. *See* 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (when determining whether and when to allow joinder, the Office may consider factors including the breadth or unusualness of the claim scope, claim construction issues, and consent of the patent owner). When exercising that 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* 37 C.F.R. § 42.1(b).

As the moving party, HME has the burden of proof in establishing entitlement to the requested relief. *See* 37 C.F.R. 42.20(c). HME argues that joinder is appropriate because the request was filed within one month of the institution of trial in IPR2015-00491. Mot. 3. HME argues that joinder is appropriate because IPR2015-00482 and IPR2015-00491 involve the same parties, same secondary references, same panels, and nearly identical schedules. *Id.* HME also argues that 3M is not prejudiced by the joinder of IPR2015-00482 with IPR2015-00491, and that joinder will not cause undue delay because both trials are set for oral argument on the same day. *Id.*

3M argues that HME's Motion for Joinder should be denied for the following reasons: (1) HME fails to assert a reason for joinder as required by 37 C.F.R. § 42.22(a)(2); (2) joinder would prejudice 3M and would not result in the "just, speedy, and inexpensive resolution of every proceeding"; and (3) joinder would favor gamesmanship over fairness. Opposition 4–7. In particular, 3M argues that the primary references are different in each proceeding and some of the secondary references are different so that each Petition asserts different grounds of unpatentability. Opposition 6. Thus, 3M asserts that it would be unjust to limit 3M to a single response to these different grounds presented in two separate petitions. *Id.* 3M also argues that HME chose to divide its grounds of patentability into two Petitions when it might have presented all grounds in a single petition, so 3M should not be denied the right to prepare an individual response to each Petition, particularly where HME has not provided any reason why HME could not have presented all of its asserted grounds of unpatentability in a single petition. *Id.* at 6–7.

We are not persuaded that joining IPR2015-00482 with IPR2015-00491 will result in a more just, speedy, or inexpensive resolution of the proceedings. Identical scheduling orders were entered in both proceedings, with both proceedings scheduled for oral argument on the same day. We do not see joinder having an impact on the timing of the proceedings or their speedy resolutions. Moreover, we share 3M's concern that what HME seeks to accomplish is to cut in half the number of pages 3M is allowed to respond to HME's challenges after HME had its opportunity to present fully its case. HME has not argued persuasively that joinder would reduce expenses.

3M, however, has argued persuasively that effectively halving the page limit of its responses would be unjust. HME has presented six different grounds of unpatentability, three in each proceeding. 3M must defend against, and we must decide, each of those grounds whether they are presented in two different *inter partes* reviews or joined into one *inter partes* review. The three grounds asserted in IPR2015-00482 rely on HME Pro850 (Ex. 1009) as the primary reference, while the three grounds asserted in IPR2015-00491 rely on Gosieski (Ex. 1008) as the primary reference. Thus, HME has asserted six distinct grounds in two *inter partes* reviews.

HME has not explained why it could not have presented all six grounds in a single petition for *inter partes* review. Presumably, HME made the strategic decision to present its grounds in two separate Petitions because it needed twice the length of one petition to present fully its evidence. Now that HME has presented six distinct grounds of unpatentability against the claims of the '040 patent in two separate Petitions for *inter partes* reviews, joinder would limit 3M to a single response. It is in the interests of ensuring a just proceeding that 3M have an opportunity to respond to the three

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grounds in IPR2015-00482 in one response in this proceeding and the three different grounds asserted in IPR2015-00491 in a separate response in that proceeding.

The parties are free to stipulate to changes in the scheduling orders to achieve other efficiencies that they may perceive. Moreover, the parties are encouraged to seek efficiencies in discovery, for example, through consolidation of depositions of expert witnesses for both trials.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Motion for Joinder of IPR2015-00482 and IPR2015-00491 is *denied*.

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For PETITIONER:

Charles Segelbaum
csegelbaum@fredlaw.com

Adam Steinert
asteinert@fredlaw.com

For PATENT OWNER:

Timothy E. Bianchi
tbianchi@slwip.com

Erik Drange
emdrange@mmm.com

David B. Patchett
dbpatchett@mmm.com