

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENERAL MOTORS LLC,
Petitioner,

v.

ARIGNA TECHNOLOGY LTD.,
Patent Owner.

IPR2022-00641
Patent 8,247,867 B2

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

BAER, *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*

General Motors LLC (“Petitioner”) filed a Petition (Paper 2, “Pet.”) to institute an *inter partes* review of claims 1–9 of U.S. Patent No. 8,247,867 B2 (Ex. 1001, “the ’867 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.*, IPR2021-01321 (PTAB) (“Volkswagen IPR”). Paper 3 (“Mot.”). Arigna Technology Ltd. (“Patent Owner”) filed a Preliminary Response, (Paper 7, “Prelim. Resp.”), to which Petitioner filed a Preliminary Reply (Paper 8, “Reply”), and Patent Owner filed a Preliminary Sur-reply (Paper 9, “Sur-reply”).

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 ’867 patent is at issue in *Arigna Technology Limited v. Volkswagen AG et al.*, Case No. 2:21-cv-00054-JRG-RSP (E.D. Tex.); ITC Proceeding 337-TA-1267 (“ITC proceeding”); as well as IPR2021-01321, IPR2021-01382, and IPR2022-00631. See Pet. 111–114; Paper 6, 2.

C. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability. Pet. 56.

Reference(s)	Basis	Challenged Claim(s)
Torii ¹	§ 102	4, 7
Torii, Hebert ²	§ 103	5
Torii, Hebinuma ³	§ 103	6
Kim03 ⁴	§ 102	8, 9
Sekiguchi, ⁵ Hebert	§ 103	8, 9
Kim03, Sekiguchi	§ 103	1–3
Sekiguchi, Williams99 ⁶	§ 103	1, 3
Sekiguchi, Williams99, Hebert	§ 103	2

Petitioner also relies on the declaration from Dr. Sanjay K. Banerjee in the Volkswagen IPR (Ex. 1002), adopted by Petitioner’s declarant Dr. David Kuan-Yu Liu (Ex. 1070 ¶ 23). See Pet. 1 n.1.

¹ WO 2009/060670 A1, Pub. May 14, 2009 (Translation) (Ex. 1030, “Torii”).

² US 2009/0218619 A1, Pub. Sept. 3, 2009 (Ex. 1025, “Hebert”).

³ JP 2006-59940 A, Pub. Mar. 2, 2006 (Translation) (Ex. 1027, “Hebinuma”).

⁴ J. Kim et al., High-Density Trench MOSFETs Employing Two Step Trench Technique and Trench Contact Structure, Proceedings of the 2003 IEEE 15th International Symposium on Power Semiconductor Devices and ICs, pp. 165–67 (2003) (Ex. 1034, “Kim03”).

⁵ US 2009/0179261 A1, Pub. Jul. 16, 2009 (Ex. 1044, “Sekiguchi”).

⁶ US 6,413,822 B2, Jul. 2, 2002 (Ex. 1033, “Williams99”).

II. DISCUSSION

A. *Institution of Inter Partes Review*

1. *Discretionary Denial based on Related ITC Investigation*

In its Preliminary Response, Patent Owner contends we should deny the Petition under § 314(a), based primarily on a parallel ITC investigation involving the '867 patent. *See* Prelim. Resp. 76–80. However, after Patent Owner filed its Preliminary Response, the USPTO Director issued an Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation⁷ (“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. Thus, we decline to discretionarily deny the Petition based on a parallel ITC investigation.

2. *Discretionary Denial based on Related District Court Proceeding*

In its Sur-reply, Patent Owner focuses its discretionary-denial argument on the related litigation in the Eastern District of Texas. *See* Sur-reply 2–3. 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

⁷ Available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

such action provides any basis for discretionary denial. *Fintiv*, Paper 11 at 5–16. Those factors include:

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

Because the district court stayed the related litigation pending the related ITC investigation, this factor weighs against denying institution. *See* Reply 2; Sur-reply 2.

b. Factor 2

Because, as explained below, we are joining this case to the Volkswagen IPR, the final written decision in this case is due in February 2023. *See* Reply 2. Given the district court’s stay, there is no scheduled trial date. *See* Reply 2; Sur-reply 2–3. Despite the stay, Patent Owner argues we should use the Eastern District of Texas’s 24.2-month median

time to trial, which “yields an expected trial date in March of 2023.” Sur-reply 2. Even if Patent Owner is correct, however, because we are joining this case with the Volkswagen IPR, the final decision in this case will precede the district court’s trial. Thus, this factor weighs against exercising our discretion to deny the Petition.

c. Factor 3

Petitioner argues there has been “only minimal actions” in the district court “[b]ecause this case was stayed shortly after filing.” Reply 3. Patent Owner does not identify any specific investment in the parallel district court proceeding, arguing instead only that “[f]our months of district court proceedings had already elapsed before the stay was granted.” Sur-reply 2.⁸ In these circumstances, we find this factor weighs against exercising our discretion to deny the Petition.

d. Factor 4

Although the parties address overlap between this case and the related ITC proceeding, they do not address overlap in the related district court proceeding. *See* Pet. 120, Prelim. Resp. 79, Reply 2–3, Sur-reply 2–3. In these circumstances, we determine this factor is neutral.

e. Factor 5

Petitioner is a defendant in the related district court proceeding. Prelim. Resp. 80. Thus, Petitioner and the defendant in the parallel proceeding are the same. This factor therefore weighs in favor of exercising our discretion to deny the Petition.

⁸ In its Preliminary Response, Patent Owner focusses on investment in the related ITC proceeding. *See* Prelim. Resp. 79. However, as noted above, we no longer discretionarily deny petitions based on a parallel ITC proceeding.

f. Factor 6

As Petitioner notes, in the Volkswagen IPR, we determined that this factor is neutral for the same prior art and arguments raised here. *See* Pet. 121; *see also* Volkswagen IPR, Paper 10 at 9. According to Petitioner, however, “[a]dditional facts not present in the Volkswagen IPR move this factor to favor institution.” Pet. 121. Patent Owner argues that the merits are weak because in the Volkswagen IPR, Petitioner’s expert “repeatedly contradicted and abandoned” his analysis during deposition. Prelim. Resp. 80.

As we noted in our institution decision in the Volkswagen IPR, the petition met the standard for institution, but there remained a number of factual disputes to be resolved at trial. Volkswagen IPR, Paper 10 at 9. We decline to resolve those issues, or the additional issues Patent Owner raises, here. Instead, as explained below, we will consider Patent Owner’s substantive arguments with the benefit of a complete record in the context in which Patent Owner first raised them—i.e., in the Volkswagen IPR.

For the same reasons discussed in our Decision on Institution in the Volkswagen IPR (*see* Volkswagen IPR, Paper 10), we find the Petition’s merits meet the reasonably-likely-to-prevail standard for institution. We decline, however, to characterize the merits as particularly strong or weak. Thus, we find this factor neutral.

g. Summary and Conclusion

We have considered the circumstances and facts before us in view of the *Fintiv* factors. For the reasons given, we are not persuaded to exercise our discretion to deny institution.

3. The Petition's Merits

Petitioner represents that the Petition “is substantively the same as the Volkswagen IPR petition” (Mot. 1), which we found met the reasonably-likely-to-prevail standard for institution under 35 U.S.C. § 314. Volkswagen IPR, Paper 10, 31. Further, the Petition “challenges the same claims, on the same grounds and relies on the same prior art as instituted in the Volkswagen IPR.” *Id.* Although Patent Owner does not dispute that the Petition is the same as the Volkswagen IPR’s petition, Patent Owner raises a number of substantive challenges, including some based on evidence submitted in IPR2021-01321 after institution. *See, e.g.*, Prelim. Resp. 20–21, 25–26, 31, 34, 42.

We acknowledge Patent Owner’s arguments that Petitioner has not shown sufficiently that claims 1–9 are unpatentable over the asserted prior art. *See* Prelim. Resp. 19–75. Based on our independent review, Patent Owner’s Preliminary-Response arguments are substantively the same as those in Patent Owner’s Response to the Volkswagen IPR petition. *Compare id.* at 19–75, *with* Volkswagen IPR, Paper 17 at 22–78. Rather than decide those issues here, we grant the Petition and join Petitioner to the Volkswagen IPR, as that will provide us with the opportunity to more fully consider Patent Owner’s arguments with the benefit of a complete record and does so without imposing any additional burden on Patent Owner. Granting the Petition and joining Petitioner to the Volkswagen IPR also avoids us having to consider the same arguments twice.

At this stage of the proceeding and based on our preliminary review, we find Petitioner has demonstrated a reasonable likelihood of showing the unpatentability of the challenged claims for the same reasons discussed in

our Decision on Institution in the Volkswagen IPR. Accordingly, we grant the Petition, and institute *inter partes* review of the challenged claims.

B. Motion for Joinder

Joinder in *inter partes* reviews is governed by 35 U.S.C. § 315(c), which reads:

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 partes* review under section 314.

A motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See Kyocera Corp. v. SoftView LLC*, Case IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

We instituted the Volkswagen IPR on February 15, 2022. *See* Volkswagen IPR, Paper 10. Petitioner filed this Petition and Motion for Joinder on March 1, 2022, i.e., within one month of the institution date of the Volkswagen IPR. *See* Paper 2; Mot. Thus, Petitioner timely filed its Motion for Joinder. *See* 37 C.F.R. § 42.122(b).

Petitioner represents that its Petition “is substantively identical to the petition in the Volkswagen IPR.” Mot. 4. Petitioner explains that According to Petitioner, although it “uses its own expert declarant, the expert’s declaration agrees with the facts, analysis, and conclusions of the expert declaration in the Volkswagen IPR and does not contain any new

opinions not included in the Volkswagen IPR expert declaration.” *Id.* at 6. Petitioner further represents that should it be joined to the Volkswagen IPR, “as long as the Volkswagen IPR Petitioner remains a party to the Volkswagen IPR,” it will “take an understudy role, which will simplify briefing and discovery.” *Id.* at 8. Thus, Petitioner agrees to not make any substantive filings, to be bound by the filings of the Volkswagen IPR petitioner, to not present any argument at oral hearing, to not seek to cross-examine or defend any witness, and to not seek additional discovery from Patent Owner. *Id.* According to Petitioner, “Patent Owner and the Volkswagen IPR Petitioner will only need to respond to one principal set of papers, will not require additional time to address additional arguments, and can thus proceed with the existing trial schedule.” *Id.* at 9–10. Petitioner further explains it seeks joinder “to ensure that an accused infringer with an active interest in the proceeding remains a party to this IPR if the Volkswagen IPR Petitioner’s participation is terminated prior to completion.” *Id.* at 4. Other than the merits arguments addressed above, Patent Owner does not separately contest joinder.

We are persuaded by Petitioner’s arguments. Because the Petition challenges the same claims on the same grounds using the same prior art, *Kyocera* factor (2) favors joinder. *See Kyocera*, IPR2013-00004, Paper 15 at 4. Indeed, the Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.” *Samsung Elecs. Co., Ltd. v. Raytheon Company*, IPR2016-00962, Paper 12 at 9 (PTAB Aug. 24, 2016). Moreover, because the issues to be decided are the same and Petitioner agrees to take an “understudy” role to the petitioner in the Volkswagen IPR

by consolidating all filings, refraining from advancing new arguments, binding itself to any discovery agreements, and limiting its deposition time to the time already allotted, *Kyocera* factors (3) and (4) also favor joinder. *See* Mot. 8–9; *Kyocera*, IPR2013-00004, Paper 15 at 4. Thus, we find that joining Petitioner to the Volkswagen IPR is appropriate under the present circumstances. We, therefore, *grant* Petitioner’s Motion for Joinder.

III. CONCLUSION

For the foregoing reasons, we are persuaded that Petitioner has demonstrated a reasonable likelihood that it will succeed in showing claims 1–9 are unpatentable under 35 U.S.C. § 103. At this preliminary stage, we have not made a final determination with respect to the patentability of the challenged claims or any underlying factual and legal issues.

Given that Petitioner is being joined as a party to the Volkswagen IPR, Petitioner is bound by the ultimate determination made in the Volkswagen IPR. *See* 35 U.S.C. §§ 315(e)(1), 325(d); 37 C.F.R. § 42.73(d)(1). Accordingly, Petitioner shall not advance any arguments regarding these claims in this proceeding; all grounds raised by Petitioner regarding these claims will be addressed in the Volkswagen IPR.

IV. ORDER

For the reasons given, it is:

ORDERED that *inter partes* review is instituted in IPR2022-00641;

FURTHER ORDERED that the Motion for Joinder with IPR2021-01321 is *granted*, and Petitioner is joined as a petitioner in IPR2021-01321;

FURTHER ORDERED that all future filings shall be made in IPR2021-01321;

FURTHER ORDERED that Petitioner shall file each paper due in IPR2021-01321 as a consolidated filing with the petitioner in the Volkswagen IPR, except for a paper that does not involve the petitioner in the Volkswagen IPR;

FURTHER ORDERED that, for each paper due in IPR2021-01321, Petitioner may not file any paper in addition to the consolidated paper filed in the Volkswagen IPR absent prior authorization from the Board;

FURTHER ORDERED that Petitioner and the petitioner in the Volkswagen IPR shall collectively designate attorneys to conduct the cross-examination of any witness produced by Patent Owner and the redirect of any witness produced by the petitioner in the Volkswagen IPR, within the timeframes set forth in 37 C.F.R. § 42.53(c) or agreed to by the parties;

FURTHER ORDERED that Petitioner and the petitioner in the Volkswagen IPR shall collectively designate attorneys to present at the oral hearing, if requested and scheduled, in a consolidated argument;

FURTHER ORDERED that the case caption in IPR2021-01321 shall be changed to reflect joinder of General Motors LLC as a petitioner in accordance with the attached example; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2021-01321.

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Example Case Caption for Joined Proceeding

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLKSWAGEN GROUP OF AMERICA, INC., BMW OF NORTH
AMERICA, LLC, and
GENERAL MOTORS LLC,
Petitioners,

v.

ARIGNA TECHNOLOGY LTD.,
Patent Owner.

IPR2021-01321⁹
Patent 8,247,867 B2

⁹ BMW of North America, LLC, who filed a petition in IPR2022-00631 and General Motors LLC, who filed a petition in IPR2022-00641 have been joined as petitioners in this proceeding.