

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PORSCHE CARS NORTH AMERICA, INC.,
Petitioner,

v.

YECHEZKAL EVAN SPERO,
Patent Owner.

IPR2023-01296
Patent 9,955,551 B2

Before JON M. JURGOVAN, JASON W. MELVIN, and
AARON W. MOORE, *Administrative Patent Judges*.

MELVIN, *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)

I. INTRODUCTION

Porsche Cars North America, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 56–87 of U.S. Patent No. 9,955,551 B2 (Ex. 1001, “the ’551 patent”). Petitioner filed also a Motion for Joinder seeking to join Petitioner as a party to *Volkswagen Group of America, Inc. v. Yechezkal Evan Spero*, IPR2023-00318 (“the VW IPR”), instituted July 11, 2023. Paper 3 (“Mot.”); *see* IPR2023-00318, Paper 11. Yechezkal Evan Spero (“Patent Owner”) filed a Preliminary Response. (Paper 7, “Prelim. Resp.”). Patent Owner did not oppose joinder. Pursuant to 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a), we have authority to determine whether to institute review.

An *inter partes* review may not be instituted unless “the information presented in the petition . . . and any response . . . 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.” 35 U.S.C. § 314(a). For the reasons set forth below, we conclude that Petitioner has shown a reasonable likelihood it will prevail in establishing the unpatentability of at least one challenged claim, and we institute *inter partes* review.

A. REAL PARTIES IN INTEREST

Petitioner identifies itself and its affiliate Dr. Ing. h.c. F. Porsche Aktiengesellschaft as the real parties in interest. Pet. 84. Patent Owner identifies itself, Yechezkal Evan Spero, and Torchlight Technologies LLC, the exclusive licensee of the ’551 patent, as the real parties in interest. Paper 6, 1 (Patent Owner’s Mandatory Notices).

B. RELATED MATTERS

The parties identify the following related litigation: *Torchlight Techs. LLC v. Daimler AG et al.*, Case No. 1:22-cv-00751 (D. Del.); *Torchlight Technologies LLC v. General Motors LLC et al.*, No. 1:22-cv-00752 (D. Del). *See* Pet. 87–88; Paper 6, 1. They identify pending reissue application 16/858,342. Pet. 88, Paper 6, 1. They also identify IPR2022-00315, IPR2022-00318, IPR2023-00336, IPR2023-01039, IPR2023-01040, and IPR2023-01225. *See* Pet. 84–86; Paper 6, 1–3.¹

C. THE '551 PATENT

The '551 patent is titled “Detector Controlled Illuminating System” and relates to an “illuminating device” whereby “illumination intensity and spectrum” are varied to illuminate “areas according to the principles of correct lighting practice,” e.g., “adapt to ambient lighting, movement, visual tasks being performed, and environmental and personal conditions.” Ex. 1001, codes (54, 57). The specification generally describes a lighting device that “incorporates one or more discrete light sources and their ancillary optical and electrical control equipment in an integrated illuminating element.” *Id.* at 13:34–36. The combined unit is referred to as a Digital Lighting Fixture (DLF). *Id.* at 18:18–22.

The specification further describes transportation vehicle applications. *Id.* at 50:38–57:37. One such application involves a DLF headlamp device that includes a cluster of LEDs for flexible illumination. *Id.* at 50:50–58. With LEDs having a variety of aims, the headlamp’s light distribution pattern may be controlled based

¹ Patent Owner further lists several IPRs involving two different patents related to the '551 patent. Paper 6, 3–5.

on a number of factors, including detected oncoming vehicles. *See id.* at 51:43–47, 52:59–65.

D. CHALLENGED CLAIMS

Petitioner challenges claims 56–87 of the '551 patent. Pet. 3. Claim 56 is independent and is reproduced, below, with limitation identifiers reproduced from the Petition's claim appendix (Pet., Appx B):

- [.p] 56. An illuminating device having automatic control of light provided to an illuminated area comprising:
 - [.1] a structure for incorporating illuminating device elements, wherein the structure comprises a motor vehicle;
 - [.2] a plurality of individually controllable LEDs incorporated in the structure via at least one headlamp mounted to the structure, each headlamp including at least one of the LEDs, the LEDs in communication with a power source;
 - [.3] electronic circuitry apparatus for the controlled powering of the LEDs and other of the illuminating device elements;
 - [.4] one or more processors;
 - [.5] one or more sensors, including one or more cameras, placed on the structure for detecting coordinate-specific information about the illuminated area and positioned to capture an image of at least one other vehicle ahead of the motor vehicle, at least one of said cameras in communication with power, and in communication with at least one of the one or more processors;
 - [.6] a controller, including at least one of the one or more processors, integrated with the structure via mounting, in communication with the LED controlling power electronic circuitry apparatus, said controller arranged to process the information communicated from the cameras and to automatically control the light provided to the illuminated area; and
 - [.7] memory storing instructions that, when executed by one or more processors of the controller, enable the controller to:

- [.8] determine, based on data from one or more of the sensors, a vertical and horizontal position associated with the at least one other vehicle;
- [.9] select a first cluster of the LEDs based at least in part on at least one of the vertical and horizontal position compared to known aimings of light associated with the first cluster; and
- [.10] reduce intensity of illumination to non-glaring illumination of a first area associated with the at least one other vehicle, relative to intensity of illumination on both sides of the first area at elevations common with the first area illuminated by a second cluster of the LEDs, by control of emission from the first cluster.

Ex. 1035 (Reexam. Cert.), 8:14–57; Ex. 1002, 1015–16 (Certificate of Correction). Claims 64 (Ex. 1035 at 9:50–10:34), 72 (*id.* at 11:30–12:12), and 80 (*id.* at 12:66–13:40) are the other independent claims and Petitioner asserts that each recites only limitations similar to the limitations of independent claim 56 (Pet. 21–32). Remaining claims 57–63, 65–71, 73–79, and 81–87 depend, directly or indirectly, from independent claim 56, 64, 72, or 80. Ex. 1035, 8:58–14:52.

E. PRIOR ART AND ASSERTED GROUNDS

Petitioner asserts the following unpatentability grounds:

	Claims Challenged	35 U.S.C. § ²	References/Basis
1	56, 57, 62–65, 70–73, 78–81, 86, 87	103	Beam, ³ Satonaka ⁴
2	58–61, 66–69, 74–77, 82–85	103	Beam, Satonaka, Kobayashi ⁵
3	56, 57, 62–65, 70–73, 78–81, 86, 87	103	Karlsson, ⁶ Nakamura ⁷
4	58–61, 66–69, 74–77, 82–85	103	Karlsson, Nakamura, Gotou ⁸

Pet. 3. Petitioner also relies on the Declaration of Scott Andrews. Ex. 1003.

II. ANALYSIS

To join a petitioner to an instituted proceeding, the Board first determines whether the Petition “warrants” institution under 35 U.S.C. § 314. 35 U.S.C. § 315(c); *see Facebook, Inc. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020).

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. § 103, effective March 16, 2013. Because the application from which the ’551 patent issued was filed before this date, the pre-AIA version of § 103 applies.

³ U.S. Patent No. 6,144,158, issued Nov. 7, 2000 (Ex. 1005).

⁴ English translation of Japan Patent Publication No. H7-101291, published Apr. 18, 1995 (Ex. 1014).

⁵ U.S. Patent No. 6,049,749, issued Apr. 11, 2000 (Ex. 1008).

⁶ WIPO Patent Publication No. 98/54030, published December 3, 1998 (Ex. 1010).

⁷ English translation of Japan Patent Publication No. H7-65603, published Mar. 10, 1995 (Ex. 1013).

⁸ U.S. Patent No. 5,588,733, issued Dec. 31, 1996 (Ex. 1012).

The Board next determines whether to exercise “discretion to decide whether to ‘join as a party’ the joinder applicant,” who is the Petitioner in this proceeding. *Windy City*, 973 F.3d at 1332. As moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder should (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *See Kyocera Corp. v. SoftView, LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013). In addition, a motion for joinder must be filed “no later than one month after the institution date of any inter partes review for which joinder is requested.” 37 C.F.R. § 42.122(b).

A. INSTITUTION OF INTER PARTES REVIEW

Petitioner represents that the “Petition is essentially a copy of the petition filed in” the VW IPR and that the Petition is “based on the same grounds.” Mot. 1, 2–3. Our independent review of the Petition and the VW IPR petition confirms Petitioner’s representations, and that the petitions in the two proceedings are substantially the same. Further, although Petitioner relies on a different expert declarant, Petitioner submits that the two declarations are “substantively identical.” *Id.* at 3.

Having already considered the merits of those challenges and the evidence in the VW IPR and having determined that the threshold for institution of *inter partes* review has been met, we determine that the Petition here also presents a reasonable likelihood of prevailing on the challenges to at least one claim. Additionally, we determine that Patent Owner’s arguments for discretionary denial (*see* Prelim.

Resp. 29–40) are not persuasive.⁹ Therefore, for the same reasons stated in our Decision to Institute in the VW IPR, we institute *inter partes* review in this proceeding on the grounds presented in the Petition. *See* IPR2023-00318, Paper 11.

B. MOTION FOR JOINDER

Petitioner timely filed its Motion for Joinder on August 9, 2023, which was no later than one month after the institution of the VW IPR on July 11, 2023. *See* 37 C.F.R. § 42.122(b).

We determine that Petitioner has met its burden of showing that joinder is appropriate because, as set forth above, the Petition is substantially identical to the petition in the VW IPR, contains the same grounds based on the same evidence, and relies on a substantively identical declaration. Petitioner also represents that joinder will not impact the VW IPR schedule. Mot. 4–5.

Additionally, Petitioner represents that it is willing to accept a limited, “understudy role” to Volkswagen (the original petitioner in the VW IPR), taking over only in the event VW no longer participates. *Id.* at 5, 5 n.3. Specifically, Petitioner represents that in its understudy role, it agrees that the following conditions will apply:

- (a) Petitioner will not make any substantive filings and shall be bound by the filings of VW, unless a filing concerns termination and settlement, or issues solely involving Petitioner.
- (b) Petitioner will not present any argument or make any presentation at oral hearing unless an issue solely involves Petitioner, or when addressing motions that do not affect VW.
- (c) Petitioner will not seek to cross-examine or defend the cross-examination of any witness, unless the topic of cross-examination

⁹ Patent Owner notes that its Preliminary Response “repeats the same reasons and same supporting evidence set forth in Patent Owner’s preliminary response in” the VW IPR. Prelim. Resp. 2–3.

concerns issues solely involving Petitioner, within the time permitted by VW alone and with VW's agreement.

(d) Petitioner will not seek discovery from Patent Owner, unless issues arise that are unique to, and only applicable to, Petitioner.

(e) Petitioner will not rely on expert testimony beyond that submitted by VW unless and until VW is terminated as party to the proceedings, prior to any necessary depositions. While Petitioner's expert, Scott Andrews, is not the same expert as VW's expert, Jianzhong Jiao, Mr. Andres's expert declaration submitted herein is substantively identical to Dr. Jiao's declaration submitted on behalf of VW.

Id. at 5–6. Patent Owner has not filed an opposition to Petitioner's Motion. Thus, Petitioner's Motion stands unopposed.

Under these circumstances, we agree with Petitioner that joinder is appropriate and will not unduly impact the ongoing trial in the VW IPR. We limit Petitioner's participation in the VW IPR proceeding, as follows: (1) VW alone is responsible for all petitioner filings in the proceeding until such time that it is no longer an entity in the proceeding, and (2) Petitioner is bound by all filings by VW in the VW IPR proceeding, except for (a) filings regarding termination or settlement, and (b) filings where Petitioner receives permission to file an independent paper. Petitioner must obtain prior Board authorization to file any paper or take any action on its own in the proceeding, so long as VW remains as a non-terminated petitioner in the proceeding. This arrangement promotes the just and efficient administration of the ongoing trial in the VW IPR and protects the interests of VW as original petitioner in IPR2023-00318 and of Patent Owner.

III. CONCLUSION

For the reasons discussed above, we institute *inter partes* review of the challenged claims of the '551 patent based on the asserted grounds. We *grant* Petitioner's Motion for Joinder and join Petitioner to IPR2023-00318, with the restrictions set forth above.

IV. ORDER

Accordingly, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review of claims 56–87 of the ’551 patent is instituted on the grounds set forth in the Petition;

FURTHER ORDERED that, pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122, Petitioner’s Motion for Joinder is *granted*, and Petitioner is joined as a petitioner to IPR2023-00318, subject to the above-described restrictions on Petitioner’s participation;

FURTHER ORDERED that the asserted grounds of unpatentability on which the Board instituted *inter partes* review in IPR2023-00318 are unchanged and remain the only instituted grounds;

FURTHER ORDERED that the Scheduling Order entered in IPR2023-00318, including any schedule changes agreed by the parties in that proceeding pursuant to the Scheduling Order, shall govern the trial schedule in IPR2023-00318;

FURTHER ORDERED that the case caption in IPR2023-00318 for all further submissions shall be modified to add Porsche Cars North America, Inc., as a named Petitioner, and to indicate by footnote the joinder of Petitioner to that proceeding, as indicated in the attached sample case caption; and

FURTHER ORDERED that a copy of this Decision be entered into the record of IPR2023-00318.

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[Sample Case Caption]

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IPR2023-00318*
Patent 9,955,551 B2

* Porsche Cars North America, Inc., which filed a petition in IPR2023-01296, has been joined as a party to this proceeding.