UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCEDES-BENZ USA, LLC.
Petitioner

v.

NEO WIRELESS, LLC
Patent Owner

Case (to be assigned)
U.S. Patent No. 10,965,512

Filed on behalf of Petitioner:
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I. Statement of Precise Relief Requested

Mercedes-Benz USA LLC ("Petitioner") respectively submits this Motion for Joinder, concurrently with a Petition for *inter partes* review of U.S. Patent No. 10,965,512 (the "'512 patent").

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner moves for joinder with any *inter partes* review that is instituted as to the '512 patent in *Volkswagen Group of America, Inc. v. Neo Wireless, Inc.*, IPR2022-01539 (the "Volkswagen IPR"). Petitioner requests that action on this motion be held in abeyance until, and the motion be granted if, the Volkswagen IPR is instituted. Should the Volkswagen IPR be terminated prior to any institution decision or otherwise not instituted for any reason, Petitioner submits this motion for joinder would be moot, and requests the Board consider Petitioner's *inter partes* review petition on its own merits. This motion is timely because it is being filed before institution of the Volkswagen IPR.

Petitioner requests institution of its Petition for *inter partes* review filed concurrently herewith. The Petition is substantively the same as the Volkswagen IPR petition. It challenges the same claims, on the same grounds, and relies on the same prior art as the Volkswagen IPR petition. Accordingly, no additional burden would be created for the Board, the Volkswagen IPR petitioner, or Patent Owner if

joined. Joinder would therefore lead to an efficient resolution of the invalidity of the '512 patent.

Petitioner agrees to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the Volkswagen IPR if it is instituted. The Petition therefore warrants institution under 35 U.S.C. § 314, and 35 U.S.C. § 315(c) permits Petitioner's joinder to the Volkswagen IPR if it is instituted.

Petitioner stipulates that if joinder is granted, it will act as an "understudy" and will not assume an active role unless the Volkswagen IPR petitioner ceases to participate in the proceeding. The Volkswagen IPR petitioner will maintain the lead role in the proceeding so long as it remains in the proceeding. These limitations will avoid lengthy and duplicative briefing. Petitioner also will not seek additional depositions or deposition time. Accordingly, the proposed joinder will neither unduly complicate the Volkswagen IPR nor delay its schedule.

Joinder will not unduly prejudice any party. Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or increase needless filings, any additional costs on the Patent Owner would be minimal. On the other hand, denial of joinder would prejudice Petitioner. Petitioner's interests may not be adequately protected in the Volkswagen IPR, particularly if the Volkswagen IPR petitioner settles with the Patent Owner. Petitioner should be allowed to join in a proceeding affecting a patent asserted against it.

II. Statement of Reasons for the Relief Requested

A. Legal Standards and Applicable Rules

The Board has discretion to join a properly filed IPR petition to an existing IPR proceeding. See 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); *see also Sony Mobile Commc'ns. AB v. Ancora Techs., Inc.*, IPR2021-00663, Paper 17, at 29-33; *Dell Inc. v. Network-1 Sec. Solutions, Inc.*, IPR2013-00385, Paper 19, at 4-6; *Sony Corp. v. Yissum Res. & Dev. Co. of the Hebrew Univ. of Jerusalem*, IPR2013-00326, Paper 15, at 3-4; *Microsoft Corp. v. Proxyconn, Inc.*, IPR2013-00109, Paper 15, at 3-4.

"The Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations." *Dell*, IPR2013-00385, Paper 19, at 3. The movants bear the burden of proof in establishing entitlement to the requested relief. 37 §§ 42.20(c), 42.122(b). A motion for joinder should:

> (1) set forth the 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.

Dell, IPR2013-00385, Paper 19, at 4.

B. Joinder with the Proceeding Is Appropriate

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 Co.*, IPR2016-00962, Paper No. 12 at 9 (Aug. 24, 2016) (emphasis added) (internal quotations and citations omitted).

Here, in the event the Volkswagen IPR is instituted, joinder is appropriate because the Petition introduces identical unpatentability arguments and the same grounds raised in the Volkswagen IPR petition. In other words, both petitions contain the same grounds based on the same prior art combinations and supporting evidence against the same claims. There are no substantive differences between the Petition and the Volkswagen IPR petition. Petitioner also relies on substantially the same supporting evidence in the Petition as is relied on in the Volkswagen IPR. Because these proceedings introduce identical unpatentability arguments and the same grounds, good cause exists for joinder, so that the Board, consistent with 37 C.F.R. § 42.1(b), can efficiently "secure the just, speedy, and inexpensive resolution" of this proceeding and the Volkswagen IPR.

Moreover, Petitioner notes that the Board has indicated that the factors outlined by *General Plastics* are not particularly relevant here "where a different petitioner files a 'me-too' or 'copycat' petition in conjunction with a timely motion to join." *See, e.g., Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11 at 9-11; *Pfizer, Inc. v Genentech, Inc.*, IPR2017-02063, Paper 25 at 7-8. This is Petitioner's first challenge against the '512 patent at the PTAB, and there is no risk of prejudice or abuse. Rather, through grant of this joinder, the Board is simply

offered the opportunity to ensure that the Volkswagen IPR is not prematurely terminated based on opportunistic settlement or dismissal by Patent Owner with fewer than all parties against which it has asserted the subject patent.

C. Joinder Will Not Add Any New Grounds of Unpatentability or Impact the Trial Schedule

The Petition is based on the same grounds and combinations of prior art in the Volkswagen IPR petition. For simplicity and efficiency, Petitioner has copied the substance of the Volkswagen IPR petition and its accompanying expert declaration. While Petitioner 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. *See Everlight Elecs. Co., v. Document Security Sys., Inc.*, IPR2018-01260, Paper No. 12 at 6-7 (Nov. 14, 2018) (granting motion for joinder where petitioner submitted separate but substantially identical expert declaration); *see also Celltrion*, IPR2018-01019, Paper No. 11 at 14 (same); *Sun Pharm. Indus. Ltd. v. Merck Sharp & Dohme Corp.*, IPR2020-01072, Paper No. 12 at 7 (Sept. 1, 2020) (same).

Petitioner does not seek to introduce grounds or claims not currently in the Volkswagen IPR and seeks only to join the proceeding if and as instituted. Patent Owner should not require any discovery beyond that which it may need in the Volkswagen IPR. The Petition introduces no new substantive issues relative to the

Volkswagen IPR and does not seek to broaden the scope of the Volkswagen IPR. There are no new issues for the Board to address, and Patent Owner will not be required to present any additional responses or arguments.

The Patent Owner's Response, if any, will also not be negatively impacted because the substantive issues presented in the Petition are identical to the issues presented in the Volkswagen IPR. Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in responding to the Volkswagen IPR petition.

Accordingly, joinder with the Volkswagen IPR does not unduly burden or negatively impact the trial schedule.

D. Procedures to Simplify Briefing and Discovery

Petitioner agrees to take an "understudy" role, which will simplify briefing and discovery. Specifically, Petitioner agrees, upon joining the Volkswagen IPR, that the following conditions, as previously approved by the Board in similar circumstances, shall apply so long as the Volkswagen IPR petitioner remains an active party:

a. all filings by Petitioner in the Volkswagen IPR shall be consolidated with the filings of the Volkswagen IPR petitioner, unless a filing concerns issues solely involving Petitioner;

b. Petitioner shall not be permitted to raise any new grounds not instituted by the Board in the Volkswagen IPR, or introduce any argument or discovery not introduced by the Volkswagen IPR petitioner;

c. Petitioner shall be bound by any agreement between Patent Owner and the Volkswagen IPR petitioner concerning discovery and depositions; and

d. Petitioner at deposition shall not receive any direct, cross examination, or redirect time beyond that permitted under either 37 C.F.R. § 42.53 or any agreement between Patent Owner and the Volkswagen IPR petitioner. *See Noven Pharms., Inc. v. Novartis AG*, IPR2014-00550, Paper No. 38 at 5 (Apr. 10, 2015).

Unless and until the Volkswagen IPR petitioner ceases to participate, Petitioner will not assume an active role in the Volkswagen IPR. Petitioner will not rely on expert testimony beyond that submitted by the Volkswagen IPR petitioner unless the Volkswagen IPR petitioner is terminated from the case prior to any necessary depositions. Thus, Petitioner's expert Mr. McNair would not be relied on if the Volkswagen IPR petitioner's expert remains available.

By Petitioner accepting an "understudy" role, the parties can comply with the trial schedule assigned to the Volkswagen IPR without needing any duplicative efforts by the Board or the Patent Owner. These steps minimize the possibility of

any complication or delay from joinder. *See LG*, IPR2015-01353, Paper No. 11 at 6-7 (granting IPR and motion for joinder because "joinder would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board" where petitioners agreed to an "understudy" role). Petitioner is further willing to agree to any other reasonable conditions the Board deems necessary.

III. Conclusion

Joinder will not affect the substance, procedure, or scheduling of the Volkswagen IPR. Petitioner files this motion under the statutory joinder provisions as contemplated by the AIA. Joinder will simplify the issues and promote efficiency, justice, and speed.

For the foregoing reasons, Petitioner respectfully requests *inter partes* review of U.S. Patent No. 10,965,512 and joinder with *Volkswagen Group of America, Inc. v. Neo Wireless, Inc.*, IPR2021-01539 if it is instituted.

Dated: October 19, 2022

Respectfully submitted,

/s/ Celine J. Crowson

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CERTIFICATE OF SERVICE

I certify that on October 19, 2022, a copy of this Petition and supporting documents were served on Patent Owner via Overnight Courier at the following address of record and addresses known to Petitioner as likely to effect service and the address of record for the ’512 patent:

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