UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORD MOTOR COMPANY,
Petitioner,

v.

NEO WIRELESS, LLC,
Patent Owner.

Case IPR2023-00764
Patent US 10,965,512

PATENT OWNER'S RESPONSE TO PETITIONER'S MOTION FOR JOINDER

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I. INTRODUCTION

Patent Owner Neo Wireless, LLC hereby responds to Petitioner Ford Motor Company's ("Ford") Motion For Joinder (Paper 3, "Mot."), which requests joinder of this IPR with IPR2022-01539 filed by Volkswagen Group of America, Inc. ("Volkswagen") and IPR2023-00079 filed by Mercedes-Benz USA, LLC ("Mercedes"). This motion is timely under 37 C.F.R. § 42.25(a)(1).

"Joinder may be authorized when warranted, but the decision to grant joinder is discretionary." *Sony Corp. of Am. v. Network-1 Security Sols., Inc.*, IPR2013-00386, Paper 16, 3 (July 29, 2013). As moving party, Ford has the burden to establish entitlement to relief. 37 C.F.R. §§ 42.20(c), 42.122(b).[1]

If the Board institutes review in this case, joinder should only be granted with additional conditions limiting Ford's participation as joined understudy petitioner, such as those the Board has imposed in other cases, to reduce the inarguable burden the requested joinder will create in these speedy proceedings.

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[1] The Motion is moot if review of Ford's, or Mercedes's and Volkswagen's Petitions, are denied. *See Synaptics Inc. v. Amkor Tech., Inc.*, IPR2017-00085, Paper 12, 11 (Apr. 18, 2017). This Response assumes, *arguendo*, institution of both petitions.

Ford concedes that measures limiting its joined participation are appropriate, and pre-emptively "agrees" to several such limits. Mot., 2, 9-10. The Board should, however, grant joinder, if at all, only with further limits.

Ford has said it "will remain in the understudy role" until the target IPR petitioner is no longer a party in the proceeding. Mot., 2. But what does this mean? The Board has stated that "an 'understudy role' means that [the petitioner seeking joinder] would not make any substantive filing," not make "oral hearing presentations," "not seek to take cross-examination testimony of any witness or have a role in defending the cross-examination of a witness beyond mere observation," not seek "other discovery," and, absent termination of the initial petitioner "before the proceeding is complete," "remain completely inactive as the understudy with the exception being ministerial issues specifically directed to [the petitioner seeking joinder] (e.g., an update to [petitioner's] Mandatory Notices or Powers of Attorney)." *MSN Labs. Private Ltd. v. Bausch Health Ireland Ltd.*, IPR2023-00016, Paper 12, 3-4 (Nov. 29, 2022). Patent Owner agrees with this understanding of the understudy role. The Board here should make this explicit. In other words, Patent Owner requests that the Board in fact hold Ford to a silent understudy role. Unless the promised "understudy role" is expressly clarified as discussed below, Patent Owner respectfully opposes granting the subject joinder request.

At the very least, Patent Owner respectfully submits that the Board should grant joinder only on the further conditions:

(1) That Ford be denied any right to participate in the joined proceeding, including filing papers, engaging in discovery, or participate in depositions and oral argument, jointly or otherwise, without first obtaining authorization from the Board; and

(2) That Ford's exhibits, including its separate expert declaration (Ex. 1035), not be added to the record of this case, and that Ford have no right as understudy petitioner to submit any separate exhibits or other materials.

In the absence of clarity on what the "understudy" role does and does not entail, granting joinder would create undefined and unacceptable risks of making the original case, if instituted, substantially more complicated, expensive, and unfair.

II. FORD SHOULD NOT BE JOINED WITH ANY RIGHTS TO TAKE ACTIONS WITHOUT PRIOR BOARD AUTHORIZATION.

In accordance with past proceedings, including those cited below, the Board should grant Ford's joinder request only if Ford is given no right thereby to participate, as a joined party, without express prior Board authorization.

Ford pledges that if joined it will submit no separate arguments—essentially, to act as an understudy to Mercedes and Volkswagen—because it "fully adopted"

Volkswagen and Mercedes's "arguments, art, and evidence." Mot., 8. There is no apparent reason why Ford, as joined understudy petitioner, should be given any right to take any action in the proceedings whatsoever without prior express Board permission.

Moreover, as further explained *infra* § III, while Ford has "agreed" to let either Volkswagen or Mercedes take the "lead" (Mot., 2), Ford presents no proof that either Mercedes or Volkswagen agrees to the limitations Ford says Mercedes and Volkswagen will follow, instead simply saying that "they do not oppose joinder" (Mot., 3), and furthermore, has not promised not to submit its own separate evidence. Indeed, Ford has already begun to submit its own separate evidence, including separate witness testimony, and, if joinder were granted, may continue to separately proffer still more. Furthermore, Ford itself admits that its Petition is not fully identical to Volkswagen's, stating that Ford's "discussion of *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 11, 2020)" is not identical. Mot., 2.

In similar factual circumstances in past proceedings, where joinder has not been denied altogether, the Board has addressed the concerns above by imposing just such restrictions on joinder petitioners—*i.e.*, allowing joinder only on condition that the joining petitioner has no right to participate or submit any materials or arguments without express permission from the Board.

For example, in *GlobalFoundries U.S. Inc. v. Godo Kaisha IP Bridge I*, IPR2017-00919, the petitioner seeking joinder made promises essentially similar to Ford's. There, the petitioner promised that, if joinder were granted, it would stay "in a circumscribed 'understudy' role without a separate opportunity to actively participate," and "w[ould] not file additional written submissions, nor . . . pose questions at depositions or argue at oral hearing without permission of" the first petitioner. *Id.*, Paper 12, 8-9 (June 9, 2017). The Board "agree[d] with Patent Owner, though, that given its 'understudy' role, Petitioner should be permitted to file papers, engage in discovery, and participate in depositions and oral argument ***only after obtaining authorization from the Board***, not [the first petitioner]." *Id.*, 9.[2] The Board therefore granted the petitioner's motion for joinder in that case only on the condition that the petitioner was given no right to participate in the joined proceedings at all, and would have to contact the Board to request permission before taking any action. *See id.*

For another example, in *Taiwan Semiconductor Manufacturing Co. Ltd. v. Arbor Global Strategies LLC*, IPR2021-00738, the petitioner seeking joinder stated it was "willing to accept a limited, 'understudy role'" and submitted conditions of such a role, one of which would give the petitioner in the target IPR "full control over all … filings unless a filing solely concerns issues that do not involve [the

[2] All emphasis is added unless stated otherwise.

target IPR petitioner]." *Id.*, Paper 9, 9 (June 14, 2021). Such a condition would have permitted the joining petitioner to make certain filings without prior Board authorization. The Board rejected the petitioner's terms. Instead, the Board granted joinder only under more restrictive terms like those Patent Owner requests here—ordering that "(1) [the target IPR petitioner] 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 [the target IPR petitioner] in the proceeding," further stating that "Petitioner ***must obtain prior Board authorization to file any paper or take any action on its own in the proceeding***, so long as [the target IPR petitioner] remains as a non-terminated petitioner in the proceeding." *Id.*, 10. Thus, just like in *Global Foundries*, the joining petitioner was barred from any substantive filings without obtaining Board permission in advance.

For yet another example, in *Splunk Inc. v. Sable Networks, Inc.*, IPR2022-00228, the Board permitted joinder, limiting the "Petitioner's participation in the [target] IPR, such that … (2) Petitioner ***must obtain Board authorization prior to filing any paper or exhibit or taking any action on its own*** until [the target IPR petitioner] is terminated from the [target] IPR." *Id.*, Paper 9, 7 (Apr. 4, 2022). The Board stated that it was "persuaded that, ***with the appropriate conditions***, Petitioner's joinder will have minimal impact on the [target] IPR," where the

"appropriate conditions" required, among other things, that authorization be given by the Board prior to the joining petitioner "taking any action on its own" or filing anything in the target IPR. *Id.*, 6. For similar reasons, such a condition should be imposed on Ford here as well.

Ford has no more justification to a greater right to participate in this case than the petitioners in *GlobalFoundries*, *Taiwan Semiconductor*, *Splunk*, and *MSN Laboratories* , and if joinder were to be granted here, the same condition requiring Board authorization for any involvement should be imposed. Thus, the Board should not grant Ford joinder except if Ford is, *inter alia*, limited to the role of a silent understudy, with no right to file papers, engage in discovery, or participate in depositions and oral argument without first obtaining authorization from the Board.

III. FORD SHOULD BE PROHIBITED FROM OFFERING ITS OWN SEPARATE EVIDENCE.

Aside from other restrictions the Board places on Ford, if its joinder request to Volkswagen's or Mercedes' cases are granted, then Ford's exhibits in this case, including its separate witness declaration, should not become exhibits in Volkswagen's or Mercedes' cases, and Ford should be granted no right to file any exhibits in the joined case.

Ford pledges that if joined, it will refrain from certain independent action. Ford states that it will "allow[] Volkswagen or Mercedes (whichever is in the

proceeding) to lead the joined proceedings absent settlement or termination for any reason" (Mot., 2) and that "Ford's counsel will be present only to observe and to answer any questions pertaining specifically to Ford as the joining party, should any such questions arise." Mot., 9. However, Ford does ***not*** agree to not file separate exhibits.[3] Indeed, Ford has already begun to file separate exhibits, including an expert declaration signed by Mr. Todor Cooklev, whose testimony does not appear as an exhibit in the Volkswagen or Mercedes IPRs. Ex. 1035.

Allowing Ford to add its own separate, different evidence, such as Mr. Cooklev's declaration, to the record would be in tension with the rules governing *inter partes* reviews, designed "to secure the just, speedy, and inexpensive resolution of every proceeding." 37 C.F.R. § 42.1(b). Ford's separately filed exhibits, including the Cooklev declaration, should be required to be withdrawn and should not become part of the record of the joined proceedings.

To be sure, Ford conditionally agrees to "allow[] Volkswagen or Mercedes (whichever is in the proceeding) to lead the joined proceedings absent settlement or termination for any reason" (Mot., 2) and that "Ford's counsel will be present

[3] Or, for that matter, to not serve ***proposed*** exhibits. *Compare, e.g., Johns Manville Corp. v. Knauf Insulation, Inc.*, IPR2015-01453, Papers 16, 35, 36 (PTAB Mar. 14, Jun. 27, & Jul. 26, 2016) (Board had to rule on two subpoena requests because party served supplemental information, including testimony).

only to observe and to answer any questions pertaining specifically to Ford as the joining party, should any such questions arise." Mot., 9. Ford vaguely suggests that it is "further willing to agree to any other reasonable conditions." Mot., 10. But Ford has not limited itself, or Mercedes or Volkswagen, from presenting different arguments with respect to Ford's separate witness, simply stating that "Ford will rely on its own expert's declaration only if Volkswagen and Mercedes are not parties to this IPR." Mot., 8 n. 2. Ford's Motion therefore appears to leave open the possibility, absent Board direction to the contrary, that Ford will insert itself into the proceedings whenever it unilaterally determines any question raised to be one "pertaining to Ford," to submit its own separate evidence whenever it unilaterally deems doing so to be appropriate, and to not follow any conditions on its participation that it unilaterally deems not reasonable.

In other proceedings, the Board has granted joinder only on the condition that the joined petitioner use the witness declaration of the existing party, and indeed that, if it has filed a declaration, that the declaration be withdrawn. *Compare, e.g.*, *Mylan Pharms. Inc. v. Janssen Oncology, Inc.*, IPR2016-01332, Paper 21, 9-11 (Jan. 10, 2017) (denying joinder largely because of different experts); *Argentum Pharma. LLC v. Janssen Oncology Inc.*, IPR2016-01317, Paper 9, 9 (Sep. 19, 2016) (requiring joining petitioner to withdraw declaration of its expert and rely solely on declaration testimony of first petitioner's expert); *Sony*,

IPR2013-00386, Paper 16, 7 (denying joinder because, *inter alia*, "Petitioners also include with their Petition a declaration from [a new expert declarant], which likely would increase the amount of discovery (e.g., depositions) that would be required if joinder is permitted.") (citation omitted). Ford's joinder request, if granted at all, should be granted only on, *inter alia*, this condition.

As for Ford's remaining exhibits (Ex. 1001 to Ex. 1034), they appear identical to exhibits Volkswagen has previously filed. The rules generally deny parties the right to the filing of duplicative exhibits without express Board authorization. *See* 37 C.F.R. § 42.6(d) ("A document already in the record of the proceeding must not be filed again, not even as an exhibit or an appendix, without express Board authorization."). These exhibits, too, should not be part of the target proceeding.

IV. CONCLUSION

For the reasons given above, Patent Owner respectfully urges that joinder not be granted on the basis of Ford's pledge of understudy status, in the absence of clarity as to what that status means, and Patent Owner respectfully submits that, if Ford's petition is instituted, joinder should be granted only with the conditions described above.

Respectfully submitted,

____/ Kenneth Weatherwax /_____

Kenneth J. Weatherwax, Reg. No. 54,528

Date: April 28, 2023 Lowenstein & Weatherwax LLP

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following documents were served on the date below and to the addresses listed below:

PATENT OWNER'S RESPONSE TO PETITIONER'S MOTION FOR JOINDER

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