Filed on behalf of: Ford Motor Company

Entered: March 28, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORD MOTOR COMPANY,
Petitioner,

v.

NEO WIRELESS, LLC,
Patent Owner.

Case Unassigned
U.S. Patent No. 10,833,908

CONDITIONAL MOTION FOR JOINDER
UNDER 35 U.S.C. § 315(c),
37 C.F.R. §§ 42.22, AND 42.122(b)

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I. STATEMENT OF PRECISE RELIEF REQUESTED

Ford Motor Company ("Ford") submits this Conditional Motion for Joinder ("Motion") concurrently with a "copycat" petition for *inter partes* review (IPR) ("Petition") of U.S. Patent No. 10,833,908 ("the '908 patent") (Ex. 1001), under 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b).

At present, one other IPR challenging the '908 patent has been filed: IPR2023-00086, *Volkswagen Group of America, Inc. v. Neo Wireless LLC*, filed October 28, 2022 (the "Volkswagen IPR").

Ford's IPR was filed after the Volkswagen IPR. Accordingly, Ford respectfully requests that the Board hold Ford's Motion in abeyance until the Board has decided whether to institute the Volkswagen IPR or it has been terminated, whichever comes first.

Ford seeks party joinder to the Volkswagen IPR if the Volkswagen IPR has been instituted and is still pending when the Board reaches this Motion. As will be discussed below, Ford will remain in the understudy role as long as Volkswagen remains as a party in the proceeding.

If the Volkswagen IPR is not pending when the Board reaches Ford's Motion and Petition, this Motion is moot and Ford asks the Board to consider the Petition on its merits.

Joinder will efficiently resolve the challenges presented in the Petition and the Volkswagen IPR and will not prejudice the patent owner or first-petitioner Volkswagen. The Petition is a typical "copycat" petition. The grounds presented in the Petition are identical to those in the Volkswagen IPR. Ford's Petition is substantively identical to the Volkswagen Petition—in fact, it is a verbatim copy of Volkswagen's Petition, with the exception of administrative portions (e.g., mandatory notices, petitioner and counsel identity, etc.) and the discussion of *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 11, 2020).

Moreover, if the Board grants this Motion, Petitioner agrees to act as an "understudy," following the common PTAB practice by allowing Volkswagen to lead the joined proceedings absent settlement or termination for any reason.

Lead petitioner Volkswagen has stated to Petitioner that it does not oppose joinder.

II. BACKGROUND AND RELATED PROCEEDINGS

The '908 patent is assigned on its face to Neo Wireless LLC ("Patent Owner"). Patent Owner has asserted the '908 patent against Petitioner and numerous other parties. The '908 patent is the subject of the following civil actions: *Neo Wireless LLC v. Dell Technologies Inc.*, No. 6:21-cv-00024 (W.D. Tex), filed January 12, 2021; *Neo Wireless LLC v. Dell Technologies Inc.*, No. 1:22-cv-00060 (W.D. Tex.), filed January 12, 2021; *Neo Wireless LLC v. LG Electronics Inc.*, No. 6:21-cv-00025

(W.D. Tex.), filed January 13, 2021; *Neo Wireless LLC v. Apple Inc.*, No. 6:21-cv-00026 (W.D. Tex.), filed January 13, 2021; *Neo Wireless, LLC v. Ford Motor Company*, No. 4:22-cv-00210 (W.D. Mo.), filed March 29, 2022; *Neo Wireless, LLC v. American Honda Motor Co., Inc.*, No. 2:22-cv-01824 (S.D. Ohio), filed March 29, 2022; *NEO Wireless, LLC v. Nissan North America Inc.*, No. 3:22-cv-00220 (M.D. Tenn.), filed March 29, 2022; *Neo Wireless LLC v. Toyota Motor North America, Inc.*, No. 2:22-cv-00093 (E.D. Tex.), filed March 29, 2022; *Neo Wireless LLC v. General Motors Company*, No. 2:22-cv-00094 (E.D. Tex.), filed March 29, 2022; *Neo Wireless LLC v. Tesla, Inc.*, No. 2:22-cv-00095 (E.D. Tex.), filed March 29, 2022; *Neo Wireless, LLC v. Volkswagen Group of America, Inc.*, No. 1:22- cv-00076 (E.D. Tenn.), filed March 29, 2022; *In re Neo Wireless, LLC Patent Litigation*, No. 2:22-md-03034 (E.D. Mich.), filed June 23, 2022; *Neo Wireless, LLC v. Ford Motor Company*, No. 2:22-cv-11402 (E.D. Mich.), filed June 27, 2022; *Neo Wireless, LLC v. American Honda Motor Co., Inc.*, No. 2:22-cv-11403 (E.D. Mich.), filed June 27, 2022; *Neo Wireless, LLC v. Volkswagen Group of America, Inc.*, No. 2:22-cv-11404 (E.D. Mich), filed June 28, 2022; *Neo Wireless, LLC v. Nissan North America Inc.*, No. 2:22-cv-11405 (E.D. Mich), filed June 29, 2022; *Neo Wireless LLC v. Toyota Motor North America, Inc.*, No. 2:22-cv-11406 (E.D. Mich), filed June 28, 2022; *Neo Wireless LLC v. General Motors Company*, No. 2:22-cv-11407 (E.D. Mich.), filed June 28, 2022; *Neo*

Wireless LLC v. Tesla Inc., No. 2:22-cv-11408 (E.D. Mich), filed June 28, 2022; *Neo Wireless, LLC v. FCA US LLC*, No. 3:22-cv-01252 (N.D. Ohio), filed July 15, 2022; *Neo Wireless, LLC v. Mercedes-Benz USA, LLC*, No. 3:22-cv-00780 (M.D. Fla), filed July 15, 2022.

In addition, the Volkswagen IPR (also challenging the '908 patent) is currently in the pre-institution phase.

III. 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 (June 10, 2021); *Dell Inc. v. Network-1 Sec. Sols., Inc.*, IPR2013-00385, Paper 17 at 4-6 (July 29, 2013); *Sony Corp. v. Yissum Res. & Dev. Co. of the Hebrew Univ. of Jerusalem*, IPR2013-00326, Paper 15 at 3-7 (Sept. 24, 2013); *Microsoft Corp. v. Proxyconn, Inc.*, IPR2013-00109, Paper 15 at 3-5 (Feb. 25, 2013).

"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 17 at 3. 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.

Id. at 4 (citing *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (Apr. 24, 2013)).

B. Joinder with the Volkswagen IPR 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. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (Aug. 24, 2016) (internal quotations marks omitted). Here, joinder is appropriate because there are no substantive differences between the Petition and the Volkswagen IPR. Both petitions have identical unpatentability arguments, grounds and supporting evidence, and challenge the same claims.

When, as here, the petitions are identical, joinder should be granted as a matter of right. *See* 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) ("The Office anticipates that joinder will be allowed as of right—if an inter partes review is instituted on the basis of a petition, for example, a party that files an identical petition will be joined to that proceeding, and thus allowed to file its own briefs and make its own arguments.")

Further, Ford may be prejudiced if it is not permitted to join the IPR. Patent Owner has asserted the '908 patent against Ford in pending litigation. *See supra* Related Proceedings. Ford should be permitted to join the IPR to participate in proceedings affecting a patent asserted against it, and thereby allowed to continue the proceedings should Volkswagen settle under 37 C.F.R. § 42.74 before a final written decision is issued. *See Lowes Cos. Inc. v. Nichia Corp.*, IPR2017-02011, Paper 13 at 19 (Mar. 12, 2018) ("[d]enial of the Petition in part would prejudice the Petitioner in this proceeding should the Vizio Petitions be resolved by settlement").

In addition, permitting Ford to join this proceeding helps ensure that the patentability of the challenged claims will ultimately be decided by the Board, efficiently protecting the public and providing the patent owner with predictable and reliable expectations regarding its patent rights.

Thus, this factor favors joinder.[1]

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[1] The factors outlined by *General Plastic Industries Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (Sept. 6, 2017), 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 (Oct. 30, 2018); *Pfizer, Inc. v Genentech, Inc.*, IPR2017-02063, Paper 25 at 7-8 (Feb. 21, 2018).

C. Joinder Will Not Add Any New Grounds or Issues

The Petition does not include any new grounds of unpatentability. In fact, the Petition and its accompanying expert declaration are substantively identical to the Volkswagen IPR and its accompanying expert declaration.[2] *See Everlight Elecs. Co.*

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[2] Ford submitted two technical expert declarations with its Petition. The first one (Ex. 1003) is a copy of Volkswagen's declaration from Dr. Cimini. Although Volkswagen did not object to Ford copying and joining its IPR, Volkswagen refused to allow Ford to retain Volkswagen's expert solely for the purpose of this "copycat" IPR. Accordingly, Ford retained its own technical expert, Dr. Cooklev. Dr. Cooklev has reviewed and adopted Dr. Cimini's testimony as his own. Dr. Cooklev's declaration is a verbatim copy of Volkswagen's declaration from Dr. Cimini with the exception of the expert's qualifications and personal information. Similarly, Ford submitted a declaration from a librarian (Dr. Hsieh-Yee), in addition to a copy of Volkswagen's declaration from Dr. Hall-Ellis (Ex. 1005). Both of these librarian declarations address Gibson's and Kaiser's public availability—a simple factual issue, especially here where Gibson is a readily available treatise/textbook, and Kaiser is a readily available IEEE publication. As discussed, Ford will rely on its own declarations only if Volkswagen is not party to

v. Document Sec. Sys., Inc., IPR2018-01260, Paper 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 11 at 14 (same); *Sun Pharm. Indus. Ltd. v. Merck Sharp & Dohme Corp.*, IPR2020-01072, Paper 12 at 7 (Sept. 1, 2020) (same). Therefore, this factor weighs in favor of joinder.

D. Joinder Will Not Impact the Trial Schedule

Joinder will not impact the trial schedule because Ford does not seek to introduce any new grounds or challenge any new claims. Moreover, Patent Owner will not require any discovery beyond what it will need in the previously filed IPR. Because Ford fully adopted Volkswagen's patentability arguments, art, and evidence, and because Ford will remain in the understudy role so long as Volkswagen remains in the proceeding, joining Ford will not affect the trial schedule.

Accordingly, this factor also favors joinder.

E. Briefing and Discovery Will Be Simplified

Joining Ford should not require any additional briefing or discovery. Ford's Petition adds no new issues whatsoever. Further, Ford agrees to take an understudy

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this IPR, i.e., if Ford must shed its understudy role before Volkswagen's experts have been deposed.

role, which will simplify briefing and discovery. Volkswagen's lead counsel will act as the lead counsel so long as Volkswagen remains in the proceeding. Likewise Volkswagen's counsel will submit all briefs, and take and defend all depositions, take the lead for petitioners on any conference calls, and will argue the case before the Board, so long as Volkswagen remains in the proceeding. So long as Volkswagen remains in the proceeding, 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.

By Petitioner accepting an "understudy" role, the parties can comply with the trial schedule assigned to the Volkswagen IPR without any duplicative efforts by the Board or the Patent Owner. *See Sony Corp. v. Memory Integrity, LLC*, IPR2015-01353, Paper 11 at 6-9 (Oct. 5, 2015) (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. Therefore, this final factor also weighs in favor of joinder.

F. Further Preconditions

In opposing a similar joinder motion filed by Mercedes, Patent Owner argues that several preconditions should be met prior to joinder. *See Mercedes-Benz USA,*

LLC. v. Neo Wireless LLC, IPR2023-00079, Paper 7 at 2 (Jan. 20, 2023). Patent Owner argues that Mercedes be denied any right to participate in the joined proceeding without authorization from the Board, that Mercedes' exhibits, including its expert declaration, be excluded from the record, and that Volkswagen be shown to have accepted Mercedes' understudy role in the joined proceeding. *Id*. If Patent Owner makes the same arguments here, Ford agrees with them only to the extent the Board deems them necessary for joinder.

Ford has agreed to assume and remain in the understudy role unless Volkswagen is not participating in the joined proceedings. And as explained earlier, Ford will rely on the testimony of each of its declarants (Dr. Cooklev and Dr. Hsieh Yee) if, and only if, Ford is thrust from its position as an understudy because Volkswagen is not participating in the joined proceedings and Volkswagen's corresponding declarant(s) have not yet been deposed and the time to take their depositions has not expired.

To be sure, the Board regularly permits joinder of petitioners who rely on different declarants when, as is the case here, the joining petitioner's expert presents the same opinions as in the earlier-filed IPR. *See, e.g.*, *Everlight Elecs. Co. v. Document Sec. Sys., Inc.*, IPR2018-01225, Paper 14 at 5-9 (Sept. 27, 2018); *see also Pfizer Inc. v. Sanofi-Aventis Deutschland GmbH*, IPR2019-00981, Paper 12 at 4-7

(Aug. 15, 2019); *Microsoft Corp. v. Koninklijke Philips N.V.*, IPR2017-01754, Paper 16 at 6, 13-16 (Nov. 29, 2017).

Consistent with such cases, Ford agrees to rely entirely on, and be bound by, the declarations and depositions of Volkswagen's declarants (Dr. Cimini and Dr. Hall-Ellis) in the joined IPR, so long as Volkswagen remains a party until its experts are deposed. *See Everlight Elecs.*, IPR2018-01225, Paper 14 at 6. And if Volkswagen is not a party in the IPR, Petitioner will rely on Dr. Cooklev's substantively identical declaration and the Patent Owner can depose Dr. Cooklev. Similarly, in that scenario, Petitioner will rely on Dr. Hsieh-Yee's librarian declaration and Patent Owner can also depose Dr. Hsieh-Yee. Joinder accordingly presents no risk of duplicative declarations, depositions, or other evidence.

IV. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests institution of IPR proceedings based on its Petition and joinder with any proceeding instituted based on the Volkswagen IPR.

Respectfully submitted,

Dated: March 28, 2023

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CERTIFICATE OF SERVICE

The undersigned certifies that a true and complete copy of **Conditional Motion For Joinder Under 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22, and 42.122(b)** was served on the official correspondence address for the patent shown in Patent Center:

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