UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORD MOTOR COMPANY
Petitioner,

v.

NEO WIRELESS, LLC
Patent Owner.

U.S. Patent No. 10,075,941

IPR Case No.: 2023-00766

PETITIONER'S REPLY IN SUPPORT OF PETITIONER'S MOTION FOR JOINDER

Petitioner moved pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) for joinder with any *inter partes* review that is instituted as to U.S. Patent No. 10,075,941 (the "'941 patent") in *Volkswagen Group of America, Inc. v. Neo Wireless, LLC*, No. IPR2022-01537 (the "Volkswagen IPR"). (Paper 3 ("Motion").) Neo Wireless, LLC ("Patent Owner") filed a Patent Owner's Response to Petitioner's Motion for Joinder, in which it does not oppose but instead seeks multiple unnecessary conditions on such joinder. (Paper 7 ("Response").) Instead of a substantive opposition, Patent Owner argues that joinder should only be granted on the following conditions: 1) Petitioner should be denied *any* right to participate in the joined proceeding, and 2) Petitioner's exhibits, including its expert declaration, should be excluded from the record. (Response at 3.)

For the reasons herein and in Petitioner's Motion, Petitioner's Motion for Joinder should be granted, without imposing Patent's Owner's unnecessary conditions.

First, the Response fails to appropriately consider Petitioner's express statements that it, if joined, would take an inactive understudy role. Petitioner being joined as an inactive understudy would not present any additional burden on the Patent Owner. (Motion at 2.) As described in Petitioner's Motion, the grounds presented here by Petitioner are the same as the grounds presented in the Volkswagen IPR, and Petitioner will have no substantive role in that proceeding

unless the petitioner in the Volkswagen IPR ceases its own participation. (Motion at 5 and 7-8.)

Second, Patent Owner's supposed "further conditions," are essentially duplicative of the restrictions that Petitioner already proposes on its participation in the Volkswagen IPR and thus are unnecessary. Petitioner's Motion makes clear that, if joined, it will not raise new grounds or introduce its own arguments or discovery and that it will not submit any filing unless the filing solely involves Petitioner. These restrictions are adequate to eliminate the chance of duplicative briefing and any additional burden in the Volkswagen IPR. *See, e.g.*, *Mercedes-Benz Grp. AG v. Arigna Tech. Ltd.*, No. IPR2022-00776, Paper 8, 11 (P.T.A.B.).

And although Patent Owner urges that Petitioner be compelled to withdraw the declaration of Dr. Cooklev, that would be inappropriate and premature at this stage. The cases relied upon by Patent Owner involve situations where joining petitioners sought to introduce expert declarations with *new* or additional arguments or otherwise did not agree to rely solely on the declaration of first petitioner's expert, and are inapplicable here. (Response at 9.) As explained in the Petitioner's Motion, the Board regularly permits joinder of petitioners who relied on different declarants, when, as is the case here, the joining petitioner's expert presents the same opinions as the earlier-filed IPR. (Motion at 10–11.) Consistent with such cases, Petitioner previously agreed to rely entirely on, and be bound by, the expert declaration and

deposition of Dr. Wilson and the librarian declaration of Ms. Fields in the Volkswagen IPR, assuming that the Volkswagen IPR petitioner does not terminate its IPR before they are deposed. *See Everlight Elecs.*, No. IPR2018-01225, Paper 14, at 6. (Motion at 11.) Petitioner also previously agreed that if the Volkswagen Petitioner terminates its IPR before Dr. Wilson is deposed, Petitioner will rely on Dr. Cooklev's substantively identical declaration and the Patent Owner can depose Dr. Cooklev. (*Id.*) Joinder accordingly presents no risk of duplicative declarations, depositions, or other evidence.

In a related IPR, the Board has already considered the same extra conditions sought by Patent Owner here and found them "not necessary" in view of the conditions that the petitioner, Mercedes, had voluntarily agreed to. (*Mercedes-Benz USA, LLC*, *v. Neo Wireless, LLC*, No. IPR2023-00079 ("Mercedes IPR"), Paper 11 at 13 (P.T.A.B)). Ford's self-imposed conditions are the ***same*** conditions the Board found sufficient in the Mercedes IPR. *See* Mercedes IPR, Paper 11 at 13 ("Petitioner challenges the same claims that are challenged in the Volkswagen IPR on the same grounds using the same prior art and evidence. Petitioner explicitly agrees that it will take an "understudy role" in the Volkswagen IPR, and has shown that the trial schedule will not be affected at all by joinder.") As such, the Board should reject Patent Owner's additional conditions for joinder for the same reasons it did in the Mercedes IPR and the reason presented above.

For the foregoing reasons, and the reasons provided in Petitioner's Motion, Petitioner respectfully requests *inter partes* review of U.S. Patent No. 10,075,941 and joinder with *Volkswagen Group of America, Inc. v. Neo Wireless, LLC*, No. IPR2022-01537, now instituted.

Respectfully submitted,

Dated: May 24, 2023

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 24th day of May, 2023, a true and correct copy of the foregoing **Petitioner's Reply in Support Petitioner's Motion for Joinder** was served by electronic mail on Patent Owner's lead and back-up counsel at the following email addresses:

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