

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AMERICAN HONDA MOTOR CO., INC.,  
Petitioner,

v.

NEO WIRELESS, LLC,  
Patent Owner.

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IPR2023-00791  
Patent No. 10,075,941

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

## **I. STATEMENT OF PRECISE RELIEF REQUESTED**

American Honda Motor Co., Inc. (“Honda”) respectfully submits this Motion for Joinder, concurrently with a Petition (“Honda Petition”) for *inter partes* review of U.S. Patent No. 10,075,941 (“the ‘941 Patent”).

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b), Honda requests institution of an *inter partes* review and joinder with IPR2022-01537 (*Volkswagen Group of America, Inc. v. Neo Wireless LLC* “Volkswagen IPR”), institution expected by May 15, 2023. Honda’s 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 and therefore would create no additional burden for the Board, the Volkswagen IPR Petitioner, or Patent Owner if joined. Joinder would therefore lead to an efficient resolution of the validity of the ‘941 patent.

Honda is currently named as a defendant in *Neo Wireless, LLC v. American Honda Motor Co., Inc., et al.* in the Southern District of Ohio, Civil Action No. 2:22-cv-11403 (S.D. Ohio) (now centralized in a multidistrict litigation in the Eastern District of Michigan, *In re Neo Wireless, LLC Patent Litigation*, Civil Action No. 2:22-md-03034 (E.D. Mich.)). Honda has been accused of infringing the ‘941 patent. Honda has not previously filed a petition for IPR challenging the validity of the ‘941 patent.

Honda 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. Honda also will not seek additional depositions or deposition time. Joinder will not impact the trial schedule because it has not yet been instituted.

In fact, joinder will help efficiently resolve the disputes among the parties. By joinder, a single Board decision may dispose of the issues raised in the Volkswagen IPR for all interested parties.

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

Given the similarities of the proceedings, the lack of undue prejudice to Patent Owner, and the potential benefit to the public and to the Board that would accrue by Honda’s cooperative participation in the Volkswagen IPR in the event that the

Volkswagen IPR Petitioner's participation terminates, the Board should institute IPR and grant Honda's Motion for Joinder.

## **II. ARGUMENT**

### **A. Legal Standards and Applicable Rules**

A petitioner may request joinder, without prior authorization, up to one month after the institution date of the proceeding to which joinder is requested. 37 C.F.R. § 42.122(b); *Taiwan Semiconductor Mfg. Co., Ltd. v. Zond LLC*, IPR2014-00781 and IPR2014-00782, Paper 5 at 3 (PTAB May 29, 2014).

The Board has discretion to grant a motion for joinder of a petitioner for *inter partes* review to another *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). In determining whether to exercise its discretion to grant a motion for joinder, the Board considers: (1) reasons why joinder is appropriate; (2) any new grounds of unpatentability asserted in the petition; (3) what impact (if any) joinder would have on the trial schedule for the existing review; and (4) specifically how briefing and discovery may be simplified. *See Dell, Inc. v. Network-I Security Solutions, Inc.*, IPR2013-00385, Paper 17 at 3 (July 29, 2013).

### **B. Honda's Motion for Joinder is Timely**

Joinder may be requested "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). The Volkswagen IPR is expected to be instituted on or before May 15,

2023. IPR2022-01537. Honda's current motion is timely as it is being filed prior to institution.

**C. The Four Factors Favor Joinder**

Each of the four factors weighs in favor of granting Honda's Motion for Joinder. Honda's Petition is substantively identical to the petition in the Volkswagen IPR; it presents no new grounds of unpatentability. Joinder will have no impact on the pending schedule of the Volkswagen IPR. Moreover, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

**1. Joinder of Honda Is Appropriate Because It Will Promote an Efficient Determination of the Validity of the '941 Patent Without Prejudice to Any Party**

Honda seeks to join the Volkswagen IPR in order to ensure that an accused infringer with an active interest in the proceeding remains a party to this IPR if the Volkswagen IPR Petitioner's participation is terminated prior to completion. Thus, joining Honda to the Volkswagen IPR is the most practical way to secure the just, speedy, and inexpensive resolution of the challenge to the '941 patent. *See* 37 C.F.R. § 42.1(b).

If Honda is joined as a party, the validity of the grounds raised in the Volkswagen IPR can be determined in a single proceeding. Joinder is also appropriate because Honda's petition challenges the validity of the same claims of the '941 patent on identical grounds to those in the Volkswagen IPR. There are

no substantive differences between Honda's and the Volkswagen IPR Petitioner's Petition, IPR2022-01537, Paper 1 (September 15, 2022). Honda also relies on substantially the same supporting evidence in its Petition as is relied on in the Volkswagen IPR.<sup>1</sup> A consolidated proceeding, including Honda and the Volkswagen IPR Petitioner, will therefore be more efficient and less wasteful, as only a single trial on these common grounds would be required. *See, e.g., Oracle America Inc. v. Realtime Data LLC*, IPR2016-01672, Paper 13 at 7 (PTAB Mar. 7, 2017) (noting that "joining Oracle's identical challenges to those in the 1002 IPR will lead to greater efficiency while reducing the resources necessary from both Realtime and the Board"). 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*

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<sup>1</sup> The supporting expert declaration of Dr. R. Michael Buehrer submitted by Honda agrees with the facts, analysis, and conclusions of the expert declaration in the Volkswagen IPR. The declaration of Dr. Buehrer 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).

*Co.*, IPR2016-00962, Paper 12 at 9 (PTAB Aug. 24, 2016) (internal quotations and citations omitted).

Joining Honda as a party to the Volkswagen IPR would promote the public interest relating to the unpatentability of the ‘941 patent and not cause any undue prejudice to Patent Owner or the Volkswagen IPR Petitioner. The Patent Owner must respond to the common invalidity grounds identified in the Volkswagen and Honda’s Petitions regardless of joinder.

**2. Honda’s Petition Does Not Raise Any New Grounds of Unpatentability and Therefore Does Not Add Additional Complexity to the Grounds in the Volkswagen IPR Petitioner’s Petition**

Honda’s Petition challenges the validity of the ‘941 patent on identical grounds to those in the Volkswagen IPR. *See* IPR2022-01537, Paper 1 (September 15, 2022). Honda’s supporting materials—including its supporting expert declaration, exhibits, and exhibit numbering—are substantially identical to those presented in the Volkswagen IPR. *See supra* n.2. While Honda 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). Further, unity of exhibits

and exhibit numbering with the Volkswagen IPR has been maintained. Accordingly, no new grounds are being introduced. *See Sony Corp. v. Memory Integrity, LLC.*, IPR2015-01353, Paper No. 11 at 5-6 (PTAB Oct. 5, 2015).

Therefore, consolidation of this proceeding with Volkswagen's via joinder of Honda's Petition will not raise any new issues of unpatentability and will not impose any additional burden on the Board or Patent Owner, or add additional complexity to the case.

**3. Joinder Will Not Affect the Schedule in the Volkswagen IPR**

Given that the Board has not yet instituted the Volkswagen IPR, joinder of Honda would not affect the schedule in any potential forthcoming trial. Honda's participation should result in no changes to the schedule.

Honda agrees to adhere to all applicable deadlines set forth in the Volkswagen IPR Scheduling Order.

**4. Joinder Will Simplify Briefing Because Honda Has Agreed to Consolidated Filings and an Understudy Role if the Volkswagen Petitioner Remains**

To further prevent joinder from imposing any burden on the Volkswagen IPR Petitioner, Patent Owner, or the Board and to further ensure that there are no changes in the potential trial schedule, Honda has agreed, as long as the Volkswagen IPR Petitioner remains a party to the Volkswagen IPR, to take an understudy role, which will simplify briefing and discovery. In this role, Honda

agrees to the following conditions:

(a) Honda shall not make any substantive filing and shall be bound by the filings of the Volkswagen IPR Petitioner, unless a filing concerns termination and settlement, or issues solely involving Honda;

(b) Honda shall not present any argument or make any presentation at oral hearing unless an issue solely involves Honda, or when addressing Board-approved motions that do not affect the Volkswagen IPR Petitioner, or its respective position;

(c) Honda shall not seek to cross-examine or defend the cross-examination of any witness, unless the topic of cross-examination concerns issues solely involving Honda;

(d) Honda shall not seek discovery from Patent Owner on issues not solely involving Honda;

(e) Honda 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. If the Volkswagen IPR Petitioner is not terminated from the case prior to any necessary depositions, Honda agrees to rely entirely on, and be bound by, the expert declarations and depositions in the Volkswagen IPR. Honda's expert declaration of Dr. Buehrer is substantially identical to the Wilson declaration filed by the Volkswagen IPR Petitioner. Dr.

Buehrer would not be relied on if the Volkswagen IPR Petitioner continues to participate in the Volkswagen IPR. *See, e.g., Noven Pharm., Inc. v. Novartis AG*, IPR2014-00550, Paper 38 at 5 (PTAB April 10, 2015). Unless and until the current petitioner in IPR2022-01537 ceases to participate in the instituted Volkswagen IPR, Honda will not assume an active role.<sup>2</sup>

Accordingly, due to Honda taking only an “understudy” role, Patent Owner and the Volkswagen IPR Petitioner will only need to respond to one principal set of papers, will not require additional time to address additional arguments, and can thus proceed with the existing trial schedule. These steps will minimize or eliminate any potential complications or delay that could potentially result from joinder. *See Sony*, Paper No. 11 at 6-7 (granting motion 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 second petitioner agreed to “understudy” role). Honda will also abide by any additional conditions the Board deems appropriate for an “understudy” role.

## **5. Joinder Will Result in No Prejudice to Patent Owner**

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<sup>2</sup> For clarity, should the Volkswagen IPR Petitioner’s participation in the Volkswagen IPR terminate, Honda would take over primary responsibility for subsequent filings and discovery.

As noted above, Honda's joining of the Volkswagen IPR proceeding should not result in any prejudice to Patent Owner. No additional grounds or arguments are being introduced, no new evidence or issues are being added, and no additional discovery or briefing or oral argument should be necessary as a result of Honda's joinder. Thus, Patent Owner would not need to expend any additional resources beyond those required in the current Volkswagen IPR.

### **III. INSTITUTION IS APPROPRIATE UNDER *GENERAL PLASTIC***

*General Plastic* does not apply here because Honda has not previously challenged the '941 patent and seeks to join the Volkswagen IPR in an understudy role. *See General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 15-19 (PTAB Sept. 6, 2017); *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00224, Paper 10 at 4-5 (PTAB Apr. 6, 2020).

**Factor 1:** Under *General Plastic*, factor 1 considers "whether the same petitioner previously filed a petition directed to the same claims of the same patent." *General Plastic* at 16. Here, Honda has not previously filed a petition against the '941 patent.

Honda and the Volkswagen IPR Petitioner are separate, unrelated petitioners, and are not similarly situated for purposes of Factor 1. This factor weighs in favor of institution and against discretionary denial.

**Factors 2, 4 and 5:** As to the timing examined in these factors, Honda did

not previously file a first petition prior to its current petition, and while Honda became aware of the prior art references in the Volkswagen IPR, it made no serial attack on the '941 patent and has filed this petition for IPR prior to institution. These factors weigh in favor of institution and against discretionary denial.

**Factor 3:** As Honda did not previously file a first petition this factor weighs in favor of institution and against discretionary denial.

**Factors 6 and 7:** As stated above, Honda seeks to join the Volkswagen IPR and is not raising arguments beyond those raised by the Volkswagen petition. These factors thus weigh in favor of institution, as there should be no material impact on the Board's finite resources or its ability to issue a final determination on the Volkswagen petition within one year.

#### **IV. CONCLUSION**

For the foregoing reasons, Honda respectfully requests that its Petition for *Inter partes* review of the '941 Patent be instituted and that Honda be joined to the Volkswagen IPR proceeding IPR2022-01537.

Respectfully submitted,

Dated March 30, 2023

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**CERTIFICATE OF SERVICE**

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on March 30, 2023, a complete and entire copy of this Petitioner's Motion for Joinder was provided by Federal Express, to the Patent Owner, by serving the correspondence address of record as follows:

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