UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN HONDA MOTOR CO., INC.,
Petitioner,

v.

NEO WIRELESS, LLC,
Patent Owner.

Case IPR2023-00791
Patent US 10,075,941

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 American Honda Motor Co., Inc.'s ("Honda") Motion For Joinder (Paper 2, "Mot."), which requests joinder of this IPR with IPR2022-01537 filed by Volkswagen Group of America, Inc. ("Volkswagen"). 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, Honda 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 Honda'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. Honda concedes that measures limiting its joined participation are appropriate, and pre-emptively "agrees" to several such limits. Mot., 2, 7-9. The Board should, however, grant joinder, if at all, only with further limits.

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

Honda has said it "will act as an 'understudy'" 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 filings," 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 rule. The Board here should make this explicit. In other words, Patent Owner requests that the Board in fact hold Honda to a silent understudy rule. 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 Honda 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 Honda's exhibits, including its separate expert declaration (Ex. 1047), not be added to the record of this case, and that Honda 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. HONDA 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 Honda's joinder request only if Honda is given no right thereby to participate, as a joined party, without express prior Board authorization.

Honda pledges that if joined it will submit no separate arguments—essentially, to act as an understudy to Volkswagen—if joinder is granted. Mot., 6-9. There is no apparent reason why Honda, as a 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 Honda has agreed to let Volkswagen "maintain the lead" (Mot., 2), Honda has not promised not to submit its own separate evidence, only stating that it "will not seek additional depositions or deposition time," (Mot., 2) giving itself multiple carve-outs wherein it would be permitted to submit evidence or briefing when an issue "solely involv[es] Honda" or when motions "do not affect the Volkswagen IPR Petitioner, or its respective position." Mot., 8. Indeed, Honda 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.

While Honda has proposed numerous conditions ostensibly limiting its participation in the target proceedings, they would not limit Honda to a silent understudy role. In its Motion for Joinder, Honda offers 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.

Mot., 7-9.

The restrictions on Honda's involvement in the Volkswagen IPR, as laid out in Honda's proposed conditions, are insufficient. For example, as seen above, Honda purports to agree to limit its ability to make substantive filings, but then immediately states that the limitation does not extend to "a filing concern[ing]

termination and settlement, or issues solely involving Honda." Mot., 8. Each of Honda's conditions has a carve-out of some degree permitting Honda to directly involve itself in the Volkswagen IPR, in a manner inconsistent with being a "silent understudy." Not all of the conditional carve-outs only apply when Honda is addressed in the IPR in some manner, as Honda also tries to allow itself to ***seek*** discovery from Patent Owner on issues "solely involving Honda." *Id.* In short, Honda is dressing itself up as a silent understudy, but effectively seeks permission to be a potentially participating party in the Volkswagen IPR. This type of involvement should not be permitted absent obtaining of advance Board approval of each act of participation.

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 petitions—*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 Honda'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 the prior 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 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

[2] All emphasis is added unless stated otherwise.

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 Honda here as well.

Honda 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 Honda joinder except if Honda 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. HONDA SHOULD BE PROHIBITED FROM OFFERING ITS OWN SEPARATE EVIDENCE.

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

Honda pledges that if joined, it will refrain from certain independent action, including that it will "not assume an active role" and that it "will not seek additional depositions or deposition time." Mot., 2. However, Honda does ***not***

agree to not file separate exhibits[3] nor does it explicitly agree not to file briefing, simply stating that "[t]hese limitations will avoid … ***duplicative*** briefing" (*id.*), while at the same time giving itself multiple carve-outs wherein it can file briefing or advance arguments. Mot., 7-9; *see* supra § II. Indeed, Honda has already begun to file separate exhibits, including an expert declaration signed by Mr. Michael Buehrer, whose testimony does not appear as an exhibit in the Volkswagen IPR. Ex. 1047.

Allowing Honda to add its own separate, different evidence, such as Mr. Buehrer'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). Honda's separately filed exhibits, including the Buehrer declaration, should be required to be withdrawn and should not become part of the record of the joined proceedings.

To be sure, Honda does not even agree to proceed solely on the grounds, evidence, and arguments advanced in the Volkswagen IPR if it is instituted, instead attempting to carve out multiple situations in which Honda should be permitted to

[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).

present arguments, file briefing, seek discovery, and cross-examine witnesses. Mot., 7-9. Furthermore, Honda has not limited itself, or Volkswagen, from presenting different arguments with respect to Honda's separate witness (Mr. Buehrer), unilaterally stating that he "would not be relied on" by ***Honda*** if Volkswagen "continues to participate in the Volkswagen IPR." *Id.*, 9. Honda does not state that Volkswagen has similarly agreed not to rely on, or take the deposition of, Mr. Buehrer. Honda's Motion therefore appears to leave open the possibility, absent Board direction to the contrary, that Honda will insert itself into the proceedings whenever it unilaterally determines any question is "solely involving Honda" or "do not affect the Volkswagen IPR Petitioner," 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. *Id.*, 8.

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). Honda's joinder request, if granted at all, should be granted only on, *inter alia*, this condition.

As for Honda's remaining exhibits (Ex. 1001 to Ex. 1045), 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 Honda's pledge of understudy status, in the absence of clarity as to what that status means, and Patent Owner respectfully submits that, if Honda's petition is instituted, joinder should be granted only with the conditions described above.

Respectfully submitted,

____/ Kenneth Weatherwax /_____
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Lowenstein & Weatherwax LLP

Date: May 1, 2023

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

The names and address of the parties being served are as follows:

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Date: May 1, 2023