

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.

IPR2023-00793

Patent No. 10,447,450

**PETITIONERS' REPLY IN SUPPORT OF MOTION FOR JOINDER
UNDER 35 U.S.C. § 315(c), 37 C.F.R. § 42.22, AND § 42.122(b)**

I. INTRODUCTION

Petitioner American Honda Motor Co., Inc. (“Honda”) hereby responds to Patent Owner’s Response (Paper 7, “Resp.”) to Petitioner’s Motion for Joinder (Paper 2, “Mot.”) which requests joinder with IPR2022-01567 (*Volkswagen Group of America, Inc. v. Neo Wireless LLC* “Volkswagen IPR”). This reply is timely under 37 C.F.R. § 42.25(a)(2).

On May 4, 2023, the Board instituted the Volkswagen IPR petition on all grounds. Volkswagen IPR, Paper 8. Honda’s petition is substantively the same as the instituted Volkswagen IPR petition. Honda’s petition challenges the same claims, on the same grounds, and relies on the same prior art as the Volkswagen IPR. Furthermore, Honda has stipulated 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. Mot., 2. Honda has agreed to abide by numerous conditions for the “understudy” role. Mot., 7-9 (Honda’s stipulated conditions (a)-(e)).

In response, Patent Owner argues that Honda’s stipulated conditions “are insufficient” and that the Board should only grant joinder with the following additional 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. 1048), 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. Resp., 2-3. Patent Owner further demands that "Honda's separately filed exhibits, including the Buehrer declaration, should be required to be withdrawn and should not become part of the record of the joined proceedings." Resp., 10.

Patent Owner's additional condition (1) is unnecessary because Honda's stipulated conditions are consistent with the Board's practice.

Patent Owner's additional condition (2) is contrary to the Board's practice. Contrary to Patent Owner's assertions, the Board routinely grants joinder without requiring the joined petitioner to withdraw its exhibits in cases where the joined petitioner's supporting materials are substantially identical to those in the existing proceeding.

II. HONDA'S PROPOSAL IS CONSISTENT WITH THE BOARD'S PRACTICE

Patent Owner's additional condition (1) that Honda should have "no right to file papers, engage in discovery, or participate in depositions and oral argument without first obtaining authorization from the Board" is unnecessary because Honda's stipulated conditions (Mot., 7-9) already limit Honda's participation in a manner consistent with the Board's practice by limiting additional discovery,

briefing, and oral argument. *See Sony Corp. v. Memory Integrity, LLC.*, IPR2015-01353, Paper No. 11 at 6-7 (PTAB Oct. 5, 2015) (granting motion because “joinder would increase efficiency”).

The Board routinely grants motions for joinder where petitioner agrees to participate as Honda proposes. *See, e.g., Advance Micro Devices, Inc. et al. v. Monterey Research, LLC*, IPR2021-00776, Paper No. 13 at 22 (PTAB Oct. 13, 2021); *Taiwan Semiconductor Manufacturing Co., Ltd. v. Arbor Global Strategies, LLC*, IPR2021-00736, Paper No. 9 at 8 (PTAB Jun. 11, 2021)..

III. HONDA SHOULD NOT BE REQUIRED TO WITHDRAW ITS EXHIBITS

Patent Owner’s additional condition (2) that “Honda’s separately filed exhibits, including the Buehrer declaration, should be required to be withdrawn” and that “Honda have no right as understudy petitioner to submit any separate exhibits or other materials” is inconsistent with the Board’s practice.

Contrary to Patent Owner’s assertions, the Board routinely grants joinder without requiring the joined petitioner to withdraw its exhibits when substantially the same evidence was filed as in the existing proceeding. *See, e.g., Everlight Elecs. Co., v. Document Security Sys., Inc.*, IPR2018- 01260, Paper No. 12 at 6-7 (PTAB Nov. 14, 2018) (granting motion for joinder where petitioner submitted separate but substantially identical expert declaration); *Splunk Inc. v. Sable Networks, Inc.*,

IPR2022-00228, Paper 9, 8 (PTAB Apr. 4, 2022) (denying Patent Owner's request that petitioner should be required to withdraw its exhibits from the proceeding).

Furthermore, contrary to Patent Owner's demand, the Board routinely permits a joining party to submit separate filings in a limited "understudy" role. *See, e.g., MSN Labs. Private Ltd. v. Bausch Health Ireland Ltd.*, IPR2023-00016, Paper 12, 3-4 (PTAB Nov. 29, 2022); *Sony* (IPR2015-01353), Paper No. 11 at 5-6 (permitting a joining party to submit a separate filing).

Patent Owner asserts that "[i]n 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" (Resp. 11). However, the facts in the Patent Owner's cited proceedings are not consistent with the facts in this proceeding.

In *Mylan*, the Board denied joinder because "the date for the oral hearing is only a few weeks away" without "a practical way to accommodate the additional discovery." *See Mylan Pharms. Inc. v. Janssen Oncology, Inc.*, IPR2016-01332, Paper 21, 11 (PTAB Jan. 10, 2017).

In *Argentum*, the joining party preemptively offered, as a condition in its Motion for Joinder, to "withdraw the declaration of its expert" if the existing party allows the joining party "to retain the same expert." *See Argentum Pharma. LLC v. Janssen Oncology Inc.*, IPR2016-01317, Paper 9, 5-6 (PTAB Sep. 19, 2016).

In *Sony* (IPR2013-00386), the Board denied joinder because the joining party sought to challenge a new claim with new grounds. *See Sony Corp. of Am. v. Network-1 Security Sols., Inc.*, IPR2013-00386, Paper 16, 7 (PTAB Jul. 29, 2013).

By contrast, in this proceeding, Honda's supporting materials—including its supporting expert declaration, exhibits, and exhibit numbering—are substantially identical to those presented in the Volkswagen IPR. 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*, Paper No. 12 at 6-7 (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. *See Splunk*, Paper 9, 8 (denying Patent Owner's request that petitioner should be required to withdraw its exhibits from the proceeding because the exhibits "were not previously of record this proceeding, and we discern no justification for their removal from it").

IV. CONCLUSION

For the foregoing reasons, Honda respectfully requests that its Petition for *inter partes* review of the '450 Patent be instituted and that Honda be joined to the Volkswagen IPR proceeding IPR2022-01567.

Respectfully submitted,

Date:6/1/2023

/Thomas A. Rozylowicz/

Thomas A. Rozylowicz, Reg. No. 50,620

John T. Johnson, Reg. No. 37,363

Jeffrey C. Mok, Reg. No. 69,878

Won Yoon, Reg. No. 71,058

Fish & Richardson P.C.

60 South Sixth Street, Suite 3200

Minneapolis, MN 55402

T: 202-783-5070

F: 877-769-7945

Attorneys for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on June 1, 2023, a complete and entire copy of this Petitioners' Reply In Support Of Motion For Joinder was provided by email, to the Patent Owner, by serving the correspondence address of record as follows:

Kenneth J. Weatherwax
Parham Hendifar
LOWENSTEIN & WEATHERWAX LLP
1016 Pico Boulevard, Santa Monica, CA 90405

Hamad M. Hamad
CALDWELL, CASSADY, & CURRY P.C.
2121 N. Pearl St., Ste 1200, Dallas, TX 75201

Email: weatherwax@lowensteinweatherwax.com
NeoWireless_IPRs@lowensteinweatherwax.com

_____/Diana Bradley/
Diana Bradley
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
(858) 678-5667