UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENERAL MOTORS LLC, NISSAN NORTH AMERICA, INC., TESLA, INC., AND AMERICAN HONDA MOTOR CO., INC.,
Petitioner,

v.

NEO WIRELESS, LLC,
Patent Owner.

Case IPR2023-00961
Patent US 10,965,512 B2

PATENT OWNER'S RESPONSE TO PETITIONER'S MOTION FOR JOINDER

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I. INTRODUCTION

Patent Owner Neo Wireless, LLC hereby responds to Petitioners General Motors LLC, Nissan North America, Inc., Tesla, Inc., and American Honda Motor Co., Inc.'s, (collectively "GM's") Motion For Joinder (Paper 2, "Mot."), which requests joinder of this IPR with IPR2022-01539 filed by Volkswagen Group of America, Inc. ("Volkswagen"). This response 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, GM has the burden to establish entitlement to relief. 37 C.F.R. §§ 42.20(c), 42.122(b).

If the Board decides to grant joinder, it should only be granted with additional conditions limiting GM's participation as joined understudy petitioner, such as those the Board has imposed in other cases,[1] to reduce the inarguable

[1] Patent Owner respectfully disagrees with the decision to grant joinder without formally imposing such conditions in IPR2023-00079, Paper 11 (May 5, 2023), which already granted a motion for joinder to IPR2022-01539. Patent Owner notes that multiplying grants of joinder increase the likelihood of resulting cost and delay. *See, e.g., Am. Honda Motor Co. v. Intellectual Ventures II LLC*, IPR2018-

burden the requested joinder will create in these speedy proceedings. GM 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.

GM has said it "will act as an 'understudy'" until the target IPR petitioner is no longer a party in the proceeding. Mot., 1-2. 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

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00348, Paper 10, 20 (June 27, 2018) (denying institution and joinder where, *inter alia*, "multiple, staggered petition filings," including those requesting joinder, "each challenging the same claims of the same patent, . . . results in some inefficiency for the Board"). The multiplying requests for joinder by multiple additional petitioners is a further reason such conditions should be imposed.

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 role. The Board here should make this explicit. In other words, Patent Owner requests that the Board in fact hold GM to a silent understudy role. 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 GM 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 GM's exhibits, including its separate expert declaration (Ex. 1035), not be added to the record of this case, and that GM 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. GM 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 GM's joinder request only if GM is given no right thereby to participate, as a joined party, without express prior Board authorization.

GM pledges that if joined it will submit no separate arguments—essentially, to act as an understudy to Volkswagen—if joinder is granted. Mot., 7-9. There is no apparent reason why GM, 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 GM has agreed to let Volkswagen "maintain the lead" (Mot., 2), GM 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 potential carve-outs wherein it might potentially deem itself permitted to submit evidence or briefing when an issue "solely involv[es] Petitioners" or when motions "do not affect the VW IPR Petitioner, or its respective position." Mot., 8. (Indeed, GM has already submitted its own separate evidence, including separate witness testimony, and, if joinder were granted, may continue to separately proffer still more.)

While GM has proposed numerous conditions ostensibly limiting its participation in the target proceedings, they would present potential loopholes that

may not limit GM to a silent understudy role. In its Motion for Joinder, GM offers the following conditions:

a. Petitioners shall not make any substantive filing and shall be bound by the filings of the VW IPR Petitioner, unless a filing concerns termination and settlement, or issues solely involving Petitioners;
b. Petitioners shall not present any argument or make any presentation at oral hearing unless an issue solely involves Petitioners, or when addressing Board-approved motions that do not affect the VW IPR Petitioner, or its respective position;
c. Petitioners shall not seek to cross-examine or defend the cross-examination of any witness, unless the topic of cross-examination concerns issues solely involving Petitioners;
d. Petitioners shall not seek discovery from Patent Owner on issues not solely involving Petitioners;
e. Petitioners will not rely on expert testimony beyond that submitted by the VW IPR Petitioner unless the VW IPR Petitioner is terminated from the case prior to any necessary depositions. If the VW IPR Petitioner is not terminated from the case prior to any necessary depositions, Petitioners agree to rely entirely on, and be bound by, the expert declarations and depositions in the VW IPR. Petitioners' expert declaration of Dr. Matthew C. Valenti is substantively identical to the declaration filed in the VW IPR petition. *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 IPR2023-01539 ceases to participate in the instituted VW IPR, Petitioners will not assume an active role.

Mot., 7-9.

The restrictions on GM's involvement in the Volkswagen IPR, as laid out in GM's proposed conditions, should be augmented. For example, as seen above, GM 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 Petitioners." Mot., 8. Each of GM's conditions has a carve-out of some degree permitting the petitioners to directly involve themselves in the Volkswagen IPR, in a manner inconsistent with being a "silent understudy." GM also fails to offer clarity as to what it understands that a "necessary" deposition would be, which, in the event of dismissal of Volkswagen, would permit GM to claim a deposition is still "necessary" and introduce its own expert. *Id.*, 8-9. Not all of the conditional carve-outs only apply when GM is addressed in the IPR in some manner, as GM also tries to allow itself to ***seek*** discovery from Patent Owner on issues "solely involving Petitioners." *Id.*, 8. In short, GM 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 all participation.

In similar factual circumstances in past proceedings, where joinder has not been denied altogether, the Board has addressed the concerns above in a simple

and efficient manner, 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 GM'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.*

[2] All emphasis is added unless stated otherwise.

For another example, in *Taiwan Semiconductor Manufacturing Co. Ltd. v. Arbor Global Strategies LLC*, IPR2021-00738, the petitioner seeking joinder stated that 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 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 GM here as well.

GM has no more justification to a greater right to participate in this case than the petitioners in *GlobalFoundries*, *Taiwan Semiconductor*, *Splunk*, and *MSN Laboratories*. If joinder were to be granted here, the same simple, efficient condition requiring Board authorization for any involvement should be imposed.

The Board should not grant GM joinder except if GM 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. GM SHOULD BE PROHIBITED FROM OFFERING ITS OWN SEPARATE EVIDENCE.

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

GM 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, GM 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., 2, 7-9; *see* supra § II. Indeed, GM has already begun to file separate exhibits, including an expert declaration signed by Dr. Matthew Valenti, whose testimony does not appear as an exhibit in the Volkswagen IPR. Ex. 1035.

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[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).

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

To be sure, GM 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 GM should be permitted to present arguments, file briefing, seek discovery, and cross-examine witnesses. Mot., 7-9. Furthermore, GM has not limited itself, or Volkswagen, from presenting different arguments with respect to GM's separate witness (Dr. Valenti), unilaterally stating that he "will not [be] rel[ied] on" by ***Petitioners*** "beyond that ***submitted by the VW IPR Petitioner*** unless the VW IPR Petitioner is terminated from the case prior to any necessary depositions." *Id.*, 9. GM does not state that Volkswagen has similarly agreed not to rely on, or take the deposition of, Dr. Valenti, and indeed seems to phrase the condition to permit his involvement through Volkswagen. GM's Motion therefore appears to leave open the possibility, absent Board direction to the contrary, that GM will seek to insert itself into the proceedings whenever it unilaterally determines any question is "solely

involv[ing] Petitioners" or "do not affect the VW 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 simple, efficient 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 (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). GM's joinder request, if granted at all, should be granted only on, *inter alia*, this condition.

As for GM's remaining exhibits (Ex. 1001 to Ex. 1032), 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 GM's pledge of understudy status, in the absence of clarity as to what that status means, and Patent Owner respectfully submits that, if GM's petition is instituted, joinder should be granted only with the simple, tested, and efficient conditions described above.

Respectfully submitted,

/ Kenneth J. Weatherwax /

Kenneth J. Weatherwax, Reg. No. 54,528
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Date: July 3, 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

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