

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENERAL MOTORS LLC, ET AL.,
Petitioners,

v.

NEO WIRELESS, LLC,
Patent Owner.

IPR2023-00962
Patent No. 10,447,450

**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

General Motors LLC and Nissan North America, Inc. (collectively “Petitioner” or “Petitioners”) respectfully submit this Motion for Joinder, concurrently with a Petition for *inter partes* review (“IPR”) of U.S. Patent No. 10,965,450 (“the ’450 Patent”).

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b), Petitioners move for joinder with any IPR that is instituted as to the ’450 Patent in IPR2023-00763 (“Ford IPR”). *Ford Motor Company v. Neo Wireless LLC*, IPR2023-00763, Paper 1 (PTAB March 29, 2023). Petitioners request that action on this motion be held in abeyance until, and the motion be granted if, the Ford IPR is instituted. Should the Ford IPR be terminated prior to any institution decision or otherwise not instituted for any reason, Petitioners submit this motion for joinder would be moot, and requests the Board consider Petitioners’ IPR petition on its own merits. This motion is timely because it is being filed before institution of the Ford IPR.

Petitioners’ concurrently-filed Petition is substantively the same as the Ford IPR petition. It challenges the same claims, on the same grounds, and relies on the same prior art set forth in the Ford IPR and therefore would create no additional burden for the Board, the Ford IPR Petitioner, or Patent Owner if joined. Joinder would therefore lead to an efficient resolution of the validity of the ’450 patent.

Petitioners are currently defendants in a multidistrict court litigation in the Eastern District of Michigan, *In re Neo Wireless, LLC Patent Litig.*, 2:22-md-3034-TGB (E.D. MI). In this proceeding, Petitioners have been accused of infringing the '450 patent. Petitioners have not previously filed a petition for IPR challenging the validity of the '450 patent.

Petitioner agrees to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the Ford IPR if it is instituted. The Petition therefore warrants institution under 35 U.S.C. § 314, and 35 U.S.C. § 315(c) permits Petitioners' joinder to the Ford IPR if it is instituted.

Petitioners stipulate that if joinder is granted, they will act as an "understudy" and will not assume an active role unless the Ford IPR Petitioner ceases to participate in the proceeding. The Ford 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. Petitioners also will not seek additional depositions or deposition time. Joinder will not impact the trial schedule because the proceeding based on the Ford IPR is in its early stages (prior to the Patent Owner Preliminary Response due date).

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 Ford 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 Petitioners. Petitioners' interests may not be adequately protected in the Ford IPR, particularly if the Ford IPR Petitioner settles with Patent Owner and ceases to participate. Petitioners should be allowed to join in a proceeding affecting a patent asserted against them.

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 Petitioners' cooperative participation in the Ford IPR in the event that the Ford IPR Petitioner's participation terminates, the Board should institute IPR and grant Petitioners' instant 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-1 Security Solutions, Inc.*, IPR201300385, Paper 17 at 3 (July 29, 2013).

B. Petitioner'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 Ford IPR was filed less than three months ago on March 29, 2023. IPR2023-00763, Paper 1 (PTAB March 29, 2023). Petitioners’ current motion is timely as it is being filed prior to any institution decision in the Ford IPR.

C. The Four Factors Favor Joinder

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

1. Joinder of Petitioners Is Appropriate Because It Will Promote an Efficient Determination of the Validity of the '450 Patent Without Prejudice to Any Party

Petitioners seek to join the Ford IPR, if instituted, in order to ensure that accused infringers with an active interest in the proceeding remains a party to this IPR if the Ford IPR Petitioner's participation is terminated prior to completion. Thus, joining Petitioners to the Ford IPR is the most practical way to secure the just, speedy, and inexpensive resolution of the challenge to the '450 patent. *See* 37 C.F.R. § 42.1(b).

If Petitioners are joined as parties, the validity of the grounds raised in the Ford IPR, if instituted, can be determined in a single proceeding. Joinder is also appropriate because Petitioners' petition challenges the validity of the same claims of the '450 patent on identical grounds to those in the Ford IPR. There are no substantive differences between Petitioners' IPR Petition and the Ford's IPR Petition, IPR2023-00763, Paper 1 (March 29, 2023). Petitioners also rely on substantially the same supporting evidence in its Petition as is relied on in the Ford Petition.¹ A consolidated proceeding, including Petitioners and the Ford IPR

¹ The supporting expert declaration of Dr. Matthew C. Valenti submitted by Petitioners agrees with the facts, analysis, and conclusions of the expert declaration in the Ford IPR. The declaration of Dr. Valenti does not contain any new opinions

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.” *GM Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (PTAB Aug. 24, 2016) (internal quotations and citations omitted).

Joining Petitioners as a party to the Ford IPR would promote the public interest relating to the unpatentability of the ’450 patent and not cause any undue prejudice to Patent Owner or the Ford IPR Petitioner. The Patent Owner must respond to the common invalidity grounds identified in the Ford and Petitioners’ Petitions regardless of joinder.

not included in the Ford 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).

2. Petitioners' Petition Does Not Raise Any New Grounds of Unpatentability and Therefore Does Not Add Additional Complexity to the Grounds in the Ford IPR

Petitioners' Petition challenges the validity of the '450 patent on identical grounds to those in the Ford IPR. *See* IPR2023-00763, Paper 2 (September 27, 2022). Petitioners' supporting materials—including its supporting expert declaration, exhibits, and exhibit numbering—are substantially and substantively identical to those presented in the Ford IPR. *See supra*. While Petitioners use their own expert declarant, the expert's declaration agrees with and adopts the facts, analysis, and conclusions of the expert declaration in the Ford IPR and does not contain any new opinions not included in the Ford 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 Ford 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) (granting motion for joinder where petitioners relied “on the same prior art, same arguments, and same evidence, including the same expert and a substantively identical declaration”).

Therefore, consolidation of this proceeding with Ford's via joinder of

Petitioners' 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 Ford IPR

Joinder of Petitioners would not affect the schedule in any forthcoming instituted IPR. Petitioners' participation should result in no changes to the schedule.

Petitioners agree to adhere to all applicable deadlines set forth in the Ford IPR Scheduling Order, if instituted. The Patent Owner's Response will not be affected because the issues in Petitioners' Petition are identical to those in the Ford IPR petition. Patent Owner will thus not be required to provide any additional analysis or arguments.

4. Joinder Will Simplify Briefing Because Petitioners Have Agreed to Consolidated Filings and an Understudy Role if the Ford Petitioner Remains

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

- (a) Petitioners shall not make any substantive filing and shall be bound by

the filings of the Ford 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 Ford 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 Ford IPR Petitioner unless the Ford IPR Petitioner is terminated from the case prior to any necessary depositions. If the Ford 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 Ford IPR. Petitioners' expert declaration of Dr. Matthew C. Valenti is substantively identical to the declaration filed in the Ford 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 IPR2023-00763 ceases to participate in the instituted Ford IPR,

Petitioners will not assume an active role.²

Accordingly, due to Petitioners taking only an “understudy” role, Patent Owner and the Ford 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). Petitioners 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

As noted above, Petitioners’ joining of the Ford 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 Petitioners’

² For clarity, should the Ford IPR Petitioner’s participation in the Ford IPR terminate, Petitioners would take over primary responsibility for subsequent filings and discovery.

joinder. Thus, Patent Owner would not need to expend any additional resources beyond those required in the current Ford IPR.

III. INSTITUTION IS APPROPRIATE UNDER *GENERAL PLASTIC*

General Plastic does not apply here because Petitioners have not previously challenged the '450 patent and seek to join the Ford IPR, if instituted, 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.

Further, Petitioners and the Ford IPR Petitioner are separate, unrelated petitioners, and are not similarly situated for purposes of Factor 1. While Petitioners and the Ford IPR Petitioner are co-defendants in different (now consolidated) district court litigations, they are not accused of infringing the '450 Patent based on sale of the same products. Nor has Petitioners or the Ford IPR Petitioner provided any products or technology to the other leading to an allegation of infringement of the '450 Patent. This factor weighs in favor of institution and against discretionary denial.

Factors 2, 4 and 5: As to the timing examined in these factors, Petitioners

did not previously file a first petition prior to its current petition, and while Petitioners previously became aware of the prior art references in the Ford IPR as of at least the time of its filing, they made no serial attack on the '450 patent and have filed an IPR petition prior to institution of the Ford IPR. These factors weigh in favor of institution and against discretionary denial.

Factor 3: As Petitioners 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, Petitioners seek to join the Ford IPR and are not raising arguments beyond those raised by the Ford 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 Ford petition within one year.

IV. INSTITUTION IS APPROPRIATE UNDER *FINTIV*

For the reasons explained in more detail below, and in Petitioners' Petition, the *Fintiv* factors weigh in favor of grant of this Motion for Joinder and institution of the concurrently-filed Petition, and even more so because Petitioners merely seek to join the Ford IPR, if instituted, with a petition that relies on the same prior art references and grounds set forth in the Ford IPR.

Factor 1 is neutral or favors institution. Following institution of IPR2023-00763, Petitioner, as part of a joint defense group, filed a motion to staying pending

IPR of the '450 patent. *See In re Neo Wireless, LLC Patent Litig.*, 2:22-md-3034-TGB, Dkt. 145 (E.D. MI, May 17, 2023). The court has yet to rule on the motion. Accordingly, Factor 1 is either neutral or weighs against discretionary denial.

Factor 2 favors institution because the EDMI litigation is in early stages, no trial date has been set, and the median time to trial for civil actions in EDMI is 46.8 months. EX1042, 40; *see* June 2022 Memo, 3 (explaining that under factor 2 “the PTAB will consider the median time from filing to disposition of the civil trial for the district in which the parallel litigation resides”). Thus, trial would likely occur (if at all) in early 2026—years after the Board’s projected deadline for a final decision here. *See Mylan Pharma. Inc. v. Bayer Pharma. Aktiengesellschaft*, IPR2022-00517, Paper 15 at 8-9 (P.T.A.B. Aug. 9, 2022).

Factor 3 favors institution because, at institution, neither the parties nor the court will have invested significant resources in the parallel litigation. Currently, the court has not issued a scheduling order, or any substantive rulings. Other than claim construction briefs being exchanged and a *Markman* hearing set for June 21, 2023, no substantive progress has been made in the litigation. Petitioner reserves the right to update the Board should the circumstances change before the institution deadline.

Factor 4 favors institution. Petitioner stipulates that, if the Board institutes this Petition, Petitioner will not raise at trial in the parallel litigation any invalidity

challenges based on the prior art asserted here. This significantly mitigates the concerns for duplication and inconsistent conclusions embodied in factor 4.

Factor 5 is neutral or weighs against discretionary denial. Taking the relevant circumstances into account, including the unique nature of the grounds raised in the Petition, Petitioner's status as joint defendants in District Court is at worst a neutral factor. *See Snap, Inc. v. SRK Technology LLC*, IPR2020-00820 Pap. 15 at 16 (PTAB Oct. 21, 2020) (precedential); *Sand Revolution II, LLC v. Cont'l Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 at 11-12 (PTAB June 16, 2020). Moreover, institution would promote judicial efficiency and integrity by potentially relieving the District Court of the need to conduct trial, and by enabling the Board to determine invalidity of claims that Patent Owner has serially asserted.

Factor 6 favors institution because the merits of the Petition are strong, as indicated by the fact that the Ford IPR (IPR2023-00763), which Petitioners seek to join has already been instituted. *See supra*; June 2022 Memo, 3-5. Other considerations favoring institution under factor 6 include: Further, (1) the Board is best suited to address the technical issues raised here; (2) a decision on the merits at institution may aid the parties in resolving their disputes through alternative dispute resolution; and (3) a patentability ruling will benefit the public by providing a complete record and rationale absent from a black box jury verdict form, such as by deterring future litigation. Patent Owner has filed suit against nine defendants and is

likely to file against others given the remaining patent term of the '450 patent and Patent Owner's allegations that the '450 patent is essential to certain telecommunication standards. Considered holistically, the *Fintiv* factors strongly favor IPR.

V. CONCLUSION

For the foregoing reasons, Petitioners respectfully request that their Petition for *Inter partes* review of the '450 Patent be instituted and that Petitioners be joined to the Ford IPR proceeding IPR2023-00763 if the Ford petition is instituted.

Respectfully submitted,

Dated June 5, 2023

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on June 5, 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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