UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCEDES-BENZ USA, LLC,
Petitioner,

v.

YECHEZKAL EVAN SPERO,
Patent Owner.

Case (to be assigned)
U.S. Patent No. 11,208,029

PETITIONER'S CONTINGENT MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c) AND37 C.F.R. § 42.122.

Filed on behalf of Petitioner:
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I. Statement of Precise Relief Requested

Mercedes-Benz USA LLC ("**Mercedes**") respectively submits this Contingent Motion for Joinder, concurrently with a Petition for *Inter Partes* Review of U.S. Patent No. 11,208,029 (the "**'029 Patent**"). Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Mercedes ***conditionally*** requests *inter partes* review and moves for joinder with *Volkswagen Group of America, Inc. v. Yechezkal Evan Spero*, IPR2022-01586 (the "**Volkswagen IPR**"), which was instituted on May 24, 2023. This motion is timely because it is being filed within one month of institution of the Volkswagen IPR. This motion is contingent because Mercedes has filed its own IPR petition as described below. Counsel for Volkswagen has indicated Volkswagen does not oppose the requested contingent joinder.

On June 8, 2023, Mercedes filed an IPR petition (IPR2023-01034), challenging Claims 1-33 of the '029 Patent (the "**Mercedes Petition**"). ***Mercedes prefers and requests full consideration of the Mercedes Petition, which includes grounds different than those presented in the Volkswagen IPR.*** Should the Mercedes Petition be instituted, Mercedes withdraws this motion (if not yet ruled upon), and would withdraw or move to terminate Mercedes from any joined proceeding (should this motion be ruled upon prior to any institution decision on

the Mercedes Petition). *See, e.g.*, *Apple Inc. v. Speir Technologies LTD*, IPR2023-00305, Paper 9 (P.T.A.B. May 15, 2023).

Mercedes moves for joinder with the Volkswagen IPR ***if, and only if,*** the Board denies institution of the Mercedes Petition. Should the Board deny institution of the Mercedes Petition, Mercedes thus requests institution and joinder of the Petition for *Inter Partes* Review filed concurrently herewith. The 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 instituted in 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 invalidity of the '029 patent.

If so joined, Mercedes agrees to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the Volkswagen IPR as instituted. The Petition therefore warrants institution under 35 U.S.C. § 314, and 35 U.S.C. § 315(c) permits Petitioner's joinder to the instituted Volkswagen IPR, again should the Mercedes Petition be denied institution.

Mercedes 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. Joinder will not unduly prejudice any party because joinder will not add any new substantive issues, delay the schedule, burden

deponents, or increase needless filings, any additional costs on the Patent Owner would be minimal. On the other hand, denial of joinder would prejudice Mercedes. Mercedes' interests may not be adequately protected in the Volkswagen IPR, particularly if the Mercedes Petition is denied institution and the Volkswagen IPR petitioner settles with the Patent Owner. Mercedes 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 Mercedes' cooperative participation in the Volkswagen IPR, in the event that the Volkswagen IPR petitioner's participation terminates, the Board should institute the Petition and grant Mercedes' Motion for Joinder.

II. Background and Related Proceedings

An entity separate from the Patent Owner reflected in USPTO records, Torchlight Technologies, LLC ("**Torchlight**"), asserted the '029 Patent in two lawsuits in the District of Delaware on June 7, 2022:

- Case No. 1:22-CV-751 against Petitioner Mercedes-Benz USA, LLC, Daimler AG,[1] Volkswagen Group of America, Inc., Audi AG, Audi of America, LLC, Porsche AG, and Porsche North America, Inc.

[1] Daimler AG became Mercedes-Benz Group AG on February 1, 2022.

- Case No. 1:22-CV-752 against General Motors LLC, General Motors Co., and General Motors Holdings, LLC.

These cases are in their infancy. Many defendants were only just served (including "Daimler AG"); responses to the operative complaint have not been filed; and no discovery has been exchanged. Further, the cases have been indefinitely stayed pending resolution of whether the complaint should be dismissed due to lack of standing and failure to join necessary parties.

On September 22, 2022, Unified Patents, LLC filed an IPR petition (IPR2022-01500), challenging Claims 1, 2, 10-13, and 23-24 of the '029 Patent (the "**Unified IPR**"). The Board instituted the Unified IPR on May 4, 2023.

On October 3, 2022, Volkswagen Group of America, Inc. filed the Volkswagen IPR, challenging Claims 1-33 of the '029 Patent. The Board instituted the Volkswagen IPR on May 24, 2023.

On June 8, 2023, Mercedes filed the Mercedes Petition, challenging Claims 1-33 of the '029 Patent. The Mercedes Petition is pending and awaiting a decision on institution. Again, Mercedes seeks joinder to the Volkswagen IPR if and only if the Mercedes Petition is denied institution. Should the Mercedes Petition be instituted, Mercedes withdraws this motion (if not yet ruled upon), and would withdraw or move to terminate Mercedes from any joined proceeding (should this motion be ruled upon prior to any institution decision on the Mercedes Petition).

On June 22, 2023, Porsche Cars North America, Inc. ("Porsche") filed an IPR petition (IPR2023-01122) with a motion to join the Volkswagen IPR.

III. Statement of Reasons for the Relief Requested

A. Legal Standards and Applicable Rules

The Board has discretion to join a properly filed IPR petition to an existing IPR proceeding. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); *see also Sony Mobile Comms. AB v. Ancora Technologies, Inc.*, IPR2021-00663, Paper 17, at 29-33; *Dell Inc. v. Network-1 Sec. Solutions, Inc.*, IPR2013-00385, Paper 19, at 4-6; *Sony Corp. v. Yissum Res. & Dev. Co. of the Hebrew Univ. of Jerusalem*, IPR2013-00326, Paper 15, at 3-4; *Microsoft Corp. v. Proxyconn, Inc.*, IPR2013-00109, Paper 15, at 3-4.

"The Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations." *Dell*, IPR2013-00385, Paper 19, at 3. The movants bear the burden of proof in establishing entitlement to the requested relief. 37 §§ 42.20(c), 42.122(b). A motion for joinder should:

> (1) set forth the reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified.

Dell, IPR2013-00385, Paper 19, at 4.

B. Joinder with the Proceeding is Appropriate

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 Co.*, IPR2016-00962, Paper No. 12 at 9 (Aug. 24, 2016) (emphasis added) (internal quotations and citations omitted).

Here, joinder with the Volkswagen IPR is appropriate because the Petition introduces identical unpatentability arguments and the same grounds raised in the Volkswagen IPR petition. In other words, both petitions contain the same grounds based on the same prior art combinations and supporting evidence against the same claims. There are no substantive differences between the Petition and the Volkswagen IPR petition. Petitioner also relies on substantially the same supporting evidence in the Petition as is relied on in the Volkswagen IPR.[2]

[2] The supporting expert declaration of Dr. Nikolaos Papanikolopoulos submitted by Mercedes agrees with the facts, analysis, and conclusions of the expert declaration in the Volkswagen IPR. The declaration of Dr. Papanikolopoulos 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

Because these proceedings introduce identical unpatentability arguments and the same grounds, good cause exists for joinder, so that the Board, consistent with 37 C.F.R. § 42.1(b), can efficiently "secure the just, speedy, and inexpensive resolution" of this proceeding and the Volkswagen IPR.

Moreover, Mercedes notes that the Board has indicated that the factors outlined by *General Plastics* are not particularly relevant here "where a different petitioner files a 'me-too' or 'copycat' petition in conjunction with a timely motion to join." *See, e.g., Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11 at 9-11; *Pfizer, Inc. v Genentech, Inc.*, IPR2017-02063, Paper 25 at 7-8. Through grant of this joinder, the Board is simply offered the opportunity to ensure that the Volkswagen IPR is not prematurely terminated based on opportunistic settlement or dismissal by Patent Owner with fewer than all parties against which it has asserted the subject patent.

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separate but substantially identical expert declaration); *see also Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper No. 11 at 14 (Oct. 30, 2018) (same); *Sun Pharmaceutical Industries Ltd. v. Merck Sharp & Dohme Corp.,* IPR2020-01072, Paper No. 12 at 7 (Sept. 1, 2020) (same).

C. Joinder Will Not Add New Grounds of Unpatentability or Impact the Trial Schedule

The Petition is based on the same grounds and combinations of prior art in the Volkswagen IPR. For simplicity and efficiency, Petitioner has copied the substance of the petition in the Volkswagen IPR and its accompanying expert declaration. While Petitioner 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); *see also Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper No. 11 at 14 (Oct. 30, 2018) (same); *Sun Pharmaceutical Industries Ltd. v. Merck Sharp & Dohme Corp.*, IPR2020-01072, Paper No. 12 at 7 (Sept. 1, 2020) (same).

Mercedes does not seek to introduce grounds or claims not currently in the Volkswagen IPR and seeks only to join the proceeding as instituted. Patent Owner should not require any discovery beyond that which it may need in the Volkswagen IPR. The Petition introduces no new substantive issues relative to the Volkswagen IPR and does not seek to broaden the scope of the Volkswagen IPR.

Joinder will not impact the Volkswagen IPR trial schedule because the Petition presents no new issues or grounds of unpatentability. *See LG*, IPR2015-01353, Paper No. 11 at 6 (granting IPR and motion for joinder where "joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]"). Further, Mercedes consents to the trial schedule as adopted in the Volkswagen IPR. There are no new issues for the Board to address, and Patent Owner will not be required to present any additional responses or arguments.

The Patent Owner's Response, if any, will also not be negatively impacted because the substantive issues presented in the Petition are identical to the issues presented in the Volkswagen IPR. Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in responding to the Volkswagen IPR petition.

Accordingly, joinder with the Volkswagen IPR does not unduly burden or negatively impact the trial schedule.

D. Procedures to Simplify Briefing and Discovery

Petitioner agrees to take an "understudy" role, which will simplify briefing and discovery. Specifically, Petitioner agrees, upon joining the Volkswagen IPR, that the following conditions, as previously approved by the Board in similar

circumstances, shall apply so long as the Volkswagen IPR petitioner remains active parties:

(a) all filings by Mercedes in the Volkswagen IPR shall be consolidated with the filings of the Volkswagen IPR petitioner, unless a filing concerns issues solely involving Petitioners;

(b) Mercedes shall not be permitted to raise any new grounds not instituted by the Board in the Volkswagen IPR, or introduce any argument or discovery not introduced by the Volkswagen IPR petitioner in the Volkswagen IPR;

(c) Mercedes shall be bound by any agreement between Patent Owner and the Volkswagen IPR petitioner in the Volkswagen IPR concerning discovery and depositions; and

(d) Mercedes at deposition in the Volkswagen IPR shall not receive any direct, cross examination, or redirect time beyond that permitted under either 37 C.F.R. § 42.53 or any agreement between Patent Owner and the Volkswagen IPR petitioner. *See Noven Pharmaceuticals, Inc. v. Novartis AG*, IPR2014-00550, Paper No. 38 at 5 (Apr. 10, 2015).

Unless and until the Volkswagen IPR petitioner ceases to participate, Mercedes will not assume an active role in the Volkswagen IPR.[3] Mercedes will not rely on expert testimony beyond that submitted by Volkswagen unless Volkswagen is terminated from the case prior to any necessary depositions. Thus, Mercedes' expert Dr. Papanikolopoulos would not be relied on in the Volkswagen IPR if Volkswagen's expert remains available.

By Mercedes accepting an "understudy" role, the parties can comply with the trial schedule assigned to the Volkswagen IPR without needing any duplicative efforts by the Board or the Patent Owner. These steps minimize the possibility of any complication or delay from joinder. *See LG*, IPR2015-01353, Paper No. 11 at 6-7 (granting IPR and motion for joinder 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 petitioners agreed to an "understudy" role). Petitioner is further willing to agree to any other reasonable conditions the Board deems necessary.

[3] Should Volkswagen IPR petitioner cease to participate in any joined IPR proceeding, Mercedes would work with Porsche on who would take the active role as lead petitioner.

IV. Conclusion

Joinder will not affect the substance, procedure, or scheduling of the Volkswagen IPR. Mercedes files this motion under the statutory joinder provisions as contemplated by the AIA. Joinder will simplify the issues and promote efficiency, justice, and speed.

For the foregoing reasons, should the Board deny institution of the Mercedes Petition (IPR2023-01034), Mercedes respectfully requests *inter partes* review of U.S. Patent No. 11,208,029 and joinder with *Volkswagen Group of America, Inc. v. Yechezkal Evan Spero*, IPR2022-01586.

Dated: June 23, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that, in accordance with 37 C.F.R. § 42.6(e) and 37 C.F.R. § 42.105, the foregoing Motion for Joinder was served on June 23, 2023, by Overnight Courier and hand delivery at the following address of record and addresses known to Petitioner as likely to effect service and the address of record for the ’029 patent:

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