Filed on behalf of:

PORSCHE CARS NORTH AMERICA, INC.

By:
Edgar H. Haug, Reg. No. 29,309
Robert E. Colletti, Reg. No. 76,417
HAUG PARTNERS LLP
745 Fifth Avenue
New York, NY 10151
Telephone: 212-588-0800
Facsimile: 212-588-0500

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PORSCHE CARS NORTH AMERICA, INC.,
Petitioner,

v.

YECHEZKAL EVAN SPERO,
Patent Owner.

Case No. IPR2023-01321
U.S. Patent No. 10,894,503 B2

PETITIONER'S MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c), 37 C.F.R. § 42.22 AND § 42.122(b)

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Porsche Cars North America, Inc. ("Petitioner") respectfully submits this Motion for Joinder under 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22 and 42.122(b), concurrently with its Petition ("Instant Petition") for *inter partes* review of claims 1-19 and 37-58 of U.S. Patent No. 10,894,503 (the "'503 Patent"). Petitioner respectfully requests that the Board institute Petitioner's IPR and join it to the IPR captioned as *Volkswagen Group of America, Inc. v. Yechezkal Evan Spero*, IPR2023-00335, which the Board instituted on July 17, 2023 (the "VW IPR").

Joinder is appropriate because the Instant Petition is essentially a copy of the petition filed in IPR2023-00335 ("the VW Petition"). The Instant Petition includes the same grounds based on the same prior art, and challenges the same claims as the VW Petition, and therefore would create no additional burden for the Board, the Petitioner Volkswagen Group of America, Inc. ("VW"), or the Patent Owner Yechezkal Evan Spero ("Patent Owner"), if joined. Further, Counsel for VW has indicated VW does not oppose the requested joinder.

Petitioner stipulates that if joinder is granted, it will cooperate with VW in the joined proceeding, including at hearings, at depositions, in filings, or otherwise, as outlined below. Additionally, Petitioner stipulates that if joinder is granted, it will act as an "understudy" and will not assume an active role unless VW ceases to participate in the proceeding. Joinder will not impact the trial schedule because the VW IPR

proceeding is in its early stages. Joinder will therefore lead to an efficient resolution of the validity of the challenged claims of the '503 Patent.

This Motion for Joinder is timely under 37 C.F.R. §§ 42.22 and 42.122(b), because it is submitted within one month of July 17, 2023, the date on which the VW IPR was instituted.

II. REASONS FOR THE RELIEF REQUESTED

A. Legal Standard

In determining whether to join one IPR proceeding to another, 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.*, IPR2013-00385, Paper 17 at 3 (P.T.A.B. July 29, 2013). Each of these factors favors joinder here.

B. Reasons Why Joinder Is Appropriate

Joinder is appropriate because it is the most efficient way to resolve the two related proceedings. The Instant Petition is intentionally identical in substance to the VW Petition and does "not present issues that might complicate or delay" the VW IPR. *See Enzymotec Ltd. v. Neptune Techs & Bioresources, Inc.*, IPR2014-00556, Paper 19 (P.T.A.B. July 9, 2014). The Instant Petition challenges the same claims as the VW

Petition, based on the same grounds, using the same prior art references. The only differences between the Instant Petition and the VW Petition are the sections on Real Parties-In-Interest, Related Matters, Counsel, Grounds for Standing, and Discretionary Denial, which have been updated.

Further, while Petitioner's expert, Scott Andrews, is not the same expert as VW's expert, Jianzhong Jiao, Mr. Andrews's expert declaration submitted herein is substantively identical to Dr. Jiao's declaration submitted in the VW IPR.[1, 2] *See Everlight Elecs. Co., v. Document Security Sys., Inc.*, IPR2018-01260, Paper No. 12 at 6-7 (P.T.A.B. 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 (P.T.A.B. Oct. 30, 2018) (same); *Sun Pharmaceutical Industries Ltd. v. Merck Sharp & Dohme Corp.*, IPR2020-01072, Paper No. 12 at 7 (P.T.A.B. Sept. 1, 2020) (same).

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[1] The supporting expert declaration of Mr. Andrews submitted on behalf of Petitioner in this IPR agrees with the facts, analysis, and conclusions of the expert declaration of Dr. Jiao submitted on behalf of VW in the VW IPR. The declaration of Mr. Andrews does not contain any new opinions not included in Dr. Jiao's declaration.

[2] Moreover, Exhibit 1004 is the Curriculum Vitae of Mr. Andrews instead of Dr. Jiao.

Joinder would therefore have little, if any, impact on the VW IPR because no new grounds will be added, the schedule will not be affected, no additional briefing or discovery will be required, and no additional burdens will be placed on the Patent Owner, as detailed below. Accordingly, joinder is appropriate because it would ensure a just, speedy, and inexpensive resolution of these proceedings. *See Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (P.T.A.B. Aug. 24, 2016) (recognizing that the Board "routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.").

C. The Instant Petition Does Not Raise Any New Grounds of Unpatentability

The Instant Petition relies on the same grounds of unpatentability of claims 1-19 and 37-58 of the '503 Patent that were instituted in the VW IPR. *See* IPR2023-00335, Paper No. 11 (July 17, 2023). As discussed above, the evidence and arguments supporting the Instant Petition are substantively identical to the evidence and arguments supporting the VW Petition.

D. Joinder Will Not Affect the Schedule in the VW IPR

Joinder will not affect the schedule in the VW IPR, because Petitioner does not intend to seek modification of the deadlines set forth in the VW IPR Scheduling Order. *See* IPR2023-00335, Paper No. 12 (July 17, 2023). Since the Instant Petition does not raise any new arguments and is substantively identical to the VW Petition, there should

be no need for Patent Owner to submit a preliminary response to the Instant Petition. Joinder will allow the Board and the parties to focus on the merits of the unpatentability challenges to claims 1-19 and 37-58 of the '503 Patent in a single consolidated proceeding without duplication of effort, and in an efficient manner.

E. Joinder Will Simplify Briefing Because Petitioner Agrees to Consolidated Filings and an Understudy Role

Petitioner agrees to take an "understudy" role as long as VW remains a party to the VW IPR, which will simplify briefing and discovery.[3] *See, e.g.*, *Noven Pharm., Inc. v. Novartis AG*, IPR2014-00550, Paper 38 at 5 (P.T.A.B. April 10, 2015). In this role, Petitioner agrees to the following conditions:

(a) Petitioner will not make any substantive filings and shall be bound by the filings of VW, unless a filing concerns termination and settlement, or issues solely involving Petitioner.

(b) Petitioner will not present any argument or make any presentation at the oral hearing unless an issue solely involves Petitioner, or when addressing motions that do not affect VW.

(c) Petitioner will not seek to cross-examine or defend the cross-

[3] In the event that VW no longer participates in the IPR proceedings, Petitioner would take over primary responsibility for subsequent filings and discovery.

examination of any witness, unless the topic of cross-examination concerns issues solely involving Petitioner, within the time permitted by VW alone and with VW's agreement.

(d) Petitioner will not seek discovery from Patent Owner, unless issues arise that are unique to, and only applicable to, Petitioner.

(e) Petitioner will not rely on expert testimony beyond that submitted by VW unless and until VW is terminated as a party to the proceedings, prior to any necessary depositions. As explained above, while Petitioner's expert, Scott Andrews, is not the same expert as VW's expert, Jianzhong Jiao, Mr. Andrews's expert declaration submitted herein is substantively identical to Dr. Jiao's declaration submitted on behalf of VW.

F. Joinder Will Not Prejudice Patent Owner

Petitioner's joining of the VW IPR will 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, briefing or oral argument should be necessary as a result of the Instant Petition and joinder. Additionally, joinder will decrease the number of filings by the parties, eliminate duplication of effort, and will create case management efficiencies for the Board and Patent Owner.

III. CONCLUSION

For the reasons above, Petitioner respectfully requests that its Petition for *Inter Partes* Review of claims 1-19 and 37-58 of the '503 Patent be instituted and that Petitioner be joined to the VW IPR, IPR2023-00335.

Dated: August 14, 2023

Respectfully submitted,

HAUG PARTNERS LLP

/s/ Edgar H. Haug
Edgar H. Haug
Robert E. Colletti
Attorneys for Petitioner
Porsche Cars North America, Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on August 14, 2023, true and correct copies of the foregoing **Petitioner's Motion for Joinder Under 35 U.S.C. § 315(c), 37 C.F.R. § 42.22 and § 42.122(b)** and all associated exhibits were served in their entireties on the following party via FedEx Express®:

Brooks Kushman
1000 Town Center
22nd Floor
Southfield, MI 48075

Patent Center Correspondence
Address for U.S. Patent No. 10,894,503

HAUG PARTNERS LLP

/Robert E. Colletti /

Robert E. Colletti (Reg. No. 76,417)
Attorney for Petitioner
Porsche Cars North America, Inc.

Date: August 14, 2023

745 Fifth Avenue
New York, NY 10151
(212) 588-0800