

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCEDES-BENZ USA, LTD,

Petitioner,

v.

DAEDALUS PRIME LLC,

Patent Owner.

Case No.: IPR2023-01333

U.S. Patent No. 10,049,080

PATENT OWNER'S OPPOSITION TO
PETITIONER'S CONTINGENT MOTION FOR JOINDER

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I. INTRODUCTION

Petitioner, Mercedes-Benz USA LLC, seeks joinder with *Qualcomm Inc. v. Daedalus Prime LLC*, IPR2023-00567 (the “Qualcomm IPR”), but only if that IPR is instituted. Mot. at 1. While it is true that if the Qualcomm IPR is not instituted, Petitioner’s motion would be moot inasmuch as there would be no proceeding to join, the rules of practice do not make provision for conditional motions of this type and Petitioner did not obtain leave for filing its instant motion. Further, Petitioner has not indicated that Qualcomm has agreed to such joinder and nor has Petitioner agreed to rely entirely on, and be bound by, the expert declaration(s) and deposition(s) in the Qualcomm IPR and so has not met the requirements for being a true “understudy” in that proceeding. Accordingly, Patent Owner opposes, and respectfully requests that the Board deny Petitioner’s motion.

II. BACKGROUND

The Qualcomm IPR is presently pending, but no institution decision has yet been reached. Mercedes-Benz filed its petition and contingent motion for joinder on August 18, 2023. Mercedes-Benz characterizes its petition as being “substantively the same as the Qualcomm IPR petition [] challeng[ing] the same claims, on the same grounds, and rel[ying] on the

same prior art as the Qualcomm IPR petition.” *Id.* at 1-2. Yet, along with its petition Mercedes-Benz filed a supporting declaration by its own expert witness, *id.* at 5, and that declaration offers opinions not included in the expert declaration filed in the Qualcomm IPR. *See, e.g.*, Ex. 1034 at p.23, n. 5, n.6; p. 25, n. 7; p. 31, n. 8; pp. 43-44, n. 10. Mercedes-Benz has not agreed to rely entirely on, and be bound by, the expert declaration(s) and deposition(s) in the Qualcomm IPR, saying only that it “agrees to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the Qualcomm IPR if it is instituted.” Mot. at 2. This is important because should the Qualcomm IPR petitioners cease to participate in the Qualcomm IPR, Mercedes-Benz would seek to avoid being a mere “understudy.” *See id.* More particularly, Mercedes-Benz’ stipulation is inadequate, and does not address Patent Owner’s concern that, in the event the Qualcomm IPR petitioners were to exit the Qualcomm IPR, Mercedes-Benz will attempt a “re-do” of expert testimony, inconsistent with joinder proceedings. Accordingly, Patent Owner is compelled to file the present opposition.

III. ARGUMENT

Joinder is discretionary and not a matter of right. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122; *Unified Patents, Inc. v. Personalweb Techs. et al.*, IPR2014-00702, Paper 12, slip op. at 4 (PTAB July 24, 2014). The petitioner seeking joinder bears the burden of demonstrating it is entitled to joinder. 37 C.F.R. § 42.20(c). Moreover, the Board may impose limitations to ensure that a joinder petitioner assumes a true “understudy” role. *See, e.g., Noven Pharmaceuticals, Inc. v. Novartis AG*, IPR2014-00550, Paper 38, slip op. at 5 (PTAB Apr. 10, 2015) (adopting patent owner’s proposed limitations on joinder).

Mercedes-Benz’ notable omission of an agreement to be bound by the testimony of Qualcomm’s experts is prejudicial and inconsistent with this Board’s precedent and practice. The requirement for such agreement follows directly from the Board’s case law addressing similar circumstance, where aspiring joinder parties submit a “placeholder” declaration from their own experts. *See Z-Shade Co., Ltd. v. Caravan Canopy Int’l, Inc.*, IPR2020-01026, Paper 22, slip op. at 8 (PTAB May 17, 2021) (granting joinder where joinder petitioner “agree[ed] to rely entirely on, and be bound by, the expert declaration(s) and deposition(s) in the [primary] IPR, and ... waive its own expert declaration” if the primary petitioner “[did] not terminate its IPR

before its expert is deposed.”); *Samsung Elecs. Co., Ltd. v. Yu*, IPR2020-00492, Paper 6, slip op. at 7 (PTAB Aug. 12, 2020) (“Samsung agrees to be bound by the expert deposition and declarations of Apple’s expert, and Samsung will waive its own expert own expert declaration, unless Apple ceases to be an active participant in its IPR prior to its expert’s deposition). Indeed, the Board has recognized that this is one of the conditions “regularly cited in ... cases where joinder of a me-too petitioner is granted.” *Sun Pharm. Indus. Ltd. v. Merck Sharp and Dohme Corp.*, IPR2020-01060, Paper 15, slip op. at 8 (PTAB Sept. 1, 2020) (“Petitioner persuades us that it has agreed to play the role of a true and silent ‘understudy’ to Mylan in the joined proceeding—agreeing to conditions like those regularly cited in other Board cases where joinder of a me-too petition was granted. [Joinder Petitioner’s] Mot. 1, 5-7 (agreeing, for example, to rely on and be bound by the testimony of Mylan’s expert)”) (emphasis added).

Conversely, by not agreeing to be bound by the Qualcomm expert’s testimony, Mercedes-Benz leaves open the possibility that it may later seek to submit new testimony from its own expert, or rely on such testimony included in its expert’s existing declaration, thus changing the scope of a joined proceeding. In that case, Patent Owner would, at a minimum, need to seek a modification of any trial schedule to allow sufficient time for

additional discovery and response, which could add procedural complications and delay to the proceedings. *See, e.g., Mylan Pharmaceuticals, Inc., v. Janssen Oncology, Inc.*, IPR2016-01332, Paper 21, slip op. at 10-11 (PTAB Jan. 10, 2017) (denying joinder where movant had filed its own expert declarations, and did “not offer a practical way to accommodate the additional discovery without inconveniencing all involved or delaying the due dates in the [main] IPR.”).

In addition to the above, the conditional nature of Mercedes-Benz’ instant motion is not provided for under the Board’s rules of practice. Requests for joinder are provided for under 37 C.F.R. 42.122(b), however, there is no provision for making such a request conditional or contingent on factors of a petitioner’s choosing. Mercedes-Benz did not seek leave of the Board to file such a motion, notwithstanding that such leave is necessary for any motion not provided for as a matter of right. 37 C.F.R. 42.20(b). Nor did Mercedes-Benz contact the Board, the Patent Owner and the petitioner in the Qualcomm IPR to request a teleconference where issues such as those addressed herein might have been ironed out. *See* PTAB Consolidated Trial Practice Guide at 76 (November 2019). Accordingly, this motion should be denied.

IV. CONCLUSION

Because of the uncertainty caused by Mercedes-Benz' submission of a separate expert declaration coupled with its failure to agree be bound by the representations of Qualcomm's experts in the Qualcomm IPR, and because Mercedes-Benz' contingent motion is not provided for under the rules as of right and the Board did not authorize its filing, Patent Owner respectfully requests that the Board deny the motion.

Dated: September 15, 2023

Ascenda Law Group, PC
2150 N First St., Suite 420
San Jose, CA 95131
Tel: 866-877-4883
Email: tarek.fahmi@ascendalaw.com

Respectfully submitted,

/Tarek N. Fahmi/

Tarek N. Fahmi
Reg. No. 41,402

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing

PATENT OWNER'S OPPOSITION TO

PETITIONER'S CONTINGENT MOTION FOR JOINDER

was served on September 15, 2023, by filing this document through the PTAB P-TACTS System as well as by delivering a copy via email directed to the attorneys of record for the Petitioner at the following addresses:

Celine J. Crowson
Joseph J. Raffetto
Scott Hughes
Helen Y. Trac
Ryan Stephenson
Nicholas Rotz
Hogan Lovells US LLP
555 13th Street N.W.
Washington, D.C. 20004

Email:

celine.crowson@hogan.com
joseph.raffetto@hoganlovells.com
scott.hughes@hoganlovells.com
helen.trac@hoganlovells.com
ryan.stephenson@hoganlovells.com
nicholas.rotz@hoganlovells.com

The parties have agreed to electronic service in this proceeding.

Respectfully submitted,

Dated: September 15, 2023

/Tarek N. Fahmi/

Tarek N. Fahmi

Reg. No. 41,402

Ascenda Law Group, PC
2150 N First St., Suite 420
San Jose, CA 95131
Tel: 866-877-4883
Email: patents@ascendalaw.com