UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL INC., AND DELL TECHNOLOGIES INC.,

Petitioners,

v.

AX WIRELESS,

Patent Owner.

IPR 2024-00683
U.S. Patent 10,554,459

MOTION FOR JOINDER TO *INTER PARTES* REVIEW IPR2023-01138

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I. STATEMENT OF PRECISE RELIEF REQUESTED

Petitioners Dell Inc. and Dell Technologies Inc. ("Petitioners" or "Dell") move for joinder of their contemporaneously-filed Petition for *Inter Partes* Review ("IPR") of claims 1–3, 5, 7–11, and 13 of U.S. Patent No. 10,554,459 ("the '459 patent") with a pending IPR, *Intel Corp. v. AX Wireless*, IPR2023-01138 ("the Intel IPR" or "the Intel proceeding"), which the Board instituted on February 14, 2024.

The Intel IPR concerns the same patent and the same claims (1–3, 5, 7–11, and 13) as Dell's Petition. The prior art-related portions of Dell's Petition and supporting expert declaration are substantively identical to those submitted in the Intel IPR. Petitioners here assert that the same claims (1–3, 5, 7–11, and 13) are obvious over the same prior art based on the same arguments supported by the same expert as in the Intel IPR.

Petitioners agree to take an "understudy" role if joined. Joinder will not cause any delay in the resolution of the Intel IPR. The Intel IPR petitioner does not oppose Dell's joinder request. Joinder is appropriate because it will resolve the same patentability issues of the same patent, it will not delay the schedule that the Board has issued in the Intel IPR, and the parties in the Intel IPR will not be prejudiced.

II. STATEMENT OF MATERIAL FACTS

1. AX Wireless ("Patent Owner") purports to own the '459 patent.

2. Patent Owner has asserted the '459 patent against Petitioners in a

district court lawsuit: *AX Wireless LLC, v. Dell Inc., and Dell Technologies Inc.*, 2-22-cv-00277 (E.D. Tex.).

3. On June 30, 2023, Intel filed the Intel IPR, requesting cancellation of claims 1–3, 5, 7–11, and 13 of the ’459 patent. IPR2023-01138, Paper 2.

4. On February 14, 2024, the Board instituted the Intel IPR and entered a Scheduling Order. IPR2023-01138, Papers 10 and 11.

5. Along with this Motion for Joinder, Petitioners simultaneously file the Petition, which argues, among other things, that the same claims of the ’459 patent are obvious based on the same grounds and for the same reasons as set forth in the Intel IPR petition. The Petition is supported by the same expert declaration of Thomas F. La Porta, Ph.D. submitted in support of the Intel IPR petition.

6. The grounds proposed in the Petition are the same as those described in the Intel IPR petition—the Petition does not contain any additional arguments or evidence in support of the unpatentability of claims 1–3, 5, 7–11, and 13 of the ’459 patent. Exhibit 1048 to the Petition provides a comparison between the Petition and the Intel IPR petition, showing non-substantive edits and changes related to, for example, different parties filing the petition and the reasons *Fintiv* does not apply here.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Joinder is timely

This request is being submitted within the time period set forth in 37 C.F.R. § 42.122(b).

B. The applicable factors support joinder

The Board has discretion to join this IPR with the Intel IPR. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); *HTC v. Parthenon Unified Memory Architecture LLC*, IPR2017-00512, Paper 12 at 6 (PTAB June 1, 2017). In evaluating a motion for joinder, the Board considers the following factors: (1) the reasons why joinder is appropriate; (2) whether the petition raises any new grounds of unpatentability; (3) any impact joinder would have on the cost and trial schedule for the existing review; and (4) whether joinder will add to the complexity of briefing or discovery. *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013); Consolidated Trial Practice Guide 76 (Nov. 2019), https://go.usa.gov/xpvPF. These factors weigh in favor of joinder. As a result, the Board should exercise its discretion to allow joinder here.

1. Joinder is appropriate because Petitioners propose no new grounds of unpatentability (factors 1 and 2)

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. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9

(PTAB Aug. 24, 2016) (internal quotations and citations omitted) (emphasis in original). Joinder is appropriate here because the Petition asserts the same grounds and relies on the same evidence for unpatentability presented in the Intel IPR. *See* Exhibit 1048. Specifically, the Petition and the Intel IPR petition rely on the same prior art references in the same combinations. Moreover, the Petition and the Intel IPR petition rely on the same declaration of Thomas F. La Porta, Ph.D. The arguments in both petitions are identical; there are no new grounds of unpatentability asserted in the Petition.

As the same issues will be addressed in both proceedings, joinder makes sense. *See, e.g.*, *HTC*, IPR2017-00512, Paper 12 at 7 (granting motion for joinder where the second petition involved "the same claims, the same patent, the same prior art references, the same expert declaration, and the same arguments and rationales"); *Intel Corp. v. Demaray LLC*, IPR2021-01030, Paper 8 at 9–10 (PTAB Oct. 29, 2021) (similar).

2. Joinder will not impact the trial schedule or cost of the joined proceeding (factor 3)

Joinder will not prejudice the parties to the Intel IPR. Petitioners will not request any alterations to the trial schedule that the Board issued in the Intel IPR (IPR2023-01138, Paper 11), leaving that schedule unchanged.

Petitioners also agree to adopt a secondary, "understudy" role in the Intel IPR, if joined. *See, e.g.*, *Garmin Int'l, Inc. v. Philips North Am. LLC*, IPR2020-00910,

Paper 8 at 45, 47-50 (PTAB Nov. 19, 2020) (granting joinder where petitioners agreed to accept an "understudy" role); *Intel Corp.*, IPR2021-01030, Paper 8 at 9–10 (similar). Petitioners will assume a primary role only if the Intel IPR petitioner ceases its participation in that proceeding. Petitioners' agreement to take an "understudy" role removes any potential complication or delay caused by joinder, while providing the parties an opportunity to address all issues that may arise. *See, e.g.*, *Mylan Pharms. Inc. v. Novartis AG*, IPR2014-00550, Paper 38 at 5-6 (PTAB Apr. 10, 2015). The Intel IPR petitioner does not oppose Dell's joinder request. Joinder will not affect the cost of the Intel IPR for Patent Owner, the Intel IPR petitioner, or the Board.

3. Joinder will not complicate briefing and discovery (factor 4)

This factor favors joinder. If joinder is granted, Petitioners agree to take on an understudy role. Accordingly, joinder will not affect briefing and discovery. Those activities will proceed in the same way with or without joinder. In either case, Intel will file briefing and conduct discovery, and Petitioners will not be involved. Petitioners will become involved only if Intel exits the proceeding.

IV. CONCLUSION

For the foregoing reasons, Dell respectfully requests that the Board institute its Petition for *Inter Partes* Review of U.S. Patent No. 10,554,459 and join this proceeding with *Intel Corp. v. AX Wireless*, IPR2023-01138.

Dated: March 14, 2024

Respectfully submitted,

/*Jonathan R. Carter*/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that true copies of the foregoing **MOTION FOR JOINDER TO INTER PARTES REVIEW IPR2023-01138, POWER OF ATTORNEY AND EXHIBITS 1001-1048** have been served this 14th day of March 2024, by Federal Express delivery service on Patent Owner at the correspondence address for the attorney of record for the ’459 patent shown in USPTO PAIR:

Andrew Park
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and via email to the attorneys of record for Plaintiff in the concurrent *AX Wireless LLC, v. Dell Inc., and Dell Technologies Inc.,* 2-22-cv-00277 (EDTX)*, AX Wireless LLC, v. HP Inc.,* 2-22-cv-00279 (EDTX), and *AX Wireless LLC, v. Lenovo Group Ltd.,* 2-22-cv-00280 (EDTX) litigations:

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