

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GARMIN LTD.,
Petitioner

v.

SLYDE ANALYTICS, LLC,
Patent Owner

Inter Partes Review Case No. IPR2024-00765
U.S. Patent No. 8,588,033

**PETITIONER'S REPLY TO PATENT OWNER'S OPPOSITION TO
PETITIONER'S MOTION FOR JOINDER**

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I. THE *GENERAL PLASTIC* FACTORS DO NOT BAR JOINDER.

Slyde argues the *General Plastic* factors support denial of Garmin's joinder. However, *General Plastic* does not apply to the requested joinder in this case. *General Plastic* is applicable where “**the same petitioner** files ‘follow-on petitions’ against the same patents, after a first set of petitions was denied on the merits.” *Mercedes-Benz USA v. Carucel Investments*, IPR2019-01644, Paper 9 at 12 (PTAB Mar. 26, 2020) (citing *General Plastic*, Paper 19 at 2-3). As Garmin's motion explains, Garmin was not the original petitioner. Instead, Garmin is filing a motion for *joinder* to join a petition filed by *another* petitioner, Samsung. And it is undisputed that Garmin has **not previously** filed an IPR against the '033 Patent. Motion for Joinder at 8. Thus, *General Plastic* cannot apply because Garmin is not a serial petitioner

Further, there is no “**significant relationship**” between Samsung and Garmin that would otherwise invoke *General Plastic*. See *Facebook v. Palo Alto Research Center*, IPR2021-01294, Paper 13 at 9 (PTAB Jan. 25, 2022). In limited circumstances, “the Board [has] found that there was a significant relationship between the proposed petitioner and the prior petitioner because they had been co-defendants in a district court litigation, both were sued on the same products, and there was a license agreement between the parties related to the technology of the product.” *Id.* (Citing *Valve Corp. v. Elec. Scripting Prods., Inc.*, Case IPR2019-

00062, -00063, -00084, Paper 11 at 9-10 (PTAB Apr. 2, 2019) (precedential)). None of those facts are present here, and Slyde has not presented a shred of evidence showing otherwise. Moreover, the fact that the prior petitioner and the proposed petitioner at issue have both been sued by the same patent owner is not enough to establish a significant relationship that warrants the application of *General Plastic*. *Facebook*, IPR2021-01294, Paper 13 at 9-10 (holding although Facebook and Snap had both been sued by the same Patent Owner, the *General Plastic* factors were inapplicable because there was no evidence that the infringement allegations concerned the same products nor that there was a licensing agreement between the parties). While both Samsung and Garmin were sued by the same patent owner, the lawsuits were filed at different times, different products are being accused, there is no licensing agreement between the parties regarding the alleged infringing products, and Garmin has not coordinated with Samsung in any manner other than discussing their position on this motion. Therefore, no “significant relationship” exists between Samsung and Garmin, and the *General Plastic* factors are inapplicable.

II. GARMIN’S JOINDER WILL NOT COMPLICATE PROCEEDINGS.

Garmin requests to join and participate in this proceeding in the standard understudy role that is routinely accepted by the Board in other joinder scenarios. In this understudy role, Garmin agrees to consolidate common filings, to forgo the

introduction of new grounds, to be bound by any agreement between Patent Owner and Samsung concerning discovery and/or depositions, and to not receive any additional deposition examination time. These are all typical constraints on an “understudy” party and are routinely accepted by the Board. Motion for Joinder at 6-7; *See Noven Pharmaceuticals, Inc. v. Novartis AG*, IPR2014-00550, Paper 38 at 5 (PTAB Apr. 10, 2015). To the extent it was unclear, Garmin states that it **will not** assume an active role in the Samsung Proceeding unless and until the current petitioner ceases to participate. Motion for Joinder at 7. Nonetheless, Slyde seeks to leave the impression that Garmin’s role will be more active than promised and will needlessly complicate the proceeding. Patent Owner’s Opp. at 2-3. These concerns are baseless.

A. Garmin’s proposal for deposition time is a typical understudy proposal.

In Garmin’s motion for joinder, Garmin proposed that it be allowed to participate in depositions only within the time provided to Samsung. Patent Owner’s Opp. at 2. There is nothing strange about this request. Indeed, the Board has repeatedly found this request to be proper and routine within the understudy role. *See Noven Pharmaceuticals, Inc.*, IPR2014-00550, Paper 38 at 5; *See also Garmin International, Inc. v. Philips North America*, IPR 2020-00910, Paper 15 at 47-48 (PTAB Nov. 19, 2020); *Apple Inc. v. INVT SPE LLC*, IPR 2019-00958, Paper 9 at 7-8 (PTAB May 30, 2019); *Mylan Pharmaceuticals Inc. v. Novartis AG and LTS*

Lohmann Therapie-Systeme AG, IPR2015-00268, Paper 17 at 5 (PTAB Apr. 10, 2015); *Zillow Group, Inc. v. International Business Machines Corp.*, IPR2023-00259, Paper 7 at 8-11 (PTAB Apr. 20, 2023). Slyde has not presented any arguments showing why Garmin's request differs from this plethora of other proceedings where this identical language has been approved. Because the Board has routinely accepted Garmin's very proposed language regarding deposition time, Slyde's arguments should be disregarded.

B. Garmin's limited request to permit filings on issues that only concern Garmin addresses rarely occurring circumstances.

Garmin's proposal is routinely seen in joinder situations and seeks to address rare circumstances that are unlikely to occur, such as when the IPR proceedings appear to no longer be adversarial between the original petitioner and patent owner. *See CyWee Group LTD. v. ZTE (USA), Inc.*, 90 F.4th 1358 (Fed. Cir. 2024) (holding the PTAB Board was correct to allow the understudy party to file a motion in opposition and present oral arguments against Patent Owner's revised motion to amend because the original petitioner had no intentions of challenging the patentability of the amended claims"). To address such circumstances, the Board routinely allows an understudy to preserve the ability to protect its own unique interests where the original petitioner has stepped aside. *See Noven Pharmaceuticals, Inc.*, IPR2014-00550, Paper 38 at 5; *See also Garmin International, Inc. v. Philips North America*, IPR 2020-00910, Paper 15 at 47-48

(PTAB Nov. 19, 2020); *Apple Inc. v. INVT SPE LLC*, IPR 2019-00958, Paper 9 at 7-8 (PTAB May 30, 2019); *Mylan Pharmaceuticals Inc. v. Novartis AG and LTS Lohmann Therapie-Systeme AG*, IPR2015-00268, Paper 17 at 5; *Zillow Group, Inc. v. International Business Machines Corp.*, IPR2023-00259, Paper 7 at 8-11 (PTAB Apr. 20, 2023). While unlikely, it would be appropriate for Garmin to be able to file papers on its own in this situation. Accordingly, Garmin respectfully asks the Board to follow this long line of precedent approving this very language permitting Garmin to retain the ability to make its own filings if Samsung steps aside without fully terminating its role.

However, this situation should not be an impediment to granting Garmin's motion for joinder. In the event the Board finds that Garmin's request exceeds the role of the understudy, Garmin additionally agrees to limit any such filings by obtaining prior Board authorization for the same. *See AT&T Corp. v. Dali Wireless Inc.*, IPR2023-00844, Paper 7 at 11 (PTAB Sept. 13, 2023) (limiting filing power by forcing understudy party to seek Board authorization to file any paper on its own in the proceeding so long as original petitioner remains a non-terminated party in the proceeding).

Dated: June 21, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the above-captioned *Petitioner's Reply To Patent Owner's Opposition To Petitioner's Motion For Joinder* was served in its entirety on June 21, 2024, by filing this document through the Patent Trial and Appeal Case Tracking System as well as delivering a copy via electronic mail upon the following attorneys of record for the Patent Owner:

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