

Filed: April 19, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HL Klemove Corporation,
Petitioner,

v.

Foras Technologies Ltd.,
Patent Owner.

Case IPR2024-00813
U.S. Patent 7,502,958

**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 RELIEF REQUESTED

Petitioner HL Klemove Corporation (“HL Klemove” or “Petitioner”) respectfully request to join, pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), the concurrently filed petition for *inter partes* review (“IPR”) of U.S. Patent No. 7,502,958 (“the ’958 patent”) (“HL Klemove’s Petition”) with the previously instituted and currently pending IPR captioned *BMW of North America LLC and Robert Bosch LLC v. Foras Technologies Ltd.*, No. IPR2023-01373 (“BMW/Bosch IPR”).

HL Klemove only seeks an understudy role in the proceedings and so files a Petition that is substantively identical to the BMW/Bosch IPR. This motion and accompanying petition are timely, being filed within one month of the decision instituting trial in the BMW/Bosch IPR (Paper 11, issued March 20, 2024).

Under these circumstances (as discussed further below), joinder would create no additional burden for the Board, BMW, Bosch, or Foras Technologies Ltd. (“Foras” or “Patent Owner”) and would provide for “the just, speedy, and inexpensive resolution” of the validity of the ’958 patent. *See* 37 C.F.R. § 42.1(b).

Accordingly, HL Klemove respectfully requests that the Board grant this motion.

II. STATEMENT OF MATERIAL FACTS

1. On May 18, 2023, Foras filed a Complaint against Kia Corporation and Kia America, Inc. in the United States District Court for the Eastern District of Texas alleging infringement of the '958 patent. *Foras Technologies Limited v. Kia Corporation et al.*, Case No. 2-23-cv-00219 (“*Foras v. Kia* Action”).

2. On December 11, 2023, HL Klemove filed a Complaint against Foras in the United States District Court for the Eastern District of Virginia seeking a declaratory judgment that the HL Klemove products identified in the *Foras v. Kia* Action did not infringe the '958 patent.

3. On September 8, 2023, BMW of North America LLC and Robert Bosch LLC filed the BMW/Bosch IPR challenging claims 1-8 and 13-22 of the '958 patent.

4. On March 20, 2024, the Board instituted the BMW/Bosch IPR. *See BMW of North America LLC and Robert Bosch LLC v. Foras Technologies Ltd.*, No. IPR2023-01373, Paper 11 (PTAB March 20, 2024).

5. HL Klemove's Petition and this motion are being filed within one month of the decision instituting the BMW/Bosch IPR.

6. HL Klemove's petition has also been filed less than one year after Foras served its complaint on Kia, which was on May 19, 2023.

III. STATEMENT OF REASONS FOR REQUESTED RELIEF

A. Legal Standards

The Leahy-Smith America Invents Act (“AIA”) permits joinder of IPR proceedings. Joinder is governed by 35 U.S.C. § 315(c), which states:

(c) Joinder.— If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

A motion for joinder should (1) set forth 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. *Everlight Elecs. Co., Ltd., v. Document Security Sys., Inc.*, IPR2018-01244, Paper 15 at 5-6 (PTAB Sept. 27, 2018) (citing *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013)).

B. HL Klemove’s Motion For Joinder Is Timely

A motion for joinder is timely if the moving party files within one month of institution of the IPR for which joinder is requested. 37 C.F.R. §42.122(b). BMW/Bosch’s petition was instituted on March 20, 2024. *BMW*, IPR2023-01373, Paper 11 (PTAB March 20, 2024). HL Klemove’s current motion is thus timely as it is being filed within one month of the institution date.

C. Joinder Is Appropriate Because It Will Promote An Efficient Determination Of The Validity Of The '958 Patent Without Prejudice To Any Party

HL Klemove's Petition is nearly identical to the BMW/Bosch Petition, challenging the same claims of the '958 patent with the same prior art, on the same grounds and relying on a substantially identical expert declaration. The only differences between HL Klemove's Petition and BMW's and Bosch's Petition are the sections regarding Real Party-in-Interest, Related Matters, and Counsel (which have been appropriately updated) as well as the section discussing discretionary denials under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020). Accordingly, HL Klemove's Petition does not raise any new grounds and does not present any issues that would complicate or delay the BMW/Bosch IPR. Therefore a consolidated proceeding, including both HL Klemove and BMW/Bosch, will be more efficient and less wasteful, as only a single trial on these identical grounds would be required.

Joining HL Klemove as a party to the BMW/Bosch IPR would also not cause any prejudice to either BMW/Bosch or Foras. Foras, as the alleged patent owner, must respond to the common invalidity grounds identified in BMW/Bosch's (and HL Klemove's) Petition regardless of joinder. Thus, Foras bears no additional burden. Also, as HL Klemove would merely be an understudy, there would be no prejudice to BMW/Bosch. *See, e.g., Everlight*, IPR2018-01244, Paper 15 (PTAB

Sept. 27, 2018) (granting motion for joinder where petitioner, albeit using a different expert, acted as an understudy); *Celltrion, Inc., v. Genentech, Inc.*, IPR2018-01019, Paper 11 (PTAB Oct. 30, 2018) (same). Indeed, the case here is even stronger than in these cases, since HL Klemove is providing a declaration from the same expert that BMW/Bosch used, and that declaration is essentially identical to the one executed in the BMW/Bosch IPR.

D. HL Klemove's Petition Does Not Raise Any New Grounds Of Unpatentability

HL Klemove's Petition does not assert any new grounds of unpatentability. It challenges the same claims (1-8 and 13-22) of the '958 patent based on the same prior art, arguments, evidence, and grounds of unpatentability as the BMW/Bosch IPR.

E. Joinder Would Not Affect The Schedule In The BMW/Bosch IPR

Given that HL Klemove timely filed its Petition with this motion, that HL Klemove seeks an understudy role, and that HL Klemove's Petition raises no new grounds of unpatentability, joinder of HL Klemove would not affect the schedule in the IPR.

HL Klemove, for example, seeks no change to the Scheduling Order for the trial in the BMW/Bosch IPR. *BMW*, IPR2019-00340, Paper 12 (PTAB May 14,

2019). Moreover, HL Klemove's Petition relies on a declaration from the same expert as BMW/Bosch, meaning no additional expert discovery will be needed.

Further, as a silent understudy, HL Klemove will file no separate briefs outside of the consolidated filings and will not request separate oral hearing time.¹ As long as BMW and Bosch are parties, BMW and Bosch will retain responsibility for oral argument (including telephone hearings and appeals). In addition, as long as BMW and Bosch are parties, HL Klemove will not separately file or serve objections or discovery requests, will not receive separate cross examination or redirect time, will not separately cross examine or redirect any witness, and agrees that cross examinations will occur within the timeframe normally allotted to one party without a need for extension in light of the joinder. Only in the event that the BMW/Bosch IPR is terminated with respect to BMW and Bosch does HL Klemove intend to "step into the shoes" of the dismissed petitioners and materially participate in the joined proceedings.

Thus, the consolidated trial can proceed at the same pace as if HL Klemove were not joined and so HL Klemove's joinder will not affect the Board's ability to

¹ Except for Board-approved motions (if any), or to address said Board-approved motions, that do not affect BMW/Bosch or BMW/Bosch's position.

complete its review and final decision within the statutory time limits under 35 U.S.C. § 316(a)(11) and 37 C.F.R. § 42.100(c).

F. Briefing and Discovery Will Be Simplified

As stated in Section II.F, *supra*, HL Klemove agrees to an “understudy” role and does not raise any issues that are not already before the Board. In particular, HL Klemove agrees that, if joined, the following conditions will apply so long as BMW and Bosch remain active parties, as previously approved by the Board in similar circumstances:

(a) all filings by HL Klemove in the joined proceeding be consolidated with the filings of BMW and Bosch, unless a filing solely concerns issues that do not involve BMW and Bosch;

(b) HL Klemove shall not be permitted to raise any new grounds not instituted by the Board in the BMW/Bosch IPR, or introduce any argument or discovery not already introduced by BMW or Bosch;

(c) HL Klemove shall be bound by any agreement between Foras on the one hand, and BMW and Bosch on the other, concerning discovery and/or depositions;

(d) for depositions, HL Klemove shall not receive any direct examination, cross examination, or redirect time beyond that permitted for BMW and Bosch in

this proceeding alone under 37 C.F.R. § 42.53 or any agreement between Foras on the one hand, and BMW and Bosch on the other; and

(e) HL Klemove agrees to be bound by the expert deposition and declaration of BMW and Bosch expert, unless BMW and Bosch terminates their IPR prior to its expert's deposition or reply declaration.

HL Klemove would therefore only assume a primary role if BMW and Bosch ceased to participate in the proceedings. Briefing and discovery will be simplified in that there will be no need for redundant depositions, briefings, or hearings.

G. Joinder Will Create No Prejudice To Foras

Joinder of HL Klemove to the BMW/Bosch IPR will not create any additional burden on Foras. As noted above, because HL Klemove will be a silent understudy and the issues are identical, HL Klemove's joinder will not affect Foras. In particular, Foras can merely proceed as it would have had to in any event to respond to the issues in the already instituted BMW/Bosch IPR. In addition, joinder eliminates the need for Foras to respond to parallel IPR proceedings on identical grounds of unpatentability.

IV. CONCLUSION

For the foregoing reasons, HL Klemove respectfully requests that the Board grant its concurrently filed petition for IPR of the '958 patent and that the proceedings be joined.

Dated: April 19, 2024

Respectfully submitted,

/Jeffrey A. Miller/

Jeffrey A. Miller, Lead Counsel
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(a), the undersigned certifies that on April 19, 2024, a copy 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)** was served by overnight courier on the correspondence address of record indicated in the Patent Office's Patent Center system for U.S. Patent No. 7,502,958.

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Dated: April 19, 2024

By: /Jeffrey A. Miller/
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