

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VALEO SE
and
VALEO SCHALTER UND SENSOREN GMBH
Petitioners

v.

FORAS TECHNOLOGIES LTD.
Patent Owner

Case IPR2024-00823
U.S. Patent No. 7,502,958

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

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Petitioners Valeo SE and Valeo Schalter und Sensoren GmbH (“Petitioners” or “Valeo”) respectfully request their Petition for *Inter Partes* Review (“Petition”) of U.S. Patent No. 7,502,958 (“the ’958 Patent”) be granted and joined pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b) with the petition for *inter partes* review filed by BMW of North America, LLC and Robert Bosch LLC (collectively, “BMW”) concerning the ’958 Patent: *BMW of North America, LLC et al v. Foras Technologies Ltd.*, PTAB-IPR2023-01373 (the “BMW Petition” or “BMW IPR”). The BMW IPR was instituted on March 20, 2024.

Valeo’s Petition relies on the references cited and follows the arguments raised in the BMW Petition, and Valeo’s Petition is essentially a copy of the BMW Petition. It includes the identical grounds presented in the BMW Petition and therefore would create no additional burden for the Board, BMW or Patent Owner, Foras Technologies Ltd. (“Foras”), if joined. Further, upon joining the BMW IPR, Valeo will act as an “understudy” and will not assume an active role unless BMW is terminated from the proceedings. Accordingly, the proposed joinder will not unduly complicate the BMW IPR nor adversely impact its schedule. As such, the requested joinder will promote judicial efficiency in determining the patentability of the ’958 Patent without prejudice to Foras. Moreover, Valeo has spoken with BMW’s counsel of record in IPR2023-01373, and BMW does not oppose this requested

joinder. Accordingly, and for the reasons discussed below, joinder should be granted.

II. BACKGROUND AND RELATED PROCEEDINGS

Patent Office records indicate that the '958 Patent currently is assigned to Foras. To Valeo's knowledge, the '958 Patent is involved in the following law suits captioned *Foras Technologies Ltd. v. Toyota Motor North America, Inc. et al.*, 2:23-cv-00150 (E.D. Tex.), filed on Apr. 5, 2023; *Foras Technologies Ltd. v. Kia Corporation et al.*, 2:23-cv-00219 (E.D. Tex.), filed on May 18, 2023; *Foras Technologies Ltd. v. Bayerische Motoren Werke AG et al.*, 6:23-cv-00386 (W.D. Tex.), filed on May 19, 2023; *Foras Technologies Ltd. v. Nissan Motor Company, Ltd. et al.*, 1:23-cv-00640 (W.D. Tex.), filed on June 6, 2023; *Foras Technologies Ltd. v. Volkswagen AG et al.*, 2:23-cv-00314 (E.D. Tex.), filed on June 28, 2023; *Foras Technologies Ltd. v. Toyota Motor North America, Inc.*, 2:23-cv-00321 (E.D. Tex.), filed on July 12, 2023 (now dismissed); *HL Klemove Corp. v. Foras Technologies Ltd.*, 2:23-cv-00647 (E.D. Va.), filed on Dec. 11, 2023; *HL Klemove Corp. v. Foras Technologies Ltd.*, 1:23-cv-01689 (E.D. Va.), filed on Dec. 11, 2023 (transferred via intradistrict transfer in connection with 2:23-cv-00647); and *Bayerische Motoren Werke AG et al. v. Foras Technologies Ltd.*, 1:24-cv-00363 (E.D. Va.), filed on March 6, 2024. Further, the '958 Patent is involved in an *ex parte* reexamination filed by Unified Patents, Control No. 90/019,245 on Sept. 1,

2023.

On September 8, 2023, BMW filed a petition for *inter partes* review of the '958 Patent. *See* BMW IPR, IPR2023-01373, Paper 1 (Sept. 8, 2023). The Board granted institution on March 20, 2024. *See* BMW IPR, IPR2023-01373, Paper 11 (Institution Decision) (March 20, 2024). Valeo files this motion concurrently with its petition for *inter partes* review of the '958 Patent.

III. ARGUMENT

The Board may join any person who properly files a petition for *inter partes* review to a separate, ongoing *inter partes* review. 35 U.S.C. § 315(c). A petition that seeks joinder must be timely filed “no later than one month after the institution date of any *inter partes* review for which joinder is requested.” 37 C.F.R. § 42.122(b).

A motion for joinder should “(1) set forth the 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.” *AT&T Services, Inc. and DirecTV, LLC v. Broadband iTV, Inc.*, IPR 2021-00556, Paper 14 at 15 (PTAB Aug. 25, 2021) (“*AT&T*”) (citing *Kyocera Corp. v. SoftView LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013)).

Valeo’s motion is timely, and the Board should grant joinder because

consideration of the foregoing factors weighs in favor of joinder. Other panels have granted motions for joinder under similar circumstances. *See id.* at 17; *Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11 at 13-16 (PTAB Oct. 30, 2018) (granting motion for joinder when petitioner submitted a “copycat” petition and declaration, and agreed to take an “understudy role” in the proceedings); *Activision Blizzard, Inc. v. Game & Tech Co., Ltd.*, IPR2018-00157, Paper 12 at 16-19 (PTAB May 3, 2018) (same); *Veritas Techs, LLC v. Realtime Data LLC*, IPR2017-00364, Paper 6 at 4-8 (PTAB June 1, 2017) (same).

A. Valeo’s Motion for Joinder Is Timely

Valeo’s motion is timely as it was filed within one month of the March 20, 2024 institution date of the BMW IPR. *See* BMW IPR, IPR2023-01373, Paper 11 (Institution Decision) (March 20, 2024); 37 C.F.R. § 42.122(b) (requiring joinder petitions to be filed within one month of institution).

B. The *Kyocera* Factors Weigh in Favor of Joinder

Each of the four factors that the Board considers in motions for joinder favor granting Valeo’s motion. As shown below, joinder will not add further complication to the proceedings or cause prejudice to the parties. Moreover, joinder will significantly simplify briefing, discovery, and trial associated with review of the ’958 Patent.

1. Joinder of Valeo Is Appropriate Because It Will Promote an Efficient Determination of the Validity of the '958 Patent Without Prejudice to Any Party

If Valeo is joined as a party, the validity of the grounds raised in the BMW Petition and Valeo's Petition can be determined in a single proceeding. Valeo's Petition challenges the validity of the same claims of the '958 Patent on identical grounds to those in the BMW Petition. There are no substantive differences between BMW's and Valeo's Petitions.¹ *See* BMW IPR, IPR2023-01373, Paper 1 (Sept. 8, 2023). Valeo also relies on the same supporting evidence in its Petition as is relied on in the BMW Petition.² A consolidated proceeding, including both BMW and Valeo, will therefore be more efficient and less wasteful, as only a single trial on these common grounds would be required. *See, e.g., Oracle America*, IPR2016-01672, Paper 13 at 7 (PTAB March 7, 2017) (noting that "joining Oracle's identical

¹ The only differences between the Valeo Petition and the BMW Petition are the Mandatory Notices and Valeo's analysis of the discretionary factors the Board employs for its institution decisions.

² Valeo submits a declaration from Dr. Michael C. Brogioli, the same expert retained by BMW, on whom Valeo will rely only in the event that BMW is terminated from the proceedings. The supporting declaration submitted by Valeo is identical to the one filed by BMW.

challenges to those in the 1002 IPR will lead to greater efficiency while reducing the resources necessary from both Realtime and the Board”).

Joining Valeo as a party to the BMW *inter partes* review also would not cause any prejudice to either Foras or BMW. Foras, as the patent owner, must respond to the common invalidity grounds identified in BMW’s and Valeo’s Petitions regardless of joinder. Thus, Foras bears no additional burden and is, in fact, saved of the burden of responding to two separate petitions. Further, there is no prejudice to BMW as Valeo files a copycat petition and will take an understudy role. This factor favors joinder.

2. Valeo’s Petition Does Not Raise Any New Grounds of Unpatentability and Therefore Does Not Add Additional Complexity to the Grounds in BMW’s Petition

Valeo’s Petition challenges the validity of the ’958 Patent on identical grounds to those in the BMW Petition, which the Board already accepted. *See* BMW IPR, IPR2023-01373, Paper 1 (Sept. 8, 2023). Valeo’s petition and supporting materials are also substantially identical to those presented by BMW, save for the captions, petitioners, mandatory notices, and signature dates. Therefore, consolidation of this proceeding with BMW’s, via joinder of Valeo’s Petition, will not raise any new issues of unpatentability and will not impose any additional burden on the Board or add additional complexity to the case. The Board has granted joinder in similar situations. *See, e.g., AT&T*, Paper 14 at 17-18 (finding “joinder to the Dish IPR

would result in the just, speedy, and inexpensive resolution of Petitioner’s challenge” where Petitioner “challenge[d] the same claims...on the same grounds using the same prior art and evidence”); *Hyundai Motor Co. v. Am. Vehicular Scis. LLC*, IPR2014-01543, Paper 11 at 2-4 (PTAB Oct. 24, 2014); *Sony Corp. of Am. v. Network-1 Sec Solutions, Inc.*, IPR2013-00495, Paper 13 at 5-9 (PTAB Sept. 16, 2013); *Dell Inc. v. Network-1 Solutions, Inc.*, IPR2013-00385, Paper 17 at 6-10 (PTAB July 29, 2013); *Motorola Mobility*, IPR2013-00256, Paper 10 at 4-10 (PTAB June 20, 2013). This factor thus favors joinder.

3. Joinder Would Not Affect the Schedule in the BMW *Inter Partes* Review

Given that Valeo has agreed to participate only in a secondary “understudy” role absent dismissal of the BMW Petition or termination of BMW from the proceedings, joinder would not affect the schedule of the forthcoming trial. In particular, Valeo has agreed, as long as BMW remains a party to the review, not to (1) produce its own testifying witnesses; (2) file substantive papers; (3) separately file or serve objections or discovery requests; (4) seek separate cross examination or redirect time, nor separately cross examine or redirect any witness; and (5) separately argue during oral argument, including telephone hearings and appeals. Further, if BMW is terminated from the case prior to any necessary deposition, Valeo will continue to rely on the opinions and testimony of BMW’s expert. Thus, no additional depositions would be necessary and no adjustments to the schedule would

be required. Thus, the consolidated trial and entire *inter partes* review proceeding could proceed at the same pace as if Valeo were not joined. *Torrent Pharm Ltd., v. UCB Pharma GMBH*, IPR2016-01636, Paper 10 at 5 (PTAB Dec. 7, 2016) (granting joinder and proceeding with same schedule as if petitioner was not joined); *Amerigen Pharm Ltd. v. UCB Pharma GMBH*, IPR2016-01665, Paper 8 at 6 (PTAB Dec. 7, 2016) (same); *see also, AT&T*, Paper 14 at 18 (finding copycat petition had no effect on trial schedule).

4. Joinder Will Simplify Briefing and Discovery

Joinder will simplify briefing and discovery relative to maintaining two separate petitions because Valeo has agreed to take an understudy role. With Valeo's understudy role, Foras would only need to respond to one set of papers. Further, as discussed above, as long as BMW is a party to the review, Valeo will not separately file or serve objections or discovery requests. Thus, joinder would simplify the proceedings.

IV. CONCLUSION

For the foregoing reasons, Valeo respectfully requests that the Board grant its concurrently filed Petition for *inter partes* review of the '958 Patent and join the grounds of invalidity raised therein with the BMW IPR, IPR2023-01373.

Dated: April 18, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4)(i) *et seq.* and 42.105(b), the undersigned certifies that on April 18, 2024, a true and correct copy of this Motion for Joinder was provided via Federal Express, cost prepaid, to the Patent Owner by service the correspondence address of record as follows:

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A courtesy copy was also served by electronic mail on Patent Owner's and BMW's counsel of record in IPR2023-01373:

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