

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Shenzhen Waydoo Intelligence Technology Co., Ltd.,
Petitioner

v.

MHL Custom, Inc.,
Patent Owner

Case No. IPR2024-00998

Patent No. 9,359,044

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

I. INTRODUCTION

Petitioner moves the Patent Trial and Appeal Board (“Board”) for joinder of this *inter partes* review (Case No. **IPR2024-00998**), “Waydoo IPR”) to an earlier *inter partes* review case filed by Foil Boarding Company, Inc. (Case No. **IPR2024-00086**, “Foil IPR”). The Waydoo IPR is concurrently filed with this motion and is intentionally identical to the Foil IPR in all substantive aspects. Both seek *inter partes* (“IPR”) review of claims 1, 2, 5-8, 10-15, 17-18, and 20-21 (the “Challenged Claims”) of MHL Custom Inc.’s (“Patent Owner” or “PO”) U.S. 9,359,044 (the “’044 Patent”). Further, the Waydoo and Foil IPRs rely upon the same analytical framework (*e.g.*, same expert declarant and prior art) in addressing the Challenged Claims. Accordingly, resolving the Waydoo and Foil IPRs will necessarily involve considering the same issues by all parties and the Board.

Petitioner is filing this petition and joinder motion to ensure that the instituted trial is completed if the petitioner in the Foil IPR reaches a settlement with the PO. Joinder of these proceedings also presents the best opportunity to secure the just, speedy, and inexpensive resolution of the related proceedings without any prejudice to the PO. This includes consolidated filings and discovery and eliminating the duplicate hearings and briefing that might otherwise be required. Joinder should also provide for case-management efficiencies for the Board.

Given the similarities of the proceedings and the efficiencies that can be realized via joinder, Petitioner respectfully requests that the Board join the Waydoo IPR with the Foil IPR.

II. BACKGROUND

Foil filed a petition requesting *inter partes* review of the '044 Patent on October 26, 2023. Foil IPR, Paper 2.

The Waydoo IPR and Foil IPR involve different petitioners and real parties-in-interest. *Compare* Waydoo IPR, Petition at 5 (identifying real party-in-interest) *with* Foil IPR, Paper 2 at 5 (identifying real party-in-interest). Patent Owner has asserted the '044 Patent in (1) *MHL Custom, Inc. v. Avante Innovations, LLC*, 3:20-cv-01648 (S.D. Cal.) (settled); (2) *MHL Custom, Inc. v. Waydoo USA, Inc. et al*, 1:21-cv-00091 (D. Del.) (pending); and (3) *MHL Custom, Inc. v. Foil Boarding Company, Inc.*, 3:22-cv-21258 (N.D. Fla.) (pending).

III. LEGAL STANDARD

When more than one petition for *inter partes* review of the same patent is properly filed and those petitions warrant institution, the Board has the authority and discretion to join the proceedings. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b). Joinder of one *inter partes* review with another *inter partes* review is appropriate where it secures the just, speedy, and inexpensive resolution of the *inter partes* review proceedings. *See* 37 C.F.R. § 42.1(b).

A petitioner may request joinder, without prior authorization, up to one month after the institution date of the proceeding to which joinder is requested. 37 C.F.R. § 42.122(b) (addressing timing to request joinder); *Taiwan Semiconductor Mfg. Co., Ltd. v. Zond LLC*, IPR2014-00781 and IPR2014-782, Paper 5 at 3 (May 29, 2014) (prior authorization not required before one month deadline). Typically, such a joinder request: (1) sets forth the reasons why joinder is appropriate; (2) identifies any new grounds of unpatentability asserted in the petition; and (3) explains what impact (if any) joinder would have on the trial schedule for the existing review. *See, e.g., Microsoft Corp. v. IPR Licensing, Inc.*, IPR2015-00074, Paper 21 at 4 (Mar. 4, 2015). A joinder request can additionally address specifically how briefing and discovery may be simplified. *See, e.g., Sony Corp. of Am. v. Network-1 Security Solutions, Inc.*, IPR2013-00495, Paper 13 at 3 (Sep. 16, 2013); *Fujitsu Semiconductor Ltd. v. Zond, LLC*, IPR2014-00845, Paper 14 at 304 (Oct. 2, 2014). Petitioner addresses each of these points below.

IV. ANALYSIS

Given that the *inter partes* review of the '044 Patent was instituted based on the Foil IPR, Petitioner respectfully requests that the Board grant this motion for joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b).

A. This Joinder Motion Is Timely

This motion is timely. Under 37 C.F.R. § 42.122(b), joinder can be

requested without prior authorization no later than one month after the institution date of the proceeding to which joinder is requested. *Taiwan Semiconductor*, IPR2014-00781 and IPR2014-782, Paper 5 at 3. Because this motion is being filed within one month after the Board’s decision instituting trial in the Foil IPR (May 28, 2024), it meets the timing requirements of § 42.122(b). *See, e.g., Biotronik, Inc. v. Atlas IP LLC*, IPR2015-00534, Paper 10 (Feb. 25, 2015) (granting motion for joinder filed concurrently with institution of IPR review).

B. Joinder Is Appropriate

Joinder of the Waydoo IPR with the Foil IPR is the most practical way to secure the just, speedy, and inexpensive resolution of these related proceedings. *See* 37 C.F.R. § 42.1(b). The petition in the Waydoo IPR is intentionally identical to the petition in the Foil IPR in all substantive aspects.¹ That is, the same claims are challenged (1, 2, 5-8, 10-15, 17-18, and 20-21 of the ’044 patent) based on the same prior art under the same grounds. The same expert declarant is used, and the expert’s declarations in the two cases are substantively identical. Further, unity of exhibits and exhibit numbering (particularly with respect to prior art) with the Foil IPR have also been maintained, with only non-substantive minor exceptions such

¹ Minor changes were made to the Petition to properly identify the Petitioner. An analysis of discretionary-denial issues was also added.

as to the exhibit stamps. Accordingly, resolving the Waydoo IPR and Foil IPR will necessarily involve considering the same issues and same papers. Joining these *inter partes* reviews thus presents an opportunity to streamline review of the '044 Patent's Challenged Claims and eliminate unnecessary duplication of filings, papers, and efforts of the Petitioner, the PO, and the Board. On the other hand, if the Waydoo IPR and Foil IPR proceed separately, duplicate effort could result. Petitioner's counsel reached out to counsel for Foil to confirm their non-opposition to this joinder request, but was eventually told that, absent some form of a business arrangement, Foil would not agree to provide non-opposition. Ex. 1024 (email chain with Foil's counsel regarding same).

C. No New Grounds of Unpatentability

The Waydoo IPR raises no new grounds of unpatentability from those raised in the Foil IPR. This is because, as noted above, the petitions and expert declarations in the Waydoo IPR and Foil IPR are substantively identical.

D. No Impact on IPR Trial Schedule

This motion is being filed after the Board's institution decision on the Foil IPR, and Petitioner has agreed to adhere to all applicable deadlines set forth in the Foil IPR Scheduling Order. Accordingly, the trial schedule for the Foil IPR should not be adversely affected.

Moreover, as discussed below, Waydoo is willing to limit its participation in

the proceeding as a “silent understudy” to Foil, only assuming an active role in the event that Foil ceases active participation. Waydoo does not anticipate that any extension of the trial schedule will be required as a result of joinder.

E. Consolidated Filings and Discovery

As a “silent understudy,” Waydoo agrees that, if joined, the following conditions will apply so long as Foil remains an active party, as previously approved by the Board in other joinder circumstances:

(a) All filings by Waydoo in the joined proceeding will be consolidated with the filings of Foil, unless a filing solely concerns issues that do not involve Foil;

(b) So long as Foil remains an active participant, Waydoo shall not be permitted to raise any new grounds not instituted by the Board in the Foil IPR or introduce any argument not already introduced by Foil; and

(c) With regard to taking of testimony, Waydoo will abide by 37 C.F.R. § 42.53 or any agreement between the Patent Owner and Foil concerning the provision of testimony. *See DRL Pharms. Inc. v. Novartis AG*, IPR2015-00268, Paper 17 at 5–6 (PTAB Apr. 10, 2015) (finding the same proposed limitations “are consistent with the ‘understudy’ role that Petitioner agrees to assume, as well as Petitioner’s assertion that its presence would not require introducing any additional arguments, briefing, or discovery.”). Waydoo is also willing to abide by any additional conditions that the Board deems appropriate.

F. Joinder Will Streamline the Proceedings and Result in No Prejudice to Patent Owner

Joinder will streamline the proceedings and reduce the costs and burden on Petitioner, PO, and the Board. Joining these proceedings will eliminate duplicate papers that must be filed, reviewed, and managed in each proceeding if the proceedings are not joined. Joinder will therefore also create case management efficiencies for the Board and all parties. Further, joinder will also reduce by half the time and expense for depositions and other discovery that would otherwise accompany separate IPR proceedings. As such, joinder will simplify briefing and discovery, without any foreseeable prejudice to PO.²

V. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Board institute its Petition for *Inter Partes* Review of U.S. Patent No. 9,359,044 and grant joinder of the Waydoo IPR with the Foil IPR.

² The argument that joinder may theoretically frustrate settlement between any particular petitioner and Patent Owner is not a basis to deny joinder because that same possibility exists in every joinder situation. *Global Foundries U.S. Inc. v . Godo Kaisha IP Bridge 1*, IPR2017-00925 and IPR2017-00926, Paper 13 at 10 (June 9, 2017).

Dated: June 6, 2024

Respectfully submitted,

/ Alexander B. Stein /

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Lead Counsel for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105, lead counsel for Petitioner hereby certifies that on June 6, 2024, a copy of the foregoing PETITIONER'S MOTION FOR JOINDER was sent via Priority Mail Express to the correspondence address of record for the '044 patent:

Lerner David LLP
20 Commerce Drive, Suite 400
Cranford, NJ 07016
UNITED STATES

A courtesy copy of this PETITIONER'S MOTION FOR JOINDER was also served via email on June 6, 2024 on Patent Owner's counsel of record in *MHL Custom, Inc. v. Waydoo USA, Inc. et al*, DDE-1-21-cv-00091:

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Dated: June 6, 2024

Respectfully Submitted,

/ Alexander B. Stein /
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