UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOMBARDIER RECREATIONAL PRODUCTS INC.

Petitioner,

v.

MHL CUSTOM INC.

Patent Owner.

Case No. IPR2024-01107

U.S. Patent No. 9,586,659

PETITIONER'S MOTION FOR JOINDER OF IPR2024-00085 UNDER 35 U.S.C. § 315(c) AND 37 C.F.R. §§42.122(c) AND 42.122(b)

I. INTRODUCTION

Bombardier Recreational Products Inc. ("Petitioner") files the present petition for inter partes review IPR2024-01107 (the "BRP IPR") and moves for joinder of IPR2024-00085, filed by Foil Boarding Company, Inc. (the "Foil Boarding IPR"). The BRP IPR is substantively identical to the Foil Boarding IPR in all substantive respects, includes identical exhibits, and relies upon the same expert declarant. Petitioner does not seek to alter the grounds upon which the Board has already instituted the Foil Boarding IPR, and seeks no change in the existing schedule for that IPR proceeding. Petitioner respectfully request an opportunity to join with the Foil Boarding IPR solely as an "understudy," where Petitioner would only assume an active role in the event Foil Boarding settles with Patent Owner MHL Custom Inc. and moves to terminate the Foil Boarding IPR, or in which Foil Boarding indicates that it is no longer willing or financially able to prosecute the Foil Boarding IPR.

II. BACKGROUND AND RELATED PROCEEDINGS

MHL Custom is the owner of U.S. Patent No. 9,586,659 (the "'659 Patent") and has asserted infringement of this patent in the following cases: *MHL Custom, Inc. v. Avante Innovations, LLC*, Case No. 3-20-cv-01648 (S.D. Cal.) (terminated); *MHL Custom, Inc. v. Waydoo USA*, Case No. 1-21-cv-00091 (D. Del.) ("Waydoo

Litigation"); *MHL Custom, Inc. v. Foil Boarding Company, Inc.*, Case No. 3-22-cv-21258 (N.D. F.L.) (stayed) ("Foil Boarding Litigation").

On October 26, 2023, Foil Boarding filed a Petition requesting an inter partes review of claims 1, 2, 4-5, 7-11, 13, and 15 of the '659 Patent. MHL Custom filed a Preliminary Response to the Petition, Petitioner filed a Reply, and MHL Custom filed a Sur-reply. The Board instituted the Foil Boarding IPR on May 28, 2024. The '659 Patent is also at issue in *Shenzhen Waydoo Intelligence Technology Co., Ltd. v. MHL Custom, Inc.*, IPR2024-00999 (PTAB) (filed June 6, 2024), in which Shenzhen Waydoo Intelligence Technology Co., Ltd. requested to join the Foil Boarding IPR.

III. DISCUSSION

Petitioner respectfully requests that the Board exercise its discretion to grant joinder of the BRP IPR and the Foil Boarding IPR proceedings pursuant to 35 U.S.C. § 315(c), 37 C.F.R. § 42.22, and 37 C.F.R. § 42.122(b). In support of this motion, Petitioner proposes consolidated filings and other procedural accommodations designed to streamline the proceedings.

A. Reasons Why Joinder Is Appropriate

Joinder is appropriate in this case because it is the most expedient way to secure the just, speedy, and inexpensive resolution of the related proceedings. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b). Intentionally, the BRP IPR is substantively identical to the corresponding Foil Boarding IPR in an effort to avoid multiplication

of issues before the Board. Given the duplicative nature of these petitions, joinder of the related proceedings is appropriate. Further, Petitioner will agree to consolidated filings and discovery.

1. Substantively Identical Petitions

Petitioner represents that the BRP IPR is identical to the Foil Boarding IPR in all substantive respects. It includes identical grounds, analysis, and exhibits and relies upon the same expert declarant and substantively identical declaration. Accordingly, if instituted, maintaining the BRP IPR proceeding separate from that of Foil Boarding would entail needless duplication of effort.

2. Consolidated Filing And Discovery

Because the grounds of unpatentability in the BRP IPR and Foil Boarding IPR are the same, the case is amenable to consolidated filings. Petitioner will agree to consolidated filings for all substantive papers in the proceeding (e.g., Reply to the Patent Owner's Response, Opposition to Motion to Amend, Motion to Exclude Evidence, Opposition to Motion to Exclude Evidence and Reply). Specifically, Petitioner will agree to incorporate its filings with those of Foil Boarding in a consolidated filing, subject to the applicable rules for one party on page limits. Foil Boarding will be responsible for the consolidated filings unless Foil Boarding ceases to participate in the IPR proceeding.

Petitioner agrees not to be permitted any arguments separate from those advanced by Petitioner and Foil Boarding in the consolidated filings. These limitations avoid lengthy and duplicative briefing.

Consolidated discovery is also appropriate given that Petitioner and Foil Boarding are using the same expert declarant, who has submitted the same, substantively identical declarations in the proceedings. Foil Boarding and Petitioner (consistent with the understudy role) will designate an attorney to conduct the cross-examination of any given witness produced by MHL Custom and the redirect of any given witness produced by Foil Boarding (or Petitioner) within the timeframe allotted by the rules for one party. Petitioner will not receive any separate cross-examination or redirect time. Petitioner will agree to the foregoing conditions regarding consolidated filings and discovery even in the event other IPRs filed by other, third-party petitioners are joined with the Foil Boarding IPR. Petitioner recognizes that Waydoo has already moved for joinder with the Foil Boarding IPR. If Waydoo's motion is granted and Foil Boarding ceases to prosecute the Foil Boarding IPR, Petitioner agrees to take the understudy role to Waydoo.

B. No New Grounds Of Patentability

The BRP IPR raises no new grounds of unpatentability from those of the Foil Boarding IPR because, in fact, the petitions are substantively identical.

C. No Impact On IPR Trial Schedule

The trial schedule for the Foil Boarding IPR would not need to be delayed to effect joinder, and the joint proceeding would allow the Board and parties to focus on the merits in one consolidated proceeding without unnecessary duplication of effort, and in a timely manner.

D. Briefing And Discovery Will Be Simplified

Joinder will simplify briefing and discovery because Petitioner seeks an order similar to that issued in *Motorola Mobility LLC v. Softview LLC*, IPR2013-00256 (PTAB June 20, 2013) (Paper 10). As discussed above, Petitioner and Foil Boarding will engage in consolidated filings and discovery, which will simplify the briefing and discovery process.

E. No Prejudice To MHL Custom If Proceedings Are Joined

Petitioner proposes joinder to streamline the proceedings and reduce the costs and burdens on the parties. Petitioner believes joinder will achieve these goals for several reasons. First, joinder will most certainly decrease the number of papers the parties must file, by eliminating a duplicative proceeding. Second, joinder will also reduce by half the time and expense for depositions and other discovery required in separate proceedings. Third, joinder creates case management efficiencies for the Board and parties without any prejudice to MHL Custom.

IV. PROPOSED ORDER

Petitioner proposes a joinder order for consideration by the Board as follows:

- The BRP IPR will be instituted and will be joined with the Foil Boarding IPR on the same grounds.
- The scheduling order for the Foil Boarding IPR will apply for the joined proceedings.
- Throughout the proceedings, Foil Boarding and BRP will file papers as consolidated filings, except for motions that do not involve the other party, in accordance with the Board's established rules regarding page limits. So long as they both continue to participate in the joined proceedings, Foil Boarding and Petitioner will identify each such filing as a Consolidated Filing and will be responsible for completing all consolidated filings.
- Foil Boarding and Petitioner will designate an attorney to conduct the cross examination of any given witness produced by MHL Custom and the redirect of any given witness produced by Foil Boarding or Petitioner within the timeframe normally allotted by the rules for one party. Petitioner will not receive any separate cross-examination or redirect time.
- MHL Custom will conduct any cross examination of any given witness produced by Foil Boarding (and/or Petitioner) and the redirect of any given witness produced by MHL Custom within the timeframe

normally allotted by the rules for one cross-examination or redirect examination.

V. CONCLUSION

For the foregoing reasons, if the Director institutes inter partes review, Petitioner respectfully requests that the Board grant joinder of the BRP IPR and the Foil Boarding IPR proceedings.

Respectfully submitted,

Dated: June 28, 2024

By: /David L. Cavanaugh/
David L. Cavanaugh (Reg. No. 36,476)
Counsel for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on June 28, 2024, I caused a true and correct copy of the foregoing "PETITIONER'S MOTION FOR JOINDER OF IPR2024-00085 UNDER 35 U.S.C. § 315(c) AND 37 C.F.R. §§ 42.22 AND 42.122(b)" to be served via express mail on the Patent Owner at the following correspondence address of record as listed in Patent Center:

LERNER DAVID LLP
20 Commerce Drive
Cranford, NJ 07016

A courtesy copy has also been provided via electronic mail to counsel for Patent Owner in IPR2024-00085 at the following addresses:

Robert J. Theuerkauf (rjt@grayice.com)
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By: /Alexander J. Nemtzow/
Alexander J Nemtzow (Reg. No. 82,130)