

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MENARD, INC.,

Petitioner,

v.

Signify Holding B.V.,

Patent Owner

Inter Partes Review No.: IPR2024-01469
U.S. Patent No. 10,299,336

**MOTION FOR JOINDER UNDER 35 U.S.C. § 325(c)
AND 37 C.F.R. §§ 42.22 AND 42.122(b)**

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Petitioner, Menard, Inc. (“Menard”), respectfully requests joinder of the concurrently filed petition for *inter partes* review of U.S. Patent. No. 10,299,336 (the “’336 Patent”) (IPR2024-01469) with *Luminex Int’l Co., Ltd. v. Signify Holdings B.V.*, IPR2024-00101 (P.T.A.B), filed October 25, 2023, and instituted on September 9, 2024 (“the Luminex IPR”). See IPR2024-00101, Paper 14.

The instant Petition is substantially the same of the Luminex IPR: it involves the same patent, same claims, same grounds of unpatentability, and the same evidence (including the same prior art combinations supported by the same expert declaration) as the Luminex IPR. If joined, Menard will assume a “silent understudy” role and will not take an active role in the *inter partes* review proceeding unless the Luminex Petitioner ceases to participate in the instituted IPR. Thus, the proposed joinder will neither unduly complicate the Luminex IPR, nor delay its schedule. As such, joinder will promote judicial efficiency in determining patentability in the Luminex IPR with prejudice to the Patent Owner.

This motion for Joinder, and accompanying Petition, are timely because they are filed less than one month after a decision instituting trial in the Luminex IPR. 37 C.F.R. § 42.122(b). Additionally, this motion and petition are not time barred by the time period set forth in 37 C.F.R. § 42.101(b). 37 C.F.R. § 42.122(b) (“The

time period in § 42.101(b) shall not apply when the petition is accompanied by a request for joinder.”).

II. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Leahy-Smith America Invents Act (AIA) permits joinder of *inter partes* review (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.

The AIA’s legislative history makes clear that joinder is to be liberally granted. 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011)(statement of Sen. Kyl). As joinder should be liberally granted the factors *General Plastic Indus. Co. Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16 (Sept. 6, 2017) favor institution, as Menard has not previously filed a petition challenging the same claims of the ‘681 patent.¹

¹ The other factors are either also positive or neutral. For example, Factor 6, which is the “finite resources of the Board,” favors institution as Menard is presenting the

A motion for joinder should “(1) set forth 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.” *Dell Inc. v. Network-1 Sec. Solutions, Inc.*, IPR2013-00385, Paper 17, at 4 (PTAB July 29, 1013); *Hyundai Motor Co. v. Am. Vehicular Scis. LLC*, IPR2014-01543, Paper 11, at 3 (Oct. 24, 2014); *Macronix Int’l Co. v. Spansion*, IPR2014-00898, Paper 15, at 4 (Aug. 13, 2014).

B. Menard’s Motion for Joinder is Timely

A motion for joinder is timely if the moving party files one month of institution of the *inter partes* review for which joinder is requested 37 C.F.R. § 42.122(b). Because Menard filed this motion within one month of the September 9, 2024 decision on institution of the Luminex IPR, this motion is timely.

same challenges, arguments, and evidence relied upon in the Luminex IPR. For the same reason, Signify’s Preliminary Response was not used as a roadmap for this Petition. And as discussed in the Motion, joinder would have no impact on the trial schedule for the Luminex IPR.

C. Joinder is Appropriate

Joinder is appropriate because Menard's Petition does not raise any new grounds of unpatentability and does not present issues that might complicate or delay the Luminex IPR. *See Enzymotec Ltd. v. Neptune Techs & Bioresources, Inc.*, IPR2014-00556, Paper 19 (PTAB July 9, 2014). Menard's petition is substantially identical to the petition in the Luminex IPR, challenging the same claims of the '336 Patent on the same grounds and relying on the same expert testimony. Thus, the only different between Menard's Petition and the petition filed in the Luminex IPR, besides changing party names, are the sections on Grounds For Standing, the description of the parallel litigation, Real Party-In-Interest, Related Matters, and Counsel, which have been appropriately updated.

Joinder would, therefore, have little, if any, impact on the Luminex IPR, the schedule would not be affected, no additional briefing or discovery would be required, and no additional burdens would be placed on any party or the PTAB, as detailed below.

1. No New Grounds of Unpatentability in the Petition

Menard's Petition does not assert any new grounds of unpatentability. It challenges the same claims (1-20) of the '336 Patent based on the same arguments and analysis, prior art, evidence (including the expert declaration) as the Luminex

IPR. *See, e.g., Hyundai*, IPR2014-01543, Paper 11, at 2-4; *Dell*, IPR 2013-00385, Paper 17, at 6-10.

2. No Impact on the Schedule for the Existing IPR Proceeding

Because Menard's Petition raises no new grounds of unpatentability, and because a Scheduling Order has been established for the Luminex IPR less than one month ago, joinder should have no impact on the schedule of the Luminex IPR. *See LG v. Memory Integrity, LLC*, IPR2015-01353, Paper 11, at 6 (Oct. 5, 2015) (granting IPR motion for joinder where "joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]). Menard will adhere to all applicable deadlines set in the Scheduling Order for the Luminex IPR.

Menard is willing to limit its participation in this proceeding to a "silent understudy." In the event that the Luminex IPR is terminated with respect to the Luminex Petitioner, only then does Menard intend to substantively participate in the joined proceedings. Accordingly, for the reasons stated above, joinder of Menard to the Luminex IPR will not affect the Board's ability to 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).

3. Briefing and Discovery Will be Simplified

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

(a) all filings by Menard in the joined proceeding be consolidated with the filings of Luminex, unless a filing solely concerns issues that do not involve Luminex;

(b) Menard shall not be permitted to raise any new grounds not instituted by the Board in the Luminex IPR, or introduce any argument not already introduced by Luminex; and

(c) with regard to taking of testimony, Menard will abide by 37 C.F.R. § 42.53 or any agreement between the Patent Owner and Luminex. *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.”).

Menard is also willing to abide by any additional conditions the Board deems appropriate.

4. No Prejudice to Patent Owner

Joinder of Petitioner to the Mylan IPR will not create any additional burden on the Patent Owner. The Patent Owner need not expend any additional resources above and beyond those required in the current Luminex IPR.²

III. CONCLUSION

For the reasons discussed above, Menard respectfully requests that its Petition for *inter partes* review of the '336 Patent be granted and that the proceeding be joined with IPR2024-00101.

Respectfully submitted,

Date: September 23, 2024

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² The argument that joinder may frustrate settlement between Luminex 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 (PTAB June 9, 2017).

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing petition for Inter Partes Review of U.S. Patent No. 10,299,336, including all Exhibits, was served on September 23, 2024 via Express Mail delivery directed to the following correspondence address of record for the patent, and additional addresses of record for patentee Signify:

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