UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIFESCAN, INC., SENSEONICS HOLDINGS, INC.,
and ASCENSIA DIABETES CARE HOLDINGS AG,

Petitioners,

v.

CELLSPIN SOFT, INC.,

Patent Owner.

Case No. IPR2025-00103
U.S. PATENT NO. 9,900,766

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

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I. STATEMENT OF PRECISE RELIEF REQUESTED

LifeScan, Inc., Senseonics Holdings, Inc., and Ascensia Diabetes Care Holdings AG ("Joining Petitioners") respectfully submit this Motion for Joinder concurrently with a Petition ("LifeScan Petition") for *inter partes* review of U.S. Patent No. 9,900,766 ("the '766 patent").

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b), the Joining Petitioners request institution of an *inter partes* review and joinder with the pending and instituted proceeding filed by Petitioner TikTok Inc. ("Petitioner TikTok"), IPR2024-00769 (*TikTok Inc. v. CellSpin Soft, Inc.* "TikTok IPR"), instituted on September 30, 2024. TikTok Inc. does not oppose the Joining Petitioners' joinder to the TikTok IPR. Patent Owner CellSpin Soft, Inc. opposes joinder.

The LifeScan Petition is substantively the same as the TikTok IPR petition. It challenges the same claims, on the same grounds, relies on the same prior art, and includes the exact same substantive arguments as the TikTok IPR and therefore would create no additional burden for the Board, the TikTok IPR Petitioner, or Patent Owner if joined. Joinder would therefore lead to an efficient resolution of the patentability of the '766 patent.

The Joining Petitioners are currently named as defendants in *CellSpin Soft, Inc. v. LifeScan, Inc.* in the Eastern District of Texas, Civil Action No. 2:24-cv-

00286 filed April 29, 2024, and *CellSpin Soft, Inc. v. Senseonics Holdings, Inc. et al.* in the Eastern District of Texas, Civil Action No. 2:24-cv-00263 filed April 19, 2024. Patent Owner has accused each of the Joining Petitioners of infringing the ’766 patent. The Joining Petitioners have not previously filed a petition for IPR challenging the validity of the ’766 patent.

The Joining Petitioners stipulate that if joinder is granted, they will act as an “understudy” and will not assume an active role unless Petitioner TikTok ceases to participate in the proceeding. Petitioner TikTok will maintain the lead role in the proceeding so long as it remains in the proceeding. These limitations will avoid lengthy and duplicative briefing. The Joining Petitioners also will not seek additional depositions or deposition time. Joinder will not impact the trial schedule because the Joining Petitioners agree to be bound by the scheduling order in the TikTok IPR proceeding.

In fact, joinder will help efficiently resolve the disputes among the parties. Through joinder, a single Board decision may dispose of the issues raised in the TikTok IPR for all interested parties.

Joinder will not unduly prejudice any party. Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or needlessly increase filings, any additional costs on Patent Owner will be minimal. On the other hand, denial of joinder would prejudice the Joining Petitioners. The Joining Petitioners’

interests may not be adequately protected in the TikTok IPR, particularly if Petitioner TikTok settles with Patent Owner and ceases to participate. The Joining Petitioners should be allowed to join in a proceeding affecting a patent asserted against them.

Given the similarities of the proceedings, the lack of undue prejudice to Patent Owner, and the potential benefit to the public and to the Board that would accrue by the Joining Petitioners' cooperative participation as described above, the Joining Petitioners respectfully submit that the Board should institute their IPR Petition and grant this Motion for Joinder.

II. ARGUMENT

A. Legal Standards and Applicable Rules

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); *Taiwan Semiconductor Mfg. Co., Ltd. v. Zond LLC*, IPR2014-00781 and IPR2014-00782, Paper 5 at 3 (PTAB May 29, 2014).

The Board has discretion to grant a motion for joinder of a petitioner for *inter partes* review to another *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). In determining whether to exercise its discretion to grant a motion for joinder, the Board considers: (1) reasons why joinder is appropriate; (2) any new grounds of unpatentability asserted in the petition; (3) what impact (if any) joinder would have

on the trial schedule for the existing review; and (4) specifically how briefing and discovery may be simplified. *See Dell, Inc. v. Network-1 Security Solutions, Inc.*, IPR201300385, Paper 17 at 3 (July 29, 2013).

B. Petitioners' Motion for Joinder is Timely

Joinder may be requested "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). The TikTok IPR was instituted on September 30, 2024. IPR2024-00769. Joining Petitioners' current motion is timely as it is being filed no later than 1 month after the institution date.

C. The Four Factors Favor Joinder

Each of the four factors weighs in favor of granting the Joining Petitioners' Motion for Joinder. The LifeScan Petition is substantively identical to the petition in the TikTok IPR, and it presents no new grounds of unpatentability. Joinder will have no impact on the pending schedule of the TikTok IPR. Moreover, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

1. Joinder of Joining Petitioners Is Appropriate Because It Will Promote an Efficient Determination of the Validity of the '766 Patent Without Prejudice to Any Party

The Joining Petitioners seek to join the TikTok IPR in order to ensure that an accused infringer with an active interest in the proceeding remains a party to this IPR if Petitioner TikTok participation is terminated prior to completion. Thus,

joining the Joining Petitioners to the TikTok IPR is the most practical way to secure the just, speedy, and inexpensive resolution of the challenge to the '766 patent. *See* 37 C.F.R. § 42.1(b).

If the Joining Petitioners are joined as parties, the validity of the grounds raised in the TikTok IPR can be determined in a single proceeding. Joinder is also appropriate because the LifeScan Petition challenges the validity of the same claims of the '766 patent on identical grounds to those in the TikTok IPR. There are no substantive differences between the LifeScan Petition and the TikTok IPR Petition, IPR2024-00769, Paper 2 (April 5, 2024). The Joining Petitioners also rely on the same supporting evidence in their petition as is relied on in the TikTok IPR. A consolidated proceeding, including the Joining Petitioners and Petitioner TikTok, 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 Inc. v. Realtime Data LLC*, IPR2016-01672, Paper 13 at 7 (PTAB Mar. 7, 2017) (noting that "joining Oracle's identical challenges to those in the 1002 IPR will lead to greater efficiency while reducing the resources necessary from both Realtime and the Board"). The Board "routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding." *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016- 00962, Paper 12 at 9 (PTAB Aug. 24, 2016) (internal quotations and citations omitted).

Joining the Joining Petitioners as parties to the TikTok IPR would promote the public interest relating to the unpatentability of the ’766 patent and not cause any undue prejudice to Patent Owner or Petitioner TikTok. The Patent Owner must respond to the common invalidity grounds identified in the TikTok IPR Petition and LifeScan Petition regardless of joinder.

2. The LifeScan Petition Does Not Raise Any New Grounds of Unpatentability and Therefore Does Not Add Additional Complexity to the Grounds in the TikTok IPR

The LifeScan Petition challenges the validity of the ’766 patent on identical grounds to those in the TikTok IPR. *See* IPR2024-00769, Paper 2 (April 5, 2024). The Joining Petitioners’ supporting materials—including its supporting expert declaration, exhibits, and exhibit numbering—are substantively identical to those presented in the TikTok IPR. Accordingly, no new grounds are being introduced. *See Sony Corp. v. Memory Integrity, LLC.*, IPR2015-01353, Paper No. 11 at 5-6 (PTAB Oct. 5, 2015).

Therefore, consolidation of this proceeding with IPR2024-00769 via joinder of the LifeScan Petition will not raise any new issues of unpatentability and will not impose any additional burden on the Board or Patent Owner, or add additional complexity to the case.

3. Joinder Will Not Affect the Schedule in the TikTok IPR

Given that the Board only recently instituted the TikTok IPR, joinder of the Joining Petitioners would not affect the schedule in any potential forthcoming trial. The Joining Petitioners' participation should result in no changes to the schedule.

The Joining Petitioners agree to adhere to all applicable deadlines set forth in the TikTok IPR Scheduling Order.

4. Joinder Will Simplify Briefing Because The Joining Petitioners Have Agreed to Consolidated Filings and an Understudy Role if Petitioner TikTok Remains

To further prevent joinder from imposing any burden on Petitioner TikTok, Patent Owner, or the Board, and to further ensure that there are no changes in the potential trial schedule, the Joining Petitioners have agreed, as long as Petitioner TikTok remains a party to the TikTok IPR, to take an understudy role, which will simplify briefing and discovery. In this role, the Joining Petitioners agree to the following conditions:

(a) The Joining Petitioners shall not make any substantive filing and shall be bound by the filings of Petitioner TikTok, unless a filing concerns termination and settlement, or issues solely involving the Joining Petitioners;

(b) The Joining Petitioners shall not present any argument or make any presentation at oral hearing unless an issue solely involves the Joining Petitioners,

or when addressing Board-approved motions that do not affect Petitioner TikTok, or its respective position;

(c) The Joining Petitioners shall not seek to cross-examine or defend the cross-examination of any witness, unless the topic of cross-examination concerns issues solely involving the Joining Petitioners;

(d) The Joining Petitioners shall not seek discovery from Patent Owner on issues not solely involving the Joining Petitioners;

(e) The Joining Petitioners will not rely on expert testimony beyond that submitted by Petitioner TikTok unless Petitioner TikTok is terminated from the case. If Petitioner TikTok is not terminated from the case, then the Joining Petitioners agree to rely entirely on, and be bound by, the expert declarations and depositions in the TikTok IPR. Unless and until Petitioner TikTok ceases to participate in the instituted TikTok IPR, the Joining Petitioners will not assume an active role.

Accordingly, due to the Joining Petitioners taking only an "understudy" role, Patent Owner and Petitioner TikTok will only need to respond to one principal set of papers, will not require additional time to address additional arguments raised by the Joining Petitioners, and can thus proceed with the existing trial schedule. These steps will minimize or eliminate any potential complications or delay that could potentially result from joinder. *See Sony,* Paper No. 11 at 6-7 (granting motion because "joinder would increase efficiency by eliminating duplicative filings and

discovery, and would reduce costs and burdens on the parties as well as the Board" where second petitioner agreed to "understudy" role). The Joining Petitioners will also abide by any additional conditions the Board deems appropriate for an "understudy" role.

5. Joinder Will Result in No Prejudice to Patent Owner

As noted above, the Joining Petitioners' joining of the TikTok IPR proceeding should not result in any prejudice to Patent Owner. No additional grounds or arguments are being introduced, no new evidence or issues are being added, and no additional discovery or briefing or oral argument should be necessary as a result of the Joining Petitioners' joinder. Thus, Patent Owner would not need to expend any additional resources beyond those required in the current TikTok IPR.

III. INSTITUTION IS APPROPRIATE UNDER *GENERAL PLASTIC*

General Plastic does not apply here because the Joining Petitioners have not previously challenged the '766 patent and seek to join the TikTok IPR only in an understudy role. *See General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 15-19 (PTAB Sept. 6, 2017); *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00224, Paper 10 at 4-5 (PTAB Apr. 6, 2020).

Factor 1: Under *General Plastic*, factor 1 considers "whether the same petitioner previously filed a petition directed to the same claims of the same patent."

General Plastic at 16. Here, the Joining Petitioners have not previously filed a petition against the ’766 patent.

The Joining Petitioners and Petitioner TikTok are separate, unrelated petitioners, and are not similarly situated for purposes of Factor 1. This factor weighs in favor of institution and against discretionary denial.

Factors 2, 4 and 5: As to the timing examined in these factors, the Joining Petitioners did not previously file a first petition prior to its current petition, and while the Joining Petitioners became aware of the prior art references in the TikTok IPR, they have made no serial attack on the ’766 patent. Thus, factors 2, 4, and 5 weigh in favor of institution and against discretionary denial.

Factor 3: Because the Joining Petitioners did not previously file a first petition, this factor weighs in favor of institution and against discretionary denial.

Factors 6 and 7: As stated above, the Joining Petitioners seek to join the TikTok IPR and are not raising arguments beyond those raised in the TikTok IPR petition. These factors thus weigh in favor of institution, as there should be no material impact on the Board’s finite resources or its ability to issue a final determination on the TikTok IPR petition within one year.

IV. CONCLUSION

For the foregoing reasons, the Joining Petitioners respectfully request that their Petition for *Inter partes* review of the '766 Patent be instituted and that they be joined to the TikTok IPR proceeding IPR2024-00769.

Respectfully submitted,

Dated: October 30, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e), the undersigned certifies that on October 30, 2024, a complete and entire copy of this Motion was provided via Federal Express, to the Patent Owner, by serving the correspondence address of record as follows:

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The undersigned further certifies that on October 30, 2024, a complete and entire copy of this Motion was provided via email, to the following parties of IPR2024-00769:

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Dated: October 30, 2024

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