UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LENOVO (UNITED STATES) INC. and MOTOROLA MOBILITY LLC
Petitioners,

v.

COLLISION COMMUNICATIONS, INC.,

Patent Owner.

Case No. IPR2025-00284

U.S. Patent No. 8,089,946

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

I. STATEMENT OF PRECISE RELIEF REQUESTED

Petitioners Lenovo (United States) Inc. and Motorola Mobility LLC (collectively "Petitioners") respectfully submit this Motion for Joinder, concurrently with a Petition for *inter partes* review of U.S. Patent No. 8,089,946 (the "'946 Patent").

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioners move for joinder with any *inter partes* review that is instituted as to the '946 Patent in *Samsung Electronics America, Inc., et al. v. Collision Communications, Inc.*, IPR2024-01250 (the "Samsung IPR"). Petitioners request that action on this motion be held in abeyance until, and the motion be granted if, the Samsung IPR is instituted. Should the Samsung IPR be terminated prior to any institution decision or otherwise not instituted for any reason, Petitioners submit this motion for joinder would be moot, and request the Board consider Petitioners' *inter partes* review petition on its own merits. Petitioners' Motion for Joinder is timely under 37 C.F.R. §42.122(b) because it is being filed before institution of the Samsung IPR.

Petitioners' concurrently-filed Petition for *inter partes* review is substantively the same as the Samsung IPR petition. It challenges the same claims, on the same grounds, and relies on the same prior art as the Samsung IPR petition. Accordingly, no additional burden would be created for the Board, the Samsung IPR petitioners, or Patent Owner if joined. Indeed, joinder would lead to an efficient resolution of

the invalidity of the ’946 Patent.

Lenovo Group Limited (“Lenovo”), parent of petitioners Lenovo (United States) Inc. and Motorola Mobility LLC, is currently a defendant in a district court litigation in the Eastern District of Texas, *Collision Communications, Inc. v. Lenovo Group Ltd.*, 2-23-cv-00594 (E.D. Tex.). In this proceeding, Lenovo has been accused of infringing the ’946 Patent. Petitioners have not previously filed a petition for *inter partes* review challenging the validity of the ’946 Patent.

Petitioners agree to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the Samsung IPR if it is instituted. The Petition therefore warrants institution under 35 U.S.C. § 314, and 35 U.S.C. § 315(c) permits Petitioners’ joinder to the Samsung IPR if it is instituted.

Petitioners stipulate that if joinder is granted, they will act as “understudies” and will not assume an active role unless the Samsung IPR petitioners cease to participate in the proceeding. The Samsung IPR petitioners will maintain the lead role in the proceeding so long as they remain in the proceeding. These limitations will avoid lengthy and duplicative briefing. Petitioners will also not seek additional depositions or deposition time. Accordingly, the proposed joinder will neither unduly complicate the Samsung IPR nor delay its schedule; in fact, by joinder, a single Board decision may dispose of the issues raised in the Samsung 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 increase needless filings, any additional costs on the Patent Owner will be minimal. On the other hand, denial of joinder would prejudice Petitioners. Petitioners' interests may not be adequately protected in the Samsung IPR, particularly if the Samsung IPR petitioners settle with the Patent Owner. Petitioners should be allowed to join in a proceeding affecting a patent asserted against Lenovo.

II. ARGUMENT

A. Legal Standard

Pursuant to 35 U.S.C. § 315(c), the Board may grant a motion for joining an *inter partes* review petition with another *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). In determining whether to exercise its discretion to grant joinder, the Board considers whether the joinder motion: (1) sets forth the reasons why joinder is appropriate; (2) identifies any new grounds of unpatentability asserted in the petition; (3) explains what impact (if any) joinder would have on the trial schedule for the existing review; and (4) addresses specifically how briefing and discovery may be simplified. *See Dell, Inc. v. Network-1 Security Solutions, Inc.,* IPR2013-00385, Paper No. 17 at 4 (PTAB July 29, 2013).

B. Petitioners' Motion for Joinder is Timely

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). The Samsung IPR was filed on August 2, 2024, and an institution decision has yet to issue. IPR2024-01250, Paper 3 (Aug. 2, 2024). Thus, Petitioners' current motion is timely.

C. Each of the Factors Weighs in Favor of the Board Granting the Motion for Joinder

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

1. Joinder with the Samsung IPR is Appropriate Because It Will Promote an Efficient Determination of the Validity of the '946 Patent Without Prejudice to Any Party

Petitioners seek to join the Samsung IPR, if instituted, to ensure that an accused infringer with an active interest in the proceeding remains a party to the IPR if the Samsung IPR petitioners' participation is terminated prior to completion. Thus, joining Petitioners to the Samsung IPR is the most practical way to secure the just, speedy, and inexpensive resolution of the challenge to the '946 Patent. *See* 37 C.F.R. § 42.1(b). If Petitioners are joined as parties, the validity of the grounds raised in the Samsung IPR, if instituted, can be determined in a single proceeding.

The Board "routinely grants motions for joinder where" as here, "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 No. 12 at 9 (PTAB Aug. 24, 2016). There are no substantive differences between Petitioners' petition for *inter partes* review and the Samsung IPR petition. Petitioners also rely on the same supporting evidence, including a declaration from the same retained expert who has adopted his prior opinions.[1] Because these proceedings introduce identical unpatentability arguments and the same grounds, a consolidated proceeding including Petitioners and the Samsung IPR petition will be more efficient and less wasteful. *See, e.g.*, *Oracle Am. Inc. v. Realtime Data LLC*, IPR2016-01672, Paper 13 at 7 (PTAB Mar. 7, 2017) (explaining that "joining [petitioner's] identical challenges to those in the 1002 IPR will lead to greater efficiency while reducing the resources necessary from both [the patent owner] and the Board.").

Furthermore, joining Petitioners as parties to the Samsung IPR would promote the public interest relating to the unpatentability of the '946 Patent and not cause any undue prejudice to the Samsung IPR petitioners or the Patent Owner. And

[1] Petitioners retained the same expert as the Petitioners did in the Samsung IPR petition, Paul Min, Ph.D. Dr. Min has adopted his prior opinions as set forth in his previously submitted declaration for the Samsung IPR. EX1019.

the Patent Owner must respond to the common invalidity grounds identified in both *inter partes* review petitions regardless of joinder.

2. Petitioners Do Not Propose New Grounds of Unpatentability

As discussed above, Petitioners' petition does not assert any new grounds of patentability. It challenges the same claims of the '946 Patent based on the same arguments, evidence, and grounds of unpatentability as the Samsung IPR. *See* IPR2024-01250, Paper 3 (Aug. 2, 2024). For simplicity and efficiency, the substantive portions of Petitioners' petition are identical to that of the Samsung IPR petition and even refer to the same accompanying expert declaration, which necessarily does not contain any opinions not raised in the Samsung IPR. *See id*. Consolidation of this proceeding with Samsung's via joinder therefore will not raise any new issues of unpatentability. *See Par Pharm., Inc. v. Novartis AG,* IPR2016-01023, Paper No. 20 at 14 (Oct. 27, 2016) (granting motion for joinder where petitioners "do not assert any new ground of unpatentability that is not already being considered in [an instituted IPR proceeding], rely on the same arguments and evidence, and do not require any modification to the existing schedule").

3. Joinder Will Have No Impact on the Samsung IPR Trial Schedule

Petitioners' participation should result in no changes to the schedule because

Petitioners' petition does not seek to broaden the scope of the Samsung IPR petition or introduce new substantive issues. There are no new issues for the Board to address. Furthermore, the Patent Owner's Response, if any, will not be affected because the Patent Owner will not be required to provide analysis or arguments beyond what it will already provide in responding to the Samsung IPR petition. Accordingly, joinder of Petitioners would not affect the schedule in the Samsung IPR.

4. Briefing and Discovery Will Be Simplified Because Petitioners Have Agreed to Consolidated Filings and an Understudy Role if the Samsung Petitioner Remains

To further prevent joinder from imposing a burden on the Samsung IPR petitioners, Patent Owner, or the Board, Petitioners agree to take "understudy" roles. Specifically, Petitioners agree that, if joined, the following conditions shall apply so long as Samsung remains an active party:

(a) all filings by Petitioners in the Samsung IPR shall be consolidated with the filings of Samsung, unless a filing concerns termination, settlement, or issues solely involving Petitioners;

(b) Petitioners shall not be permitted to raise any new grounds not instituted by the Board in the Samsung IPR, or introduce any argument or discovery not introduced by the Samsung IPR petitioner;

(c) Petitioners shall be bound by any agreement between Patent Owner

and Samsung concerning discovery and/or depositions; and

(d) Petitioners at deposition shall not request any direct, cross examination or redirect time beyond that permitted for Samsung alone under either 37 C.F.R. § 42.53 or any agreement between Patent Owner and Samsung. *See Mylan Pharms. Inc. v. Novartis AG,* IPR2015-00268, Paper 17 at 5-6 (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.").

Unless and until Samsung ceases to participate, Petitioners will not assume an active role in the Samsung IPR. Petitioners will not rely on expert testimony beyond that submitted by the Samsung IPR petitioners unless Samsung is terminated from the case prior to any necessary depositions.

By Petitioners accepting an "understudy" role, Patent Owner and Samsung can comply with the existing trial schedule without needing any duplicative efforts by the Board or the Patent Owner. These steps will minimize the possibility of any complication or delay from joinder. *See Sony Corp. v. Memory Integrity, LLC*, IPR2015- 01353, Paper No. 11 at 6-7 (Oct. 5, 2015) (instituting IPR and granting motion for joinder 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 petitioners agreed to an "understudy" role). Petitioners are further willing to agree to any other reasonable conditions the Board deems necessary.

III. CONCLUSION

For the foregoing reasons, Petitioners respectfully request *inter partes* review of U.S. Patent No. 8,089,946 and joinder with *Samsung Electronics America, Inc., et al. v. Collision Communications, Inc.*, IPR2024-01250 if it is instituted.

Respectfully submitted,

Dated: December 12, 2024

/Timothy W. Riffe/

Timothy Riffe, Reg. No. 43,881
Jennifer Huang, Reg. No. 64,297
Whitney Reichel, Reg. No. 59,173
Lawrence Jarvis, Reg. No. 74,636
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
T: 202-783-5070
F: 877-769-7945

Attorneys for Petitioners

CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (E)(4)

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on December 12, 2024, a complete and entire copy of this Motion for Joinder was provided to the Patent Owner by serving the correspondence addresses of record as follows:

Official Correspondence Address
Collision Communications, Inc.
20 Depot Street
Suite 2A
Peterborough, NH 03458
UNITED STATES

Courtesy copies were also sent via electronic mail to Patent Owner's counsel of record in the related district court proceeding

ahaley@caldwellcc.com
agras@caldwellcc.com
andrea@wsfirm.com
hhamad@caldwellcc.com
jcassady@caldwellcc.com
acurry@caldwellcc.com
jsummers@caldwellcc.com
jnemunaitis@caldwellcc.com
bcaldwell@caldwellcc.com

/Anastasia Renard/

Anastasia Renard
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
renard@fr.com