

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZF ACTIVE SAFETY AND ELECTRONICS US LLC,
Petitioner,

v.

FACET TECHNOLOGY CORP.,
Patent Owner.

Patent No. 9,335,255

Filing Date: October 13, 2014

Issue Date: May 10, 2016

Title: SYSTEM AND ASSESSMENT OF REFLECTIVE OBJECTS ALONG A
ROADWAY

Inter Partes Review No.: IPR2025-00748

**MOTION FOR JOINDER UNDER
35 U.S.C. § 315(c) AND 37 C.F.R. §§ 42.22 AND 42.122(b)
TO *INTER PARTES* REVIEW IPR2024-01110**

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I. PRELIMINARY STATEMENT

Petitioner respectfully submits this Motion for Joinder, together with a Petition for *Inter Partes* Review of U.S. Patent No. 9,335,255 (“’255 Patent”), filed contemporaneously herewith. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner requests institution of an *inter partes* review and joinder with the *inter partes* review in *Mobileye Global, Inc. v. Facet Technology Corp.*, IPR2024-01110 (“Mobileye IPR”), which was instituted by the Patent Trial and Appeal Board (“Board”) on March 5, 2025. Petitioner’s Motion for Joinder is timely under 37 C.F.R. § 42.22 and 42.122(b) as it is submitted no later than one month after the institution date of the Mobileye IPR. The Petition is also narrowly tailored to the same claims, prior art, and grounds for unpatentability that were the subject of the Mobileye IPR.¹

Petitioner submits that joinder is appropriate because it will not unduly burden or prejudice the parties to the Mobileye IPR while efficiently resolving the question of the validity of the challenged claims of the ’255 patent in a single proceeding.

II. STATEMENT OF MATERIAL FACTS

1. Facet Technology Corp. (“Facet” or “Patent Owner”) filed civil actions against numerous companies, as listed in the mandatory notices section of the

¹ Certain, but not all, of the claims at issue have been disclaimed.

Petition. Those companies included Petitioner's customer General Motors LLC (*Facet Technology Corp. v. General Motors LLC*, Case No. 2:24-cv-00035 (E.D. Tex.)) and an entity associated with Petitioner's supplier (*Facet Technology Corp. v. Mobileye Global, Inc.*, Case No. 2:24-cv-00058 (E.D. Tex.)).

2. On August 1, 2024, Mobileye Global, Inc. filed a petition for *inter partes* review (IPR2024-01110, the Mobileye IPR) requesting cancellation of claims 12-15 and 17-23 of the '255 patent.

3. On March 5, 2025, the Board instituted Mobileye's Petition in IPR2024-01110, finding a reasonable likelihood existed that Mobileye's Petition for *inter partes* review would prevail in showing the unpatentability of claims of the '255 patent. *See* IPR2024-01110, Decision Granting Institution of *Inter Partes* Review, Paper No. 16 (Mar. 5, 2025).

4. On April 4, 2025, contemporaneously with this Motion, Petitioner filed a Petition for *inter partes* review (IPR2025-00748) requesting cancellation of claims 12-15 and 17-23 of the '255 patent, which is substantively identical to the Mobileye IPR.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Board has the authority under 35 U.S.C. § 315(c) to join a properly filed *inter partes* review petition to an instituted *inter partes* review proceeding. *See* 35

U.S.C. § 315(c). A motion for joinder must be filed within one month of the Board instituting an original *inter partes* review. 37 C.F.R. § 42.122(b). “To join a party to an instituted [*inter partes* review (IPR)], the plain language of § 315(c) requires two different decisions. First, the statute requires that the Director (or the Board acting through a delegation of authority...) determine whether the joinder applicant’s petition for IPR ‘warrants’ institution under § 314. ...Second, to effect joinder, § 315(c) requires the Director to exercise his discretion to decide whether to ‘join as a party’ the joinder applicant.” *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020).

Under the first step, the Board analyzes the merits of the petition and whether it should exercise its discretion to deny institution. *See, e.g., AT&T Servs., Inc. et al. v. Broadband iTV, Inc.*, IPR2021-00556, Paper No. 14 (PTAB Aug. 25, 2021). Under the second step, the Board considers factors, including: (1) the reasons why joinder is appropriate; (2) whether the new petition presents any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper No. 15 at 4 (PTAB Apr. 24, 2013).

B. Petitioner’s Motion for Joinder is Timely

This Motion for Joinder is timely because it is filed within one month of the March 5, 2025 institution decision of the Mobileye IPR. *See* 37 C.F.R. § 42.122(b).

C. The Board Should Not Exercise Its Discretion Under § 314(a)

As explained in the Petition (*see* Petition at Section VI), the Board should not exercise its discretion to deny this Petition. Additionally, the Mobileye IPR was instituted and is substantively identical to the Petition.

D. Each Factor Weighs in Favor of Joinder

Each of the four factors considered by the Board weighs in favor of joinder here. Specifically, joinder will promote efficiency. The Petition does not present any new grounds of unpatentability; rather it is substantively identical to the Mobileye Petition. Further, joinder will have minimal, if any, impact on the trial schedule, as all issues are substantively identical and Petitioner will accept an “understudy” role. *See, e.g., Apple Inc. v. INVT SPE LLC*, IPR2019-00225, Paper 9 at 5-8 (PTAB May 30, 2019) (granting IPR where petitioner requested an “understudy” role); *Sony Corp. et al. v. Memory Integrity, LLC*, IPR2015-01353, Paper 11 at 6 (PTAB Oct. 15, 2015); *Google LLC v. Express Mobile Inc.*, IPR2022-00789, Paper 15 at 7-8 (PTAB Oct. 5, 2022). Lastly, the briefing and discovery will be simplified by resolving the issues in a single proceeding.

Accordingly, joinder is appropriate here. *See, e.g., Apple*, IPR2019-00225, Paper 9 at 5-8; *Sony*, IPR2015-01353, Paper 11 at 5-6 (granting institution of IPR

and motion for joinder where petitioner relied “on the same prior art, same arguments, and same evidence, including the same expert and a substantively identical declaration”); *Google*, IPR2022-00789, Paper 15 at 15 (granting institution and motion for joinder).

1. Joinder Is Appropriate with the Mobileye IPR

Joinder with the Mobileye IPR is appropriate because the Petition involves the same patent, challenges the same claims, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the Mobileye Petition. *Id.* The Petition is substantively identical to the Mobileye Petition with only non-substantive modifications specific to the formalities of a different party filing the Petition as well as an explanation that the Board should not exercise its discretion to deny the Petition.

Because these proceedings are substantively identical, good cause exists for joining this proceeding with the Mobileye IPR so that the Board can efficiently resolve the grounds in both petitions in a single proceeding. *Id.*

2. Petitioner Proposes No New Grounds of Unpatentability

The Petition does not present any new grounds of unpatentability and is substantively identical to the Mobileye Petition. The Petition presents the unpatentability of the same claims of the same patent on the same grounds as the Mobileye Petition.

3. Joinder Will Not Unduly Burden or Negatively Impact the Mobileye IPR Trial Schedule

Because the Petition is substantively identical to the Mobileye Petition, with the same grounds challenging the same claims as instituted by the Board, there are no new issues for Patent Owner to address and Patent Owner will not be required to present any additional responses or arguments. *See Apple*, IPR2019-00225, Paper 9 at 8 (holding “joinder is appropriate in these circumstances because joinder will not unduly burden the parties to the [first] IPR while efficiently resolving the question of unpatentability of” the challenged claims); *Sony*, IPR2015-01353, Paper 11 at 6 (granting IPR and motion for joinder where “joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]”). The Patent Owner Response will contain the same analysis or arguments it would provide in any event in responding to the Mobileye Petition. Also, because the Petition relies on the same expert and identical declarations, only a single deposition is needed for the proposed joined proceeding.

Joinder of this proceeding with the Mobileye IPR does not unduly burden or negatively impact the trial schedule in any meaningful way. Further, even if a small adjustment of the trial schedule were necessary, this is already provided for in the rules and is a routine undertaking by parties in IPR proceedings. *See* 37 C.F.R. § 42.100(c). Thus, a slight adjustment in the trial schedule, should one be needed, is not enough of a reason to deny joining the present Petition with the Mobileye IPR.

4. Procedures to Simplify Briefing and Discovery

The Petition and the Mobileye Petition present substantively identical grounds of rejection, including the same art combinations against the same claims. Additionally, Petitioner explicitly agrees to take an “understudy” role in the joined proceeding, as described by the Board:

(a) all filings by [the ZF Petitioner] in the joined proceeding be consolidated with [the filings of the petitioner in the Mobileye IPR], unless a filing solely concerns issues that do not involve [the petitioner in the Mobileye IPR]; (b) [the ZF Petitioner] shall not be permitted to raise any new grounds not already instituted by the Board in the [Mobileye IPR], or introduce any argument or discovery not already introduced by [the petitioner in the Mobileye IPR]; (c) [the ZF Petitioner] shall be bound by any agreement between [Patent Owner] and [the petitioner in the Mobileye IPR] concerning discovery and/or depositions; and (d) [the ZF Petitioner] at deposition shall not receive any direct, cross-examination or redirect time beyond that permitted for [the petitioner in the Mobileye IPR] alone under either 37 C.F.R. § 42.53 or any agreement between [Patent Owner] and [the petitioner in the Mobileye IPR].

See Noven Pharms., Inc. v. Novartis AG et al., IPR2014-00550, Paper 38 at 5 (PTAB Apr. 10, 2015) (emphasis in original). Petitioner will assume the primary role only if Petitioner in the Mobileye IPR ceases to participate.

By Petitioner accepting an “understudy” role, Patent Owner and Petitioner can comply with the current trial schedule in the Mobileye IPR and avoid any duplicative efforts by the Board or the Patent Owner. These steps will minimize any potential complications or delay that potentially may result by joinder. *See Apple*, IPR2019-00225, Paper 9 at 5-8; *Sony*, IPR2015-01353, Paper 11 at 6-7 (granting IPR and 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 petitioner agreed to an “understudy” role).

IV. CONCLUSION

Based on the factors discussed above, Petitioner respectfully requests that the Board institute its Petition for *Inter Partes* Review of U.S. Patent No. 9,335,255 and grant joinder with the instituted IPR2024-01110 proceeding.

Respectfully submitted,

Dated: April 4, 2025

By: /John R. Hutchins/

John R. Hutchins
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.105, I hereby certify that I caused a true and correct copy of the **MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c) AND 37 C.F.R. §§ 42.22 AND 42.122(b) TO *INTER PARTES* REVIEW IPR2024-01110** to be served via FedEx Priority Overnight on April 4, 2025, on the following:

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Dated: April 4, 2025

By: /John R. Hutchins/

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