Paper No. 6

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

IPR2025-00748
U.S. Patent No. 9,335,255 B2

PATENT OWNER'S RESPONSE TO MOTION FOR JOINDER

I. INTRODUCTION

Petitioner ZF Active Safety and Electronics US LLC ("ZF" or "Petitioner") seeks joinder with Mobileye Global, Inc. ("Mobileye") in IPR2024-01110. Paper 2 ("Mot.") at 1. ZF states that it will accept an understudy role and agrees to certain conditions that would define that role. Mot. at 7-8. These conditions, however, would allow ZF to play a larger role than that of the silent observer unless additional conditions were enforced by the Board in order to limit ZF to a true understudy role. Unless ZF is confined to a true understudy role as set forth below, joinder is inefficient and prejudicial to Patent Owner Facet Technology Corp. ("Facet" or "Patent Owner"). The Board should therefore either impose the joinder conditions enumerated below or deny joinder.

II. ARGUMENT

Facet would agree to joinder only if ZF is confined to a true "silent understudy" role. Without such confinement, this IPR proceeding will be inefficient and will prejudice Facet. Although ZF has agreed to several limitations on its participation, *see* Mot. 7-8, ZF's conditions allow it to maintain a much more active role than is typically allowed of silent understudies. Thus, Facet would agree to joinder only subject to the conditions set forth below.

First, Petitioner's motion is procedurally deficient. Petitioner failed to arrange a conference call with the panel, Mobileye (petitioner), and Facet (patent owner) of

the Mobileye IPR (IPR2024-01110) within five business days of ZF filing its motion in accordance with the Patent Trial and Appeal Board Consolidated Trial Practice Guide. *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019 at 76.

Second, ZF does not commit to not rely on expert testimony (in the form of both declaration and deposition testimony) beyond that submitted by Mobileye in the Mobileye IPR unless the Volkswagen IPR Petitioner is terminated from the case prior to any necessary depositions. *See Am. Honda Motor Co. v. Neo Wireless, LLC*, IPR2023-00791, Paper 11 at 13 (P.T.A.B. Oct. 10, 2023) (ordering joinder where petitioner agreed to "not rely on expert testimony beyond that submitted by the Volkswagen IPR Petitioner unless the Volkswagen IPR Petitioner is terminated from the case *prior to any necessary depositions*" (emphasis added)); *Mercedes-Benz USA, LLC v. Neo Wireless, LLC*, IPR2023-00079, Paper 11 at 11 (P.T.A.B. May 5, 2023) (same). Similarly, for the same reason, once depositions are taken in the Mobileye IPR, ZF should commit to rely upon and be bound by the expert testimony (in the form of both declaration and deposition testimony) submitted in the Mobileye IPR.

Third, ZF has not offered to limit its participation in the Mobileye IPR in ways that the Board has found necessary in other proceedings. To ensure that joinder does not introduce inefficiencies, complicate briefing and discovery, and prejudice Facet,

the following additional conditions should be imposed so long as Mobileye remains an active party in the Mobileye IPR (IPR2024-01110):

1. Mobileye will be subject to the word-count limits for a single party when filing papers on behalf of itself and ZF. *Aurobindo Pharma U.S.A. Inc. v. AstraZeneca AB*, IPR2016-01117, Paper 12 at 11 (P.T.A.B. Oct. 21, 2016).
2. ZF will not serve discovery requests in connection with the Mobileye IPR. *Id*. at 6.
3. ZF must obtain prior Board authorization to file any paper or to take any action on its own in the Mobileye IPR, with the exception of *pro hac vice* motions, updated mandatory notices, and similar administrative filings that do not constitute argument or evidence relating to the merits. *Ericsson Inc., v. Uniloc 2017 LLC*, IPR2020-00376, Paper 16 at 10 (P.T.A.B. May 22, 2020).
4. Counsel for ZF will not participate in a speaking role in any telephonic conference before the Board in the Mobileye IPR. *Teva Pharm. USA, Inc. v. Eli Lilly & Co.*, IPR2016-01340, Paper 8 at 3 (P.T.A.B. Aug. 22, 2016), Paper 9 at 11 (P.T.A.B. Oct. 6, 2016).
5. Counsel for ZF will not participate in oral argument in the Mobileye IPR. *Dr. Reddy's Labs., Inc. v. Horizon Pharma USA, Inc.*, IPR2018-

01341, Paper 21 at 7 (P.T.A.B. Apr. 19, 2019).

6. Counsel for ZF shall not participate in any speaking role in any deposition in the Mobileye IPR, including by participating in the questioning of any witness or the defense of any witness. *LG Elecs., Inc. v. Fundamental Innovation Sys. Int'l LLC*, IPR2018-00461, Paper 10 at 5-6 (P.T.A.B. May 29, 2018).

7. Mobileye filed a *Sotera* stipulation in the Mobileye IPR, which the Board relied upon in determining not to discretionarily deny the petition. *Mobileye*, Paper 16 at 15. ZF has not yet filed its own *Sotera* stipulation. ZF must be required to file its own *Sotera* stipulation in order to take a true understudy role if the proceedings are joined.

These conditions are in addition to the conditions already agreed by ZF in its motion. Mot. at 7-8. By imposing these conditions and thereby confining ZF to a true silent understudy role, the Board can ensure that joinder does not create inefficiencies, complications, and will not prejudice Facet. In prior matters, the Board has required similar covenants as a condition of joinder in order to ensure the efficient and orderly resolution of the proceedings. *See, e.g.*, *Dr. Reddy's Labs.*, IPR2018-01341, Paper 21 at 7.

In the absence of the aforementioned safeguards, Facet opposes joinder. The enumerated safeguards, including the requirement that ZF commit not to rely upon

its own experts after the deposition of Mobileye's experts by Facet, are necessary to prevent prejudice to Facet and to "ensure the just, speedy, and inexpensive resolution of [this] proceeding." *Central Security Grp. – Nationwide, Inc., v. Ubiquitous Connectivity, LP*, IPR2019-01610, Paper 12 at 6 (P.T.A.B. Feb. 26, 2020) (citing *Kyocera Corp. v. SoftView LLC*, IPR2013-00004, Paper 15 at 4 (P.T.A.B. Apr. 24, 2013)).

III. CONCLUSION

Facet would agree to joinder of ZF to the Mobileye IPR (IPR2024-01110) subject to the conditions set forth above. Without the requested safeguards, the Board should deny joinder.

Dated: May 6, 2025

Respectfully submitted,

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Certificate of Service 37 C.F.R. § 42.6(e)

The undersigned certifies that on May 6, 2025, I will cause true and correct copies of the foregoing Patent Owner's Response to Motion for Joinder, and all associated exhibits or appendices referred to therein, to be served electronically upon the following attorneys who have consented to service via email. Pet. at viii.

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