

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.

IPR2025-00749
Patent 9,671,328 B2

Before KEVIN F. TURNER, ROBERT J. SILVERMAN, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

O'HANLON, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

A. Background

ZF Active Safety and Electronics US LLC (“Petitioner”) filed a Petition for *inter partes* review of claims 1–22 of U.S. Patent No. 9,671,328 B2 (Ex. 1001, “the ’328 patent”). Paper 2 (“Pet.”). Concurrently with its petition, Petitioner filed a motion for joinder (Paper 3 (“Motion” or “Mot.”)), seeking to join *Mobileye Global, Inc. v. Facet Technology Corp.*, IPR2024-01111 (“the Mobileye IPR”). Prior to the institution decision in the Mobileye IPR, Facet Technology Corp. (“Patent Owner”) statutorily disclaimed claims 17–22. *See* IPR2024-01111, Ex. 2002; Mot. 1 n.1. Therefore, claims 1–16 (“the challenged claims”) of the ’328 patent are the only claims at issue here and in the Mobileye IPR.

Patent Owner did not file a Preliminary Response. Patent Owner filed an opposition to the Motion (Paper 6, “Opp.”), but later indicated that it did not oppose joinder (*see* Ex. 3001).

For the reasons set forth below, we institute *inter partes* review of the challenged claims and grant Petitioner’s Motion.

B. Real Parties in Interest

Petitioner identifies itself as its sole real party in interest. Pet. ix.

Patent Owner identifies itself and Mandli Communications, Inc. as the real parties in interest. Paper 5, 3.

C. Related Matters

The parties indicate that the ’328 patent is the subject of the following district court proceedings:

Facet Technology Corp. v. General Motors LLC, No. 2:24-cv-00035 (E.D. Tex. filed January 22, 2024),

Facet Technology Corp. v. Mobileye Global, Inc., No. 2:24-cv-00058 (E.D. Tex. filed January 26, 2024) (“the Texas Litigation”),

Facet Technology Corp. v. HERE Global B.V., No. 2:24-cv-00269 (E.D. Tex. filed April 22, 2024),

Facet Technology Corp. v. TomTom International B.V., No. 1:24-cv-00111 (D.N.H. filed April 23, 2024), and

Mobileye Vision Technologies Ltd. v. Facet Technology Corp., No. 0:24-cv-04149 (D. Minn. filed November 7, 2024).

Pet. ix; Paper 5, 3–4. The parties note that the ’328 patent is the subject of the Mobileye IPR and an *ex parte* reexamination (which has been stayed).

Pet. x; Paper 5, 3–4.

Petitioner notes two petitions for *inter partes* review challenging U.S. Patent No. 9,335,255 B2, a related patent owned by Patent Owner: IPR2024-01110 filed by Mobileye Global, Inc. and IPR2025-00748 filed by Petitioner. Pet. x.

D. Asserted Grounds of Unpatentability

The Petition relies on the following prior art references:

Name	Reference	Exhibit
Gallagher	US 2002/0063638 A1, published May 30, 2002	1005
Schofield	US 5,796,094, issued August 18, 1998	1006
Frank	US 5,202,742, issued April 13, 1993	1007

Name	Reference	Exhibit
ASTM	<i>American Society for Testing and Materials, 1997 Annual Book of ASTM Standards, Vol. 04.03: Road and Paving Materials; Vehicle-Pavement Systems, Designation D 4383–96: Standard Specification for Plowable, Raised Retroreflective Pavement Markers</i>	1008
Leonard	US 5,313,262, issued May 17, 1994	1009
Popovich	WO 96/17258, published June 6, 1996	1010

Petitioner asserts the following grounds of unpatentability, based on an evaluation of the claims that may be challenged in this proceeding:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–4, 8–13	103(a) ¹	Gallagher, Schofield
15, 16	103(a)	Gallagher, Schofield, Frank
14	103(a)	Gallagher, Schofield, Frank, ASTM
5–7	103(a)	Gallagher, Schofield, Leonard, Popovich

Pet. 2.

II. DECISION ON INSTITUTION

The Petition in this proceeding asserts the same grounds of unpatentability as asserted in the Mobileye IPR. *Compare* Pet. 2, with Mobileye IPR, Paper 1, 2 (“Mobileye Petition”). Petitioner represents that that “the Petition involves the same patent, challenges the same claims, relies on the same expert declaration, and is based on the same grounds and

¹ The application resulting in the ’328 patent claims priority to a date prior to the date when the Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, 125 Stat. 284 (2011), took effect. Thus, we refer to the pre-AIA version of section 103.

combinations of prior art submitted in the Mobileye Petition” and “[t]he Petition is substantively identical to the Mobileye Petition.” Mot. 5.

As noted above, Patent Owner does not present an opposition to the Petition on the merits.

Because the grounds of unpatentability in the instant Petition are identical to those in the Mobileye IPR and for the same reasons stated in our Decision to Institute in the Mobileye IPR, we institute *inter partes* review in this proceeding on the grounds presented in the Petition. *See* Mobileye IPR, Paper 14 (analyzing challenges in the Mobileye Petition).

III. MOTION FOR JOINDER

The Petition and Motion for Joinder in this proceeding were accorded a filing date of April 4, 2025. *See* Paper 7. Thus, Petitioner’s Motion for Joinder is timely because joinder was requested no later than one month after the institution date of the Mobileye IPR, March 5, 2025. *See* 37 C.F.R. § 42.122(b).

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested joinder. *See* 37 C.F.R. § 42.20(c). The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which states:

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.

A motion for joinder should (1) set forth reasons 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. *See Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013); Patent Trial and Appeal Board Consolidated Trial Practice Guide 76 (Nov. 2019).²

Petitioner’s Motion addresses each of these considerations. Mot. 4–8. According to Petitioner, “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” and “does not present any new grounds of unpatentability and is substantively identical to the Mobileye Petition.” *Id.* at 5. Petitioner argues that, “[b]ecause 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, therefore, joinder with the Mobileye IPR would “not unduly burden or negatively impact the trial schedule in any meaningful way.” *Id.* at 6. Further, “Petitioner explicitly agrees to take an ‘understudy’ role in the joined proceeding” and “will assume the primary role only if Petitioner in the Mobileye IPR ceases to participate.” *Id.* at 7–8 (quoting *Noven Pharms., Inc. v. Novartis AG*, IPR2014-00550, Paper 38 at 5 (PTAB Apr. 10, 2015)).

Patent Owner initially opposed joinder, arguing that, “[a]lthough [Petitioner] has agreed to several limitations on its participation,

² Available at www.uspto.gov/TrialPracticeGuideConsolidated.

[Petitioner's] conditions allow it to maintain a much more active role than is typically allowed of silent understudies.” Opp. 1 (citing Mot. 7–8).

However, the parties subsequently “met and conferred regarding Patent Owner’s Response to Motion for Joinder,” resulting in “Patent Owner . . . agree[ing] not to oppose Petitioner’s motion[] for joinder to . . .

IPR2024-01111 provided that Petitioner agrees to [certain additional] conditions.” Ex. 3001, 1. These additional conditions are:

Petitioner will rely upon the expert testimony submitted by Mobileye and will not seek to add additional expert testimony unless Mobileye is terminated prior to any necessary depositions;

Petitioner will not seek to extend or expand the word-count limits for any papers filed in the Mobileye IPR;

Petitioner will not serve any discovery requests in connection with the Mobileye IPR;

Petitioner will seek Board authorization to file any arguments or evidence relating to the merits in the Mobileye IPR;

Counsel for Petitioner will not participate in a speaking role in any telephone conference before the Board in the Mobileye IPR, except for matters relating to the joinder;

Counsel for Petitioner will not participate in oral argument in the Mobileye IPR; and

Counsel for Petitioner will not participate in any speaking role in any deposition in the Mobileye IPR.

Id. Petitioner indicated that it agreed to those conditions so long as Mobileye remains an active party in the Mobileye IPR. *Id.*

Under the circumstances outlined above, we agree with Petitioner that joinder is appropriate and will not unduly impact the ongoing trial in the Mobileye IPR. Therefore, we *grant* Petitioner’s Motion for Joinder.

IV. CONCLUSION

Based on the record before us, we institute *inter partes* review in IPR2025-00749 and *grant* Petitioner's Motion for Joinder, joining Petitioner as a party to the Mobileye IPR, with the limitations set forth herein.

V. ORDER

Accordingly, it is:

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–16 of the '328 patent is instituted with respect to the ground set forth in the Petition;

FURTHER ORDERED that, pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122, Petitioner's Motion for Joinder is *granted*, and Petitioner is joined as a petitioner in IPR2024-01111, subject to the above-described limitations on Petitioner's participation in that proceeding;

FURTHER ORDERED that IPR2025-00749 is terminated under 37 C.F.R. § 42.72, and all further filings shall be made only in IPR2024-01111;

FURTHER ORDERED that, subsequent to joinder, the grounds for trial in IPR2024-01111 remain unchanged;

FURTHER ORDERED that, subsequent to joinder, the Scheduling Order and any of its modifications entered in IPR2024-01111 will govern the schedule of the proceeding;

FURTHER ORDERED that the case caption in IPR2024-01111 shall be changed to reflect joinder of ZF Active Safety and Electronics US LLC as a petitioner in accordance with the attached example; and

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FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2024-01111.

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Example Case Caption

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MOBILEYE GLOBAL, INC. and
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Patent Owner.

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³ ZF Active Safety and Electronics US LLC, which filed a petition in IPR2025-00749, has been joined as a petitioner in this proceeding.