

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ADC SOLUTIONS AUTO LLC
Petitioner

v.

THE NOCO COMPANY
Patent Owner

IPR2025-00885
Patent No. 11,667,203

MOTION FOR JOINDER TO *INTER PARTES* REVIEW IPR2024-01219

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

ADC Solutions Auto LLC respectfully submits this Motion for Joinder, with a Petition (“the Petition”) for *inter partes* review of U.S. Patent No. 11,667,203 (“the ‘203 patent”), filed concurrently herewith.

Pursuant to 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22 and 42.122(b), Petitioner requests institution of an *inter partes* review and joinder with *Deltran USA LLC v. The NOCO Company*, IPR2024-01219 (“the Deltran IPR”), which the Board instituted on March 19, 2025, concerning the same claims (1-11) of the ‘203 patent at issue in the current Petition. This request is being submitted within the one-month time limit set forth in 37 C.F.R. § 42.122(b).

Petitioner submits that the request for joinder is consistent with the policy objectives surrounding *inter partes* reviews, as it is the most expedient way “to secure the just, speedy, and inexpensive resolution of every proceeding.” See 37 C.F.R. § 42.1(b); *see also HTC v. Parthenon Unified Memory Architecture LLC.*, IPR2017-00512, Paper No. 12 at 5-6 (June 1, 2017). The present Petition and the Deltran IPR Petition are substantially identical with respect to the asserted grounds, are based on the same prior art combinations and supporting evidence and asserted

against the same claims.¹ Further, upon joining the Deltran IPR, Petitioner will act as an “understudy” and will not assume an active role unless the current petitioner ceases to participate in the instituted IPR. Accordingly, the proposed joinder will not unduly complicate the Deltran IPR nor adversely impact its schedule. As such, the requested joinder will promote judicial efficiency in determining the patentability of the ‘203 patent without prejudice to Patent Owner. Moreover, Petitioner has spoken with Deltran’s counsel of record in IPR2024-01219, and Deltran does not oppose this requested joinder.

II. STATEMENT OF MATERIAL FACTS

The ‘203 patent has been asserted in the following District Court case to the best of Petitioner’s knowledge:

- *The NOCO Company v. Deltona Transformer Corporation et al.*, 6-23-cv-02194, Middle District of Florida.

Related patents also asserted in the above captioned litigation, in addition to a second litigation filed against Petitioner, styled *The NOCO Company v. Winplus North America, Inc. et al.*, Case No. 8:23-cv-00269-DOC-DFM, Central District of

¹ Section IX of the present Petition includes a separate statement regarding discretion under 35 U.S.C. § 314(a) as compared to Section IX of the Deltran IPR Petition.

California, include U.S. Patent No. 11,447,023 (the '023 Patent) and U.S. Patent No. 11,584,243 (the '243 Patent). Patent Owner has threatened to also assert the '203 patent against Petitioner.

The '023 Patent has been challenged by Petitioner in *ADC Solutions Auto, LLC v. The Noco Company*, IPR2024-00577, PTAB. Trial was instituted in IPR2024-00577 on August 29, 2024. EX1055.

The '243 Patent has been challenged by Petitioner in *ADC Solutions Auto, LLC v. The Noco Company*, IPR2024-00671, PTAB. Trial was instituted in IPR2024-00671 on August 29, 2024. EX1054.

The present Petition asserts the same ground of unpatentability against the same claims and relies on the same expert declaration and evidence as asserted and relied upon on in the Deltran IPR.

III. REASONS FOR REQUESTED RELIEF

A. Legal Standard

The Board may grant a motion for joining an *inter partes* review petition with another *inter partes* review proceeding. 35 U.S.C. § 315(c). A petitioner may request joinder up to one month after the institution date of the proceeding to which joinder is requested, without prior authorization. 37 C.F.R. § 42.122(b). The Board, in determining whether to exercise its discretion to grant joinder, 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. *Central Security Group – Nationwide, Inc. d/b/a Alert360 v. Ubiquitous Connectivity, LP*, IPR2019-01610, Paper No. 12, p. 6.

B. The Motion for Joinder is Timely

Pursuant to 37 C.F.R. § 42.122(b), joinder can be requested without prior authorization no later than one month after the institution date of the proceeding to which joinder is requested. This motion is being filed no later than one month from the March 19, 2025, institution date of IPR2024-01219. This motion is timely.

Additionally, patent owner has threatened to assert the ‘203 against Petitioner in district court but has not yet done so. Accordingly, Petitioner would not be timed barred from filings a separate petition under 35 U.S.C. § 315(b).

C. The Factors Weigh in Favor of Granting the Motion for Joinder

All four factors weigh in favor of granting the motion for Petitioner. The Petition is substantively identical to the petition in the Deltran IPR. Petitioner does not present any new grounds of unpatentability. Additionally, as all issues are substantively identical and Petitioner will act as an “understudy,” joinder will have no impact on the pending schedule of the Deltran IPR. *See LG v. Memory Integrity, LLC*, IPR2015-01353, Paper No. 11, p. 6 (granting motion for joinder where

petitioner requested an “understudy” role). Moreover, the briefing and discovery will be simplified by resolving all issues in a single proceeding. Accordingly, joinder is appropriate.

1. Joinder with the Deltran IPR is Appropriate

The Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in [an] existing proceeding.” *Central Security*, IPR2019-01610, Paper No. 12, p. 6 (internal citations omitted). Here, joinder with the Deltran IPR is appropriate because the present Petition introduces the same arguments and the same grounds raised in the existing Deltran IPR (i.e., challenges the same claims of the same patent, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the granted Deltran Petition). Although there are minor differences related to the mandatory notices and grounds for standing, there are no substantive changes to the facts, citations, evidence, or arguments relied upon to assert unpatentability of the claims relative to the Deltran Petition.

Because these proceedings are substantively identical, good cause exists for joining this proceeding with the Deltran IPR so that the Board, consistent with 37 C.F.R. § 42.1(b), can efficiently “secure the just, speedy, and inexpensive resolution” of the present Petition and Deltran’s Petition in a single proceeding, as compared with two separate proceedings.

2. Petitioner Does Not Propose New Grounds

As noted above, the Petition challenges the same claims of the ‘203 patent, relying on the same expert declaration, and on the same grounds and combinations of prior art submitted in the Deltran Petition. *See LG*, IPR2015-01353, Paper No. 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”); *see also Central Security*, IPR2019-01610, Paper No. 12, p. 8 (granting motion for joinder where the Petitions challenge the same claims on the same grounds using the same prior art).

3. Joinder Will Not Negatively Impact the Deltran IPR Trial Schedule

Joinder should have no meaningful impact on the Deltran IPR trial schedule because the present Petition presents no new issues or grounds of unpatentability. *See LG*, IPR2015-01353, Paper No. 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]”). Further, Petitioner explicitly consents to the existing IPR2024-01219 trial schedule. There are no new issues for the Board to address, and Patent Owner will not be required to present any additional responses or arguments upon joinder. Further, Patent Owner is under no obligation to file a Preliminary Response in response to the present

Petition. Presumably, Patent Owner has already been actively analyzing the same grounds presented in the present Petition in connection with its Patent Owner's Response due June 11, 2025 in the Deltran IPR.

Accordingly, joinder with the Deltran IPR does not unduly burden or negatively impact the trial schedule.

4. Procedures to Simplify Briefing and Discovery

Petitioner explicitly agrees to take an “understudy” role, which will simplify briefing and discovery. Specifically, Petitioner explicitly agrees, upon joining the Deltran IPR, that the following conditions shall apply so long as the current lead petitioner in IPR2024-01219 remains an active party:

- a) Petitioner shall not make any substantive filings and shall be bound by the filings of Deltran, unless a filing concerns termination and settlement;
- b) Petitioner shall not present any argument or make any presentation at oral hearing;
- c) Petitioner shall not seek to cross-examine or defend the cross-examination of any witness; and
- d) Petitioner shall not seek discovery from Patent Owner.

See, e.g., Central Security, IPR2019-01610, Paper No. 12, p. 8 (“Petitioner avers it will take an ‘understudy’ role in the [joined] IPR by consolidating all filings,

refraining from advancing new arguments, binding itself to any discovery agreements, and limiting its deposition time to the time already allotted . . . Thus, joinder would result in the just, speedy, and inexpensive resolution of the instant Petition as well as the petition filed in the [joined] IPR.”). Unless and until the current petitioner ceases to participate in the instituted IPR proceeding, Petitioner will not assume an active role therein.

Thus, by Petitioner accepting an “understudy” role, Patent Owner and the current petitioner in the Deltran IPR can comply with the existing trial schedule without requiring 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. Petitioner is further amenable to any other reasonable conditions the Board deems necessary.

IV. CONCLUSION

Based on the factors discussed above, Petitioner respectfully requests that the Board grant the Petition and grant this motion for joinder with the Deltran IPR.

Date: April 18, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing Motion for Joinder, together with all exhibits and other documents filed therewith, was served by Express Mail on April 18, 2025 on the Patent Owner's counsel of record at the United States Patent & Trademark Office having the following address:

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