

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

MAHLE FILTER SYSTEMS NORTH AMERICA, INC.

Petitioner

v.

INGEVITY SOUTH CAROLINA, LLC

Patent Owner

Case No. 2019-00960

Patent RE38,844

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

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I. INTRODUCTION

Pursuant to 37 C.F.R. 42.122(b), Petitioner respectfully requests joinder of this *inter partes* review (Case No. IPR2019-00960, “MAHLE IPR”) to an earlier *inter partes* review filed by BASF Corporation (Case No. IPR2019-00202, “BASF IPR”). The MAHLE IPR is intentionally identical to the BASF IPR in all substantive aspects. Both seek *inter partes* review of claims 1–8, 11, 12, 14–16, 18–21, 24, 25, 27–29, 31–33, 36, 37, 39–41, 43–45, 48, 49, and 51–53 (collectively the “Challenged Claims”) of U.S. Patent No. RE38,844 (“the ’844 patent”). Further, the MAHLE IPR and the BASF IPR rely upon the same analytical framework (*e.g.*, same expert declarant, prior art, claim charts, and claim constructions) in addressing the Challenged Claims. Accordingly, resolving both *inter partes* reviews will necessarily involve considering the same issues by all parties and the Patent Trial and Appeal Board (“Board”).

Petitioner is filing this joinder motion and the accompanying petition to ensure that the instituted trial is completed in the event that BASF IPR reaches a settlement with the Patent Owner. Joinder of these proceedings also presents the best opportunity to secure the just, speedy, and inexpensive resolution of the related proceedings without any prejudice to the Patent Owner. This includes consolidated filings and discovery and eliminating the duplicate hearings and briefing that would surely accompany separate proceedings. After inquiry by Petitioner, BASF indicated

that it would not oppose the motion for joinder. Joinder should also provide for case management efficiencies for the Board.

In light of the similarities of the proceedings and the efficiencies that can be realized via joinder, Petitioner respectfully requests that joinder be granted.

II. BACKGROUND AND RELATED PROCEEDINGS

The '844 patent is assigned to Ingevity South Carolina, LLC (“Ingevity” or “Patent Owner”). Ingevity has asserted the '844 patent against MAHLE Filter Systems North America, Inc. (“MAHLE”) and BASF Corporation (“BASF”) in *Ingevity Corp. et al. v. MAHLE Filter Sys. North America, Inc. et al.*, Investigation No. 337-TA-1140 (ITC), filed November 8, 2018; *Ingevity Corp. et al. v. BASF Corp.*, Case No. 1:18-cv-01391 (D. Del.), filed September 6, 2018; *Ingevity Corp. et al. v. MAHLE Filter Sys. North America, Inc.*, Case No. 1:18-cv-06158 (N.D. Ill.), filed September 7, 2018; *Ingevity Corp. v. BASF Corp.*, Case No. 1:18-cv-01072 (D. Del.), filed July 19, 2018 and dismissed without prejudice October 11, 2018; and *Ingevity Corp. v. MAHLE Filter Sys. North America, Inc.*, Case No. 1:18-cv-04920 (N.D. Ill.), filed July 19, 2018 and dismissed without prejudice September 10, 2018. BASF filed a petition requesting *inter partes* review of the '844 patent on November 5, 2018. (BASF IPR, Paper 1). The Board has not yet entered a decision on whether to institute the BASF IPR. Out of an abundance of caution, the '844 patent may relate to the subject matter of the following administrative actions: BASF

Corporation filed an opposition to European Pat. No. 3055546 on January 30, 2019; and BASF Corporation filed an opposition to European Pat. No. 2906811 on November 6, 2018.

III. LEGAL STANDARD

When more than one petition for *inter partes* review of the same patent is properly filed and those petitions warrant institution, the Board has the authority and discretion to join the proceedings. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b). Joinder of one *inter partes* review with another *inter partes* review is appropriate where it secures the just, speedy, and inexpensive resolution of the *inter partes* review proceedings. *See* 37 C.F.R. § 42.1(b).

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). A joinder request should (1) set forth the reasons why joinder is appropriate, (2) identify any new grounds of unpatentability asserted in the petition, and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *See, e.g. Microsoft Corp. v. IPR Licensing, Inc.*, IPR2015-00074, Paper 21 at 4 (Mar. 4, 2015). A joinder request can additionally address specifically how briefing and discovery may be simplified. *See, e.g., Sony Corp. of Am. v. Network-1 Security Solutions, Inc.*, IPR2013-00495, Paper 13 at 3 (Sep. 16, 2013); *Fujitsu Semiconductor Ltd. v. Zond, LLC*, IPR2014-00845, Paper 14 at 3 (Oct. 2,

2014). Petitioner addresses each of these points below.

IV. ANALYSIS

Petitioner respectfully requests that the Board grant this motion for joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) and enter an order consistent with the proposed order provided below.

A. This Joinder Motion is Timely

This motion is timely. Under 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. Because this motion is being filed prior to the Board's decision to institute trial in the BASF IPR, it meets the requirements of § 42.122(b). *See, e.g., Biotronik, Inc. v. Atlas IP LLC*, IPR2015-00534, Paper 10 (Feb. 25, 2015) (granting motion for joinder filed concurrently with institution of IPR review).

B. Joinder is Appropriate

Joinder of the MAHLE IPR and the BASF IPR is the most practical way to secure the just, speedy, and inexpensive resolution of these related proceedings. *See* 37 C.F.R. § 42.1(b). The petition in the MAHLE IPR is intentionally identical to the petition in the BASF IPR in all substantive aspects. That is, the same claims are challenged (1–8, 11, 12, 14–16, 18–21, 24, 25, 27–29, 31–33, 36, 37, 39–41, 43–45, 48, 49, and 51–53 of the '844 patent) based on the same prior art, same claim

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