

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. IPR2019-00960

Patent No. RE38,844

**PATENT OWNER'S OPPOSITION TO MOTION FOR JOINDER (PAPER
NO. 3)**

Mail Stop Patent Board
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450

Alexandria, VA 22313-1450

Patent Owner opposes joinder of IPR2019-00960 with IPR2019-00202 filed by BASF Corporation.

First, joinder of a second IPR is premature. No institution decision in IPR2019-00202 has been entered as of this date and thus, a decision on joinder should be deferred. Patent Owner provided detailed reasons why IPR2019-00202 should not be instituted in its Patent Owner's Preliminary Response. If IPR2019-00202 is not instituted, then institution and joinder should be denied in IPR2019-00960.

Second, the petitioner in IPR2019-009660 (Mahle Filter Systems North America, Inc.) is listed as a real party in interest in IPR2019-00202. *See* IPR2019-00202, Paper No. 2 at 81. Mahle provides no basis for allowing it to be a real party in interest in two substantively identical IPR petitions on the same patent raising the same grounds. It provides no explanation why it is just and speedy to permit parties, such as Mahle, to be a real party in interest to one petition (while affirmatively electing not to be named as a petitioner) but then months later change its mind and seek joinder to the original petition. Joining petitions and adding petitioners increases the complexity of the proceedings. That complexity may be justified in some circumstances, but not where the complexity is caused by the petitioner's own affirmative decision to change its mind. IPR2019-00202 fails to explain why

Mahle's decision to change its mind and actually participate as a petitioner is justified.

Third, IPR2019-00960 identifies six additional real parties in interest that are not listed as petitioners in either petition. Joinder should further be denied if it turns out that any of those entities should have been identified as real parties in interest in IPR2019-00202.

Date: May 9, 2019

Respectfully submitted,

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CERTIFICATE OF SERVICE

A copy of PATENT OWNER'S OPPOSITION TO MOTION FOR JOINDER
(PAPER NO. 3) was served via electronic mail on the following counsel of record
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