

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MAZDA MOTOR OF AMERICA, INC., VOLVO CAR USA, LLC, AND
SUBARU OF AMERICA, INC.,
Petitioner

v.

STRATOSAUDIO, INC.,
Patent Owner

Case No. IPR2022-00203
U.S. Patent No. 8,166,081

**MOTION FOR JOINDER TO *INTER PARTES* REVIEW
(35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b))**

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Mazda Motor of America, Inc., Volvo Car USA, LLC, and Subaru of America, Inc. (“Petitioner”) move for joinder with the *Inter Partes* Review of U.S. Patent No. 8,166,081 (“the ’081 Patent”), *Volkswagen Group of America, Inc. v. StratosAudio, Inc.*, IPR2021-00721 (“the Volkswagen IPR”), for which the petition for *Inter Partes* Review was filed on April 16, 2021, and was instituted for trial on October 22, 2021. IPR2021-00721, paper 16. This motion is timely because it is filed within one month of the Board’s decision instituting trial in the Volkswagen IPR, *i.e.*, “no later than one month after the institution date” of the Volkswagen IPR. 37 C.F.R. § 42.122(b); *Central Security Group – Nationwide, Inc. v. Ubiquitous Connectivity, LP*, IPR2019-01609, Paper 11, at 8-9 (P.T.A.B. Feb. 26, 2020) (stating that § 42.122(b) is “[t]he only timing requirement for a motion for joinder”). The petitioner in the Volkswagen IPR (“Volkswagen”) does not oppose Petitioner’s request for joinder.

Petitioner requests institution of this Petition for *Inter Partes* Review. This Petition is substantively identical to the original Volkswagen IPR petition in all material respects. The only substantive changes are in the Introduction to identify the correct Petitioner, and in mandatory notices under 37 C.F.R. § 42.8(b). The Petition here and the Volkswagen IPR petition challenge the same claims of the ’081

patent on the same grounds relying on the same prior art and evidence, including a declaration identical in substance from the same expert.

Thus, the Petition warrants institution under 35 U.S.C. § 314, and 35 U.S.C. § 315(c) permits Petitioner's joinder to the Volkswagen IPR.

Further, if joined, Petitioner agrees to adhere to all applicable deadlines in the Volkswagen IPR and coordinate all filings with Volkswagen in the Volkswagen IPR. Volkswagen will maintain the lead role in the proceedings so long as it is a party to the proceedings and is not estopped under § 315(e)(1), and Petitioner here will assume an understudy role. Petitioner will only assume the lead role in the proceedings if Volkswagen is no longer a party to the proceedings or unable to advance arguments for one or more claims, or grounds, for example, because of § 315(e)(1). Petitioner agrees to consolidated filings for all substantive papers in the proceeding. Volkswagen and Petitioner will be jointly responsible for the consolidated filings. Absent a Board order precluding Volkswagen from making arguments that would otherwise be available to Petitioner, Petitioner will not advance any arguments separate from those advanced by Volkswagen in the consolidated filings. These limitations will avoid lengthy and duplicative briefing. Also, Petitioner will not seek additional depositions or deposition time, and will coordinate deposition questioning and hearing presentations with Volkswagen.

Petitioner agrees to the foregoing conditions even if other IPRs filed by other, third-party petitioners are joined with the Volkswagen IPR.

Joinder will help efficiently resolve the disputes among the parties. By joinder, a single Board decision may dispose of the issues raised in the Volkswagen IPR for all interested parties. Further, the Patent Owner has asserted the '081 patent in district court against Petitioner. Joinder will estop Petitioner from asserting in district court those issues resolved in a final decision from the Volkswagen IPR, thus narrowing the issues in the district court. *See* 35 U.S.C. § 315(e)(2). Finally, joinder would not complicate or delay the Volkswagen IPR and would not adversely affect any schedule set in that proceeding. In sum, joinder would promote efficient adjudication in multiple forums. On the other hand, maintaining the Petitioner's IPR proceeding separate from that of the Volkswagen IPR would entail needless duplication of effort.

Joinder will not unduly prejudice any party. Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or increase needless filings, any additional costs on the Patent Owner would be minimal. On the other hand, denial of joinder would prejudice Petitioner. Their interests may not be adequately protected in the Volkswagen IPR proceedings, particularly if

Volkswagen settles with the Patent Owner. Petitioner should be allowed to join in a proceeding affecting a patent asserted against them.

II. BACKGROUND AND RELATED PROCEEDINGS

StratosAudio, Inc. (the “Patent Owner”) is the owner of the ’081 patent. StratosAudio, Inc. has asserted the ’081 patent against Petitioner in *StratosAudio, Inc. v. Mazda Motor of America, Inc.* No. 6:20-cv-1126 and *StratosAudio, Inc. v. Subaru of America, Inc.* No. 6:20-cv-1128, and *StratosAudio, Inc. v. Volvo Cars of North America, LLC et al.*, No. 6:20-cv-01129, pending in the United States District Court for the Western District of Texas. On April 16, 2021, Volkswagen filed its IPR petition, IPR2021-00721, against the ’081 patent. On October 22, 2021, trial was instituted on all proposed grounds, finding that a reasonable likelihood existed that Volkswagen’s petition for *inter partes* review would prevail in showing unpatentability of claims 12-16 of the ’081 Patent. *See* IPR2021-00720, Decision Instituting IPR Review, Paper No. 16. Petitioner hereby timely moves for joinder with the Volkswagen IPR.

III. STATEMENT OF REASONS FOR THE REQUESTED RELIEF

A. Legal Standards and Applicable Rules

The Board has discretion to join a properly filed IPR petition to an IPR proceeding. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); *see also Dell Inc. v.*

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.