

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCEDES-BENZ USA, LLC.
Petitioner

v.

NEO WIRELESS, LLC
Patent Owner

Case (to be assigned)
U.S. Patent No. 10,965,512

Filed on behalf of Petitioner:
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I. Statement of Precise Relief Requested

Mercedes-Benz USA LLC (“Petitioner”) respectively submits this Motion for Joinder, concurrently with a Petition for *inter partes* review of U.S. Patent No. 10,965,512 (the “’512 patent”).

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner moves for joinder with any *inter partes* review that is instituted as to the ’512 patent in *Volkswagen Group of America, Inc. v. Neo Wireless, Inc.*, IPR2022-01539 (the “Volkswagen IPR”). Petitioner requests that action on this motion be held in abeyance until, and the motion be granted if, the Volkswagen IPR is instituted. Should the Volkswagen IPR be terminated prior to any institution decision or otherwise not instituted for any reason, Petitioner submits this motion for joinder would be moot, and requests the Board consider Petitioner’s *inter partes* review petition on its own merits. This motion is timely because it is being filed before institution of the Volkswagen IPR.

Petitioner requests institution of its Petition for *inter partes* review filed concurrently herewith. The Petition is substantively the same as the Volkswagen IPR petition. It challenges the same claims, on the same grounds, and relies on the same prior art as the Volkswagen IPR petition. Accordingly, no additional burden would be created for the Board, the Volkswagen IPR petitioner, or Patent Owner if

joined. Joinder would therefore lead to an efficient resolution of the invalidity of the '512 patent.

Petitioner agrees to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the Volkswagen IPR if it is instituted. The Petition therefore warrants institution under 35 U.S.C. § 314, and 35 U.S.C. § 315(c) permits Petitioner's joinder to the Volkswagen IPR if it is instituted.

Petitioner stipulates that if joinder is granted, it will act as an "understudy" and will not assume an active role unless the Volkswagen IPR petitioner ceases to participate in the proceeding. The Volkswagen IPR petitioner will maintain the lead role in the proceeding so long as it remains in the proceeding. These limitations will avoid lengthy and duplicative briefing. Petitioner also will not seek additional depositions or deposition time. Accordingly, the proposed joinder will neither unduly complicate the Volkswagen IPR nor delay its schedule.

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. Petitioner's interests may not be adequately protected in the Volkswagen IPR, particularly if the Volkswagen IPR petitioner settles with the Patent Owner. Petitioner should be allowed to join in a proceeding affecting a patent asserted against it.

II. Statement of Reasons for the Relief Requested

A. Legal Standards and Applicable Rules

The Board has discretion to join a properly filed IPR petition to an existing IPR proceeding. See 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); *see also Sony Mobile Commc'ns. AB v. Ancora Techs., Inc.*, IPR2021-00663, Paper 17, at 29-33; *Dell Inc. v. Network-1 Sec. Solutions, Inc.*, IPR2013-00385, Paper 19, at 4-6; *Sony Corp. v. Yissum Res. & Dev. Co. of the Hebrew Univ. of Jerusalem*, IPR2013-00326, Paper 15, at 3-4; *Microsoft Corp. v. Proxyconn, Inc.*, IPR2013-00109, Paper 15, at 3-4.

“The Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations.” *Dell*, IPR2013-00385, Paper 19, at 3. The movants bear the burden of proof in establishing entitlement to the requested relief. 37 §§ 42.20(c), 42.122(b). A motion for joinder should:

(1) set forth the 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.

Dell, IPR2013-00385, Paper 19, at 4.

B. Joinder with the Proceeding Is Appropriate

The Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing

proceeding.” *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper No. 12 at 9 (Aug. 24, 2016) (emphasis added) (internal quotations and citations omitted).

Here, in the event the Volkswagen IPR is instituted, joinder is appropriate because the Petition introduces identical unpatentability arguments and the same grounds raised in the Volkswagen IPR petition. In other words, both petitions contain the same grounds based on the same prior art combinations and supporting evidence against the same claims. There are no substantive differences between the Petition and the Volkswagen IPR petition. Petitioner also relies on substantially the same supporting evidence in the Petition as is relied on in the Volkswagen IPR. Because these proceedings introduce identical unpatentability arguments and the same grounds, good cause exists for joinder, so that the Board, consistent with 37 C.F.R. § 42.1(b), can efficiently “secure the just, speedy, and inexpensive resolution” of this proceeding and the Volkswagen IPR.

Moreover, Petitioner notes that the Board has indicated that the factors outlined by *General Plastics* are not particularly relevant here “where a different petitioner files a ‘me-too’ or ‘copycat’ petition in conjunction with a timely motion to join.” See, e.g., *Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11 at 9-11; *Pfizer, Inc. v. Genentech, Inc.*, IPR2017-02063, Paper 25 at 7-8. This is Petitioner’s first challenge against the ’512 patent at the PTAB, and there is no risk of prejudice or abuse. Rather, through grant of this joinder, the Board is simply

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