

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GARMIN INTERNATIONAL, INC., GARMIN USA, INC.,
AND GARMIN LTD.,
Petitioner

v.

AIRE TECHNOLOGY LIMITED,
Patent Owner

Case No. IPR2023-00188
U.S. Patent No. 8,581,706

**MOTION FOR JOINDER TO
INTER PARTES REVIEW IPR2022-01137**

TABLE OF CONTENTS

I. STATEMENT OF THE PRECISE RELIEF REQUESTED 1

II. STATEMENT OF MATERIAL FACTS 2

III. STATEMENT OF REASONS FOR RELIEF REQUESTED 3

A. Legal Standard..... 3

**B. Each of the Factors Weighs in Favor of the Board Granting the Motion
for Joinder..... 3**

1. Joinder with the Apple IPR Is Appropriate 4

2. Petitioner Does Not Propose New Grounds of Unpatentability 5

**3. Joinder will Not Negatively Impact the Apple IPR Trial Schedule
..... 5**

**4. Petitioner Agrees to Adhere to Procedures to Simplify Briefing
and Discovery 6**

IV. CONCLUSION..... 8

TABLE OF AUTHORITIES

Page(s)

Cases

Apple Inc. v. Aire Technology Limited,
IPR2022-01137 1

Dell, Inc. v. Network-1 Security Sols., Inc.,
IPR2013-00385, Paper 17 (PTAB July 29, 2013) 3

Kyocera Corp. v. Softview LLC,
IPR2013-00004, Paper 15 (PTAB Apr. 24, 2013) 3

Noven Pharm, Inc. v. Novartis AG,
IPR2014-00550, Paper No. 38 (Apr. 10, 2015)..... 7

Par Pharm., Inc., v. Novartis AG,
IPR2016-01023, Paper 20 (Oct. 27, 2016) 5

Samsung Elecs. Co., Ltd. v. Raytheon Co.,
IPR2016-00962, Paper 12 (Aug. 24, 2016) 4

Sony Corp., et al. v. Memory Integrity,
LLC, IPR2015-01353, Paper 11 (Oct. 5, 2015)..... 3, 5, 7

Statutes

35 U.S.C. § 315(c) 1, 3

Other Authorities

37 C.F.R. § 42.1(b) 1, 4

37 C.F.R. § 42.22 1

37 C.F.R. § 42.122(b) 1

37 C.F.R. § 42.53 7

U.S. Patent No. 8,581,706..... 1, 2

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Garmin International, Inc., Garmin USA, Inc., and Garmin Ltd. (“Petitioner” or “Garmin”) respectfully submits this Motion for Joinder concurrently with a Petition (“the Garmin petition”) for *inter partes* review of U.S. Patent No. 8,581,706 (“the ‘706 patent”).

Pursuant to 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22 and 42.122(b), Garmin requests institution of the concurrently filed Petition for *inter partes* review and joinder with *Apple Inc. v. Aire Technology Limited*, IPR2022-01137 (“the Apple IPR” or “the Apple proceeding”), which Apple filed on June 15, 2022 and concerns the same claims 1-3, 11-12, 16, 18 and 20 of the ‘706 patent. No institution decision has been issued yet in the Apple IPR. This request is being submitted within the time set forth in 37 C.F.R. § 42.122(b).

Garmin submits that the request for joinder is consistent with the policy 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). The Garmin petition and the Apple IPR are substantively identical; they contain the same grounds (based on the same prior-art combinations and supporting evidence) against the same claims. Further, upon joining the Apple proceeding, Garmin will act as an “understudy” and will not assume an active role unless the current petitioner ceases to participate in the IPR. Accordingly, the proposed joinder will neither

unduly complicate the Apple IPR nor delay its schedule. As such, the joinder will promote judicial efficiency in determining the patentability of the '706 patent without prejudice to Patent Owner. Apple does not oppose this motion for joinder.

II. STATEMENT OF MATERIAL FACTS

1. The '706 patent is or was at issue in the following patent infringement actions: Case Nos. 6:21-cv-00955 (W.D. Tex.); 6:21-cv-01101 (W.D. Tex.); 6:21-cv-01104 (W.D. Tex.); and 8:22-cv-01027 (C.D. Cal.).

2. The '706 patent is at issue in two other IPR proceedings: Case Nos. IPR2022-01137 (the Apple IPR) and IPR2022-00876.

3. On May 2, 2022, Samsung Electronics Co., Ltd. filed a petition for *inter partes* review (IPR2022-00876) ("the Samsung IPR"), requesting cancellation of claims 1-6, 9-12, and 14-22 of the '706 patent. On June 15, 2022, Apple Inc. filed a petition for *inter partes* review (IPR2022-01137), requesting cancellation of claims 1-3, 11-12, 16, 18 and 20 of the '706 patent. On October 6, 2022, Patent Owner Aire Technology Limited ("Patent Owner") filed a Patent Owner Preliminary Response in the Apple IPR. On October 18, 2022 the Board granted a joint motion to terminate the Samsung IPR based on settlement.

4. The Garmin petition and the Apple petition are substantially identical as they contain the same grounds (based on the same prior-art combinations and same supporting evidence) against the same claims.

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