

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Xiaodong Li, et al.
U.S. Patent No.: 10,965,512 Attorney Docket No.: 18768-0206IP1
Issue Date: March 30, 2021
Appl. Serial No.: 17/012,813
Filing Date: September 4, 2020
Title: METHOD AND APPARATUS USING CELL-SPECIFIC AND
COMMON PILOT SUBCARRIERS IN MULTI-CARRIER,
MULTI CELL WIRELESS COMMUNICATION NETWORKS

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

I. STATEMENT OF PRECISE RELIEF REQUESTED

General Motors LLC, Nissan North America, Inc., Tesla, Inc., and American Honda Motor Co., Inc. (collectively “Petitioner” or “Petitioners”) respectfully submit 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. §§ 42.22 and 42.122(b), Petitioners move for joinder with the IPR recently instituted on May 2, 2023 in IPR2022-01539 (“VW IPR”). *Volkswagen Group of America Inc. v. Neo Wireless LLC*, IPR2022-01539, Paper 7 (PTAB May 2, 2023). Petitioners’ concurrently-filed Petition is substantively the same as the VW IPR petition. It challenges the same claims, on the same grounds, and relies on the same prior art as instituted in the VW IPR and therefore would create no additional burden for the Board, the VW IPR Petitioner, or Patent Owner if joined. Joinder would therefore lead to an efficient resolution of the validity of the ’512 patent.

Petitioners are currently defendants in a multidistrict court litigation in the Eastern District of Michigan, *In re Neo Wireless, LLC Patent Litig.*, 2:22-md-3034-TGB (E.D. MI). In this proceeding, Petitioners have been accused of infringing the ’512 patent. Petitioners have not previously filed a petition for IPR challenging the validity of the ’512 patent.

Petitioners stipulate that if joinder is granted, they will act as an “understudy”

and will not assume an active role unless the VW IPR Petitioner ceases to participate in the proceeding. The VW 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. Petitioners also will not seek additional depositions or deposition time. Joinder will not impact the trial schedule because the proceeding based on the VW IPR is in its early stages having just instituted on May 2, 2023.

In fact, joinder will help efficiently resolve the disputes among the parties. By joinder, a single Board decision may dispose of the issues raised in the VW IPR for all interested parties.

Joinder will not unduly prejudice any party. Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or needlessly increase filings, any additional costs on Patent Owner will be minimal. On the other hand, denial of joinder would prejudice Petitioners. Petitioners' interests may not be adequately protected in the VW IPR, particularly if the VW IPR Petitioner settles with Patent Owner and ceases to participate. Petitioners should be allowed to join in a proceeding affecting a patent asserted against them.

Given the similarities of the proceedings, the lack of undue prejudice to Patent Owner, and the potential benefit to the public and to the Board that would accrue by Petitioners' cooperative participation in the VW IPR in the event that the VW IPR Petitioner's participation terminates, the Board should institute IPR and grant

Petitioners' instant Motion for Joinder.

II. ARGUMENT

A. Legal Standards and Applicable Rules

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); *Taiwan Semiconductor Mfg. Co., Ltd. v. Zond LLC*, IPR2014-00781 and IPR2014-00782, Paper 5 at 3 (PTAB May 29, 2014).

The Board has discretion to grant a motion for joinder of a petitioner for *inter partes* review to another *inter partes* review proceeding. See 35 U.S.C. § 315(c). In determining whether to exercise its discretion to grant a motion for joinder, the Board considers: (1) reasons why joinder is appropriate; (2) any new grounds of unpatentability asserted in the petition; (3) what impact (if any) joinder would have on the trial schedule for the existing review; and (4) specifically how briefing and discovery may be simplified. See *Dell, Inc. v. Network-1 Security Solutions, Inc.*, IPR201300385, Paper 17 at 3 (July 29, 2013).

B. Petitioner's Motion for Joinder is Timely

Joinder may be requested "no later than one month after the institution date of any *inter partes* review for which joinder is requested." 37 C.F.R. § 42.122(b). The VW IPR was instituted on May 2, 2023. IPR2022-01539, Paper 7 (PTAB May 2, 2023). Petitioners' current motion is timely as it is being filed within one

month of the institution date.

C. The Four Factors Favor Joinder

Each of the four factors weighs in favor of granting Petitioners' Motion for Joinder. Petitioners' Petition is substantively identical to the petition in the VW IPR; it presents no new grounds of unpatentability. Joinder will have no impact on the pending schedule of the VW IPR. Moreover, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

1. Joinder of Petitioners Is Appropriate Because It Will Promote an Efficient Determination of the Validity of the '512 Patent Without Prejudice to Any Party

Petitioners seek to join the VW IPR in order to ensure that accused infringers with an active interest in the proceeding remains a party to this IPR if the VW IPR Petitioner's participation is terminated prior to completion. Thus, joining Petitioners to the VW IPR is the most practical way to secure the just, speedy, and inexpensive resolution of the challenge to the '512 patent. *See* 37 C.F.R. § 42.1(b).

If Petitioners are joined as parties, the validity of the grounds raised in the VW IPR can be determined in a single proceeding. Joinder is also appropriate because Petitioners' petition challenges the validity of the same claims of the '512 patent on identical grounds to those in the VW IPR. There are no substantive differences between Petitioners' and the VW IPR Petitioner's Petition, IPR2022-01539, Paper 1 (September 15 2022). Petitioners also rely on substantially the

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