

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENERAL MOTORS LLC, NISSAN NORTH AMERICA, INC., TESLA, INC.,
AND AMERICAN HONDA MOTOR CO., INC.,

Petitioner,

v.

NEO WIRELESS LLC,

Patent Owner.

Case IPR2023-00961

Patent 10,965,512

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

I. INTRODUCTION

General Motors LLC, Nissan North America, Inc., Tesla, Inc., and American Honda Motor Co., Inc. (collectively “Petitioner”) hereby respond to Patent Owner’s Response (Paper 7, “Resp.”) to Petitioner’s Motion for Joinder (Paper 2, “Mot.”) that requests joinder with IPR2022-01539 (*Volkswagen Group of America, Inc. v. Neo Wireless LLC* (“Volkswagen IPR”)). This reply is timely under 37 C.F.R. § 42.25(a)(2).

On May 2, 2023, the Board instituted the Volkswagen IPR petition on all grounds. Volkswagen IPR, Paper 7. Petitioner’s petition is substantively the same as the instituted Volkswagen IPR petition. Petitioner’s petition challenges the same claims, on the same grounds, and relies on the same prior art as the Volkswagen IPR. Furthermore, Petitioner has stipulated 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. Mot., 1-2. Petitioner has also agreed to abide by numerous conditions for the “understudy” role. Mot., 7-9 (Petitioner’s stipulated conditions (a)-(e)).

In response, Patent Owner argues that Petitioner’s stipulated conditions “are insufficient” and that the Board should only grant joinder with the following additional conditions: (1) that Petitioner be denied any right to participate in the joined proceeding, including filing papers, engaging in discovery, or participate in depositions and oral argument, jointly or otherwise, without first obtaining

authorization from the Board; and (2) that Petitioner's exhibits, including its separate expert declaration (Ex. 1035), not be added to the record of this case, and that Petitioner has no right as understudy petitioner to submit any separate exhibits or other materials. Resp., 2-3. Patent Owner further demands that "[Petitioner]'s separately filed exhibits, including the Valenti declaration, should be required to be withdrawn and should not become part of the record of the joined proceedings." Resp., 11.

Patent Owner's additional condition (1) is unnecessary because Petitioner's stipulated conditions are consistent with the Board's practice.

Patent Owner's additional condition (2) is contrary to the Board's practice. Contrary to Patent Owner's assertions, the Board routinely grants joinder without requiring the joined petitioner to withdraw its exhibits in cases where the joined petitioner's supporting materials are substantially identical to those in the existing proceeding.

II. PETITIONER'S PROPOSAL IS CONSISTENT WITH THE BOARD'S PRACTICE

Patent Owner's additional condition (1) that Petitioner should have "no right to file papers, engage in discovery, or participate in depositions and oral argument without first obtaining authorization from the Board" is unnecessary because Petitioner's stipulated conditions (Mot., 7-9) already limit Petitioner's participation in a manner consistent with the Board's practice by limiting

additional discovery, briefing, and oral argument. *See Sony Corp. v. Memory*

Integrity, LLC, IPR2015-01353, Paper No. 11 at 6-7 (PTAB Oct. 5, 2015)

(granting motion because “joinder would increase efficiency”).

The Board routinely grants motions for joinder where petitioner agrees to participate as Petitioner proposes here. *See, e.g., Advanced Micro Devices, Inc. et al. v. Monterey Research, LLC*, IPR2021-00776, Paper No. 13 at 22 (PTAB Oct. 13, 2021); *Taiwan Semiconductor Manufacturing Co., Ltd. v. Arbor Global Strategies, LLC*, IPR2021-00736, Paper No. 9 at 8 (PTAB Jun. 11, 2021).

III. PETITIONER SHOULD NOT BE REQUIRED TO WITHDRAW ITS EXHIBITS

Patent Owner’s additional condition (2) that “[Petitioner]’s separately filed exhibits, including the Valenti declaration, should be required to be withdrawn” and that “[Petitioner] have no right as understudy petitioner to submit any separate exhibits or other materials” is inconsistent with the Board’s practice.

Contrary to Patent Owner’s assertions, the Board routinely grants joinder without requiring the joined petitioner to withdraw its exhibits when substantially the same evidence was filed as in the existing proceeding. *See, e.g., Everlight Elecs. Co., v. Document Security Sys., Inc.*, IPR2018- 01260, Paper No. 12 at 6-7 (PTAB Nov. 14, 2018) (granting motion for joinder where petitioner submitted separate but substantially identical expert declaration); *Splunk Inc. v. Sable Networks, Inc.*, IPR2022-00228, Paper 9, 8 (PTAB Apr. 4, 2022) (denying Patent

Owner's request that petitioner should be required to withdraw its exhibits from the proceeding).

Furthermore, contrary to Patent Owner's demand, the Board routinely permits a joining party to submit separate filings in a limited "understudy" role. *See, e.g., MSN Labs. Private Ltd. v. Bausch Health Ireland Ltd.*, IPR2023-00016, Paper 12, 3-4 (PTAB Nov. 29, 2022); *Sony* (IPR2015-01353), Paper No. 11 at 5-6 (permitting a joining party to submit a separate filing).

Patent Owner asserts that "[i]n other proceedings, the Board has granted joinder only on the simple, efficient condition that the joined petitioner use the witness declaration of the existing party, and indeed that, if it has filed a declaration, that the declaration be withdrawn." (Resp. 12). However, the facts in the Patent Owner's cited proceedings are not consistent with the facts in this proceeding.

In *Mylan*, the Board denied joinder because "the date for the oral hearing is only a few weeks away" without "a practical way to accommodate the additional discovery." *See Mylan Pharms. Inc. v. Janssen Oncology, Inc.*, IPR2016-01332, Paper 21, 11 (PTAB Jan. 10, 2017).

In *Argentum*, the joining party preemptively offered, as a condition in its Motion for Joinder, to "withdraw the declaration of its expert" if the existing party allows the joining party "to retain the same expert." *See Argentum Pharma. LLC v. Janssen Oncology Inc.*, IPR2016-01317, Paper 9, 5-6 (PTAB Sep. 19, 2016).

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