

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCEDES-BENZ USA, LTD,

Petitioner,

v.

DAEDALUS PRIME LLC,

Patent Owner.

Case No.: IPR2023-01333

U.S. Patent No. 10,049,080

PATENT OWNER'S OPPOSITION TO
PETITIONER'S CONTINGENT MOTION FOR JOINDER

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I. INTRODUCTION

Petitioner, Mercedes-Benz USA LLC, seeks joinder with *Qualcomm Inc. v. Daedalus Prime LLC*, IPR2023-00567 (the “Qualcomm IPR”), but only if that IPR is instituted. Mot. at 1. While it is true that if the Qualcomm IPR is not instituted, Petitioner’s motion would be moot inasmuch as there would be no proceeding to join, the rules of practice do not make provision for conditional motions of this type and Petitioner did not obtain leave for filing its instant motion. Further, Petitioner has not indicated that Qualcomm has agreed to such joinder and nor has Petitioner agreed to rely entirely on, and be bound by, the expert declaration(s) and deposition(s) in the Qualcomm IPR and so has not met the requirements for being a true “understudy” in that proceeding. Accordingly, Patent Owner opposes, and respectfully requests that the Board deny Petitioner’s motion.

II. BACKGROUND

The Qualcomm IPR is presently pending, but no institution decision has yet been reached. Mercedes-Benz filed its petition and contingent motion for joinder on August 18, 2023. Mercedes-Benz characterizes its petition as being “substantively the same as the Qualcomm IPR petition [] challeng[ing] the same claims, on the same grounds, and rel[ying] on the

same prior art as the Qualcomm IPR petition.” *Id.* at 1-2. Yet, along with its petition Mercedes-Benz filed a supporting declaration by its own expert witness, *id.* at 5, and that declaration offers opinions not included in the expert declaration filed in the Qualcomm IPR. *See, e.g.*, Ex. 1034 at p.23, n. 5, n.6; p. 25, n. 7; p. 31, n. 8; pp. 43-44, n. 10. Mercedes-Benz has not agreed to rely entirely on, and be bound by, the expert declaration(s) and deposition(s) in the Qualcomm IPR, saying only that it “agrees to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the Qualcomm IPR if it is instituted.” Mot. at 2. This is important because should the Qualcomm IPR petitioners cease to participate in the Qualcomm IPR, Mercedes-Benz would seek to avoid being a mere “understudy.” *See id.* More particularly, Mercedes-Benz’ stipulation is inadequate, and does not address Patent Owner’s concern that, in the event the Qualcomm IPR petitioners were to exit the Qualcomm IPR, Mercedes-Benz will attempt a “re-do” of expert testimony, inconsistent with joinder proceedings. Accordingly, Patent Owner is compelled to file the present opposition.

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