

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCEDES-BENZ USA, LLC,
Petitioner

v.

DAEDALUS PRIME LLC,
Patent Owner

Case IPR2023-01333
U.S. Patent No. 10,049,080

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

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Daedalus Prime LLC (“Patent Owner”) opposes Petitioner’s Contingent Motion for Joinder¹ (Paper 2) (the “Motion”) on two non-substantive grounds. *See* Paper 7, Patent Owner’s Opposition to Petitioner’s Contingent Motion For Joinder (the “Opposition”). First, Patent Owner argues that joinder should be denied because Petitioner allegedly did not agree to rely on the Qualcomm IPR petitioner’s expert declaration and deposition. *Id.* at 2, 3-5. Second, Patent Owner contends that Petitioner failed to follow Board procedures when filing the Motion. *Id.* at 5. Patent Owner is incorrect on both counts. The Board should thus grant joinder for the reasons given herein and in the Motion.

First, Patent Owner misunderstands Petitioner’s commitment to act as an “understudy” if joined into the Qualcomm IPR. Petitioner explicitly agreed to rely on Dr. Trevor Mudge’s (the Qualcomm IPR petitioner’s expert) declaration and testimony. Mot. at 2, 7. Petitioner’s only reservation is that it will rely on its own

¹ Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner respectively moved to join any *inter partes* review instituted as to U.S. Patent No. 10,049,080 in *Qualcomm Inc. v. Daedalus Prime LLC*, No. IPR2023-00567 (the “Qualcomm IPR”). *Inter partes* review was instituted in the Qualcomm IPR on October 11, 2023 (see Qualcomm IPR, Paper 13), so the Motion is ripe for consideration. Petitioner files this Reply pursuant to 37 C.F.R. §§ 42.23, 42.24, 42.25.

expert if “the Qualcomm IPR petitioner is terminated from the case prior to any necessary depositions” and Dr. Mudge is unavailable to be deposed. *Id.* at 7-8. At such time, Petitioner will rely on Dr. Robert Horst’s substantively identical declaration² and Patent Owner can depose Dr. Horst.

This approach is customary in joined *inter partes* review proceedings, including those cited by Patent Owner. *Oppo.* at 3-4 (quoting *Z-Shade Co. v. Caravan Canopy Int’l, Inc.*, IPR2020-01026, Paper 22 at 8 (PTAB May 17, 2021) and *Samsung Elecs. Co. v. Yu*, IPR2020-00492, Paper 6 at 7 (PTAB Aug. 12, 2020), which each imposed the same conditions agreed to by Petitioner here); *see also Mercedes-Benz Grp. AG v. Neo Wireless, LLC.*, IPR2023-00079, Paper 11 at 6-14 (P.T.A.B. May 5, 2023) (granting joinder based on the same conditions); *Mercedes-Benz Grp. AG v. Arigna Tech. Ltd.*, IPR2022-00776, Paper 8 at 9-11

² Patent Owner identifies a handful of statements that Dr. Horst offers in addition to Dr. Mudge’s analysis. *See Oppo.* at 2 (citing Ex. 1034 at 23, n.5, n.6; 25 n.7; 31 n.8; 43-44 n.10.). These minor additions do not alter the fact that Dr. Horst’s declaration is substantively identical to the expert declaration in the Qualcomm IPR. And, for the avoidance of doubt, as Petitioner agreed in the Motion, in the joined proceeding it would proceed “solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the Qualcomm IPR.” (Motion at 2 (emphasis added).)

(P.T.A.B. Sept. 8, 2022) (same). Joinder accordingly presents no risk of duplicative declarations, depositions, or other evidence.

Second, Petitioner's Motion was procedurally proper. The Board regularly grants joinder motions that are contingent on institution being granted in the first *inter partes* review proceeding. *See, e.g., Mercedes-Benz USA, LLC v. Neo Wireless, LLC*, IPR2023-00079, Paper 11 at 6-14 (PTAB May 5, 2023); *Ford Motor Co. v. Carrum Techs., LLC*, IPR2020-00055, Paper 8 at 2, 4-5 (PTAB Apr. 17, 2020). The Board has now granted institution of the Qualcomm IPR, but if institution had been denied, the Motion would have simply been moot. Mot. at 1.

Moreover, Petitioner was authorized to file its timely motion for joinder under 37 C.F.R. § 42.122(b). *See, e.g., Samsung Elecs. Co. v. Fujinomaki*, IPR2017-01017, Paper 12 at 3-4 (P.T.A.B. May 26, 2017); *Taiwan Semiconductor Mfg. Co. v. Zond, LLC*, IPR2014-00781, Paper 5 at 3 (P.T.A.B. May 29, 2014). The Consolidated Trial Practice Guide's contemplation of a teleconference within days of a joinder motion does not account for pre-institution joinder requests. *See* PTAB Consolidated Trial Practice Guide at 76 (November 2019), *available at* <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>. A pre-institution teleconference with the panel and parties from the first proceeding would have been inefficient, since the panel had not yet decided whether to institute and issue a schedule. Nor has the Board required such pre-institution teleconferences when

granting similar joinder motions in the past. *See, e.g., Mercedes-Benz USA, LLC v. Neo Wireless, LLC*, IPR2023-00079, Paper 11.³ In any event, Patent Owner identifies no prejudice from Petitioner's Motion or its procedures upon joinder.

For the foregoing reasons, and the reasons provided in Petitioner's Motion, Petitioner respectfully requests *inter partes* review of U.S. Patent No. 10,049,080 and joinder with *Qualcomm Inc. v. Daedalus Prime LLC*, IPR2023-00567.

Dated: October 13, 2023

Respectfully submitted,

/s/ Celine J. Crowson

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³ Petitioner is willing to meet and confer with the Board and all involved parties regarding the conduct of the joined proceeding, if desired.

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