

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WALMART INC. and WALMART STORES TEXAS, LLC
Petitioner,

v.

RAVENWHITE SECURITY, INC.,
Patent Owner.

Case No. IPR2025-00810
U.S. Patent No. 10,594,823

**MOTION FOR JOINDER UNDER
35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)
TO RELATED *INTER PARTES* REVIEW IPR2024-01316**

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Walmart Inc. and Walmart Stores Texas, LLC (“Petitioner”) respectfully submits this Motion for Joinder, together with a Petition for *Inter Partes* Review of U.S. Patent No. 10,594,823 (“’823 Patent”) (IPR2025-00810, “the 00810 Petition”) filed contemporaneously herewith. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner requests institution of an *inter partes* review and joinder with the *inter partes* review in *Home Depot U.S.A., Inc. v. RavenWhite Security, Inc.*, IPR2024-01316 (“the Home Depot IPR”). The 00810 Petition is also narrowly tailored to the same claims, prior art, and grounds for unpatentability that are the subject of the Home Depot IPR. In addition, Petitioner is willing to streamline discovery and briefing. Petitioner understands that Home Depot does not oppose Petitioner’s request for joinder.

Petitioner submits that joinder is appropriate because it will not unduly burden or prejudice the parties to the Home Depot IPR while efficiently resolving the question of the ’823 Patent’s validity in a single proceeding.

II. STATEMENT OF MATERIAL FACTS

1. On September 17, 2024, Home Depot U.S.A., Inc. (“Home Depot”) filed a petition for *inter partes* review (IPR2024-01316) requesting cancellation of claims 1-10 of the ’823 Patent.

2. On December 26, 2024, Patent Owner filed its preliminary response, setting a deadline for the Board to issue an institution decision in late March, 2025. 35 U.S.C. § 315(b); IPR2024-01316, Paper 9.

3. On March 24, 2025, the Board issued its decision granting institution of the Home Depot IPR. IPR2024-01316, Paper 12.

3. Contemporaneously with this Motion, Petitioner filed its Petition for *Inter Partes* Review requesting cancellation of claims 1-10 of the '823 Patent, which is substantively identical to the Home Depot IPR.

III. STATEMENT OF THE PRECISE RELIEF REQUESTED

A. Legal Standard

The Board has the authority under 35 U.S.C. § 315(c) to join a properly filed *inter partes* review petition to an instituted *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). A motion for joinder must be filed within one month of the Board instituting an original *inter partes* review. 37 C.F.R. § 42.122(b). In deciding whether to exercise its discretion and permit joinder, the Board considers factors, including: (1) the reasons why joinder is appropriate; (2) whether the new petition presents any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (April 24, 2013).

B. Petitioner’s Motion for Joinder is Timely

This Motion for Joinder is timely because it is filed within 30 days of the Board’s March 24, 2025 Institution Decision in the Home Depot IPR. 37 C.F.R. § 42.122(b).

C. Each Factor Weighs in Favor of Joinder

Each of the four factors considered by the Board weighs in favor of joinder here. Specifically, the 00810Petition does not present any new grounds of unpatentability; rather it is substantively identical to the Home Depot IPR Petition. Further, joinder will have minimal, if any, impact on any forthcoming trial schedule, as all issues are substantively identical and Petitioner will accept an “understudy” role. *See Sony Corp. et al. v. Memory Integrity, LLC*, IPR2015-01353, Decision Instituting IPR Review, Motion for Joinder, Paper 11 at 6; (granting IPR where petitioners requested an “understudy” role); *see also* IPR2015-01353, Motion for Joinder, Paper 4 at 5-7. Lastly, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

1. Joinder is Appropriate

Joinder with the Home Depot IPR is appropriate because the 00810 Petition involves the same patent, challenges the same claims, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the Home Depot IPR Petition. *Id.* The 00810 Petition is substantively identical to the Home Depot IPR Petition, containing only minor differences

related to only issues associated with a different party filing the petition. The 00810 Petition presents no changes to the facts, citations, evidence, or arguments related to patentability presented in the Home Depot IPR Petition. Because these proceedings are substantively identical, good cause exists for joining this proceeding with the Home Depot IPR so that the Board can efficiently resolve all grounds in both the 00810 Petition and Home Depot IPR Petition in a single proceeding. *Id.*

2. Petitioner Proposes No New Grounds of Unpatentability

The 00810 Petition presents the same grounds of unpatentability as the Home Depot IPR Petition.

3. Joinder Will Not Unduly Burden or Negatively Impact Any Forthcoming Home Depot IPR Trial Schedule

Because the 00810 Petition is substantively identical to the Home Depot IPR Petition, with the same grounds challenging the same claims as in the original Home Depot IPR Petition, there are no new substantive issues for Patent Owner to address. Due to the same issues being presented in the 00810 Petition and the Home Depot IPR Petition, Patent Owner will not be required to present any additional responses or arguments. *See* IPR2015-01353, Decision Instituting IPR, Motion for Joinder, Paper 11 at 6 (granting IPR and motion for joinder where “joinder should not necessitate any additional briefing or discovery from Patent

Owner beyond that already required in [the original IPR].”); *see also* IPR2015-01353, Motion for Joinder, Paper 4 at 5-7.

The Patent Owner Response will also not be negatively impacted because the issues presented in the Home Depot IPR Petition are identical to the issues presented in the 00810 Petition. Patent Owner will not be required to provide any additional analysis or arguments beyond what it already provided in responding to the Home Depot IPR Petition. Also, because the 00810 Petition relies on the same expert and an identical declaration, only a single deposition is needed for the proposed joined proceeding.

Joinder of this proceeding with the Home Depot IPR does not unduly burden or negatively impact any forthcoming trial schedule in any meaningful way. Further, even if a small adjustment of the trial schedule was necessary, this is already provided for in the rules and is a routine undertaking by parties in IPR proceedings. *See* 37 C.F.R. § 42.100(c). Thus, a slight adjustment in the trial schedule, should one be needed, is not enough of a reason to deny joining the present 00810 Petition with the Home Depot IPR.

4. Procedures to Simplify Briefing and Discovery

The Home Depot IPR Petition and 00810 Petition present substantively identical grounds of unpatentability, including the same art combinations against

the same claims. Additionally, Petitioner explicitly agrees to take an “understudy” role, as described by the Board:

“(a) *all* filings by [Petitioner] in the joined proceeding be consolidated with [the filings of the petitioner in the Home Depot IPR], unless a filing solely concerns issues that do not involve [the petitioner in the Home Depot IPR]; (b) [Petitioner] shall not be permitted to raise any new grounds not already instituted by the Board in the [Home Depot] IPR, or introduce any argument or discovery not already introduced by [the petitioner in the Home Depot IPR]; (c) [Petitioner] shall be bound by any agreement between [Patent Owner] and [the petitioner in the Home Depot IPR] concerning discovery and/or depositions; and (d) [Petitioner] at deposition shall not receive any direct, cross-examination or redirect time beyond that permitted for [the petitioner in the Home Depot IPR] alone under either 37 C.F.R. § 42.53 or any agreement between [Patent Owner] and [the petitioner in the Home Depot IPR].”

Noven Pharmaceuticals, Inc. et al. v. Novartis AG et al., IPR2014-00550, Paper 38 at 5 (Apr. 10, 2015) (emphasis in original). Petitioner will assume the primary role only if Home Depot ceases to participate in the Home Depot IPR.

By Petitioner accepting an “understudy” role, Patent Owner and Petitioner can comply with any forthcoming trial schedule and avoid any duplicative efforts by the Board or the Patent Owner. These steps will minimize any potential complications or delay that potentially may result by joinder. *See* IPR2015-01353, Decision Instituting IPR, Paper 11 at 6-7 (granting IPR and motion for joinder because “joinder would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board” where petitioners agreed to an “understudy” role.); *see also* IPR2015-01353, Motion for Joinder, Paper 4 at 6-7.

Accordingly, joinder should be permitted. *See* IPR2015-01353, Decision Instituting IPR Review, Motion for Joinder, Paper 11 at 5-6 (granting institution of IPR and motion for joinder where petitioners relied “on the same prior art, same arguments, and same evidence, including the same expert and a substantively identical declaration.”); *see also* IPR2015-01353, Motion for Joinder, Paper 4 at 4-5.

IV. GENERAL PLASTIC IS INAPPLICABLE

Pursuant to Acting Director Coke M. Stewart’s March 26, 2025, Memorandum regarding Interim Processes for PTAB Workload Management, Petitioner understands that discretionary denial issues if any will be raised in a separate brief to be filed by Patent Owner. To the extent that Patent Owner files such a brief implicating the *General Plastic* factors, Petitioner intends to respond in an opposition brief consistent with Acting Director Coke M. Stewart’s March 26, 2025, Memorandum regarding Interim Processes for PTAB Workload Management. Accordingly, Petitioner will not address discretionary denial issues in this Motion other than to address a threshold issue, namely, that application of the *General Plastic* analysis is inapplicable here.

In the current motion, Petitioner merely seeks to join Home Depot’s petition and does not present any new grounds. As such, Petitioner respectfully submits that *General Plastic* does not apply in this circumstance because Petitioner would be taking an understudy role and the Board’s finite resources would not be impacted. Moreover, a joinder petition in these circumstances is not the type of serial petition to which *General Plastic* applies, especially as Petitioner has not previously filed an IPR against the ’823 Patent. The PTAB has previously stated that a joinder petition “effectively neutralizes” a *General Plastic* analysis. *See Apple Inc. v. Uniloc 2017 LLC*, IPR2018-00580, Paper 13 at 10 (PTAB Aug. 21,

2018) (instituting a joinder petition where joinder petitioner previously filed a non-instituted IPR, stating joinder petitioner’s joinder motion agreeing to a passive understudy role “effectively neutraliz[es] the *General Plastic* factors”); *see also Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11 at 10 (PTAB Oct. 30, 2018) (instituting a joinder petition where joinder petitioner previously filed a non-instituted IPR, stating the joinder motion “effectively obviates any concerns of serial harassment and unnecessary expenditure of resources”).

V. CONCLUSION

Based on the factors discussed above, Petitioner respectfully requests that the Board grant the 00810 Petition for *Inter Partes* Review of U.S. Patent No. 10,594,823 and then grant joinder with the Home Depot IPR2024-01316 proceeding.

Dated: March 28, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the Motion for Joinder has been served via email on the following, who has agreed to accept service on behalf of Patent Owner:

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