

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOMBARDIER RECREATIONAL PRODUCTS INC.,
Petitioner,

v.

MHL CUSTOM, INC.,
Patent Owner.

IPR2024-01107
Patent 9,586,659 B2

Before BART A. GERSTENBLITH, KEVIN W. CHERRY, and
MICHAEL L. WOODS, *Administrative Patent Judges*.

CHERRY, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

Bombardier Recreational Products Inc. (“Petitioner” or “BRP”) filed a Petition (Paper 3, “Pet.” or “Petition” or “BRP IPR”) for *inter partes* review of claims 1, 2, 4, 5, 7–11, 13, and 15 (the “Challenged Claims”) of U.S. Patent No. 9,586,659 B2 (Ex. 1001, “the ’659 patent”). Pet. 1. MHL Custom, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.” or “Preliminary Response”).

Petitioner also filed a Motion for Joinder (Paper 4, “Mot.” or “Motion”), seeking to join IPR2024-00085 (the “Foil Boarding IPR,” filed by petitioner Foil Boarding Company, Inc. (“Foil Boarding”)). Patent Owner did not file an opposition to the Motion.

The Petition asserts the same grounds of unpatentability as those upon which we instituted review in the Foil Boarding IPR. *Compare* Pet. 10, with Foil Boarding IPR, Paper 12 at 6; *see also* Mot. 4 (“Petitioner represents that the BRP IPR is identical to the Foil Boarding IPR in all substantive respects. It includes identical grounds, analysis, and exhibits and relies upon the same expert declarant and substantively identical declaration.”).

Under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a), we have authority to institute an *inter partes* review if “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). As explained below, we grant Petitioner’s unopposed Motion and we grant institution of *inter partes* review.

II. BACKGROUND

A. Real Parties-in-Interest

Petitioner identifies itself as the sole real party-in-interest. Pet. 5.

Patent Owner identifies itself as the sole real party-in-interest. *See* Paper 6, 2.

B. Related Matters

The parties identify the following court proceedings relating to the '659 patent:

1. *MHL Custom, Inc. v. Foil Boarding Company, Inc., d/b/a Foil, f/k/a Get Foil*, No. 3:22-cv-21258 (N.D. Fla.);
2. *MHL Custom, Inc. v. Waydoo USA, Inc.*, No. 1:21-cv-00091 (D. Del.), *appealed as MHL Custom, Inc. v. Waydoo USA, Inc.*, No. 24-1036 (Fed. Cir.); and
3. *MHL Custom Inc. v. Avante Innovations, LLC*, No. 3-20-cv-01648 (S.D. Cal.) (dismissed).

Pet. 5–6; Paper 6, 2–3.

We also note that the following matters are related:

1. IPR2024-00085, the Foil Boarding IPR;
2. IPR2024-00086 (filed by Foil Boarding, challenging related U.S. Patent No. 9,359,044 B2 (the "'044 patent"));
3. IPR2024-00998, filed by Shenzhen Waydoo Intelligence Technology Co., Ltd., challenging the '044 patent;
4. IPR2024-00999, filed by Shenzhen Waydoo Intelligence Technology Co., Ltd., challenging the '659 patent; and
5. IPR2024-01108, filed by BRP, challenging the '044 patent.

C. Asserted Grounds of Unpatentability and Declaration Evidence

Petitioner asserts that the Challenged Claims are unpatentable based on the following grounds (Pet. 9–10):

Ground	Claim(s) Challenged	35 U.S.C. §¹	References/Basis
1	1, 2, 4, 5, 7–11, 13, 15	103	Evolo Report, ² Woolley ³
2	1, 4, 5, 7, 15	103	Evolo Videos, ⁴ Woolley
3	2, 9, 10	103	Evolo Videos, Woolley, Torqeedo Manual ⁵
4	8	103	Evolo Videos, Woolley, Torqeedo Manual, Gleason ⁶
5	11, 13	103	Evolo Videos, Woolley, Torqeedo Manual, Gleason, Manning ⁷

¹ The '659 patent was filed after March 15, 2013, and the AIA version of 35 U.S.C. applies to this proceeding. *See* Ex. 1001, codes (22), (60), (63).

² “Evolo Report” or “EvoloReport” (Ex. 1003), published Apr. 23, 2009. Pet. 13.

³ U.S. Pat. No. 6,443,786 B2, issued Sept. 3, 2002 (Ex. 1011, “Woolley”).

⁴ The Evolo Videos collectively comprise: (1) Ex. 1006 (allegedly published May 5, 2009, https://www.youtube.com/watch?v=a-_OCN50aWo); (2) Ex. 1008 (allegedly published June 11, 2009, <https://www.youtube.com/watch?v=zL9fO8tF118>); and (3) Ex. 1010 (allegedly published Apr. 29, 2009, <https://www.youtube.com/watch?v=fKOQ0JwQnjc>). *See* Pet. 13–14 (citing the same).

⁵ Operating Manual Cruise 2.0 (Ex. 1014, “Torqeedo Manual”), allegedly published Feb. 2007. Pet. 14.

⁶ U.S. Pat. No. 4,020,782, issued May 3, 1977 (Ex. 1012, “Gleason”).

⁷ U.S. Pat. No. 8,290,636 B2, issued Oct. 16, 2012 (Ex. 1013, “Manning”).

Petitioner relies on the Declaration of Stefano Brizzolara, Ph.D. *Id.* at 10 (citing Ex. 1002).

III. ANALYSIS

A. Institution of Inter Partes Review

In its Motion for Joinder, Petitioner represents that the “BRP IPR is substantially identical to the Foil Boarding IPR in all substantive respects, includes identical exhibits, and relies upon the same expert.” Mot. 2. Petitioner further represents that “[the BRP IPR] includes identical grounds, analysis, and exhibits and relies upon the same expert declarant and substantively identical declaration.” *Id.* at 4. Our independent review of the Petition and the Foil Boarding IPR petition confirms Petitioner’s representations.

The Foil Boarding IPR petition was filed on October 26, 2023, challenging claims 1, 2, 4, 5, 7–11, 13, and 15 of the ’659 patent on the same grounds raised in this Petition. *See* Foil Boarding IPR, Paper 2 at 9–10. Patent Owner filed a preliminary response to the Foil Boarding IPR petition on February 29, 2024. Foil Boarding IPR, Paper 6. We instituted *inter partes* review based on the Foil Boarding IPR petition on May 28, 2024. Foil Boarding IPR, Paper 12. Patent Owner filed a response to the Foil Boarding IPR petition on September 17, 2024. Foil Boarding IPR, Paper 23. On October 29, 2024, Patent Owner filed a Preliminary Response to the Petition in this case. Prelim. Resp.

We acknowledge Patent Owner’s arguments supporting its position that Petitioner has not shown sufficiently that claims 1, 2, 4, 5, 7–11, 13, and 15 would have been obvious. Prelim. Resp. 4–59. Based on our independent review, Patent Owner’s Preliminary Response arguments are

the same as or substantially similar to those in Patent Owner's response to the Foil Boarding IPR petition. *Compare id.* at 4–59, with Foil Boarding IPR, Paper 23 at 4–67.

At this stage of the proceeding and based on our preliminary review, we find Petitioner has demonstrated a reasonable likelihood of showing the unpatentability of the Challenged Claims for the same reasons discussed in our Decision on Institution in the Foil Boarding IPR. Granting the Petition and joining Petitioner to the Foil Boarding IPR will provide us with the opportunity to more fully consider Patent Owner's arguments—first raised in response to the petition in the Foil Boarding IPR—in the context in which they were first raised. Those common arguments will be fully considered in the Foil Boarding IPR, with the benefit of a complete record.⁸

Accordingly, for the reasons discussed above, we are persuaded Petitioner has demonstrated a reasonable likelihood of showing the unpatentability of the Challenged Claims of the '659 patent. We therefore grant the Petition, and institute *inter partes* review of the Challenged Claims.

B. Motion for Joinder

Joinder in *inter partes* reviews is governed by 35 U.S.C. § 315(c), which reads:

If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for

⁸ Our preliminary finding here is not intended to suggest that we have reached any determination as to the merits of Patent Owner's response in the Foil Boarding IPR. We have not. As noted above, we will consider the merits of Patent Owner's response in that proceeding in due course.

filing such a response, determines warrants the institution of an inter partes review under section 314.

A motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See Kyocera Corp. v. SoftView LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

We instituted the Foil Boarding IPR on May 28, 2024. *See* Foil Boarding IPR, Paper 12. Petitioner filed this Petition and Motion for Joinder on June 28, 2024, i.e., within one month of the institution date of the Foil Boarding IPR. *See* Paper 4; Mot. Thus, Petitioner timely filed its Motion for Joinder. *See* 37 C.F.R. § 42.122(b).

As discussed above, Petitioner represents that the “BRP IPR is substantially identical to the Foil Boarding IPR in all substantive respects, includes identical exhibits, and relies upon the same expert.” Mot. 2. Petitioner also represents that “[the BRP IPR] includes identical grounds, analysis, and exhibits and relies upon the same expert declarant and substantively identical declaration.” *Id.* at 4. Petitioner further represents that, should it be joined to the Foil Boarding IPR, Petitioner will act “solely as an ‘understudy,’” and “would only assume an active role in the event Foil Boarding settles with Patent Owner MHL Custom Inc. and moves to terminate the Foil Boarding IPR, or in which [case] Foil Boarding indicates that it is no longer willing or financially able to prosecute the Foil Boarding IPR.” *Id.* at 2. Thus, if joined, Petitioner agrees to consolidate all filings with Foil Boarding, refrain from advancing any arguments not advanced by Foil Boarding, bind itself to any agreements concerning depositions or

discovery made by Foil Boarding, and limit its deposition time to the time allotted to Foil Boarding. *Id.* at 4–5. Petitioner notes that the Petition does not raise any new grounds of unpatentability, and the trial schedule in the Foil Boarding IPR will not have to be altered. *Id.* at 5–6.

Petitioner argues that joinder to the Foil Boarding IPR is appropriate because “Petitioner proposes joinder to streamline the proceedings and reduce the costs and burdens on the parties.” *Id.* at 6. Petitioner asserts joinder will accomplish this because it will “decrease the number of papers the parties must file, by eliminating a duplicative proceeding,” “reduce by half the time and expense for depositions and other discovery required in separate proceedings,” and create “case management efficiencies for the Board and parties without any prejudice to MHL Custom.” *Id.*

Patent Owner does not oppose Petitioner’s Motion.

We are persuaded by Petitioner’s arguments. Because the Petition challenges the same claims on the same grounds using the same prior art, *Kyocera* factor (2) favors joinder. *See Kyocera*, IPR2013-00004, Paper 15 at 4. Indeed, the Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.” *Samsung Elecs. Co. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (PTAB Aug. 24, 2016). Moreover, because the issues to be decided are the same and Petitioner avers that it will take an “understudy” role to Foil Boarding in the Foil Boarding IPR by consolidating all filings, refraining from advancing new arguments, binding itself to any discovery agreements, and limiting its deposition time to the time already allotted, *Kyocera* factors (3) and (4) also favor joinder. *See* Mot. 4–6; *Kyocera*, IPR2013-00004, Paper 15 at 4.

For the reasons explained above, we find that joining Petitioner to the Foil Boarding IPR is appropriate under the present circumstances. We, therefore, *grant* Petitioner's Motion.

IV. CONCLUSION

For the foregoing reasons, we are persuaded that Petitioner has demonstrated a reasonable likelihood that it will succeed in showing claims 1, 2, 4, 5, 7–11, 13, and 15 are unpatentable under 35 U.S.C. § 103. At this preliminary stage, we have not made a final determination with respect to the patentability of the Challenged Claims or any underlying factual and legal issues.

Given that Petitioner is being joined as a party to the Foil Boarding IPR, Petitioner is bound by the ultimate determination made in the Foil Boarding IPR. *See* 35 U.S.C. §§ 315(e)(1), 325(d); 37 C.F.R. § 42.73(d)(1).

V. ORDER

For the reasons given, it is:

ORDERED that *inter partes* review is instituted in IPR2024-01107;
FURTHER ORDERED that, pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(a), Petitioner's Motion for Joinder (Paper 4) is *granted*, and Petitioner is joined as a petitioner in IPR2024-00085;

FURTHER ORDERED that, in view of the joinder, no further filings shall be made in this proceeding—IPR2024-01107—and **all further filings shall be made only in IPR2024-00085**;

FURTHER ORDERED that the asserted grounds of unpatentability on which the Board granted institution in IPR2024-00085 are unchanged and remain the only instituted grounds;

FURTHER ORDERED that the Scheduling Order in IPR2024-00085, and any modifications thereto, shall govern the schedule of the joined proceeding;

FURTHER ORDERED that, in IPR2024-00085, Petitioner will file each paper, except for any paper that does not involve the other party, as a single, consolidated filing with Foil Boarding subject to the page limits set forth in 37 C.F.R. § 42.24, and shall identify such filing as a consolidated filing;

FURTHER ORDERED that for any consolidated filing, if Petitioner wishes to file an additional paper to address points of disagreement with Foil Boarding, Petitioner must request authorization from the Board to file a motion for an additional paper or pages;

FURTHER ORDERED that Petitioner shall collectively designate attorneys with Foil Boarding to conduct the cross-examination of any witness produced by Patent Owner and the redirect of any witness produced by Foil Boarding and Petitioner, within the timeframes set forth in 37 C.F.R. § 42.53(c) or agreed to by the parties;

FURTHER ORDERED that Petitioner shall collectively designate attorneys with Foil Boarding to present at the oral hearing, if requested and scheduled, in a consolidated argument;

FURTHER ORDERED that the case caption in IPR2024-00085 shall be changed to reflect joinder of Petitioner in accordance with the attached example; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2024-00085.

IPR2024-01107
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Example Case Caption for Joined Proceeding

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⁹ Bombardier Recreational Products Inc. is joined as a Petitioner in this proceeding.