

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC,
Petitioner,

v.

TORCHLIGHT TECHNOLOGIES LLC,
Patent Owner.

IPR2022-01500
Patent 11,208,029 B2

Before JON M. JURGOVAN, JASON W. MELVIN, and
AARON W. MOORE, *Administrative Patent Judges*.

MELVIN, *Administrative Patent Judge*.

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

I. INTRODUCTION

Unified Patents, LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1, 2, 10–13, 23, and 24 of U.S. Patent No. 11,208,029 B2 (Ex. 1001, “the ’029 patent”). Torchlight Technologies LLC (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). Pursuant to 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a), we have authority to determine whether to institute review.

An *inter partes* review may not be instituted unless “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). For the reasons set forth below, we conclude that Petitioner has shown a reasonable likelihood it will prevail in establishing the unpatentability of at least one challenged claim, and we institute *inter partes* review.

A. REAL PARTIES IN INTEREST

Petitioner identifies itself as the real party in interest. Pet. 1. Patent Owner also identifies itself as the real party in interest, noting that it is the exclusive licensee of the ’029 patent, which is owned by Yechezkal Evan Spero. Paper 6, 1 (Patent Owner’s Mandatory Notices). Patent Owner challenges Petitioner’s identification, and we discuss that challenge below. *See infra* at 16 (§§ II.E, II.F).

B. RELATED MATTERS

The parties identify the following related litigation: *Torchlight Technologies LLC v. Daimler AG et al.*, No. 1:22-cv-00751 (D. Del); *Torchlight Technologies LLC v. General Motors LLC et al.*, No. 1:22-cv-

00752 (D. Del.). Pet. 2; Paper 6, 1. Patent Owner additionally identifies *Volkswagen Group of America, Inc. v. Yechezkal Evan Spero*, IPR2022-01586 (PTAB October 3, 2022). Paper 6, 1.

C. THE '029 PATENT

The '029 patent is titled “Adaptive Headlight System” and relates to motor vehicle headlamps with LED light sources and a processor to control the headlamp light pattern. Ex. 1001, codes (54), (57). The specification more generally describes a lighting device that “incorporates one or more discrete light sources and their ancillary optical and electrical control equipment in an integrated illuminating element.” *Id.* at 13:34–36. The combined unit is referred to as a Digital Lighting Fixture (DLF). *Id.* at 18:29–33.

The specification further describes transportation vehicle applications. *Id.* at 50:49–57:35. One such application involves a DLF headlamp device that includes a cluster of LEDs to illuminate around a corner. *Id.* at 51:54–63, 54:8–15. With LEDs having a variety of aims, the headlamp’s light distribution pattern may be controlled based on a number of factors, including location data from a GPS system, providing information about upcoming curves in the road. *See id.* at 51:54–67, 54:15–22.

D. CHALLENGED CLAIMS

Challenged claim 1 is independent and is reproduced below:

1. A system, for a motor vehicle, comprising:
 - a plurality of headlamps, each comprising a plurality of LED light sources;
 - one or more processors; and

a memory storing instructions that, when executed by one or more of the one or more processors, enable the one or more processors to:

receive first data, including at least map data, indicating a road curvature upcoming along a road on which the motor vehicle is traveling;

determine a light change, the change adapting a light pattern of the headlamps in at least one of color, intensity or spatial distribution to increase light in a direction of the road curvature ahead of the motor vehicle and shaping light based at least in part on the road curvature; and

control at least a first plurality of the LED light sources to provide light based at least in part on the determined light change and prior to the motor vehicle reaching the road curvature.

Id. at 95:56–96:8. Claims 2, 10, and 11 depend, directly or indirectly, from claim 1. *Id.* at 96:9–11, 97:39–44. Claim 12 is independent and recites limitations similar to claim 1’s. *Id.* at 97:45–62. Claim 13 depends from claim 12. *Id.* at 97:63–65. Claim 23 is independent and recites limitations similar to claim 1’s. *Id.* at 99:28–43. Claim 24 depends from claim 23. *Id.* at 99:44–46.

E. PRIOR ART AND ASSERTED GROUNDS

Petitioner asserts the following ground of unpatentability:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 2, 12, 13, 23, 24	103	Gotou ¹ , Harbers ²

¹ US 5,588,733; filed June 7, 1995, issued Dec. 31, 1996 (Ex. 1003).

² US 6,406,172 B1; filed June 22, 2000, issued June 18, 2002 (Ex. 1004).

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 2, 10–13, 23, 24	103	Heinz ³ , Gotou
1, 2, 10–13, 23, 24	103	Heinz, Gotou, Harbers

Pet. 6. Petitioner also relies on the Declaration of Mr. A. Brent York.
Ex. 1002.

II. ANALYSIS

A. LEVEL OF ORDINARY SKILL IN THE ART

Petitioner asserts that ordinarily skilled artisans “would have had at least a bachelor’s degree in physics, engineering physics, mechanical engineering, electrical engineering, or a related field, and at least two years of work experience in transportation lighting.” Pet. 14 (citing Ex. 1002 ¶¶ 32–35). Patent Owner “disputes Unified’s proposed level of ordinary skill” and proposes that skilled artisans:

would have had a Master’s of Science Degree (or a similar technical Master’s Degree, or higher degree) in an academic area emphasizing electrical engineering, computer engineering, or computer science with experience or education in optics and imaging systems or, alternatively, a Bachelor’s Degree (or higher degree) in an academic area emphasizing electrical, computer engineering or computer science and having two or more years of experience in the field of optical and imaging systems.

Prelim. Resp. 16. Patent Owner, however, does not explain the significance of the differing levels of ordinary skill proposed. To the extent Patent Owner

³ German Patent DE 199 23 187 C2, issued May 3, 2001 (Ex. 1006 (certified translation); Ex. 1007 (original)).

believes the level of ordinary skill affects this proceeding, it should explain that in the instituted trial.

B. CLAIM CONSTRUCTION

The parties agree that no express claim construction is required at this stage. Pet. 14; Prelim. Resp. 16. We therefore do not construe the claims for this decision. *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’”) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

To the extent the scope of a particular claim term impacts a party’s argument during trial, the party should propose an express construction and show how the record supports it.

C. OBVIOUSNESS OVER GOTOU AND HARBERS

Gotou is titled “Head Lamp Device for Vehicle” and is directed to a vehicle headlamp with a left-right adjustable lighting region. Ex. 1003, codes (54), (57). Gotou’s device may adjust the lighting region based on a number of factors, including “direction indicating signal, steering angle signal, map information and information of the present position.” *Id.* at 2:5–7. Gotou describes a “light distributing control ECU 10” that receives information from a variety of sensors and “processes the information[] and signals to determine a requisite optical axis angle θ .” *Id.* at 3:52–63. Gotou’s system uses the optical axis angle to control a motor driver that aims the lamp unit. *Id.* at 3:24–45, 3:63–67. Gotou describes that its controller generates “a curve pre-noticing signal” from map information and adjusts

the optical axis angle “when the vehicle reaches the predetermined distance S before the curve entrance and the light distribution is deflected leftward at a proper timing before the curve.” *Id.* at 7:32–43.

Harbers is titled “Headlamp and Dynamic Lighting System for Vehicles” and is directed to a vehicle headlamp comprising multiple lighting elements (preferably LEDs) that can be switched on and off to adjust the spatial distribution of the headlamp’s light beam. Ex. 1004, codes (54), (57), 2:9–12. Harbers describes adjusting the headlamp’s spatial distribution based on vehicle velocity, steering-wheel rotation, weather conditions, or driver input. *Id.* at 3:11–4:3.

Petitioner relies on Gotou’s control ECU as the claimed processor that receives map data indicating upcoming road curvature and, before the vehicle reaches the curve, determines the desired optical axis to increase light in the direction of road curvature, and relies on Harbers’s LED headlamps as the mechanism included in the combination’s headlights for realizing the desired optical axis. Pet. 28–50. Petitioner submits that it would have been obvious to combine the teachings in that way because “the combination would have enhanced how Gotou illuminates the surroundings of a vehicle, providing Gotou’s headlights with Harbers’[s] LEDs to provide ‘more dynamic lighting possibilities.’” Pet. 21 (quoting Ex. 1004, 1:43–45; citing Ex. 1003, 3:24–35, Fig. 1; Ex. 1002 ¶ 59). Petitioner asserts that, in the combination, “Gotou’s ECU would have sent control signals . . . that . . . control each of Harbers’[s] LEDs . . . to direct how the optical axes of headlights 2 change.” *Id.* (citing Ex. 1002 ¶ 59). Petitioner asserts additionally that the combination “would have improved the efficacy of Gotou’s system, providing improved lighting by right and left headlights 2,

and in turn, improvements to the driver’s view of surroundings, furthering Gotou’s goals of ‘superior visibility.’” *Id.* at 22–23. Petitioner contends that “only routine, known circuitry and/or programming changes would have been necessary to adjust ECU 10 such that its control signals implement Harbers’[s] LED control.” *Id.* at 25 (citing Ex. 1002 ¶ 60).

1. The “control” limitation

Patent Owner argues that the Petition fails to show that the asserted combination discloses “the control limitation in claims 1–22”—“control at least a first plurality of the LED light sources to provide light based at least in part on the determined light change and prior to the motor vehicle reaching the road curvature.” Prelim. Resp. 20. Patent Owner contrasts Gotou’s motor-pivoted single-lamp unit with Harbers’s non-moveable multi-LED system, contending “the applied references are not functionally interchangeable.” *Id.* Petitioner, however, does not rely on interchanging the mechanical aspects of the two systems. Rather, the combination applies Gotou’s control system with Harbers’s LED light source. Pet. 20–28. Petitioner has adequately supported that Gotou’s control system would determine the desired optical axis, which could then be realized with Harbers’s light sources.

Additionally, because Gotou’s system anticipates direction changes and moves the optical axis “before the steering wheel is actually turned” (Ex. 1003, 6:40–44), Patent Owner contends it is not compatible with Harbers’s control strategy, which depends on the “steering wheel position during a turn.” Prelim. Resp. 22 (emphasis omitted). But Petitioner does not assert a combination including Harbers’s control strategy. Pet. 20–28. Thus, Harbers’s control strategy does not impact whether the claims read on the

asserted combination. To the extent Patent Owner argues that Harbers's different control strategy would preclude the asserted combination with Gotou's control system, we do not agree. Gotou's control system determines the optical axis required at any given time. Ex. 1003, 3:62–63, 4:45–47. Harbers describes a headlamp system in which “spatial distribution is (continuously) adjustable.” Ex. 1004, 2:34. As Patent Owner points out, in Harbers, “spatial distribution of the light beam is achieved by controlling the individual LEDs and the corresponding light beam segments; the optical axis of each LED is fixed.” Prelim. Resp. 23 (citing Ex. 1004, 2:56–60). Harbers describes that the spatial distribution may respond to a number of internal or external conditions. Ex. 1004, 2:11–22, 3:11–4:3. Stated otherwise, Harbers's headlamp can flexibly respond to create a desired spatial distribution and is not limited to one particular source for the desired distribution. Thus, Petitioner's proposed combination is consistent with Harbers's teachings, in that Gotou's controller would provide a desired spatial distribution to Harbers's headlamp.

According to Patent Owner, “use of map information to generate the single optical axis angle calculation in Gotou, without more, would be of no use as an input to the Heinz and Harbers LED systems.” Prelim. Resp. 25. In particular, Patent Owner questions “how the optical axis angle calculation in Gotou would be used to control individual LEDs in the Harbers and Heinz headlights.” *Id.* at 26. We do not agree. Because Harbers describes a system that can flexibly respond to a desired spatial light distribution, it facilitates a system in which Gotou's controller provides a desired optical axis. Thus, the present record supports Petitioner's contention that skilled artisans could

readily adapt Harbers's headlamp to respond to the desired distribution from Gotou's controller.

2. Reason to combine

Relatedly, Patent Owner argues that Petitioner makes an unsupported assertion that "Gotou's ECU would have been enhanced to provide headlight control as taught by Harbers, where the ECU's control signals ('indicating signals') would have controlled LEDs as taught by Harbers."

Prelim. Resp. 29–30 (quoting Pet. 24) (emphases omitted). In Patent Owner's view, Harbers discloses controlling its LEDs based only on "three fixed inputs: 'the velocity of the vehicle,' 'the rotational position of the steering wheel,' and manual inputs by the driver." *Id.* at 29 (quoting Ex. 1004, 3:11–17, 3:24–42, 3:54–59). We do not agree that Harbers is so limited. It discloses a system that can achieve a desired spatial distribution based on a number of possible inputs. Ex. 1004, 2:11–22, 3:11–4:3. We agree with Petitioner that skilled artisans would have understood that a different control strategy could be used to define Harbers's desired spatial distribution. *See* Pet. 24–25 ("[O]nly routine, known circuitry and/or programming changes would have been necessary to adjust ECU 10 such that its control signals implement Harbers'[s] LED control." (citing Ex. 1002 ¶ 60)).

Patent Owner challenges whether Petitioner sufficiently justifies the asserted combination. Prelim. Resp. 34–36. Petitioner asserts that using Harbers's LED array in place of Gotou's headlights "would have enhanced how Gotou illuminates the surroundings of a vehicle, providing Gotou's headlights with Harbers'[s] LEDs to provide 'more dynamic lighting possibilities.'" Pet. 21 (quoting Ex. 1004, 1:43–45, 2:6–9); *accord id.* at

22–23 (asserting the combination “would have improved the efficacy of Gotou’s system, providing improved lighting by right and left headlights 2, and in turn, improvements to the driver’s view of surroundings, furthering Gotou’s goals of ‘superior visibility’”). We conclude that Petitioner provides a logical reason that skilled artisans would have made the combination.

Patent Owner asserts that Gotou teaches away from the claimed invention because it adjusts illumination before the steering wheel is turned, while Harbers teaches illumination that depends on the steering-wheel position. Prelim. Resp. 36–37. On the present record, that argument does not show a flaw in the proposed combination. At most, Patent Owner has identified preferences expressed in the prior art, rather than disclosures that would discourage skilled artisans from making the asserted combination. Moreover, the asserted combination satisfies Gotou’s preference for adjusting illumination before the steering wheel turns. Thus, Patent Owner has not shown that the asserted combinations would have proceeded counter to the references’ disclosures.

Relatedly, Patent Owner argues that Gotou disclosed a “fully functional mechanical lighting system” and that skilled artisans would have no need to modify that system. Prelim. Resp. 40–43. We do not agree. As discussed already, Petitioner explains that the asserted combination would have improved lighting performance over Gotou’s mechanical system. Pet. 21. That is sufficient. *See Intel Corp. v. PACT XPP Schweiz AG*, 61 F.4th 1373, 1380 (Fed. Cir. 2023).

We conclude that Petitioner has provided an adequate reason that skilled artisans would have combined Gotou and Harbers as asserted.

3. Reasonable Expectation of Success

Patent Owner argues that the asserted combinations would not have been “predictable, straightforward, and routine” as Petitioner asserts. Prelim. Resp. 32–33. In this regard, Patent Owner distinguishes Gotou’s mechanical aiming system from Harbers’s fixed, multi-LED system. *Id.* We do not agree that the systems were so different that Petitioner’s proposed combination would have been infeasible. Petitioner’s asserted combination relies on aspects distinct from Gotou’s particular aiming mechanism. Instead, it relies on Gotou’s control methodology using map data to predicted changes in the desired illumination angle. Pet. 60–79. Thus, we do not agree with Patent Owner that the asserted combination required “extensive modifications.” Prelim. Resp. 33.

Adapting Gotou’s control system to use Harbers’s multi-LED headlights would have involved software to translate Gotou’s control-system output of illumination axis to Harbers’s target spatial distribution. That task appears to be well within the ordinary skill in the art. *See Keynetik, Inc. v. Samsung Elecs. Co.*, No. 2022-1127, 2023 WL 2003932, at *2 (Fed. Cir. Feb. 15, 2023) (nonprecedential) (“Normally, once the function to be performed by software has been identified, writing code to achieve that function is within the skill of the art.” (citing *Fonar Corp. v. Gen. Elec. Co.*, 107 F.3d 1543, 1549 (Fed. Cir. 1997))).

We conclude Petitioner has shown that skilled artisans would have had a reasonable expectation of success if making the asserted combination.

4. Conclusion

We have reviewed Petitioner’s contentions for claims 1, 2, 12, 13, 23, and 24 based on Gotou and Harbers, and Patent Owner’s arguments

challenging that combination, and conclude that Petitioner’s contentions and evidence support institution. *See* Pet. 14–55.

D. OBVIOUSNESS OVER HEINZ AND GOTOU OR
HEINZ, GOTOU, AND HARBERS

Petitioner asserts two grounds using Heinz as the primary reference—one combining it with Gotou and another combining it with Gotou and Harbers. Pet. 55–86.

Heinz discloses a vehicle lighting system in which a controller selectively switches lights to generate a light “adapted to the driving situation of the motor vehicle.” Ex. 1006, 2:28–38. Heinz’s controller may receive data including steering wheel angle, velocity, and turn signal activation. *Id.* at 2:53–55. It may also receive route-detection data to determine the roadway path. *Id.* at 3:2–9. Heinz discloses that “data of a vehicle navigation system may be used” “for detecting the path of the roadway.” *Id.* at 5:31–34.

Petitioner submits that, in light of Heinz’s suggestion to use navigation data, skilled artisans “would have looked to Gotou for explicit implementation details on the format of such navigational data.” Pet. 61. The result would be “Heinz’s system explicitly considering map information indicating the direction and sharpness of a road curve and information on proper vehicle position to determine where light from headlights should be directed.” *Id.* at 62 (citing Ex. 1002 ¶ 102). Petitioner argues additionally that the combined system would determine a headlight direction change prior to reaching a road curvature, as taught by Gotou. Pet. 73–79.

Patent Owner challenges the combinations using Heinz as a primary reference for much the same reasons as discussed above regarding Gotou

and Harbers. Pet. 30–32. According to Patent Owner, skilled artisans reading Heinz would not look to Gotou, because Heinz teaches that turning the headlights to accommodate a corner has a disadvantage of losing forward illumination. Prelim. Resp. 30–31 (citing Ex. 1006, 1:37–46). Petitioner, however, does not propose combinations using Gotou’s mechanical aiming. Rather, Petitioner proposes using Gotou’s navigational data to inform Heinz’s controller. Pet. 60–64; *accord id.* at 71 (“[I]n the Heinz-Gotou combination, Heinz’s system explicitly considers map information indicating the direction and sharpness of a road curve and information on proper vehicle position to determine where light from headlights should be directed as taught by Gotou.”). The other proposed modification to Heinz relates to altering the illumination before reaching a road curvature (Pet. 73–79), which similarly does not implicate Gotou’s mechanical aiming.

Patent Owner argues also that Heinz teaches away from mechanical lighting systems because of their complexity. Prelim. Resp. 38–40 (citing Ex. 1006, 2:5–10). Because the asserted combination does not include Gotou’s mechanical system, the argument is inapposite. Stated otherwise, Heinz’s preference for nonmechanical lighting adjustability is satisfied by the asserted combination. Patent Owner raises the same teaching-away argument discussed above—that Gotou teaches away from lighting changes based on steering wheel angle—because Heinz teaches determining illumination based on steering-wheel angle. *Id.* at 37–38. As discussed above, that argument is not persuasive because it at most identifies a preference in the prior art, not a disclosure that would discourage skilled artisans from making the asserted combination.

Patent Owner argues additionally that Gotou’s system addresses “forward, curve illumination” and therefore would not apply to a system seeking to improve lateral illumination. Prelim. Resp. 31–32 (emphasis omitted). But Gotou describes its field as “controlling of a lighting region of the head lamp in a horizontal direction.” Ex. 1003, 1:7–8. Thus, we do not agree with Patent Owner that Gotou would not apply to improving lateral illumination.

We have reviewed Petitioner’s contentions for claims 1, 2, 12, 13, 23, and 24 based on Heinz and Gotou, and Patent Owner’s arguments challenging that combination, and conclude that Petitioner’s contentions and evidence support institution. *See* Pet. 55–79, 84–86.

As to the ground including Heinz, Gotou, and Harbers, Petitioner relies on Harbers for the “control” limitation, arguing that Harbers’s teachings are relevant if the claims are interpreted to require each LED light source is individually or separately controlled. *Id.* at 79. Petitioner contends that Harbers teaches the claim language under such an interpretation, and that skilled artisans had reason to use Harbers’s teachings in that regard. *Id.* at 80–84. Specifically, Petitioner asserts “the combination would have enhanced the Heinz-Gotou system, providing Harber[s]’s individualized and more precise control of Heinz’s LED lighting elements to produce a desired spatial distribution of light.” Pet. 80 (citing Ex. 1002 ¶ 130).

Patent Owner does not separately address Petitioner’s contentions directed to the Heinz-Gotou-Harbers combination. We have reviewed Petitioner’s contentions for claims 1, 2, 12, 13, 23, and 24 based on Heinz, Gotou, and Harbers, and conclude that Petitioner’s contentions and evidence support institution. *See* Pet. 79–86.

E. DISCRETIONARY DENIAL UNDER § 312(a)(2)

Patent Owner argues that we should deny institution because Petitioner fails to identify all real parties in interest (“RPI”). Prelim. Resp. 43–46. In Patent Owner’s view, Mercedes-Benz USA, LLC, is a party in litigation involving the ’029 patent and is a Unified member, and therefore should have been identified. *Id.*

Patent Owner has not asserted that a statutory bar or other estoppel would apply to Mercedes-Benz in this proceeding. *See* 35 U.S.C. §§ 315(b), (e). Accordingly, we need not address whether Mercedes-Benz is an unnamed RPI. *SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11 at 18–20 (PTAB Oct. 6, 2020) (precedential). We decline to exercise discretion to deny institution based on Petitioner’s identification of real parties in interest.

F. DISCRETIONARY DENIAL UNDER § 314(a)

Patent Owner argues we should exercise our discretion to decline institution under § 314(a) because “Unified flouted ethics rules, increased inefficiencies and the possibility of inconsistent rulings, and is creating an unnecessary burden on the Board and Patent Owner.” Prelim. Resp. 47–54.

According to Patent Owner, Petitioner’s failure to name its member companies as real parties in interest prohibits the Board from accurately identifying potential conflicts. *Id.* at 48–50. While the panel appreciates Patent Owner’s concern, the panel confirms that it does not have a conflict with the asserted unnamed RPI, Mercedes-Benz USA, LLC.

Patent Owner argues that we should deny institution because there is no litigation between the parties. Prelim. Resp. 51. But there is no

requirement that a petitioner be involved in litigation in order to file an IPR petition. *See* 35 U.S.C. § 311.

Patent Owner argues that nothing will stop Petitioner's member companies, such as Mercedes-Benz, from pursuing these IPR grounds in the district-court litigation, and that we should therefore decline to institute. Prelim. Resp. 52. To the extent Patent Owner believes that estoppel should apply to a litigation party after an IPR final written decision, Patent Owner may assert the AIA's estoppel provision in the district court. *See* 35 U.S.C. § 315(e)(2). We do not agree that we should deny institution based on speculation regarding arguments that may be made in the district court.

Patent Owner submits that an IPR petition filed by Volkswagen addresses the '029 patent and raises challenges based on Gotou. Prelim. Resp. 53 (identifying IPR2022-01586). According to Patent Owner, we should deny institution because Volkswagen's petition overlaps the present Petition and will burden the Board. We do not agree. The Board has not yet considered the merits of the petition in IPR2022-01586. Assuming Patent Owner accurately represents the substantial substantive overlap, there would be little additional burden to the Board if it additionally institutes Volkswagen's petition. Further, Patent Owner has not adequately supported that the Board should deny the first petition challenging a patent when other petitions have been filed but not yet considered.

Moreover, Patent Owner has not shown a significant relationship between Petitioner and Volkswagen that would support denying institution here. Patent Owner argues that "Mercedes and VW also have a significant relationship as co-defendants in litigation." Prelim. Resp. 54 (citing *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 (PTAB

Apr. 2, 2019) (precedential)). Patent Owner does not contend that Mercedes-Benz and Volkswagen are accused of infringement based on the same products. Thus, *Valve* does not apply. We do not agree that litigation co-defendants necessarily have a significant relationship that would justify discretionary denial.

We have considered Patent Owner's arguments for discretionary denial and decline to exercise our discretion as Patent Owner seeks.

III. CONCLUSION

For the reasons discussed above, we conclude Petitioner has shown a reasonable likelihood of prevailing with respect to at least one claim. We have evaluated all of the parties' submissions and determine that the record supports institution.

Our determination at this stage of the proceeding is based on the evidentiary record currently before us. This decision to institute trial is not a final decision as to patentability of any claim for which *inter partes* review has been instituted. Our final decision will be based on the full record developed during trial.

IV. ORDER

Accordingly, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review of claims 1, 2, 10–13, 23, and 24 of the '029 patent is instituted on the grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial commencing on the entry date of this decision.

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