

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORD MOTOR COMPANY,
Petitioner,

v.

NEO WIRELESS LLC,
Patent Owner.

Case IPR2023-00763
Patent 10,447,450

**PATENT OWNER'S REQUEST FOR REHEARING
OF ORDER (EXHIBIT 3103) DENYING PATENT OWNER'S REQUEST
FOR LEAVE TO RESPOND TO REQUEST FOR DIRECTOR REVIEW**

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I. RELIEF REQUESTED

Patent Owner Neo Wireless, LLC respectfully requests rehearing of the email order (Exhibit 3103) denying Patent Owner leave to file a response to the Director Review Request (Paper 18) filed by Petitioner Ford Motor Co. (“Ford”).

The Order does not specify whether it is issued by the Director or a delegate on the Director’s behalf. The present request for rehearing is authorized in either event. *See* Revised Director Review Process (updated Sep. 18, 2023), § 5.C.ii.

II. STATEMENT OF FACTS

In court, Ford and Volkswagen Group of America, Inc. (“VW”) are accused of infringement of the patent-at-issue (“Patent”). VW filed a prior IPR petition challenging all claims of the Patent. Paper 12 (“POPR”), 4-5. That petition was instituted (IPR2022-1567), trial is mostly complete, and the scheduled February 1, 2014 final hearing was today postponed by the Board in light of VW’s entry into a settlement with Patent Owner. The trial continues as to other (joined) petitioners.

The district court Multi-District Litigation (“MDL”) panel consolidated Patent Owner’s district court pretrial proceedings against Ford and VW into a multi-district proceeding. Ex. 1013 [Transfer Order] 1; Ex. 1010 [Opinion and Order] 1. The MDL panel ordered consolidation in light of the close relationship between the proceedings involving VW and those involving Ford, including in infringing products, technology, and claim construction, validity and infringement

questions. The panel found consolidation appropriate because “[a]ll accused ... are automaker groups who are alleged to implement cellular communications technology into their vehicles” and that “by complying with [common technical] standards, each defendant allegedly infringes the asserted patents. All actions thus can be expected to share factual questions concerning such matters as the technology underlying the patents, prior art, claim construction, and/or issues of infringement involving the patents.” Ex. 1013, 1-2; *see* POPR, 10-13.

In the MDL proceeding, the district court ordered the defendants, including Ford and VW, to present their invalidity contentions jointly. Ex. 1010, 3. They did so. *See* Ex. 2019 [Invalidity-Contentions] 2 n.1. On November 16, 2022, Ford and VW co-filed joint invalidity contentions challenging the Patent as obvious based on the same combination raised in the present case: IEEE 802.16-2004 and Park. Ex. 2019 [Invalidity-Contentions] 666 (combination), 16 (identifying US Pat. App. No. 2006/0039274 (Park) against Patent), 27 (identifying various IEEE 802.16 publications against Patent), 1027 (proof of service); *see* POPR, 12-13.

Despite raising this challenge jointly with VW in court, Ford did not raise this challenge jointly with VW in the PTO. VW filed for IPR on September 27, 2022. IPR2022-01567, Paper 2. Ford did not attempt to join VW’s IPR. Instead, Ford waited over six months after VW challenged the patent in IPR, until the last possible day under the 35 U.S.C. § 315 time bar, to file a second, *dis*joint IPR

against the Patent, raising an obviousness combination that it had raised jointly with VW months earlier in their joint district court invalidity contentions. POPR, 18-19, 23.

Patent Owner's Preliminary Response to Ford's Petition set forth these facts and explained why the Board should exercise discretion under 35 U.S.C. § 314(a) to deny institution under *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 (PTAB Apr. 2, 2019), a decision by an *ex officio* panel including the then-Director and Vice-Chief APJ that was designated "precedential" on May 7, 2019. POPR, 4-28. Ford did not ask permission to file a reply to the POPR. The assigned panel denied institution under *General Plastic* and *Valve*. Paper 17.

On December 13, 2023, Ford filed a 12-page Request for Director Review raising new arguments and authority. Paper 18. On December 21, 2023, Director Review was granted and a sealed order re: Ex Parte Communication was entered. Papers 19-20.

On January 3, 2023, an unsigned email Order denied "at this time" Patent Owner's request to file a response to the Request for Review. Ex. 3103.

Patent Owner requests rehearing of the January 3 email Order.

III. DENIAL OF A RESPONSE TO THE ARGUMENTS AND AUTHORITIES IN THE REQUEST FOR DIRECTOR REVIEW CONTRAVENES THE APA AND DUE PROCESS GUARANTEES.

“While the rules and practices of the Board *generally* protect against loss of patent rights without the required notice and opportunity to respond, those rules and practices protect against such loss in a given case only when, upon a proper request, the PTO actually provides the opportunities required by the APA and due process.” *In re NuVasive, Inc.*, 841 F.3d 966, 971 (Fed. Cir. 2016) (cleaned up) (vacating IPR decision because “[d]espite requests from [the patent owner], the Board refused to permit [the patent owner] to file a surreply or even to address the matter during oral argument.”). In this case, the Director, after reviewing the contentions in Ford’s Request for Director Review, has granted Director Review. Paper 19. Patent Owner has requested permission to file a response to the contentions in the Request and to provide the full and true information necessary to decide the review. Ex. 3104. The email Order denies that request “at this time.” *Id.* This denial, like the denial in *NuVasive* above, is an abuse of discretion.

“For a formal adjudication like the inter partes review considered here, the [Administrative Procedure Act] imposes particular requirements on the PTO.” *Dell Inc. v. Acceleron, LLC*, 818 F.3d 1293, 1301 (Fed. Cir. 2016). The PTO “must ... provide ‘all interested parties opportunity for the submission and consideration of facts [and] arguments,’ [5 U.S.C. § 554 (c)], and must allow ‘a

party . . . to submit rebuttal evidence . . . as may be required for a full and true disclosure of the facts’ [5 U.S.C. § 556 (d)].” *Id.* The denial of Patent Owner’s request to file a response to Ford’s Director Review Request is contrary to the requirements of the APA and due process because Ford’s Request introduced copious new arguments and authorities into the record, and Director Review has been granted based in part on review of those contentions. Ex. 3103.

The January 3 Order cites the Revised Interim Process’s provision that “Director Review decisions are generally made ***based on the existing record . . .***” Ex. 3103 (quoting Process, § 5.a.ii.b) (emphasis added). This reasoning is not responsive to Patent Owner’s request for permission to respond. It overlooks the fact that the Request for Director Review itself, which contains new arguments and authority, is in the existing record, which is the very reason Patent Owner has requested an opportunity to respond to it. It is impossible for the ordered Director Review to be conducted based on the existing record ***excluding*** the Request for Director Review. Indeed, the grant of Director Review is already expressly based in part on review of that portion of the existing record. Ex. 3103. Conducting Director Review based on this unequal record fails to comport with the AIA or due process.

The Director’s August 20, 2023 decision on Director Review in *Vector Flow, Inc. v. HID Global Corp.*, IPR2023-00353, illustrates the importance of

permitting Patent Owner to respond to these contentions as requested. In *Vector*, the assigned Board panel denied a petitioner's request to file a response to the POPR and subsequently denied institution. Paper 11, 1. The Director vacated the panel's decision and remanded on the basis that the Board abused its discretion in denying petitioner leave to file a response to the patent owner's contentions. Paper 11, 2. The Director noted that the POPR raised arguments based on events and orders that occurred after the filing of the petition in the case, which therefore could not have been addressed in the petition. *Id.*, 7-8. The Director further noted that the Board would "benefit" from briefing by *both* parties on the issues. *Id.*, 8. Like the denied party in *Vector*, Patent Owner should be allowed to respond to new contentions in the Request for Director Review, to which Patent Owner could not have responded earlier because they were omitted from the Petition. Indeed, here, unlike the denied party in *Vector*, Ford not only did not present its new arguments and authority until after its Petition, it did not even submit a request for permission to file a reply to Patent Owner's preliminary response.

The guarantees of the APA and due process are particularly salient here, because the Request for Director Review amounts to a barely veiled request to alter, reduce or nullify the scope of the *Valve* precedent's protection of patent owners against harassment from multiple, separated attacks. The Request includes pages of new "analysis" arguing that Ford does not have any "substantial

relationship” with VW and argues that the Director should impose “co-defendant” and “same product” requirements before “any relationship” between petitioners can be a basis to deny institution under *Valve*. Paper 18, 7-10. Ford fails to point to any holding limiting *Valve* to any specific type of co-defendant or requiring the “same products,” and discounts *Valve*’s broad command that the Board must consider “**any** relationship” between petitioners when considering whether to institute a second challenge. *Valve*, 9 (emphasis added). The importance of this decision to Board precedent is still another reason the request to respond to Petitioner should be granted.

On that note, the Request also fails to address contemporary statements to the Office by members of Congress. *See* Ex. 2014 [Senators’ April 9, 2019 Letter]. These statements by members of Congress, dated between the date of the *Valve* decision and the date of its precedential designation, urged the then-Director to limit serial petitioning in situations like this one. *Id.*, 1-2 (urging that *General Plastic* is “not sufficient” and that the Office should “adopt a presumption that, when the PTAB has already issued a decision on institution with respect to a particular patent, further petitions, whether by the original petitioner or different petitioners, will not be entertained in the absence of compelling circumstances.”). Briefing of these facts in response to Petitioner’s briefing in support of Director Review should be permitted for a full record informing Petitioner’s request.

The Request for Director Review also cites many past Board decisions (some cited for the first time, others discussed in more detail for the first time) that it argues contradict the denial of institution here. Patent Owner should be entitled to respond to these citations, and the Request fails to address the fact that none of them involved prior joint cooperation and delay associated with a same-patent challenge to the same extent as the facts here, where these months of delay, stretching until after the February 8, 2023 POPR in the VW IPR, maximized Ford's road-mapping opportunities and the burden on Patent Owner and the PTO. Paper 18-4-5. (citing *Illumina, Inc. v. Ravgen, Inc.*, IPR2021-01271, Paper 12 at 16-17 (Jan. 26, 2022); *Facebook, Inc. v. Express Mobile Inc.*, IPR2021-01455, Paper 11 (Mar. 4, 2022); *Twitter, Inc. v. Palo Alto Rsch. Ctr., Inc.*, IPR2021-01458, Paper 11 at 31-33 (Apr. 6, 2022); *Google LLC, v. Neonode Smartphone LLC*, IPR2021-01041, Paper 19, 10 (Jan. 13, 2022), and *Shenzhen Silver Star Intelligent Tech. Co., Ltd. v. iRobot Corp.*, IPR2018-00761, Paper 15, 9–10 (Sept. 5, 2018)). Denying Patent Owner's request to respond to these citations will leave the record on these issues improperly one-sided. *See* 5 U.S.C. § 556 (d).

In the end, Ford's Request for Director Review argues that VW and Ford's *joint* raising in district court of the same obviousness combination as in this case, and deliberate months of delay between their IPR challenges, should be immunized from being found relevant to institution under *Valve* even though they are plainly

relevant to the exercise of discretion under *Valve*'s reasoning, simply because they happened to arise in the context of MDL proceedings. Patent Owner is entitled to respond to Petitioner's arguments that only MDL status—not the intentional delay of serial challenges to the same patent—should be deemed relevant to whether institution should be granted, and Petitioner's premise that the reasons favoring consolidation of factually-related cases in district court should not have similar relevance in IPR.

IV. CONCLUSION.

The Order should be reconsidered, and Patent Owner's request to file a response to the Request for Director Review should be granted.

Respectfully submitted,

 / Parham Hendifar /

Parham Hendifar, Reg. No. 71,470
LOWENSTEIN & WEATHERWAX LLP

Date: January 17, 2024

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following documents were served by electronic service, by consent between the parties (Pet. at 64), on the date signed below:

PATENT OWNER'S REQUEST FOR REHEARING OF ORDER (EXHIBIT 3103) DENYING PATENT OWNER'S REQUEST FOR LEAVE TO RESPOND TO REQUEST FOR DIRECTOR REVIEW

The names and addresses of the parties being served are as follows:

John S. LeRoy
Christopher Smith
Kyle G. Konz

FPGP0138IPR@brookskushman.com

Respectfully submitted,

/ Parham Hendifar /

Date: January 17, 2024