

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORD MOTOR COMPANY,
Petitioner,

v.

NEO WIRELESS, LLC,
Patent Owner.

IPR2023-00765
Patent 10,833,908 B2

Before HYUN J. JUNG, MATTHEW S. MEYERS, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314
Denying Motion for Joinder
35 U.S.C. § 315

I. INTRODUCTION

A. *Background and Summary*

Ford Motor Company (“Petitioner” or “Ford”) filed a Petition (Paper 1, “Petition” or “Pet.”) requesting institution of an *inter partes* review of claims 1–30 of U.S. Patent No. 10,833,908 B2 (Ex. 1001, “the ’908 patent”). Concurrently, Petitioner filed a Conditional Motion for Joinder seeking to be joined as a party to *Volkswagen Group of America, Inc. v. Neo Wireless, LLC*, IPR2023-00086 (“Volkswagen IPR”). Paper 3 (“Motion” or “Mot.”). Neo Wireless LLC (“Patent Owner”) filed a Preliminary Response (Paper 14, “Preliminary Response” or “Prelim. Resp.”) and a Response to Petitioner’s Motion for Joinder (Paper 7, “Opp.”). Petitioner subsequently filed a Reply in Support of its Motion for Joinder. Paper 10 (“Mot. Reply”).

In the Motion, Petitioner states that its “Petition is substantively identical to the Volkswagen Petition—in fact, it is a verbatim copy of Volkswagen’s Petition, with the exception of administrative portions (e.g., mandatory notices, petitioner and counsel identity, etc.) and the discussion of *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 11, 2020).” Mot. 2. We denied institution on the merits in the Volkswagen IPR. *See* Volkswagen IPR, Paper 7, 35.

In its Preliminary Response, Patent Owner states that “[t]his Petition is a copycat petition seeking joinder to a case (IPR2023-00086) in which institution has already been denied.” Prelim. Resp. 1. And because this is a copycat petition, Patent Owner notes that arguments in its

Preliminary Response essentially repeat the non-institution arguments already successfully raised in the denied target case (IPR2023-00086), just as the present Petition essentially repeated the arguments in the target case’s petition. Since the

same merits arguments are at issue in this case as in the target case, institution should be denied in this case for the same reasons as in that case.

Id. In the Response to Petitioner’s Motion for Joinder, Patent Owner contends that “joinder should only be granted with additional conditions limiting Ford’s participation as joined understudy petitioner.” Opp. 1.

For the reasons discussed below, we deny institution of *inter partes* review and deny the Motion for Joinder.

II. ANALYSIS

The denial of institution on the merits in the Volkswagen IPR proceeding dictates that institution also be denied in this proceeding. Because we did not institute review in the proceeding that Petitioner seeks to join as a party, we also deny the Motion for Joinder.

Joinder for purposes of an *inter partes* review is governed by 35 U.S.C. § 315(c), which states:

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

“To join a party to an instituted [*inter partes* review (IPR)], the plain language of § 315(c) requires two different decisions.” *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). “First, the statute requires that the Director (or the Board acting through a delegation of authority) . . . determine whether the joinder applicant’s petition for IPR ‘warrants’ institution under § 314.” *Id.* “Second, to effect

joinder, § 315(c) requires the Director to exercise his discretion to decide whether to ‘join as a party’ the joinder applicant.” *Id.*

A. Whether the Petition Warrants Institution

Petitioner states that its “Petition is substantively identical to the Volkswagen Petition—in fact, it is a verbatim copy of Volkswagen’s Petition, with the exception of administrative portions (e.g., mandatory notices, petitioner and counsel identity, etc.) and the discussion of *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 11, 2020).” Mot. 2.

Petitioner states that its “Petition does not include any new grounds of unpatentability” and “its accompanying expert declaration are substantively identical to the Volkswagen IPR and its accompanying expert declaration.” *Id.* at 7; *see also id.* at 7 n.2 (“Dr. Cooklev’s declaration is a verbatim copy of Volkswagen’s declaration from Dr. Cimini with the exception of the expert’s qualifications and personal information.”).

Patent Owner notes that the “Petition is a copycat petition seeking joinder to a case (IPR2023-00086) in which institution has already been denied” and that “for the panel’s convenience that the non-institution arguments in this Preliminary Response essentially repeat the non-institution arguments already successfully raised in the denied target case.” Prelim. Resp. 1; *see also id.* (stating that the Petition “of the sort that has been called a ‘copycat’ petition, for it is nearly identical to the Petition filed in IPR2023-00086”). Patent Owner explains that “[b]ecause the grounds in this petition are the same as they are in Volkswagen’s petition in IPR2023-00086 from which Petitioner copied, this Petition’s grounds fail to support institution for the same reasons that the same grounds in IPR2023-00086 fail to do so.” *Id.* at 2.

After consideration of the arguments and evidence in the Volkswagen IPR, we determined that the information presented in Volkswagen’s Petition did not establish a reasonable likelihood that the Petitioner (“Volkswagen”) would prevail with respect to its unpatentability challenges. Volkswagen IPR, Paper 7, 35.¹ We incorporate our previous analysis regarding the asserted grounds of unpatentability and conclude that Petitioner has not demonstrated a reasonable likelihood of prevailing with respect to at least one claim of the ’908 patent challenged in the Petition for the same reasons. *See id.* at 7–35. Because the arguments and evidence in this proceeding are substantively identical to the arguments and evidence in the Volkswagen IPR, we deny institution in this proceeding for the reasons set forth in the Decision Denying Institution in the Volkswagen IPR. *See id.*

B. Whether to Join Petitioner as a Party to the Volkswagen IPR

The Director may grant a motion for joinder and allow the movant to “join as a party” an existing proceeding only “[i]f the Director institutes an inter partes review” in the proceeding to which joinder as a party is sought. 35 U.S.C. § 315(c). Petitioner implicitly recognized this prerequisite to granting its Motion for Joinder when it stated “[i]f the Volkswagen IPR is

¹ Following our Decision Denying Institution, Volkswagen filed a Petitioner’s Request for Rehearing (Paper 8), and concurrently requested Precedential Opinion Panel (“POP”) review (Ex. 3100). *See also* Paper 9 (Notice of Receipt of POP review). On July 24, 2023, Volkswagen’s request for POP review was dismissed. *See* Paper 10, 1 (“In light of recent updates to the POP review process, the request for POP review is dismissed.”). However, the order “grant[ed] [Volkswagen] leave to request to have its rehearing request (Paper 8) treated as a Request for Rehearing by the Director within 14 days of this Order.” *Id.* On August 8, 2023, Volkswagen made a Request for Rehearing by the Director. *See* Ex. 3100. On August 23, 2023, an order denying Volkswagen’s request was issued. *See* Paper 12, 2 (“[T]he request for Director Review is denied.”).

not pending when the Board reaches Ford's Motion and Petition, this Motion is moot and Ford asks the Board to consider the Petition on its merits."

Mot. 1. Because we did not institute review in the Volkswagen IPR, we deny the Motion for Joinder.

III. CONCLUSION

For the reasons stated above, we do not institute *inter partes* review on any claims or any challenge to the claims of the '908 patent and we deny the Motion for Joinder.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is denied and we do not institute *inter partes* review of any challenged claim of U.S. Patent No. 10,833,908 B2; and

FURTHER ORDERED that the Petitioner's Motion for Joinder is *denied*.

IPR2023-00765
Patent 10,833,908 B2

For PETITIONER:

John S. LeRoy
Christopher Smith
Kyle G. Konz
BROOKS KUSHMAN P.C.
jleroy@brookskushman.com
csmith@brookskushman.com
kkonz@brookskushman.com
FPGP0140IPR@brookskushman.com

For PATENT OWNER:

Kenneth J. Weatherwax
Parham Hendifar
LOWENSTEIN & WEATHERWAX LLP
weatherwax@lowensteinweatherwax.com
hendifar@lowensteinweatherwax.com
NeoWireless_IPRs@lowensteinweatherwax.com

Hamad M. Hamad
CALDWELL, CASSADY, & CURRY P.C.
hhamad@caldwellcc.com