

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN HONDA MOTOR CO., INC.,
Petitioner,

v.

NEO WIRELESS LLC,
Patent Owner.

IPR2023-00797
Patent 10,771,302 B2

Before HYUN J. JUNG, JO-ANNE M. KOKOSKI, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

BELISLE, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
Denying Petitioner's Request
to Reply to Patent Owner's Preliminary Response
37 C.F.R. §§ 42.5, 42.20

In a September 18, 2023, email to the Board (Ex. 3001), American Honda Motor Co., Inc. (“Petitioner”) requested authorization to file (i) a reply to the Preliminary Response of Neo Wireless LLC (“Patent Owner”) (Paper 7), and (ii) additional evidence, including a supplemental declaration from its technical expert, Dr. Buehrer, in the above proceeding. Ex. 3001. Patent Owner opposes the request and, in its own September 18, 2023, email to the Board (Ex. 3002), submitted that “Petitioner’s email [i.e., Ex. 3001] improperly includes arguments,” and provided its “respon[se]” to those arguments. Ex. 3002. Then, in a September 19, 2023, email to the Board (Ex. 3003), Petitioner argued that its prior email (Ex. 3001) does not include arguments. Ex. 3003.

Petitioner seeks to address arguments in the Preliminary Response that allegedly *mischaracterize* Petition arguments and cited evidence. Ex. 3001 (“Petitioner’s Reply would address [Preliminary Response] arguments that could not have reasonably been foreseen, at least insofar as the [Preliminary Response] characterizes petition arguments and record evidence in a manner inconsistent with the petition and evidence.”). In particular, Petitioner seeks to reply to the following alleged “issues” in the Preliminary Response:

- (1) “Patent Owner’s arguments under § 314(a) attempt to extend the holding of *Valve*^[1] to a circumstance in which prior art is different from that applied in an earlier IPR petition”;
- (2) “Patent Owner’s arguments under § 325(d) are based on a 300-page technical standard document that was never discussed during original examination”; and

¹ *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 (PTAB Apr. 2, 2019) (precedential) (“*Valve*”).

(3) “Patent Owner’s arguments that the reference Koo is not prior art mischaracterize the ’586 provisional to which the ’302 patent claims priority and also mischaracterize a 2006 book authored by Petitioner’s technical expert Dr. Buehrer.”

Id. (citing Prelim. Resp. §§ II, III.B). Petitioner submits that good cause for additional briefing on these alleged issues exists, “at least because briefing would clarify the record and aid the Board in deliberations on issues that are potentially dispositive to institution.” *Id.*

Patent Owner submits that “alleged mischaracterizations of the record do not support good cause for additional briefing.” Ex. 3002 (citing *Dell Inc. v. Neo Wireless LLC*, IPR2021-01468, Paper 10, 3 (PTAB Jan. 27, 2022) (“The Board routinely determines whether a party mischaracterizes the asserted references or the other party’s arguments without the need for additional briefing.”)). Patent Owner also submits that “the notion that Petitioner ‘could not have reasonably’ foreseen [Patent Owner’s] arguments is readily refuted,” and responds as follows to the three alleged “issues” noted above:

(1) “Patent Owner’s raising of *Valve* ([Preliminary Response], § II) was foreseen and addressed in the Petition, which devoted an entire section to it”;

(2) “Patent Owner’s sole citation to § 325(d) and any related analysis ([Preliminary Response], 18) was foreseen and addressed in the Petition, which devoted an entire section to § 325(d)”;

(3) “Patent Owner’s argument that Koo is not prior art ([Preliminary Response], § III.B) was foreseen and addressed in the Petition, which devoted more than three pages and a claim chart to it. In fact, Petitioner’s second ground relies on Kitroser instead of Koo with the effect of addressing the possibility that Koo is not prior art.”

Ex. 3002 (citing Pet. 2–6, 58, 67–68 (§§ IV.B, IV.C); Prelim. Resp. 19).

Based on our preliminary review of the Petition and Preliminary Response concerning the alleged “issues” noted above, and upon consideration of the parties’ positions discussed herein, we agree with Patent Owner and find Petitioner has not established good cause for further briefing on any of these “issues” at this time. *See* 37 C.F.R. § 42.108(c) (A petitioner may seek leave to file a reply to a preliminary response, but is required to “make a showing of good cause.”); *Xactware Sols., Inc. v. Pictometry Int’l Corp.*, IPR2016-00593, Paper 11 at 3 (PTAB July 1, 2016) (“[I]dentifying and evaluating statements or misstatements of the facts and law are well within the purview of the [panels of judges] assigned to these proceedings.”).

Petitioner itself addresses each of §§ 314(a) and 325(d) and the prior art status of Koo in the Petition (*see, e.g.*, Pet. 2–5, 66–68), and did so with 1,432 additional words available if it had desired to further address those issues (*see* Pet. 71; Prelim. Resp. 2 (“[I]nexplicably, and despite having used fewer than 13,000 of the 14,000 words permitted for its Petition, Petitioner elected not to present any analysis of *General Plastic*’s^[2] factors or any otherwise serious analysis.”)). In doing so, Petitioner by choice does not specifically address many, if any, of the various known factors underlying our use of discretion to deny a petition under §§ 314(a) and 325(d), and instead submits that such factors are “not at play here” or that invoking such discretion simply is “not appropriate” (Pet. 67). Where, for example,

² *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, 16–17 (PTAB Sept. 6, 2017) (§ II.B.4.i precedential).

Petitioner argues discretionary denial under § 325(d) is “not appropriate” allegedly because “the same or substantially the same art or arguments were not previously presented to the Office” (Pet. 67–68), we find it at least reasonably foreseeable that Patent Owner would challenge that allegation given that the Petition’s lead reference, 802.16a-2003 (Ex. 1004), is cited *on the face* of the challenged patent (Ex. 1001 at code (56) (p. 2)). Also, where Petitioner summarily deems § 314(a) “not at play here” because “*Petitioner* has not previously petitioned for [*inter partes* review] of the [challenged] patent” (Pet. 67 (emphasis added)), we again find it at least reasonably foreseeable that Patent Owner would challenge that basis in view of *Valve* (even cited by Petitioner), which states: “[O]ur application of the *General Plastic* factors is not limited solely to instances when multiple petitions are filed by the same petitioner. Rather, when different petitioners challenge the same patent, we consider any relationship between those petitioners when weighing the *General Plastic* factors” (*Valve* at 9).

Accordingly, we deny Petitioner’s request for authorization to file a reply to Patent Owner’s Preliminary Response.

The panel will determine whether to institute trial based on the Petition, the Preliminary Response, and the evidence in the record.

A conference call is not necessary at this time.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s request for authorization to file a reply to Patent Owner’s Preliminary Response is *denied*.

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