

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLKSWAGEN GROUP OF AMERICA, INC.,

Petitioner,

v.

LONGHORN AUTOMOTIVE GROUP LLC,

Patent Owner.

Patent No. 8,085,192

Filing Date: April 5, 2010

Issue Date: December 27, 2011

Inventor: Leigh M. Rothschild

Title: DEVICE, SYSTEM AND METHOD FOR CONTROLLING
AND STORING SENSITIVE INFORMATION ON A GPS DEVICE

**PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION**

Case No. IPR2025-00925

TABLE OF CONTENTS

	<u>Page(s)</u>
I. INTRODUCTION	1
II. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE DIRECTOR UNDER 35 U.S.C. § 314(a)	2
A. The Parallel District Court Litigation and the Petition Involve the Same Parties	4
B. The District Court Litigation Involves Substantially the Same Claims.....	4
C. Proximity of the District Court’s Trial Date	5
D. Significant Investment and Petitioner’s Delay in Filing the Petition.....	8
E. No Stay of the Parallel District Court Litigation	8
F. Other Factors Favor Discretionary Denial	9
G. Settled Expectations of the Parties	9
III. CONCLUSION.....	10

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020)	2, 7
<i>Cisco Sys., Inc. v. Estech Sys., Inc.</i> , IPR2021-00329, Paper 13 (P.T.A.B. Jul. 6, 2021)	6
<i>Cisco Sys., Inc. v. Oyster Optics, LLC</i> , IPR2021-00238, Paper 10 (P.T.A.B. Jun. 1, 2021)	7
<i>Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.</i> , IPR2020-00122, Paper 15 (P.T.A.B. May 15, 2020)	5, 6
<i>Dabico Airport Sols. Inc. v. AXA Powers Aps</i> , IPR2025-00408, Paper 21 (P.T.A.B. June 18, 2025)	10
<i>Edward LifeSciences Corp. v. Evalve, Inc.</i> , IPR2019-01479, Paper 7 (P.T.A.B. Feb. 26, 2020)	6
<i>F5 Networks, Inc. v. WSOU Invs., LLC</i> , IPR2022-00239, Paper 12 (P.T.A.B. May 19, 2022)	6
<i>Force Mos Tech., Co. v. ASUSTek Comput., Inc.</i> , No. 2:22-cv-00460-JRG, 2024 WL 1586266 (E.D. Tex. Apr. 11, 2024)	8
<i>Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha</i> , IPR2016-01357, Paper 19 (P.T.A.B. Sept. 6, 2017)	4
<i>Google LLC v. EcoFactor, Inc.</i> , IPR2021-00488, Paper 12 (P.T.A.B. Aug. 11, 2021)	6
<i>Longhorn Automotive Group LLC v. Volkswagen AG</i> , Case No. 2:24-cv-00933-JRG (E.D. Tex.)	<i>passim</i>

<i>Next Caller Inc. v. TRUSTID, Inc.</i> , IPR2019-00961, -00962, Paper 10, at 8-16 (P.T.A.B. Oct. 16, 2019)	6
<i>NHK Spring Co. v. Intri-Plex Techs., Inc.</i> , IPR2018-00752, Paper 8 (P.T.A.B. Sept. 12, 2018).....	4
<i>Nissan Motor Co., Ltd. v. Longhorn Automotive Group LLC</i> , IPR2025-01089, Paper 5 (P.T.A.B. June 25, 2025)	9
<i>Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC</i> , IPR2019-01218, Paper 7 (P.T.A.B. Jan. 7, 2020)	6
<i>Samsung Elecs. Co. v. Truesight Commc'ns LLC</i> , IPR2025-00123, Paper 12 at 6-7 (P.T.A.B. Apr. 22, 2025)	7
<i>Supercell Oy v. Gree, Inc.</i> , IPR2020-00513, Paper 11 (P.T.A.B. June 24, 2020)	6
Statutes	
35 U.S.C. § 314(a)	1, 3, 10
35 U.S.C. § 314(b)(1).....	5
35 U.S.C. § 316(a)(11).....	5
Other Authorities	
37 C.F.R. § 42.75	7
89 Fed. Reg. 79744 (Oct. 1, 2024).....	7

LIST OF EXHIBITS

Exhibit No.	Description of Document
2001	Fourth Amended Docket Control Order, Dkt. 58, <i>Longhorn Automotive Group LLC. v. Volkswagen AG</i> , Case No. 2:24-cv-00933-JRG (E.D. Tex. May 15, 2025)
2002	Longhorn Automotive Group LLC's Infringement Contentions and P.R. 3-1 and 3-2 Disclosures in <i>Longhorn Automotive Group LLC. v. Volkswagen AG</i> , Case No. 2:24-cv-00933-JRG (E.D. Tex.), dated April 4, 2025

I. INTRODUCTION

Pursuant to the Director’s March 26, 2025, Memorandum Regarding Interim Processes for PTAB Workload Management, Longhorn Automotive Group LLC (“Patent Owner”) files this Request for Discretionary Denial of Institution.

On April 24, 2025, Volkswagen Group of America, Inc. (“Petitioner”) submitted a Petition (Paper No. 1, “Petition” or “Pet.”) requesting *inter partes* review (“IPR”) of U.S. Patent No. 8,085,192 (Ex. 1001, the “’192 Patent”), challenging Claims 1-22 (the “Challenged Claims”). The Petition identifies co-pending district court litigation *Longhorn Automotive Group LLC. v. Volkswagen AG*, Case No. 2:24-cv-00933-JRG (E.D. Tex.) (the “District Court Litigation”), with a trial date set for August 17, 2026. Pet. 89; Ex. 2001. With Patent Owner’s Preliminary Response due August 25, 2025, institution of any grounds will result in the issuance of a Final Written Decision (“FWD”) by November 25, 2026.

The Director should exercise discretion to deny the Petition under 35 U.S.C. § 314(a) for at least the following reasons: (i) the parallel District Court Litigation exists between the same parties or real-parties-in-interest; (ii) the District Court Litigation involves the same subject patent, the ’192 Patent, with the same claims; (iii) the District Court’s trial will be more than *three months* before as the projected statutory deadline for FWD and more than *four months* before the deadline for

Director Review; (iv) the parties will have heavily invested in the District Court Litigation and exchanged proposed claim construction terms before the November 25, 2025 institution deadline; and (v) settled expectations have been created because the '192 Patent was issued over thirteen years ago.

For the reasons set forth herein, the Director should exercise discretion to deny the Petition.

II. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE DIRECTOR UNDER 35 U.S.C. § 314(a)

The circumstances of the parallel District Court Litigation, *Longhorn Automotive Group LLC. v. Volkswagen AG*, Case No. 2:24-cv-00933-JRG (E.D. Tex.), necessitate denial of the Petition under the Board's precedent, as every factor considered in relation to efficiency, fairness, and the merits supports denial. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (P.T.A.B. Mar. 20, 2020) (precedential) (considering (a) "whether the petitioner and the defendant in the parallel proceeding are the same party"; (b) "overlap between issues raised in the petition and in the parallel proceeding"; (c) "proximity of the court's trial date to the Board's projected statutory deadline for a final written decision"; (d) "investment in the parallel proceeding by the court and the parties"; (e) "whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted"; and

(f) “other circumstances that impact the Board’s exercise of discretion, including the merits.”).

As set forth below, these factors collectively demonstrate that efficiency and integrity of the AIA are best served by denying review. First, the issues in the parallel District Court litigation are identical to this proceeding. *See infra* Section II.A. Second, the District Court Litigation involves the same claims at issue in the Petition. *See infra* Section II.B. Third, trial in the District Court Litigation is set for August 17, 2026, more than **three months** before the projected statutory deadline for a Final Written Decision of this Petition on November 25, 2026. *See infra* Section II.C. Fourth, the parties (and Patent Owner in particular) have invested significant resources in developing legal and factual issues of validity and infringement in the District Court Litigation and will have invested substantially more resources before any decision on this Petition. *See infra* Section II.D. Fifth, there is no stay in the parallel District Court Litigation, and a stay will likely not be entered before an institution decision here. *See infra* Section II.E. Sixth, other factors weigh in favor of denial. *See infra* Section II.F. Finally, there are settled expectations regarding the ’192 Patent, as it was granted over **thirteen years ago**. *See infra* Section II.G.

Accordingly, the Director should exercise discretion under § 314(a) and deny the Petition because institution of this proceeding would not be consistent with the

objective of the AIA to “provide an effective and efficient alternative to district court litigation.” *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018) (quoting *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16–17 (P.T.A.B. Sept. 6, 2017) (precedential)).

A. The Parallel District Court Litigation and the Petition Involve the Same Parties

As Petitioner notes, there exists a parallel District Court Litigation between real parties-in-interest in this proceeding – *i.e.*, Volkswagen AG and Audi AG – regarding the same subject patent (the ’192 Patent) and involving the real parties’ Accused Products, which includes a variety of Volkswagen-branded and Audi-branded vehicles. Pet. at 89; Ex. 2002 at 3-4.

Accordingly, this factor weighs strongly in favor of discretionary denial.

B. The District Court Litigation Involves Substantially the Same Claims

There is complete overlap between the claims at issue in this Petition and the District Court Litigation because the Petition challenges all claims asserted in the District Court Litigation, including Claims 7, 8, and 10, not asserted in the District Court Litigation. *See* Ex. 2002 at 3; Pet. at 1. “In at least these ways, the parallel proceedings would duplicate effort. This is an inefficient use of Board, party, and

judicial resources and raises the possibility of conflicting decisions.” *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 at 10 (P.T.A.B. May 15, 2020).

Accordingly, this factor weighs strongly in favor of discretionary denial.

C. Proximity of the District Court’s Trial Date

The proximity of the District Court Litigation’s trial date to the Board’s projected statutory deadline for a Final Written Decision weighs strongly in favor of discretionary denial.

The parties’ trial is scheduled for August 17, 2026. Ex. 2001. Pursuant to 35 U.S.C. §§ 314(b)(1) and 316(a)(11), the projected statutory deadline for a Final Written Decision of this Petition is November 25, 2026.¹ As the District Court’s trial will be over *three months* before the projected statutory deadline, this factor weighs

¹ Patent Owner will file a timely preliminary response on August 25, 2025. The statutory deadline for institution is Monday, November 25, 2025, “three months after receiving a preliminary response to the petition under section 313.” *See* 35 U.S.C. § 314(b)(1). If instituted, the statutory deadline for a Final Written Decision is Tuesday, November 25, 2026, “not later than 1 year after the date on which the Director notices the institution of a review.”

in favor of denying institution. *See Supercell Oy v. Gree, Inc.*, IPR2020-00513, Paper 11 at 10-12 (P.T.A.B. June 24, 2020) (denying institution where the jury trial was scheduled to conclude approximately ten months before the statutory deadline); *Edward LifeSciences Corp. v. Evalve, Inc.*, IPR2019-01479, Paper 7, at 6-13 (P.T.A.B. Feb. 26, 2020) (denying institution where jury trial would conclude more than nine months before a final decision would be due); *Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC*, IPR2019-01218, Paper 7, at 7-10 (P.T.A.B. Jan. 7, 2020) (denying institution where jury selection was scheduled for approximately six months before trial in the Board proceeding would conclude); *Next Caller Inc. v. TRUSTID, Inc.*, IPR2019-00961, -00962, Paper 10, at 8-16 (P.T.A.B. Oct. 16, 2019) (denying institution where trial was scheduled to conclude “several months,” before a final decision would be due); *Cisco Sys., Inc.*, IPR2020-00122, Paper 15 at 8 (“Because the trial date is substantially earlier than the projected statutory deadline for the Board’s final decision, this factor weighs in favor of discretionary denial.”); *Cisco Sys., Inc. v. Estech Sys., Inc.*, IPR2021-00329, Paper 13 at 7-15 (P.T.A.B. Jul. 6, 2021) (denied when two related trials predate FWD by eleven months and seven months, respectively); *F5 Networks, Inc. v. WSOU Invs., LLC*, IPR2022-00239, Paper 12 at 7-8 (P.T.A.B. May 19, 2022) (denied when trial predates FWD by six months); *Google LLC v. EcoFactor, Inc.*, IPR2021-00488, Paper 12 at 11-12

(P.T.A.B. Aug. 11, 2021) (denied when trial predates FWD by six months); *Cisco Sys., Inc. v. Oyster Optics, LLC*, IPR2021-00238, Paper 10 at 11-13 (P.T.A.B. Jun. 1, 2021) (denied when trial predates FWD by seven months); *Samsung Elecs. Co. v. Truesight Commc'ns LLC*, IPR2025-00123, Paper 12 at 6-7 (P.T.A.B. Apr. 22, 2025) (denied when trial predates FWD by six months). The significant difference between the August 17, 2026, trial date and the November 25, 2026, FWD justifies discretionary denial on its own.

The justification is compounded when considering the deadline for a request for Director Review, which is within 30 days of the entry of the FWD (*i.e.*, December 26, 2026), let alone the ultimate decision of any Director Review. Notably, it was only on Oct. 1, 2024, that the U.S. Patent and Trademark Office (USPTO) issued a final rule governing Director Review of PTAB decisions in contested proceedings brought under the AIA, Rules Governing Director Review of Patent Trial and Appeal Board Decisions, effective Oct. 31, 2024, as 37 C.F.R. § 42.75. 89 Fed. Reg. 79744 (Oct. 1, 2024). As such, the Board's *Apple Inc. v. Fintiv, Inc.* decision was unable to consider the extended period of time for the PTAB Director to opine on a FWD. In this proceeding, such a determination from Director Review would likely be over ***four months*** past the August 17, 2026, trial date.

Accordingly, because the trial date is well before the project statutory deadline

of a FWD and any determination from a Director Review of a FWD, this factor weighs strongly in favor of discretionary denial.

D. Significant Investment and Petitioner's Delay in Filing the Petition

The parties' and the Court's investment in the parallel proceeding weighs strongly in favor of discretionary denial. In the District Court Litigation, Patent Owner has already served infringement contentions, and claim construction proceedings will begin on October 23, 2025, a month before the institution deadline. Ex. 2001. Therefore, on the November 25, 2025, statutory deadline for an institution decision, the parties will have completed infringement contentions, served invalidity contentions, and conducted months of discovery. *See* Ex. 2001.

Accordingly, the parties' and Court's substantial investment in this proceeding weighs in favor of denial of institution.

E. No Stay of the Parallel District Court Litigation

There is no stay of the parallel District Court Litigation. Even if a defendant in the District Court Litigation moves to stay the case, the Eastern District of Texas routinely denies requests to stay pending IPRs before institution on all asserted claims of all Asserted Patents. *See Force Mos Tech., Co. v. ASUSTek Comput., Inc.*, No. 2:22-cv-00460-JRG, 2024 WL 1586266, at *4 (E.D. Tex. Apr. 11, 2024) (citation omitted). A stay in the District Court Litigation is unlikely before the

institution decision in this matter because the most recently filed petition for *inter partes* review against a patent asserted in the District Court Litigation will not have an institution decision entered until December 26, 2025. *See Nissan Motor Co., Ltd. v. Longhorn Automotive Group LLC*, IPR2025-01089, Paper 5 (P.T.A.B. June 25, 2025) (according the petition the filing date).

Accordingly, the lack of a stay and future unlikelihood of a stay weighs strongly in favor of denial of institution.

F. Other Factors Favor Discretionary Denial

The Petition should be denied for the additional reason that the Petition is weak. Not including the discussion of discretionary denial, the Petition is 86 pages long. *See generally* Pet. In contrast, Petition is effectively a copy-and-paste of the expert declaration, which is also nearly 50 pages longer than the substantive portion of the Petition. *Compare* Pet. *with* Ex. 1002. Petitioner, therefore, relies almost entirely on the expert declaration, evidencing its weakness.

G. Settled Expectations of the Parties

The '192 Patent was granted December 27, 2011, over *thirteen years* before Petitioner filed this Petition, and claims priority to an application filed on September 6, 2005, which is *nineteen years* before Petitioner filed its Petition. *See* Ex. 1001. Furthermore, the '192 Patent will expire on October 7, 2025, over a month before

the institution decision is expected. As such, Patent Owner has settled expectations at this point. The Board has previously discretionarily denied institution because “the challenged patent has been in force almost eight years, creating settled expectations.” *Dabico Airport Sols. Inc. v. AXA Powers Aps*, IPR2025-00408, Paper 21 at 2 (P.T.A.B. June 18, 2025). The Board also noted that “the longer the patent has been in force, the more settled expectations should be” and equated this approach to the six-year damages period related to filing infringement lawsuits. *Id.* at 3. The situation is even more applicable here, where the patent is *five years older* than the patent at issue in *Dabico*.

When viewing the factors together, and particularly in view of District Court Litigation’s trial date and Patent Owner’s settled expectations, the Petition should be denied in the Director’s discretion under 35 U.S.C. § 314(a).

III. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Director exercise discretion to deny institution of the Petition in its entirety.

Respectfully submitted,

July 23, 2025

By: /Vincent J. Rubino, III /
Vincent J. Rubino, III (Reg. No. 68,594)
Lead Counsel for Patent Owner
FABRICANT LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580
Tel. 212-257-5797
Fax. 212-257-5796
vrubino@fabricantllp.com
ptab@fabricantllp.com

CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION has 2,073 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word for Office 365.

Respectfully submitted,

July 23, 2025

By: /Vincent J. Rubino, III /
Vincent J. Rubino, III (Reg. No. 68,594)
Lead Counsel for Patent Owner
FABRICANT LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580
Tel. 212-257-5797
Fax. 212-257-5796
vrubino@fabricantllp.com
ptab@fabricantllp.com

CERTIFICATE OF SERVICE

A copy of the foregoing PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION and Exhibits 2001 through 2002 have been served on Petitioner's counsel of record as follows:

Elliot C. Cook
Email: elliott.cook@finnegan.com
Email: Finnegan-Longhorn-192IPR@finnegan.com
Alexander Boyer
Email: alexander.boyer@finnegan.com
Daniel Jordan
Email: daniel.jordan@finnegan.com
Luke MacDonald
Email: luke.macdonald@finnegan.com
**FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP**
1875 Explorer Street, Suite 800
Reston, VA 20190-6023

Attorneys for Volkswagen Group of America, Inc.

July 23, 2025

By: /Vincent J. Rubino, III /
Vincent J. Rubino, III (Reg. No. 68,594)
Lead Counsel for Patent Owner
FABRICANT LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580
Tel. 212-257-5797
Fax. 212-257-5796
vrubino@fabricantllp.com
ptab@fabricantllp.com