UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NISSAN MOTOR CO., LTD.,

Petitioner,

v.

LONGHORN AUTOMOTIVE GROUP LLC,

Patent Owner.

Patent No. 7,513,238
Filing Date: October 15, 2004
Issue Date: April 7, 2009

Inventors: Ruediger Pfaff, Martin Schnabel, and Joachim Suess
Title: DIRECTLY INJECTING INTERNAL COMBUSTION ENGINE

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION

Case No. IPR2025-01089

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Exhibit No.	Description of Document
2001	Second Amended Docket Control Order, Dkt. 69, *Longhorn Auto. Grp. LLC v. Hyundai Motor Corp.*, Case No. 2:24-cv-00554 (E.D. Tex. July 9, 2025)
2002	Fourth Amended Docket Control Order, Dkt. 58, *Longhorn Auto. Grp. LLC. v. Volkswagen AG*, Case No. 2:24-cv-00933 (E.D. Tex. May 15, 2025)
2003	Longhorn Automotive Group LLC's Infringement Contentions and P.R. 3-1 and 3-2 Disclosures in *Longhorn Auto. Grp. LLC v. Hyundai Motor Corp.*, Case No. 2:24-cv-00554 (E.D. Tex.), dated July 25, 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 June 3, 2025, Nissan Motor Co, Ltd. ("Petitioner") submitted a Petition (Paper No. 2, "Petition" or "Pet.") requesting *inter partes* review ("IPR") of U.S. Patent No. 7,513,238 (Ex. 1001, the "'238 Patent"), challenging Claims 1-14 (the "Challenged Claims"). The Petition identifies several co-pending district court litigations: *Longhorn Auto. Grp. LLC v. Volkswagen AG*, Case No. 2:24-cv-00933-JRG (E.D. Tex.) (the "*Volkswagen* Case"); *Longhorn Auto. Grp. LLC v. Mazda Motor Corp.*, Case No. 2:24-cv-00686 (E.D. Tex.); *Longhorn Auto. Grp. LLC v. Mitsubishi Motors Corp.*, Case No. 2:24-cv-00685 (E.D. Tex); *Longhorn Auto. Grp. LLC v. Volvo Car Corp.*, Case No. 2:24-cv-00603 (E.D. Tex.); *Longhorn Auto. Grp. LLC v. Hyundai Motor Co.*, Case No. 2:24-cv-00554 (E.D. Tex.) (the "*Kia* Case"); and *Longhorn Auto. Grp. LLC v. Nissan Motor Co.*, Case No. 2:24-cv-00397 (E.D.

Tex.) (collectively, the "District Court Litigations").[1] The earliest filed of these matters where the '238 Patent is asserted is the *Kia* Case, which has a trial date set for June 1, 2026. Ex. 2001. Furthermore, the trial date in the *Volkswagen* Case is set for August 17, 2026 (*see* Ex. 2002). With Patent Owner's Preliminary Response due September 25, 2025, institution of any grounds will result in the issuance of a Final Written Decision ("FWD") by December 28, 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 Litigations exist between the same parties or real-parties-in-interest; (ii) the District Court Litigations involve the same subject patent, the '238 Patent, with the same claims; (iii) the District Court's first trial will be more than ***six months*** before the projected statutory deadline for FWD and more than ***seven months*** before the deadline for Director Review; (iv) the parties will have heavily invested in the District Court Litigations, and a Claim Construction Hearing is scheduled in the *Kia* Case for December 3, 2025, over three (3) weeks before the institution deadline; and

[1] Several of these cases have been consolidated for the purpose of pre-trial proceeding. For example, the *Volkswagen* and *Mazda* matters have been consolidated, and the *Kia* and *Nissan* matters have been consolidated.

(v) settled expectations have been created because the ’238 Patent was issued over sixteen (16) 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 Litigations, including at least the *Kia* Case and the *Volkswagen* Case, 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 Litigations are identical to this proceeding. *See infra* Section II.A. Second, the District Court Litigations involve the same claims at issue in the Petition. *See infra* Section II.B. Third, trials in at least the *Kia* Case and the *Volkswagen* Case are set for June 1, 2026, and August 17, 2026, respectively, the earliest more than ***six months*** before the projected statutory deadline for a Final Written Decision of this Petition on December 28, 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 Litigations 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 Litigations, 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 '238 Patent, as it was granted over ***sixteen 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 Litigations and the Petition Involve the Same Parties

As Petitioner notes, there exists parallel District Court Litigations between real parties-in-interest in this proceeding – *i.e.,* Petitioner, Kia Corporation, Hyundai Motor Company, Volkswagen AG, Audi AG, Mazda Motor Corporation, Mitsubishi Motors Corporation, AB Volvo, and Volvo Car Corporation – regarding the same subject patent (the '238 Patent) and involving the real parties' Accused Products, which include a variety of vehicles from nine (9) manufacturers. *See, e.g.,* Ex. 2003 at 3-4.

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

B. The District Court Litigations Involve Substantially the Same Claims

There is complete overlap between the claims at issue in this Petition and the District Court Litigations because the Petition challenges all claims asserted in the District Court Litigations. *See, e.g.,* Ex. 2003 at 3. "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 Dates

The proximity of the trial dates in at least the *Kia* Case and the *Volkswagen* Case in relation to the Board's projected statutory deadline for a Final Written Decision weighs strongly in favor of discretionary denial.

Trial in the *Kia* Case is scheduled for June 1, 2026. Ex. 2001. Trial in the *Volkswagen* Case is scheduled for August 17, 2026. Ex. 2002. 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 December 28, 2026.[2] As the trial in the *Kia* Case will take place over ***six months*** before the projected statutory deadline, and the trial in the *Volkswagen* Case will take place over ***four months*** before the projected statutory

[2] Under 35 U.S.C. 314(b), the statutory deadline for institution is Friday, December 26, 2025. If instituted, the statutory deadline for a Final Written Decision is Monday, December 28, 2026, "not later than 1 year after the date on which the Director notices the institution of a review."

deadline, this factor weighs 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 June 1, 2026, and August 17, 2026 trial dates, and the December 28, 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.*, January 27, 2027), let alone the ultimate decision of any Director Review. Notably, it was only on October 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 ***seven months*** past the June 1, 2026, trial date and over ***five months*** past the August 17, 2026, trial date.

Accordingly, because the two trial dates are well before the projected 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 proceedings weighs strongly in favor of discretionary denial. In at least the *Kia* Case, the Patent Owner has already served two sets of amended infringement contentions. *See* Ex. 2003. Furthermore, a Claim Construction Hearing is scheduled for December 3, 2025, in the *Kia* Case, over three (3) weeks before the institution decision is due in this matter. *See* Ex. 2001. Similarly, in the *Volkswagen* Case, Patent Owner has also served infringement contentions, and claim construction proceedings will begin on October 23, 2025, more than two (2) months before the institution deadline. Ex. 2002. Therefore, on the December 26, 2025 statutory deadline for an institution decision, the parties in the *Kia* Case and the *Volkswagen* Case will have completed infringement contentions, served invalidity contentions, conducted months of discovery, and completed claim construction in one matter. *See* Exs. 2001, 2002.

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 Litigations

There is no stay of any of the parallel District Court Litigations. Even if any defendants in the District Court Litigations move 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 Litigations 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 Litigations (this matter) will not have an institution decision entered until December 26, 2025. *See Nissan Motor Co. v. Longhorn Auto. Grp. LLC*, IPR2025-01089, Paper 5 (P.T.A.B. June 25, 2025) (according to the petition filing date).

Accordingly, the lack of a stay and the 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. The substantive portion of the Petition setting forth the challenging grounds

is approximately sixty-nine (69) pages long. *See* Pet. at 15-84. This portion of the Petition is effectively a copy-and-paste of the expert declaration, which is approximately ninety-one (91) pages of substantive grounds. *Compare* Pet. *with* Ex. 1004 at 114-205. Petitioner, therefore, relies almost entirely on the expert declaration, evidencing its weakness.

G. Settled Expectations of the Parties

The ’238 Patent was granted April 7, 2009, over ***sixteen years*** before Petitioner filed this Petition, and claims priority to an application filed on October 29, 2003, which is nearly ***twenty-two years*** before Petitioner filed its Petition. *See* Ex. 1002. 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 ***eight years older*** than the patent at issue in *Dabico*.

When viewing the factors together, and particularly in view of trial dates in at least the *Kia* Case and the *Volkswagen* Case, 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,

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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 2,316 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,

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CERTIFICATE OF SERVICE

A copy of the foregoing PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION and Exhibits 2001 through 2003 have been served on Petitioner's counsel of record as follows:

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