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Paper 16
Date: March 22, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

GENERAL MOTORS LLC and NISSAN NORTH AMERICA, INC.,
Petitioner,

v.

NEO WIRELESS LLC,
Patent Owner.

IPR2023-00962
Patent 10,447,450 B2

Before KATHERINE K. VIDAL, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office*.

DECISION
Vacating the Decision on Institution and Remanding to the Patent Trial and Appeal Board Panel for Further Proceedings

General Motors LLC and Nissan North America Inc. (collectively "Petitioner") filed a Petition requesting *inter partes* review of claims 7 and 11 of U.S. Patent No. 10,447,450 B2 (Paper 4) as well as a motion seeking to join IPR2023-00763 ("the Ford IPR") as a petitioner (Paper 3). Neo Wireless LLC ("Patent Owner") opposed the motion for joinder (Paper 8) and filed a Preliminary Response, which argued, *inter alia*, that the Board should exercise discretion and deny institution because Volkswagen Group of America ("Volkswagen") filed an earlier petition in IPR2022-01567 ("the Volkswagen IPR") (Paper 10, 6–29).

On December 6, 2023, the Board exercised discretion to deny institution of this Petition as a follow-on of Volkswagen's petition. Paper 11 ("Decision"). Specifically, applying *General Plastic* and *Valve*, the Board found that a "significant relationship" exists between Petitioner and Volkswagen, and that most of the *General Plastic* factors weigh in favor of denying institution given Volkswagen's petition. *Id.* at 11–21 (citing *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 (Apr. 2, 2019) (precedential); *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 15 (PTAB Sept. 6, 2017) (precedential only as to Section II.B.4.i)). The Decision also denied Petitioner's motion to join the Ford IPR because that proceeding had not been instituted. *Id.* at 10–11 (citing *Ford Motor Co. v. Neo Wireless LLC*, IPR2023-00763, Paper 17 (PTAB Nov. 9, 2023)).

I previously granted Director Review of the Board's decision denying institution in the Ford IPR, and I also granted *sua sponte* Director Review of the Board's Decision in this proceeding (Paper 12).

Upon review, I find that Petitioner and Volkswagen do not have a "significant relationship," for purposes of the *General Plastic* analysis.

Under existing Office policy and precedent, the Board does not recognize a "significant relationship" between parties having different accused products that merely engage in court-ordered pretrial coordination. In reaching this conclusion, this decision recognizes that existing policy does not support the result reached by the Board in this case.

The Board here conducted a similar *General Plastics/Valve* analysis as in *Ford*. As I explain in *Ford*, Paper 28, 11 (Vidal), issued concurrently, "[c]ourt-ordered pretrial coordination between parties having different accused products does not present a 'significant relationship' vis-à-vis the challenged patent that justifies application of a *General Plastic* analysis, unless there are other relevant or extenuating facts or circumstances." *Id.* at 11. As in *Ford*, here Petitioner and Volkswagen are accused of infringing the challenged patent with different products in different court proceedings, and there is no evidence that they had any interactions or agreements regarding the accused wireless standard or the accused products. Paper 4, 53–54; *see also* Paper 3, 11–12 (arguing that Petitioner and Ford are co-defendants in different district court litigations, are not accused of infringement based on the sale of the same products, and did not provide any products or technology to the other). In addition, their court-ordered case-management coordination, by itself, does not create the type of "significant relationship" contemplated by *Valve*.

Accordingly, I vacate the Board's Decision and remand to the Board to issue a decision on institution that addresses the merits of the Petition.[1]

[1] Patent Owner did not otherwise argue that institution should be denied on other discretionary bases.

Based on the foregoing, it is hereby:

ORDERED that the Decision Denying Institution (Paper 11) is *vacated*; and

FURTHER ORDERED that the case is remanded to the Board for further proceedings consistent with the instructions above.

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