

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

AMERICAN HONDA MOTOR CO., INC.,
Petitioner,

v.

NEO WIRELESS LLC,
Patent Owner.

IPR2023-00797
Patent 10,771,302 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

American Honda Motor Co., Inc. (“Petitioner” or “Honda”) filed a Petition requesting *inter partes* review of claims 23, 24, 26, and 27 of U.S. Patent No. 10,771,302 B2. Paper 2. Neo Wireless LLC (“Patent Owner”) 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 IPR2022-01538 (“the Volkswagen IPR”). Paper 7, 3–23.

On November 9, 2023, the Board exercised discretion to deny institution of Honda’s Petition as a follow-on of Volkswagen’s petition. Paper 14 (“Decision”). Specifically, applying *General Plastic* and *Valve*, the Board found that a “significant relationship” exists between Honda and Volkswagen, and that most of the *General Plastic* factors weigh in favor of denying institution given Volkswagen’s petition. *Id.* at 9–21 (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)).

Petitioner requested Director Review of the Board’s Decision (Paper 16, “Request”; *see also* Ex. 3100), and I granted that Request (Paper 18). With my authorization (Paper 23), Patent Owner filed a response to Petitioner’s Request (Paper 24), and Petitioner filed a reply (Paper 25).

Upon review, I find that Honda 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 Motor Co. v. Neo Wireless LLC*, IPR2023-00763, Paper 17. 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 Honda 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. *See* Request 8–10. 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

Based on the foregoing, it is hereby:

ORDERED that the Decision Denying Institution (Paper 14) is *vacated*; and

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

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

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