

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLKSWAGEN GROUP OF AMERICA, INC.,
MERCEDES-BENZ USA, LLC, and FORD MOTOR COMPANY,¹
Petitioners,

v.

NEO WIRELESS, LLC,
Patent Owner.

IPR2022-01539
Patent 10,965,512 B2

**JOINT MOTION TO TERMINATE PROCEEDING
WITH RESPECT TO PETITIONER MERCEDES-BENZ USA, LLC
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

¹ Mercedes-Benz USA, LLC filed a motion for joinder and a petition in IPR2023-00079, and Ford Motor Company filed its own motion for joinder and petition in IPR2023-00764. Both motions were granted, and, therefore, Mercedes-Benz USA, LLC and Ford Motor Company have been joined as petitioners in this proceeding.

STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioner Mercedes-Benz USA, LLC (“Mercedes”) and Patent Owner Neo Wireless LLC (“Neo”) jointly request termination of this proceeding with respect to Mercedes as a result of a Patent License and Settlement Agreement that resolves all pending disputes between Mercedes and Neo. Mercedes and Neo note that granting this motion will not result in termination of the proceeding in its entirety, because Petitioners Volkswagen Group of America, Inc. (“VW”) and Ford Motor Company (“Ford”) are not requesting termination. The Board authorized filing of this Joint Motion via email on July 28, 2023.

Mercedes and Neo are further filing concurrently herewith a request that the Patent License and Settlement Agreement, filed herewith as Exhibit 2100, be kept confidential and separate from the file, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The Patent License and Settlement Agreement is being filed as “Available only to Board” in order to preserve confidentiality, including so that the other Petitioner (*i.e.*, VW and Ford) does not have access to the agreement.

STATEMENT OF FACTS

On July 15, 2022, Neo asserted U.S. Patent No. 10,965,512 (the “’512 Patent”) against Mercedes in an action entitled *Neo Wireless LLC v. Mercedes-Benz USA, LLC*, Case No. 3:22-cv-00780 (M.D. Fla.), which was conditionally

transferred to the Eastern District of Michigan for consolidated pretrial proceedings, as part of a multi-district litigation, in actions entitled *In re Neo Wireless LLC Patent Litig.*, Case No. 2:22-md-03034 (E.D. Mich.) and *Neo Wireless, LLC v. Mercedes-Benz USA, LLC*, Case No. 2:22-cv-11769 (E.D. Mich.). The district court cases have since been dismissed with prejudice as to Mercedes, as part of the parties' settlement. Mercedes filed its petition for *inter partes* review of the '512 Patent on October 19, 2022, along with a motion to join IPR2022-01539 filed by VW. The Board granted institution of *inter partes* review and Mercedes's motion for joinder on May 5, 2023. Similarly, Ford filed its petition for *inter partes* review of the '512 Patent on March 28, 2023, along with a motion to join IPR2022-01539 filed by VW. The Board granted institution of *inter partes* review and Ford's motion for joinder on July 17, 2023.

A Patent License and Settlement Agreement has been reached which resolves all underlying disputes between Neo and Mercedes, including those related to this proceeding and the related district court proceedings involving the '512 Patent. A true and correct copy of the Patent License and Settlement Agreement is attached as Exhibit 2100.

ARGUMENT

Pursuant to 35 U.S.C. § 317(a), “[a]n *inter partes* review shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent

owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” *See also* 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate, including where the trial is consolidated with another proceeding or pursuant to a joint request under 35 U.S.C. 317(a) or 327(a).”).

As noted above, pursuant to 35 U.S.C. § 317(a)-(b), Mercedes and Neo request termination of this proceeding with respect to Mercedes and are filing herewith a confidential Patent License and Settlement Agreement as Exhibit 2100, which resolves all disputes between Mercedes and Neo. Mercedes and Neo certify that there are no other collateral agreements or understandings between them made in connection with, or in contemplation of, termination of this proceeding. Mercedes and Neo request that the Patent License and Settlement Agreement be kept separate from the file and treated as business confidential information, and are submitting herewith a Joint Motion to Keep Confidential And Separate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74.

Termination is appropriate as to Mercedes because the Board has not yet decided the merits of this *inter partes* review. Indeed, a Final Written Decision is not due until May 2, 2024, one year from institution. (Paper 7, Institution Decision dated May 2, 2023). And, as Mercedes has assumed an understudy role, its termination will not affect the proceeding going forward.

Moreover, no other party's rights would be prejudiced by the termination of this *inter partes* review as to Mercedes. Petitioners VW and Ford remains active in this proceeding. As Mercedes agreed to take an understudy role to VW, Mercedes being terminated from this proceeding will have no effect on the remaining parties.

Accordingly, Mercedes and Neo respectfully request that the Board grant this Joint Motion to Terminate as to Mercedes.

Dated: August 2, 2023

Respectfully submitted,

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