

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN HONDA MOTOR CO., INC.,
Petitioner,

v.

NEO WIRELESS, LLC,
Patent Owner.

IPR2023-00790
Patent 8,467,366 B2

Before HYUN J. JUNG, JO-ANNE M. KOKOSKI, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review

35 U.S.C. § 314

Denying Motion for Joinder

35 U.S.C. § 315

I. INTRODUCTION

American Honda Motor Co., Inc. (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 1–24 (the “challenged claims”) of U.S. Patent No. 8,467,366 B2 (“the ’366 patent,” Ex. 1001). Paper 2 (“Pet.”). Neo Wireless, LLC (“Patent Owner”) filed a Preliminary Response. Paper 9 (“Prelim. Resp.”). Concurrently with the Petition, Petitioner filed a Motion for Joinder. Paper 3 (“Mot.”). Patent Owner filed an Opposition to Petitioner’s Motion for Joinder (Paper 7), and Petitioner filed a Reply (Paper 8).

In the Motion for Joinder, Petitioner requests that it be joined as a party to IPR2023-00426 (“the 426 proceeding”). Mot. 1, 11. Petitioner asserts that its Petition “is substantively the same as” the petition in the 426 proceeding, which sought cancellation of the same challenged claims on the same grounds asserted in this proceeding. *Id.* at 1; *compare* IPR2022-00426, Paper 2 (Petition), 6–9, *with* Pet. 6–9. In addition, Patent Owner’s Preliminary Response is substantially the same as its preliminary response in the 426 proceeding. *See* Prelim. Resp. 1 (“For the panel’s convenience, the present response repeats the same reasons and supporting evidence as Patent Owner’s response in” the 426 proceeding.). We denied institution on the merits in the 426 proceeding. IPR2023-00426, Paper 12 at 30.

For the reasons discussed below, we deny institution and deny the Motion for Joinder.

II. ANALYSIS

The denial of institution on the merits in the 426 proceeding dictates that institution also be denied in this proceeding. Because we did not institute review in the proceeding that Petitioner seeks to join as a party, we also deny the Motion for Joinder.

A. Institution of Inter Partes Review

Petitioner asserts, and Patent Owner agrees, that the Petition is substantively identical to the Petition in the 426 proceeding. In particular, Petitioner states that the Petition “challenges the same claims, on the same grounds, and relies on the same prior art” as the petition in the 426 proceeding. Mot. 1; *see also id.* at 4–5 (“There are no substantive differences between [Petitioner’s] and [the 426 proceeding’s] Petitioner’s Petition. [Petitioner] also relies on substantially the same supporting evidence in its Petition as is relied on in [the 426 proceeding].” (internal citation omitted) (footnote omitted)). Petitioner also states that the Petition “presents no new grounds of unpatentability.” *Id.* at 4; *see id.* at 6–7. Similarly, Patent Owner asserts that the Petition is “nearly identical to” the petition in the 426 proceeding, and states that its Preliminary Response “repeats the same reasons and same supporting evidence as Patent Owner’s response” in the 426 proceeding. Prelim. Resp. 1; *compare* IPR2023-00426, Paper 6 (Preliminary Response) *with* Prelim. Resp.

After consideration of the arguments in the petition and the preliminary response and the evidence of record in the 426 proceeding, we denied institution because the petition in the 426 proceeding did not sufficiently establish that the cited art disclosed all of the limitations of the challenged claims, or that an ordinarily skilled artisan would have modified the cited art as proposed. IPR2023-00426, Paper 12 at 20, 28–29. Because the arguments and evidence in this proceeding are substantively identical to the arguments and evidence in the 426 proceeding, we deny institution in this proceeding for the reasons set forth in the Decision Denying Institution in the 426 proceeding. *Id.* at 11–30.

B. Motion for Joinder

The Director may grant a motion for joinder and allow the movant to “join as a party” to an existing proceeding only “[i]f the Director institutes an inter partes review” in the proceeding to which joinder as a party is sought. 35 U.S.C. § 315(c). Because we did not institute review in the 426 proceeding, we deny Petitioner’s Motion for Joinder.

III. CONCLUSION

For the reasons stated above, we do not institute an *inter partes* review on any claims or challenge to the claims of the ’366 patent, and we deny Petitioner’s Motion for Joinder.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* and no trial is instituted; and
FURTHER ORDERED that Petitioner’s Motion for Joinder is *denied*.

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