

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORD MOTOR COMPANY, GENERAL MOTORS LLC,
NISSAN NORTH AMERICA, INC., TESLA, INC., and
AMERICAN HONDA MOTOR CO., INC.,¹
Petitioner,

v.

NEO WIRELESS, LLC,
Patent Owner.

IPR2022-01539
Patent 10,965,512 B2

Before HYUN J. JUNG, JO-ANNE M. KOKOSKI, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

JUNG, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ Ford Motor Company filed a motion for joinder and a petition in IPR2023-00764, and General Motors LLC, Nissan North America, Inc., Tesla, Inc., and American Honda Motor Co., Inc., filed their own motion for joinder and petition in IPR2023-00961. Both motions were granted, and, therefore, Ford Motor Company, General Motors LLC, Nissan North America, Inc., Tesla, Inc., and American Honda Motor Co., Inc., have been joined as petitioners in this proceeding.

I. INTRODUCTION

Volkswagen Group of America, Inc. (“VWGoA”) filed a Petition seeking institution of an *inter partes* review of claims 1–30 of U.S. Patent No. 10,965,512 B2 (Ex. 1001, “the ’512 patent”). Paper 1. After reviewing the Petition (Paper 1) and Patent Owner’s Preliminary Response (Paper 6), we instituted an *inter partes* review. Paper 7.

In IPR2023-00764, Ford Motor Company (“Ford”) filed a petition and a motion for joinder requesting that Ford be joined as a petitioner in IPR2022-01539, which was granted, and, therefore, Ford has been joined as a petitioner in this proceeding. Paper 15. In IPR2023-00961, General Motors LLC (“GM”), Nissan North America, Inc. (“Nissan”), Tesla, Inc. (“Tesla”), and American Honda Motor Co., Inc. (“Honda”) filed a petition and a motion for joinder requesting that they be joined as petitioners in IPR2022-01539, which was granted, and, therefore, they have also been joined as petitioners in this proceeding. Paper 29.

On January 9, 2024, VWGoA and Patent Owner Neo Wireless, LLC (“Neo Wireless”) filed a Joint Motion to Terminate *Inter Partes* Review with Respect to VWGoA, which was granted, and, consequently, Ford, GM, Nissan, Tesla, and Honda remained as petitioners in this proceeding. Paper 49.

On January 29, 2024, with our authorization, Ford, GM, Nissan, Tesla, Honda, and Neo Wireless (collectively, the “Parties”) filed a Joint Motion to Terminate the above-identified proceeding. Paper 50 (“Joint Motion” or “Mot.”). The Parties represent that a Joint Stipulation to Dismiss (Ex. 2101 (“Joint Stipulation” or “Joint Stip.”)) “resolves all pending disputes” between the Parties with respect to the ’512 patent. Mot. 4; *see*

also id. at 6 (stating similarly that the Parties “have entered into a Stipulation resolving all underlying disputes . . . with respect to the ’512 Patent”), 7 (stating that the “Stipulation . . . resolves all disputes . . . with respect to the ’512 Patent”). The Parties also represent that a true and correct copy of the Joint Stipulation has been filed and “certify that there are no other collateral agreements or understandings between them made in connection with, or in contemplation of, termination of this proceeding.” *Id.* at 6, 7.

II. DISCUSSION

Under 35 U.S.C. § 317(a), “[a]n *inter partes* review instituted under this chapter 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.” Any agreement or understanding “made in connection with, or in contemplation of, the termination of an *inter partes* review” must be in writing, and a true copy of any such documents must be filed in the Office before termination. *Id.* § 317(b); *accord* 37 C.F.R. § 42.74(b).

The Parties represent that they have complied with the applicable requirements. Also, as noted by the Parties, “oral hearing has not been held and a Final Written Decision is not due until May 2, 2024.” Mot. 7. We, thus, agree with the Parties that “[t]ermination is appropriate . . . because the Board has not yet decided the merits of this *inter partes* review.” *Id.*

Accordingly, we terminate this *inter partes* review with respect to all present parties. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.74. This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

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III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Parties' Joint Motion to Terminate (Paper 50) is *granted*;

FURTHER ORDERED that this proceeding is terminated as to all parties;

FURTHER ORDERED this paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a);

FURTHER ORDERED that a copy of this Order be entered into each of IPR2023-00764 and IPR2023-00961;

FURTHER ORDERED that IPR2023-00764 is terminated under 37 C.F.R. § 42.72; and

FURTHER ORDERED that IPR2023-00961 is terminated under 37 C.F.R. § 42.72.

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