

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.

IPR2023-00797
Patent 10,771,302 B2

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

BELISLE, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

American Honda Motor Co., Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 23, 24, 26, and 27 (“Challenged Claims”) of U.S. Patent No. 10,771,302 B2 (Ex. 1001, “the ’302 patent”). Petitioner identifies itself and Honda Development & Manufacturing of America, LLC as real parties in interest. Pet. 68. Neo Wireless LLC (“Patent Owner”) identifies itself as a real party in interest (Paper 4, 1), and timely filed a Preliminary Response to the Petition (Paper 7, “Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314(b) (2018); 37 C.F.R. § 42.4(a) (2022). We may not institute an *inter partes* review “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). The “reasonable likelihood” standard is “a higher standard than mere notice pleading” but “lower than the ‘preponderance’ standard to prevail in a final written decision.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 13 (PTAB Dec. 20, 2019) (precedential). We also may exercise our discretion to deny a petition for reasons independent of whether the petitioner meets that threshold. *See, e.g., Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) invests the Director with discretion on the question whether to institute review” (emphasis omitted)); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir.

2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

Applying those standards, and upon consideration of the information presented in the Petition and Preliminary Response, we determine that it is appropriate in this case to exercise our discretion to deny institution of *inter partes* review. Accordingly, based on the record before us, we deny institution of an *inter partes* review of the ’302 patent.

II. BACKGROUND

A. Related Matters

The parties indicate that the ’302 patent is (or was) involved in several pending and terminated proceedings. *See* Pet. 68–70; Paper 4, 1–3 (listing a total of twenty proceedings). Such proceedings include, *inter alia*, (1) *Neo Wireless LLC v. American Honda Motor Co., Inc.*, No. 2-22-cv-11403 (E.D. Mich.); (2) *In Re: Neo Wireless, LLC Patent Litigation*, No. 2-22-md-03034 (E.D. Mich.) (“Multidistrict Litigation”); and (3) *Volkswagen Group of America, Inc. v. Neo Wireless LLC*, IPR2022-01538, Paper 7 (PTAB May 5, 2023), in which the Board denied *inter partes* review on the merits (“VW 1538 IPR” involving “Volkswagen”).

B. The ’302 Patent

The ’302 patent is titled “Channel Probing Signal for a Broadband Communication System,” and issued September 8, 2020, from U.S. Patent Application No. 15/953,950, filed April 16, 2018. Ex. 1001, codes (10), (21), (22), (45), (54). The ’302 patent claims priority through a series of continuation applications to U.S. Provisional Patent Application

Nos. 60/540,586, filed January 30, 2004, and 60/540,032, filed January 29, 2004.¹ *Id.* at 1:6–24, codes (60), (63).

The '302 patent explains that “[a] direct Sequence Spread Spectrum (DSSS) system is inherently capable of supporting multi-cell and multi-user access applications through the use of orthogonal spreading codes,” but “a DSSS system using orthogonal spreading codes, may suffer severely from the loss of orthogonality in a broadband environment due to multi-path propagation effects, which results in low spectral efficiency.” Ex. 1001, 1:28–31, 1:34–38. The '302 patent also explains that a Multi-Carrier (“MC”) “system such as an Orthogonal Frequency Division Multiplexing (OFDM) system is capable of supporting broadband applications with higher spectral efficiency” and “mitigates the adverse effects of multi-path propagation in wireless environments by using cyclic prefixes to extend the signal period as the data is multiplexed on orthogonal sub-carriers.” *Id.* at 1:41–47. The '302 patent states, however, that “MC systems are vulnerable while operating in multi-user and multi-cell environments.” *Id.* at 1:52–54.

In view of the above, the '302 patent describes “[a] broadband wireless communication system where both the Multi-Carrier (MC) and direct Sequence Spread Spectrum (DSSS) signals are intentionally overlaid together in both time and frequency domains.” Ex. 1001, 2:39–42. The '302 patent explains that “[t]he MC signal is used to carry broadband data

¹ The parties dispute the effective filing date(s) of the Challenged Claims. Pet. 2–5; Prelim. Resp. 25–32. Because we exercise our discretion to deny institution of *inter partes* review regardless of the '302 patent's effective filing date, we need not and do not herein address this dispute.

signal for its high spectral efficiency, while the DSSS signal is used for special purpose processing, such as initial random access, channel probing, and short messaging.” *Id.* at 2:44–48.

The ’302 patent describes an embodiment in which “a DSSS signal and a MC signal [are] fully overlaid or partially overlaid with an MC symbol or slot boundary in the time domain.” Ex. 1001, 7:27–29. Figure 13 of the ’302 patent is reproduced below.

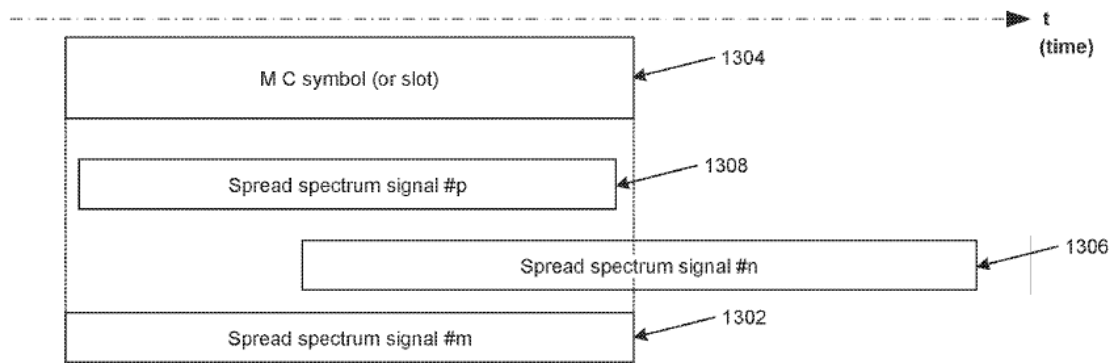


FIG. 13

Figure 13 shows DSSS signal 1302 that fully overlaps with MC symbol 1304 in the time domain, and DSSS signal 1306 that overlaps with MC symbol 1304 only partially. *Id.* at 7:29–35. The ’302 patent further describes an embodiment in which guard periods are added to DSSS signal 1308 to “ensure that a well-designed DSSS sequence (with low [Peak to Average ratio (“PAR”)] in frequency domain) causes little interference with the MC subcarriers even when there is time misalignment in a DSSS signal relative to the OFDM symbol period.” *Id.* at 7:56–60.

The ’302 patent also describes using spectrum nulls in a DSSS signal to protect an MC control subchannel. Ex. 1001, 7:64–65. Figure 15 of the ’302 patent is reproduced below.

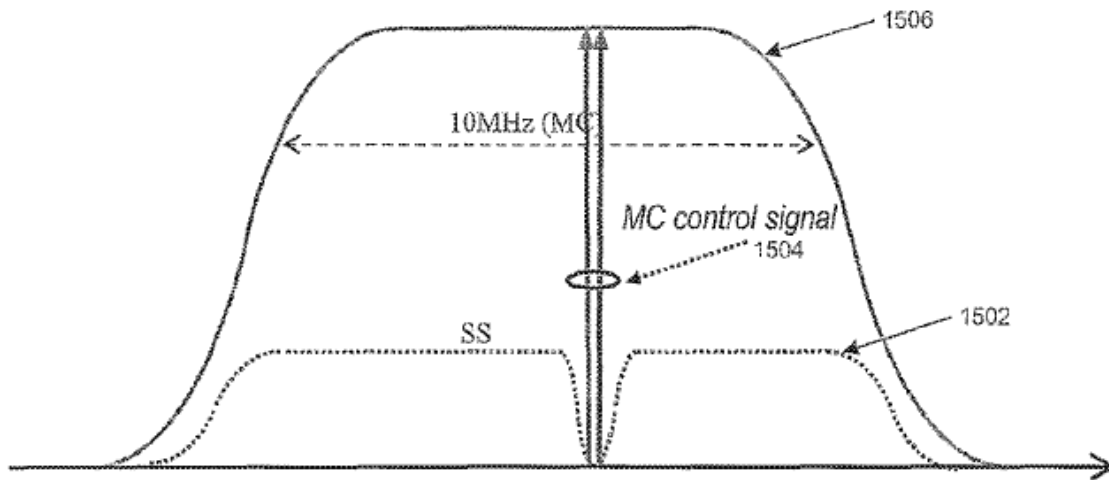


FIG. 15

Figure 15 depicts an available spectrum 1506 and DSSS signal 1502 that has a spectrum null to avoid excess interference with uplink MC control signal 1504. *Id.* at 7:65–8:2. The '302 patent explains that “interference with the MC sub-carriers over the rest of the spectrum will be much lower where the MC subchannels, carrying control information or using higher modulation subcarriers (such as 16 QAM), are placed.” *Id.* at 8:7–11.

The '302 patent also describes an embodiment in which “the DSSS signal is used to assist estimation of channel characteristics.” Ex. 1001, 8:66–67. Specifically, “the base station dictates the mobile station to transmit the channel probing DSSS when it needs an update of the mobile station’s channel characteristics.” *Id.* at 9:39–41. The '302 patent further describes an embodiment in which “the base station polls the mobile station during its silent period and gets an update of the mobile station’s information such as transmission timing and power from the probing DSSS signal.” *Id.* at 9:41–45. The '302 patent explains that the channel profile

information can be “used by the base station to determine the proper modulation/coding and pilot pattern.” *Id.* at 9:45–48.

C. Illustrative Claim

The ’302 patent includes thirty-six claims, of which claims 23, 24, 26, and 27 are challenged. Independent claim 23, reproduced below, is illustrative of the claimed subject matter.

23. A mobile device in an Orthogonal Frequency Division Multiplexing (OFDM) communication system, the mobile device comprising:

a receiver configured to receive a request for a probing signal from a base station in the system;

a transmitter configured to form and transmit, in response to the received request, the probing signal with a code sequence modulated in the frequency domain, wherein:

the probing signal is configured to overlap, in the time domain, with uplink signals transmitted over an uplink frequency band by other mobile devices in the system; and

the probing signal is configured to occupy a portion of spectrum in the uplink frequency band not designated for transmission of uplink control signals in the system.

Ex. 1001, 12:28–42.

D. Evidence of Record

Petitioner relies on the following published patent application evidence.

Name	Patent Document	Exhibit
Koo	US 2004/0174845 A1, published September 9, 2004	1006

Petitioner also relies on the following non-patent literature evidence.

Name	Non-Patent Literature Title	Author	Exhibit
802.16a-2003 ²	IEEE Std 802.16a-2003 Amendment; Part 16: Air Interface for Fixed Broadband Wireless Access Systems Amendment 2: Medium Access Control Modifications and Additional Physical Layer Specifications for 2-11 GHz	The Institute of Electrical and Electronics Engineers, Inc. ("IEEE")	1004
802.16-2001	IEEE Std 802.16-2001; Part 16: Air Interface for Fixed Broadband Wireless Access Systems	IEEE	1005
Kitroser	IEEE 802.16e Mobility System Perspective (Re: Call for contributions IEEE 80216e-02/01 in Project: IEEE 802.16 Broadband Wireless Access Working Group)	Itzik Kitroser et al. (IEEE)	1007

Pet. 2, 5–7.

Petitioner also relies upon the Declaration of Dr. R. Michael Buehrer (Ex. 1003) and the Declaration of June Ann Munford (Ex. 1012).

Patent Owner relies upon the Declaration of William P. Alberth Jr. (Ex. 2001).

² Petitioner collectively refers to 802.16a-2003 and 802.16-2001 as "802.16a." Pet. 2, 11–12.

E. Asserted Challenges to Patentability

Petitioner challenges the patentability of claims 23, 24, 26, and 27 of the '302 patent on the following bases (Pet. 2).

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
23, 24, 26, 27	103 ³	802.16a-2003, 802.16-2001, Koo
23, 24, 26, 27	103	802.16a-2003, 802.16-2001, Kitroser

III. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314(a)

A. General Plastic Factors and Valve

The Board recognizes several factors that may merit denial of institution under § 314(a) when a party files a “follow-on” petition challenging the same patent as a previous petition. *See General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 15–16 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i) (“*General Plastic*”). A “non-exhaustive list” of such factors includes:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary

³ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103 effective on March 16, 2013. Neither party argues that the outcome of this case would differ based on applying the pre-AIA or post-AIA versions of these laws.

- response to the first petition or received the Board’s decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
 5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
 6. the finite resources of the Board; and
 7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

General Plastic, Paper 19 at 16. The *General Plastic* factors “are not dispositive, but part of a balanced assessment of all relevant circumstances in the case, including the merits.” Consolidated Trial Practice Guide 58 (Nov. 2019) (“CTPG”), <https://go.usa.gov/xpvPF> (citing *General Plastic*, Paper 19 at 15).

Since *General Plastic*, the Board has held that “our application of the *General Plastic* factors is not limited solely to instances when multiple petitions are filed by the same petitioner.” *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, -00063, -00084, Paper 11 at 9 (PTAB Apr. 2, 2019) (precedential) (denying institution where a party filed follow-on petitions for *inter partes* review after the denial of an *inter partes* review request of the same claims filed by the party’s co-defendant) (“*Valve*”). Rather, when different petitioners challenge the same patent, the Board considers the relationship, if any, between those petitioners when weighing the *General Plastic* factors. *Id.*

Petitioner summarily argues “[s]erial petitioning concerns addressed in *General Plastic* . . . and *Valve* . . . are not at play here.” Pet. 67

(emphasis added). Patent Owner argues “the *General Plastic* factors uniformly and strongly support denial of institution.” Prelim. Resp. 6; *see id.* at 3–23. We agree with Patent Owner, and address below each of these factors as they apply to the circumstances of this case.⁴

1. *Factor One*

Under the first *General Plastic* factor, we consider “whether the same petitioner previously filed a petition directed to the same claims of the same patent.” *General Plastic*, Paper 19 at 16. Patent Owner argues:

Petitioner is a district court co-defendant with former petitioner Volkswagen, who filed the first petition against the same Patent [i.e., the '302 patent], *and whose petition was denied on the merits*. Specifically, both Petitioner Honda and former petitioner Volkswagen are co-defendants in a formally consolidated, subject-matter-sharing multi-district litigation pending in the Eastern District of Michigan Furthermore, their cases have been consolidated in light of the close linkages between the cases’ subject matter, including because both defendants are accused of infringement by implementing the LTE and/or 4G/5G standards In other words, the two petitioners’ accused products have substantially the same subject matter for purposes of the *General Plastic* and *Valve* precedential decisions.

Further still, Defendants have been ordered to jointly present their invalidity contentions in the district court, and have

⁴ After receiving Patent Owner’s Preliminary Response in this case, Petitioner requested authorization to file a reply thereto along with additional evidence, including a supplemental declaration from its technical expert. *See* Paper 13. Petitioner sought to address arguments in the Preliminary Response that allegedly *mischaracterized* Petition arguments and cited evidence concerning discretionary denial, among other issues. *See id.* at 2–3. We determined that Petitioner had not established good cause for such further briefing or submission of additional evidence, and denied Petitioner’s request. *See id.* at 4–5.

done so, which makes it even more questionable as to why they should not do the same before the PTAB.

Prelim. Resp. 7–8 (emphasis added). Petitioner argues it “has not previously petitioned for IPR of the ’302 patent.” Pet. 67. Although Petitioner is correct that it has not *itself* previously filed such a petition, this does not end our inquiry.

The Petition in this case and the previous petition in the VW 1538 IPR both challenge claims 23, 24, 26, and 27 of the ’302 patent (indeed, the VW 1538 IPR challenged *all* claims of the ’302 patent). *See, e.g.*, Pet. 1; IPR2022-01538, Paper 2, 1; Prelim. Resp. 9–10. Although Petitioner did not file the petition in the VW 1538 IPR, as discussed above, our application of the *General Plastic* factors is not limited solely to instances where multiple petitions are filed by the same petitioner. Rather, “where different petitioners challenge the same patent, we consider *any relationship between those petitioners* when weighing the *General Plastic* factors.” *See Valve*, Paper 11 at 9 (emphasis added).

Here, Petitioner and Volkswagen, both automaker groups, are co-defendants in the Multidistrict Litigation and are accused of infringing the ’302 patent based on similar products that allegedly comply with “LTE or 4G/5G technical standards” on which the ’302 patent allegedly reads, including vehicle products such as “remote lock and unlock, remote start and remote start scheduling, parked vehicle location, remote fuel level checks, automatic collision notification, roadside assistance, and Wi-Fi hotspot.” Ex. 2015, 1–2 (“All actions thus can be expected to share factual questions concerning such matters as the technology underlying the patents, prior art, claim construction, and/or issues of infringement involving the patents.”).

Further, in the Multidistrict Litigation, Petitioner and Volkswagen were ordered to jointly present their invalidity contentions, and have done so. *See* Ex. 2016, 3 (“[T]he Court **ORDERS** Defendants to limit their total asserted prior art references and/or products to an average of eight (8) per patent, for a total of not more than forty-eight (48) references and/or products.”).

Indeed, as noted by Patent Owner, “Petitioner and Volkswagen *are* jointly presenting their invalidity contentions in the district court, including specifically the same IEEE 802.16a-2003 reference that forms the primary basis of the Petition.” Prelim. Resp. 8–9 (citing Ex. 2013 (Defendants’ Preliminary Invalidity and Unenforceability Contentions), 29, 2 n. 1 (identifying both Petitioner and Volkswagen as defendants that jointly submitted the invalidity and unenforceability contentions), 1027).

We determine that the first *General Plastic* factor weighs against institution. As discussed above, the Petition in this case challenges the same claims of the ’302 patent as the previous petition in the VW 1538 IPR. As also discussed above, Petitioner and Volkswagen are co-defendants in the Multidistrict Litigation, are accused of infringing the ’302 patent based on products that allegedly comply with the same technical standards on which the ’302 patent allegedly reads, and were ordered to jointly submit invalidity and unenforceability contentions (and have done so), which requires cooperation concerning the identification and application of asserted prior art. Thus, a significant relationship exists between Petitioner and Volkswagen with respect to Patent Owner’s assertion of the ’302 patent. The complete overlap in the challenged claims and the significant relationship between Petitioner and Volkswagen favor denying institution.

2. *Factor Two*

Under the second *General Plastic* factor, we consider “whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it.” *General Plastic*, Paper 19 at 16. This factor includes considering whether the prior art relied on in the later petition “could have been found with reasonable diligence.” *Id.* at 20; *see Valve*, Paper 11 at 11 (“Although Valve may not have known of the Maeda and Anderson references at the time HTC filed its petition in the 1031 IPR, the timing of Valve’s petitions suggests that it could have found the Maeda and Anderson references through the exercise of reasonable diligence around the time of HTC’s petition.”).

Patent Owner argues “[b]oth of Petitioner’s grounds rely on IEEE 802.16a-2003 for all limitations except ‘mobile device,’” and “IEEE 802.16a-2003 is cited on the face of the ’302 Patent as a reference considered by the Examiner.” Prelim. Resp. 10–11 (emphasis added); *see* Exs. 1004, 1005. Given these facts, Patent Owner argues “Petitioner either was or should have been aware of it at the time of the VW Petition—and in fact much earlier.” *Id.* at 11. Patent Owner argues, “[n]ot surprisingly, given that [IEEE 802.16a-2003] is one of the select references listed on the front of the Patent itself, Petitioner and Volkswagen were well aware of 802.11a-2003, and they jointly cited IEEE 802.16a-2003 in their [1,027-page] invalidity contentions served on November 16, 2022, around the same time as the filing of the Volkswagen Petition [i.e., September 15, 2022].” *Id.* (citing Ex. 2013, 29, 1027). Similarly, Patent Owner argues “Petitioner and Volkswagen jointly cited the Koo reference [Ex. 1006], the secondary reference in Petitioner’s first ground, in their invalidity

contentions served on November 16, 2022, around the same time as Petitioner Volkswagen’s petition.” *Id.* at 12 (citing Ex. 2013, 12). Petitioner does not identify in the Petition when it first knew of any of the prior art asserted in its Petition. *See* Pet. 67; *see generally* Pet. 1–70.

We determine that the second *General Plastic* factor weighs against institution. At the time Volkswagen filed its petition in the VW 1538 IPR, Petitioner either knew or should have known of IEEE 802.16a-2003 (more specifically, “802.16a” as defined above⁵), which Petitioner argues “discloses all features of the Challenged Claims except for a device that is ‘mobile’” (Pet. 11), because IEEE 802.16a-2003 is conspicuously listed on the face of the ’302 patent and was jointly cited by Petitioner and Volkswagen in the Multidistrict Litigation around the time of Volkswagen’s

⁵ Petitioner’s two grounds of unpatentability rely, in part, on IEEE 802.16a-2003 and IEEE 802.16-2001, which Petitioner collectively refers to as “802.16a” in the Petition. Pet. 2, 11–12. Petitioner justifies relying on both of those references as one disclosure as follows:

802.16a is an IEEE communications standard that specifies an “air interface for fixed broadband wireless access systems.” The standard is defined in two documents – 802.16a-2003 . . . and 802.16-2001 . . . [,] which will hereinafter collectively be referred to as “802.16a.” The 802.16a-2003 document “amends IEEE Std 802.16-2001 by enhancing the medium access control layer and providing additional physical layer specifications in support of broadband wireless access at frequencies from 2-11 GHz.” The resulting standard is referred to herein simply as “802.16a.”

Pet. 11–12 (citations omitted). Thus, for purposes of this *General Plastics* analysis, we consider having knowledge of IEEE 802.16a-2003 to likewise include having knowledge of IEEE 802.16-2001. *See* Ex. 1004, 1 (stating on its face “Amendment to IEEE Std 802.16TM-2001”).

petition. Petitioner also either knew or should have known of the Koo reference (the only other reference relied on in Petitioner's first ground of unpatentability) at or around the time Volkswagen filed its petition, because it too was jointly cited by Petitioner and Volkswagen in the Multidistrict Litigation around the time of Volkswagen's petition. Although Petitioner may not have known of the Kitroser reference (Ex. 1007) at the time Volkswagen filed its petition, Petitioner applies Kitroser for the same limited purpose as Koo (allegedly to show the applicability of 802.16a processes to a "mobile" environment (Pet. 58)). Further, Kitroser relates to IEEE 802.16,⁶ explicitly states that it presents notes on the "impact of the mobile environment on the current 802.16a" (Ex. 1007, 1), and according to Petitioner's declarant, "was first available to the public by the Internet Archive as of July 2, 2003 if not earlier by the IEEE" (Ex. 1012 ¶ 22), all of which suggests that Petitioner could have found Kitroser through the exercise of reasonable diligence around the time Volkswagen filed its petition. This availability to Petitioner of all of its asserted art at or around the time Volkswagen filed its petition favors denying institution.

3. *Factor Three*

Under the third *General Plastic* factor, we consider "whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's

⁶ Petitioner describes Kitroser as "an IEEE *standard contribution document* that was submitted to the IEEE 802.16 Broadband Wireless Access Working Group on January 10, 2003." Pet. 6 (emphasis added).

decision on whether to institute review in the first petition.” *General Plastic*, Paper 19 at 16. The Board has previously explained:

[F]actor 3 is directed to Petitioner’s potential benefit from receiving and having the opportunity to study Patent Owner’s Preliminary Response, as well as our institution decisions on the first-filed petitions, prior to its filing of follow-on petitions. . . . Multiple, staggered petitions challenging the same patent and same claims raise the potential for abuse. The absence of any restrictions on follow-on petitions would allow petitioners the opportunity to strategically stage their prior art and arguments in multiple petitions, using our decisions as a roadmap, until a ground is found that results in the grant of review. All other factors aside, this is unfair to patent owners and is an inefficient use of the *inter partes* review process and other post-grant review processes.

Id. at 17–18 (internal citation and footnote omitted).

Patent Owner argues “[t]his black-and-white factor also strongly weighs against institution:”

At the time [Petitioner] filed its Petition on March 30, 2023, [Petitioner] had received Patent Owner’s Preliminary Response to the *Volkswagen Petition*. Specifically, in the Volkswagen IPR, the Petition was filed on September 15, 2022, and the Patent Owner Preliminary Response was filed on February 8, 2023. Both dates are substantially prior to the filing date of the Petition in this matter, on March 30, 2023. In fact, the evidence suggests that Petitioner deliberately waited until the **very last day** of its statutory bar grace period to file its Petition on March 30, 2023, thereby ensuring that [Petitioner] had received Patent Owner’s Preliminary Response, and maximizing its road-mapping opportunity, before filing its serial Petition. *See Ex. 2009 [Honda-POS]* (service of complaint on Petitioner on March 30, 2022).

Prelim. Resp. 13. Petitioner argues it “[has not] used the Volkswagen IPR as a ‘roadmap’ to craft invalidity positions,” but “[r]ather, Petitioner’s

review and consideration of the record in [the] Volkswagen IPR is no different than review of the '302 patent's file history—routine diligence to understand the patent's history before the Office.” Pet. 67. As an initial observation, we interpret Petitioner's latter statement here as at least a tacit admission that Petitioner did indeed review Patent Owner's Preliminary Response in the VW 1538 IPR and at least accounted for it in preparing its Petition in this case.

Patent Owner responds, because the Board denied the VW 1538 IPR *on the merits*, this Factor Three (and Factors One and Two) would still weigh against institution even without a showing of “road-mapping.” See Prelim. Resp. 19–23; VW 1538 IPR, Paper 7 (denying *inter partes* review of the '302 patent on the merits). We agree. See *Code200, UAB v. Bright Data Ltd.*, IPR2022-00861, Paper 18 at 4–5 (Aug. 23, 2022) (precedential) (“*Where the first-filed petition under factor 1 was discretionarily denied or otherwise was not evaluated on the merits*, factors 1–3 only weigh in favor of discretionary denial when there are ‘road-mapping’ concerns under factor 3 or other concerns under factor 2.” (emphasis added)).

Patent Owner also responds that “even Petitioner's underlying allegation that it did not roadmap based on the Volkswagen IPR is at best suspect,” not only because “Petitioner deliberately waited until the very last day of its one year statutory bar to file its Petition,” and did so *after* receiving Patent Owner's Preliminary Response in the VW 1538 IPR, but because “the record suggests that Petitioner did in fact utilize Patent Owner's Preliminary Response in the Volkswagen IPR to draft its Petition.” Prelim. Resp. 22–23. In particular, Patent Owner argues:

[T]he Patent Owner Preliminary Response [in the VW 1538 IPR] argued that the Volkswagen Petition failed to show the limitation “receiving a request for a probing signal from a base station in the system.” IPR2022-01538, Paper 7, 1, 25, 31–32. [Petitioner], in the instant Petition, has devoted ~**1000 words and three figures across eight pages** just to address the limitation “a request.” Pet., 29–36. That is by far more words and pages than the Petition has devoted to other, substantially longer, limitations. It is highly unlikely, to the point of not credible, that it was by sheer coincidence that Petitioner decided to devote a highly disproportionate length of its Petition to discussing the limitation that Patent Owner argued was missing from the Volkswagen Petition, and that the Board ultimately credited in denying that Petition.

Id. at 23. We find Patent Owner’s arguments persuasive.

Based on the foregoing, we determine that the third *General Plastic* factor weighs against institution.

4. *Factors Four and Five*

Under the fourth and fifth *General Plastic* factors, we consider “the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition” and “whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent.” *General Plastic*, Paper 19 at 16.

As discussed above under Factor Two, at or around the time Volkswagen filed its petition in the VW 1538 IPR (i.e., September 15, 2022), (1) Petitioner either knew or should have known of IEEE 802.16a-2003 (more specifically, “802.16a” as defined above) and the Koo reference, and (2) Petitioner could have found the Kitroser reference through the exercise of reasonable diligence. *See supra* Section III.A.2; Prelim.

Resp. 14. Despite this, as argued by Patent Owner, “Petitioner did not file its Petition anytime around the filing of the Volkswagen Petition in September 2022, or around the time it served its invalidity [contentions] identifying IEEE 802.16a-2003 and Koo on November 16, 2022,” but instead, Petitioner “waited all the way until *the last day of its statutory bar on March 30, 2023* to maximize its road-mapping opportunities, and maximizing Patent Owner’s cost and harassment as well.” Prelim. Resp. 14 (citing Ex. 2009). Further, as argued by Patent Owner, “Petitioner does not even attempt to provide an explanation for that time gap—adequate or otherwise.” *Id.* at 15; *see* Pet. 67.

We determine that the fourth and fifth *General Plastic* factors weigh against institution. The fact that Petitioner waited over six months after Volkswagen filed its petition in the VW 1538 IPR to file the Petition in this case favors denying institution, where Petitioner knew of, should have known of, or with reasonable diligence could have found the art asserted in the Petition at or around the time Volkswagen filed its petition. Also, the fact that Petitioner provides no explanation in the Petition for this time gap favors denying institution.

5. *Factors Six and Seven*

Under the sixth and seventh *General Plastic* factors, we consider “the finite resources of the Board” and “the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.” *General Plastic*, Paper 19 at 16. “The sixth and seventh factors are efficiency considerations.” *Valve*, Paper 11 at 15; *see also* CTPG 56 (noting that the Director’s discretion under § 314(a) is informed by 35 U.S.C. § 316(b),

which requires “the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter”).

We determine that the sixth and seventh *General Plastic* factors weigh against institution. In general, having multiple petitions challenging the same patent, especially when not filed at or around the same time as in this case, is inefficient and tends to waste resources. Here, Petitioner waited to file the Petition in this case for over six months after Volkswagen filed its petition in the VW 1538 IPR, and until after Patent Owner filed its Preliminary Response in the VW 1538 IPR, even though Petitioner knew of, should have known of, or with reasonable diligence could have found the art asserted in the Petition at or around the time Volkswagen filed its petition. This serial and repetitive attack implicates the efficiency concerns underpinning *General Plastic*, and, thus, favors denying institution.

B. Summary

As discussed above, the evidence of record shows that all of the *General Plastic* factors weigh against institution. Although no single factor is dispositive, the evidence and circumstances as a whole weigh strongly in favor of denying institution in this case. As a result, we determine that it is appropriate to exercise our discretion under § 314(a) to deny institution.

IV. CONCLUSION

For the forgoing reasons, we exercise our discretion under § 314(a) to deny institution of an *inter partes* review.

IPR2023-00797
Patent 10,771,302 B2

V. ORDER

For the reasons given, it is hereby
ORDERED that the Petition is *denied*, and an *inter partes* review of
U.S. Patent No. 10,771,302 B2 is not instituted.

IPR2023-00797
Patent 10,771,302 B2

FOR PETITIONER:

Thomas A. Rozylowicz
John T. Johnson
Jeffrey C. Mok
Won S. Yoon
FISH & RICHARDSON P.C.
PTABInbound@fr.com
IPR15625-0037IP4@fr.com

FOR PATENT OWNER:

Kenneth J. Weatherwax
Parham Hendifar
LOWENSTEIN & WEATHERWAX LLP
weatherwax@lowensteinweatherwax.com
hendifar@lowensteinweatherwax.com