

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,
Petitioner,

v.

NEO WIRELESS, LLC,
Patent Owner.

IPR2022-01539¹
Patent 10,965,512 B2

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

JUNG, *Administrative Patent Judge*.

ORDER
Settlement as to Mercedes-Benz USA, LLC
35 U.S.C. § 317; 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.

I. INTRODUCTION

Volkswagen Group of America, Inc. (“Volkswagen”) 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.

Mercedes-Benz USA, LLC (“Mercedes-Benz”), filed a petition and a joinder motion in IPR2023-00079, requesting that Mercedes-Benz be joined as a petitioner in IPR2022-01539. *Mercedes-Benz USA, LLC v. Neo Wireless, LLC*, IPR2023-00079, Paper 1 (petition), Paper 3 (joinder motion). After considering the parties’ papers, we instituted trial in IPR2023-00079, granted Mercedes-Benz’s joinder motion, and joined Mercedes-Benz as a petitioner to IPR2022-01539. *Mercedes-Benz USA, LLC v. Neo Wireless, LLC*, IPR2023-00079, Paper 11 (Institution Decision). A copy of that decision is entered in IPR2022-01539. Paper 9.

On August 2, 2023, pursuant to our authorization, Mercedes-Benz and Neo Wireless, LLC (“Patent Owner”) filed a Joint Motion to Terminate with respect to Mercedes-Benz. Paper 17 (“Motion” or “Mot.”). Mercedes-Benz and Patent Owner also filed a copy of a settlement agreement (Ex. 2100, “Settlement Agreement”), along with an authorized joint request to treat the Settlement Agreement as business confidential information and to keep it separate under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 18).

In the Motion, Mercedes-Benz and Patent Owner state that they have settled their dispute with respect to IPR2023-00079 and IPR2022-01539, and that the related district court litigation captioned *Neo Wireless LLC v. Mercedes-Benz USA, LLC*, Case No. 3:22-cv-00780 (M.D. Fla.), which was

transferred to actions captioned *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.), has been dismissed. Mot. 2–3.

The parties also submit that Confidential Exhibit 2100 is a true and correct copy of the Settlement Agreement (Mot. 3) and there are no collateral agreements made in connection with, or in contemplation of, the termination of the *inter partes* review (*id.* at 4).

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).

Because the moving parties (Mercedes-Benz and Patent Owner) represent that they have complied with the applicable requirements, we terminate the *inter partes* review with respect to Petitioner Mercedes-Benz. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.74.

Volkswagen and Ford Motor Company, the remaining Petitioners in IPR2022-01539, are not parties to the Settlement Agreement and did not join the Motion. Accordingly, IPR2022-01539 remains pending as to Volkswagen and Ford Motor Company.

The moving parties further request that “in the event a person or entity makes a written request, as stated in 37 C.F.R. § 42.74(c)(1)–(2), for access to the settlement agreement, that any such written request be served upon Mercedes[-Benz] and Neo on the day the written request is provided to the Board.” Paper 18, 2. We have no such procedure to serve upon the parties any written request for access to the Settlement Agreement, and, further, our regulations do not require us to do so. Therefore, we deny the moving parties’ request to be served with a written request for access to the Settlement Agreement.

The moving parties further request that the Settlement Agreement “be kept separate from the file of this proceeding and the involved patent.” Paper 18, 2. After reviewing the Settlement Agreement, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. Therefore, we determine that good cause exists to treat the Settlement Agreement (Ex. 2100) between the moving parties as business confidential information under 37 C.F.R. § 42.74(c), to keep it separate from the files of the involved patent and associated proceedings, and to limit its availability pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

Accordingly, it is:

ORDERED that the Joint Motion to Terminate with respect to Mercedes-Benz only is granted in IPR2022-01539;

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FURTHER ORDERED that the Settlement Agreement (Ex. 2100) be treated as business confidential information and shall remain designated as “Filing Party and Board” only in Board’s filing system, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause, and shall be kept separate from the files of the involved patent, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R.

§ 42.74(c);

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

FURTHER ORDERED that the case caption for future submissions in IPR2022-01539 shall not list Mercedes-Benz as a petitioner as set forth on the attached Exhibit;

FURTHER ORDERED that a copy of this Order be entered into the record of IPR2023-00079; and

FURTHER ORDERED that IPR2023-00079 is terminated under 37 C.F.R. § 42.72.

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(Exhibit: Sample Case Caption)

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¹ Ford Motor Company filed a motion for joinder and petition in IPR2023-00764. The motion was granted, and, therefore, Ford Motor Company has been joined as petitioner in this proceeding.