

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLKSWAGEN GROUP OF AMERICA, INC.,
Petitioner,

v.

NEO WIRELESS LLC,
Patent Owner.

IPR2023-00426
Patent 8,467,366 B2

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

KOKOSKI, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request on Rehearing of
Decision Denying Institution
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Volkswagen Group of America, Inc. (“Petitioner”) filed a Request for Rehearing (Paper 13, “Request” or “Req.”) of our Decision (Paper 12, “Decision” or “Dec.”) denying institution of an *inter partes* review of claims 1–24 (“the challenged claims”) of U.S. Patent No. 8,467,366 B2 (Ex. 1001, “the ’366 patent”). With our authorization, Neo Wireless LLC (“Patent Owner”) filed an Opposition to Petitioner’s Request. Paper 14 (“Opposition” or “Opp.”).

The Request challenges our determination that the information presented in the Petition did not establish a reasonable likelihood of showing that: (1) claims 1–4, 6–20, and 22–24 would have been obvious over the combined teachings of Jeong¹ and Suzuki;² (2) claims 2, 3, 5, 10, 11, and 21 would have been obvious over the combined teachings of Jeong, Suzuki, and Gibson;³ (3) claims 1, 4, 6–9, 12, 15–20, and 22–24 would have been obvious over the combined teachings of Koo,⁴ 802.16ab,⁵ Chayat,⁶ and Suzuki; and (4) claims 2, 3, 5, 10, 11, 13, 14, and 21 would have been obvious over the combined teachings of Koo, 802.16ab, Chayat, Suzuki, and Gibson. Dec. 15–21, 24–30. The Decision rests on our determination that Petitioner did not adequately establish that the combined teachings of Jeong

¹ Jeong, KR2003-00585589, published July 7, 2003 (Ex. 1008).

² Suzuki, US 5,903,614, issued May 11, 1999 (Ex. 1009).

³ Jerry D. Gibson, “The Mobile Communications Handbook,” 2nd Edition, CRC Press LLC, 1999 (Ex. 1010).

⁴ Koo, US 2003/0198179 A1, published Oct. 23, 2003 (Ex. 1011).

⁵ Unapproved Working Document Standard Air Interface for Fixed Broadband Wireless Access Systems-Media Access Control Modifications and Additional Physical Layer for 2-11 GHz, Part 16, IEEE 802.16, July 2001 (Ex. 1012, “802.16ab”).

⁶ Chayat, WO 03/075500 A2, published Sept. 12, 2003 (Ex. 1013).

and Suzuki, and the combined teachings of 802.16ab and Suzuki, disclose “the ranging subchannel comprises at least one block of subcarriers within the communication channel and power levels of subcarriers at both ends of a block are set to zero” limitation of claim 1 (“Limitation 1.5”). Dec. 18–21, 26–30. Petitioner argues that reconsideration is appropriate because the Board abused its discretion in denying Petitioner’s request to file a pre-institution reply to address claim construction issues raised in Patent Owner’s Preliminary Response (“POPR”). Req. 8–10. Petitioner also argues that the Board considered the scope of Limitation 1.5 without explicitly construing the limitation, and then incorrectly determined that the zero-power subcarriers are part of the “at least one block of subcarriers within the communication channel.” *Id.* at 10–14. In addition, Petitioner argues that the Board misapprehended its arguments regarding the reasons to combine the disclosures of 802.16ab and Suzuki, and overlooked Dr. Cimini’s testimony in support thereof. *Id.* at 14–15.

After considering Petitioner’s Request and Patent Owner’s Opposition, we find no error or abuse of discretion in our determination to deny institution. Accordingly, for the reasons that follow, Petitioner’s Request is denied.

II. STANDARD OF REVIEW

When rehearing a decision on institution, we do not review the merits of the decision *de novo*, but instead review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be determined “if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors.” *Arnold Partnership v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004) (citing *In re*

Gartside, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000)). The party requesting rehearing has the burden to show that the decision should be modified.

37 C.F.R. § 42.71(d). Additionally, the request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.*

III. ANALYSIS

A. Petitioner’s Request to File a Reply

Petitioner argues that we abused our discretion in denying Petitioner’s request to file a reply to the POPR. Req. 8–10. Petitioner asserts that, in the POPR, Patent Owner proposed a construction for Limitation 1.5 and introduced new testimonial evidence from Mr. Alberth about that construction, and its request to file a reply “was timely, made in response to newly introduced testimony from Mr. Alberth, and identified a good cause basis for limited briefing.” *Id.* at 9 (citing Ex. 1033, 3–4).⁷ According to Petitioner, because it “was denied an opportunity to respond to Patent Owner’s claim construction of a term that the Panel determined to be dispositive and the parties clearly dispute the scope of the term, the Panel should institute review and allow the record to develop as to the proper scope of Limitation 1.5.” *Id.* at 10.

Our rules provide for a reply to a preliminary response only when good cause exists. 37 C.F.R. § 42.108(c). Here, Petitioner argued that “[g]ood cause exists for the requested reply because the POPR includes critical mischaracterizations and inconsistencies that warrant a response.”

⁷ Petitioner filed Exhibit 1033 with its Request. We determine that Petitioner established good cause for admitting Exhibit 1033, and, accordingly, admit Exhibit 1033 into the record. Req. 8.

Ex. 1033, 3. Petitioner’s only reference to Limitation 1.5 was when it identified “Patent Owner’s allegations regarding the appropriate scope of the claimed ‘power levels of subcarriers at both ends of a block are set to zero,’ which are insolubly inconsistent with its infringement theories in the corresponding multi-district litigation” as one example of such “key mischaracterizations and inconsistencies in the POPR.” *Id.* Petitioner did not otherwise refer to claim construction or Mr. Alberth’s testimony. *Id.* It is not unusual for a petitioner to disagree with how a patent owner characterizes the facts and law presented in a petition, and the Board routinely determines whether a party mischaracterizes the record or the opposing party’s arguments without the need for additional briefing. *See Dell Inc. v. Neo Wireless LLC*, IPR2021-01468, Paper 10 at 3 (PTAB January 27, 2022). Accordingly, we determined that Petitioner failed to show good cause to file a reply to the POPR and denied Petitioner’s request for leave to file a reply.

After considering Petitioner’s Request, we are not persuaded that we erred in that determination. Petitioner chiefly argues that it was “arbitrarily den[ied] . . . an opportunity to brief the claim construction issue” regarding Limitation 1.5. Req. 8–10. Petitioner’s request to file a reply, however, sought only to address Patent Owner’s argument with respect to Limitation 1.5 in relation to Patent Owner’s infringement allegations in the related litigation. Ex. 1033, 3. We are not persuaded that any such inconsistencies require reconsideration of our Decision.

We also disagree that Petitioner was denied an opportunity to address claim construction in this proceeding. Petitioner argued in the Petition that “[n]o claim terms require express construction,” despite recognizing that Limitation 1.5 could be construed to include the guard subcarriers at both

ends of the “block of subcarriers.” Pet. 13, 31. In addition to arguing that the prior art discloses guard subcarriers between blocks of subcarriers, (*id.* at 32–33), Petitioner argued that the prior art disclosed a block of subcarriers with guard subcarriers at both ends. *Id.* at 31 (“Alternatively, to the extent ‘block of subcarriers’ is interpreted to include the guard subcarriers at both ends, Jeong’s 127 subcarrier ranging sub-channel plus one or more guard subcarriers on each end is a ‘block of subcarriers.’”). Thus, the scope of Limitation 1.5 was a reasonably foreseeable issue that Petitioner could have expressly addressed in the Petition. That Petitioner chose not to do so does not create good cause to file a reply to a POPR that did address the issue. *See Masimo Corp. v. Apple Inc.*, IPR2023-00734 at 14 n.5 (PTAB October 5, 2023) (“If, for example, a petitioner does not address adequately a foreseeable issue, Petitioner does so at its own peril.”).

For these reasons, we are not persuaded that we abused our discretion in denying Petitioner’s request to file a reply to the POPR.

B. Claim Construction

Petitioner argues that we abused our discretion by not expressly construing Limitation 1.5 because “the scope of the term ‘at both ends’ in Limitation 1.5 is not readily apparent from the claim language and is clearly disputed by the parties.” Req. 12. Petitioner also argues that we misapprehended Limitation 1.5 because the claim language “recites only that the zero-power subcarriers are ‘at both ends of a block,’ not that zero-power subcarriers are part of and included within the ‘at least one block of subcarriers’ of the first sub-limitation” of Limitation 1.5. *Id.* at 12–13.

As we noted in the Decision, Petitioner asserted in the Petition that no claim term required express construction, and Patent Owner did not address claim construction at this stage of the proceeding. Dec. 10–11. When

analyzing Petitioner’s arguments with respect to claim 1, we relied on the plain language of the claim to determine that Petitioner did not sufficiently establish that the combined teachings of Jeong and Suzuki teach or disclose “a block of subcarriers that includes the zero power subcarriers as part of the subcarrier block” as required by Limitation 1.5. *Id.* at 15. This reading of Limitation 1.5 is consistent with Petitioner’s argument in the Petition that, “to the extent ‘block of subcarriers’ is interpreted to include the guard subcarriers at both ends, Jeong’s 127 subcarrier ranging sub-channel plus one or more guard subcarriers on each end is a ‘block of subcarriers.’” Pet. 31 (citing Ex. 1003 ¶ 88). We considered this argument in the Decision, but did not find it to be persuasive. Dec. 20.

Having chosen not to propose an express construction of Limitation 1.5 in the Petition, Petitioner argues for the first time in the Request that our reading of Limitation 1.5 is not supported by the claim language or the ’366 patent specification. Req. 13–14. A request for rehearing, however, is not an opportunity to supplement a petition and make arguments a party did not make earlier. *See also Harmonic Inc. v. Avid Tech. Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (“In an IPR, the petitioner has the burden from the outset to show with particularity why the patent it challenges is unpatentable.”); 37 C.F.R. § 42.22(a)(2) (“Each petition . . . must include . . . [a] full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence including material facts, and the governing law, rules, and precedent.”).

Petitioner also argues that, because the Decision “turned on the Panel’s interpretation of Limitation 1.5 as requiring the zero-power subcarriers to be a part of the subcarrier block,” we erred by not expressly construing Limitation 1.5. Req. 10–11 (citing Dec. 15, 19–20, 26–27). As

discussed above, Petitioner asserted that no claim terms required express construction, and our Decision rests on the plain language of the claim. Considering that Petitioner argued that the prior art disclosed Limitation 1.5 even if “block of subcarriers” is interpreted to include the guard subcarriers at both ends, our analysis of Limitation 1.5, summarized above, is sufficient for purposes of our Decision. Petitioner’s Request does not persuade us that we erred in our treatment of Limitation 1.5.

C. Motivation to Combine

In the Decision, we determined that Petitioner did not sufficiently establish that the combined teachings of 802.16ab and Suzuki would have led an ordinarily skilled artisan “to incorporate zero power subcarriers on both ends of 802.16ab’s block of subcarriers.” Dec. 26. In particular, we found that Petitioner’s analysis, and Dr. Cimini’s testimony in support thereof, was conclusory and failed to adequately explain how or why a skilled artisan would have made the proposed modification. *Id.* at 26–27. We relied on Mr. Alberth’s testimony to find that 802.16ab teaches not to include guard frequency subcarriers because it uses a scheme that already has a high tolerance to interference, and thus we were not persuaded by Petitioner’s argument that an ordinarily skilled artisan would have been motivated to combine Suzuki’s zero power subcarriers with 802.16ab’s block of subcarriers “to reduce interference between groups of subcarriers.” *Id.* at 28.

Petitioner asserts that we misapprehended Petitioner’s motivation-to-combine arguments with respect to the combination of 802.16ab and Suzuki. Req. 14–15. Petitioner argues that 802.16ab’s scheme “would reduce interference **within** the ranging subchannel,” but its proffered motivation to combine was “to reduce interference between

adjacent subcarriers.” *Id.* at 15 (citing Pet. 54, 59, 64, 70) (emphasis in original). As noted above, however, our Decision explicitly states that “Petitioner’s proffered motivation to combine Suzuki’s zero power subcarriers with 802.16ab’s block of subcarriers is ‘to reduce interference **between groups of subcarriers.**’” Dec. 28 (quoting Pet. 59) (emphasis added). We found this motivation to be inadequate because, in light of 802.16ab’s

scheme that already has a high tolerance to interference, neither Petitioner nor Dr. Cimini sufficiently explains how or why a [person of ordinary skill in the art] would have been motivated to reduce interference between 802.16ab’s subcarriers in the first instance, or that implementing Suzuki’s zero power subcarriers in 802.16ab’s system would have yielded predictable results.

Id. at 28–29. Thus, our Decision demonstrates that we understood Petitioner’s arguments, but did not find them to be persuasive. Petitioner’s Request does not persuade us that we misapprehended Petitioner’s motivation to combine arguments with respect to the teachings of 802.16ab and Suzuki.

IV. CONCLUSION

We have reviewed and considered the arguments in Petitioner’s Request and Patent Owner’s Opposition, and conclude that Petitioner has not carried its burden of demonstrating that we misapprehended or overlooked any matters, and therefore abused our discretion, in denying institution of *inter partes* review of the challenged claims of the ’366 patent.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petitioner’s Request for Rehearing is *denied*.

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