

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORD MOTOR COMPANY, GENERAL MOTORS LLC, and
NISSAN NORTH AMERICA, INC.,¹
Petitioner,

v.

NEO WIRELESS, LLC
Patent Owner.

IPR 2023-00763
U.S. Patent No. 10,447,450 B2

**Corrected Motion to Submit Supplemental Information
under 35 U.S.C. § 316(a)(3) and
37 C.F.R. § 42.123(a)**

¹ General Motors LLC and Nissan North America, Inc. were joined as a petitioner to this proceeding based on a petition and motion for joinder filed in IPR2023-00962, which were granted.

EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 10,447,450 (“’450 Patent”)
1002	File History for U.S. Patent No. 10,447,450 (“’450 FH”)
1003	Declaration of Dr. Todor Cooklev (“Cooklev Decl.”)
1004	<i>Curriculum Vitae</i> of Dr. Todor Cooklev
1005	U.S. Patent Application Publication No. 2006/0039274 A1 (“Park”)
1006	IEEE, <i>IEEE Standard for Local and Metropolitan Area Networks, Part 16: Air Interface for Fixed Broadband Wireless Access Systems</i> , IEEE STANDARDS 802.16 (Oct. 2004) (“802.16-2004”)
1007	Declaration of David Ringle (Mar. 1, 2023) (“Ringle Decl. (802.16-2004)”)
1008	Certified Translation of Korean Patent Application No. 65099/2004 (“Park Translation”)
1009	Opinion and Order Granting in Part and Denying in Part Defendants’ Motion to Reduce Number of Asserted Claims (ECF No. 96), <i>In re Neo Wireless, LLC Patent Litig.</i> , No. 2:22-md-03034 (E.D. Mich. Nov. 18, 2022), ECF No. 99 (“ <i>In re Neo</i> Reduction of Asserted Claims Op. (ECF 99)”)
1010	Opinion and Order on Further Prior Art and Claim Narrowing, <i>In re Neo Wireless, LLC Patent Litig.</i> , No. 2:22-md-03034 (E.D. Mich. Dec. 9, 2022), ECF No. 102 (“ <i>In re Neo</i> Claim Narrowing Op. (ECF 102)”)
1011	Joint Claim Construction Statement, <i>In re Neo Wireless, LLC Patent Litig.</i> , No. 2:22-md-03034 (E.D. Mich. Jan. 18, 2023), ECF No. 114 (“Joint Claim Construction Statement”)
1012	United States District Courts – National Judicial Caseload Profile (Sept. 30, 2017–Sept. 30, 2022)
1013	Transfer Order, <i>In re Neo Wireless, LLC Patent Litig.</i> MDL No. 3034 (J.P.M.L. June 14, 2022), ECF No. 50 (“MDL Transfer Order”)
1014	IEEE, <i>IEEE Standard for Local and Metropolitan Area Networks, Part 16: Air Interface for Fixed Broadband Wireless Access Systems – Amendment 2: Physical and Medium Access Control Layers for Combined Fixed and Mobile Operation in Licensed Bands and Corrigendum 1</i> , IEEE STANDARDS 802.16e (Dec. 2005) (“802.16e-2005”)

Exhibit No.	Description
1015	Declaration of David Ringle (Mar. 16, 2023) (“Ringle Decl. (802.16e-2005)”)
1016	IEEE, <i>IEEE 802.16 Published Standards and Drafts</i> , https://www.ieee802.org/16/published.html (last visited Mar. 14, 2023, 2:43 PM)
1017	IEEE, <i>IEEE Standard 802.16-2004: Publication History (Updated 2004-04-04)</i> , https://www.ieee802.org/16/pubs/80216-2004.html (last visited Mar. 15, 2023, 8:34 AM)
1018	Patent Owner’s Preliminary Response, <i>Volkswagen Grp. of Am., Inc. v. Neo Wireless, LLC</i> , IPR2022-01567 (Patent 10,447,450), Paper 7 (P.T.A.B. Feb. 8, 2023) (“IPR2022-01567, Paper 7 (POPR)”)
1019	Plaintiff Neo Wireless, LLC’s Opening Claim Construction Brief, <i>In re Neo Wireless, LLC Patent Litig.</i> , No. 2:22-md-03034 (E.D. Mich. Feb. 16, 2023), ECF No. 127 (“Neo Opening Claim Construction Brief”)
1020	Declaration of William Alberth in Support of Neo Wireless’s Opening Claim Construction Brief, <i>In re Neo Wireless, LLC Patent Litig.</i> , No. 2:22-md-03034 (E.D. Mich. Feb. 16, 2023), ECF No. 127-3 (“ <i>In re Neo</i> (ECF 127-3)”)
1021	Patent Owner’s Preliminary Response, <i>Dell, Inc. v. Neo Wireless, LLC</i> , IPR2021-01486 (Patent 10,447,450), Paper 7 (P.T.A.B. Dec. 20, 2021) (“IPR2022-01486, Paper 7 (POPR)”)
1022	Roger Marks, Presentation: <i>IEEE 802.16 WirelessMAN® Standard: Myths and Facts</i> , 2006 Wireless Communications Conference, Wash., D.C. (Doc. No. IEEE C802.16-06/007r1) (June 29, 2006) (“Marks”)
1023	Soon Young Yoon, Presentation: <i>Introduction to WiBro Technology</i> , Telecom R&D Center, Samsung Electronics Co., Ltd. (Sept. 10, 2004) (“Yoon”)
1024	Kim Tong-hyung, <i>Seoul Chooses Standard for Wireless Broadband Access</i> , THE KOREA HERALD (July 29, 2004)
1025	IEEE, <i>IEEE Standards Wireless Networks Series: WirelessMan®, Inside the IEEE 802.16™ Standard for Wireless Metropolitan Networks</i> (2006) (“Eklund”)
1026	<i>Wireless Internet Operators to Be Picked</i> , KOREA TIMES (July 30, 2004)

Exhibit No.	Description
1027	Sorour Falahati et al., <i>Adaptive Modulation Systems for Predicted Wireless Channels</i> , 52 IEEE TRANSACTIONS COMMC'NS 307 (Feb. 2004) ("Falahati")
1028	Exhibit C to Defendants' Joint Motion to Reduce the Number of Asserted Claims, Plaintiff's Infringement Contentions to Ford, In re Neo Wireless, LLC Patent Litig., No. 2:22-md-03034 (E.D. Mich. Oct. 21, 2022), ECF No. 96-4 (excerpts)

NEW EXHIBITS

Exhibit No.	Description
1029	Declaration of Matt Ceglia (October 8, 2024) (the "Ceglia Declaration")
1030	Full publicly available file history of US Patent No. 10,447,450 B2

I. INTRODUCTION

Petitioner moves to submit supplemental information as permitted by the Board's email dated October 11, 2024. Petitioner's motion meets the requirements of 37 C.F.R §42.123(a). The supplemental information is (i) a declaration of Matt Ceglia (Ex. 1029, "Ceglia Declaration"), which further shows Ex. 1006 (802.16-2004 - IEEE standard; hereinafter "802.16-2004") is prior art, and (ii) a full public version of the file history for US Patent No. 10,447,450 (Ex. 1030). The supplemental information is responsive to Patent Owner's objections to Exhibits 1002 and 1007. (Paper 32). Petitioner served the supplemental information to Patent Owner within ten business days of the objections. *See* 37 C.F.R. §42.64(b).

II. THE SUPPLEMENTAL INFORMATION PERTAINS TO EXHIBITS PREVIOUSLY SUBMITTED

Petitioner previously submitted Ex. 1007, which was a declaration from an IEEE employee authenticating 802.16-2004 (Ex. 1006) and establishing public accessibility of 802.16-2004 as of October 1, 2004. Patent Owner objected to Ex. 1007 (Paper 32, P. 2–3) In response to the objections, Petitioner contacted IEEE and acquired a second declaration (Ceglia Declaration, Ex. 1029) further explaining the public accessibility of 802.16-2004. Ex. 1029 further explains IEEE's regular business practices related to dating their published standards, inclusion of metadata, and when publications are first made available to the interested public thus further demonstrating that 802.16-2004 was publicly accessible on October 1, 2004 via

IEEE Xplore. Petitioner did not intentionally withhold the Ceglia Declaration; rather, Petitioner served the supplemental evidence in response to Patent Owner's objections per PTAB procedure.

Patent Owner objected to Ex. 1002 as being "incomplete." (Paper 32, P. 1.) Ex. 1002 included the relevant excerpts of the publicly available file history, but in response to Patent Owner's objections, Petitioner seeks to file a full public version of the file history (Ex. 1030) to supplement Ex. 1002.

III. BOARD PRECEDENT SUPPORTS THE MOTION

The Board has consistently granted motions to submit supplemental information to confirm the public accessibility of non-patent prior art relied upon in the Petition. *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 15 (PTAB Dec. 20, 2019) (*Precedential*) citing *Nikon Corp. v. ASML Netherlands B.V.*, IPR2018-00688, Paper 16 at 5–6 (PTAB Oct. 29, 2018). The Board has also held, "Petitioner need not demonstrate that the supplemental information proffered could not have been obtained earlier." *Valeo NA Inc., v. Magna Electronics, Inc.*, IPR2014-01208, Paper 23 at 5 (PTAB Mar. 9, 2015). Nor do the "Board's rules prohibit[] a party from filing, as supplemental information, evidence which also is responsive to evidentiary objections." (*Id.*)

In *Nikon*, the Board granted Petitioner's motion to submit a librarian's declaration showing a non-patent prior-art reference was publicly accessible before

the filing date of the challenged patent. The Board granted the motion because the supplemental information did not change the grounds nor the evidence presented in the Petition, did not limit the Board's ability to ensure a just, speedy, and inexpensive trial, did not prejudice patent owner, and precedent supported granting motions to submit, as supplemental information, declarations confirming the date of public accessibility of non-patent prior art relied upon in the petition. *Nikon* at 4–6.

The facts of this case are like *Nikon*. Petitioner is seeking to submit a declaration further confirming the date of public accessibility of 802.16-2004 (Ex. 1029), Patent Owner has until December 5, 2024 to respond and will not be prejudiced, granting Petitioner's motion is in the interest of a just, speedy, and inexpensive resolution of the trial, and the supplement information does not change the grounds nor the evidence presented in the Petition.

Petitioner respectfully requests the Board grant this motion.

Dated: April 28, 2025

Respectfully submitted,

/Kyle G. Konz/
John S. LeRoy (Reg. No. 48,158)
Christopher C. Smith (Reg. No. 59,669)
Kyle G. Konz (Reg. No. 68,910)
BROOKS KUSHMAN P.C.
150 W. Second St., Suite 400N
Royal Oak, Michigan 48067-3846
Attorneys for Petitioner

Certificate of Service

The undersigned hereby certifies that on April 28, 2025, a complete and entire copy of Corrected **Motion to Submit Supplemental Information under 35 U.S.C. § 316(a)(3) and 37 C.F.R. § 42.123(a)**, was served via electronic mail to the attorneys listed below at the following email addresses:
NeoWireless_IPRs@lowensteinweatherwax.com;
lowenstein@lowensteinweatherwax.com; xzhou@caldwellcc.com;
hhamad@caldwellcc.com; weatherwax@lowensteinweatherwax.com;
hendifar@lowensteinweatherwax.com

LEAD COUNSEL	BACK-UP COUNSEL
Kenneth J. Weatherwax Parham Hendifar Lowenstein & Weatherwax LLP 1016 Pico Boulevard Santa Monica, CA 90405 Tel.: 310.307.4503 Fax: 310.307.4509	Nathan Lowenstein Lowenstein & Weatherwax LLP 1016 Pico Boulevard Santa Monica, CA 90405 Telephone: (310) 307-4500 Facsimile: (310) 307-4509 Hamad M. Hamad Xu Zhou Caldwell, Cassady, & Curry P.C. 2121 N. Pearl St., Ste 1200 Dallas, TX 75201 Telephone: (214) 888-4848 Facsimile: (214) 888-4849

Respectfully submitted,

/Kyle G. Konz/

John S. LeRoy (Reg. No. 48,158)
Christopher C. Smith (Reg. No. 59,669)
Kyle G. Konz (Reg. No. 68,910)
BROOKS KUSHMAN P.C.
150 W. Second St., Suite 400N
Royal Oak, Michigan 48067-3846
(248) 358-4400
Attorneys for Petitioner

Certificate of Compliance Pursuant to 37 C.F.R. § 42.24

This paper complies with the type-volume limitation of 37 C.F.R. § 42.24. The paper is within the 3-page limit prescribed by the Board's Authorization email dated October 11, 2024, excluding the parts of the paper exempted.

This paper also complies with the typeface requirements of 37 C.F.R. § 42.6(a)(ii) and the type style requirements of § 42.6(a)(iii)&(iv).

Respectfully submitted,

Dated: April 28, 2025

/Kyle G. Konz/
John S. LeRoy (Reg. No. 48,158)
Christopher C. Smith (Reg. No. 59,669)
Kyle G. Konz (Reg. No. 68,910)
BROOKS KUSHMAN P.C.
150 W. Second St., Suite 400N
Royal Oak, Michigan 48067-3846
(248) 358-4400

Attorneys for Petitioner