

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.

Case IPR2023-00794
U.S. Patent 10,833,908

**PETITIONER’S REQUEST FOR REHEARING OF THE DECISION
DENYING INSTITUTION OF *INTER PARTES* REVIEW**

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Petitioner, American Honda Motor Co., Inc., respectfully requests rehearing of the Decision Denying Institution of *Inter Partes* Review (Paper 11, “DI”).

I. BACKGROUND

The Petition challenges claims 1-30 of the ’908 patent. Pet., 6.¹ It is supported by a declaration submitted by Dr. R. Michael Buehrer. EX1028.² The DI turned on Limitation 1.3 of Claim 1. DI, 17-35.³ Petitioner and Dr. Cimini explained that the combination of Kaiser, Gibson, and Frank teaches or renders obvious Limitation 1.3, Pet., 33-39; EX1003, ¶¶103-114, and articulated *at least 10 separate motivations to combine* Frank’s teachings related to using a random access signal followed by a guard period with Kaiser and Gibson, each motivation being supported by teachings and suggestions in the references themselves, Pet., 21-26; EX1003, ¶¶79-87.

Dr. Cimini is recognized as one of the pre-eminent wireless communications experts in the world. He has over 40 years of experience in wireless technologies and standards, various communications technologies, networking, OFDM, and

¹ Citations to the Petition, *infra*, are to the Petition in IPR2023-00086, which Petitioners substantively copied in the instant proceeding.

² Dr. Buehrer adopted the testimony of Dr. Cimini (EX1028, ¶24). Citations to EX1003, *infra*, are to the Declaration of Dr. Cimini in IPR2023-00086.

³ Citations to the DI, *infra*, are to the Inst. Decision in IPR2023-00086.

physical and media access control (MAC) layer technology. While working at Bell Laboratories from 1982-1985, he proposed and analyzed the use of OFDM in mobile radio systems. His proposal was *the first application of OFDM to wireless systems*, which has become the basis for much of the current, widespread use of OFDM today. Dr. Cimini has also authored or co-authored more than 190 industry publications, has been listed as an inventor on 20 patents, and has received some of the industry's most prestigious honors and awards. EX1003, ¶¶8-16.

At the end of March 2023, after having retained different, well-qualified experts that reviewed and agreed with Dr. Cimini's expert declaration, Ford Motor Company ("Ford") and American Honda Motor Company ("Honda") filed copycat petitions challenging the '908 patent and sought joinder with IPR2023-00086.

Ford Motor Co. v. Neo Wireless LLC, IPR2023-00765; *Amer. Honda Motor Co. v. Neo Wireless LLC*, IPR2023-00794. Ford's petition is supported by testimony from Dr. Todor Cooklev, and Honda's petition is supported by testimony from Dr. R. Michael Buehrer. Both Drs. Cooklev and Buehrer testified that they reviewed and agreed with Dr. Cimini's opinions in full and without qualification. IPR2023-00765, EX1028, ¶4; IPR2023-00794, EX1028, ¶24.

On October 10, 2023, the Panel denied institution in the instant proceeding, finding that Petitioner had not sufficiently articulated a motivation to combine Frank with Kaiser and Gibson to render obvious the element: "transmit, to the base

station, a random access signal followed by a guard period in only a portion of the frequency band.” DI, 17-35.

II. LEGAL STANDARD

A party dissatisfied with a decision may request rehearing, which must identify all matters the party believes the Board misapprehended or overlooked, and where each matter was previously addressed. 37 C.F.R. § 42.71(d). Requests are reviewed for abuse of discretion, *id.* at § 42.71(c), which “occurs when a court misunderstands or misapplies the relevant law or makes clearly erroneous findings of fact,” *Renda Marine, Inc. v. U.S.*, 509 F.3d 1372, 1379 (Fed. Cir. 2007).

III. ARGUMENTS

The Panel should reverse for three reasons: (1) The Panel misapprehended or overlooked established precedent in failing to credit Dr. Cimini’s testimony because it “mirrors” arguments in the Petition; (2) The Panel misapprehended or overlooked the well-settled principle of obviousness law that it is not necessary to show that a combination is the best option, only that it be a suitable option; (3) The Panel’s fact finding that a POSA would not have combined Frank’s guard period with Kaiser/Gibson to address alignment issues was clearly erroneous.

A. The Panel misapprehended or overlooked PTAB and Federal Circuit precedent in failing to credit Dr. Cimini’s testimony because it “mirrors” arguments in the Petition.

The Petition articulated *at least 10 reasons* a POSA would have been motivated to combine Frank with Kaiser and Gibson, and relied on and adopted Dr.

Cimini’s related testimony, including his opinions in paragraphs 81-83 and 88.

Pet., 21-26 (citing EX1003, ¶¶ 79-87). In the DI, the Panel gave little weight to Dr. Cimini’s opinions in paragraphs 81-83 and 88, which proffer certain motivations to combine Frank with Kaiser and Gibson, because, according to the Board, Dr.

Cimini’s testimony “mirrors” the motivation-to-combine arguments in the Petition.

DI, 29, 31, 31-32. By contrast, the Panel widely credited Mr. Alberth’s rebuttal testimony, which Patent Owner presented in its Preliminary Response (“POPR”) using lengthy block quotes—a different form of presentation that, nevertheless, results in the POPR mirroring Mr. Alberth’s testimony. *See, e.g.*, DI, 28 (crediting POPR, 31-32, which block quotes EX2001, ¶47).

In assessing expert testimony, the critical inquiries are whether the testimony “is conclusory and unsupported” and whether it “disclose[s] the underlying facts or data on which the opinion is based.” *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (PTAB Aug. 24, 2022) (precedential) (quoting 37 C.F.R. § 42.65(a)); *TQ Delta, LLC v. Cisco Systems, Inc.*, 942 F.3d 1352, 1359 (Fed. Cir. 2019) (“This court’s opinions have repeatedly recognized that *conclusory* expert testimony is inadequate to support an obviousness determination on substantial evidence review.” (emphasis added)). That expert testimony “mirrors” arguments in a party’s paper (or vice versa) is not sufficient under established precedent—including *Xerox*, *TQ Delta*, and Rule 42.65(a)—to disregard the testimony.

Indeed, contrary to the DI, other PTAB panels have recognized that mere repetition of arguments between a declaration and a party's paper is not an appropriate reason to accord little or no weight to the declaration testimony. *TikTok, Inc. v. Advanced Coding Techs., LLC*, IPR2022-01548, Paper 7 at 5 n.7 (PTAB April 13, 2023); *Inductec Inc. v. Witricity Corp.*, IPR2021-01165, Paper 41 at 6 n.4 (PTAB Mar. 6, 2023). The panel in *TikTok*, for example, rejected the patent owner's argument that declaration testimony from petitioner's expert should be given no weight merely due to repetition between the petition and declaration:

[T]o the extent there is repetition, it is more reasonable to infer that the Petition repeats Mr. Lett's testimony (not the other way around). Second, **that a petition repeats the analysis of an expert declarant is not a reason, in and of itself, to give that expert's opinion little to no weight.** Rather, the critical inquiries are whether the declaration testimony "is conclusory and unsupported" and whether it "disclose[s] the underlying facts or data on which the opinion is based." [*Xerox*, Paper 9 at 15]. Additionally, a similar important inquiry is whether the declaration testimony supports the arguments made in the Petition. If these conditions are satisfied, we do not give little to no weight to declaration testimony simply because it is repeated in a petition, just as we do not give little to no weight to teachings of the prior art that are repeated in a petition.

TikTok, IPR2022-01548, Paper 7 at 5 n.7 (emphasis added); *see also Inductec*, IPR2021-01165, Paper 41 at 6 n.4 ("A declaration that repeats the assertions in a

party’s brief is not for that reason alone entitled to little or no weight. We must consider whether the testimony discloses the supporting evidence in the record.”).

Here, the Panel abused its discretion and elevated form over substance in giving little weight to Dr. Cimini’s opinions while crediting Mr. Alberth’s opinions. To start, the Panel *did not* find that Dr. Cimini’s relevant opinions regarding motivation to combine are conclusory or unsupported. *See* DI, 29, 31, 31-32. Nor are they. Dr. Cimini’s opinions on motivation to combine Frank with Kaiser and Gibson (EX1003, ¶¶79-88) are supported by express teachings in the references themselves. *See, e.g.*, EX1003, ¶¶81-82 (supporting testimony with express teachings in each of Kaiser, Gibson, and Frank), 83 (supporting testimony with express teachings and stated technical advantages in Frank). PTAB panels routinely credit expert testimony that is supported by the cited references, such as Dr. Cimini’s testimony. *See, e.g.*, *Hulu, LLC v. Sito Mobile R&D IP, LLC*, IPR2021-00298, Paper 31 at 56 (PTAB May 17, 2022) (crediting expert testimony on motivation to combine that was “supported by the references cited”); *Cloudflare, Inc. v. Sable Networks, Inc.*, IPR2021-00909, Paper 42 at 20-21 (PTAB Oct. 18, 2022). The Panel thus erred in failing to appropriately credit Dr. Cimini’s well-supported testimony merely because the Petition “mirrors” his testimony.

The Panel’s decision to give little weight to Dr. Cimini’s testimony while

crediting Mr. Alberth's testimony that Patent Owner block quoted also elevates form over substance. In the POPR, Patent Owner presented Mr. Alberth's testimony on motivation to combine in lengthy block quotes. POPR, 9-10 (block quoting of EX2001, ¶40), 11-12 (block quoting EX2001, ¶35), 16-17, 19 (block quoting EX2001, ¶¶37-38), 28-29 (block quoting EX2001, ¶45), 30-31 (block quoting EX2001, ¶46), 32 (block quoting EX2001, ¶47). Indeed, most of Mr. Alberth's relevant testimony is block quoted in the POPR. *Id.* In the DI, the Panel adopted Patent Owner's arguments and widely credited Mr. Alberth's testimony, despite the fact the POPR repeats (or "mirrors") Mr. Alberth's testimony. DI, 24-25 (crediting POPR, 9-10 and EX2001, ¶40), 25 (crediting POPR, 11-12 and EX2001, ¶35), 27 (crediting POPR, 14-22, 28 and EX2001, ¶¶36-39), 27 (crediting POPR, 28-29 and EX2001, ¶45), 28 (crediting POPR, 30-31 and EX2001, ¶46), 28 (crediting POPR, 31-32 and EX2001, ¶47), 30 (crediting POPR, 16-21 and EX2001, ¶¶37-39). The Panel's decision elevates the presentation of the testimony over its substance, favoring block quotes over prose.

But the weight to accord testimony does not hinge on any particular form of presentation, *cf. Xerox*, IPR2022-00624, Paper 9 at 15, and thus the Panel erred in crediting Mr. Alberth's testimony while essentially disregarding Dr. Cimini's opinions. This error is particularly acute pre-institution because Petitioner has not had an opportunity to cross examine Mr. Alberth and to challenge his theories.

Finally, the Panel overlooked that two additional technical experts, who were not retained by Petitioner in IPR2023-00086 and are not directly involved in that proceeding, reviewed Dr. Cimini's testimony and adopted it wholesale. Dr. Todor Cooklev, testifying on behalf of Ford, opined: "I was further asked to review the documents filed as part of IPR2023-00086 by Volkswagen Group of America, Inc., including the Declaration of Leonard J. Cimini, Jr., Ph.D. (EX1003) and its associated exhibits. I agree with Dr. Cimini's analysis and conclusions." IPR2023-00765, EX1028, ¶4. And Dr. R. Michael Buehrer, testifying on behalf of Honda, as noted above, adopted Dr. Cimini's Declaration. IPR2023-00794, EX1028, ¶24.

So in addition to being supported by the express teachings of the references, Dr. Cimini's testimony that the Panel disregarded is further supported and corroborated by two additional, distinguished technical experts. Drs. Cooklev and Buehrer add further credibility to Dr. Cimini's testimony, which the Panel should have credited, particularly at this juncture of the proceeding.

In sum, the Panel's decision to not analyze and to accord little weight to Dr. Cimini's testimony on motivation to combine because it "mirrors" the Petition misapplies precedent on assessing expert testimony, elevates form over substance in crediting equally repetitious testimony from Mr. Alberth, and overlooks the corroborating testimony of Drs. Cooklev and Buehrer. The Panel should reverse its decision and institute review so that parties can develop the record and Petitioner

can cross examine Mr. Alberth on the testimony that the Panel credited over (i) express teachings in the references and (ii) the testimony of three technical experts.

B. The Board misapprehended or overlooked the well-settled principle of obviousness law that it is not necessary to show that a combination is the best option, only that it be a suitable option.

The Petition explained that design incentives and other market forces driving the development of 3G cellular systems—particularly the known problem of contending with increased user traffic—would have motivated a POSA use Frank’s random-access techniques, which Frank teaches were specifically designed to address the “much higher traffic density on random access channels (RACHs).” Pet., 23-24; EX1003, ¶82. The Petition also explained that Frank’s teaching that an advantage of transmitting a guard period after a random-access signal is “that all necessary post-processing, such as for example, signature decoding, can be accomplished during the guard period” would have further motivated the combination. Pet., 23 (citing EX1009, 6:20-24); EX1003, ¶83.

The Panel rejected these motivations to combine, adopting Patent Owner’s and Mr. Alberth’s argument that, by 2004, Frank’s guard period was no longer required because “faster processors were available that could do this without a ‘guard interval’” and thus a POSA “would have simply used a faster processor.” DI, 30-31 (quoting POPR, 14); *see also* DI, 27. In other words, because there was allegedly a better solution (i.e., a faster processor), the Panel held that a POSA

would not have been motivated to use Frank’s solution. This holding is contrary to established law on motivation to combine.

“The motivation-to-combine analysis is a flexible one. ‘[A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.’” *Intel Corp. v. PACT XPP Schweiz AG*, 61 F.4th 1373, 1379 (Fed. Cir. 2023) (“*PACT*”) (quoting *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007)) (emphasis of “any” in original). “It’s not necessary to show that a combination is ‘the best option, only that it be a *suitable* option.” *Intel Corp. v. Qualcomm Inc.*, 21 F.4th 784, 800 (Fed. Cir. 2021) (“*Qualcomm*”) (emphasis in original); *see also In re Fulton*, 391 F.3d 1195, 1200 (Fed. Cir. 2004) (“[A] finding that the prior art as a whole suggests the desirability of a particular combination need not be supported by a finding that the prior art suggests that the combination claimed by the patent applicant is the preferred, or most desirable, combination.”); *In re Mouttet*, 686 F.3d 1322, 1334 (Fed. Cir. 2012) (“just because better alternatives exist in the prior art does not mean that an inferior combination is inapt for obviousness purposes”).⁴

The Panel misapprehended or overlooked this established principle in

⁴ The panel in *Volkswagen Group of America, Inc. v. Neo Wireless LLC*, IPR2022-01537, relied on this very same principle in rejecting Patent Owner and Mr. Alberth’s teaching-away argument. Paper 8 at 53-54 (PTAB May 5, 2023).

rejecting Petitioner’s motivations to combine. Even if by 2004 simply using a faster processor was the preferred solution to address random-access issues in 3G systems (which Petitioner does not concede),⁵ Frank’s solution of providing a guard period after sending a random-access request was a suitable solution that would have been known to a POSA for the reasons stated in Frank and relied upon in the Petition. *See* Pet., 23-24. The law simply does not require a POSA to choose the best solution, even where a non-preferred solution has tradeoffs or disadvantages. *Qualcomm*, 21 F.4th at 795 (explaining “that ‘simultaneous advantages and disadvantages ... do[] not necessarily obviate motivation to combine.’ ... In *KSR* itself, for example, evidence indicating that a prior-art product was ‘bulky, complex, and expensive’ wasn’t on its own enough to dismiss it as ‘too flawed to upgrade.’”).

Notably, Mr. Alberth’s testimony implies that Frank’s solution would have been obvious in 1998 (Frank’s earliest priority), but became non-obvious by 2004: “This may have been a concern in some limited circumstances in May of 1998

⁵ Mr. Alberth’s testimony about using faster processors overlooks and is inconsistent with Patent Owner’s assertion of the claims against post-2004, 4G/5G systems, demonstrating Patent Owner’s contrary belief that systems still use guard periods. *See, e.g.*, Amended Complaint, 2:22-MD-03034-TGB, Dkt. No. 30, ¶46.

when Frank was first written.” EX2001, ¶37. He further testified, “This supports my belief that by 2002, at the latest, it would *no longer have been obvious* to include a ‘guard time’ even in situations where data is transmitted on the RACH.” EX2001, ¶39 (emphasis added). Knowledge in the public domain is not lost simply because technology advances. An obvious solution is still obvious, even if “better” solutions are later developed. *See PACT*, 61 F.4th at 1381.

The Panel’s framing of the motivation-to-combine issue and ultimate decision appear to have been influenced by Patent Owner’s argument that Petitioner did not sufficiently explain whether data would have been transmitted in the random-access channel when Frank is combined with Kaiser and Gibson. DI, 25-26, 32-33. But Patent Owner’s argument is not commensurate with the scope of the independent claims, and thus is a strawman that misled the Panel into rejecting Petitioner’s well-supported motivations to transmit Frank’s preamble and guard period in Gibson’s random-access channel. Claim 1, for example, requires “transmit[ting] . . . a random access signal followed by a guard period in only a portion of the frequency band,” but does not recite a prohibition on transmitting data in “the portion of the frequency band.” *See* EX1001, 11:8-25.

As the Federal Circuit recently explained, the motivation-to-combine “inquiry is not whether a relevant artisan would combine a first reference’s feature [e.g., Gibson’s random-access channel] with a second reference’s feature [e.g.,

Frank’s preamble and guard period] to meet requirements of the first reference [e.g., Gibson] that are not requirements of the claims at issue.” *Axonics, Inc. v. Medtronic, Inc.*, No. 22-1451, slip op. at 12 (Fed. Cir. July 10, 2023). “A contrary view would run counter to established principles, including that the claim defines the invention whose obviousness is being assessed and that a skilled artisan may be motivated to combine particular features of different references, e.g., to secure some benefits at the expense of others, even when bodily incorporation would be impossible or inadvisable.” *Id.* The Panel’s decision is thus further legally flawed for focusing on purported requirements of Gibson that are not requirements of the analyzed claims, and for rejecting Petitioner’s motivation to combine based on bodily incorporation of Frank into Gibson. *See id.*

Because the DI’s motivation-to-combine analysis runs afoul of well-settled principles of obviousness law, the Panel should reverse the DI and institute review.

C. The Panel’s fact finding that a POSA would not have combined Frank’s guard period with Kaiser and Gibson to address alignment issues was clearly erroneous.

Both Petitioner and Patent Owner explained that the ’908 patent discloses using the claimed “guard period” to address alignment issues. Pet., 10 (quoting EX1001, 8:60-62); POPR, 17 n.3; *see* EX1001, 8:60-62 (“A sufficient guard period is reserved in the DSSS signal to account for initial time alignment uncertainty.”). Frank expressly teaches that an advantage of using a guard period is that “the

timing of the random access request can be *aligned* exactly to that of an existing system's frame slot scheme." EX1009, 9:23-24 (emphasis added). So the same concern over alignment that motivated the '908 inventors to use a guard period also motivated Frank to do the same. The same problem and the same solution described in the '908 patent thus existed in the prior art years earlier. Petitioner and Dr. Cimini relied on Frank's express teachings related to alignment, among others, to explain why a POSA would have looked to Frank when implementing the random- access protocol in the Kaiser-Gibson system. Pet., 23-24; EX1003, ¶83.

The Panel glossed over and dismissed this motivation to combine, simply saying: "We agree with Patent Owner's argument and credit Mr. Alberth's testimony that this purported advantage relates to features already taught by Gibson." DI, 28 (citing EX2001, ¶47). This fact finding is clearly erroneous and appears to be based on a single, unsupported, and twice-qualified statement in Mr. Alberth's declaration. Without support, he testified that "Gibson's RACH is already *broadly* aligned with the existing frame slot *to the extent it implements the well-known slotted ALOHA protocol*." EX2001, ¶47. This speculative and conclusory testimony is not commensurate with Gibson's teachings, and should not have been credited. It is also immaterial because the combination does not use the ALOHA protocol.

Petitioner relied on Gibson's teachings at pages 319-320, in which Gibson

teaches that “a random access protocol, *like* the ALOHA protocol, has to be employed to resolve possible collisions.” EX1008, 0319 (emphasis added); Pet., 16-17, 34-35.⁶ The relevant portion of Gibson does not specify the type of random access protocol, suggest using slotted ALOHA,⁷ or provide any other details regarding random access. *See* EX1008, 0319-20. Indeed, Petitioner explained that, “Other than a passing mention of the ‘ALOHA protocol,’ Gibson does not expressly describe the details of the random access protocol, which would have led a POSA to Frank.” Pet., 17; *see id.*, 35.

The Panel was thus incorrect to credit Mr. Alberth’s basis for dismissing Frank’s express motivation to use guard periods—the relevant portion of Gibson does not teach using slotted ALOHA or suggest using a guard period to address alignment issues. Thus, the Panel’s basis for rejecting Petitioner’s motivation to combine is clearly erroneous and should be reversed, particularly in light of the fact that Frank’s stated motivation is the same as the ’908 patent.

⁶ Frank’s protocol is like ALOHA in that it “sought to improve upon then existing approaches, such as ALOHA-type approaches.” Pet., 18.

⁷ Dr. Cimini explained that the ALOHA protocol has different variants, only one of which is slotted ALOHA. EX1003, ¶¶53-54.

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Respectfully submitted,

Date: November 9, 2023

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on November 9, 2023, a complete and entire copy of this Petitioner's Request for Rehearing of the Decision Denying Institution of Inter Partes Review was provided by email, to the Patent Owner by serving the correspondence addresses of record as follows:

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