

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.

IPR2023-00794
Patent 10,833,908 B2

Before HYUN J. JUNG, MATTHEW S. MEYERS, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(c), (d)

I. INTRODUCTION

American Honda Motor Co., Inc. (“Petitioner” or “Honda”) concurrently filed a Petition (Paper 3) requesting institution of an *inter partes* review of claims 1–30 of U.S. Patent No. 10,833,908 B2 (Ex. 1001, “the ’908 patent”) and made a motion to be joined as a party to *Volkswagen Group of America, Inc. v. Neo Wireless, LLC*, IPR2023-00086 (“Volkswagen IPR”). Paper 2 (“Motion” or “Mot.”). Because the arguments and evidence in this proceeding were substantively identical to those in the Volkswagen IPR, we denied institution in this proceeding for the reasons set forth in the Decision Denying Institution in the Volkswagen IPR. Paper 11, 5; *see* Volkswagen IPR, Paper 7 (“Volkswagen Decision” or “Dec.”); *cf.* Mot. 1 (“Honda’s petition is substantively the same as the Volkswagen IPR petition,” “[i]t challenges the same claims, on the same grounds, and relies on the same prior art as the Volkswagen IPR and therefore would create no additional burden for the Board, the Volkswagen IPR Petitioner, or Patent Owner if joined.”). Petitioner then filed a Request for Rehearing of our decision not to institute an *inter partes* review in this proceeding. Paper 12 (“Request” or “Req.”).¹ For the reasons that follow, Petitioner’s Request is *denied*.

¹ In the Volkswagen IPR, Volkswagen Group of America, Inc. filed a Request for Director Review, which was denied. *See Volkswagen Group of America, Inc. v. Neo Wireless LLC*, IPR2023-00086, Paper 12 at 2 (PTAB Aug. 23, 2023).

II. STANDARD OF REVIEW

On request for rehearing, “[t]he burden of showing a decision should be modified lies with the party challenging the decision.” 37 C.F.R. § 42.71(d). “The request 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, reply, or a sur-reply.” *Id.* When rehearing a decision on a petition, we review the decision for abuse of discretion. 37 C.F.R. § 42.71(c). It is not an abuse of discretion to have performed an analysis or reached a conclusion with which a party disagrees. “An abuse of discretion occurs 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 P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004).

III. DISCUSSION²

In the Volkswagen Decision, we determined that Petitioner had not adequately established a rationale to combine Kaiser,³ Gibson,⁴ and Frank,⁵ as proposed. Dec. 23. More particularly, we determined that Petitioner had not sufficiently shown that one of ordinary skill in the art would have had a reason to modify Kaiser in view of Gibson to further include Frank's preamble and guard period. *Id.* at 24. In reaching that determination, we found that Dr. Cimini's testimony in paragraphs 81–83 and 88 of his Declaration (Ex. 1003) “mirror[ed] Petitioner's arguments without more,” and we thus accorded that testimony “little weight.” Dec. 31–32; *see id.* at 29. We credited Patent Owner's evidence, relying on the declaration testimony of Mr. Alberth, that, at the time of the earliest filing date of the '908 patent, processors were fast enough to process the preamble before receiving data without a guard period, and we thus found that “‘design incentives and market forces’ would not have provided a sufficient reason to use Frank's preamble and guard interval in the combination of Kaiser and

² As Petitioner cites to papers and exhibits from the Volkswagen IPR in its Request, so do we in our analysis below. For example, we cite to the Volkswagen Decision and the Petition from the Volkswagen IPR (IPR2023-00086, Paper 2, “Pet.”), which Petitioner “substantively copied in the instant proceeding.” Req. 1 n. 1.

³ Stefan Kaiser & Khaled Fazel, A flexible Spread-Spectrum Multi-Carrier Multiple-Access System for Multi-Media Applications, Proc. of 8th Int'l Symp. on Personal, Indoor and Mobile Radio Comms., vol. 1, 100–104 (1997) (Ex. 1007) (“Kaiser”).

⁴ The Mobile Communications Handbook (Jerry D. Gibson) 2nd ed. (1999) (Ex. 1008).

⁵ WO Pub. No. 99/60729, published November 25, 1999 (Ex. 1009).

Gibson.” *Id.* at 30–31 (citing Prelim. Resp. 14, 16–21). We found Mr. Alberth’s declaration testimony to be supported with reference to “a document dated 2002 for the 3GPP2 system, which transmitted data immediately after a preamble on its random-access channel without a guard period.” *Id.* at 30 (citing Ex. 2001 ¶ 39 (citing Ex. 2008⁶, 1, 53, 463)). We further agreed with Patent Owner that Frank’s advantage of being able to align the timing of the random access request to that of an existing system’s frame slot scheme “relate[d] to features already taught by Gibson.” *Id.* at 28. On that record, we “[did] not view the purported advantages of Frank’s method as sufficiently articulating adequate reasoning such that one of ordinary skill would have been led to modify Kaiser and Gibson in order to use Frank’s preamble and guard period.” *Id.*

Petitioner argues that the Board “misapprehended or overlooked established precedent in failing to credit Dr. Cimini’s testimony because it ‘mirrors’ arguments in the Petition.” Req. 3. Specifically, Petitioner contends that “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.’” *Id.* at 4 (quoting *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (PTAB Aug. 24, 2022) (precedential); 37 C.F.R. § 42.65(a)). According to Petitioner, Dr. Cimini’s testimony regarding motivation to combine Frank with Kaiser and Gibson is neither conclusory nor unsupported, but rather “supported by express teachings in

⁶ 3rd Generation Partnership Project 2 “3GPP2,” cdma2000 High Rate Packet Data Air Interface Specification, Pgs. 1, 53, 463 (2002) [3GPP2] [3GPP2].

the references themselves.” *Id.* at 6. Petitioner argues that the Board abused its discretion in crediting Mr. Alberth’s opinions over those of Dr. Cimini when Patent Owner’s Preliminary Response also mirrors Mr. Alberth’s testimony via lengthy block quotes. *Id.* at 6–7. Petitioner further argues that the Board overlooked that two additional technical experts, Dr. Cooklev and Dr. Buehrer, “reviewed Dr. Cimini’s testimony and adopted it wholesale.” *Id.* at 8.

We are not persuaded that we overlooked or misapprehended precedent in the amount of weight we accorded Petitioner’s testimony. In the Volkswagen Decision, we considered Petitioner’s arguments regarding motivation to modify the Kaiser-Gibson combination to further include Frank’s preamble and guard period. Dec. 26–32 (citing Pet. 22–26). We noted that paragraphs 81–83 and 88 of Dr. Cimini’s Declaration (Ex. 1003) “mirror[ed] the same assertions advanced in the Petition regarding Frank’s purported advantages, without further substantive explanation” and, as a result, we accorded that testimony “little weight.” Dec. 29; *see id.* at 31–32 (“Dr. Cimini’s testimony . . . mirrors Petitioner’s arguments without more.”).

In other words, having fully considered Petitioner’s arguments, including the cited portions of Kaiser, Gibson, and Frank, we did not find paragraphs 81–83 and 88 of Dr. Cimini’s Declaration to add any *additional* technical reasoning for us to consider beyond what was already presented in the Petition. *See* Dec. 25–33 (discussing arguments and evidence presented in the Petition regarding the asserted reason to combine with Frank). We gave Dr. Cimini’s testimony full consideration in that it was fully considered

as presented in the Petition, and we found Mr. Alberth’s declaration testimony regarding the purported advantages of Frank to be better supported in comparison to Mr. Cimini’s testimony and more persuasive for the reasons explained in the Volkswagen Decision. *Id.* at 26–32. Thus, we did not overlook or misapprehend Dr. Cimini’s testimony or the associated evidence, nor did we abuse our discretion in deciding how much weight to accord the expert testimony. *See Elbit Sys. of Am., LLC v. Thales Visionix, Inc.*, 881 F.3d 1354, 1358 (Fed. Cir. 2018) (“The PTAB [i]s entitled to weigh the credibility of the witnesses” (citation omitted)).

As to Petitioner’s argument that two other experts agreed with and adopted Dr. Cimini’s opinions (Req. 8), this is a new argument raised improperly for the first time in the Request. A rehearing request is not an opportunity for the moving party to present new arguments that were not in its original submissions. *See* 37 C.F.R. § 42.71(d). Nevertheless, we are not persuaded that Dr. Cimini’s testimony is significantly bolstered by virtue of being adopted by Drs. Cooklev and Buehrer. Petitioner does not cite, nor are we aware of, any case law or other authority that suggests we should accord additional weight to an expert’s testimony when it is adopted by another expert retained by a joined party.

Petitioner argues that 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.” Req. 9–10 (emphasis omitted) (citing *Intel Corp. v. Qualcomm Inc.*, 21 F.4th 784, 800 (Fed. Cir. 2021)). In the Volkswagen Decision, we were not persuaded by Petitioner’s argument that “design incentives and market

forces” relating to increased user traffic, collisions, and access failures would have motivated one of ordinary skill to use Frank’s preamble and guard period in the Kaiser-Gibson combination. Dec. 29–31 (quoting Pet. 22–23). Instead, we credited Mr. Alberth’s declaration testimony that, by 2004, the earliest filing date of the ’908 patent, processors were fast enough to process the preamble before receiving data without a guard period, obviating the need for Frank’s guard period. *Id.* at 27, 30. We further credited Mr. Alberth’s declaration testimony that one of ordinary skill in the art in 2004 simply would have used a faster processor. *Id.* at 30. Petitioner contends that “[t]he law simply does not require [one of ordinary skill in the art] to choose the best solution, even where a non-preferred solution has tradeoffs or disadvantages.” Req. 11 (citing 21 F.4th at 795).

Petitioner does not persuade us that we overlooked or misapprehended that Petitioner’s proposed combination was a “suitable option.” Our finding that design incentives and market forces would not have been a sufficient reason to apply Frank’s guard period to the Kaiser-Gibson combination due to the available processing power in 2004 applied to the scenario in which data would be transmitted on the random-access channel in the Kaiser-Gibson-Frank combination. *See* Dec. 30 (“Patent Owner argues that ‘[t]he purpose of the ‘guard interval’ in Frank was to allow time to process the preamble before receiving the data’” (citation omitted)), 27 (finding that Frank’s “advantage of ‘less buffering’ clearly relates to Frank’s insertion of the guard period between the preamble and data” (citation omitted)). Even if Frank’s guard period would have been a suitable option for processing the preamble before receiving data (compared to using a faster processor), that

does not alter the fact that we ultimately determined that “Petitioner does not adequately explain why one of ordinary skill in the art would have modified Kaiser and Gibson to . . . transmit data on the random-access channel, as Frank teaches,” when “Gibson teaches the use of separate random-access and data channels.” Dec. 33. Indeed, we were persuaded that there “would have been disadvantages to transmitting data on the random-access channel” such that “one of ordinary skill in the art would have been led away from modifying Kaiser and Gibson to transmit data on the random-access channel.” *Id.*

Petitioner contends that we erred in focusing on a feature of Gibson—the separation of random-access and data channels—that is not recited in the analyzed claims. Req. 12–13. According to Petitioner, our reasoning was improperly “based on bodily incorporation of Frank into Gibson.” *Id.* at 13. We disagree. In our view, Petitioner’s proposed combination necessitated considering whether data would have been transmitted on or separately from the random-access channel in the Kaiser-Gibson-Frank combination in order to parse the purported advantages of Frank’s guard period, some of which required the data to be transmitted on the random-access channel. *See* Dec. 26–27. The differences between Gibson (separation of random-access and data channels) and Frank (transmission of a random-access preamble and data on the same channel) went to the heart of the matter, i.e., whether one of ordinary skill would have been motivated to add Frank’s guard period to the Kaiser-Gibson combination. While bodily incorporation is not required to show obviousness, the Petition fell short of explaining *how* and *why* the references would have been combined to produce the claimed

invention. *TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1066 (Fed. Cir. 2016); *see Pers. Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017) (“such a clear, evidence-supported account of the contemplated workings of the combination is a prerequisite to adequately explaining and supporting a conclusion that a relevant skilled artisan would have been motivated to make the combination and reasonably expect success in doing so”).

Finally, Petitioner argues that the Board’s “fact finding that [one of ordinary skill in the art] would not have combined Frank’s guard period with Kaiser and Gibson to address alignment issues was clearly erroneous.” Req. 13 (emphasis omitted). More particularly, Petitioner argues that Frank teaches the same advantage of time alignment from using a guard period as described in the ’908 patent, and that we erred in crediting Mr. Alberth’s testimony that the purported advantage of alignment relates to features already taught by Gibson. *Id.* at 13–14 (citing Dec. 28). According to Mr. Alberth’s testimony, which we credited, “Gibson’s RACH is already broadly aligned with the existing frame slot to the extent it implements the well-known slotted ALOHA protocol.” Ex. 2001 ¶ 47; *see* Ex. 1008, 319 (“Since this channel is shared by all users in range of the base station, a random access protocol, like the ALOHA protocol, has to be employed to resolve possible collisions.”); Dec. 28. Petitioner contends that we should not have credited this testimony because it is conclusory and unsupported, and because Gibson’s teachings relied on by Petitioner and Petitioner’s Kaiser-Gibson-Frank combination do not use the slotted ALOHA protocol or otherwise address alignment issues. Req. 14–15.

We are not persuaded that we clearly erred in finding that the purported advantages in alignment do not sufficiently articulate adequate reasoning such that one of ordinary skill would have been led to modify the Kaiser-Gibson combination with Frank. *See* Dec. 28. In the Volkswagen Decision, we considered Petitioner’s brief argument, which consisted of quoting Frank’s disclosure that the “random access request can be aligned exactly to that of an existing system’s frame slot scheme.” *Id.* at 28 (citing Pet. 23–24 (quoting Ex. 1009, 9:22–23)). We explained that Dr. Cimini added no substantive explanation (*id.* at 29) for that brief argument and citation and, in contrast, we found that Mr. Alberth’s testimony that the ALOHA protocol disclosed by Gibson already provides alignment was more credible and persuasive (*id.* at 28 (citing Ex. 2001 ¶ 47)). That is, we weighed Petitioner’s brief arguments and evidence against the record in our analysis, and supported our findings with substantial evidence. *See Arnold P’ship*, 362 F.3d at 1340 (“An abuse of discretion occurs . . . if a factual finding is not supported by substantial evidence”).

Petitioner’s disagreement with our factual finding does not mean that it was not supported with substantial evidence. Req. 13–15. “[T]he possibility of drawing two inconsistent conclusions from the evidence does not prevent an administrative agency’s finding from being supported by substantial evidence.” *Consolo v. Fed. Maritime Comm’n*, 383 U.S. 607, 620 (1966). Furthermore, Petitioner’s arguments that “the same concern over alignment that motivated the ’908 inventors to use a guard period also motivated Frank to do the same” (Req. 14) and that Petitioner’s Kaiser-Gibson-Frank “combination does not use the ALOHA protocol” (*id.*) are

untimely new arguments that we could not have overlooked or misapprehended, since they were not presented in the first instance. *See* 37 C.F.R. § 42.71(d).

IV. CONCLUSION

Having considered the arguments in Petitioner's Request for Rehearing, we determine that Petitioner has not carried its burden of demonstrating that the Board misapprehended or overlooked a matter or abused its discretion in the decision denying institution in this proceeding. 37 C.F.R. § 42.71(c), (d).

V. ORDER

It is

ORDERED that Petitioner's Request for Rehearing is *denied*.

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