

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION**

IN RE NEO WIRELESS, LLC
PATENT LITIG.

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2:22-MD-03034-TGB

HON. TERRENCE G. BERG

**PLAINTIFF NEO WIRELESS, LLC'S
SUPPLEMENTAL CLAIM CONSTRUCTION BRIEF**

The Court ordered briefing to “address arguments made in IPR proceedings *since the claim construction briefing was originally filed*” related to three claim terms. 6/6/23 Order (emphasis added). This Order was in response to a letter from Defendants, in which Defendants identify two IPR proceedings and claim that, “[a]s part of these IPR proceedings, Neo and the PTAB have made statements that are relevant to the claim construction analysis.” 6/6/23 P. Steadman Ltr. at 1.

However, contrary to Defendants’ claim, there have been no new arguments made in the identified IPR proceedings since the claim construction briefing was originally filed in this case. In both IPR proceedings, Neo submitted a Patent Owner’s Preliminary Response on February 8, 2023—this was *before* the filing of Neo’s claim construction brief. It was also well over a month *before* the filing of Defendants’ brief. This means there have been no new arguments in these IPRs to address. This also means that Defendants had ample time to address any IPR statements in their claim construction briefing—they, in fact, purported to do so. *See* Dkt. 131 at 30. It is unclear why Defendants’ letter insists that there were new statements made by Neo in these proceedings. There have been none—the intrinsic record for these claim terms has not changed since the parties’ briefing.

The only new development is that *the PTAB* has issued two institution decisions, in which it made preliminary claim construction determinations. Yet, despite Defendants’ claims that these statements “impact the scope and meaning of

the claim terms” or are “directly relevant to the disputed constructions,” 6/6/23 P. Steadman Ltr. at 2, statements made by the PTAB are not binding on the Court. *See, e.g., XMTT, Inc. v. Intel Corp.*, No. 18-1810, 2022 WL 2904308 (D. Del. July 22, 2022). This is especially true for *preliminary* PTAB decisions, which the PTAB itself can change after institution.¹ Nor can the PTAB’s characterizations of Neo’s patent claims disclaim or alter their scope.² Regardless, Neo addresses the PTAB statements for the claim terms highlighted by the Court’s Order.

A. ’941 Patent—“antenna transmission scheme” term.

With regard to this term, the PTAB stated only that “at a minimum . . . the antenna transmission scheme indicated by the mobile station-specific transmission parameters is capable of supporting, as alternatives, a transmission diversity scheme and a MIMO scheme.” IPR2022-01537, Paper 8 at 29. However, as the PTAB noted, “[t]he positions taken by the plaintiff and defendants (including

¹ “[T]he Board is not bound by any findings made in its Institution Decision[,] . . . is free to change its view of the merits after further development of the record, and *should do so* if convinced its initial inclinations were wrong.” *TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016) (emphasis in original); *see also In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1377 (Fed. Cir. 2016) (“[T]he Board has an obligation to assess the question anew after trial based on the totality of the record.”).

² *Cf. Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1124 (Fed. Cir. 2004) (“It is well settled, however, that it is the applicant, not the examiner, who must give up or disclaim subject matter that would otherwise fall within the scope of the claims.”); *3M Innovative Properties Co. v. Avery Dennison Corp.*, 350 F.3d 1365, 1373–74 (Fed. Cir. 2003).

Petitioner) in the NEO Wireless litigation also support this understanding.” *Id.* at 28. Both proposed constructions in this Court, just like the PTAB’s construction, explicitly “require[e] supporting both MIMO and non-MIMO transmission diversity systems.” *See* Dkt. 114-2 at 4. In other words, the PTAB’s preliminary construction merely addresses the undisputed portion of the parties’ competing constructions in this Court; it does not touch on the actual dispute between the parties (whether those are the *only* schemes that can be supported), and thus is not relevant to the Court’s resolution of this dispute.

B. ’941 Patent—“corresponding subchannel configuration” term.

With respect to this term, the PTAB’s recent institution decision adopts the same preliminary construction it adopted in Dell’s prior, unsuccessful IPR of this patent. *See* IPR2022-01537, Paper 8 at 26–27. First, that decision denying institution in Dell’s IPR was published over a year ago, so the recent decision provided *nothing new* that the parties did not already have before briefing in this case. In fact, Defendants’ briefing discusses the Dell decision for this very term.

In any case, Defendants’ conclusion—that the PTAB’s statements in the Dell IPR support their position here—is wrong. *See* Dkt. 133 at 11–12. As with the “antenna transmission scheme” term, here the PTAB again determined only that, at a minimum, the construction of this term requires the capability to indicate both distributed subcarriers and localized subcarriers as subchannel configurations.

IPR2021-01468, Paper 12 at 19. The PTAB specifically “decline[d] to speculate” on the dispute *here*—whether the term requires an explicit “parameter” that indicates “localized” or “distributed.” *See id.* at 18–19; Dkt. 114-2 at 5.

C. ’512 Patent—“at least one of the time slots” term.

In IPR2022-01539, the PTAB declined to expressly interpret this term as a preliminary decision, stating that “[o]n the present record,” the PTAB saw “no reason” to interpret the term “*at this stage* because Patent Owner has *not yet presented its support* for adopting its proposed interpretation.” IPR2022-01539, Paper 7 at 12 (emphasis added). The PTAB even invited Neo to “explai[n] how the language of the claims, the Specification, prosecution history, and possibly other evidence support its proposed interpretation” during the IPR proceeding. *Id.* at 12–13; *see also id.* at 50 (citing the same analysis when discussing an unasserted claim). At that point, the PTAB will have to reassess the construction of this term. *See Magnum*, 829 F.3d at 1377. Neo, however, *has* provided its more developed analyses before this Court. And for this claim term in particular, Neo has developed the factual record with unrebutted testimony of a technical expert repeatedly found credible by the PTAB. *See* IPR2021-01468, Paper 12 at 31–32, 45; IPR2022-00277, Paper 10 at 23–24, 33. The Court should construe this term using the developed record and arguments made before it, which the PTAB did not have when making its preliminary determination.

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