# Exhibit 1

#### 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 IPR2023-00797 Patent 10,771,302 B2

\_\_\_\_\_

PATENT OWNER'S PRELIMINARY RESPONSE



## TABLE OF CONTENTS

		Page	
I.	INTI	RODUCTION1	
II.	THIS SECOND PETITION BY DISTRICT-COURT CO-DEFENDANTS SHOULD BE DENIED UNDER 35 U.SC. § 314(a)		
	A.	Factor 1: The Board Already Rejected On The Merits A First Petition By Petitioner's District Court Co-Defendant, Volkswagen6	
	В.	Factor 2: The Asserted Art Should Have Been Known At The Time Of Co-Defendant Volkswagen's Prior Petition	
	C.	Factor 3: Petitioner Had Access To Patent Owner's Response To Volkswagen's Prior Petition Prior To Filing Its Later Petition13	
	D.	Factor 4: Substantial Time Elapsed Between The Prior Petition And Petitioner's Knowing Of The Prior Art, And This Petition14	
	Е.	Factor 5: Petitioner Fails To Offer Adequate Explanation For The Delay Between The Filing Of Volkswagen's Petition And Its Own15	
	F.	Factors 6-7: Fairness, Timing And Efficiency Weigh Against Institution	
	G.	The Additional Factor That The Office Already Considered Petitioner's Primary Reference 802.16a-2003, Contrary To Petitioner's Assertion Otherwise, Also Weighs Against Institution16	
	Н.	Petitioner's Assertion Of No Roadmapping Is Both Factually Incorrect And, In The Circumstances Here, Legally Irrelevant19	
III.		ITIONER FAILS TO SHOW A "MOBILE DEVICE" AS CLAIMED GROUNDS, ALL CLAIMS)24	
	A.	The Claims Recite A "Mobile Device."	
	В.	Ground 1 Fails To Show A "Mobile Device" Because Koo Is Not Prior Art	
	C.	Ground 2 Fails Because Petitioner Fails To Show Either A Motivation Or A Reasonable Expectation Of Success To Implement IEEE 802.16a With Mobile Users In View Of Kitroser32	
		1. Petitioner Fails To Even Allege, Let Alone Prove, A Motivation To Modify The IEEE 802.16a-2003 Standard To Support Mobility In View Of Kitroser	



	To Ir	tioner Fails To Show A Reasonable Expectation Of Succemplement The IEEE 802.16a-2003 Standard To Support bility In View Of Kitroser	
	a.	Kitroser Fails To Show "Sufficient Certainty" To Pro A Reasonable Expectation Of Success.	
	b.	Petitioner's Reliance On The Truth Of Statements In Kitroser Is Inadmissible Hearsay.	45
137	CONCLUSION		16



### **TABLE OF AUTHORITIES**

	Page(s)
COURT DECISIONS	
Arctic Cat Inc. v. Polaris Indus., 795 Fed. Appx. 827 (Fed. Cir., 2019)	31
Ariad Pharms., Inc. v. Eli Lilly & Co., 598 F.3d 1336 (Fed. Cir. 2010)	23
Belden Inc. v. Berk-Tek LLC, 805 F.3d 1064 (Fed. Cir. 2015)	31
Bicon, Inc. v. Straumann Co., 441 F.3d 945 (Fed. Cir. 2006)	21
Eli Lilly & Co. v. Teva Pharms. Int'l GmbH, 8 F.4th 1331 (Fed. Cir. 2021)	30, 42
<i>In Re Glob. IP Holdings LLC</i> , 927 F.3d 1373 (Fed. Cir. 2019)	23
Honeywell Int'l Inc. v. Mexichem Amanco Holding S.A. De C.V., 865 F.3d 1348 (Fed. Cir. 2017)	
Intelligent Bio-Systems, Inc. v. Illumina Cambridge, Ltd., 821 F.3d 1359 (Fed. Cir. 2016)	
<i>In Re NTP, Inc.</i> , 654 F.3d 1268 (Fed. Cir. 2011)	
Purdue Pharma L.P. v. Faulding, Inc., 230 F.3d 1320 (Fed. Cir. 2000)	
Union Oil Co. of California v. Atl. Richfield Co., 208 F.3d 989 (Fed. Cir. 2000)	
AGENCY DECISIONS	
Abiomed, Inc. v. Maquet Cardiovascular, LLC, IPR2017–02150, Paper 11 (Mar. 12, 2018)	4
Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential)	16
Apple Inc. v. Zomm, LLC, IPR 2019-01030, Paper 8 (Nov. 14, 2019)	9



# DOCKET

# Explore Litigation Insights



Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

# **Real-Time Litigation Alerts**



Keep your litigation team up-to-date with **real-time** alerts and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

### **Advanced Docket Research**



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

# **Analytics At Your Fingertips**



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

#### API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

#### **LAW FIRMS**

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

#### **FINANCIAL INSTITUTIONS**

Litigation and bankruptcy checks for companies and debtors.

#### **E-DISCOVERY AND LEGAL VENDORS**

Sync your system to PACER to automate legal marketing.

