

Filed: November 25, 2016

Megan Lyman (Reg. No. 57,054)  
Lyman Patent Services  
1816 Silver Mist Ct.  
Raleigh, NC 27613  
Tel: (919) 341-4023  
Fax: (919) 341-0271  
melyman@lymanpatents.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

SONY CORPORATION,  
Petitioner,

v.

ONE-E-WAY, INC.  
Patent Owner.

---

Case IPR2016-01639  
Patent 9,282,396

---

PATENT OWNER ONE-E-WAY'S PRELIMINARY RESPONSE TO  
PETITION FOR INTER PARTES REVIEW

## TABLE OF CONTENTS

I. INTRODUCTION .....	1
II. BACKGROUND.....	3
III. OVERVIEW OF THE '396 PATENT.....	4
A. Embodiments described in the specification.....	4
B. The claims .....	7
C. Preliminary Claim Construction.....	10
D. Person of Ordinary Skill in the Art .....	10
E. Effective Filing Date of the Challenged Claims .....	11
IV. PETITIONER'S THEORIES .....	11
V. OVERVIEW OF THE REFERENCES RELIED UPON .....	12
A. The '892 Patent .....	12
B. The 1998 Paper.....	12
C. Giannakis.....	13
VI. THE PETITION IS FUNDAMENTALLY DEFICIENT .....	13
VII. GROUND 1 FAILS.....	14
A. The '892 Patent Fails to Properly Incorporate Any Particular Material From the 1998 paper .....	14
1. The Legal Standard for Incorporation by Reference Requires Specific Identification of Material .....	14
2. The '892 Patent Fails to Incorporate the 1998 Paper in Its Entirety .....	16

B.	The Petition Attempts to Impermissibly Combine Disparate Embodiments for Anticipation.....	18
1.	The Legal Standard for Anticipation .....	19
2.	The '892 patent and the 1998 paper describe distinct systems .....	20
C.	Failure of Omission: Petitioner fails to show that the '892 patent discloses independent CDMA operation. Limitations 1(d) and (f). .....	21
D.	Failure of Confusion: Petitioner fails to show that the '892 patent discloses a digital demodulator. Limitation 1(f). .....	23
E.	Failure of Omission: Petitioner fails to show that the '892 patent discloses a transmitter coupled to a portable audio player or source. Limitation 1(b). .....	25
F.	Failure of Disparate Disclosures and Insufficient Incorporation: Petitioner fails to show that the '892 patent discloses a transmitter comprising an encoder for reduced ISI coding. Limitations 1(b) and (c). .....	27
G.	Failure of Technical Misunderstanding and Ignoring Context: Petitioner fails to show that the '892 patent discloses a decoder operative to decode the applied reduced intersymbol interference coding. Limitation 1(g). .....	29
H.	Failure of Disparate Disclosures and Insufficient Incorporation: Petitioner fails to show that the '892 patent discloses a headphone comprising a direct conversion module. Limitations 1(d) and (e). .....	32
I.	Failure of Disparate Disclosures and Insufficient Incorporation: Petitioner fails to show that the '892 patent discloses a direct conversion module configured to capture packets corresponding to a unique user code. Limitation 1(e). .....	34

J.	Failure of Omission: Petitioner fails to show that the '892 patent discloses a system in which other signals are inaudible while operating in the spread spectrum. Limitation 1(j).	36
VIII.	GROUND 2 ALSO FAILS	39
A.	For All Limitations other than the Reduced ISI Limitations, Petitioner Offers No Additional Argument in Support of its Ground 2 Obviousness Theory and Thus, Ground 2 Fails for the Same Reasons as Ground 1	39
1.	Petitioner fails to apply critical aspects of the required <i>Graham</i> analysis	40
B.	Petitioner Fails to Provide Any Argument or Analysis Addressing a Reason or Motivation to Combine Giannakis with the '892 Patent, and this Failure is Fatal to Ground 2	43
C.	Petitioner Misleadingly Omitted and Ignored Giannakis' Express Statement Limiting the Applicability of its Approach and Thus Failed to Sustain its Burden to Demonstrate any Reason or Motivation to Combine Giannakis with the '892 Patent	45
1.	Petitioner's Declarant, Mr. Moring, Inexcusably Used an Ellipsis to Omit and Ignore Giannakis' Express Restriction On Applicability	47
2.	A Person of Ordinary Skill in the Art Would Understand that Bluetooth is a Fast Hopping System, and Zhou Expressly States that Fast Hopping Systems are Beyond the Scope of the Disclosed $\phi_m$ -based Frequency Hopping Technique	49

3.	A Person of Ordinary Skill in the Art Would Know that Giannakis' $\phi_m$ -Based Frequency Hopping Approach is Not Possible in Bluetooth.....	51
a.	A Person of Ordinary Skill in the Art Would Understand that Frequency-Hopping Cannot be Implemented in Bluetooth using Zhou's Subcarrier Selector Matrix $\phi_m$ .....	52
b.	A Person of Ordinary Skill in the Art Would Understand that Redundant Simultaneous Transmissions on Multiple Frequencies is Incompatible with Bluetooth.....	53
c.	Petitioner has Failed to Demonstrate that a Person of Ordinary Skill in the Art Would Have Had Any Reason or Motivation to Combine Giannakis and the '892 Patent.....	55
IX.	THE CHALLENGED CLAIMS ARE ENTITLED TO THE FILING DATE OF PATENT OWNER'S 2001 APPLICATION .....	56
X.	CONCLUSION.....	60

# 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.