

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORD MOTOR COMPANY
Petitioner,

v.

SAFE DRIVING TECHNOLOGIES LLC
Patent Owner.

IPR2021-01341
Patent 9,713,994 B2

Before SCOTT C. MOORE, RYAN H. FLAX, and BRENT M. DOUGAL,
Administrative Patent Judges.

FLAX, *Administrative Patent Judge.*

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

Ford Motor Company (“Petitioner”) filed a Petition for *inter partes* review challenging claims 1–4 and 7–10 of U.S. Patent 9,713,994 (Ex. 1001, “the ’994 patent”). Paper 4 (“Pet.”). Safe Driving Technologies LLC (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). Petitioner filed an authorized Preliminary Reply (Paper 9, “Prelim. Reply”) and Patent Owner filed an authorized Preliminary Sur-Reply (Paper 10, “Prelim. Sur-Reply”), each addressing Section 314(a) issues.

Under 37 C.F.R. § 42.4(a), we have authority to determine whether to institute trial in an *inter partes* review. We may institute an *inter partes* review if the information presented in the petition filed under 35 U.S.C. § 311, and any preliminary response filed under § 313, shows that there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the claims challenged in the petition. 35 U.S.C. § 314.

After reviewing the parties’ submissions, we conclude Petitioner demonstrates a reasonable likelihood it would prevail in showing that claims of the ’994 patent are unpatentable under the presented grounds. Therefore, we institute *inter partes* review of all challenged claims (1–4, 7–10) under the grounds raised in the Petition, pursuant to 35 U.S.C. § 314. *See SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018); *see also* Guidance on the Impact of *SAS* on AIA Trial Proceedings (April 26, 2018) (available at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>) (“Guidance”). We decline to exercise discretion under 35 U.S.C. § 314(a) to deny institution under the circumstances.

I. INTRODUCTION

A. REAL PARTIES-IN-INTEREST

Petitioner identifies itself as a real party-in-interest. Pet. xii. Patent Owner identifies itself and also “General Patent Corporation” as real parties-in-interest. Paper 6, 1.

B. RELATED MATTERS

Petitioner identifies *Safe Driving Technologies LLC v. Ford Motor Company*, 1-21-cv-00064 (D. Del.) (the “related district court litigation”) as a related matter. Pet. xii. Patent Owner identifies this same litigation as a related matter and also identifies the following other related matters: IPR2021-01353 concerning U.S. Patent 10,532,709; IPR2021-01446 concerning U.S. Patent 9,047,170; and IPR2022-00086 concerning U.S. Patent 8,301,108. Paper 6, 1. The parties indicate that these other patents are also at issue in the related district court litigation. Pet. xii; Paper 6, 1.

C. THE '994 PATENT

The '994 patent issued on July 25, 2017, from U.S. Application 15/352,206, which was filed on November 15, 2016. Ex. 1001, codes (45), (21), (22). On its face, the '994 patent identifies its priority to U.S. Application 14/661,589, which was filed on March 18, 2015. *Id.* at code (63). However, in its written description, the '994 patent further references priority, ultimately, to U.S. Provisional 60/336,293, which was filed October 24, 2001. *Id.* at 1:6–17. At this stage of the proceeding, in the absence of any argument to the contrary, we understand that the '994 patent is entitled to priority to this provisional application. *See, e.g.*, Pet. 3 (Petitioner asserts that the ordinarily skilled artisan would be someone as of October 24, 2001).

The '994 patent concludes with 10 claims, of which claims 1, 9, and 10 are independent claims. Ex. 1001, 22:42–24:59. Claim 1 is illustrative and reproduced below with added sub-numbering, as used by the parties (*see, e.g.*, Pet. 13–27; Prelim. Resp. 39–40, 42):

- [1.0] 1. A safety control system for vehicles comprising:
 - a telematic device running at least one software application and having at least one input and at least one output;
 - [1.1] at least one sensor operable to sense at least one condition related to a driving environment and data providing information indicating at least one distracting feature for at least one software application;
 - [1.2] a controller in communication with the sensor and the data and the software application and the telematic device, the controller configured to prevent the at least one application output from being provided to the driver in the original format of the at least one output and to provide the at least one output to the driver in a different format, and
 - [1.3] wherein the controller controls when at least one input into the software application and at least one output from the software application are provided to the driver so that prior to permitting the driver to access the input or prior to providing an output from the software application on the telematic device to the driver, the controller determines whether said at least one condition is within a threshold and permits the driver to access said input or provides said output to said driver only when said at least one condition is within the threshold.

Ex. 1001, 22:42–67. The '994 patent's claims 2–8 depend, directly or indirectly, from independent claim 1 (claims 5 and 6 are not challenged). *Id.* at 23:1–24:6.

The '994 patent's Abstract summarizes its invention as follows:

According to one aspect of one embodiment of the present invention, a safety control system for using applications in vehicles, includes, a communication device having at least one

of an input accessible from within the vehicle and an output communicated within the vehicle, at least one sensor operable to sense at least one condition related to vehicle operation, and data about distraction features of a running application, to and a controller communicated with the sensor and the communication device to selectively suppress at least one of said input and said output in response to a sensed parameter of said at least one condition being outside of a threshold. When an input is suppressed, the driver is prevented from accessing or inputting information into the communication device. When an output is suppressed, communication between the device and the driver of a vehicle is suppressed to, among other things, avoid distracting the driver during certain driving situations or conditions relating to the driver, vehicle and/or environment.

Id. at Abstract.

For context, regarding the claimed safety control system, the '994 patent's Figure 1, reproduced below, illustrates a vehicle having such a system:

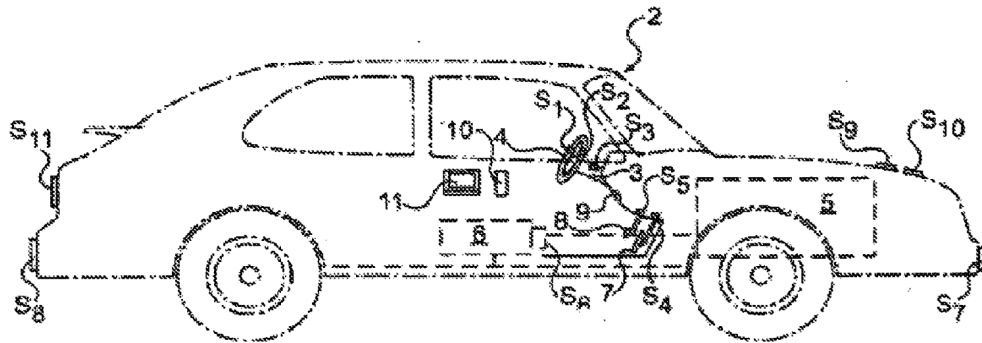


Figure 1

The '994 patent states that “FIG. 1 schematically illustrates one form of a safety control system for vehicles constructed in accordance with the present invention.” *Id.* at 5:14–16. Figure 1 shows vehicle 2 (a “conventional vehicle”), including steering mechanism 3 (column), steering wheel 4,

engine 5, torque converting means 6 (e.g., transmission and driveshaft), acceleration pedal 7, brake pedal 8, visual indicator and audio alarms 9 (collectively), cellular telephone 10 and computer 11 (identified as telematic devices), and sensors S_1 – S_{11} . *Id.* at 5:35–6:61. Sensors S_1 and S_2 are on steering wheel 4 and sense a driver, sensor S_3 is on steering mechanism 3 and senses changes in steering direction or actuation of turning indicator, sensor S_4 senses gas pedal 7 condition and/or vehicle speed or acceleration, sensor S_5 senses brake pedal 8 condition, sensor S_6 senses transmission condition at torque converter 6, sensors S_7 and S_8 sense vehicle proximity to other vehicles, sensor S_9 senses darkness or headlight activation, sensor S_{10} senses weather conditions, and sensor S_{11} senses turn signal activation. *Id.* at 6:35–61, 9:33–35.

In addition to the cell phone and computer discussed above, the '994 patent identifies other telematic devices that provide email, radio, CD or DVD play, navigation system, paging, and the like, as well as blackberry and PDA devices, etc. *Id.* at 5:56–58, 15:42–43. Figure 3, reproduced below, illustrates how the aforementioned sensors and telematics devices are interconnected in a system via a microprocessor, which controls their functions:

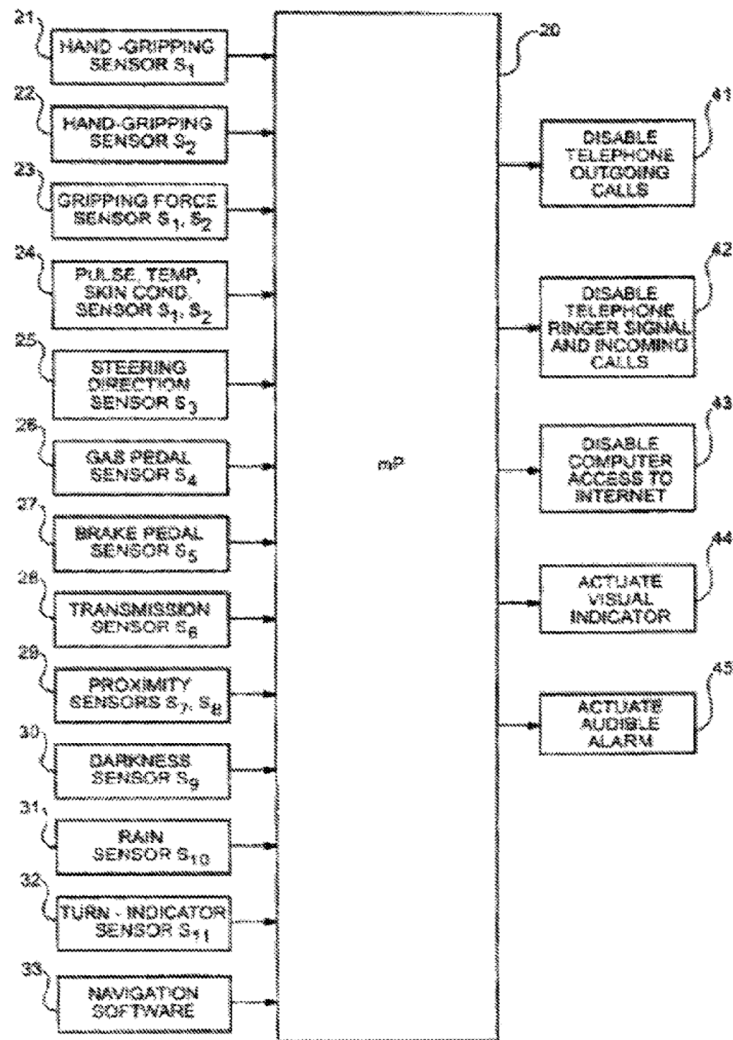


Figure 3

The '994 patent states that "FIG. 3 is a block diagram illustrating the main components in the system of FIG. 1." *Id.* at 5:19–20. Figure 3 shows as a central block microprocessor (mP) 20, which is connected to and, as indicated via arrows, receives input 21–33 from each of the aforementioned sensors S_1 – S_{11} , as well as navigation software 33. *Id.* at 9:50–11:11. Figure 3 also shows that microprocessor 20 is also connected with and, as indicated via arrows, provides output to control disabling of telephone outgoing calls (block 41), disabling of telephone ringer signal and incoming

calls (block 42), disabling of computer access to internet (block 43), actuating of visual indicator (block 44), and actuating of audible alarm (block 45). *Id.* at 11:12–14:27.

The '994 patent calls microprocessor 20 a “state machine” for its ability to perform these functions. The '994 patent states:

The state machine aspect of the microprocessor may make telematic control decisions on a variety of criteria such as: (a) the frequency of use of the application, the frequency in which a number, e-mail or URL is contacted; (b) based on safety/urgency priorities, e.g. cruise or CD changer, cell messages or other telematics, or music played on the radio; (c) as preset by the operator; (d) optionally, based on other collected information from the driving system, the microprocessor will initiate calls at predetermined times out of voice mail as, for example, when the driver completes backing out of a driveway and begins a trip.

Id. at 11:18–30. The operation of such a system is illustrated by the '994 patent at Figure 4, which we reproduce below:

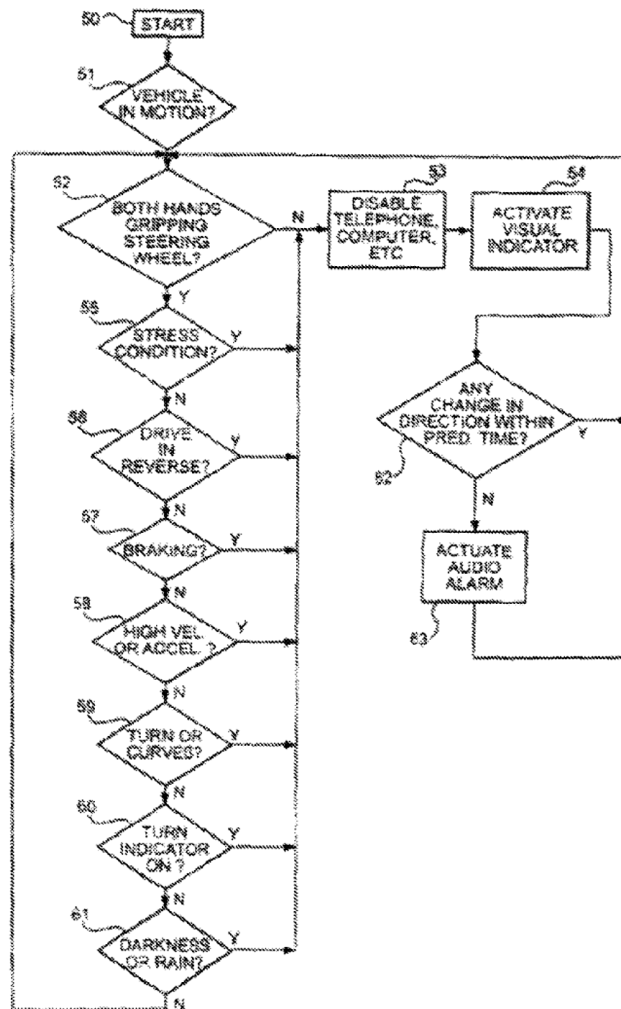


Figure 4

The '994 patent states that “FIG. 4 is a flowchart illustrating the operation of the system of FIG. 1.” *Id.* at 5:21–22. Figure 4 shows the operational and algorithmic decision making of the state machine, which (via the aforementioned sensors) determines whether the vehicle is in motion (block 51) and thereafter uses sensor input to determine if potentially distracting conditions are met (blocks 51, 55–61). *Id.* at 13:59–15:40. If microprocessor 20 determines a distracting condition is present, it outputs

signals to disable vehicle components, e.g., phone, computer, etc., and provides an indicator of the condition. *Id.*

The described factors that can be monitored and considered as potential distractions are numerous and are listed in Figure 5 of the '994 patent, for example, state of the transmission, vehicle speed, and noises, and the system may take certain thresholds into consideration, for example vehicle speeds, to determine whether to restrict, suppress, or disable components. *Id.* at 17:58–21:6. For example, if the system senses a high vehicle speed it may disable the telephone entirely, but if it senses a slower vehicle speed it may enable the telephone's operation. *See id.* at 20:23–31.

D. SUMMARY OF ASSERTED GROUNDS FOR UNPATENTABILITY

Petitioner asserts the following grounds for the unpatentability of claims 1–4 and 7–10 of the '994 patent:

Ground	Claims Challenged	35 U.S.C. § ¹	Reference(s)/Basis
1	1–4, 7–9	103	Tan ²
2	1–4, 7–9	103	Boies ³
3	2, 7, 8	103	Tan, Shuman, ⁴ Behr ⁵
4	10	103	Hardouin ⁶

See Pet. 2–3.

¹ The '994 patent has an uncontested priority date of October 24, 2001, which is before AIA revisions to 35 U.S.C. § 103 took effect on March 16, 2013. 35 U.S.C. § 100 (note). Therefore, pre-AIA § 103(a) applies. Our decision is not impacted, however, by which version of the statute applies.

² US 6,574,531 B2, issued June 3, 2003 (Ex. 1025, “Tan”).

³ US 6,266,589 B1, issued July 24, 2001 (Ex. 1026, “Boies”).

⁴ US 6,161,071, issued Dec. 12, 2000 (Ex. 1029, “Shuman”).

⁵ US 5,808,566, issued Sept. 15, 1998 (Ex. 1012, “Behr”).

⁶ US 6,311,078 B1, issued Oct. 30, 2001 (Ex. 1027, “Hardouin”).

In support of the grounds for unpatentability Petitioner submits, *inter alia*, the Declaration of Scott Andrews (Ex. 1003). At this stage of the proceeding, and in the absence of evidence to the contrary, we find Mr. Andrews competent to testify as to the perspective and understanding of the person of ordinary skill in the art, as defined herein. *See infra* Section II.A; *see also* (describing this witness's background, qualifications, and considered materials) Ex. 1003 ¶¶ 5–22, 28, 31, 35, 39–41; Ex. 1004.

At this stage of the proceeding, Patent Owner has not similarly supported its preliminary arguments with witness opinion testimony; it was not required to do so.

We review Petitioner's asserted prior art below.

E. TAN

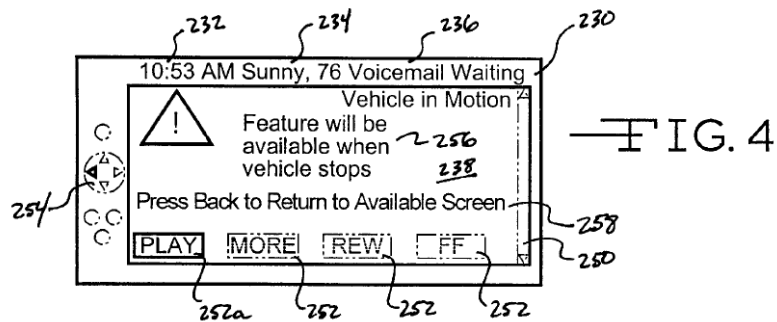
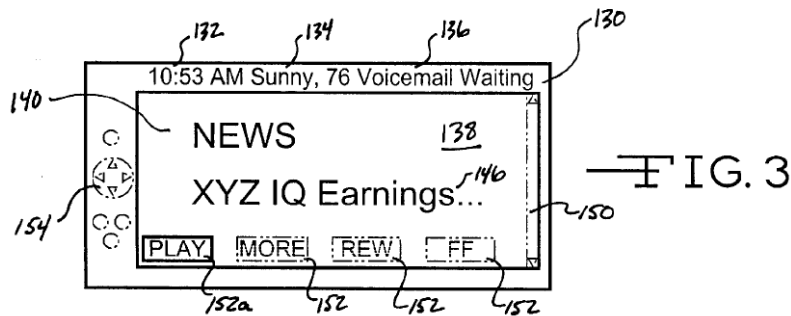
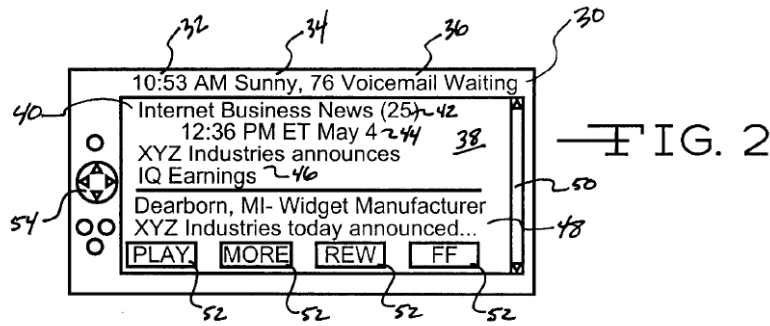
Tan issued as U.S. Patent 6,574,531 on June 3, 2003, from U.S. Application 09/915,124, which was filed on July 25, 2001. Ex. 1025, codes (45), (21), (22). There is no dispute at this stage of the proceeding that Tan is prior art. *See generally* Prelim. Resp.

Tan's Abstract summarizes its disclosed invention as follows:

A vehicle computer system and method of providing information to an occupant of a vehicle that minimizes complete feature lock out are provided. The operating system of the computer is adapted to selectively display full and limited functionality versions of a particular screen, preferably based on whether the vehicle is in motion. A text-to-speech engine can automatically generate audio based on a particular screen once motion is detected. The availability of a limited functionality version of the screen and audio, either independently or together, allow a vehicle occupant to retrieve information from the computer system without distraction.

Ex. 1025, Abstract.

Tan's Figures 2–4, reproduced below, illustrate this concept of limiting display and functionality of screen-enabled systems of a vehicle based on detecting vehicle motion:



Figures 2–4 show three views of a screen of a device in a vehicle. *See, e.g., id.* at 1:43–62, 2:39–41, 4:13–15. Tan states that “FIG. 2 is a schematic view of a full functionality version of an Internet news screen in accordance with the present invention,” “FIG. 3 is a schematic of a limited functionality version of an Internet news screen in accordance with the present invention,” and “FIG. 4 is a schematic of a common screen in accordance with the

present invention.” *Id.* at 2:19–26. As these quoted portions of Tan indicate, Figures 2, 3, and 4 are three versions of the same in-vehicle computer system 10 having screen 14 for input (via touchscreen) and display, as well as hard buttons for input (*see also* Fig. 1), that illustrate decreasing degrees of information display and user-accessibility. *Id.* at 2:39–5:7.

Figure 2 shows a first, full functionality version 30 of the system where full information is displayed and full user access to all features and functions is provided. *Id.* at 4:10–33. Figure 2 shows that the device’s display shows internet-derived news 40 (and details 42, 44, 46, 48, 48), a clock 32, weather summary 34, voicemail indicator 36, an active scroll bar 50 for screen navigation, active touch buttons 52, and an active directional navigator 54. *Id.*

Figure 3 shows a second, alternate, limited functionality version 130 of this system where some display and information is maintained, e.g., clock 132, weather summary 134, and voicemail indicator 136; some other display and information is modified to be abbreviated or truncated, e.g., internet news 140, with details omitted; and some functionality is unavailable, e.g., scroll bar 150, touch buttons 152, navigator 154, while some remains available, e.g., play touchscreen button 152a. *Id.* at 4:35–60.

Figure 4 shows a third, less-functional, common screen 230 to which the system defaults when the limited functionality version shown in Figure 3 is unavailable. *Id.* at 4:61–5:7. The common screen 230 preferably includes a notice 256 to inform the vehicle occupant that they have reached a point at which even limited functionality is not available; the notice states “Vehicle

in Motion” and “Feature will be available when vehicle stops.” *Id.* at 5:1–7, Fig. 4.

Tan discloses that its computer system includes electronics, such as a navigation system, internet connectivity, integrated mobile phone, and radio. *Id.* at 2:39–56, 3:13–36. Tan explains how its operating system functions to select the aforementioned versions of its display and functionality, as follows:

[T]he operating system selectively chooses which version of the screen to display based on whether the vehicle is in motion. The operating system can receive data related to vehicle motion from a motion sensor placed appropriately in the vehicle, as described above. Based on this data, the operating system preferably chooses between the two alternate versions of the screen. In the preferred method, the operating system displays the full functionality version of the screen if the vehicle is not in motion, giving an occupant of the vehicle access to all information associated with the screen. However, if the vehicle is in motion, the operating system displays the limited functionality version of the screen. This method restricts the ability of a vehicle occupant to interact with the computer system, but avoids complete lock-out of features. Of course, the application and/or computer processor can select the appropriate screen based on vehicle motion, if appropriate.

It is preferred that the sensor continually monitor for motion of the vehicle. This continuous monitoring allows the operating system to switch from the full functionality version of the screen to the limited functionality version as soon as vehicle motion is detected.

Id. at 5:16–38.

F. BOIES

Boies issued as U.S. Patent 6,266,589 on July 24, 2001, from U.S. Application 09/443,388, which was filed on November 19, 1999. Ex. 1026,

codes (45), (21), (22). There is no dispute at this stage of the proceeding that Boies is prior art. *See generally* Prelim. Resp.

Boies summarizes its disclosed invention at its Abstract, which states:

A motor vehicle safety system determines the state of automotive electronic devices as a function of speed to minimize potential distractions to the driver. Vehicle speed data is supplied to a rules based system which applies rules to determine what functions, at a given speed, within the respective electronic devices are available.

Ex. 1026, Abstract.

Boies illustrates such a system with a block diagram and a flowchart at Figures 1 and 2, which are reproduced below, side-by-side:

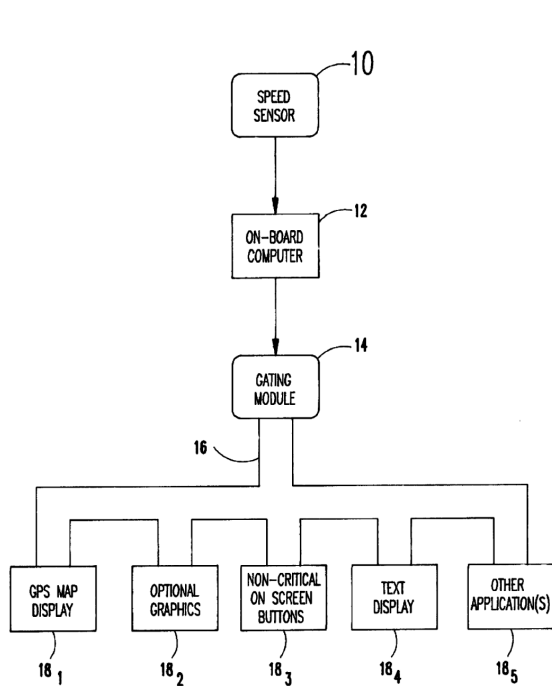


FIG. 1

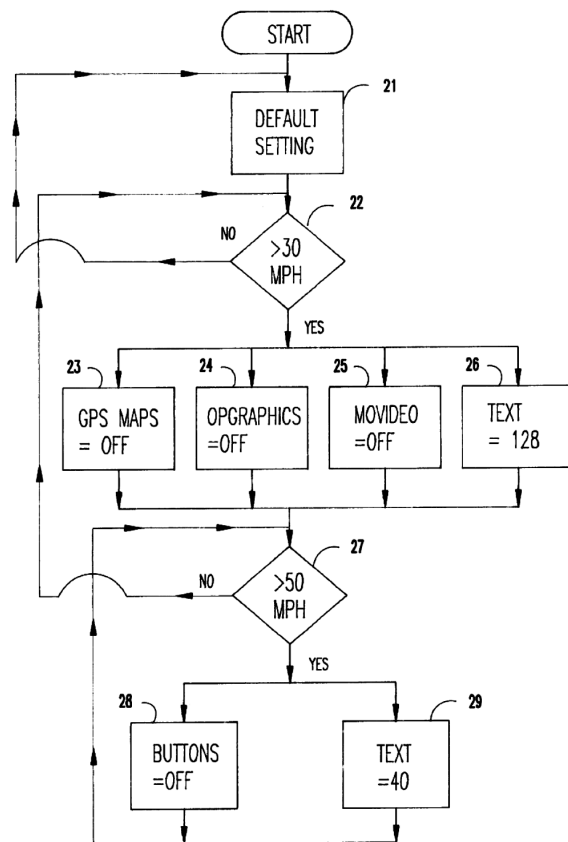


FIG. 2

Boies states that “FIG. 1 is a high level block diagram showing the basic components of a preferred embodiment of the invention; and FIG. 2 is a flow diagram showing the logic of the gating module of the system shown in FIG. 1.” *Id.* at 1:59–62.

Figure 1 (prior page, above-left) shows the connections, data flow, and functionality control by and between a vehicle’s speed sensor 10, on-board computer 12, gating module 14, and several electronic devices, including GPS map display 18₁, optional graphics 18₂, non-critical on screen buttons 18₃, text display 18₄, and other applications 18₅. *Id.* at 1:66–2:52. In terms of such “other applications,” Boies discloses FM and internet radio, on-board cellular telephone, HVAC environmental controls, digital compass, and other devices. *Id.* at 1:13–17, 5:31–4:14. Boies discloses that “the gating module 14 is a rule based system which determines the state, as a function of vehicle speed, of devices that may have potentially distracting functions” and that, “[f]or example, depending on the speed [of the vehicle], the gating module 14 may first determine whether particular electronic devices should be enabled or disabled and, if enabled, what portion of the full functionality can be provided to the driver as a function of automobile speed.” *Id.* at 2:11–29.

Boies includes “[a]n example of the rules applied by the gating module 14 [a]s illustrated in the following pseudocode:”

```
If speed>30
{
    GPSMaps=off;
    OptionalGraphics=off;
    MotionVideo=off;
    MaxText=128;
}

If speed>50
{
    Non-CriticalOnScreenButtons=off;
    MaxText=40;
}
```

Id. at 2:37–53.

Figure 2 (second prior page, above-right) shows how Boies system implements such pseudocode and illustrates that, once the vehicle is powered up:

Vehicle speed is then monitored, preferably in real time, by gating module 14. A test is made in decision block 22 to determine if the speed is greater than 30 mph. If not, the process loops back to function block 21, where the default settings are maintained. If the speed exceeds 30 mph, the GPS map display flag is turned to “off” in function block 23, the optional graphics display flag is turned to “off” in function block 24, the motion video (if any) flag is turned to “off” in function block 25, and the maximum text displayed flag is turned to “128” in function block 26. Flags may contain multiple bits to allow for the setting of multiple values rather than simply on or off. Thus, for example, if the text function has a two bit flag and both bits are set to “1”, then there may, for example, be no limitation to the text display. If one bit is set to “1” and the other bit set “0”, then the text display, for example, may be limited to the information content of 128 bits

(or some other appropriate value). If both bits are set, for example, to “0”, then the text display is limited to the information content of 40 bits (or some other appropriate value).

The next step in the process is to determine in decision block 27 whether the speed exceeds 50 mph. If not, the process loops back to decision block 22 to determine if the speed exceeds 30 mph, and the logic of decision block 22 is again executed, as discussed above. If the test in decision block 27 indicates that the speed exceeds 50 mph, the non-critical screen buttons flag is set to “off” in function block 28, and the maximum text displayed flag is set to “40” in function block 29. The process then loops back to decision block 22 to maintain this state until the speed drops below 50 mph. Upon detecting that the speed has decreased below the thresholds of 50 (as used in this example), the process loops back to decision block 22 to determine if the speed exceeds 30 mph, and the logic of decision block 22 is again executed, as discussed above.

Id. at 2:61–3:28. Thus, Boies discloses a sensed-speed-based control system that restricts or suppresses the functionality and display of several devices in a vehicle, where one level of suppression (none or default) is instituted at a first speed threshold, a second level of suppression (higher suppression) is instituted at a second speed threshold, and a third level of suppression (highest or full suppression) is instituted at a third speed threshold. *Id.* Boies describes how these various levels of suppression may be instituted in devices such as a radio or a cell phone. *Id.* at 3:29–4:14.

G. SHUMAN

Shuman issued as U.S. Patent 6,161,071 on December 12, 2000, from U.S. Application 09/268,162, which was filed on March 12, 1999. Ex. 1029, codes [45], [21], [22]. There is no dispute at this stage of the proceeding that Shuman is prior art. *See generally* Prelim. Resp.

Shuman summarizes its disclosed invention in its Abstract, as follows:

A computing architecture for a motorized land-based vehicle is disclosed. The computing architecture includes a data network comprised of a plurality of interconnected processors, a first group of sensors responsive to environmental conditions around the vehicle, a second group of sensors responsive to the vehicle's hardware systems, and a map database containing data that represent geographic features in the geographic area around the vehicle. A vehicle-environment modeling program, executed on the data network, uses the outputs from the first and second groups of sensors and the map database to provide and continuously update a data model that represents the vehicle and the environmental around the vehicle, including geographic features, conditions, structures, objects and obstacles around the vehicle. Vehicle operations programming applications, executed on the data network, use the data model to determine desired vehicle operation in the context of the vehicle's environment. A driver interface receives the vehicle driver's input. Vehicle control programming, executed on the data network, receives outputs from the vehicle operations programming applications and the driver interface, determines a resolved operation for the vehicle's hardware systems and provides output commands indicative, thereof. The vehicle operations programming applications may include adaptive cruise control, automated mayday, and obstacle and collision warning systems, among, others. Also disclosed is a new computing architecture that organizes the applications and systems in the vehicle into two groups: driver assistance systems and mobile services and information systems. Also disclosed is a drive recorder that maintains records of the statuses of all vehicle systems and of the driver.

Ex. 1029, Abstract. Further discussing the "group of sensors" identified above, Shuman discloses that sensor devices 202 may include those sensing the vehicle's physical and geographic position, orientation, altitude, global positioning system information, gyroscopic information, road conditions such as moisture and traction, weather and meteorological conditions such as

temperature, precipitation, barometric pressure, ambient and external light and visibility. *Id.* at 8:43–63.

H. BEHR

Behr issued as U.S. Patent 5,808,566 on September 15, 1998, from U.S. Application 494,198, which was filed on June 23, 1995. Ex. 1012, codes [45], [21], [22]. There is no dispute at this stage of the proceeding that Behr is prior art. *See generally* Prelim. Resp.

Behr summarizes its disclosed invention in its Abstract, which states, in part, “[t]he invention provides a method and system for providing route guidance and other information from a base unit to a remote unit in response to a request from the remote unit.” Ex. 1012, Abstract. Behr explains that the “route guidance” may include information about roads as navigation instructions, that information communication may be by, for example, cellular telephone or radio frequency, and that the database of geographic data need not be “on-board.” *Id.* at 3:29–30, 4:32–34, 5:16–27, 6:46–48. Behr provides several examples of a “remote unit” for use in such a system, such as a computer, PDA (e.g., Apple Newton), and a pager, which may be in a car, for example. *Id.* at 7:20–55, 11:6–9. Behr states that, “[i]n determining the route, the route calculator 66 preferably takes into account routing restrictions such as toll road avoidance, turn restrictions at a specified time of day, and other restrictions. Such routing restrictions may be specified by an operator at the base unit 12 in response to a temporary condition or may be added to the map database 72 when the restrictions become nationally available.” *Id.* at 10:29–35.

I. HARDOUIN

Hardouin issued as U.S. Patent 6,311,078 on October 30, 2001, from U.S. Application 09/196,542, which was filed on November 20, 1998. Ex. 1027, codes (45), (21), (22). There is no dispute at this stage of the proceeding that Hardouin is prior art. *See generally* Prelim. Resp.

The title of Hardouin is “Automatic Shutoff for Wireless Endpoints in Motion,” and it summarizes its disclosed invention at its Abstract, as follows:

A wireless telephone does not generate an alerting signal if the speed at which the wireless telephone is moving exceeds a predefined speed when an incoming call is received. If an alerting signal is not generated for an incoming call, the wireless telephone transmits a message back to the calling party informing them that they have contacted the wireless telephone and may leave either a voice or data message. The caller can then either leave a voice message or touch tone in the caller's telephone number. Further, the wireless telephone can inhibit the origination of calls from the wireless telephone if the speed of the wireless telephone exceeds the predefined speed. In addition, if the speed has not been equal or less than the predefined speed for a predefined amount of time, call originations and alerting signals are blocked.

Ex. 1027, code (54), Abstract. Hardouin explains that this system is for preventing driver distraction by a wireless telephone. *Id.* at 1:10–16, 1:24–46.

Hardouin discloses that a control unit of a wireless telephone detects speed, e.g., of an automobile in which the telephone is traveling, via a GPS device or via the automobile's speedometer. *Id.* at 1:57–2:15. If the control unit determines that this speed is above some predefined speed it will control the telephone so as not to alert the user/driver via audio or vibration output and does not give the user/driver access to recorded information on the

telephone or the ability to originate a call until the detected movement is detected to be at a rate below the predefined speed (e.g., 5 mph) for some predefined amount of time (e.g., 30 seconds). *Id.* at 2:4–38.

II. DISCUSSION

A. LEVEL OF ORDINARY SKILL IN THE ART

In determining the level of skill in the art, we consider the type of problems encountered in the art, the prior art solutions to those problems, the rapidity with which innovations are made, the sophistication of the technology, and the educational level of active workers in the field. *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986).

Petitioner asserts:

An ordinary artisan would have been a person having, as of October 24, 2001, a Bachelor’s degree in Electrical Engineering, Mechanical Engineering, Computer Engineering, or Computer Science, or an equivalent degree with at least two years of experience in electronic user interface systems and vehicle sensor systems or related technologies. Additional education may substitute for lesser work experience and vice-versa. (Ex.1003, ¶40.)

Pet. 3 (citing Andrews Declaration). Patent Owner does not address the definition of the person of ordinary skill in the art, either to contest Petitioner’s proposal or to offer a different definition. *See generally* Prelim. Resp.

For the purposes of this Institution Decision, we accept Petitioner’s unopposed, proposed definition of the person of ordinary skill in the art (or ordinarily skilled artisan), which appears to be consistent with the level of skill in the art reflected in the prior art of record and the disclosure of the ’994 patent. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir.

2001) (“the prior art itself [may] reflect[] an appropriate level” as evidence of the ordinary level of skill in the art) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

B. CLAIM CONSTRUCTION

“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy.’” *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

Petitioner asserts “that the limitations of the claims from the ‘994 Patent at issue in this IPR can be understood based on their ordinary and customary meaning as understood by one of ordinary skill in the art, and therefore no claim construction is necessary at this time.” Pet. 8. However, Petitioner does discuss a dispute in the related litigation concerning the meaning of the language of dependent claim 2 directed to a “communication device including *at least* a pager, a telephone, a global location sensor, a temporal sensor, an optical sensor, a heading sensor, a bearing sensor, and an altitude sensor.” *Id.* (citing Ex. 1001, 23:1–26). Petitioner explains that there is some ambiguity whether the language “at least” means that each of the subsequently listed devices are required or only one of those devices is required. *Id.* at 8–9; *see also* Ex. 1033 (email from related district court litigation addressing claim 2’s meaning). In view of this ambiguity, Petitioner explains it has challenged claim 2 here under Grounds 1 and 2 as if the respective language means “at least one of” and under Ground 3 as if the language means “each of.” Pet. 8–9.

Patent Owner does not expressly assert that any claim language requires express construction by the Board. *See generally* Prelim. Resp.

At this stage of the proceeding, we do not find it necessary to construe any claim language. The language of the claims appears to be readily understandable on its face. We encourage the parties to address the meaning and scope of claim 2 at trial (and also claims 7 and 8, which depend therefrom). Moreover, if any claim language is in dispute at trial, we encourage the parties to further develop the record thereon.

C. APPLICABLE LEGAL STANDARDS

“In an IPR, the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden of persuasion never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review).

Regarding obviousness, the Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), reaffirmed the framework for determining obviousness set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). The *KSR* Court summarized the four factual inquiries set forth in *Graham* (383 U.S. at 17–18) that are applied in determining whether a claim is unpatentable as obvious under 35 U.S.C. § 103(a) as follows:

(1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the

level of ordinary skill in the art;⁷ and (4) considering objective evidence indicating obviousness or non-obviousness.⁸ *KSR*, 550 U.S. at 406.

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416. “[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious,” the answer depends on “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

With these standards in mind, and in view of the definition of the ordinarily skilled artisan and our understanding of the asserted prior art, we address Petitioner’s challenges below.

D. PETITIONER’S PATENTABILITY CHALLENGES

As summarized above, Petitioner asserts four grounds for unpatentability of the claims of the ’994 patent. *See supra* Section I.D; *see also* Pet. 2–3. We review Petitioner’s challenges and Patent Owner’s arguments below.

1. *Obviousness of Claims 1–4, 7–9 over Tan (Ground 1)*

Petitioner’s Ground 1 addresses independent claims 1 and 9, and dependent claims 2–4, 7, and 8, and asserts that each would have been obvious over Tan. *See* Pet. 9, *et seq.*

Petitioner begins by discussing Tan and how it teaches each limitation of independent claim 1. *Id.* at 13–27 (citing Ex. 1003 ¶¶ 95–100, 102, 128–132, 134–138; Ex. 1025, Abstract, 1:43–61, 2:39–3:4, 3:24–33, 4:4–9, 4:13–

⁷ *See supra* Section II.A.

⁸ At this stage of the proceeding, there is no evidence pertaining to objective indicia of non-obviousness. *See* Prelim. Resp.

29, 4:34–49, 4:61–5:4, 5:16–32, Figs. 1–4). To summarize, Petitioner points to Tan’s vehicle computer system (*see supra* Section I.E, discussing Tan)—which runs software applications for navigation and news and a mobile phone, and is adapted to selectively display full and limited functionality versions of a device, such as internet news display and a mobile phone, based on input from a sensor that detects whether the vehicle is in motion, to mitigate driver distraction—as teaching the claimed telematics device, sensor, controller, and functionality of claim 1. Pet. 13–27.

Regarding Tan and Petitioner’s Grounds 1 and 3, Patent Owner addresses only independent claim 1’s element 1.3 (and that claim 9 has a similar clause), which is directed to the functionality of a controller in permitting or restricting driver access to, and output from the claim’s recited telematic device based on determining whether a sensed condition is “within a threshold.” Prelim. Resp. 39–49; *see also* Ex. 1001, 22:42–67 (claim 1). Patent Owner’s position is that Tan’s binary determination of whether a vehicle is or is not in motion is not the same as the claimed “within a threshold.” *See* Prelim. Resp. 39–49, 52. Patent Owner argues that mere motion does not equate to speed and a speed threshold. We are not persuaded by this argument at this stage of the proceeding.

As asserted by Petitioner, “mere motion” (as such is framed by Patent Owner) indicates “a speed greater than 0 MPH.” Pet. 26. Therefore, sensing such mere motion would be detecting that a vehicle has exceeded a speed threshold of 0 mph. Petitioner’s position is sufficiently persuasive at this stage of the proceeding.

Regarding claims 2–4 and 7–9 (concerning claim 2, this ground assumes the claim requires *at least one* of the recited communication

devices, *not all*), Petitioner similarly discusses how Tan teaches the recited subject matter. *Id.* at 27–34 (citing, *inter alia*, Ex. 1003 ¶¶ 85–87, 128–139, 141–162, 165–169, 171–175, 177–179, 181–184, 186–190; Ex. 1025, Abstract, 1:46–61, 2:39–56, 3:13–55, 4:4–60, 5:16–32, Figs. 2, 3, 4). Patent Owner does not address these assertions. *See generally* Prelim. Resp.

Patent Owner also argues that Petitioner’s witness, Mr. Andrews, may not be credible because of some past relationship with Petitioner or its related companies. Prelim. Resp. 50–52. Patent Owner offers mere unsubstantiated allegations and cites no persuasive evidence that causes us to question Mr. Andrews’s credibility at this stage of the proceeding.

At this stage of the proceeding, we find Petitioner has sufficiently explained how and why the cited prior art teaches or suggests the limitations of claims 1–4 and 7–9 and that, based on the preliminary record, Petitioner sufficiently shows that there is a reasonable likelihood that it would prevail at trial in establishing that these claims would have been obvious over Tan.

2. *Obviousness of Claims 1–4, 7–9 over Boies (Ground 2)*

Under Ground 2, Petitioner asserts that the ’994 patent’s claims 1–4 and 7–9 would have been obvious over Boies. Pet. 36–60.

Petitioner begins with independent claim 1 and addresses how Boies teaches each limitation thereof. *Id.* at 36–49 (citing Ex. 1003 ¶¶ 104–107, 191–198, 200–207, 209–215, 217–222; Ex. 1026, Abstract, 1:12–19, 1:35–42, 2:5–3:24, 4:4–14, Figs. 1, 2). To summarize, Petitioner points to Boies’s motor vehicle safety system (*see supra* Section I.F, discussing Boies)—which uses an on-board computer and a speed sensor to determine the state of the vehicle’s electronic devices, such as GPS and cellular telephone, and control their functionality, output, and interactivity with a driver as a

function of vehicle speed to minimize driver distractions—as teaching the claimed telematics device, sensor, controller, and functionality of claim 1. Pet. 39–49. Petitioner similarly addressed claims 2–4 and 7–9 (again, assuming claim 2 requires *at least one* of the recited communication devices, *not all*). *Id.* at 50–60.

Patent Owner presents no arguments directed to Ground 2 or Boies, as asserted by Petitioner. *See generally* Prelim. Resp.

At this stage of the proceeding, we find Petitioner has sufficiently explained how and why the cited prior art teaches or suggests the limitations of claims 1–4 and 7–9 and that, based on the preliminary record, Petitioner sufficiently shows that there is a reasonable likelihood that it would prevail at trial in establishing that these claims would have been obvious over Boies.

3. *Claims 2, 7, 8, 10 and Grounds 3 and 4*

Claims 2, 7, and 8 are addressed by Petitioner under Ground 3 as allegedly being obvious over Tan, Shuman, and Behr. Pet. 60–69. Under Ground 3, Petitioner assumes that claim 2, from which claims 7 and 8 depend, requires *all* of the recited communication devices, *not merely at least one* (as contrasted with Grounds 1 and 2). *Id.* at 61. As discussed above at Section II.B, it is unclear at this stage whether the parties disagree as to the scope of claim 2. We decline to address the merits of Ground 3 because we have already determined that Petitioner has met the threshold for institution of trial in this proceeding under Grounds 1 and 2. *See SAS*, 138 S. Ct. at 1359–60. The parties should not interpret this, however, to mean that we will not address this ground in a final decision.

Under Ground 4, Petitioner asserts that independent claim 10 would have been obvious over Hardouin. Pet. 69–80. As with Ground 3, we need

not address the merits of Ground 4 here because we have already determined that Petitioner has satisfied the threshold for institution under Grounds 1 and 2. However, we find it worth noting that Patent Owner argues that Hardouin fails to teach claim elements 10.2 and 10.3 because “completely turning OFF the output of a device (*i.e.*, no output at all) is fundamentally different than providing a modified partially functional output (in a second format),” and claim 10 requires that a controller prevent an output by a device in an original format and provide output in a different format, based on sensed threshold conditions (such as speed). Prelim. Resp. 54; Ex. 1001, 24:43–58. We find, at least preliminarily, that this argument may have some merit.

As discussed above at Section I.I, our understanding of Hardouin’s disclosure is that its system senses a vehicle’s speed and, based thereon, inhibits the driver’s use of a wireless telephone, providing *no* related output to the driver, but, instead, *informs a caller* that the phone cannot be answered and to leave a message. *See, e.g.*, Ex. 1027, Abstract, 1:25–33, 2:4–38. It appears that, rather than provide a differently formatted output to the driver, as required by claim 10, Hardouin prevents any output at all to the driver (“[i]f control unit 101 determines that the speed is above a predefined amount, it does not alert the user of the wireless telephone”—*id.* at 2:17–20) and, thus, may not teach the claim element, as argued by Patent Owner.

The parties may address at trial these noted concerns regarding Grounds 3 and 4.

E. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314(a)

1. *Background and Legal Standards*

Under § 314(a), the Director possesses “broad discretion” in deciding whether to institute an *inter partes* review. *See* 35 U.S.C. § 314(a); *Saint Regis Mohawk Tribe v. Mylan Pharm. Inc.*, 896 F.3d 1322, 1327 (Fed. Cir. 2018). The Board decides whether to institute an *inter partes* review on the Director’s behalf. 37 C.F.R. § 42.4(a) (2021).

Patent Owner argues that we should exercise discretion under § 314(a) to deny institution of an *inter partes* review. *See* Prelim. Resp. 9–13, 21–34; Prelim. Sur-Reply. Petitioner argues that we should decline to exercise our discretion under § 314(a) to deny institution. *See* Prelim. Reply. For the reasons explained below, under the circumstances here, we decline to exercise our discretion under § 314(a) to deny institution.

When deciding whether to exercise discretion under § 314(a) to deny institution, the Board has considered the status of litigation involving the parties in light of the AIA’s objective “to provide an effective and efficient alternative to district court litigation.” *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 12, 19–20 (PTAB Sept. 12, 2018) (precedential) (quoting *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16–17 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i)).

In *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”), the Board set forth the following nonexclusive factors to consider when determining whether to exercise discretion under § 314(a) to deny institution due to the advanced state of parallel litigation:

- (1) whether the court granted a stay or evidence exists that one may be granted if the Board institutes a trial;
- (2) the proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
- (3) the investment in the parallel litigation by the court and the parties;
- (4) the overlap in the issues raised by the petition and the issues in the parallel litigation;
- (5) whether the petitioner and the defendant in the parallel litigation are the same party; and
- (6) other circumstances that impact the Board's exercise of discretion, including the merits.

These factors, considered below, “relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* at 6. Further, *Fintiv* instructs that the Board should take “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.* (citing PTAB Consolidated Trial Practice Guide at 58 (Nov. 2019)⁹).

As identified above in this Decision at Section I.B, the related, parallel proceeding at issue here is *Safe Driving Technologies LLC v. Ford Motor Company*, Case 1:21-cv-00064-MN in the U.S. District Court for the District of Delaware. *See, e.g.*, Ex. 2019 (original complaint dated January 21, 2021).

⁹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

2. *Analysis Under Section 314(a)*

*Factor 1: Whether a Stay
has Been or is Likely to be Granted*

The parties do not dispute that there is currently no stay in the related district court litigation, either requested or granted. Prelim. Resp. 22; Prelim. Reply 1–2. Petitioner indicates that, if trial is instituted here, the district court would likely grant a stay and that such would be warranted. Prelim. Reply 1–2. Petitioner’s assertion aside, we will not speculate as to whether the related district court litigation will be stayed, as the evidence is inconclusive concerning this factor.

Accordingly, we weigh this factor as neutral as to whether to exercise our discretion to deny institution.

*Factor 2: Proximity of the Court’s Trial Date
to the Board’s Final Written Decision*

The statutory deadline for the issuance of a final written decision in this proceeding will be one year from the date of institution, if trial is instituted. 35 U.S.C. § 316(a)(11). Based upon the preliminary filings in this proceeding, the due date for our decision on institution is approximately February 16, 2022, meaning a final written decision would be due in mid-February 2023, at the latest. 35 U.S.C. § 314(b)(1). The record includes a first scheduling order (Ex. 1028) and a second, modified scheduling order (Ex. 1035) from the related district court litigation, each of which sets a jury trial date of February 21, 2023. *See* Prelim. Resp. 24–25. Thus, a jury trial is scheduled to occur in the related district court litigation after a final written decision would be statutorily due in this *inter partes* review, if the trial begins as scheduled (however, as the scheduling order has been

modified at least once, it appears that the district court is not opposed to such modifications).

We find these facts under this factor weigh in favor of not exercising discretion to deny institution.

Factor 3: Investment in the Parallel Litigation

If, at the time of the institution decision, the district court has issued substantive orders related to the challenged patent, such as a claim construction order, this fact weighs in favor of discretionary denial. *See Fintiv* at 9–10. On the other hand, if the district court has not issued such orders, this fact weighs against discretionary denial. *Id.* at 10.

The evidence of record indicates that the related district court litigation has not progressed as far as the entry of a claim construction order, which is not expected until sometime after the claim construction hearing scheduled for August 19, 2022. Ex. 1035. Patent Owner does not argue that any substantial investment has yet been made in the related district court litigation, but alludes to investments yet to come. Prelim. Resp. 26–27. Petitioner, on the other hand, points out that the institution of trial in this proceeding will occur before claim construction, the close of fact discovery, and the beginning of expert discovery. Prelim. Reply 3–4. The facts here indicate an insubstantial investment in the related district court litigation by the parties and court.

Further, *Fintiv* provides guidance on how the timing of various events can impact Factor 3:

As a matter of petition timing, notwithstanding that a defendant has one year to file a petition, it may impose unfair costs to a patent owner if the petitioner, faced with the prospect of a looming trial date, waits until the district court trial has progressed significantly before filing a petition at the Office.

Fintiv at 11 (footnote omitted). However, “it is often reasonable for a petitioner to wait to file its petition until it learns which claims are being asserted against it in the parallel proceeding.” *Id.* (footnote omitted).

Accordingly, a petitioner should act expeditiously once the patent owner has identified the claims being asserted against it so that the petitioner can file a petition challenging all asserted claims—if it chooses to do so.

Here, Patent Owner argues that Petitioner waited four months to file the Petition after knowing that the related district court litigation “may go to trial as early as January 23, 2023 (Ex. 2004 and 2005 at page 12), as is common in Delaware.” Prelim. Resp. 26. Petitioner argues that it “waited until the [allegedly infringed] claims were identified [in the related district court litigation] before filing its IPRs, which it [then] did promptly.” Prelim. Reply. 3. In this regard, Petitioner indicates that Patent Owner’s infringement positions were identified on July 12, 2021 (Ex. 1036) and the Petition was filed here on August 3, 2021, i.e., mere weeks thereafter.¹⁰ *Id.* The facts indicate Petitioner was diligent in filing the Petition after Patent Owner identified its asserted claims in the related district court litigation.

We find the facts under this factor weigh in favor of not exercising discretion to deny institution.

*Factor 4: Overlap in Issues Raised by the Petition
and in the Parallel Litigation*

“[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” *Fintiv* at 12 (footnote omitted). “Conversely,

¹⁰ An original Petition (Paper 2) was filed on this date. The Petition (Paper 4) addressed herein is an authorized replacement version correcting typographical errors, which was accorded the original’s filing date.

if the petition includes materially different grounds, arguments, and/or evidence than those presented in the district court, this fact has tended to weigh against exercising discretion to deny institution under *NHK*.” *Id.* at 12–13 (footnote omitted).

Patent Owner argues that Petitioner relies on the same primary references (Tan and Boies) and substantially the same arguments for invalidity in the related district court litigation as for unpatentability here. Prelim. Resp. 27–28. However, Patent Owner concedes some differences, stating that the invalidity contentions in the related district court litigation “abandon several positions with respect to certain prior art references *Shuman, Behr* and *Hardouin*” as presented in Grounds 3 and 4 here, and that “an additional contention” is made by Petitioner in the related district court litigation compared to the unpatentability grounds here. *Id.* at 28. Petitioner does not address this factor. *See* Prelim. Reply.

We agree with Patent Owner that there is some overlap in issues here. But, Patent Owner also concedes that there are differences, too. We note that Petitioner does not assert anticipation here, but does in the district court. Ex. 2006, 1–2. We note that Petitioner relies on fewer prior art references and combinations thereof here than in the district court. *See id.* at 3. And, apparently, Petitioner asserts certain prior art combinations here that it does not in the related district court litigation. Thus, in view of the unique facts here, we weigh this factor as neutral as to whether to exercise our discretion to deny institution.

*Factor 5: Are Petitioner and the Defendant
in the Parallel Litigation the Same Party?*

It is undisputed that Petitioner is the defendant and Patent Owner the plaintiff in the related district court litigation. *See* Ex. 2019; Prelim. Resp.

29; *see also* Prelim. Reply (Petitioner does not address this factor). Because of the evidence addressed here under *Fintiv* factors 2, 3, and 6, which supports that the related district court trial will occur after any final written decision in this proceeding, that there has not been substantial investment in that litigation, and, as discussed in detail above and noted below, that the merits of Petitioner's case here are strong, we find this fact weighs in favor of not exercising discretion to deny institution.

Factor 6: Other Circumstances, Including the Merits

Although we need not undertake a full merits analysis when evaluating *Fintiv* Factor 6, we consider the strengths and weaknesses of Petitioner's case, where stronger merits may weigh against discretionary denial and weaker merits may favor exercising discretion to deny institution. *Fintiv* at 15–16.

In our view, although some challenges of certain claims here may not be entirely persuasive at this point in the proceeding, concerning the majority of the challenged claims, as discussed above, we find Petitioner's showing to be strong on the merits, as contrasted with Patent Owner's weaker arguments on the merits at this stage. For example, as discussed above, we find the preliminary record supports Petitioner's assertions under Ground 1 that the claims would have been obvious over Tan and do not find Patent Owner's preliminary arguments over this ground persuasive, and we also find the preliminary record supports Petitioner's assertions under Ground 2 that the claims would have been obvious over Boies and Patent Owner has not addressed that ground. *See supra* Sections II.D.1 and II.D.2. Accordingly, we weigh this factor in favor of not exercising our discretion to deny institution.

3. *Holistic Assessment of Factors Under Section 314(a)*

After analyzing the *Fintiv* factors with a holistic view of whether the efficiency and integrity of the system are best served by denying or instituting review, we determine that the factors, on balance, weigh in favor of institution here. Hence, we do not exercise our discretion under § 314(a) to deny institution.

III. CONCLUSION

Petitioner demonstrates a reasonable likelihood of prevailing at trial in showing that at least some of claims 1–4 and 7–10 of the ’994 patent would have been obvious over the cited prior art. Our decision at this stage derives from our review of the preliminary record before us. In accordance with the Court’s decision in *SAS*, 138 S. Ct. at 1359–60, and Office Guidance,¹¹ we institute *inter partes* review of all challenged claims (1–4, 7–10) of the ’994 patent on all grounds asserted by Petitioner.¹²

This decision does not reflect a final determination on the patentability of the claims. No arguments from the Preliminary Response carry over to trial and any arguments not made in Patent Owner’s Response may be considered waived.¹³

¹¹ Guidance, *supra* at 2 (“If the PTAB institutes a trial, the PTAB will institute on all challenges raised in the petition.”).

¹² The Board must institute on all grounds and all claims if it does so for any. Patent Owner should address each ground at trial or else risk waiving arguments. In the interest of efficiency, Petitioner has the option to reconsider whether to pursue all grounds asserted in the Petition as the proceeding enters the trial stage.

¹³ See Consolidated Trial Practice Guide 52 (Nov. 2019) (“Once a trial is instituted, the Board may decline to consider arguments set forth in a preliminary response unless they are raised in the patent owner response.”); *In re NuVasive, Inc.*, 842 F.3d 1376, 1381 (Fed. Cir. 2016) (explaining that

ORDER

Accordingly, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314, an *inter partes* review of claims 1–4 and 7–10 of the '994 patent, in accordance with all grounds in the Petition, is hereby instituted; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review will commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

the patent owner waived an issue presented in its preliminary response that it failed to renew in its response during trial).

IPR2021-01340
Patent 9,713,994 B2

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