

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLKSWAGEN GROUP OF AMERICA, INC.,
Petitioner

v.

YECHEZKAL EVAN SPERO,
Patent Owner

Case IPR2023-00318
U.S. Patent No. 9,955,551

**PETITIONER’S REPLY TO PATENT OWNER’S PRELIMINARY
RESPONSE**

Mail Stop “PATENT BOARD”
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

I.	PATENT OWNER MISSTATED THAT PETITIONER DID NOT JUSTIFY MULTIPLE PETITIONS AND MISCHARACTERIZED THE BOARD’S GUIDANCE REGARDING MULTIPLE PETITIONS.....	1
II.	MATERIAL DISTINCTIONS EXIST BETWEEN THE PETITIONS.	2
III.	AS THE PETITIONS STATE, CONCERNS OF SERIAL PETITIONS ARE NOT AT PLAY HERE—THE <i>GENERAL PLASTIC</i> FACTORS SUPPORT INSTITUTING ALL THREE PETITIONS.	3

Petitioner’s three Petitions collectively challenge 78 claims of the ’551 patent. *See* Petition; IPR2023-00315, Pet.; IPR2023-00336, Pet. Instituting all three is justified to address the ’551 patent’s different claim groupings—as made clear in the Petitions as-filed. *See* -00315 Pet., 88; Pet., 85; -00336 Pet., 86-87.

The need for multiple petitions was also self-evident with the high number of claims, their verbosity, and the lack of claim overlap in the Petitions. Additionally, there was—and still is—uncertainty as to which claims will be asserted in district court. As the Petitions state, concerns of *serial* petitions addressed in *General Plastic* are not at play. *Compare Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, 15–18 (P.T.A.B. Sep. 6, 2017) (precedential) *with Microsoft Corp. v. IPA Techs., Inc.*, IPR2019-00810, Paper 12, 14 (P.T.A.B. Oct. 16, 2019). Patent Owner misstates that there is a lack of justification in the Petitions, mischaracterizes the Board’s guidance, and is wrong that the Petitions are redundant and place a substantial, unnecessary burden on the Board. *See* POPR, 36-38; Trial Practice Guide (Nov. 2019) (“TPG”), 56–61.

I. PATENT OWNER MISSTATED THAT PETITIONER DID NOT JUSTIFY MULTIPLE PETITIONS AND MISCHARACTERIZED THE BOARD’S GUIDANCE REGARDING MULTIPLE PETITIONS.

The Petitions satisfied the TPG’s permissive guidance on justifying multiple petitions in view of their different claim grouping. *See* -00315 Pet., 88; Pet., 85; -00336 Pet., 85-86; TPG, 56–61. While misstating that Petitioner was “require[d]”

to, yet failed to do so, POPR, 38, Patent Owner acknowledges that Petitioner explained the need for multiple petitions based on the different claim groupings. *Id.*, 37-38. Patent Owner’s implication that Petitioner was *required* to provide any *further* justification beyond its “succinct explanation” of differences between the Petitions (-00315 Pet., 88; Pet., 85; -00336 Pet., 86-87) is unsubstantiated and mischaracterizes the TPG. POPR, 36-38; TPG, 59–60.

II. MATERIAL DISTINCTIONS EXIST BETWEEN THE PETITIONS.

The Petitions address different material issues of the 78 claims. The originally issued claims are directed to a light fixture/illuminating device. But the claims added during reexamination relate to vehicle headlight systems.

Petition	Case No.	Claims	Subject Matter
1	IPR2023-00315	24-55	32 Reexam Claims
2	IPR2023-00318	56-87	32 Reexam Claims
3	IPR2023-00336	1–4, 7, 8, 10-13, 15-18	14 Original Claims

The -00336 Petition (original) claims have different feature combinations. For example, independent claims 1 and 8 recite specific algorithm details for identifying specific targets detected by a camera sensor, and claim 7 recites detecting glare on a person’s eyes. The -00315 and -00318 Petitions address different groups of 32 claims each, added during reexamination.

III. AS THE PETITIONS STATE, CONCERNS OF SERIAL PETITIONS ARE NOT AT PLAY HERE—THE *GENERAL PLASTIC* FACTORS SUPPORT INSTITUTING ALL THREE PETITIONS.

There is *no claim overlap* between the three Petitions. The Board routinely institutes multiple petitions addressing different claim groupings without overlap (*General Plastics* Factors 1 and 5). *See Signify Holding BV v. Lighting Sci. Grp. Corp.*, IPR2020-00753, Paper 16, 11–15 (P.T.A.B., Sept. 16, 2020); *Intel Corp. v. VLSI Tech.*, IPR2019-01199, Paper 19, 10–12 (P.T.A.B., Feb. 6, 2020).

Petitioner, of course, knew of the art in the second petition upon filing the first petition—the art addressing the 64 reexamination claims is the same. But the time elapsed to file all of the Petitions was *less than two weeks*—well before Patent Owner filed any preliminary responses, avoiding any “roadmapping” concerns. *See Lab. Corp. of Am. Holdings v. Ravgen, Inc.*, IPR2021-01054, Paper 11 at 28–32 (P.T.A.B., Nov. 5, 2021) (Factors 2–4). The short time between petitions will not hinder the Board’s ability to issue a final decision within one year of institution. (Factor 7). And there would be no excessive burden on the Board (or Patent Owner) in instituting three trials because of the similar art. (Factor 6). This similarity does not show redundancy due to the *different claim groupings* in each petition. The -00336 Petition uses different art because the original claims substantively differ in scope as discussed above. Accordingly, the Board should institute all three Petitions.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

/Jason A. Fitzsimmons/

Jason A. Fitzsimmons
Registration No. 65,367
Attorney for Petitioner

Date: May 9, 2023

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PETITIONER'S
REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE** were served electronically via e-mail on May 9, 2023, in their entirety on the following counsel of record for Patent Owner:

Sangeeta G. Shah (Lead Counsel)
Andrew B. Turner (Back-up Counsel)
Bernard P. Tomsa (Back-up Counsel)
BROOKS KUSHMAN P.C.
TRCH0115IPR@brookskushman.com

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

/Jason A. Fitzsimmons/

Jason A. Fitzsimmons
Registration No. 65,367
Attorney for Petitioner

Date: May 9, 2023

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600