

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 IPR2023-00335
U.S. Patent No. 10,894,503

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

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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Petitioner's three petitions collectively challenge all 70 claims of the '503 patent. *See* IPR2023-00197 Pet.; -00328 Pet.; -00335 Pet. Instituting all three is justified to address the '503 patent's different claim groupings—as made clear in the Petitions as-filed. *See* -00328 Pet., 145; -00335 Pet., 177.

The need for multiple petitions was also self-evident with the high number of claims, their verbosity, and the lack of claim overlap in petitions. Additionally, there was—and still is—uncertainty as to which claims will be asserted in district court. Concerns of *serial* petitions addressed in *General Plastic* are not at play here. *Compare Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 15–18 (P.T.A.B. Sept. 6, 2017) (precedential) *with Microsoft Corp. v. IPA Tech., Inc.*, IPR2019-00810, Paper No. 12 at 14 (P.T.A.B. Oct. 16, 2019); *Lab. Corp. of America Holdings v. Ravgen, Inc.*, IPR2021-01054, Paper 11 at 28–32 (P.T.A.B. Nov. 5, 2021). Patent Owner misstates 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* -00335 POPR, 57, 65–67; CTPG (Nov. 2019), 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 Trial Practice Guide's permissive guidance on justifying multiple petitions in view of their different claim grouping. *See* -00328

Pet., 145; -00335 Pet., 177; CTPG (Nov. 2019), 56–61. While misstating that Petitioner failed to do so, -00335 POPR, 57, 66, Patent Owner acknowledges that Petitioner explained the need for multiple petitions based on the different claim groupings. -00335 POPR, 65-66. Patent Owner’s implication that Petitioner was *required* to provide any *further* justification beyond its “succinct explanation” of differences between the petitions (-00328 Pet., 145; -00335 Pet., 177) is unsubstantiated and mischaracterizes the Trial Practice Guide. -00335 POPR, 57, 65–67; CTPG (Nov. 2019), 59–60.

II. MATERIAL DISTINCTIONS EXIST BETWEEN THE PETITIONS.

The petitions address different material issues of the 70 claims (groupings below). Independent claims 1, 20, 37, and 59 are directed to vehicle headlight systems. Independent claims 26 and 65 are directed to methods for generating a headlight beam. The system and method claims are in different statutory classes.

Petition	Case No.	Claims	Subject Matter
1	IPR2022-00197	20–25 and 59–64	System of Multi-Direct. Light Sources
2	IPR2023-00328	26–36 and 65–70	Method of Generating Light Beam
3	IPR2023-00335	1–19 and 37–58	System of Light Clusters

The -00328 Petition addresses the method claims. The system claims have different feature combinations—independent claims 20 and 59 recite “at least three directional light sources” aimed at “different” angles; independent claims 1 and 37

recite “a plurality of light clusters” without any light sources aimed at different angles. The -00197 Petition addresses the multi-directional light sources claims and the -00335 Petition addresses the light cluster claims.

III. 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 (Factors 1 and 5). *See Signify Holding B.V. v. Lighting Science Group Corp.*, IPR2020-00753, Paper 16 at 11–15 (P.T.A.B. Sept. 16, 2020); *Intel Corp. v. VLSI Technology LLC*, IPR2019-01199, Paper 19 at 10–12 (P.T.A.B. Feb. 6, 2020).

Petitioner, of course, knew of the art in the second and third petitions upon filing the first petition—the art in each petition is essentially the same. But the time elapsed to file all of the petitions was *less than one month*—well before Patent Owner filed any preliminary responses, avoiding any “roadmapping” concerns. *See Lab. Corp.*, Paper 11 at 29 (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—the petitions apply the same primary references (Beam and Karlsson) with common secondary references (Factor 6). This similarity does not show redundancy due to the *different claim groupings* in each petition. Accordingly, the Board should institute all three petitions.

Respectfully submitted,

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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:

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