IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:	Andrew William Wright
U.S. Patent No.:	10,192,369 Attorney Dock. No.: 36137-0026IP1/0026IP2/0026IP3
Issue Date:	April 25, 2017
Appl. Serial No.:	15/061,910
Filing Date:	March 4, 2016
Title:	METHOD AND SYSTEM FOR LOGGING VEHICLE BEHAVIOUR

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PETITIONER'S NOTICE RANKING PETITIONS AND EXPLAINING MATERIAL DIFFERENCES BETWEEN PETITIONS AGAINST U.S. PATENT NO. 10,192,369

United Services Automobile Association ("Petitioner" or "USAA") is concurrently filing three petitions (IPR2023-00768, IPR2023-00769, IPR2023-00770) challenging U.S. Patent No. 10,192,369 ("the '369 patent"). This paper provides "(1) a ranking of the petitions in the order in which [Petitioner] wishes the Board to consider the merits, … and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute….." Consolidated Trial Practice Guide (Nov. 2019), 59-61.

I. Ranking of Petitions

Although both petitions are meritorious and justified, USAA requests that the Board consider the petitions in the following order:

Rank	PTAB Case No.	Challenged Claims	Asserted Prior Art	Critical Date
1	IPR2023-00768 ("First Petition")	1-27	Curry, Rabu, Katayama, Tamir, Balachandran, Thompson2010, Willis, Berkobin	Dec. 15, 2010
2	IPR2023-00769 ("Second Petition")	1-27	Peng, Chatterjee, Riemer, Katayama, Tamir, Berkobin, Balachandran	Mar. 9, 2017
3	IPR2023-00770	1-27	Forstall, Rabu,	Dec. 15,

	("Third Petition")		Langle2009, Katayama, Tamir, Balachandran, Thompson2010, Warren, Willis, Berkobin	2010

II. Material Differences Support Instituting Multiple Petitions

Institution of multiple petitions may be warranted "when patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date." Consolidated Trial Practice Guide, 59. This case presents both such scenarios. Patent Owner Auto Telematics ("Telematics") asserted at least 12 claims in litigation. This is also a prototypical case that "requir[es] arguments under multiple prior art references" because the priority chain of the '369 patent is unclear and because Telematics has alleged inconsistent priority dates for the '369 patent.

First, Telematics' preliminary infringement contentions allege infringement of at least claims 1-2, 4-7, 15, 18-21, and 26, including two independent claims and 10 dependent claims unique from one another. USAA-1075, 6. Moreover, given the early stage of the litigation, Telematics could still add allegations against claims 3, 8,-14, 16-17, 22-25, and 27, including an additional independent claim and 14 dependent claims with features unique from one another. Therefore, the petitions cover all 27 claims of the '369 patent—both the asserted claims and claims that could potentially be asserted later in the litigation.

Additionally, each petition presents a different, non-cumulative challenge premised on a different primary reference, which illustrates the overly-broad nature of the '369 claims. As such, the petitions overlap only in their shared conclusion that the Challenged Claims are invalid.

Second, the questionable priority date further necessitates multiple petitions. While developing its invalidity defenses in the co-pending litigation, USAA discovered that the priority documents of the '369 patent do not provide written description support for at least the following elements in independent claim 1 (and the same limitations found in independent claims 26 and 27):

(a) a mobile telecommunications device configured "to derive driving information… wherein the driving information is derived without data from vehicle sensors,"

(b) a memory that comprises "a long term memory for persistently storing driving information and a short term memory for transiently storing driving information, wherein the short term memory receives driving information at a higher update rate than the long term memory," and

(c) "the mobile telecommunications device being further configured to: write driving information to the short term memory at a predetermined update rate during the driving period in a predetermined sequence; and overwrite the driving information previously written to the short term memory in accordance with the predetermined sequence."

Adding to the lack of clarity with respect to priority document support, Telematics has alleged inconsistent priority dates in co-pending litigation, initially

characterizing the ’369 patent as “claim[ing] priority to PCT Application No. PCT/GB2011/052492, filed on December 15, 2011.” USAA-1004, 9-10. Later, in preliminary infringement contentions, Telematics alleged an earlier priority date of “[a]s early as January 25, 2011.” USAA-1075, 8. However, as explained in the Second Petition, at least one of the cited priority applications lacks support for the noted ’369 patent claim features. Because the priority date of the ’369 patent is uncertain, the Second Petition is necessary to preserve USAA’s invalidity defenses and further enable the Board to resolve this priority dispute. Telematics’ inconsistent priority characterizations should not limit USAA to one petition—especially because the priority dispute has been precipitated by Telematics’ allegations of infringement, and because Patent Owner Telematics has the information necessary to identify the earliest priority date but has not done so.

USAA’s filing of multiple petitions against the ’369 patent is not only reasonable but necessary to ensure that the priority date and its impact on prior art availability are addressed. Any suggestion that the filings represent a form of impermissible parallel petition would unfairly prejudice USAA—and any similarly positioned petitioner while concurrently benefiting Telematics for ambiguity that it alone has created. On the one hand, USAA could be superficially limited in its invalidity defenses by only applying references that antedate the earliest proclaimed priority date despite Telematics’ refusal to sufficiently explain how its patent is

entitled to the benefit of such a priority date. Alternatively, USAA could apply references that post-date the earliest priority date listed on the first of the '369 patent, risking a substantive denial if Telematics subsequently introduced evidence that disqualifies the applied references as prior art. Parallel petitions eliminate this potential prejudice to USAA.

Finally, the Board's institution of IPRs based on multiple petitions, which compellingly demonstrate invalidity of the Challenged Claims based on materially different grounds, would serve to efficiently address issues of invalidity—and priority—for all parties, including Telematics. Indeed, the Board's institution of both petitions and subsequent resolution of the validity issues presented therein has the potential to play a significant role in bringing the dispute between the parties to a close sooner than if the Board exercised discretion not to institute on one or more of the petitions. Further, compelling merits of the grounds set forth in all petitions also warrants instituting all petitions, both to serve the public's interest in weeding out bad patent claims and to ensure that USAA has a fair and reasonable opportunity for its invalidity challenges to be considered by the PTAB.

Thus, USAA respectfully requests that the Board institute trial on all petitions.

Respectfully submitted,

Dated April 7, 2023

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) *et seq.* and 42.105(b), the undersigned certifies that on April 7, 2023, a complete and entire copy of this "Petitioner's Notice Ranking Petitions and Explaining Material Differences Between Petitions Against U.S. Patent No. 10,192,369" was provided via FedEx, to the Patent Owner by serving the correspondence address of record as follows:

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