

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNITED SERVICES AUTOMOBILE ASSOCIATION,
Petitioner,

v.

AUTO TELEMATICS LTD.,
Patent Owner.

IPR2023-00858 (Patent 10,198,879 B2)
IPR2023-00912 (Patent 9,311,271 B2)¹

Before GEORGE R. HOSKINS, FRANCES L. IPPOLITO, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding
37 C.F.R. § 42.5

¹ This order is being filed in each proceeding listed in the caption, due to the common issues addressed. The parties are not authorized to use a combined caption in these proceedings.

I. INTRODUCTION

On October 20, 2023, Petitioner sent an email communication to the Board, requesting authorization to file a Preliminary Reply to the Preliminary Response in each of these two proceedings. A copy of that email communication has been entered as Exhibit 3001 in each proceeding.

On November 1, 2023, the Board held a telephone conference with counsel to discuss Petitioner's request. Petitioner had arranged for a court reporter to transcribe the discussion. A copy of the resulting transcript has been filed in each proceeding ("Tr.") (IPR2023-00858, Exhibit No. 1518; IPR2023-00912, Exhibit No. 1520). That transcript constitutes the official record of the telephone conference.

Upon consideration of Petitioner's request, and the arguments presented during the telephone conference, Petitioner's request is *denied* for the following reasons.

II. DISCUSSION

Our Rules provide that, in the normal course, we will decide whether to institute a trial in an IPR pursuant to 35 U.S.C. § 314 based on the Petition, the Preliminary Response (if filed), and the evidence submitted with those two briefs. *See* 37 C.F.R. §§ 42.101–106 (filing and service of the Petition); *id.* § 42.107 (optional filing of the Preliminary Response); *id.* § 42.108 (Decision on Institution). However: "A petitioner may seek leave to file a reply to the preliminary response," and "[a]ny such request must make a showing of good cause." *Id.* § 42.108(c).

We conclude Petitioner has not demonstrated good cause for filing a Preliminary Reply in these two proceedings. Petitioner desires to present

further argument concerning whether “P3”²—a common parent application to the ’879 patent and the ’271 patent challenged in these two proceedings—provides written description support for generating and using *a driving score* as claimed in both patents, and determining *a start of a driving period* as claimed in the ’271 patent. *See* Ex. 3001. The written description inquiry under 35 U.S.C. § 112 is a routine issue that the Board is well-equipped to apply, and does so on a regular basis. We conclude at the present time that further briefing on these points would not materially help us to resolve the disputes presented by the existing briefs in these cases.

Petitioner asserts the arguments presented in the Preliminary Responses were unforeseeable to Petitioner when the Petitions were filed. We disagree. It was certainly foreseeable that Patent Owner might argue P3 does provide written description support for the ’879 patent and the ’271 patent claims at issue, in opposition to Petitioner’s argument that P3 does not support those claims, because if Petitioner is wrong on this issue then Petitioner’s primary reference in both proceedings (Peng, Ex. 1005) is not prior art. We address Petitioner’s arguments seeking to establish good cause, in the specific context of the *driving score* and *start of a driving period* claim terms, separately.

A. Driving Score

Petitioner suggested during the telephone conference that the Preliminary Responses rely on claim constructions of the claim term “driving score” that were unforeseeable when the Petitions were filed

² Great Britain Patent Application No. 1109759.9 filed on June 10, 2011 (Exhibit 1505 in both proceedings).

because: (1) Patent Owner in the co-pending district court litigation had argued no claim construction of the term “driving score” was necessary, and it should be afforded its plain and ordinary meaning; and (2) Patent Owner’s claim constructions in the Preliminary Responses are inconsistent with the challenged patents’ common specification, and the plain and ordinary meaning of the claim term. *See* Tr. 9:14–13:15. We are not persuaded.

As to (1), as far as we can discern from the evidence cited by Petitioner, the district court has not been asked to determine whether P3 provides written description support for the claimed driving score. *See id.* at 10:23–12:1 (Petitioner’s counsel citing Exs. 1069, 1071, and 1073). Instead, the disputed issue in the district court appears to be whether the term “driving score” is indefinite. *See* Ex. 1069, 2, 22, 27–33 (referring to the pagination at the bottom center of each page); Ex. 1071, 2, 10–11, 12–16 (same). The district court decided to apply the term’s “[p]lain and ordinary meaning,” without specifying what that meaning might be. Ex. 1073, 2. Thus, Petitioner has not established any inconsistency in positions taken by Patent Owner in the district court litigation and in the present IPR proceedings.

As to (2), Petitioner’s mere disagreement with Patent Owner’s claim construction and application of the claim term “driving score” to P3 (*see* Tr. 12:2–13:15) does not make the construction and application unforeseeable. Based on our initial review of the Preliminary Responses in these two proceedings in connection with Petitioner’s request for additional briefing, we conclude they reflect routine application of the claim language to the P3 disclosure. If Patent Owner’s understanding of the claim language is as unsupported as Petitioner seems to think it is, we will suss that out

when deciding whether to institute review, given the routine nature of this inquiry.

Petitioner further suggested during the telephone conference that fairness dictates authorization of a Preliminary Reply. *See* Tr. 13:16–16:25. We disagree. Petitioner had its say in the Petition, and chose to offer only very terse arguments. *See* IPR2023-00858, Paper 3, at 6 (arguing “[f]or [1.10]/[21.9]/[46.12]/[51.9]/[54.10]/[55.11]” that P3 “does not support requiring the mobile telecommunications device to ‘generate a driving score associated with a particular driver’ or the driver” because “the phrase and/or functionality of a driving score [are] not even mentioned” (citing Ex. 1003 ¶ 64)); IPR2023-00912, Paper 3, at 6 (arguing P3 “fail[s] to provide support for a ‘driving score’ (elements [6.9]/[7.9], [6.10]/[7.10], [7.11])” because “the phrase and/or functionality of a driving score [are] not even mentioned” (citing Ex. 1003 ¶¶ 68–105)). We appreciate the nature of Petitioner’s burden in this regard is to prove a negative (i.e., that P3 does *not* support the claims), and the associated difficulties this presents. Nonetheless, Petitioner had the opportunity to address this burden in the Petitions in more detail (as Petitioner did for other claim terms in these two proceedings and related proceedings³), and chose not to do so.

³ *See* IPR2023-00519, Paper 3, 6–9, 12–13 (arguing P3 does not disclose deriving driving information *without data from vehicle sensors*); *id.* at 6–7, 9, 11–12 (arguing P3 does not disclose *determining, based on inputs received by a user interface and sensor data, a start of a driving period*); IPR2023-00858, Paper 3, at 5–7 (arguing P3 does not disclose deriving driving information *without data from vehicle sensors*); IPR2023-00912, Paper 3, at 6 (arguing P3 does not disclose deriving driving information *without data from vehicle sensors*).

B. Start of a Driving Period

Petitioner suggested during the telephone conference that the Preliminary Response in IPR2023-00912 improperly ignores a claim construction of the term “driving period” in the IPR2023-00912 Petition, and further relies on an implicit construction that disregards the literal language of the claims. *See* Tr. 17:1–23:6. Petitioner also discussed principles of fairness. *See id.* at 20:14–21:21, 22:10–23:6.

We conclude these arguments do not establish good cause for further briefing, for similar reasons as those provided above in the context of the “driving score” claim term. That is, the claim construction and written description inquiries presented here are routine issues that the Board is well-equipped to apply, so further briefing would not materially help us resolve the parties’ disputes as presented by the existing briefs. Also, Petitioner has not shown that the positions taken in the Preliminary Response were unforeseeable because Petitioner disagrees with them, or because Petitioner believes Patent Owner should have addressed the Petition’s claim construction of the term “driving period.” Further, if Patent Owner’s application of the claim language to P3 is as unsupported as Petitioner seems to think it is, we will suss that out when deciding whether to institute review, given the routine nature of this inquiry. Finally, concerning fairness, Petitioner had its say in the Petition.

III. ORDER

In consideration of the foregoing, it is hereby ORDERED that Petitioner’s request for authorization to file a Preliminary Reply is *denied*.

IPR2023-00858 (Patent 10,198,879 B2)

IPR2023-00912 (Patent 9,311,271 B2)

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