

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Andrew William Wright
U.S. Patent No.: 9,311,271 Attorney Docket No.: 36137-0024IP1/0024IP2
Issue Date: April 12, 2016
Appl. Serial No.: 13/994,455
Filing Date: July 24, 2013
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. 9,311,271

United Services Automobile Association (“Petitioner” or “USAA”) is concurrently filing two petitions (IPR2023-00911, IPR2023-00912) challenging U.S. Patent No. 9,311,271 (“the ’271 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	IPR2023-00912 (“First Petition”)	1-7	Peng, Chatterjee, Tamir, Wilkes, Callopy	July 24, 2013
2	IPR2023-00911 (“Second Petition”)	1, 3, 4, 6, 7	Curry, Rabu, Katayama, Tamir, McClellan, Callopy	Dec. 15, 2010

II. Material Differences Support Instituting Multiple Petitions

Institution of multiple petitions may be warranted “when there is a dispute about priority date.” Consolidated Trial Practice Guide, 59. This is a prototypical

case that “requir[es] arguments under multiple prior art references” because the priority chain of the ’271 patent is unclear and because Telematics has alleged inconsistent priority dates for the ’271 patent.

While developing its invalidity defenses in the co-pending litigation, USAA discovered that the priority documents of the ’271 patent do not provide written description support for at least the following elements:

- (a) a mobile device that “determine[s], based on inputs received by the user interface and sensor data from the sensor set, a start of a driving period during which the mobile device is removably attached to the vehicle and the vehicle is in use” (claims 1, 4),
- (b) “the driving information [is] derived without data from the vehicle sensors” (claims 1, 4, 6, and 7), and
- (c) “a driving score” (claims 6 and 7).

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 ’271 patent as “claim[ing] priority to PCT Application No. PCT/GB2011/052492, filed on December 15, 2011.” USAA-1004, 8-9. 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 First Petition, at least one of the cited priority applications lacks support for the noted ’271 patent claim features. Because the priority date of the ’271 patent is uncertain, the First 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 '271 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 '271 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.

The First Petition addresses additional claims (claims 2 and 5) that are not addressed in the Second Petition. However, because the First Petition is borne from

a priority issue resulting from Patent Owner's own inconsistent priority claims (as well as its lack of written description support for the claims), institution of both petitions is not just appropriate, but necessary. Indeed, if Patent Owner was to later allege or unearth evidence in support of an earlier priority date, then Petitioner would have no recourse if the First Petition alone were instituted.

Moreover, Petitioner's two petitions challenging the '271 patent are consistent with eight earlier-filed petitions requesting *inter partes* review of patents in the same family and, for at least that reason, institution of both of the instant petitions would promote efficient review of common invalidity issues with minimal burden to the Board and parties (IPR2023-00518, IPR2023-00519, IPR2023-00768, IPR2023-00769, IPR2023-00770, IPR2023-00857, IPR2023-00858, IPR2023-00859). In particular, four of the ten filings together present a set of "Curry-based" invalidity grounds, and another four of the ten filings present a set of "Peng-based" invalidity grounds based on a later priority date. Moreover, the subject matter of independent claim 1 in each of the four challenged patents largely overlaps. As such, if the Board were to institute the Curry-based and Peng-based petitions, the resulting review of common issues based on similar grounds applying much of the same prior art would yield significant efficiencies in resolving disputed issues of invalidity, compared against the potential need for parallel litigation in district court.

Further, Petitioner notes that Petitioner gains no tactical advantage from the

earlier-filed petitions given the close timing of those filings. Indeed, if both petitions against the '271 patent instituted, Petitioner would be amenable to compressing its trial schedules to align with the schedules of IPRs of the related patents, so as to eliminate even the potential for the appearance of any tactical advantage to either party flowing from relative timing.

Finally, the Board's institution of IPRs based on multiple petitions, which compellingly demonstrate invalidity of the Challenged Claims based on materially different grounds (one set based primarily on Curry and one set based primarily on Peng), 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 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 May 11, 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 May 11, 2023, a complete and entire copy of this “Petitioner’s Notice Ranking Petitions and Explaining Material Differences Between Petitions Against U.S. Patent No. 9,311,271” was provided by Federal Express, to the Patent Owner, by serving the correspondence address of record as follows:

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