

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,
Petitioner,

v.

AUTONOMOUS DEVICES, LLC,
Patent Owner.

IPR2023-01055
Patent 11,238,344 B1

Before BARBARA A. PARVIS, ROBERT J. WEINSCHENK, and
RUSSELL E. CASS, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

ORDER

Conduct of the Proceeding
37 C.F.R. § 42.5; 37 C.F.R. § 42.20(d)

Tesla, Inc. (Petitioner) filed a Petition for an *inter partes* review of claims 1–20 of U.S. Patent No. 11,238,344 B1 (“the ’344 patent”). Paper 1. On December 13, 2023, we instituted trial with respect to all challenged claims. Paper 20. Following our institution decision, Patent Owner filed a Contingent Motion to Amend certain claims of the ’344 patent (Paper 28, “Mot. to Amend”), Petitioner filed an Opposition to the Motion to Amend (Paper 31, “Pet. MTA Opp.”), Patent Owner filed a Reply to Petitioner’s Opposition (Paper 34, “PO MTA Reply”), and Petitioner filed a Sur-reply to Petitioner’s Reply (Paper 38, “Pet. MTA Sur-reply”). On September 18, 2024, an oral hearing was held. Under the particular circumstances of this case, we exercise our discretion under 37 C.F.R. § 42.20(d) to authorize post-hearing supplemental briefing as described below.

In its Opposition to the Motion to Amend, Petitioner argued that the proposed amended claims were obvious over U.S. Patent No. 9,604,359 B1 to Grotmol (“Grotmol”) in view of U.S. Patent No. 8,639,644 B1 to Hickman (Ex. 1005, “Hickman”) or U.S. Patent Application No. 2010/0063663 to Tolstedt (Ex. 1015, “Tolstedt”). Pet. MTA Opp. 11–25.¹ In our Preliminary Guidance (Paper 32, “Prelim. Guidance”), we pointed to certain deficiencies in Petitioner’s explanations of its obviousness arguments and, in its Sur-reply, Petitioner addressed these perceived deficiencies and provided further argument and explanation. *See* Prelim. Guidance 6–11; Pet. MTA Sur-reply 2–9.

¹ Petitioner’s Opposition refers to “U.S. Patent No. 10,452,974” and “Grotmol.” *Id.* at 11. We treat this as a typographical error in light of Petitioner’s reference to “U.S. Patent No. 9,604,359” as “Grotmol” (*id.* at iii) and Petitioner’s submission of U.S. Patent No. 9,604,359 (Ex. 1004).

During the hearing, Patent Owner argued that Petitioner's MTA Sur-reply included improper new arguments that it had not had an opportunity to respond to, and that the Board should not consider those arguments. On October 4, 2024, Patent Owner sent an e-mail to the Board requesting a "ten-page brief to address new arguments raised for the first time by Petitioner in its MTA Sur-reply in IPR2023-01055." Ex. 3001. Patent Owner's e-mail stated that Petitioner "opposes Patent Owner's request" and, alternatively, "requests authorization to submit a responsive paper of equal length, with an equal amount of time to prepare the same" if Patent Owner's request is granted. *Id.*

Based on the arguments raised at the hearing, we believe the record would benefit from allowing Patent Owner to submit a Sur-sur-reply on the Motion to Amend in order to have an opportunity to respond to the arguments made in Petitioner's MTA Sur-reply. Patent Owner's Sur-sur-reply shall be limited to responding to the issues raised in Petitioner's MTA Sur-reply, and may not introduce new declaration or affidavit evidence. We grant Petitioner's unopposed request for a responsive paper limited to responding to Patent Owner's Sur-sur-reply. Petitioner may not introduce new evidence.

It is therefore:

ORDERED that Patent Owner may file a Sur-sur-reply to Petitioner's MTA Sur-reply, no longer than ten (10) pages, that responds to the issues raised in Petitioner's MTA Sur-reply;

FURTHER ORDERED that Patent Owner may not file new declaration or affidavit evidence, including declaratory testimony;

FURTHER ORDERED that Patent Owner's MTA Sur-sur-reply shall be filed no later than seven (7) business days from the issuance of this Order;

FURTHER ORDERED that Petitioner may file a Sur-sur-sur-reply to Patent Owner's Sur-sur-reply, no longer than ten (10) pages, that responds to Patent Owner's Sur-sur-reply;

FURTHER ORDERED that Petitioner may not file new evidence; and
FURTHER ORDERED that Petitioner's Sur-sur-sur-reply shall be filed no later than seven (7) business days from the filing of Patent Owner's Sur-sur-reply.

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