

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,
Petitioner

v.

AUTONOMOUS DEVICES, LLC,
Patent Owner

Case: IPR2023-01169
U.S. Patent No. 10,607,134

PATENT OWNER'S PRELIMINARY SUR-REPLY

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Exhibit List

Exhibit	Description
2001	Biography of Blair M. Jacobs (previously submitted)
2002	Declaration of Blair M. Jacobs (previously submitted)
2003	Supplemental Declaration of Blair M. Jacobs (previously submitted)
2004	District Court Docket (previously submitted)
2005	District Court Scheduling Order (previously submitted)
2006	District Court Invalidity Contentions (previously submitted)

I. INTRODUCTION

As authorized by the Board via email on November 13, 2023, Autonomous Devices, LLC (“Patent Owner” or “PO”) submits this Preliminary Sur-Reply responding to Petitioner’s Reply to Patent Owner’s Preliminary Response (Petitioner’s Reply is Paper No. 16, and PO’s Preliminary Response (“POPR”) is Paper No. 10). This Preliminary Sur-Reply is timely filed, as it is filed within five business days of Petitioner’s Reply, which was served November 20, 2023.

The Board should adopt PO’s proposed construction of “object representation” and deny institution of this IPR because Petitioner has not established that there is a reasonable likelihood that any challenged claims are unpatentable. The Board should also exercise its discretion to deny institution under 35 U.S.C. § 314(a), as five of the six *Fintiv* factors favor discretionary denial.

II. PO’S CONSTRUCTION OF “OBJECT REPRESENTATION” SHOULD BE ADOPTED

The Board should adopt Patent Owner’s proposed construction of “object representation.” Patent Owner has proposed a reasonable, well-supported construction: “data structure that includes an object property generated by object processing.” POPR, 8. This is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed. Cir. 2005) (en banc). “Importantly,” skilled artisans are “deemed to read the claim term . . . in the context of the entire patent.”

Id. at 1313. The specification “is always highly relevant to the claim construction analysis” and is usually “dispositive.” *Id.* at 1315. PO’s construction is consistent with the claim language and is well-supported by the intrinsic record including the specification and figures, particularly Figure 5B of the ’134 patent. POPR, 8-12.

Petitioner’s contention that PO’s proposed construction “is unsupported, and indeed contradicted, by the specification of the ’134 Patent” is wrong. Reply, 1. The portions of the specification and drawings cited in the POPR provide important context and meaning for the “object representation,” and the various examples later described in the specification build on that but do not change the meaning of the term. Petitioner’s argument that PO imports “limitations from preferred embodiments while excluding other embodiments expressly disclosed” is wrong. Reply, 2. The portion of the ’134 patent cited by Petitioner does not disclose embodiments of object representations that lack a data structure including an object property generated by object processing and instead merely discloses that an object representation “may include any information related to an object,” Ex. 1001, 69:5-7. This portion of the specification supports PO’s construction, as it confirms that an object representation includes information related to an object and is a data structure including an object property generated by object processing.

Petitioner’s claim that any information related to an object “plainly encompasses more than a ‘data structure that includes an object property generated

by object processing,” Reply, 2, is misleading and contradicts the specification. As the intrinsic record makes clear, an object representation is not simply information related to an object but a data structure including an object property generated by object processing. POPR, 8-12. And Petitioner’s claim that the specification discloses that object representations can be stored apart from object properties, Reply, 2, is a mischaracterization, as the cited portion discloses storing object representations and object properties, not that they are stored separately.

Petitioner’s argument that PO’s proposed construction departs from the claim term’s ordinary meaning also misses the mark. Reply, 2. As discussed in the POPR, PO’s construction is consistent with the term’s customary meaning and is supported by the claims, specification, drawings, and intrinsic record as a whole. POPR, 8-12. The Board should reject Petitioner’s attempt to analyze claim terms in a vacuum. *See Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116 (Fed. Cir. 1987).

III. THOMAS DOES NOT DISCLOSE THE CLAIMED “OBJECT REPRESENTATION” UNDER PO’S CONSTRUCTION

Petitioner’s contention that Thomas’s alleged disclosure of a database means that Thomas discloses the claimed “object representations” under PO’s construction is incorrect. Reply, 2-3. Thomas discloses a database as a generic storage arrangement and does not disclose the claimed “object representations” under PO’s proposed construction. POPR, 13-22. Thomas simply provides no disclosure regarding how information is stored. Thomas’s cursory discussion of a generic

database does not support the argument that Thomas discloses object representations that are *data structures including an object property generated by* object processing. Thomas does not disclose that data is processed into object properties, let alone disclose a data structure that includes an object property generated by object processing. Petitioner mischaracterizes the '134 patent's disclosure that a database is a type of data structure, Reply, 2-3, as somehow supporting Thomas' generic database allegedly disclosing (it does not) a specific "data structure that includes an object property generated by object processing."

Petitioner's argument that Thomas's positions and conditions are generated "object properties" (Reply, 3) is incorrect. Thomas does not disclose that situational information is processed to generate object properties that are included in object representation data structures. POPR, 13-22. Petitioner's argument that "Thomas further processes and stores this information in substantially the same" way (Reply, 3), is an incorrect generalization, as the cited portions of Thomas do not disclose data structures including an object property generated by object processing. *Id.*

IV. THE *FINTIV* FACTORS FAVOR DENIAL OF INSTITUTION

Petitioner is wrong that "the *Fintiv* factors collectively weigh strongly against discretionary denial." Reply, 3. The first factor favors denial because there is no stay in the district court proceeding and there is a low likelihood of a stay given the advanced stage of the underlying litigation. Petitioner's citation to *Sand Revolution*

II is inapposite (Reply, 4), as the Board in that case lacked evidence regarding the likelihood of a stay. The advanced stage of the litigation means that a stay is unlikely.

The third factor also weighs in favor of denial because the parties and the district court have expended significant time and resources on the litigation. Petitioner does not dispute this fact but cites an inapplicable district court decision denying a stay where deposition discovery had not even started. Reply, 4. By mid-January 2024 (the institution decision deadline), the parties will have begun deposition discovery and will have expended even more resources on discovery. And Petitioner has not filed an IPR on every patent involved in the district court litigation.

Regarding the fourth *Fintiv* factor, Petitioner's recent stipulation in its Reply (Reply, 5) confirms that Petitioner recognized the need for some type of stipulation, but provided a weak stipulation under *Sand Revolution* that falls short of a *Sotera* stipulation. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020). As a result, factor four favors denial. *See Samsung Elecs. v. Ancora Tech.*, IPR2020-01184, Paper 11 at 21-22 (PTAB Jan. 5, 2021).

Petitioner does not dispute that factor five favors denial, and factor six also favors denial because, as discussed above and in the POPR, Petitioner's arguments are weak. And although factor two may not favor denial, no factor is dispositive, *see Snap, Inc. v. SRK Technology LLC*, IPR2020-00820, Paper 15 at 19 (Oct. 21, 2020), and five of six factors favor denial, so the Board should deny institution.

Dated: November 28, 2023

Respectfully submitted,

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CERTIFICATION OF PAGE COUNT

The undersigned hereby certifies that **PATENT OWNER'S
PRELIMINARY SUR-REPLY** is 5 pages or less as required by the Board's
November 13, 2023 e-mail.

Dated: November 28, 2023

By: /Arvind Jairam/
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CERTIFICATION OF SERVICE

The undersigned hereby certifies that a copy of this **PATENT OWNER'S PRELIMINARY SUR-REPLY** has been served on Petitioner via email on the following counsel of record for Petitioner:

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