

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,
Petitioner,

v.

AUTONOMOUS DEVICES, LLC,
Patent Owner.

IPR2023-01169
Patent 10,607,134 B2

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. 10,607,134 B2 (“the ’134 patent”). Paper 1. On January 8, 2024, we instituted trial with respect to all challenged claims. Paper 19. Following our institution decision, Patent Owner filed a Contingent Motion to Amend certain claims of the ’134 patent (Paper 25, “Mot. to Amend”), Petitioner filed an Opposition to the Motion to Amend (Paper 30, “Pet. MTA Opp.”), Patent Owner filed a Reply to Petitioner’s Opposition (Paper 33, “PO MTA Reply”), and Petitioner filed a Sur-reply to Patent Owner’s Reply (Paper 38, “Pet. MTA Sur-reply”). On October 2, 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. 8,142,268 B2 to Thomas (Ex. 1005, “Thomas”) alone or in view of U.S. Patent No. 7,399,224 B2 to Hirai (Ex. 1025, “Hirai”). Pet. MTA Opp. 1–25. In our Preliminary Guidance (Paper 31, “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 7–14; Pet. MTA Sur-reply 1–9. 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.

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.

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; and

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.

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