

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 SUR-SUR-REPLY IN SUPPORT OF
CONTINGENT MOTION TO AMEND**

I.	INTRODUCTION	1
II.	THE SUBSTITUTE CLAIMS ARE PATENTABLE OVER THE ART	1
A.	The MTA Sur-Reply Is Wrong About Thomas and Thomas-Hirai	1
1.	Limitation [21.h]	1
2.	Limitation [21.j]	4
3.	Limitation [21.m]	6
III.	CONCLUSION	10

I. INTRODUCTION

Patent Owner Autonomous Devices, LLC (“Patent Owner” or “PO”) submits this MTA Sur-Sur-Reply, as authorized by the Board (Paper 41), to respond to the issues raised in Petitioner Tesla, Inc.’s MTA Sur-Reply (Paper 38). As explained in PO’s contingent Motion to Amend (Paper 25) (“MTA”), PO’s Reply (Paper 33) in support of its MTA, and below, the contingent MTA should be granted to the extent the Board finds any of original claims 2-5, 7, and 9-19 unpatentable.

II. THE SUBSTITUTE CLAIMS ARE PATENTABLE OVER THE ART

A. The MTA Sur-Reply Is Wrong About Thomas and Thomas-Hirai

1. Limitation [21.h]

The MTA Sur-Reply has not demonstrated that Thomas or Thomas-Hirai discloses/suggests limitation [21.h]. Petitioner’s MTA Sur-Reply puts forth new analysis of the *NFL 2K5 video game*, but that is *entirely different from Thomas itself that does not mention 3D objects at all*. Petitioner is thus going outside of its reference and its earlier-presented arguments. A look at the MTA Opposition (Paper 30) shows that Petitioner spent only a single sentence on NFL 2K5 in its Opposition. Opp., 10. Petitioner’s belated attempt to say many more things about NFL 2K5, and its alleged relationship to Thomas, constitutes impermissible new argument in

violation of the Board's rules. 37 C.F.R. § 42.23(b) ("A sur-reply may only respond to arguments raised in the corresponding reply...").

The MTA Sur-Reply is also substantively wrong. As the Board correctly noted in its Preliminary Guidance (Paper 31, "PG"), Thomas does not disclose or suggest first and second object representations that each represent a 3D object of the application, nor does Hirai save Petitioner. Thomas itself does not disclose or suggest that its avatars are 3D objects of the application, and, in contrast, only shows 2D avatars in 2D top-down views of a video game. ***In fact, Thomas never mentions 3D objects at all.***

The notion that the commercial video game product NFL 2K5 itself contains the disclosure of Thomas or some part of it is nonsensical. To the extent that Petitioner is arguing that the NFL 2K5 video game itself includes Thomas's disclosure, that is wrong. Additionally, apart from a very broad statement that NFL 2K5 includes a computer program 110, ***Petitioner has not pointed to, and Thomas does not disclose or suggest anything about, NFL 2K5 itself including Thomas's disclosure.*** That further does not make sense because Petitioner would have needed to analyze the source code of the NFL 2K5 to know what exactly NFL 2K5 includes, and, of course, there is no source code at issue in this IPR or the MTA. Petitioner appears to be trying to incorporate NFL 2K5 by reference into Thomas, but that

would be incorrect and improper because Thomas does not mention anything about incorporation by reference.

Petitioner relies upon Thomas's cursory mention of the NFL 2K5 video game as an example embodiment of Thomas' computer system 100, but then incorrectly imports other supposed features ("3D avatars") back into Thomas's disclosure. Notably, the 3D avatars that Petitioner imports from NFL 2K5 are entirely unsupported by Thomas. Additionally, in its MTA Opposition, Petitioner did not argue that it would have been obvious to configure Thomas' system to implement the claimed features of the 3D objects—but rather stated that a POSA would have understood that Thomas *itself* discloses the features. But NFL 2K5 is a product—a video game—with unspecified features, not a printed publication reference that is at issue in this IPR, and Petitioner's attempt to conflate Thomas with NFL 2K5 is wrong.

And even if NFL 2K5 does include everything in Figure 1 of Thomas, which Petitioner has no knowledge of and which PO does not concede, *that still does not say anything about Thomas including 3D objects that Petitioner alleges for its mapping*. Again, Thomas makes no mention of 3D objects. In any event, none of this is explained in Petitioner's Opposition beyond a single cryptic sentence (Opp., 10), and Petitioner cannot prevail on obviousness for this limitation because the Opposition and Sur-Reply did not argue that.

In its MTA Sur-Reply, Petitioner argues that NFL 2K5's "player avatars" (which Petitioner attributes to Thomas) correspond to the claimed 3D objects of the application. MTA Sur-Reply, 7. But Thomas only discloses 2D avatars/objects (as seen from 2D top-down views in its various figures and noted by the Board). PG, 13. Petitioner's assertion about 3D objects has ***no support in Thomas's disclosure or Petitioner's expert testimony*** (beyond merely repeating what is in Petitioner's briefs). *TQ Delta, LLC v. CISCO Sys., Inc.*, 942 F.3d 1352, 1358 (Fed. Cir. 2019) ("Conclusory expert testimony does not qualify as substantial evidence.").

Petitioner has not relied on teachings of Hirai for [21.h], so Hirai cannot save Petitioner's faulty analysis.

2. Limitation [21.j]

The MTA Sur-Reply has also not demonstrated that Thomas or Thomas-Hirai discloses/suggests limitation [21.j]. Petitioner's analysis is wrong regarding the "in response to" portion of this limitation. Petitioner has mapped the claimed first data structure to either A) Thomas's user profile or alternatively to B) a modification of Thomas's user profile in view of Hirai's athlete character information. However, neither of these proposed mappings discloses or suggests generating either data structure ***in response to the claimed processing of a type and location***.

Petitioner merely stated in its Opposition that data structures can be generated in advance or on demand. Opp., 15. ***But that is different than and says nothing***

about generating a data structure “in response to” something else. Petitioner’s MTA Sur-Reply tries to remedy the Opposition’s incorrect analysis by stating that “the analysis of current circumstances,” which Petitioner maps to the claimed processing, “is performed by ‘the simulator 120’ ‘[d]uring learning mode.’” MTA Sur-Reply, 10. However, the portions of Thomas that the MTA Sur-Reply cites merely disclose that “[d]uring learning mode, the simulator 120 records a user’s input as the user is interacting with the game.” Ex. 1005, 9:35-36. Petitioner has chopped up this sentence from Thomas and presented it in a misleading manner. Thomas simply does not disclose or suggest that any data structure, much less what Petitioner maps to the claimed first data structure, is generated *in response to* processing the claimed type and location. Thomas’s user profile (which Petitioner mapped to the claimed first data structure) is not generated *in response to* processing Thomas’s spatial positions and team affiliations/archetypes. The time 660 and score 670 within the user profile 650 have nothing to do with the spatial positions 665; thus, these are not generated *in response to* the claimed processing.

To the extent that the MTA Sur-Reply is trying to bolster Petitioner’s severely deficient obviousness analysis, the additional assertions in the MTA Sur-Reply about “analysis of current circumstances” are not supported by expert analysis and are instead mere attorney argument. MTA Sur-Reply, 9. Petitioner has not proven, with proper obviousness rationale and support, why a POSA would have modified

Thomas's system to generate data structures in response to the claimed features. *See In re Magnum Tools Int'l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016) ("To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.").

Petitioner has not relied on teachings of Hirai for [21.j], so Hirai cannot save Petitioner's faulty analysis.

3. Limitation [21.m]

Lastly, the MTA Sur-Reply has not demonstrated that Thomas or Thomas-Hirai discloses/suggests limitation [21.m]. The Sur-Reply points to discussion in the Petition (Paper 1) that was allegedly referenced in the Opposition. However, under the Board's Rules, a party cannot, in one paper, incorporate by reference arguments from another paper. As explained in *Corning*, the Board should not have to play the role of an archaeologist of the record in tracing meandering arguments. Petitioner is asking the Board to do exactly that. *Corning Inc. v. DSM IP Assets B.V.*, IPR2013-00043, Paper 95 at 12 n. 3 (PTAB May 1, 2014); *see also* 37 C.F.R. § 42.6(a)(3) (barring incorporation by reference); Office Trial Practice Guide at 35. Therefore, in the Opposition, Petitioner relies on mere two sentences for limitation [21.m], whereas in the MTA Sur-Reply Petitioner shifts to an impermissible new argument that relies on the Petition.

Petitioner contends that this claim limitation regarding the correlation “does not require the existence of any new correlation that was not previously recited in the original Challenged Claims.” MTA Sur-Reply, 10. In contrast, the added limitation clearly recites that “the first data structure and the second data structure are correlated with the first one or more instruction sets.” The claim language is plain on its face in reciting a narrower limitation than what is present in Claim 1, and Petitioner is therefore required to map prior art and provide argument and evidence to address this narrower limitation, which Petitioner has failed to do. ***Petitioner appears to be either avoiding the claim limitation or reading it out entirely.*** Therefore, Petitioner’s argument that this new limitation was “established” in the Petition suffers from the above incorporation by reference flaw and fails to account for the clear narrowing in the substitute claim language. Thus, Petitioner’s entire argument about this limitation is premised on fundamental flaws.

Petitioner’s argument is also flawed because Petitioner is apparently arguing that the added narrower limitation is automatically disclosed or suggested based on what Petitioner previously pointed to in its Petition regarding a broader limitation. But that is not a proper § 103 analysis. Petitioner is required to present its argument or evidence for each and every limitation allegedly disclosed or suggested in the prior art, and Petitioner has failed to do so. Furthermore, Petitioner’s argument is

fundamentally wrong as *it would deny the proper use of narrowing claim limitations.*

In its Opposition, Petitioner mapped “situations” or “circumstances” as correlated with user inputs. However, on page 11 of the MTA Sur-Reply, Petitioner asserts “[a]s set forth in the Petition” and makes an argument regarding the Petition, and then states at pages 11-12 that “Thomas also describes that the user profile (data structures) containing these parameters defining a situation (i.e., object representations) is correlated with user inputs (i.e., instruction sets). *See Opp.*, 28...” **First**, there is no page 28 in the Opposition. **Second**, referring to the Petition is an improper incorporation by reference to arguments from another paper, as discussed above. **Third**, Petitioner’s assertion that Thomas’ user profile (rather than the situation) is correlated with user inputs is impermissible new argument. **Fourth**, for this limitation, the Opposition only points to disclosures within Thomas, and nothing within Hirai. *Opp.*, 24-25. In the Opposition, Petitioner has not even mentioned obviousness for this limitation except a conclusory, unexplained assertion that “[SUB.6] is rendered obvious by Thomas alone or by the Thomas-Hirai combination”—an assertion that should be rejected due to the lack of obviousness analysis. *Opp.*, 25. Thus, the marked-up figure and its accompanying text on page 12 of the MTA Sur-Reply are impermissible new arguments that should not be considered. **Fifth**, because Thomas and Thomas-Hirai do not disclose or suggest the

first and second object representations representing 3D objects as discussed above, it follows that Thomas and Thomas-Hirai also cannot and do not disclose or suggest limitation [21.m]. **Sixth**, in its quote noted above (“Thomas also describes...”, MTA Sur-Reply, 11-12), Petitioner argues that Thomas’s user profile is correlated with user input, but not finding this disclosure in Thomas, the MTA Sur-Reply points to an “event” of Thomas as being the first one or more instruction sets recited in the new limitation. *Id.*, 12 (“an event, shown in orange (i.e., the one or more instruction sets).”). However, this is a fundamentally wrong mapping. An “event,” as defined by Thomas, is “a particular action occurring.” Ex. 1005, 4:16-19; PO Response (Paper 24, “POR”), 5-6. Indeed, ***Petitioner admits that an event in Thomas is distinct and separate from user input*** that Petitioner maps to the claimed instruction set: “As set forth in the Petition, in Thomas, the situation/circumstances surrounding occurrence of an event are associated (correlated) with a user input (i.e., the first one or more instruction sets) responsive to that event.” MTA Sur-Reply, 11. Thus, an event is clearly not an “instruction set,” and it is also not “user’s input” that Petitioner mapped to “instruction set” for Claim 1, which is now part of the proposed Substitute Claims. So, Petitioner’s analysis is incorrect with respect to what Thomas explicitly discloses and also internally inconsistent regarding Petitioner’s own prior mapping.

The marked-up figure that Petitioner includes at page 12 of the MTA Sur-Reply shows the “event” in orange. Petitioner apparently pointed to this because

there was nothing else in Thomas or Thomas-Hirai that discloses or suggests the recited instruction sets in any kind of correlation with any data structures. This figure shows the user profile that Petitioner mapped to the claimed data structures, but as explained above, the event in Thomas is fundamentally different and simply does not disclose the claimed one or more instruction sets. As to the rest of the marked-up figure, Petitioner has included it in its MTA Sur-Reply without any sort of expert support. Also, even if this new argument were permitted, ***it does not even establish the disclosure of instruction sets, much less a correlation between the claimed data structures and the claimed instruction sets.***

Additionally, Petitioner is inconsistent with its mapping of instruction sets. In the paragraph spanning pages 11-12 of the MTA Sur-Reply, Petitioner first maps “instruction sets” to a “user input,” and then maps it to an “event.” This is internally inconsistent, as the new “event” mapping is inconsistent with Petitioner’s earlier mapping in the Petition that an “instruction set” is “the user’s input for controlling an avatar in the computer program.”

III. CONCLUSION

For the above and previously presented reasons, the MTA should be granted.

Date: October 29, 2024

Respectfully submitted,

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S
SUR-SUR-REPLY IN SUPPORT OF CONTINGENT MOTION TO AMEND**
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