

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,
Petitioner,

v.

AUTONOMOUS DEVICES, LLC,
Patent Owner.

Case No. IPR2023-01170
U.S. Patent No. 10,102,449

JOINT MOTION TO DISMISS AND TERMINATE

EXHIBITS

- Ex. 1001 U.S. Patent No. 10,102,449 (the “449 patent”)
- Ex. 1002 Prosecution File History of U.S. Patent No. 10,102,449
- Ex. 1003 Declaration of Jason Janet, Ph.D.
- Ex. 1004 Curriculum Vitae of Jason Janet, Ph.D.
- Ex. 1005 U.S. Patent No. 9,604,359 (“Grotmol”)
- Ex. 1006 U.S. Patent No. 9,443,192 (“Cosic 192”)
- Ex. 1007 U.S. Patent No. 8,639,644 (“Hickman”)
- Ex. 1008 Service, Robert F., *Minds of Their Own*, Sci. Magazine. Oct. 10, 2014, 346(6206):182-183, *available at*,
https://www.usna.edu/AcResearch/_files/documents/Science_Minds_of_Their_own_182.full1.pdf
- Exs. 1009 - 1049 [RESERVED]
- Ex. 1050 CONFIDENTIAL - Litigation Agreement

I. RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.71 and 42.74, and the Board’s authorization email of October 19, 2023, Petitioner Tesla Inc. (“Petitioner”) and Patent Owner Autonomous Devices, LLC (“Patent Owner”) jointly move to dismiss and terminate IPR2023-01170 (“the Present IPR Proceeding”) in its entirety.

II. BACKGROUND

A. Status of the Present IPR Proceeding

The Present IPR Proceeding was initiated by the filing of a Petition for *Inter Partes* Review of U.S. Patent No. 10,102,449 (“the ’449 Patent”) on June 30, 2023. The Board accorded a filing date to the Petition on July 7, 2023, and the deadline for a decision on institution is still months away (January 7, 2024).

B. Related Matters

The ’449 Patent is the subject of a civil action, *Autonomous Devices LLC v. Tesla, Inc.*, No. 22-cv-1466 (MN) (D. Del.) (“the Delaware Litigation”), filed November 7, 2022. The ’449 Patent is not the subject of any other pending litigation.

Additional patents involved in the Delaware Litigation include U.S. Patent Nos. 10,452,974, 11,238,344, 11,055,583, 10,607,134, 11,113,585, and 11,663,474. Petitioner has filed petitions for *Inter Partes* Review on U.S. Patent No. 10,452,974 (IPR2023-01054), U.S. Patent No. 11,238,344 (IPR2023-01055), U.S. Patent No. 11,055,583 (IPR2023-01172 and IPR2023-01173), U.S. Patent No. 10,607,134 (IPR2023-01169), and U.S. Patent No. 11,113,585 (IPR2023-01171).

Concurrent with this Joint Motion to Dismiss and Terminate the Present IPR Proceeding on the '449 Patent, Petitioner and Patent Owner are further moving to dismiss and terminate IPR2023-01171 on U.S. Patent No. 11,113,585. The parties are not currently moving to dismiss or terminate the IPR proceedings involving any other patent involved in the Delaware Litigation apart from the '449 Patent and U.S. Patent No. 11,113,585.

C. Filing of Litigation Agreement, and Certification of No Collateral Agreements or Understandings

Petitioner and Patent Owner executed a Litigation Agreement on October 15, 2023, which settled the parties' disputes involving the '449 Patent and U.S. Patent No. 11,113,585. The Litigation Agreement does not extend to any other patent involved in the Delaware Litigation or for which Petitioner has filed an IPR petition.

The parties are concurrently filing a true copy of the Litigation Agreement as Exhibit 1050, along with a Joint Request That the Parties' Litigation Agreement be Treated as Business Confidential Information under 37 C.F.R. § 42.74(c).

Petitioner and Patent Owner certify that no collateral agreements or understandings exist in connection with, or in contemplation of, dismissal and termination of the Present IPR Proceeding beyond the Litigation Agreement.

IV. GOOD CAUSE JUSTIFIES DISMISSAL AND TERMINATION OF THE PRESENT IPR PROCEEDING

The Board has recognized that dismissal and termination of pre-institution IPR proceedings is available upon a showing of good cause. *See, e.g., Samsung Elec. Co. Ltd. v. Telefonaktiebolaget LM Ericsson*, IPR2021-00446, Paper 7, at 5 (PTAB August 3, 2021) (finding good cause for dismissal where “[t]he parties have settled their dispute, the proceedings are early in the preliminary stages, Patent Owner has not filed any preliminary responses, and the Board has not issued any decisions or otherwise invested in the merits of these proceedings”); *Apple Inc. v. Pinn, Inc.*, IPR2021-00220 Paper 10 (PTAB Mar. 19, 2021); *Staylinked Corp. v. Ivanti, Inc.*, IPR2021-00022, Paper 10 (PTAB Feb. 4, 2021); *Intel Corp. v. Tela Innovations, Inc.*, IPR2019-01257, Paper 16 (PTAB Jan. 2, 2020); *World Programming LTD. v. SAS Institute, Inc.*, IPR2019-01457 Paper 19 (PTAB Dec. 27, 2019).

In view of the Litigation Agreement that settled the parties’ disputes involving the ’449 Patent, Petitioner and Patent Owner respectfully submit that dismissal and termination of the Present IPR Proceeding is warranted to conserve resources of the Board, to conserve resources of the parties, and to promote a speedy and just resolution of the Present IPR Proceeding. The Board has recognized that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding,” and as such, the Board “expects” a proceeding to be terminated at the

parties' request "unless the Board has already decided the merits of the proceeding."

Consolidated Trial Practice Guide, November 2019, p. 86. Here, the merits of the Present IPR Proceeding have not been decided, let alone considered in any decision by the Board. Accordingly, good cause exists to dismiss and terminate the Present IPR Proceeding in its entirety.

V. CONCLUSION

For the above reasons, Petitioner and Patent Owner jointly and respectfully request that the Board dismiss and terminate the Present IPR Proceeding.

Dated: October 26, 2023

Respectfully submitted,

/Anish R. Desai/

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Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on October 26, 2023, a complete and entire copy of this Joint Motion to Dismiss and Terminate was provided via email, to Patent Owner by serving the email correspondence addresses of record as follows:

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