

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC,
Petitioner,

v.

AUTONOMOUS DEVICES, LLC,
Patent Owner.

IPR2023-01172 (Patent 11,055,583 B1)
IPR2023-01173 (Patent 11,055,583 B1)¹

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

WEINSCHENK, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This Order pertains to all of these cases. Therefore, we exercise our discretion to issue a single Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

I. INTRODUCTION

On November 20, 2023, Judges Parvis, Weinschenk, and Cass held a conference call with counsel for Tesla, Inc. (“Petitioner”) and counsel for Autonomous Devices, LLC (“Patent Owner”). This Order summarizes statements made during the conference call.

II. ANALYSIS

Petitioner requested authorization to file a reply to Patent Owner’s Preliminary Response to respond to Patent Owner’s argument that the Petition incorrectly applies statements in the asserted reference known as Grotmol. Petitioner argued that Patent Owner’s characterization of Grotmol was not reasonably foreseeable. Patent Owner contended that the Preliminary Response simply responds to statements in the Petition based on the teachings in Grotmol.

After hearing the respective positions of the parties, we denied Petitioner’s request to respond to Patent Owner’s argument regarding Grotmol. We explained that at this time the current record is sufficient for us to address the parties’ dispute. Nonetheless, if we later determine that additional briefing is necessary, we will schedule another conference call with the parties.

Petitioner also requested authorization to file a reply to Patent Owner’s Preliminary Response to respond to Patent Owner’s arguments that the Petition should be denied under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential). Patent Owner did not oppose Petitioner’s request. Thus, we authorized Petitioner to file a 3-page reply by November 22, 2023, to respond to Patent Owner’s arguments regarding discretionary denial under *Fintiv*, and we authorized

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Patent Owner to file a 3-page sur-reply by December 1, 2023, to respond to Petitioner's arguments in the reply.

III. ORDER

It is hereby

ORDERED that Petitioner may file a 3-page reply to the Preliminary Response by November 22, 2023, in accordance with the instructions above; and

FURTHER ORDERED that Patent Owner may file a 3-page sur-reply to the reply by December 1, 2023, in accordance with the instructions above.

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For PETITIONER:

W. Karl Renner
Nicholas W. Stephens
FISH & RICHARDSON P.C.
axf-ptab@fr.com
nstephens@fr.com
IPR49649-0028IP1@fr.com

For PATENT OWNER:

Arvind Jairam
Blair M. Jacobs
Christina Ondrick
John Holley
Stuart McCommas
George Fishback
MCKOOL SMITH, P.C.
ajairam@mckoolsmith.com
bjacobs@mckoolsmith.com
condrick@mckoolsmith.com
jholley@mckoolsmith.com
smccommas@mckoolsmith.com
gfishback@mckoolsmith.com