

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,
Petitioner,

v.

AUTONOMOUS DEVICES, LLC
Patent Owner

IPR2023-01173
U.S. Patent No. 11,055,583

**PETITIONER'S REPLY
TO PATENT OWNER'S PRELIMINARY RESPONSE**

TABLE OF CONTENTS

	Page
I. THE BOARD SHOULD NOT DENY INSTITUTION UNDER § 314(A).....	1

Pursuant to the Board's authorization during the conference call held November 20, 2023, Petitioner submits this Reply to Patent Owner's Preliminary Response ("POPR").

I. THE BOARD SHOULD NOT DENY INSTITUTION UNDER § 314(a)

The *Fintiv* factors weigh strongly against discretionary denial.

Factor 1: Stay: Petitioner filed IPR petitions on all six patents asserted by Patent Owner in its original complaint of November 2022, although neither party has yet requested a stay.¹ This factor is neutral. *See Sand Revolution II, LLC v. Cont'l Intermodal Grp.*, IPR2019-01393, Pap. 24 at 7 (PTAB June 16, 2020) ("we will not attempt to predict how the district court in the related district court litigation will proceed because the court may determine whether or not to stay any individual case[] ... based on a variety of circumstances and facts beyond our control") (informative).

Factor 2 (Proximity of Trial Dates): Patent Owner filed its POPR on October 10, 2023, and a decision on institution is expected by January 10, 2024. A Final Written Decision ("FWD") in this IPR, barring extensions, will therefore be due no later than January 10, 2025. Trial in Delaware is currently not scheduled to

¹ IPR2023-01170 challenging U.S. Patent 10,102,449 and IPR2023-01171 challenging U.S. Patent 11,113,585 have since been terminated. Patent Owner has since dropped the '449 and '585 patents from the Delaware litigation.

begin until June 23, 2025—i.e., 5+ months after the FWD. Ex. 2005. The current median time-to-trial in Delaware (36.7 months) also projects that trial would not begin until late November 2025—i.e., 10+ months after the FWD. Factor 2 weighs strongly against denial.

Factor 3 (Investment in Parallel Proceedings): Petitioner filed this Petition on June 30, 2023, more than four months before the statutory deadline (November 8, 2023), and currently, “the most burdensome stages of the case[]—completing discovery, preparing expert reports, filing and responding to pretrial motions, preparing for trial, going through the trial process, and engaging in post-trial motions practice—all lie in the future.” *IOENGINE, LLC v. PayPal Holdings, Inc.*, No. 18-452-WCB, 2019 WL 3943058, at *5 (D. Del. Aug. 21, 2019). Fact discovery in the Delaware action does not close until February 23, 2024. Claim construction briefing is set for April-June 2024, with a hearing on July 26, 2024. Ex. 2005. Expert discovery does not even *start* until September 2024. *Id.* Trial is set for June 2025. *Id.* Thus, Factor 3 weighs strongly against exercising discretion to deny institution.

Factor 4 (Overlap of Issues): With trial in Delaware lagging significantly behind a FWD in this IPR (*see* Factor 2), Petitioner would be estopped under 35 U.S.C. § 315(e) from asserting in the Delaware trial that any challenged claim in this IPR is invalid based on the same grounds or any other ground that reasonably could

have been raised here. There is therefore no risk of adjudication of overlapping issues.

Nonetheless, to the extent any concern remains, Petitioner stipulates that, if the Board institutes IPR on the Petition grounds, Petitioner will not pursue an invalidity defense in the district court (C.A. No. 22-cv-1466-MN) that the patent claims subject to the instituted IPR are invalid based on the same Petition grounds. *Sand Revolution II*, Paper 24 at 12. Thus, Factor 4 weighs strongly against denial.

Factor 6: (Other Circumstances): Grounds 1-3 based on Grotmol, POSITA's knowledge, Hickman, and Hoffman demonstrate that the claim features the Examiner identified in his reasons for allowance—including that “the first one or more digital pictures depict at least a portion of a first device's surrounding”—were in fact known in the prior art before the '583 Patent. *See* Ex. 1002, p. 22; Pet., 10-11. The Petition's unpatentability challenges are compelling, and *Fintiv* denial is not warranted.

Dated: November 22, 2023

/Nicholas W. Stephens/
W. Karl Renner, Reg. No. 41,265
Nicholas W. Stephens, Reg. No. 74,320
Fish & Richardson P.C.
60 South Sixth Street
Minneapolis, MN 55402
T: 202-783-5070
F: 877-769-7945

Attorneys for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on November 22, 2023, a complete and entire copy of this Petitioner's Reply to Patent Owner's Preliminary Response, were provided via email, to the Patent Owners by serving the email correspondence addresses of record as follows:

Arvind Jairam Reg. No. 62,759
Blair M. Jacobs (*pro hac vice*)
Christina Ondrick Reg. No. 46,198
John Holley Reg. No. 65,683
Stuart McCommas Reg. No. 71,834
MCKOOL SMITH, P.C.
1999 K St. NW, Suite 600
Washington, DC 20006 Telephone:
(202) 370-8300
Facsimile: (202) 370-8344

George Fishback Reg. No. 76,345
MCKOOL SMITH, P.C.
303 Colorado Street, Suite 2100
Austin, TX 78701
Telephone: (512) 692-8700
Facsimile: (512) 692-8744
E-mail: Autonomous_IPRs@mckoolsmith.com

/Crena Pacheco/
Crena Pacheco
Fish & Richardson P.C.
60 South Sixth Street
Minneapolis, MN 55402
pacheco@fr.com