

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,
Petitioner

v.

AUTONOMOUS DEVICES, LLC,
Patent Owner

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

PATENT OWNER'S PRELIMINARY SUR-REPLY

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	THE <i>FINTIV</i> FACTORS FAVOR DENIAL OF INSTITUTION	1

TABLE OF AUTHORITIES

	Page(s)
CASES	
<i>Samsung Elecs. v. Ancora Tech.</i> , IPR2020-01184, Paper 11 (PTAB Jan. 5, 2021)	2
<i>Snap, Inc. v. SRK Technology LLC</i> , IPR2020-00820, Paper 15 (PTAB Oct. 21, 2020)	2
<i>Sotera Wireless, Inc. v. Masimo Corp.</i> , IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020)	2
STATUTES	
35 U.S.C. § 314(a)	1

Exhibit List

Exhibit	Description
2001	Biography of Blair M. Jacobs (previously submitted)
2002	Declaration of Blair M. Jacobs (previously submitted)
2003	Supplemental Declaration of Blair M. Jacobs (previously submitted)
2004	District Court Docket (previously submitted)
2005	District Court Scheduling Order (previously submitted)
2006	District Court Invalidity Contentions (previously submitted)

I. INTRODUCTION

As authorized by the Board via order on November 21, 2023, Autonomous Devices, LLC (“Patent Owner” or “PO”) submits this Preliminary Sur-Reply responding to Petitioner’s Reply to Patent Owner’s Preliminary Response (Petitioner’s Reply is Paper No. 19, and PO’s Preliminary Response (“POPR”) is Paper No. 11). This Preliminary Sur-Reply is timely filed pursuant to the Board’s November 21, 2023 order (Paper No. 18), as it is filed by December 1, 2023. The Board should exercise its discretion to deny institution under 35 U.S.C. § 314(a), as five of the six *Fintiv* factors favor discretionary denial.

II. THE *FINTIV* FACTORS FAVOR DENIAL OF INSTITUTION

Petitioner is wrong that “the *Fintiv* factors weigh strongly against discretionary denial.” Reply, 1. The first *Fintiv* factor favors denial because there is no stay in the district court proceeding and there is a low likelihood of a stay given the advanced stage of the underlying litigation. Petitioner’s citation to *Sand Revolution II* is inapposite (Reply, 1), as the Board in that case lacked specific evidence regarding the likelihood of a stay. The advanced stage of the litigation here provides evidence that a stay is unlikely.

The third *Fintiv* factor also weighs in favor of denial because the parties and the district court have expended significant time and resources on the litigation. Petitioner does not dispute this fact but cites an inapplicable district court decision

denying a stay where deposition discovery had not even started. Reply, 2. By mid-January 2024 (the institution decision deadline), the parties will have begun deposition discovery, document and other discovery will be in advanced stages, and both parties will have expended even more resources on discovery. And Petitioner has not filed an IPR on every patent involved in the district court litigation.

Regarding the fourth *Fintiv* factor, Petitioner's recent stipulation in its Reply (Reply, 3) confirms that Petitioner recognized the need for some type of stipulation, but provided a weak stipulation under *Sand Revolution* that falls short of a *Sotera* stipulation. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020). As a result, *Fintiv* factor four favors denial. *See Samsung Elecs. v. Ancora Tech.*, IPR2020-01184, Paper 11 at 21-22 (PTAB Jan. 5, 2021).

Petitioner does not dispute that factor five favors denial, and factor six also favors denial because, as discussed above and in the POPR, Petitioner's invalidity arguments are weak. And although factor two may not favor denial, no factor is dispositive, *see Snap, Inc. v. SRK Technology LLC*, IPR2020-00820, Paper 15 at 19 (PTAB Oct. 21, 2020), and five of six factors favor denial, so the Board should deny institution.

Dated: November 28, 2023

Respectfully submitted,

/Arvind Jairam/

Arvind Jairam

Reg. No. 62,759

AJairam@mckoolsmith.com

Blair M. Jacobs (*pro hac vice*)

BJacobs@mckoolsmith.com

Christina Ondrick

Reg. No. 46,198

COndrick@mckoolsmith.com

John Holley

Reg. No. 65,683

JHolley@mckoolsmith.com

Stuart McCommas

Reg. No. 71,834

SMccommas@mckoolsmith.com

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

GFishback@mckoolsmith.com

McKool Smith, P.C.

303 Colorado Street, Suite 2100

Austin, TX 78701

Telephone: (512) 692-8700

Facsimile: (512) 692-8744

Counsel for Patent Owner

CERTIFICATION OF PAGE COUNT

The undersigned hereby certifies that **PATENT OWNER'S
PRELIMINARY SUR-REPLY** is 3 pages or less as required by the Board's
November 21, 2023 order.

Dated: November 28, 2023

By: /Arvind Jairam/
Arvind Jairam, Reg. No. 62,759

CERTIFICATION OF SERVICE

The undersigned hereby certifies that a copy of this **PATENT OWNER'S PRELIMINARY SUR-REPLY** has been served on Petitioner via email on the following counsel of record for Petitioner:

W. Karl Renner
Nicholas W. Stephens
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
Email: IPR49649-0028IP2@fr.com

Dated: November 28, 2023

By: /Arvind Jairam/
Arvind Jairam, Reg. No. 62,759