

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,
Petitioner,

v.

IQAR INC.,
Patent Owner.

IPR2024-00543
Patent 10,882,399 B2

Before ROBERT L. KINDER, SEAN P. O'HANLON, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

O'HANLON, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request on Rehearing of Final Written Decision
35 U.S.C. § 42.71(d)(2)

I. INTRODUCTION

On July 21, 2025, we issued a Final Written Decision in this proceeding, determining that Petitioner had shown, by a preponderance of the evidence, that claims 1–7, 9–17, 19, and 20 of U.S. Patent No. 10,882,399 B2 (Ex. 1001, “the ’399 patent”) were unpatentable, but Petitioner failed to show, by a preponderance of the evidence, that claims 8 and 18 of the ’399 patent were unpatentable. Paper 23 (“Dec.” or “Decision”). On August 20, 2025, Tesla, Inc. (“Petitioner”) filed a Request for Rehearing (Paper 24, “Reh’g Req.”) under 37 C.F.R. § 42.71(d) to seek reconsideration of the Decision. For reasons discussed below, the Request for Rehearing is *denied*.

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). The party must identify specifically all matters we misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply. *Id.*

III. ANALYSIS

Petitioner presents two arguments asserting that, in the Decision, we misapprehended matters in determining that Petitioner did not prove, by a preponderance of the evidence, that claims 8 and 18 would have been

obvious in view of the combination of Hongo,¹ Obradovich,² Niki,³ and Newstrom.⁴ *See generally* Reh’g Req. We address each of Petitioner’s arguments in turn below.

A. Statement of Petitioner’s Counsel During the Hearing

Petitioner asserts that we misapprehended its counsel’s answer to a question posed by the Board during the hearing. Reh’g Req. 6–8. Petitioner asserts that the question we asked indicates that we misapprehended its “invalidity positions for claims 8 and 18 [to be] ‘solely’ limited to Newstrom’s disclosure in column 8, lines 28 to 29.” *Id.* at 6 (citing Paper 22 (the hearing transcript, “Tr.”), 19:14–18). Similarly, Petitioner asserts that we misapprehended “the statement provided by counsel of Tesla’s unpatentability positions regarding claims 8 and 18 being ‘solely’ limited to column 8, lines 28 to 29 of Newstrom.” *Id.* Petitioner asserts that, in addition to this portion of Newstrom’s disclosure, Petitioner also relied on other portions of Newstrom and the testimony of its witness, Dr. Morellas’. *Id.* at 6–8 (citing Paper 2 (Petition, “Pet.”), 83; Paper 15 (Reply to the Patent Owner Response, “Pet. Reply”), 29; Ex. 1012, 8:15–38, 19:19–22; Ex. 1003 (Dr. Morellas’ first declaration) ¶ 197; Ex. 1053 (Dr. Morellas’ second declaration) ¶ 99).

Petitioner’s arguments fail to persuade us that we misapprehended or overlooked any matter. As we explained in the Decision, claims 8 and 18

¹ English-language translation of JP 2003-276472 (Ex. 1005).

² US 6,282,464 B1 (Ex. 1008).

³ US 7,059,435 B2 (Ex. 1009).

⁴ US 7,552,008 B2 (Ex. 1012).

recite “communicating with a remote database.” Dec. 38 (citing Ex. 1001, 28:7–10, 28:55–57). We explained that Petitioner relied on Newstrom to teach the recitation, mapping Newstrom’s geospatial database to the recited database and arguing that Newstrom’s geospatial database is remote from the vehicle based on Newstrom’s disclosure of using a “wireless connection.” *Id.* (citing Pet. 82–83; Ex. 1012, 7:56–64, Fig. 3; Ex. 1003 ¶¶ 196–197). We further noted that Petitioner argued that Newstrom’s system communicates with the geospatial database while the vehicle is being driven. *Id.* (citing Pet. 83; Ex. 1012, 8:26–38; Ex. 1003 ¶ 197). Finally, we noted that Patent Owner argued Newstrom’s geospatial database is stored on the vehicle itself, and is therefore not remote as required by claims 8 and 18. *Id.* at 39–40.

In the Petition, Petitioner argued that Newstrom’s “geospatial database 20 may be hosted on a server that is remote from a vehicle, and implemented as a remote database.” Pet. 83 (emphasis omitted) (citing Ex. 1012, 8:26–38). Dr. Morellas’ testimony is substantially the same as the Petition. *See* Ex. 1003 ¶ 197 (“Further, Newstrom describes that database 20 can be loaded by database manager 22 into ‘solid state memory’ located in a vehicle through a ‘wireless connection to server,’ and thus, geospatial database 20 may be hosted on a server that is remote from a vehicle, and implemented as a remote database.” (emphasis omitted) (citing Ex. 1012, 8:26–38)). The cited portion of Newstrom states, in relevant part, “When database manager 22 is first initialized, it loads database 20 (from a CD, DVD, hard disk, *wireless connection to server*, etc.) into solid state memory.” Ex. 1012, 8:27–29 (emphasis added).

During the hearing, Petitioner addressed claims 8 and 18 very briefly, stating that “[w]e respectfully leave the full discussion to our briefing.” Tr. 6:1–13. We questioned Petitioner’s counsel later in the hearing to confirm our understanding that Petitioner relied only on Newstrom’s disclosure of a “wireless connection” in arguing that the geospatial database is remote from the vehicle: “It’s my understanding from reading the briefs that for the remote database limitation of Claim 8, you rely, I think, solely on the disclosure of a wireless connection to the server at column 8, lines 28 to 29, I believe, of the Newstrom reference. Is that correct?” Tr. 19:15–18. Petitioner’s counsel responded by indicating that our understand of Petitioner’s arguments was correct (“That’s correct, Your Honors.”) and arguing that communication with the asserted remote database occurs both during initialization and in subsequent communications when the vehicle is being driven. *Id.* at 19:19–24.

We did not misapprehend or overlook the answer provided by Petitioner’s counsel during the hearing or any of Petitioner’s arguments and evidence. As confirmed by Petitioner’s counsel, Petitioner relies solely on Newstrom’s disclosure of loading its spatial database 20 into solid state memory via a “wireless connection to [a] server” in asserting that the database “may be hosted on a server that is remote from a vehicle.” Pet. 83 (citing Ex. 1012, 8:26–38; Ex. 1003 ¶ 197). Column 8, lines 27–29 is the only disclosure in Newstrom of a “wireless connection.” Although Petitioner argues that Newstrom’s system communicates wirelessly with the geospatial database while the vehicle is being driven (*see* Dec. 38 (citing Pet. 83); Tr. 19:20–22), Petitioner relies solely on the single instance of “wireless” in Newstrom’s disclosure to satisfy the recitation that the

database (which Petitioner maps to Newstrom's geospatial database 20) is "remote." In the Decision, we explained that Petitioner's reliance on Newstrom's "wireless connection" and its assertion that the geospatial database *may* be hosted on a remote server were not persuasive to satisfy Petitioner's burden to prove the unpatentability of claims 8 and 18 by a preponderance of the evidence, especially given Newstrom's express disclosure that the geospatial database is located on the vehicle. Dec. 40–42. For example, we stated:

Petitioner does not explain adequately why Newstrom's disclosure that, when first initializing the database manager, the geospatial database is loaded into solid state memory by, for example, wirelessly transferring data from a server means that the geospatial database is remote from the vehicle. Similarly, Petitioner does not explain adequately why Newstrom's disclosure that the database manager can load new portions of the data into solid state memory as the vehicle location changes means that the geospatial database is remote from the vehicle. Nor does Petitioner's conclusory contention that "the geospatial database 20 *may* be hosted on a server that is remote from a vehicle" (Pet. 83 (emphasis added)) apprise us of disclosure that Newstrom's geospatial database *is* remote from the vehicle. Dr. Morellas' testimony is substantially identical to the Petition (*see* Ex. 1003 ¶197) and, thus, also fails to provide adequate support for Petitioner's assertions.

During the hearing, counsel for Petitioner confirmed that it relied solely on Newstrom's disclosure of the database using a "wireless connection" by which the database manager communicates with the database in arguing that Newstrom's geospatial database 20 is remote from vehicle 12. Tr. 19:14–24; *see also* Ex. 1012, 8:27–29. Petitioner, however, fails to explain adequately how such wireless communication indicates that the database is not located on vehicle, especially given Newstrom's express disclosure (discussed above) that the database is onboard the vehicle.

Dec. 41–42.

B. Petitioner’s Reply and Dr. Morellas’ Second Declaration

Petitioner asserts that we overlooked the arguments presented on page 29 of its Reply and paragraph 99 of Dr. Morellas’ second declaration. Reh’g Req. 8–11. Petitioner asserts that we ignored its argument “on page 29 of the Reply, [where it] identified expert testimony explaining that (1) column 8, lines 15-25 of Newstrom identifies a challenge associated with retrieval of valid information, and (2) a remote-server configuration ‘improve[s] accuracy of the information specified in the geospatial database 20.’” *Id.* at 9 (second alteration in original). Petitioner argues that this disclosure “confirms the rationale in the dissenting opinion for diverging from the majority opinion” and “provides evidentiary support for findings in the dissenting opinion with respect to Newstrom’s disclosure.”⁵ *Id.* at 9–10.

Initially, Petitioner’s reliance on assertions made in its Reply, relying on Dr. Morellas’ second declaration, fail to persuade us that we overlooked or misapprehended any arguments made in the *Petition*. Such post-institution arguments attempting to bolster the *Petition* are untimely and, thus, improper. *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide 73 (Nov. 2019).⁶

Even considering Petitioner’s Reply arguments, however, we are not persuaded that we overlooked or misapprehended any matter. As stated

⁵ For clarity of the record, we note that our dissenting colleague is no longer an administrative patent judge and, therefore, has been replaced on the panel presiding over this proceeding. *See* Paper 25.

⁶ *Available at* www.uspto.gov/TrialPracticeGuideConsolidated.

above and in the Decision, Petitioner maps Newstrom’s geospatial database 20 to the recited database. Pet. 83; Dec. 38. It is this database that must be remote from the vehicle per claims 8 and 18. Ex. 1001, 28:7–10, 28:55–57; *see also* Dec. 40 (“The parties agree that ‘remote’ as used in claim 8 requires the database to be located somewhere other than on the vehicle.” (citing Pet. 83; PO Resp. 34)). Newstrom does not disclose that its geospatial database is remote from the vehicle—Newstrom does not disclose that any database or server is remote from the vehicle. Rather, Newstrom discloses multiple ways in which data can be loaded from the geospatial database into solid state memory, one such way being via a “wireless connection to [a] server.” Ex. 1012, 8:27–29. Petitioner and Dr. Morellas’ assertions that this disclosure “implies that [Newstrom’s system] could interact with an external server” and Newstrom’s “system architecture does not preclude communication with an external server” (Pet. Reply 29; Ex. 1053 ¶ 99) fails to persuade us that the server necessarily is remote, especially given Newstrom’s express disclosure that the geospatial database is located on the vehicle. Dec. 40–42 (citing Ex. 1012, 3:47–52, Fig. 1).

Furthermore, as we explained in the Decision, we found persuasive Patent Owner’s arguments traversing Petitioner’s assertions. *See* Dec. 39–40 (summarizing Patent Owner’s arguments and stating that “[w]e agree that Petitioner has not shown adequately that Newstrom’s geospatial database 20 is not located on the vehicle.”). At best for Petitioner, its arguments that the “wireless connection” indicates that Newstrom’s geospatial database could be located remotely from the vehicle are at least counterbalanced by Patent Owner’s arguments to the contrary, and, thus,

Petitioner has failed to prove the unpatentability of claims 8 and 18 by a preponderance of the evidence.

IV. CONCLUSION

In conclusion, the Request for Rehearing does not demonstrate that the Final Written Decision misapprehended or overlooked any matters in the case.

Outcome of Decision on Rehearing:

Claim(s)	35 U.S.C. §	Reference(s)/ Basis	Denied	Granted
8, 18	103(a)	Hongo, Obradovich, Niki, Newstrom	8, 18	

Final Outcome after Rehearing:

Claim(s)	35 U.S.C. §	Reference(s)/ Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1, 2, 5, 6, 9–12, 15, 16, 19, 20	103(a)	Hongo, Obradovich, Niki	1, 2, 5, 6, 9–12, 15, 16, 19, 20	
3, 4, 13, 14	103(a)	Hongo, Obradovich, Niki, Kudo	3, 4, 13, 14	
7, 17	103(a)	Hongo, Obradovich, Niki, Kuroda	7, 17	

Claim(s)	35 U.S.C. §	Reference(s)/ Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
8, 18	103(a)	Hongo, Obradovich, Niki, Newstrom		8, 18
Overall Outcome			1–7, 9–17, 19, 20	8, 18

V. ORDER

Accordingly, it is

ORDERED that the Request for Rehearing is *denied*.

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