

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,
Petitioner

v.

AUTONOMOUS DEVICES, LLC,
Patent Owner

Case: IPR2024-00745
U.S. Patent No. 11,663,474

**PATENT OWNER'S MOTION TO STRIKE PORTIONS OF
PETITIONER'S SUR-REPLY TO
PATENT OWNER'S MOTION TO AMEND**

I. INTRODUCTION

Pursuant to authorization granted via email July 21, 2025, PO moves to strike portions of Petitioner’s Sur-Reply to PO’s Motion to Amend (“MTA Sur-Reply,” Paper 34) containing new argument and evidence in violation of 37 C.F.R. § 42.23(b). Petitioner introduced new arguments and relied upon evidence for those arguments that were not presented in Petitioner’s Opposition to PO’s Motion to Amend (“MTA Opp.,” Paper 18).

II. LEGAL STANDARDS

All IPR petitioners are “afforded an opportunity to ***fully respond*** to a patent owner’s motion to amend.” PTAB Consolidated Trial Practice Guide (“TPG”), 72 (Nov. 2019) (emphasis added). Similar to the initial petition, which is “supposed to guide the life of the litigation,” *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1380 (Fed. Cir. 2023), the MTA Opposition is Petitioner’s chance to oppose the proposed amended claims. Because of that, it must “identify with particularity the evidence that supports the grounds for the challenge to each claim.” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3)). While a “sur-reply may only respond to arguments raised in the preceding brief,” this “does not mean” that a petitioner’s MTA Sur-Reply can “proceed in a new direction with a new approach as compared to the positions taken in a prior filing.” TPG, 74 (citing 37 C.F.R. § 42.23(b)).

III. ARGUMENT

Petitioner had its chance to “fully respond” to PO’s Motion to Amend (MTA) when it filed its MTA Opposition (Paper 18). *See* TPG, 72. Petitioner should not be allowed to introduce new arguments that were not presented in its MTA Opposition nor are responsive to arguments raised in PO’s Reply in Support of Contingent Motion to Amend (“MTA Reply,” Paper 26). *See, e.g.*:

- MTA Sur-Reply at 5 (new argument and evidence regarding whether “Zhu’s coordinates ... also define physical characteristics of the detected object.”). The MTA Opposition at 11-12 only discusses the size and location of Zhu’s “bounding box,” which is measured in *pixels*. Recognizing its error, Petitioner changed course and discussed multiple, never-before-cited portions of Zhu that allegedly explain how its bounding boxes “can be measured in physical units.” Those disclosures of Zhu (Ex. 1023, 18:36-47, 20:34-40, 20:67-21:17) were *never argued* in the MTA Opposition. Petitioner then wrongly chastises PO’s expert, Dr. Saber, for addressing the arguments *actually presented* in Petitioner’s MTA Opposition, rather than the lone disclosure (Ex. 1023, 15:1-20) that Petitioner only ever included in string cites without any explanation whatsoever. Petitioner’s reliance on these new disclosures and the associated argument should be stricken.

- MTA Sur-Reply at 6 (new argument and evidence regarding Zhu’s supposed disclosure of “depth information”). Petitioner relies on a newly-cited

portion of Zhu (*id.*, 9:57-10:11) and another that was cited for a different purpose (*id.*, 8:39-46) to argue that Zhu discloses “distances of detected objects to the vehicle” and “3D images.” Petitioner was free to include in its MTA Opposition whatever portions of Zhu it wanted to map onto the claimed object representation data structures, but this argument is entirely new. Petitioner should not be allowed to supplement its cursory arguments after PO has identified flaws.

- MTA Sur-Reply at 6-7 (new argument and evidence regarding Zhu’s disclosure of “objects being represented in a ‘point cloud image’”). The MTA Opposition’s discussion of limitations [85.11]-[85.12] never mentioned, let alone discussed meaningfully, FIG. 8 of Zhu. Any reference to Zhu’s figures (most notably FIG. 9) is concerned with “labeling the type of detected object and defining bounding boxes.” MTA Opp., 13. Petitioner cannot now point to new figures and say that it discloses technical concepts that Petitioner could have and should have argued in its MTA Opposition.

IV. CONCLUSION

For the reasons set forth above, PO requests the Board to strike the arguments and portions of evidence set forth above.

Dated: July 24, 2025

Respectfully submitted,

/Arvind Jairam/

Arvind Jairam

Reg. No. 62,759

airam@mckoolsmith.com

MCKOOL SMITH, P.C.

1717 K St. NW, Suite 1000

Washington, DC 20006

Telephone: (202) 370-8300

Facsimile: (202) 370-8344

Scott W. Hejny

Reg. No. 45,882

shejny@mckoolsmith.com

MCKOOL SMITH, P.C.

300 Crescent Court, Suite 1200

Dallas, TX 75201

Telephone: (214) 978-4000

Facsimile: (214) 978-4044

Counsel for Patent Owner

CERTIFICATION OF SERVICE

The undersigned hereby certifies that a copy of this **PATENT OWNER'S MOTION TO STRIKE PORTIONS OF PETITIONER'S SUR-REPLY TO PATENT OWNER'S MOTION TO AMEND** has been served on Petitioner via email on the following counsel of record for Petitioner:

W. Karl Renner
Nicholas W. Stephens
Roberto Devoto
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
IPR49649-0038IP1@fr.com

Ashraf Fawzy
Tesla, Inc.
800 Connecticut Ave NW
Washington, DC 20006
afawzy@tesla.com

Dated: July 24, 2025

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