

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAMBRIDGE MOBILE TELEMATICS, INC.
Petitioner

v.

SFARA, INC.
Patent Owner

Case IPR2024-00952
U.S. Patent No. 8,989,952

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

Patent Owner Sfara , Inc. (“Sfara”) submits this Sur-Reply to address the new arguments and evidence submitted with the Cambridge Mobile Telematics, Inc.’s (“CMT’s”) Reply and in support of Patent Owner’s Preliminary Response (“POPR”), pursuant to the Board’s authorization granted on October 10, 2024.

CMT presents evidence from the parallel district court case (the “Litigation”) that was already before the Board. *Compare* POPR, 4-8; EX2003, Dkt. Nos. 36, 128 *with* Reply, 5; EX1029, EX1030. And CMT’s newly presented stipulation is too narrow to change the calculus regarding the overlap between the Litigation and its Petition (“Pet.”), so all six *Fintiv* factors (*see* POPR, 18-19) still weigh in favor of discretionary denial.

Factor 1: There is no dispute: a stay is extremely unlikely, and this factor still weighs strongly in favor of denial. *See* POPR, 20-22.

Factor 2: CMT finds no “inaccuracies” in Sfara’s description of the Litigation, instead throwing up imaginary “procedural hurdles,”¹ none of which would prevent the Court from scheduling trial before the December 2025 Final Written Decision (“FWD”) due date. Reply, 2-3; *see* Fed R. Civ. P. 16(b); POPR, 23-24. In fact, if CMT is granted the relief it recently requested, the Litigation will

¹ These include CMT’s own tardy production, for which it should not benefit here.

See Reply, 2; EX 2012, Dkt. Nos. 131-32, 135-37, 139, 142-43, 156, 160; EX2013.

likely move even faster. *See* EX2014; EX2015. CMT denies that the Litigation is moving faster towards trial than the district’s statistical median but doesn’t understand its own statistics—inexplicably suggesting a trial date much later than the 2026 trial date it previously postulated. *Compare* Pet., 86 to Reply, 2. The Parties are discussing a schedule that would allow the Court to set a trial date before (or around the same time as) the FWD date, so Factor 2 still weighs in favor of denial.

Factor 3: CMT identifies nothing “misleading” in Sfara’s discovery volume summary or the issues before the Court in the Litigation, presenting only unsupported arguments. *Compare* POPR, 4-8 with Reply, 4. CMT does not dispute that the parties and the Court have invested substantial resources in the Litigation, and will continue to do so—including: setting and conducting the *Markman* hearing; completing one remaining fact discovery issue; and conducting expert discovery—all before the December 17 institution due date. *See id.*; EX2012, Dkt. Nos. 135-166; EX2013; EX2016. Here, there is already substantial investment by the Court and parties, so even if there is “work to be done on the district court case,” Factor 3 still weighs in favor of denial. *Samsung Elecs. Co. v. Mojo Mobility Inc.* (“*Mojo*”), IPR2023-01093, Paper 11, 9 (Jan. 8, 2024); *see* POPR, 24-27.

Factor 4: This factor requires comparing a petition’s “**grounds**” to the “district court proceeding[’s] ... **prior art** and **arguments**[.]” *NHK Spring Co. v.*

Intri-Plex Techs., Inc., IPR2018-00752, Paper 8, 19-20 (Sep. 12, 2018)

(precedential); Director’s Memorandum re: Interim Procedure for Discretionary Denials (the “Memo”; *see* POPR, 3) at 7. There is no dispute that CMT’s **grounds** “completely overlap” its **prior art** and **arguments** in the Litigation. POPR, 8 n. 8, 27-29; *see* Reply, 5. CMT presents a stipulation (*id.*), but it is not a proper *Sotera* stipulation, which is “a stipulation not to pursue in a parallel proceeding the same **grounds** or any **grounds** that could have reasonably been raised before the PTAB.” POPR, 28 (emphasis added; *quoting* Memo, 3). CMT fails to make a full *Sotera* stipulation because it is limited to “**arguments**” rather than “**grounds**,” and omits the word “reasonably.” CMT’s stipulation is thus **narrower** than what the Memo requires. Accordingly, CMT crafted its stipulation so that it can continue to rely—in the Litigation—on **prior art** that was raised, or could have been raised, in an IPR. The Board has repeatedly denied institution where petitioner presented a stipulation “**narrower** than the *Sotera* stipulation **approved in the ... Memo**[.]” *Mojo*, IPR2023-01093, Paper 11, 14-18 (Jan. 8, 2024) (emphasis added); *see BOE Tech. Group Co. v. Element Cap. Comm’l Co.*, IPR2023-00808, Paper 9, 24-26 (Nov. 15, 2023) (Memo “does not apply here.”); *Samsung Elecs. Co. v. Cal. Inst. of Tech.*, IPR2023-00137, Paper 10, 14-15 (May 4, 2023) (stipulation “does not qualify for the treatment described in [the Memo]”). CMT’s unusually narrow, unapproved stipulation language permits full use of its prior art in the district court

if argued differently, so it will not reduce the Petition/Litigation overlap. Factor 4 continues to weigh in favor of denial.

Factor 5: No dispute; weighs in favor of denial. *See* POPR, 29.

Factor 6: CMT employs wishful thinking to argue that Sfara failed to “substantively engage” with the Petition’s arguments, ignoring the POPR’s detailed analysis of CMT’s faulty claim construction arguments. Reply, 4-5; *see* POPR, 10-17, 30-32. Moreover, in a “compelling merits analysis, ... ‘the **petitioner has the burden** from the onset to show with particularity why the patent it challenges is unpatentable.’” *Int’l Bus. Mach. Corp. v. Digital Doors, Inc.*, IPR2023-00972, Paper 7, 12-13 (Jan. 11, 2024) (denying institution; quoting *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363. (Fed. Cir. 2016)) (emphasis added). CMT entirely fails to shoulder its burden to “provide sufficient analysis explaining why or how” its evidence meets the “compelling merits” test. *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23, 5 (Feb. 27, 2023) (precedential); Memo, 5.

“[CMT’s] strategy undermines its argument that the Petition presents a compelling unpatentability challenge. ... [CMT] is asking [the Board] to review the unpatentability arguments under a construction it already asserted in district court is wrong. ... For this reason, the Petition fails to meet the compelling merits standard, and this factor weighs in favor of exercising discretion to deny

institution.” *ResMed Corp. v. Cleveland Med. Devices Inc.*, IPR2023-00565, Paper 13, 17-18. (Sep. 25, 2023); *see* POPR, 30-31 (collecting cases). CMT fails to explain what its “plain and ordinary claim constructions” are. Reply, 4; *see* POPR, 14 n. 11; *T-Mobile USA, Inc. v. Cobblestone Wireless LLC*, IPR2024-00136, Paper 18, 23 (Jun. 5, 2024) (denying institution; no compelling merits where “Petitioner never explains what the plain and ordinary meaning of the term is[.]”). And CMT never actually compares those constructions—or any constructions—to the prior art. *Id.*

CMT’s claim construction strategy has resulted in a deficient petition that falls far short of meeting the “compelling merits” test. CMT fails—even when given a second chance—to identify evidence that would make it “highly likely” to prevail at trial. *CommScope*, IPR2022-01242, Paper 23, 3-4. Factor 6 weighs strongly in favor of denial.

All Fintiv Factors Favor Denial: CMT’s only new evidence is its narrow stipulation, which fails to move the needle. All six factors still weigh in favor of discretionary denial, as instituting trial would plainly result in “duplicative efforts between the PTAB and the Federal Courts.” Memo, 6. The Board should exercise its discretion and deny institution under § 314(a).

Date: Nov. 4, 2024

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PATENT OWNER'S UPDATED EXHIBIT LIST

Ex. No.	Description
2001	Complaint, <i>Cambridge Mobile Telematics, Inc. v. Sfara, Inc.</i> , No. 3:23-cv-01368 (D.N.J.), filed Mar. 3, 2023, Dkt. No. 1
2002	Sfara Inc.'s Answer, Affirmative Defenses, and Counterclaims to Cambridge Mobile Telematics, Inc.'s Complaint for Patent Infringement, <i>Cambridge Mobile Telematics, Inc. v. Sfara, Inc.</i> , No. 3:23-cv-01368 (D.N.J.), filed Jun. 7, 2023, Dkt. No. 12
2003	Docket Report dated Sep. 17, 2024, <i>Cambridge Mobile Telematics, Inc. v. Sfara, Inc.</i> , No. 3:23-cv-01368 (D.N.J.)
2004	Amended Joint Claim Construction Statement, <i>Cambridge Mobile Telematics, Inc. v. Sfara, Inc.</i> , No. 3:23-cv-01368 (D.N.J.), filed Jun. 17, 2024, Dkt. No. 105
2005	Joint Letter, <i>Cambridge Mobile Telematics, Inc. v. Sfara, Inc.</i> , No. 3:23-cv-01368 (D.N.J.), filed Aug. 19, 2024, Dkt. No. 126
2006	Order, <i>Cambridge Mobile Telematics, Inc. v. Sfara, Inc.</i> , No. 3:23-cv-01368 (D.N.J.), filed Aug. 21, 2024, Dkt. No. 129
2007	Declaration of Cathy Pampinella
2008	Plaintiff and Counterclaim-Defendant Cambridge Mobile Telematics, Inc.'s Invalidity Contentions, <i>Cambridge Mobile Telematics, Inc. v. Sfara, Inc.</i> , No. 3:23-cv-01368 (D.N.J.), Oct. 26, 2023
2009	Exhibit B-01 to CMT's Invalidity Contentions: Comparison of U.S. Patent No. 9,333,946 and Abramson '480, <i>Cambridge Mobile Telematics, Inc. v. Sfara, Inc.</i> , No. 3:23-cv-01368 (D.N.J.), Oct. 26, 2023
2010	Exhibit B-04 to CMT's Invalidity Contentions: Comparison of U.S. Patent No. 9,333,946 and Fong, <i>Cambridge Mobile Telematics, Inc. v. Sfara, Inc.</i> , No. 3:23-cv-01368 (D.N.J.), Oct. 26, 2023
2011	Pretrial Scheduling Order, <i>Cambridge Mobile Telematics, Inc. v. Sfara, Inc.</i> , No. 3:23-cv-01368 (D.N.J.), filed Jul. 26, 2023, Dkt. No. 35
2012	Docket Report dated Nov. 4, 2024, <i>Cambridge Mobile Telematics, Inc. v. Sfara, Inc.</i> , No. 3:23-cv-01368 (D.N.J.)
2013	Joint Letter, <i>Cambridge Mobile Telematics, Inc. v. Sfara, Inc.</i> , No. 3:23-cv-01368 (D.N.J.), filed Oct. 28, 2024, Dkt. No. 160
2014	Letter, <i>Cambridge Mobile Telematics, Inc. v. Sfara, Inc.</i> , No. 3:23-cv-01368 (D.N.J.), filed Oct. 3, 2024, Dkt. No. 148
2015	Letter, <i>Cambridge Mobile Telematics, Inc. v. Sfara, Inc.</i> , No. 3:23-cv-01368 (D.N.J.), filed Oct. 10, 2024, Dkt. No. 154
2016	Joint Letter, <i>Cambridge Mobile Telematics, Inc. v. Sfara, Inc.</i> , No. 3:23-cv-01368 (D.N.J.), filed Oct. 29, 2024, Dkt. No. 163

CERTIFICATE OF SERVICE

(37 C.F.R. § 42.6(e))

The undersigned hereby certifies that on Nov.4, 2024, I caused true and correct copies of the following materials:

- Patent Owner's Preliminary Response
- Patent Owner's Updated Exhibit List
- Exhibits 2012-2016

to be served via e-mail on the following:

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