

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOBILEYE GLOBAL, INC.,

Petitioner,

v.

FACET TECHNOLOGY CORP.,

Patent Owner.

Case IPR2024-01110

Patent No. 9,335,255

**PETITIONER'S PRE-INSTITUTION REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

There are two issues the Board authorized Petitioner to file its pre-institution reply regarding: (1) Patent Owner's proposed definition for "characterization profile;" and (2) discretionary denial under *Fintiv*. Ex. 3001. The Board should not adopt Patent Owner's inconsistent definition. And based on Petitioner's *Sotera* stipulation, any basis for discretionary denial under *Fintiv* is moot.

I. PATENT OWNER'S "CHARACTERIZATION PROFILE" CONSTRUCTION FAILS TO UNDERMINE THE PETITION'S SHOWING OF A REASONABLE LIKELIHOOD OF SUCCESS

Despite Patent Owner's Preliminary Response (Paper 7, "POPR") stating that Patent Owner "does not contend that any claim term should receive an express construction," Patent Owner's primary distinction over the prior art hinges on its interpretation of the claimed "characterization profile" in claim 15 (the only challenged claim remaining after Patent Owner's statutory disclaimer). POPR 12. This most recent Patent Owner interpretation of the "characterization profile" is inconsistent with its prior interpretation in a parallel district court proceeding. Moreover, even under Patent Owner's new interpretation, the prior art teaches the claimed "characterization profile." The Board should find that the Petition presents a reasonable likelihood of success by either: (i) holding Patent Owner to its interpretation of the term "characterization profile" in its district court contentions (*Scout Energy Mgmt., LLC v. Pilot Intellectual Prop., LLC*, IPR2024-00385, Paper 11 at 15 (Aug. 9, 2024) (refusing to adopt Patent Owner's construction because

“adopting [its] proposed construction may result in an inconsistency between the Board and the district court” based on conflicting infringement positions)); or (ii) finding no construction necessary to resolve the dispute because *Lumia* teaches the term under any construction (*Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe only those terms that are in controversy, and only to the extent necessary to resolve the controversy.”) (internal quotations omitted))).

A. Patent Owner should be held in this IPR to the construction it presented in the district court, under which the Prior Art teaches the claimed “characterization profile.”

In the district court proceeding, Patent Owner read the “characterization profile” on a histogram without further conditions. *See* Ex. 1023 (’255 Preliminary Infringement Contentions Chart), 14-15. Now, Patent Owner urges a construction that adds further conditions to what qualifies as a “characterization profile.” POPR 12-13. More specifically, in the district court, Patent Owner argues that “a histogram (e.g., a characterization profile) of collected data from sensors,” irrespective of conditions for collecting data, satisfies the “characterization profile” recitation of claim 15. Ex. 1023, 14-15. In this IPR however, Patent Owner now argues that a characterization profile requires collecting data under various conditions. POPR 13. Rather than accepting Patent Owner’s new construction inconsistent with its earlier construction in the District Court, the Board should

follow its *Scout Energy* precedent and hold Patent Owner to its district court construction in this IPR.

As set forth in the Petition, under the Patent Owner's district court construction, Lumia teaches the claimed "characterization profile." *See* Petition (Paper 1, 44-47).

B. The Prior Art discloses a "characterization profile" even under Patent Owner's new, narrower construction.

Even under the new interpretation proposed in the POPR, Lumia teaches the claimed "characterization profile." To make its new argument, Patent Owner mischaracterizes Lumia as failing to disclose a "characterization profile" based on multiple conditions. In fact, Lumia teaches a "characterization profile" based on a set of sensor characteristics across various conditions (e.g., different sign placements within the field of view and different sign colors) to determine a luminance value. Lumia, 16.

Patent Owner disregards these Lumia teachings and instead focuses only on the "single" calibration in Lumia's experimental results section. POPR 13. This argument is a *non sequitur* because a single calibration does not exclude taking into account various conditions, as Lumia earlier discloses. (*See* preceding paragraph).

II. PETITIONER'S *SOTERA* STIPULATION MOOTS PATENT OWNER'S *FINTIV* ARGUMENT

Petitioner stipulates that if the Board institutes an IPR on this Petition, Petitioner will not pursue in the related district court proceeding, *Facet Technology Corp. v. Mobileye Global, Inc.*, 2:24-cv-00058-RWS-RSP (EDTX), “any ground that [Petitioner] raised or reasonably could have raised” during this proceeding. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020); 35 U.S.C. § 315(d). Under the Interim Procedure, this stipulation moots Patent Owner's *Fintiv* arguments. USPTO Memorandum “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” at 3.

III. Conclusion

Patent Owner's arguments should be rejected and trial instituted.

Date: January 13, 2025

Respectfully Submitted,

/Cory C. Bell/
Cory C. Bell
Reg. No. 75,096
Lead Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Petitioner's Reply to Patent Owner's Preliminary Response** was served electronically via email on January 13, 2025, in its entirety on the following:

Michael D. Saunders
msaunders@dickinson-wright.com

Bryan D. Atkinson
BATkinson@dickinson-wright.com

Linda L. Emerson
LEmerson@dickinson-wright.com

Patent Owner has consented to service by email.

Date: January 13, 2025

By: /Daniel E. Doku/
Daniel E. Doku
Senior Litigation Legal Assistant

Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP