

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOBILEYE GLOBAL, INC.,
Petitioner,

v.

FACET TECHNOLOGY CORP.,
Patent Owner.

IPR2024-01110, Patent 9,335,255
IPR2024-01111, Patent 9,671,328¹

Before KEVIN F. TURNER, ROBERT J. SILVERMAN, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

O'HANLON, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This Order applies to each of the listed proceedings. The parties are not authorized to use this caption for any subsequent papers absent prior authorization from the Board.

I. INTRODUCTION

A conference call in these proceedings was held on January 30, 2025, among Cory C. Bell, counsel for Petitioner Mobileye Global, Inc., Michael D. Saunders, counsel for Patent Owner Facet Technology Corp., and Judges Turner, Silverman, and O’Hanlon. Petitioner had a court reporter on the conference call, and the panel asked Mr. Bell to file a copy of the transcript as an exhibit in each proceeding.

II. DISCUSSION

The purpose of the call was to address Petitioner’s concerns with Patent Owner’s Preliminary Sur-reply (Paper 10):² 1) Petitioner’s assertion that Patent Owner included improper new arguments in its Preliminary Sur-reply, and 2) Petitioner’s assertion that Patent Owner improperly submitted new evidence with its Preliminary Sur-reply. We address each of these topics in turn below.

A. Alleged New Arguments

In its Preliminary Reply, Petitioner presents a stipulation that it describes as being similar to that provided in *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18–19 (PTAB Dec. 1, 2020) (precedential in relevant part). Paper 8, 4. In its Preliminary Sur-reply, Patent Owner argues that this stipulation is inadequate because “it only purports to bind Petitioner itself” and notes that Patent Owner has moved to add two additional parties to the co-pending district court litigation between

² Citations herein refer to Papers and Exhibits filed in IPR2024-01110. Similar documents were filed in IPR2024-01111.

Patent Owner and Petitioner, that these additional parties have filed a declaratory judgment complaint against Patent Owner in another district court, and that Patent Owner has sued another entity in a third litigation. Paper 10, 3–5. Petitioner argues that these arguments are new and unresponsive to the arguments it advanced in its Preliminary Reply.

As we explained during the conference call, Patent Owner’s arguments that the stipulation is inadequate are fairly in response to the stipulation, which Petitioner presented in its Preliminary Reply. During the conference call, we denied authorization for Petitioner to file a motion to strike Patent Owner’s arguments.

B. Petitioner’s Exhibits

Patent Owner filed five exhibits (Exhibits 2015–2019) with its Preliminary Sur-reply. Petitioner argues that we did not authorize Patent Owner to file these exhibits. We agree; we did not authorize Patent Owner to file any evidence with its Preliminary Sur-reply. *See* Ex. 3001. During the conference call, we admonished Patent Owner for filing these exhibits without first seeking authorization to do so.

We also heard arguments from the parties during the conference call as to whether we should consider these five exhibits. Petitioner argued that it has not had an opportunity to address this evidence, which it asserted to violate the Administrative Procedure Act. Patent Owner argued that its filing of these exhibits was foreseeable.

Consideration of Exhibits 2015–2019 would be in the interests of justice and beneficial to our decision of whether to institute *inter partes* review. Accordingly, Petitioner is authorized to file a Second Preliminary

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Reply to Patent Owner's Preliminary Sur-reply, limited to six pages and due by February 7, 2025. Petitioner may present arguments only regarding Exhibits 2015–2019 and Patent Owner's arguments in the Preliminary Sur-reply regarding these exhibits. Petitioner is authorized to file five exhibits with its Second Preliminary Reply, and may request authorization to file more exhibits, if needed.

Patent Owner is authorized to file a Second Preliminary Sur-reply, limited to six pages and due five business days after Petitioner files its Second Preliminary Reply. Patent Owner may present arguments only in response to arguments made in the Second Preliminary Reply. Patent Owner is authorized to file five exhibits with its Second Preliminary Sur-reply, and may request authorization to file more exhibits, if needed.

It is so ORDERED.

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