

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
U.S. Patent No. 9,335,255 B2

**PATENT OWNER'S SECOND PRE-INSTITUTION SURREPLY
TO PETITIONER'S SECOND PRE-INSTITUTION REPLY**

Patent Owner's Exhibit List

Exhibit No	Description
2001	Exclusive Patent License Agreement between Facet Technology Corp. and Mandli Communications, Inc. (and patent assignment coversheet), recorded at Reel No. 062371, Frame 0313
2002	Statutory Disclaimer of certain claims filed in file wrapper of U.S. Patent No. 9,335,255
2003	U.S. Provisional Patent Appl. No. 60/296,596
2004	Docket Control Order filed in <i>Facet Tech. Corp. v. Mobileye Glob., Inc.</i> , No. 2:24-cv-00058 (E.D. Tex.)
2005	Excerpts from U.S. District Court — Judicial Caseload Profile (2024 Ed.), <i>available at</i> https://www.uscourts.gov/file/78884/download
2006	Complaint Filed in <i>Facet Tech. Corp. v. Mobileye Glob., Inc.</i> , No. 2:24-cv-00058 (E.D. Tex.)
2007	Cover Pleading to Plaintiff's Disclosure Of Asserted Claims And Infringement Contentions, as served on August 26, 2024 in <i>Facet Tech. Corp. v. Mobileye Glob., Inc.</i> , No. 2:24-cv-00058 (E.D. Tex.)
2008	Cover Pleading to Defendant's Invalidity Contentions, as served on November 4, 2024 in <i>Facet Tech. Corp. v. Mobileye Glob., Inc.</i> , No. 2:24-cv-00058 (E.D. Tex.)
2009	National Institute of Standards and Technology, "Redefinition of 'Candela,'" <i>available at</i> https://www.nist.gov/si-redefinition/candela
2010	International Commission on Illumination, Standard. No. CIE S 017:2020 ILV: International Lighting Vocabulary, 2nd edition., entry no. 17-21-050, <i>available at</i> https://cie.co.at/eilvterm/17-21-050
2011	Excerpts from Stefanov, Konstantin D. CMOS Image Sensors. Bristol, UK: IOP Publishing, 2022.

Exhibit No.	Description
2012	Ang, Bernard, Keysight Technologies, “How to Achieve Accurate Sensor Characterization Using a Digital Multimeter” (Feb. 21, 2019), <i>available</i> at https://www.keysight.com/blogs/en/tech/bench/2019/01/24/how-to-achieve-accurate-sensor-characterization-using-a-digital-multimeter
2013	Steely, Sidney L., H. S. Lowery III, and R. H. Fugerer. "Laser-based direct-write scene generation methods for closed-loop focal-plane-array diagnostics." Technologies for Synthetic Environments: Hardware-in-the-Loop Testing. Vol. 2741. SPIE, 1996.
2014	Collins Dictionary Entry for “profile,” <i>available</i> at https://www.collinsdictionary.com/us/dictionary/english/profile
2015	Plaintiff Facet Technology Corp.’s Opposed Motion For Leave To Join Additional Parties, filed as Dkt. No. 32 in <i>Facet Technology Corp. v. Mobileye Global, Inc.</i> , Case No. 2:24-cv-00058-RWS-RSP (E.D. Tex.).
2016	Defendant Mobileye Global, Inc.’s Opposition To Facet’s Motion For Leave To Join Additional Parties, filed as Dkt. No. 35 in <i>Facet Technology Corp. v. Mobileye Global, Inc.</i> , Case No. 2:24-cv-00058-RWS-RSP (E.D. Tex.).
2017	Complaint For Declaratory Judgment Of Noninfringement And Demand For Jury Trial, filed as Dkt. No. 1 in <i>Mobileye Vision Technologies Ltd. et al v. Facet Technology Corp.</i> , Case No. 0:24-cv-04149-NEB-DLM (D. Minn.)
2018	Complaint for Patent Infringement, filed as Dkt. No. 1 in <i>Facet Technology Corp. v. General Motors LLC</i> , Case No. 2:24-cv-00035-RWS-RSP (E.D. Tex.)
2019	Docket Control Order, filed as Dkt. No. 22 in <i>Facet Technology Corp. v. General Motors LLC</i> , Case No. 2:24-cv-00035-RWS-RSP (E.D. Tex.)

Exhibit No	Description
2020	Mobileye, “Fact Sheet: Mobileye Advanced Driver-Assistance Systems (ADAS)” (July 19, 2020) (available at https://www.mobileye.com/blog/fact-sheet-mobileye-advanced-driver-assistance-systems-adass/)
2021	SEC, “Mobileye to Offer User-Generated Mapping for Autonomous Driving” (January 6, 2016) (available at https://www.sec.gov/Archives/edgar/data/1607310/000157104916010521/t1600008_ex99-1.htm)
2022	Joseph White, “GM Has 'Heightened Partnership' with Mobileye for Autonomous Cars” (October 1, 2015) (available at https://www.reuters.com/article/us-gm-investors-mobileye-idUSKCN0RV4ZC20151001/)

**I. PETITIONER’S NEW STIPULATION DOES NOT MOOT THE
FINTIV ANALYSIS**

Petitioner’s Second Preliminary Reply (Paper 12) submits additional stipulations from Mobileye Vision Technologies, Ltd. (“MVTL”) and Mobileye, Inc. (“MI”). Ex. 1024. Petitioner argues these stipulations, along with its interpretation of the guidance, are conclusive as to discretionary denial. Paper No. 12 at 1-2. However, Patent Owner’s Preliminary Sur-reply also identified General Motors LLC (“GM”) as a relevant related party—a party who still has not submitted a *Sotera* stipulation. Paper 10 at 4. As Patent Owner noted in that brief, Petitioner (through its MVTL and MI subsidiaries) has affirmatively manifested responsibility for defending the patent infringement accusations against GM and Petitioner. *Id.* And, as explained, a proper *Sotera* stipulation must bind all the relevant related parties. *Id.* (citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper No. 12 at 2, n.1 (PTAB Dec. 1, 2020)). Petitioner’s interpretation of the guidance contrary to *Sotera* itself and the widespread practice of considering related parties in the *Fintiv* analysis. *See, e.g., Global Tel*Link Corp. v. HLFIP Holding, Inc.*, IPR2021-00444, Paper 14, 27–28 (PTAB July 22, 2021); *Microsoft Corporation v. InterDigital Patent Holdings, Inc.*, IPR2024-00306, Paper 12 at 6, 10 (P.T.A.B. May, 10, 2024) (applying Interim Guidance and finding litigation against related parties to weigh in favor of discretionary denial under *Fintiv* factor 5). As such, Petitioner’s failure to submit a stipulation binding GM demonstrates that instituting this IPR would result

in duplicative efforts, and thus *Fintiv* factors 4 and 5 still weigh in favor of discretionary denial for the same reasons explained in Patent Owner's Preliminary Sur-reply.

II. THE BOARD SHOULD DISREGARD PETITIONER'S LATE ARGUMENTS REGARDING *FINTIV* FACTORS 1-3 AND 6

The Board permitted briefing from Petitioner "only regarding Exhibits 2015-2019 and Patent Owner's arguments in the Preliminary Sur-Reply regarding these exhibits." Paper 11 at 4. However, Petitioner's Second Preliminary Reply presents numerous exceeding that scope. In particular, a *Sotera* stipulation relates to *Fintiv* Factors 4 and 5. Paper No. 10 at 3-5; Paper No. 12 at 4; IPR2020-01019, Paper No. 12 at 18 (P.T.A.B. Dec. 1, 2020). Patent Owner's first preliminary sur-reply only presented arguments relating to Exhibits 2015-2019 in connection with *Fintiv* factors 4 and 5 (Paper No. 10 at 3-5) because it was responding to Petitioner's argument in its first preliminary reply which only responded to Petitioner's *Fintiv* arguments with a *Sotera* stipulation (Paper No. 8 at 4). Indeed, the Board previously granted Petitioner leave to respond to all of Patent Owner's *Fintiv* arguments (Ex. 3001) and Petitioner only chose to present its argument relating to its incomplete *Sotera* stipulation. Paper No. 8 at 4. Petitioner's late arguments regarding *Fintiv* factors 1-3 and 6 should be disregarded. *See* Paper No. 12 at 2-6.

III. THE *FINTIV* FACTORS STILL WEIGH IN FAVOR OF DISCRETIONARY DENIAL

To the extent that the Board is willing to consider the late *Fintiv* arguments in Petitioner’s second surreply, the *Fintiv* factors still weigh in favor of discretionary denial. As noted, *Fintiv* factor one weighs in favor of denial because the EDTX court has not granted any stay and there is no reason to believe any stay will be granted. Paper No. 7 at 22. Petitioner’s arguments regarding the Minnesota action are irrelevant since Patent Owner has not raised the Minnesota action itself as a basis for denial under *Fintiv*.

As noted, *Fintiv* factor two and three weigh favor of denial. Paper No. 7 at 22-23. In particular, all the EDTX actions are set for trial on February 17, 2026 and have already significantly progressed. Exs. 2004 at 1, 2019 at 1; Paper No. 7 at 22-23; Paper No. 10 at 4 (citing Ex. 2019). Indeed, as Petitioner has admitted, the parties have exchanged discovery (Paper 12 at 4), in addition to infringement and invalidity contentions. Petitioner’s argument regarding “venue” are entirely speculative—they assume that the District Court will dismiss the EDTX case against Petitioner and transfer the case against GM, even though the District Court has not done so. Paper No. 12 at 3. If either of those events occur before the Board’s institution decision, Petitioner can seek leave to file exhibits informing the Board of such events. However, in a *Fintiv* analysis, it is improper to speculate about what a district court may do. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (P.T.A.B.

May 13, 2020); *GlobalFoundries Inc. v. UNM Rainforest Innovations*, IPR2020-00984, Paper 11 at 15 (P.T.A.B. Dec. 9, 2020).

Fintiv Factors Four and Five Weigh in favor of discretionary denial. Paper No. 7 at 23; Paper No. 10 at 4-5. Petitioner notes that two additional Mobileye entities (MVTL, MI), had submitted *Sotera* stipulations. Paper 12 at 2, 4 (citing Ex. 1024). However, as noted, no stipulation has been filed for GM—a party for which Mobileye (by and through its subsidiaries MVTL and MI) has manifested responsibility for Patent Owner’s infringement claims. Paper No. 10 at 4-5.¹ Petitioner argues—without any evidentiary support—that GM is not an RPI and that “the other Mobileye entities filed their declaratory judgment action to defend their own interests.” Paper No. 12 at 5-6. In particular, Petitioner argues that GM only has a relationship with other suppliers. *Id.* at 5 (citing Ex. 1028 ¶¶ 20-27). But, at most, this demonstrates that Petitioner has an indirect supply relationship with GM. Ex. 1028 ¶¶ 20-21. Moreover, Petitioner’s assertion of an absence of a relationship between Petitioner and GM is belied by the declaratory judgment complaint which expressly: (1) identifies Patent Owner’s “lawsuit against General Motors” as a basis

¹ Patent Owner’s cases against Global B.V. and Here Global B.V. are irrelevant—the only relevant issue is Petitioner’s cases against Mobileye and relevant related parties (i.e. GM).

for the declaratory judgment action (Ex. 2017 ¶¶ 16-18, 43; (2) identifies Petitioner’s pending IPRs as a basis for invalidity (Ex. 2017 ¶¶ 39, 51); and (3) seeks general declaratory and injunctive relief relating to the EyeQ3 and EyeQ4 products, including restraining Patent Owner from asserting the patents against anyone using Petitioner’s products (i.e. including GM). Ex. 2017 at 15-16. It is also belied by Petitioner’s own marketing material, which boasts of GM’s use of its technology. Ex. 2020. It is further belied by SEC filings from 2016 stating that “Mobileye is engaged with General Motors to integrate REM [Road Experience Management] into existing program launches in an expedited timeframe, as part of GM’s heightened partnership with Mobileye.” Ex. 2021. It is still further belied by news reports from 2015 that “General Motors Co is developing a ‘heightened partnership’ with vision technology supplier Mobileye NV as part of a broader effort to speed development of autonomous cars. Ex. 2022.

Even if GM does not rise to the level of an RPI of Petitioner—which Petitioner has in no way disputed with any evidence—as noted, pending infringement actions against relevant, related parties are relevant to a *Fintiv* analysis even if they do not qualify as RPIs. Paper No. 10 at 4-5. Here, there is no dispute that the GM action involve the EyeQ3 and EyeQ4 products, the same products as the action against Patent Owner, and thus the *Fintiv* reasoning (i.e. efficiency and fairness of duplicative proceedings) applies equally. Ex. 1028, ¶¶ 17-18, 20-22, 24.

Petitioner's argument regarding *Fintiv* Factor Six also fail. As set forth in the preliminary response, the Petition contains several fundamental deficiencies as to the remaining claims. In particular, claim 15 recites "determining a luminance value utilizing the plurality of light intensity values and a characterization profile of the at least one light intensity sensor." Paper 7 at 1-2 (citing Ex. 1001 ('255 Patent), cl. 15). However, Lumia, which Petitioner relies upon, fails to disclose "determining a luminance value utilizing the plurality of light intensity values and a characterization profile of the at least one light intensity sensor." Paper 7, 7-20.

IV. CONCLUSION

For the above reasons, and as set forth in the POPR and Patent Owner's Preliminary Reply, Patent Owner requests that institution of this Petition for *inter partes* review be denied.

Dated: February 14, 2025

Respectfully submitted,

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Certificate of Service 37 C.F.R. § 42.6(e)

The undersigned certifies that on February 14, 2025, I will cause true and correct copies of the foregoing Patent Owner's Pre-Institution Surreply, and all associated exhibits or appendices referred to therein, to be served electronically upon the following attorneys who have consented to service via email. Pet. at 58.

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