

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOBILEYE GLOBAL, INC.,

Petitioner,

v.

FACET TECHNOLOGY CORP.,

Patent Owner.

Case IPR2024-01111

Patent No. 9,671,328

**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 order in which recited actions must be performed; and (2) discretionary denial under *Fintiv*. Ex. 3001. The Board should not adopt Patent Owner's late attempt to require an ordered sequence of steps for certain claim elements. And based on Petitioner's *Sotera* stipulation, any basis for discretionary denial under *Fintiv* is moot.

I. PATENT OWNER'S IMPROPER INTERPRETATION OF THE CLAIMS

Despite Patent Owner's Preliminary Response (Paper 6, "POPR") stating that Patent Owner "does not contend that any claim term should receive an express construction," Patent Owner's primary POPR argument hinges on its interpretation that the remaining claims (i.e., the claims remaining after Patent Owner's statutory disclaimer) require an *ordered* sequence of steps. POPR 5-7, 13-14. However, under established precedent, claimed steps do not ordinarily imply a particular order unless the claim expressly recites an order. *Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1342 (Fed. Cir. 2001) (citation omitted). Courts only construe steps to be performed in the order written if the claim language requires it "as a matter of logic or grammar" or if the specification requires it directly or implicitly. *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1369 (Fed. Cir. 2003). That is not the case here.

More specifically, Patent Owner improperly suggests that the “computer processing system” of independent claims 1 and 9 must be “configured to” perform claimed functions in a particular order. POPR 5-7, 13-14. Specifically, each claim requires that the computer processing system be “configured to detect objects of interest within the field of view and for each object of interest” perform additional functions. For example, claim 1 requires that the computer processing system be configured to “determine whether the object of interest includes a reflective surface based on the light intensity values,” and claim 9 requires that the computer processing system be configured to “determine whether the object of interest includes at least one light intensity value associated with a reflective surface of a road marker in the field of view.” Ex. 1001, claims 1, 9. Nothing in this claim language excludes the computer processing system performing the determining step *concurrently* with the respective detecting steps of each claim. *See Cybersettle, Inc. v. Nat’l Arbitration Forum, Inc.*, 243 F. App’x 603, 609 (Fed. Cir. 2007).

The *Cybersettle* case is instructive. There, the claim recited receiving demands and offers and comparing and testing the demands and offers. *Id.* The court rejected the argument that the structure of the claim required that “the comparison and testing steps [] be performed after the multiple pairs of bids and offers are received.” *Id.* The court agreed that “the comparison and testing steps

logically cannot begin until an offer and a demand are received” but concluded that the claim allowed “the step of calculating the differences between demands and offers [to] occur concurrently with the receipt of multiple demands and offers.” *Id.* “As each new pair of bids is received, the bids are compared.” *Id.* Here, the situation is the same. While the claims recite respective determining steps occurring for each detected object of interest, that does not mean the computer processing system must *complete* the step of detecting objects of interest *before* beginning the determining step. The computer processing system can begin the determining step as it continues to detect objects.

The specification supports this reading. For example, the specification states that a “tagged videostream 20 is analyzed by a computer processor 22 to identify each road sign 30” and, “[e]ither ***concurrent with or subsequent to*** the identification of road signs 30 . . . , the computer processor 22 evaluates that portion 32 of each video frame or image that depicts a road sign 30 to determine a set of color values 40, 42 for each of a plurality of colors on the road sign.” Ex. 1001, 5:41-45, 5:52-57 (emphasis added).

Patent Owner's reading of the claims entirely reads out the “concurrent with” embodiment of the specification. Patent Owner, for example, argues that claim 9 requires “the claimed [‘]detect[ing]’ of objects of interest and subsequent ‘determin[ing]’ performed on already detected objects of interest.” POPR 10.

Patent Owner raises a similar argument for claim 1, arguing that it requires “a three-step ordered approach which: (1) detects objects of interest; (2) determines whether the detected objects of interest include a reflective surface; and (3) determines whether such determined reflective surface is a road marker.” POPR

14. Patent Owner's improper attempt to stray from the plain language and exclude the “concurrent with” embodiment in its attempt to distinguish a purported “single step approach” in *Gallagher* should be rejected. *See Oatey Co. v. IPS Corp.*, 514 F.3d 1271, 1276 (Fed. Cir. 2008) (“We normally do not interpret claim terms in a way that excludes embodiments disclosed in the specification.”).

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/

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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:

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Patent Owner has consented to service by email.

Date: January 13, 2025

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