

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOBILEYE GLOBAL, INC.,
Petitioner

v.

FACET TECHNOLOGY CORP.,
Patent Owner

IPR2024-01111
U.S. Patent No. 9,671,328 B2

**PATENT OWNER'S PRE-INSTITUTION SURREPLY
TO PETITIONER'S 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. 9,671,328
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	Intentionally Omitted
2010	Intentionally Omitted
2011	Intentionally Omitted
2012	Intentionally Omitted
2013	Intentionally Omitted
2014	Intentionally Omitted

Exhibit No.	Description
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.)

I. THE LOGIC AND GRAMMAR OF CLAIMS 1 AND 9 REQUIRE THE “determin[ation] whether the object of interest includes ... a reflective surface” BE PERFORMED ON “each” “detect[ed]” “object of interest”

The POPR explains that claims 1 and 9 require the recited “determin[ation]” be performed on an already “detect[ed]” “object[] of interest,” and that the Petition improperly disregards these separate limitations by reading them on the same single step in the prior art. POPR, 5-7, 10, 13-14, 18. Petitioner argues that claims need not require any “order” unless required by the specification or as a “matter of logic or grammar” of their language. Paper 7, 1. But, Petitioner’s argument that a determination may be performed on an object of interest entirely concurrently with detection of that same object—suggesting that determining and detecting can be the same thing—is clearly contradicted by the logic and grammar of the claims. *Id.*

Indeed, a claim may be interpreted to require an order where a subsequent step has a reference that logically indicates that a prior step had been performed. *See Mantech Envtl. Corp. v. Hudson Envtl. Servs., Inc.*, 152 F.3d 1368, 1375-76 (Fed.Cir.1998) (“Step (b) introduces acetic acid, via the wells provided in step (a) [h]ence, in order to accomplish step (b), the wells of step (a) must already have been provided.”); *E-Pass Tech., Inc. v. 3COM Corp.*, 473 F.3d 1213, 1222 (Fed. Cir. 2007) (“transferring a data set” must occur before “storing said transferred data set”). Thus, “detect objects of interest ... and for each object of interest” provides the antecedent basis for the “object of interest” upon which “determine whether *the*

object of interest includes ... a reflective surface” is performed. Ex. 1001, cls. 1, 9.

This evidences the logical relationship between detection and determination.

Petitioner’s reliance on *Cybersettle* is misplaced. Paper 7, 2-3. In *Cybersettle*, the claims recited a method for settling a claim “in rounds” that required “testing a pair of non-equal values in one of at least two rounds.” *Nat’l Arbitration Forum, Inc.*, 243 F. App’x 603, 605 (Fed. Cir. 2007). The court rejected defendant’s interpretation that required that *all* demand and offer bids be received before any comparison of any bids could commence. *Id.* at 609. But that proposed construction is completely different from the POPR’s claim interpretation. Patent Owner has not suggested that the claims require that *all* objects of interest be detected before *any* “determination” of *any* object of interest take place. Rather, Patent Owner merely noted that the claims require that the determination be performed on an already detected object of interest. Indeed, Patent Owner’s interpretation is fully supported by *Cybersettle*, which “agree[d] with [defendant] that the comparison and testing steps logically cannot begin until an offer and a demand are received.” *Id.* at 609.

II. THE SPECIFICATION DOES NOT REQUIRE PETITIONER’S “concurrent” CONSTRUCTION

Petitioner argues that the specification supports its “concurrent” construction, pointing to the statement that the computer’s evaluation of frames or images to determine a set of color values of a road sign can be performed “concurrent with or subsequent to” the step of identifying the road signs Paper 7, 3 (citing Ex. 1001, 5:41-

57). Thus, Petitioner argues that the POPR's interpretation would improperly read out an embodiment. But, Petitioner misapprehends the law and the facts.

First, there is no requirement that every claim be construed to “encompass all disclosed embodiments.” *Tip Systems, LLC V. Phillips & Brooks/Gladwin*, 529 F.3d 1364, 1373 (Fed. Cir. 2008); *see also PPC Broadband, Inc. v. Corning Optical Communications RF, LLC*, 815 F.3d 747, 755 (Fed. Cir. 2016) (rejecting proposition that “each and every claim ought to be interpreted to cover each and every embodiment”). Indeed, “*Oatey* is not even ‘applicable’ where a contrary construction covers a preferred embodiment.” *SIMO Holdings Inc. v. Hong Kong uCloudlink Network Tech. Ltd.*, 983 F.3d 1367, 1378 (Fed. Cir. 2021). That is exactly the case here, as the specification recites “concurrent *or subsequent*.”

Second, Petitioner simply misapprehends the “concurrent or subsequent” language in the specification. Similar to the competing constructions in *Cybersettle*, the statement that a determination may occur “[e]ither concurrent with or subsequent to the identification of road signs 30 and generation of asset management database” demonstrates that the invention encompasses embodiments using essentially batch processing as well as embodiments where such batch processing need not be performed. Ex. 1001, 5:41-57. In the batch processing embodiments, identification and determinations are performed in “post-processing,” and thus all signs in a batch can be first identified, and “subsequent[ly]” analysis/determination can be performed

on all identified signs. *Id.*; *id.*, 9:39-45, 9:58-10:1. In non-batch processing embodiments—such as when determinations are performed “on-the-fly” and/or in “real time”—detection and determination steps for *different signs* can occur concurrently. *See id.*, 10:1-5 (with sufficient computing power, “most, if not all, of the post-processing functions [could be] performed in the capture vehicle 225, perhaps even in real time.”), 10:30-34, cls. 3, 11 (“the computer processing system is configured to operate in a mode selected from post-processing or on-the-fly”). But nothing requires the recited determination to be capable of being performed on a *particular* road sign before that road sign is even detected or identified.

III. PETITIONER’S PURPORTED “SOTERA” STIPUALTION IS INADEQUATE

The Director’s June 21, 2022 Interim Guidance provides that discretionary denial under *Fintiv* should not be exercised when the petitioner submits a stipulation “[c]onsistent with *Sotera Wireless, Inc.*” Interim Guidance at 3. But Petitioner’s stipulation is facially inadequate—it only purports to bind Petitioner itself. Paper 7, 4. It ignores the relevant related parties that may attempt to assert—in the same court—the invalidity grounds that were raised or could have been raised in this IPR. In particular, Patent Owner has moved to add Mobileye Vision Technologies, Ltd. (“MVTL”) and Mobileye, Inc. (“MI”), which are subsidiaries of Petitioner, as defendants in the EDTX case. Ex. 2015, 1, 5. Petitioner opposed that motion as untimely, but did not dispute that MVTL and MI are related entities that participate

in the activities accused of infringement. Ex. 2016, 2-4, 7. Also, MVTL and MI have filed a declaratory judgment action against Patent Owner alleging that their “products constitute and/or incorporate the EyeQ3 and/or EyeQ4 SoCs” which were accused in the EDTX case against Petitioner, as well as in an EDTX case filed by Patent Owner against General Motors LLC (“GM”). Ex. 2017 ¶¶ 17-18, 21, 24; *see also* Ex. 2018 ¶¶ 2, 26, 37-40, 75-76; Ex. 2019. MVTL and MI have thus manifested responsibility for the ’328 Patent infringement claims against GM and Petitioner, and MVTL, MI, GM and Petitioner are thus all real-parties-in-interest in this IPR.

But, a proper *Sotera* stipulation must bind all the relevant related parties. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Ex. 1038 (PTAB). The failure to submit a stipulation binding MVTL, MI, and GM means that instituting this IPR would result in duplicative efforts, and thus *Fintiv* factors 4 and 5 still weigh in favor of discretionary denial. If Petitioner is arguing that the Director adopted a categorical rule that such a stipulation requires declining to exercise discretionary denial, the Board is not bound by such an *ultra vires* rule. *See Apple Inc. v. Vidal*, 2024 WL 1382465, *10-13 (N.D. Cal. Mar. 31, 2024) (without formal rulemaking, Director may not “set forth instructions that would require the Board to make specific institution decisions in specific circumstances as a general statement of policy”).

IV. CONCLUSION

For the reasons above and in the POPR, institution should be denied.

Dated: January 21, 2025

Respectfully submitted,

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

The undersigned certifies that on January 21, 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 75-76.

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