

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 SECOND PRELIMINARY REPLY TO
PATENT OWNER'S PRELIMINARY SUR-REPLY RESPONSE**

**I. PETITIONER'S STIPULATION MOOTS THE *FINTIV* ANALYSIS
BASED ON THE DIRECTOR'S MEMORANDUM**

Patent Owner argues that Petitioner's "[*Sotera*] stipulation is facially inadequate" because "it only purports to bind Petitioner itself." Paper 8 at 4. But the USPTO guidance plainly states that the Board "will not discretionarily deny institution in view of parallel district court litigation where *a petitioner* presents" the type of stipulation that Petitioner provided here. USPTO Memorandum, "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation" at 3 (June 21, 2022) ("Procedure") (emphasis added). Under this guidance, Petitioner's stipulation moots the *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential) ("*Fintiv*") analysis. In essence, the Patent Owner misrepresents the Procedure.

Patent Owner attempts to improperly add a requirement that the stipulation bind *all* parties engaged in litigation with the patent owner. Paper 8 at 4-5. Other panels have already rejected Patent Owner's argument. *See, e.g., Structural Wrap, LLC v. System Stormseal Pty Ltd.*, IPR2024-00084, Paper 13 at 13-15 (May 9, 2024). The Procedure lacks *any* requirement that a petitioner's stipulation must bind parties to other litigations as well. The Board should decline to add such a requirement.

Consistent with *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (Dec. 1, 2020) (precedential as to § II.A) ("*Sotera*"), Petitioner's stipulation

binds Petitioner in the parallel EDTX litigation between the parties ("Parallel Litigation"). Ex. 2006. While not required to moot the *Fintiv* analysis, ***non-parties*** Mobileye Vision Technologies, Ltd. and Mobileye, Inc., out of an abundance of caution, have made the same stipulation as Petitioner. Ex. 1024. So, even if those entities are added to the litigation (which is speculative at this point), these stipulations "mitigate[] any concerns of duplicative efforts" and "concerns of potentially conflicting decisions." *Sotera* at 19.

As explained below, GM and Mobileye have no relationship that undermines the guidance's effect. *Infra* at 6. Petitioner is the only real party-in-interest in this proceeding, but the RPI question need not be addressed at this time because Patent Owner does not contend that any purportedly unnamed real party-in-interest is time-barred or estopped.

II. DISCRETIONARY DENIAL IS NOT WARRANTED UNDER THE FINTIV ANALYSIS

While the stipulations from Petitioner and the non-party Mobileye entities moot the *Fintiv* analysis, the *Fintiv* analysis also warrants institution. As discussed below, *Fintiv* factors 1-6 caution against denial or are neutral.

A. *Fintiv* Factor One: Neutral or Against Denial

No motion to stay has been filed in the Parallel Litigation. Regarding the *Minnesota Action*, if the other Mobileye entities are RPIs, the automatic stay provisions of 35 U.S.C. § 315(a)(2) would apply.

B. *Fintiv* Factor Two: Weighs Against Denial

Any trial in the Parallel Litigation will likely occur after the Board's statutory deadline, if at all. Patent Owner's new exhibits paint an incomplete picture of the state of that litigation. Patent Owner failed to mention that the Court found the venue allegations in Patent Owner's original complaint lacking under 28 U.S.C. § 1400(b) and granted venue discovery. Ex. 1025.

Venue discovery confirmed that Petitioner was improperly sued in EDTX. *See* Ex. 1026. Despite the Court finding "the allegations of the Complaint concerning collaborations with third parties do not properly allege that Defendant has a regular and established place of business in the District," Ex. 1025, Patent Owner's venue allegations *still* rely on inadequate third-party connections, Ex. 1026 at 3-10. As explained in Petitioner's supplemental brief in support of its motion to dismiss for lack of venue, the case will likely be dismissed or transferred. *Id.* at 1. Any trial date set in another venue will likely occur after a final written decision.

The *Minnesota Action* has no trial date set. The case most likely to go to trial near the Final Written Decision date is the *GM* case. It was filed first and received the same date, time, and court for trial as the Parallel Litigation. But it is subject to a pending transfer motion because all parties are in or near Michigan. Ex. 1027 at 2-3. The motion makes the likelihood that litigation will reach trial first even more speculative given the closeness of the trial date to the final written decision date.

C. *Fintiv* Factor Three: Weighs Against Denial

The Court issued no substantive orders related to the challenged patent, which “weighs against exercising discretion to deny institution.” *Fintiv* at 10. Claim construction is not set to begin until after the Board’s projected institution decision. Ex. 2004 at 4. Discovery to date has focused almost entirely on Petitioner’s pending motion to dismiss for lack of venue. The only set of interrogatories that Patent Owner has served is styled the “First Set of Venue and Jurisdictional Interrogatories.” And only two depositions have occurred—both focused on venue.

Petitioner filed the Petition expeditiously, which weighs in favor of institution. *Fintiv* at 11. Petitioner filed its petition over three weeks *before* Patent Owner identified the asserted claims in its infringement contentions, and over three months before it served its invalidity contentions. Exs. 2007-2008.

D. *Fintiv* Factor Four: Weighs Against Denial

The fourth *Fintiv* factor weighs against denial for three reasons. First, Petitioner (and two additional Mobileye entities) provided *Sotera* stipulations. If the Board institutes the IPR, there will be no overlap between the Petition and the Parallel Litigation. Second, the Petition involves non-overlapping claims with the Parallel Litigation. Patent Owner does not assert claims 2, 5-8, and 14-16 of the ’328 patent in district court, but the Petition challenges each of these. *See* Ex. 2007 at 1. Third, Patent Owner’s Preliminary Response and Sur-Reply provide no explanation

why an overlap would occur (or the extent) for the GM litigation.

E. *Fintiv* Factor Five: Weighs Against Denial

While Petitioner and Patent Owner are parties to the Parallel Litigation, Patent Owner asserted the same patents against other entities whose trial dates will likely occur well after the Board's projected date for a final written decision. For example, Patent Owner asserts the same patents against three TomTom entities in the District of New Hampshire and against Here Global B.V. in the Eastern District of Texas. *Facet Tech. Corp. v. TomTom Int'l B.V.*, No. 1:24-cv-00111-PB-TSM, Dkt. 1 (D.N.H. Apr. 23, 2024); *Facet Tech. Corp. v. Here Global B.V.*, No. 2:24-cv-00269-RWS-RSP, Dkt. 1 (E.D. Tex. Apr. 22, 2024). Those cases do not yet have a trial date posted to their dockets. In the unlikely event that the litigation between Petitioner and Patent Owner proceeds to trial before the Board's final written decision, institution could still help save judicial resources in these other proceedings if the Board finds the claims unpatentable. And if the Board institutes, any trial between Petitioner and Patent Owner would involve different issues in light of the stipulations. Mobileye is not a party to the General Motors LLC ("GM") litigation. In fact, GM sued its suppliers for indemnity and alleges that *they* must defend GM, not Petitioner or any other Mobileye entity. Ex. 1028 ¶¶ 20-27.

GM is not a real party-in-interest to this proceeding. Patent Owner bases this assertion entirely on other non-parties to this IPR purportedly "manifest[ing]

responsibility for the '328 Patent infringement claims against GM and Petitioner” by filing a declaratory judgment action in the District of Minnesota. Paper 8 at 5. But this misrepresents the facts, as the other Mobileye entities filed their declaratory judgment action to defend their own interests once Facet threatened to sue them. Petitioner and GM have no relationship. Indeed, Facet sued Petitioner and GM separately and has not requested consolidation. As GM’s complaint shows, GM obtains its products from other, unrelated entities. Ex. 1028 ¶¶ 20-27. GM played no role in the decision to file this IPR petition, its preparation, or its funding. GM has no ability to control Petitioner’s decisions during the IPR. GM has separate counsel. GM meets none of the considerations discussed in the Trial Practice Guide for qualifying as a real party-in-interest. Consolidated Trial Practice Guide at 14-17.

F. *Fintiv* Factor Six: Weighs Against Denial

The Petition presents a strong case on the merits, further warranting institution. Patent Owner already disclaimed several claims from the patent in view of the Petition’s challenges. Ex. 2002. The compelling unpatentability challenges in the Petition, alone “demonstrate[] that the PTAB should not discretionarily deny institution under *Fintiv*.” Interim Procedure at 4-5.

III. CONCLUSION

The Board should decline to exercise its discretion to deny institution here.

Date: February 7, 2025

Respectfully Submitted,

/Cory C. Bell/

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Petitioner's Second Preliminary Reply to Patent Owner's Preliminary Sur-Reply Response** was served electronically via email on February 7, 2025, in its entirety on the following:

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Patent Owner has consented to service by email.

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