

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

IPR2025-00218
U.S. Patent No. 10,136,416

**PETITIONER'S AUTHORIZED REPLY
TO PATENT OWNER'S PRELIMINARY RESPONSE**

I. Discretionary denial under *Fintiv* is not warranted.

The *Fintiv* factors, considered as a whole, do not warrant denial.

Factor 2 favors institution. Trial is currently set for May 14, 2026, which is less than one month before the Final Written Decision is due on June 12, 2026. Ex.1011. Under *Fintiv*, “[i]f the court’s trial date is at or around the same time as the projected statutory deadline..., the decision whether to institute will likely implicate other factors.” *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 9 (Mar. 20, 2020) (precedential). Here, because the trial date is around the same time as the projected FWD, other factors—in particular Petitioner’s *Sotera* stipulation (see below)—outweigh Factor 2. Moreover, trial is unlikely to occur as scheduled on May 14, 2026. This date is inconsistent with the median time-to-trial in WDTX of 33.9 months (which puts trial in January of 2027). *See* Ex.1018, 37; *see also* USPTO Guidance of March 24, 2025 (“Boalick Memo”) (“the Board may consider...median time-to-trial statistics”). Moreover, there are *twelve* patents asserted in the parallel litigation, and Judge Albright has publicly stated that he does not think it is “fair to have a jury trying to handle more than two or three patents at a time.” Ex.1021; *see also* Ex.1020 (example Albright bifurcation order). Accordingly, a trial for any given patent of the twelve asserted in the parallel litigation is likely to occur later than the currently scheduled date and after the statutory deadline for Final Written Decision of June 12, 2026.

Factor 4 weighs strongly in favor of institution in light of Petitioner's *Sotera* stipulation filed in district court. *See* Ex.1022. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-00109, Paper 12 at 18–19 (Dec. 1, 2020). A “timely-filed *Sotera* stipulation...is highly relevant.” Boalick Memo, 2-3; *see also, e.g. Samsung Elecs Co. et al. v. Harbor Island Dynamic LLC*, IPR2024-01405, Paper 9 at 36 (March 24, 2025) (*Sotera* stipulation weighs “strongly in favor of not exercising discretion to deny institution”). Notably, the Board recently granted institution where a *Sotera* stipulation outweighed the fact that trial was scheduled **five months** before the expected final written decision (as opposed to the **less than one month** gap here). *See Samsung Electronics Co. Ltd. v. Headwater Research LLC*, IPR2024-01407, Paper 9, 8 (March 20, 2025). Also favoring institution under Factor 4 is that the Petition **challenges claims that are not asserted in the parallel proceeding**, which further minimizes overlap. To be proactive, conserve resources, and address claims that may be asserted in the future, the Petition challenges all 12 claims rather than only asserted claims 1, 2, and 4-6.

Petitioner's *Sotera* stipulation also outweighs Factor 3 because investment by the court and parties has been less than Patent Owner alleges. For example, at institution, the court and parties will still have at least 11 more months of work before the scheduled trial date—including most of fact discovery (closes Nov. 6, 2025) and all of expert discovery (closes Jan. 15, 2026). In *Bio-Rad Laboratories*,

Inc. v. California Institute of Technology, the Board found that Factor 3 “weighs against exercising our discretion to deny institution” where the *Markman* hearing had already occurred but expert discovery remained. IPR2024-01451, Paper 11, 10 (March 27, 2025). Like in the present case, “much more work remain[ed], including, expert reports, expert discovery, expert depositions, and pretrial motions and disclosures.” *Id.* Moreover, the facts here differ from those in the Director's recent decision to deny institution in *Motorola Solutions, Inc. v. Stellar LLC* where trial was set to occur less than one month after *institution* and expert discovery had already occurred. IPR2024-01205, Paper 19 at 3 (March 28, 2025).

On balance, Petitioner's *Sotera* stipulation (Factor 4), the less than one month trial gap (Factor 2), and the minimal investment relative to other instances of parallel proceedings (Factor 3) outweigh all remaining factors and favor institution. And the merits of the Petition remain strong because Patent Owner's arguments are misguided, as explained below. The Board should thus not discretionarily deny institution under §314(a).

II. Petitioner's district court construction of “broadcast information” is consistent with information in a “broadcast channel.”

Despite Patent Owner's assertions, Petitioner's district court construction of “broadcast information” is entirely consistent with the Petition's analysis of that term. The Petition identifies the Paging Indicator Channel (PICH)—which is in the *broadcast channel*—as corresponding to the claimed “broadcast information.”

Pet., 36-37. As noted in Vayanos, a broadcast channel is transmitted to all devices within a cell. Ex.1006, 1:28-30 (“A broadcast service provides point-to-multipoint communication between at least one base station and **all wireless devices** within a designated broadcast area.”). The PICH resides within the broadcast channel because it is intended for all terminals in the cell. *See* Ex.1015, 4 (“[T]he PICH **needs to be heard by all terminals in the cell** and thus needs to be sent at high power level”).

The Petition's identification of information in the broadcast channel is specifically encompassed by Petitioner's district court construction of “*broadcast information*”: “Plain and ordinary meaning, which is ‘information that is transmitted **via a broadcast transmission to all UEs** within a base station's coverage area.’” Ex.1021, 15. In contrast, information “transmitted to a targeted group” is not broadcast in a broadcast channel, as recognized by the '416 patent. Ex.1001, 11:16–26 (“[T]he indicator bits may be either **broadcast to all UEs** in a cell, or **transmitted to a targeted group of one or more UEs** in a cell.”); Ex.1021, 16. Accordingly, the Petition and Petitioner's district court position both interpret “*broadcast information*” consistent with information that is in a “*broadcast channel*.”

Patent Owner nevertheless mischaracterizes Petitioner's district court construction as “diametrically opposed” to the Petition's analysis of “*broadcast*

information.” POPR, 2. Patent Owner argues that “in Kim the ‘broadcast information’ is intended for ‘a specific paging group.’” POPR, 46 (*citing* Ex.1005, 1:38-46 (“Terminals are included in a specific paging group defined ... Therefore, the base station notifies that paging message arrives at terminals included in a corresponding group through the paging indication channel (PICH).”)). But the PICH—*because it is in the broadcast channel*—is still transmitted to all terminals in the cell. This is true even though the PICH instructs some paging groups to take further action. All terminals need to receive and examine the PICH to determine if there is information for that terminal in the paging channel PCH. *See* Ex.1005, 1:45-48. Thus, although only some terminals take further action after receiving the PICH, the PICH is transmitted to all terminals on the broadcast channel, consistent with Petitioner’s district court construction (and consistent with dependent claim 3: “*wherein the broadcast information is received on a broadcast channel*”). Because of this consistency, there was no need for Petitioner to inform the Board of its later-filed district court construction, as alleged in the POPR. *See* POPR 22-23.

III. Patent Owner seeks a construction of “each of the plurality of bits indicates a respective time interval” that is not supported by the specification.

Patent Owner seeks an overly narrow construction that is not justified by either the claim language or the specification. Specifically, Patent Owner alleges that there is “a one-to-one correspondence between each of the plurality of bits used to indicate the respective intervals and the respective time intervals

themselves, such that each single bit (in the plurality of bits) indicates whether a different (respective) time interval is used to signal channels in which a single bit identifies a time interval.” POPR, 19. But the claims themselves do not recite this “one-to-one correspondence” between a single bit and a “different” time interval. The specification similarly does not disclose such a relationship. The embodiment of Fig. 7 cited in the POPR only shows a *single* FACH indicator bit 722 (as opposed to the claimed “*plurality*”), and the cited embodiment of Fig. 9 only shows each FACH indicator bit 922 indicating a “*channel*” (as opposed to the claimed “*time interval*”). Ex.1001, Fig. 7, 13:25-30, Fig. 9, 14:1-4.

To support its construction, Patent Owner is forced to rely on figures created by its expert. POPR, 11, 14, 17. The POPR first includes an improperly expanded version of Fig. 7 with additional frames “N + 2” and “n + m” associated with an alleged “plurality of indicator bits 722.” POPR, 10-11. But the ’416 patent only states that a *single* “FACH indicator bit 722 in frame ‘n’ ... indicates that the FACH 720 is active in frame ‘n+1,’” and nowhere does it describe *other* FACH indicators pointing to subsequent frames (N+2, etc.). POPR, 10-11. The POPR also includes a doctored version of Fig. 9 to support an improper obviousness-type analysis. POPR, 13-14 (“While the embodiment depicted in FIG. 9 included four FACH channels in the same timeslot, the specification explains that the embodiment of FIG. 9 could be extended to a system where the plurality of

indicator bits 922 are used to signal whether FACH channels across multiple timeslots.”) (emphasis added). It would be inappropriate to adopt Patent Owner’s “more particularized” claim construction that is not “required by the specification or prosecution history.” *See 3M Innovative Properties Co. v. Tredegar Corp.*, 725 F.3d 1315, 1329 (Fed. Cir. 2013).

The Petition analyzes “*each of the plurality of bits indicates a respective time interval*” under the plain and ordinary meaning two different ways. Pet., 15, 40-49. In a first mapping, the Petition identifies each “frame” in the prior art as a “*respective time interval*”: “Each of these paging indicators [*“plurality of bits”*] is thus associated with and indicates a respective time interval in which a Paging Channel PCH will be found—e.g., if a paging indicator for a UE is set to ON, the UE looks in a specific frame (“time interval”) for the PCH.” Pet., 40-42. In a second mapping, “a specific Transmission Time Interval (TTI) within each frame is a ‘respective time interval,’ and the paging information for each respective frame indicates whether that frame will include a signaling channel (e.g., PCH) at a specific TTI within that frame.” Pet. 43. Thus, for each frame, each of the bits in the PICH may indicate either (i) that frame or (ii) a time window within that frame (“*respective time interval*”). Notwithstanding Patent Owner’s manufactured figures, nothing in the claim or actual specification excludes the Petition’s mapping under the plain and ordinary reading.

Petitioner's Reply to Patent Owner's Preliminary Response
IPR2025-00218 (U.S. Patent 10,136,416)

Respectfully submitted,

Date: April 4, 2025

/Scott T. Jarratt/

Scott T. Jarratt

HAYNES AND BOONE, LLP
2801 N. Harwood Street, Ste 2300
Dallas, Texas 75201

Lead Counsel for Petitioner
Registration No. 70,297

PETITIONER'S EXHIBIT LIST

Ex.1001	U.S. Patent No. 10,136,416 to Beale et al. ("416 patent")
Ex.1002	Prosecution File History of U.S. Patent Application No. 15/611,309 issued as the '416 Patent
Ex.1003	Declaration of Zhi Ding under 37 C.F.R. § 1.68
Ex.1004	<i>Curriculum Vitae</i> of Zhi Ding
Ex.1005	U.S. Patent No. 8,761,814 to Kim et al. ("Kim")
Ex.1006	U.S. Patent No. 8,144,735 to Vayanos et al. ("Vayanos")
Ex.1007	U.S. Patent No. 7,606,226 to Yi et al. ("Yi")
Ex.1008	PCT Pub. No. WO2007/123360
Ex.1009	U.S. Patent No. 9,674,818 to Beale et al.
Ex.1010	Complaint, <i>Intellectual Ventures II, LLC v. Tesla, Inc.</i> , No. 6:24-cv-188-ADA (WDTX)
Ex.1011	Proposed Scheduling Order, <i>Intellectual Ventures II, LLC v. Tesla, Inc.</i> , No. 6:24-cv-188-ADA (WDTX)
Ex.1012	Statistics on District Court Timing (as of June 30, 2024)
Ex.1013	Interim Procedure for Discretionary Denials in AIA Parallel District Court Litigation, June 21, 2022
Ex.1014	IV's Preliminary Infringement Contentions, <i>Intellectual Ventures II, LLC v. Tesla, Inc.</i> , No. 6:24-cv-188-ADA (WDTX)
Ex.1015	Harri Holma & Antti Toskala, WCDMA for UMTS: Radio Access for Third Generation Mobile Communications (3rd ed. 2004)
Ex.1016	Director Vidal Memorandum, Updated Guidance on the Treatment of Statements of the Applicant in the Challenged Patent in <i>Inter Partes</i> Reviews under 35 U.S.C. § 311, June 9, 2022
Ex.1017	Authorization Email from the Board

Petitioner's Reply to Patent Owner's Preliminary Response
IPR2025-00218 (U.S. Patent 10,136,416)

(New)	
Ex.1018 (New)	Updated Statistics on District Court Timing (As of December 30, 2024).
Ex.1019 (New)	Petitioner's Claim Construction Reply Brief, <i>Intellectual Ventures II, LLC v. Tesla, Inc.</i> , No. 6:24-cv-188-ADA (WDTX)
Ex.1020 (New)	Bifurcation Order – <i>Videolabs, Inc. v. Asustek Computer, Inc.</i> 6:22-cv-00720-ADA (WDTX)
Ex.1021 (New)	"Albright Worried Multipatent Trials Ask Too Much Of Jurors," Law360 (Dec. 18, 2020), at https://www.law360.com/articles/1337976/albright-worried-multipatent-trials-ask-too-much-of-jurors
Ex.1022 (New)	Notice of <i>Sotera</i> stipulation, <i>Intellectual Ventures II, LLC v. Tesla, Inc.</i> , No. 6:24-cv-188-ADA (WDTX)

CERTIFICATE OF SERVICE

The undersigned certifies, under 37 C.F.R. § 42.6, that service was made on the Patent Owner as detailed below.

Date of service April 4, 2025

Manner of service Electronic Email: BTheiss@vklaw.com;
DGolub@vklaw.com; RODonnell@vklaw.com;
RLeonard@vklaw.com; rrigby@intven.com

Documents served **Petitioner's Authorized Reply to Patent Owner's Preliminary Response; Exhibits 1017-1022.**

Persons served Brandon R. Theiss
Daniel H. Golub
Ryan W. O'Donnell
Robert D. Leonard
VOLPE KOENIG
30 S. 17th Street, Suite 1800
Philadelphia PA 19103

Russell J. Rigby
Intellectual Ventures II LLC
3150 139th Avenue Southeast Building 4
Bellevue, WA 98005

/Scott T. Jarratt/
Scott T. Jarratt
Lead Counsel for Petitioner
Registration No. 70,297