

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,

Petitioner,

v.

INTELLECTUAL VENTURES II LLC,

Patent Owner.

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

**PRE-INSTITUTION SUR-REPLY IN SUPPORT OF
PATENT OWNER'S PRELIMINARY RESPONSE**

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PATENT OWNER'S EXHIBIT LIST

EX2001	Declaration of Dr. Gary Lomp
EX2002	Resume of Dr. Gary Lomp
EX2003	Tesla, Inc.'s Opening Claim Construction Brief in <i>Intellectual Ventures II, LLC v. Tesla, Inc.</i> , Civil No. 1:24-cv-884-ADA, Document # 26, filed January 9, 2025
EX2004	Docket from District Court Litigation, <i>Intellectual Ventures II LLC v. Tesla, Inc.</i> , C.A. 6:24-cv-00188 (W.D. Tex.)
EX2005	Petitioner's Invalidity Contentions In District Court

The Reply fails to cure the deficiencies of the Petition. As explained below, Petitioner has failed to rebut the plain claim language requiring a one-to-one correspondence between each bit and a respective time interval, offering no alternative construction and ignoring key disclosures in the '416 Patent. The cited prior art does not teach the claimed correspondence. Its *Fintiv* arguments likewise fall short, as the Parallel Litigation is on track, the overlap in prior art was foreseeable, and Petitioner's counterclaims cover all challenged claims.

I. THE REPLY FAILS TO ADDRESS THE PLAIN MEANING OF THE CLAIM LANGUAGE

Claim 1 of the '416 recites in pertinent part:

a receiver, the receiver configured to receive broadcast information including a plurality of bits, wherein *each of the plurality of bits indicates a respective time interval* that physical shared channel resources are utilized to signal channels; ...

The juxtaposition of “*each* of the plurality of bits” with “*a respective* time interval,” mandates a one-to-one correspondence between each of the plurality of bits used to indicate the respective intervals and the respective time intervals themselves. The claim language expresses both the term “each” and the phrase “a respective time interval” in the singular, making clear that each single bit (in the plurality of bits) indicates whether a different (respective) time interval is used to signal channels. The plain language of the claims cannot be squared with any other construction.

The Reply offers only a conclusory assertion that “the claims themselves do

not recite this “one-to-one correspondence” between a single bit and a “different” time interval.” Reply, 6. Absent is any explanation of how the juxtaposition of “each of the plurality of bits” with “a respective time interval” could mean anything other than a one-to-one correspondence between each of the plurality of bits used to indicate the respective intervals and the respective time intervals themselves. The fact that Petitioner is unable to proffer any counter-interpretation of the plain language of the claim underscores the correctness of Patent Owner’s construction.

Rather than focus on the actual claim language, the Reply argues that Patent Owner’s construction requiring a one-to-one correspondence is not supported by the specification. Here again, the Reply fails to address the actual language of the '416 Patent. As set forth in the POPR (at 12-13), the '416 Patent explains:

Referring now to FIG. 9, there is illustrated an example of resource allocation in accordance with embodiments of the invention. ... for the embodiments illustrated in FIG. 9, the INCH 921 comprises a plurality of FACH indicator bits 922. For the illustrated embodiments, the INCH 921 comprises four FACH indicator bits 922, each FACH indicator bit 922 relating to one of the FACH channels 920. Ex. 1001, 13:63-14:4 (emphasis).

The Reply does not explain how the above passage discloses anything other than a one-to-one correspondence between each indicator bit and a FACH channel.

Moreover, after walking through the illustrated embodiments, the specification expressly disclosed variations of the illustrated embodiments where the indicator bits are used to individually signal whether FACH channels across multiple timeslots are each active. *Id.*, 14: 44-53 (“For the various embodiments

illustrated and described herein, a single timeslot has been allocated for FACH channels. However, a skilled artisan would appreciate that more than one timeslot may be allocated for FACH channels. Accordingly, and in accordance with an embodiment of the invention, where more than one timeslot is allocated for FACH channels, the one or more timeslots may, individually or collectively, and as a whole or partly, be re-allocated for use by other channels when not required for the transmission of FACH messages.”). In the disclosed variation where multiple timeslots are allocated to FACH channels, the “individual” reallocation of a time slot with an indicator bit plainly requires a one-to-one correspondence between each indicator bit and the time slot allocated for a particular FACH channel. Again, despite being given an opportunity to address the above quoted aspects of the specification, which were repeatedly emphasized in the POPR, the Reply fails to explain why the variations of the illustrated embodiments expressly disclosed in the specification fail to support the claimed correspondence between each indicator bit and a respective time interval. *See*, POPR, e.g., at 10-11 and 12-13.

Thus, Petitioner’s claim construction arguments must be rejected.

II. THE MAPPINGS FAIL TO MEET THE CLAIM LANGUAGE

The Reply incorrectly argues that “nothing in the claim” excludes the Petition’s mappings. Reply, at 7.

In connection with Element [1.1], the Petition maps the claimed “plurality of

bits” to the first 288 bits in the PICH frame of Vayanos. Pet., 37-40. The Reply does not dispute that in Vayanos, all of the bits in a given paging indicator (Np) -- which is always made up of multiple bits -- are set to the same value. Rather than meeting the claim language which requires a one-to-one correspondence between each of the plurality of bits and a respective interval (such that each single bit indicates whether a different (respective) time interval is used), Vayanos implements a many-to-one correspondence between the indicator bits and a particular time interval. The Reply does not address this deficiency in Vayanos.

In connection with Element [1.2], the Petition maps the claimed “plurality of bits” to the “Paging on, Paging off, Paging off” blocks at the top of FIG. 2 of Kim. Reply at 7, citing Pet., at 40-42. As explained in the POPR, this mapping fails because the “Paging On”/“Paging Off” blocks at the top portion of FIG. 2 of Kim are not transmitted to a terminal as “a plurality of bits.” Instead, Kim’s disclosure compels the opposite conclusion because the reference explains that “[w]hen no paging information is generated (see 2 of FIG. 2), the paging channel does not exist in the transport channel of the radio frame (see 5 of FIG. 2). In this case, the paging indication channel is not also set up.” EX1005, 5:9-17 (emphasis added). Thus, no paging indicator information is transmitted to the terminal for the boxes labelled “Paging off” in the top row of FIG. 2 of Kim. See POPR, at 27-30 and 41-43. The Reply does not dispute Patent Owner’s description of Kim’s “Paging On”/“Paging

Off” blocks. Since there is no “plurality of bits” sent to the UE corresponding to Kim’s “Paging On”/“Paging Off” blocks, this mapping fails to demonstrate that a UE receives such a “plurality of bits,” as claimed.

The Reply (at 7) also refers to the “alternative example” at page 43 of the Petition. In this mapping, a Transmission Time Interval is mapped to a respective time interval, but the mapping fails to identify what aspect of Kim/Vayanos corresponds to “the plurality of bits.” To the extent this mapping relies on Vayanos for “the plurality of bits,” it fails because, as explained above, Vayanos implements a many-to-one correspondence between the indicator bits and a particular time interval. To the extent the mapping relies on the PICH in Kim for “the plurality of bits,” it fails because Kim fails to disclose the format of the indication information in the PICH. Absent from Kim is any disclosure that each single bit in “the plurality of bits” in the PICH indicates whether a different (respective) time interval is used to signal channels. At most, all of the bits in Kim’s PICH collectively signal only a single TTI in the frame, which fails to meet the claim language.

III. DISCRETIONARY DENIAL IS WARRANTED

Relying on a news article (EX1021) discussing something Judge Albright said at a conference five years ago, and a bifurcation order in an unrelated case (EX1020), the Reply asks the Board to make the leap that the Court will not keep to its Scheduling Order - which is not a "proposed" or "unentered" order (see, Pet., at 83),

as it has been signed by the Court. However, the cited bifurcation resulted from a joint motion to bifurcate (*id*); no such motion has been filed in the Parallel Litigation. Moreover, Petitioner omits the portion of the article where “Judge Albright said he’s presiding right now over a case with ‘seven or eight’ patents, and the parties have made opposite requests about how to try the case.” EX1021. This demonstrates that trial structure decisions depend on actual party requests—which are absent here. Finally, while the “Boalick Memo” indicates that time-to-trial statistics “may” still be considered, the Acting Director’s rescission of the 2022 Vidal Memo (which had directed the use of such statistics over other evidence) demonstrates that such statistics now have lesser importance. Thus, factor 2 still favors discretionary denial.

As set forth in the Scheduling Order (EX1011), on April 10, 2025, the District Court held a Markman Hearing. Prior to the Hearing, the Court issued preliminary constructions based on extensive briefing submitted by the parties. Despite the number of patents at issue, the Markman Hearing occurred on time as set forth in the Scheduling Order. This demonstrates that the Parallel Litigation is on schedule, as well as the already significant investment by the Court and the parties in the Parallel Litigation, favoring discretionary denial under factor 3.

With respect to factor 4, weeks after filing this IPR, Petitioner filed its Invalidity Contentions in the District Court -- a detailed 241-page document that did not materialize overnight. EX2005. Clearly, at the time Petitioner filed this IPR,

Petitioner's Invalidity Contentions were well underway and Petitioner knew that there would be significant overlap between the prior art it was advancing in this IPR and the Parallel Litigation. However, rather than deal with this foreseeable and very likely known overlap, Petitioner made the strategic decision in the Petition to characterize the overlap as "speculative." Pet., 85. The belated attempt to abandon its position that the overlap is "speculative," in favor of a *Sotera* stipulation, should be rejected. The rules forbid a Petitioner from pivoting to a new theory in a reply. 37 C.F.R. 42.23(b). In addition, allowing a Petitioner to hold back a *Sotera* stipulation when filing the Petition in order "to wait and see" Patent Owner's discretionary arguments before deciding whether to commit to a *Sotera* stipulation in reply "would open the door to gamesmanship." *NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556, Paper #13, at 4 (precedential).

The Reply argues the Petition challenges claims not asserted by Patent Owner in the Parallel Litigation. Reply, at 2. However, Petitioner's Counterclaim in the Parallel Litigation challenges the validity of the '416 Patent as a whole, and is not limited to the claims asserted by Patent Owner but instead covers all claims of the '416 Patent. Thus, all of the claims challenged in the IPR are also covered by Petitioner's counterclaim in the Parallel Litigation. This overlap favors a discretionary denial under factor 4.

Respectfully submitted,

Dated: April 11, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **PRE-INSTITUTION SUR-REPLY IN SUPPORT OF PATENT OWNER'S PRELIMINARY RESPONSE** was served via email (as consented to by counsel) on April 11, 2025 to lead and backup counsel of record for Petitioner as follows:

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