

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

AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST

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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

Petitioner's Request ("Request") for Director Review should be denied.

I. The Board Correctly Interpreted The Claim Language

Claim 1 of the '416 Patent provides 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 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 Petition alleged that this claim limitation should have its "ordinary and customary" meaning, but mapped the limitation to prior art lacking the one-to-one correspondence required by the plain meaning of the claims. Petition, 15, POPR, 39. Petitioner requested and was authorized to file a Pre-Institution Reply, in which Petitioner offered 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 was *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 and the respective time intervals. The fact that Petitioner was (and still is) unable to proffer any counter-interpretation of the plain language of the claim underscores the futility of Petitioner's position.

While the Petition had alleged that the claim language should be given its "ordinary and customary meaning," Petitioner's Reply pivoted and argued that a construction requiring a one-to-one correspondence was not supported by the specification. However, the Reply failed to address aspects of the specification emphasized in the POPR (at, e.g., 10-13) where, for example, after walking through the illustrated embodiments, the specification of the '416 Patent disclosed variations of the illustrated embodiments where the indicator bits are used to individually signal whether FACH channels across multiple timeslots are each active. Ex. 1001, 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. Significantly, despite being given an opportunity to do so, the Reply failed to address the above aspects of the specification (e.g., 14:44-53) which had been emphasized in the POPR. See, POPR, e.g., at 10-13.

II. Petitioner’s Prior Arguments Were Considered And Properly Rejected

The Reply (at 6) included only the following two-sentence argument that the specification “does not disclose” the claimed one-to-one correspondence:

... 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.

The Board considered and correctly rejected this argument, specifically referencing Figures 7 and 9 and the passages from the specification identified by Patent Owner (Ex. 1001, 13:63-14:4 and 14:44-53) in the Board’s citations:

... Petitioner similarly does not identify anything from the specification of the ‘416 patent that would support deviating from the plain meaning of limitation 1.2. ... Here, however, Patent Owner is not attempting to import a more particularized meaning into limitation 1.2, but to demonstrate that the ‘416 specification is consistent with the ascertainable definition of “each” and “respective” within the context of limitation 1.2. In particular, Patent Owner highlights that the ‘416 specification describes the resource allocation technique as using an indicator bit, within a plurality of indicator bits, that has a one-to-one correspondence to a specific time window established for a Forward Access Channel (FACH). See Ex. 1001, 13:63–14:25, 14:44–53, Figs.

7, 9; PO Resp. 11–14, 19–20; PO Sur-reply 2–3; Ex. 2001 ¶¶ 36–40, 49. And we agree that the ‘416 specification informs, and is consistent with, the plain reading of limitation 1.2. See Ex. 1001, 13:63–14:25, 14:44–53, Figs. 7, 9. Institution Decision, 13-14 (emphasis added).

Petitioner’s allegation that the Board denied institution “[w]ithout addressing the substance of Petitioner’s reply arguments regarding lack of specification support” is simply wrong. Request, 4.

III. The Request Is Filled With New Arguments Not Previously Presented

The Request completes Petitioner’s pivot away from its position set forth in the Petition (at 15) that the claim language should be given its “ordinary and customary meaning,” alleging instead in the Request that “[c]onstrained by the specification, Petitioner interpreted the claim language (newly added in the ‘416 patent) as reasonably as possible.” Request, 10. To that end, the Request includes pages and pages of new arguments that were not raised previously. For example, Petitioner purports to address for the first time the passage from the specification (13:63-14:4) that Patent Owner advanced in the POPR (see, POPR, at 10-13) in support of Patent Owner’s position. Request, 7. More generally, other than the two sentences in the Reply (at 6) alleging that the specification “does not disclose” the claimed one-to-one correspondence (which were considered and properly rejected), none of the arguments spanning pages 4-14 of the Request were ever previously presented and must therefore be rejected as untimely. As set forth in the Office’s

Guidance on the Director Review Process, [t]he Director will not consider ... new arguments not part of the official record.”¹

In any event, the new arguments fail to diminish the Board’s finding that “the ‘416 specification informs, and is consistent with, the plain reading of limitation 1.2.” Institution Decision, 13. The new arguments purport to analyze bits and pieces of the specification in isolation, rather than reading the specification as a whole which includes not just the embodiments depicted in the figures, but also, for example, the variations to the depicted embodiments expressly disclosed at 14:44-53 and emphasized in the POPR.

IV. Petitioner’s Policy Argument Lacks Merit

Petitioner advances a “policy” argument that “the ‘416 patent should not have issued given that it includes claim language unsupported by the specification” and denial of institution is therefore “inconsistent with the AIA’s goal” of allowing challenges to patents that should not have issued. Request, 13. At bottom, Petitioner’s current position is that the ‘416 Patent is invalid because, in Petitioner’s view, the claims lack support in the specification. If that truly is Petitioner’s theory, Petitioner chose the wrong forum to advance its case: the focus of IPRs is challenges based on anticipation or obviousness, rather than lack of specification support.

For all of these reasons, the Request for Director Review should be denied.

¹ <http://www.uspto.gov/patents/ptab/decisions/director-review-process>

Respectfully submitted,

Dated: July 18, 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 **AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST** was served via email (as consented to by counsel) on July 18, 2025 to lead and backup counsel of record for Petitioners as follows:

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