

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

IPR2025-00219
U.S. Patent No. 9,706,500

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL**

Table of Contents

Petitioner’s Exhibit List	iv
I. Introduction	1
II. Discretionary denial under <i>Fintiv</i> is not warranted.....	2
A. Factor 1 is neutral: No evidence regarding a stay.	2
B. Factor 2 favors institution: The parallel proceeding trial date is speculative.	3
C. Factor 3 favors institution: Minimal relevant investment and expeditious filing.	7
D. Factor 4 strongly favors institution: Petitioner’s “ <i>Sotera Plus</i> ” stipulation.	10
E. Factor 5 is neutral: Petitioner is a defendant in the parallel litigation. ...	13
F. Factor 6 favors institution: The merits of the Petition are particularly strong because a previous panel instituted trial against a related patent on similar grounds.	13
G. The <i>Fintiv</i> factors as a whole favor institution.....	14
III. The additional factors set forth in the Director Memo favor institution.....	14
A. The merits of the Petition are strong in light of previously instituted IPRs.	15
B. Compelling economic and national security interests favor institution.	17
C. The Petition properly relies on evidence-supported expert testimony in accordance with Federal Circuit precedent.	20
1. Federal Circuit precedent requires the perspective of a POSITA.....	21
2. Dr. Kotzin’s testimony is fully supported by evidence under <i>Xerox</i>	24

D. There are no gaps in the cited references.	26
1. The Petition identifies a single physical channel carrying both scheduling information and power control information.	27
IV. The new Interim Process should not govern the decision to institute.	28
V. Conclusion.....	34
Certificate of Service	36

PETITIONER'S EXHIBIT LIST

Ex.1001	U.S. Patent No. 9,706,500 to Anderson (“’500 Patent”)
Ex.1002	Prosecution File History of U.S. Patent Application No. 15/229,906 (“’906 Application”) issued as the ’500 Patent
Ex.1003	Declaration of Michael Kotzin under 37 C.F.R. § 1.68
Ex.1004	U.S. Patent No. 6,600,772 to Zeira et al. (“Zeira”)
Ex.1005	U.S. Patent Application Publication No. 2004/0190485 by Khan (“Khan”)
Ex.1006	U.S. Patent No. 7,493,133 to Krishnan et al. (“Krishnan”)
Ex.1007	U.S. Patent No. 6,529,741 to Tong et al. (“Tong”)
Ex.1008	U.S. Patent Application Publication No. 2004/0077370 by Dick et al. (“Dick”)
Ex.1009	U.S. Patent No. 6,334,047 to Andersson et al. (“Andersson”)
Ex.1010	U.S. Patent Application Publication No. 2001/0036238 by Baker et al. (“Baker”)
Ex.1011	Prosecution File History of U.S. Patent Application No. 10/917,968 (“’968 Application”) issued as U.S. Patent No. 8,897,828 to Anderson (“’828 Patent”)
Ex.1012	Harri Holma & Antti Toskala, WCDMA for UMTS: Radio Access for Third Generation Mobile Communications (2d ed. 2002)
Ex.1013	Reserved
Ex.1014	<i>Curriculum Vitae</i> of Michael Kotzin
Ex.1015	IV’s Preliminary Infringement Contentions, <i>Intellectual Ventures II, LLC v. Tesla, Inc.</i> , No. 6:24-cv-188-ADA (WDTX)
Ex.1016	Shin & Zeira et al., “Pathloss-Aided Closed Loop Transmit Power

	Control for 3G UTRA TDD,” IEEE (2003)
Ex.1017	IV’s Complaint, <i>Intellectual Ventures II, LLC v. Tesla, Inc.</i> , No. 6:24-cv-188-ADA (WDTX)
Ex.1018	Proposed Scheduling Order, <i>Intellectual Ventures II, LLC v. Tesla, Inc.</i> , No. 6:24-cv-188-ADA (WDTX)
Ex.1019	Statistics on District Court Timing
Ex.1020	Interim Procedure for Discretionary Denials in AIA Parallel District Court Litigation, June 21, 2022
Ex.1021	Prosecution File History of U.S. Patent Application No. 13/727,153 issued as U.S. Patent No. 9,055,586 to Anderson
Ex.1022	Prosecution File History of U.S. Patent Application No. 14/713,719 issued as U.S. Patent No. 9,414,326 to Anderson
Ex.1023	Reserved
Ex.1024	Reserved
Ex.1025	Andrew S. Tanenbaum, “Computer Networks,” 4th ed. (2002)
Ex.1026	United States Copyright Office Catalog Record for Andrew S. Tanenbaum, Computer Networks, 4th ed. (Ex.1025)
Ex.1027	Behrouz A. Forouzan, “Data Communications and Networking,” (3 rd ed. 2003)
Ex.1028	Copyright registration record for Forouzan (Ex.1027)
Ex.1029	Prabhakar Chitrapu, et al., “Wideband TDD: WCDMA for the Unpaired Spectrum,” (2004)
Ex. 1030	U.S. Patent No. 7,519,390
Ex. 1031	U.S. Patent No. 6,351,460
Ex.1032- Ex.1052	Reserved

Ex.1053 (NEW)	Statistics on District Court Timing (Dec. 31, 2024)
Ex.1054 (NEW)	WDTX 2024 Statistical Public Report, available at https://www.txwd.uscourts.gov/court-information/district-statistics/
Ex.1055 (NEW)	Amended Order Assigning the Business Of the Court (Judge Moses, Jan. 31, 2025)
Ex.1056 (NEW)	LexMachina docket report
Ex.1057 (NEW)	LexMachina docket report
Ex.1058 (NEW)	“Albright Worried Multipatent Trials Ask Too Much Of Jurors,” Law360 (Dec. 18, 2020), at https://www.law360.com/articles/1337976/albright-worriedmultipatent-trials-ask-too-much-of-jurors
Ex.1059 (NEW)	Bifurcation Order – Videolabs, Inc. v. Asustek Computer, Inc. 6:22-cv-00720-ADA (WDTX)
Ex.1060 (NEW)	Joint Claim Construction Statement, <i>Intellectual Ventures II, LLC v. Tesla, Inc.</i>, No. 6:24-cv-188-ADA, ECF No. 37 (WDTX) (March 28, 2025)
Ex.1061 (NEW)	“The economic contributions of Tesla to the California economy, 2018–2021,” IHS Markit (Oct. 2022), available at https://digitalassets.tesla.com/tesla-contents/image/upload/Tesla-California-Economic-Impact-Final-Report-October-2022
Ex.1062 (NEW)	“Tesla’s ‘American-made’ cars won’t get hit as hard by the auto tariffs,” CNN.com, https://www.cnn.com/2025/03/29/cars/american-made-cars-tesla-auto-tariffs/index.html, retrieved Apr. 14, 2025
Ex.1063	“An Assessment of the Impact of the Inter Partes Review

(NEW)	Process under the Patent Trial and Appeal Board on the US Economy,” The Perryman Group, available at https://www.perrymangroup.com/publications/report/2021/9/23/an-assessment-of-the-potential-impact-of-expanding-inter-partes-review-ipr-under-the-america-invents-act-on-the-us-economy/
Ex.1064	Reserved
Ex.1065 (NEW)	“Tesla’s California Footprint,” https://www.tesla.com/blog/teslas-california-footprint (retrieved Apr. 25, 2025)
Ex.1066 (NEW)	“FAQs for Interim Processes for PTAB Workload Management,” available at https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management (retrieved May 13, 2025).
Ex.1067 (NEW)	Notice of <i>Sotera Plus</i> Stipulation for Defendant Tesla, Inc., <i>Intellectual Ventures II, LLC v. Tesla, Inc.</i>, 1:24-cv-884-ADA, ECF No. 59 (WDTX) (May 27, 2025)
Ex.1068 (New)	Defendant’s Final Invalidity Contentions, <i>Intellectual Ventures II, LLC v. Tesla, Inc.</i>, 1:24-cv-884-ADA (WDTX) (May 22, 2025)

I. Introduction

Petitioner Tesla, Inc. opposes Patent Owner’s Request for Discretionary Denial (Paper 6, “PO Brief”) because denial is inappropriate under *Fintiv* and the additional factors set forth in the Acting Director’s “Interim Processes for PTAB Workload Management” (“Director Memo”).

With respect to *Fintiv*, this IPR is a “true alternative” to the parallel litigation in view of Petitioner’s “*Sotera Plus*” stipulation that eliminates all potential overlap—including the overlap identified by the Acting Director in *Motorola Solutions*: “combinations of the prior art asserted in these proceedings with unpublished system prior art.” *Motorola Solutions Inc. v. Stellar, LLC*. IPR2024-01205, Paper 19 at 3-4 (Mar. 28, 2025). Further, at institution, the district court will not have issued any orders resolving a dispute related to the ’500 patent, which “weighs against” denial under *Fintiv*. Moreover, trial in the parallel litigation is unlikely to happen prior to a Final Written Decision, in view of (i) the median time to trial for this Court, (ii) Judge Albright’s move to Austin and corresponding 40% increase in docket size, and (iii) the sheer number of patents asserted (eleven) by Patent Owner against Petitioner.

The additional factors listed in the Director Memo similarly weigh against denial. Most importantly, the merits of the Petition are particularly strong and warrant review because a previous panel instituted trial against a related patent on

similar grounds. In addition to the strong merits, the United States has a compelling economic and national security interest in ensuring Tesla, a leading domestic manufacturer and innovator, has access to cost-effective PTAB review when accused of infringement. Congress passed the AIA specifically to curtail counterproductive litigation costs. IV has no compelling interest or expectation sufficient to avoid PTAB review under the circumstances here. IV is similarly wrong that denial is warranted based on Petitioner's use of expert testimony. Such testimony is appropriate (even necessary) under Federal Circuit precedent and supported by evidence.

For these reasons and the reasons below, Petitioner respectfully requests that the Director decline to exercise her discretion to deny and advance the Petition to a merits panel for consideration.

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

The *Fintiv* factors, considered as a whole, do not warrant denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential). Every factor either favors institution or is neutral—where Factor 4 weighs ***strongly*** toward institution given Petitioner's "*Sotera Plus*" stipulation that is broader than the scope of estoppel under 35 U.S.C. § 315(e)(2).

A. Factor 1 is neutral: No evidence regarding a stay.

No motion to stay has been filed, so the Board should not infer the outcome

of such a motion. *Sand Revolution II, LLC v. Continental Intermodal Group –*

Trucking LLC, IPR2019-01393, Paper 24 at 7 (June 16, 2020) (informative). This factor is thus neutral.

B. Factor 2 favors institution: The parallel proceeding trial date is speculative.

Factor 2 favors institution, or, at worst, is neutral. Trial is currently set for May 14, 2026, which is less than two months before the projected due date for the Final Written Decision on July 9, 2026. Ex.2003, 4. 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.” *Fintiv* at 9. Here, because the trial date is around the same time as the projected Final Written Decision, other factors—in particular Petitioner’s “*Sotera Plus*” stipulation (see below)—outweigh Factor 2.

Moreover, the less-than-two-month gap between the trial date and Final Written Decision (as opposed to the six-month trial gap in *Fintiv*) “increases the possibility here that any unforeseen delay in the district court proceeding could cause the order of those two events to reverse.” *Cisco Sys., Inc. v. Portsmouth Network Corp.*, IPR2024-00503, Paper 7 at 12-13 (Aug. 6, 2024) (citing *Fintiv* at 9). Such delay in the district court is likely here for several reasons.

First, the scheduled trial date of May 14, 2026, is inconsistent with the median time-to-trial in WDTX of 33.9 months which instead puts trial in January

of 2027, after the projected final written decision on July 9, 2026. *See* Ex.1053, 5; *see also Amazon.com, Inc. v. NL Giken Inc.*, IPR2025-00250, Paper 14 at 2 (May 16, 2025) (Acting Director finding discretionary denial inappropriate because “time-to-trial statistics suggest trial would not begin until” after the projected final written decision date); USPTO Guidance of March 24, 2025 (“Boalick Memo”) (“the Board may consider...median time-to-trial statistics”). It is likely the scheduled trial date will move more in line with the median time-to-trial statistics because Judge Albright is moving his chambers from the Waco division (a division with a limited docket) to the Austin division (a division with a much heavier docket). *See* Ex.1054 (WDTX 2024 Statistical Report), 1 (809 case filings in Waco, 1,765 case filings in Austin).

Moreover, Judge Albright's docket is further expanding beyond the median. For example, until the vacancy in Waco is filled, Judge Albright will retain his *entire* Waco docket while taking on **40%** of the docket in the Austin division, as ordered by Chief Judge Moses on January 31st:

Item VIII

U.S. District Judge Alan D. Albright:

- (a) Forty percent (40%) of the civil docket in the Austin Division;
- (b) Forty percent (40%) of the criminal docket in the Austin Division;
- (c) One hundred percent (100%) of the civil docket in the Waco Division, with the exception of patent cases;
- (d) One hundred percent (100%) of the criminal docket in the Waco Division;
- (e) Patent cases will be assigned as ordered on May 30, 2024, in the Court's Order Assigning the Business of the Court as it Relates to Patent Cases; and
- (f) All other proceedings in the Waco Division.

Ex.1055, 3. Further, in the three months since this order, at least 382 cases have been reassigned to Judge Albright, including 61 patent cases. *See* Ex.1056 (LexMachina report); Ex.1057 (LexMachina report). At least 16 of these 61 new patent cases on Judge Albright's docket were filed in the same month as the present parallel litigation or before. *See* Ex.1057. The sheer number, type, and timing of the new cases reassigned to Judge Albright will inevitably lead to delay, likely pushing the trial date in the instant parallel litigation past the Final Written Decision in this IPR.

Second, there are *eleven* patents asserted in the parallel litigation¹. Ex.1017,

¹ Patent Owner originally asserted twelve patents, but the parties jointly moved to dismiss with prejudice their respective claims for U.S. Patent No. 8,898,395. The court granted the motion on May 16, 2025.

2. These eleven patents span *nine* different families that vary widely in subject matter:

Patent	Title	Family
6,894,639	Generalized hebbian learning for principal component analysis and automatic target recognition, systems and method	A
7,181,743	Resource allocation decision function for resource management architecture and corresponding programs therefor	B
7,336,805	Docking assistant	C
7,916,180	Simultaneous multiple field of view digital cameras	D
9,232,158	Large dynamic range cameras	D
9,706,500	Power control in a wireless network	E
10,136,416	Communicating on a shared channel in a wireless network	F
10,292,138	Determining buffer occupancy and selecting data for transmission on a radio bearer	G
10,952,153	Power control in a wireless network	E
11,206,670	Communication in a wireless network using restricted bandwidths	H
11,664,889	Communications in a wireless network	I

The notion that a jury will be asked to consider eleven patents across nine families in a single trial starting on May 14, 2026 is unreasonable. Indeed, 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.1058; *see also* Ex.1059 (example Albright bifurcation order). A trial for any given patent of the eleven asserted is therefore likely to occur later than the currently scheduled date.

Accordingly, Factor 2 favors institution in view of the minimal trial gap and inevitable delay in the parallel proceeding due to (i) Judge Albright's move and corresponding docket increase and (ii) the large number and scope of asserted patents.

C. Factor 3 favors institution: Minimal relevant investment and expeditious filing.

Factor 3 favors institution because, at institution, investment by the court and parties will have been minimal as to the activities pertinent to *Fintiv*. Patent Owner's Request for Discretionary Denial includes a laundry list of activities allegedly showing substantial investment, but very few relate to invalidity of the '500 patent. *See* PO Brief, 4-5. Under *Fintiv*, "[i]f, at the time of the institution decision, the district court has not issued orders *related to the patent at issue in the petition*, this fact weighs against exercising discretion to deny institution." *Fintiv*, 10. Here, even if the court issues a *Markman* order prior to institution, there are no disputed claim terms associated with the '500 patent. *See* Joint Claim Construction Statement, Ex.1060 (showing that the parties agree on two '500 patent claim terms), 2. Thus, under *Fintiv*, the lack of an order addressing a dispute related to the '500 patent weighs against discretionary denial .

Further, *Sotera* explains that, even after *Markman* is complete, "much other work remains in the parallel proceeding as it relates to invalidity," including "fact discovery," "expert reports," and "substantive motion practice." *Sotera Wireless*,

Inc. v. Masimo Corp., IPR2020-01019, Paper 12 at 16 (Dec. 1, 2020) (precedential as to § II.A). The informative *Fintiv* and *Sand* decisions similarly observe that even after *Markman*, much work remains. See *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 13-14 (May 13, 2020) (informative) (“We recognize that much work remains in this case as it relates to invalidity: fact discovery is in its early stages, with document production ongoing and depositions just getting underway, expert reports are not yet due, and substantive motion practice is yet to come.”); *Sand Revolution*, 10 (“But aside from the district court’s *Markman* Order, much of the district court’s investment relates to ancillary matters untethered to the validity issue itself.”).

Here, although the *Markman* hearing occurred prior to institution, much work will remain in the ten months between institution (July 9, 2025) and the scheduled trial date (May 14, 2026)—especially given that the district court will not construe any contested terms for the ’500 patent. Fact discovery will be in its early stages and will not close until November 6, 2025. Ex.2003, 3. Opening expert reports are not due until November 20, 2025, and expert discovery will not close until January 15, 2026. *Id.* Substantive motion practice, similarly, will be yet to come. *Id.* at 3-4. Accordingly, because much of the investment relevant to issues of invalidity will occur after institution, this factor weighs against denial. Notably, a recent PTAB panel analyzing *Fintiv* under the Boalick Memo came to the same

conclusion under similar facts. *See Bio-Rad Labs., Inc. v. California Inst. of Tech.*, IPR2024-01451, Paper 11 at 9-10 (Mar. 27, 2025) (finding that Factor 3 “weighs against exercising our discretion to deny institution” where the *Markman* hearing has been held but “much more work remains, including, expert reports, expert discovery, expert depositions, and pretrial motions and disclosures”).

This factor also weighs against denial because “the petitioner filed the petition expeditiously.” *Fintiv*, 11. As such, “this fact [] weigh[s] against exercising the authority to deny institution.” *Id.* Here, Petitioner worked diligently to file the instant petition less than four months after receiving Patent Owner’s Preliminary Infringement Contentions and more than four months prior to the statutory deadline of April 15, 2025. At the time of filing, the parallel litigation was in its early stages and claim construction briefing had yet to begin. Petitioner submits that its diligence in filing is more than reasonable—especially given that it prepared and filed *eleven* IPR petitions challenging *121* claims in the same time frame. *See Sotera*, 17 (finding Petitioner’s explanation “reasonable” in part because “of the large number of patents and claims challenged in this and Petitioner’s [eight] other related petitions for *inter partes* review”). Several post-Boalick Memo panels have agreed that similar diligence is reasonable and weighs against denial. *See Samsung Elecs. Co., Ltd. v. Mullen Industries LLC*, IPR2024-01472, Paper 9 at 10 (Mar. 31, 2025) (“Petitioner’s diligence in filing its Petition

(a) less than five months after receiving Patent Owner's infringement contentions and (b) prior to the parties briefing claim construction issues weighs against exercising discretionary denial."); *Samsung Elecs. Co., Ltd. v. Headwater Research LLC*, IPR2024-01396, Paper 13 at 7 (Apr. 1, 2025) ("[W]e find Petitioner's diligence in filing its Petition approximately 4 months before it was statutorily required to do so, and while litigation is in its early stages, weighs against denial, not for it.").

Accordingly, Factor 3 weighs in favor of institution because (i) no substantive court order resolving a dispute related to the '500 patent will have issued prior to institution, and (ii) Petitioner's diligence in filing this petition.

D. Factor 4 strongly favors institution: Petitioner's "*Sotera Plus*" stipulation.

Factor 4 weighs strongly in favor of institution because Petitioner has made a stipulation ***broader*** than a *Sotera* stipulation in district court. *See* Ex.1067, 3 (stipulation filed in parallel district court proceeding). Specifically, Petitioner stipulated that:

[I]f the PTAB institutes an IPR (and does not subsequently vacate institution) in response to Defendant's petition against Plaintiff's U.S. Patent No. 9,706,500 (IPR2025-00219), Defendant will not pursue in this litigation against the claims challenged in IPR2025-00219, (i) the specific grounds raised in IPR2025-00219, (ii) any other grounds that could have reasonably been raised before the PTAB in that instituted proceeding (i.e.,

any ground that could have reasonably been raised under §§ 102 or 103 on the basis of prior art patents or printed publications), or (iii) any ground based on a combination of system prior art and the references asserted as part of a ground raised in IPR2025-00219, as reflected in the table summarizing the Statutory Grounds for Challenges on page 15 of the Petition .²

² To the extent Patent Owner alleges Petitioner should have submitted a stipulation at some earlier point in time, Petitioner notes that it filed the Petition prior to the creation of the bifurcated process described in the Director Memo. At the time of filing on November 26, 2024, PTAB precedent provided that the “appropriate time for a petitioner to offer a stipulation related to the *Fintiv* factor 4 analysis is prior to the Board’s decision of whether to institute review.” *NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556, Paper 13 at 4 (Sept. 7, 2022) (de-designated precedential Apr. 25, 2025); *see also Nike, Inc. v. ADIDAS AG*, 955 F.3d 45, 52 (Fed. Cir. 2020) (“In interpreting the APA’s notice provisions in the context of IPR proceedings, we have cautioned that an agency may not change theories in midstream without giving respondents reasonable notice of the change and the opportunity to present argument under the new theory.”) (citation and quotation marks omitted). Petitioner does not oppose the Director granting Patent Owner a reply for the limited purpose of addressing the above stipulation.

Petitioner's broad stipulation goes beyond the scope of estoppel under 35

U.S.C. § 315(e)(2). *See Ingenico Inc. v. IOENGINE, LLC*, No. 2023-1367, 2025 WL 1318188, at *8 (Fed. Cir. May 7, 2025) ("IPR estoppel did not preclude Ingenico from relying on the DiskOnKey System with related printed publications at trial..."). This stipulation also specifically addresses the Acting Director's comment regarding remaining overlap in *Motorola Solutions* (combinations of system art with the references asserted in the IPR). IPR2024-01205, Paper 19 at 3-4 ("Petitioner's invalidity arguments in the district court are more expansive and include combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner's [*Sotera*] stipulation is not likely to moot."). Petitioner respectfully submits that this expansive stipulation outweighs all other *Fintiv* factors as it conclusively eliminates overlap with invalidity issues raised in the parallel proceeding.

Also favoring institution under Factor 4 is that the Petition challenges *seven* claims that are not asserted in the parallel proceeding, including claims in an unasserted claim set (independent claim 17 and five of its dependents). The Petition challenges *twelve* claims (11-22), but only *five* claims (11-14 and 16) are currently asserted against Petitioner. And only those five asserted claims are the subject of Petitioner's invalidity contentions on the parallel proceeding. *See* Ex.1068, 6, 33 (asserting invalidity of "**the Asserted Claims of the Asserted**

Patents”). Petitioner elected to challenge additional, unasserted claims for efficiency reasons—for example, to avoid filing a second IPR in the event Patent Owner asserts additional claims in the parallel litigation.

Accordingly, Factor 4 weighs heavily in favor of institution because of (i) Petitioner's *Sotera* Plus stipulation and (ii) invalidity challenges to unasserted claims in the Petition that will not be resolved by the district court.

E. Factor 5 is neutral: Petitioner is a defendant in the parallel litigation.

Petitioner is a defendant in the parallel litigation. That is true of most IPR petitioners, making this factor neutral. *See HP Inc. v. Slingshot Printing LLC*, IPR2020-01084, Paper 13 at 9 (Jan. 14, 2021); *see also NVIDIA Corp. v. Invensas Corp.*, IPR2020-00603, Paper 11 at 23 (Sept. 3, 2020) (this factor weighs against discretionary denial where the district court trial and IPR final written decision are expected “around the same time”).

F. Factor 6 favors institution: The merits of the Petition are particularly strong because a previous panel instituted trial against a related patent on similar grounds.

Factor 6 favors institution because the Petition plainly shows that the '500 patent claims no more than well-known subject matter. In particular, the Petition's Zeira grounds are similar to grounds the Board previously found reasonably likely to render obvious a similar family member of the '500 patent in three separate IPR proceedings. *See* Petition, 11-13 (discussing the previously instituted IPRs

applying Zeira against the related ’828 patent). Factor 6 favors institution when “[the] issues raised by Petitioner are similar, if not identical, to those raised” in an “instituted” proceeding. *Google LLC v. Mullen Industries LLC*, IPR2025-00019, Paper 14 at 12-13 (May 12, 2025).

G. The *Fintiv* factors as a whole favor institution.

In summary, each *Fintiv* factor is either neutral or weighs against denial:

Factor	Weight	Reason
1 (stay)	neutral	no evidence of a stay
2 (trial gap)	against denial	2-month gap as scheduled; trial before FWD under time-to-trial stats; Judge Albright move and court congestion will create delay
3 (investment)	against denial	no court orders for ’500 patent; expeditious filing
4 (overlap)	strongly against denial	<i>Sotera Plus</i> stipulation; invalidity challenges not resolved by district court
5 (same party)	neutral	Petitioner is defendant
6 (merits)	strongly against denial	merits are strong as evidenced by PTAB’s institution of IPRs against related patent

Because the *Fintiv* factors as a whole favor institution, the Director should not discretionarily deny institution under §314(a).

III. The additional factors set forth in the Director Memo favor institution.

The Director Memo invites the parties to “address all relevant [discretionary denial] considerations” and provides a list of potential factors. Director Memo, 2-3. Each of the potential factors favors institution:

- The merits of the petition are particularly strong because the Board

instituted similar IPR challenges against similar claims in a related patent.

- Petitioner and the public have a reasonable expectation that the '500 patent is likely unpatentable for this same reason.
- The United States has a compelling economic and national security interest in ensuring Tesla, a leading domestic manufacturer and innovator, has access to cost-effective AIA proceedings.
- The Petition relies upon expert testimony to the extent necessary under Federal Circuit precedent, and such expert testimony is supported by evidence as required under 37 CFR § 42.65 and *Xerox*.
- Patent Owner does not allege any relevant changes in the law or new judicial precedent since issuance of the claims.

Several of these factors are of particular importance to the Director's discretion and are addressed individually below.

A. The merits of the Petition are strong in light of previously instituted IPRs.

While no tribunal has ever adjudicated the validity of the '500 patent after it issued, the PTAB previously determined there was a reasonable likelihood that similar claims of an ancestor patent, U.S. 8,897,828, were unpatentable in three separate IPR proceedings. *See* Petition, 13 (describing the history of three IPR proceedings against the related '828 patent); IPR2018-01641, Paper 7 at 14-15 (Mar. 20, 2019); IPR2018-01649, Paper 7 at 15-17 (Mar. 20, 2019); IPR2018-01773, Paper 9 at 15-16 (Apr. 22, 2019). The instant Petition applies the same prior art (Zeira) in the same way the Board found reasonably likely to render

obvious the ancestor '828 patent. In light of these previous institutions, Petitioner and the public have a reasonable expectation that the similar challenged claims of the '500 patent are likely unpatentable. Those expectations weigh strongly against discretionary denial.

Moreover, the three previous IPRs against the ancestor '828 patent were instituted but subsequently terminated prior to final written decision. Thus, the patentability of the '828 patent is under a cloud of uncertainty. Because the '500 patent claims the same concepts as the '828 patent, the '500 patent is under a similar cloud. A final adjudication on the merits would resolve the issue conclusively and put the public on notice as to whether it may make, use, or sell products embodying the concepts claimed by the '500 patent. Thus, the benefits of adjudication by a merits panel weigh strongly against discretionary denial.

Patent Owner further points out that the '500 patent is expired but does not explain how or why this fact, standing alone, favors denial. PO Brief, 17. Patent Owner, for example, does not allege that this length of time has created "settled expectations" as to any aspect of the '500 patent. Instead, IV appears to have acquired the '500 patent solely for the purpose of monetizing it through litigation, significantly decreasing any potential relevance of this factor or of any purported settled expectations. Moreover, IV itself elected to assert the '500 patent, which it should have known gives rise to the possibility of an IPR challenge. The '500

patent is not entitled to a presumption of validity in this proceeding.

Accordingly, because the previous instituted IPRs cast doubt on the validity of the '500 patent and a final adjudication on the merits would resolve that doubt, the Director should pass this petition to a merits panel for consideration.

B. Compelling economic and national security interests favor institution.

The United States has compelling economic and national security interests in affording Petitioner Tesla the opportunity to challenge the '500 patent under the more efficient IPR framework. For example, according to a recent Executive order, “[a] nation’s ability to produce domestically is the bedrock of its *national and economic security*” and “[t]he need to maintain robust and resilient domestic manufacturing capacity is *particularly acute in certain advanced industrial sectors like automobiles*” Exec. Order No. 14257, 90 Fed. Reg. 15041, 15043 (April 2, 2025). As a leading domestic automobile manufacturer, Tesla should be free to invest and innovate without being encumbered by defending expensive patent litigations where the asserted patents are likely invalid. A right to seek review of such patents before the U.S. Patent and Trademark Office ensures Tesla can continue its mission to accelerate the world’s transition to sustainable energy and that the United States leads in that mission.

Tesla has invested billions of dollars developing high-tech engineering and manufacturing facilities across the U.S., including in Texas, Nevada, and

California. These investments have led to significant, positive economic impacts for the associated areas. Ex.1061 (IHS Markit economic report), 3 (“The contributions of Tesla to the California economy” in 2021 included \$16.6 billion in economic activity, \$10.3 billion in gross state product (GSP), ~80,500 jobs, +30% higher average wage, \$10.3 billion in total wages, and ~\$1.0 billion in federal, state, and local taxes.) (cited by Ex.1065 (“Tesla’s California Footprint” on Tesla.com)). And, by design, Tesla’s vehicles are “[a]s ‘American-made’ as you can get,” and have topped “Car[s].com’s American-Made Index since 2021.” Ex.1062, 1-2 (“Tesla’s manufacturing, both as location of final assembly and the componentry of the vehicles, is all as high (a score on the index) as you could possibly get for a US-made vehicle.”).

This type of advanced domestic engineering and manufacturing capacity “is critical to U.S. national security.” Exec. Order No. 14257, 90 Fed. Reg. 15041, 15043 (April 2, 2025) (“Both my first Administration in 2017, and the Biden Administration in 2022, recognized that increasing domestic manufacturing is critical to U.S. national security.”). Domestic engineering and manufacturing not only provide good jobs for American workers but advance important technological developments and associated knowhow domestically. *See id.* (“Increased reliance on foreign producers for goods also has compromised U.S. economic security by rendering U.S. supply chains vulnerable to geopolitical disruption and supply

shocks.”), 15044 (“Importantly, U.S. manufacturing is the main engine of innovation in the United States, responsible for 55 percent of all patents and 70 percent of all research and development (R&D) spending.”).

It is vital that companies, like Tesla, making huge investments in the U.S. are provided an effective and efficient mechanism for challenging invalid patents asserted against them. Congress created the AIA for this purpose. 77 Fed. Reg. 48612, 48612 (Aug. 14, 2012) (“The purpose of the AIA ... is to establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.”); *see also Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (Sept. 6, 2017) (“[W]e recognize that an objective of the AIA is to provide an effective and efficient alternative to district court litigation.”). AIA proceedings create cost savings for its participants via “reductions in legal fees incurred and the greater probability of a settlement or early-stage resolution.” Ex.1063 (study of AIA economic benefits), 2, 8 (“[T]he total economic benefits of *inter partes* reviews resulting in stay of litigation in district court included **an increase in US business activity of \$1.87 billion in gross product and 8,530 job-years of employment**”; “In situations where an *inter partes* review was conducted parallel to a district court proceeding, the economic benefits of [*inter partes* reviews] include estimated **increases of \$135.4 million in US gross product and 617 person-years**

of employment").

Telsa is seeking review of the '500 patent consistent with the purpose of AIA post-grant proceedings: efficient, technically reliable assessments of validity. And Tesla's broad *Sotera* Plus stipulation makes the IPR a true district court alternative. Denying Tesla access to IPR in this scenario would frustrate the purpose of the AIA and deny Tesla the specific economic benefits envisioned by Congress.

For these reasons, compelling economic and national security interests favor institution (or, at the very least, consideration of the Petition by a merits panel).

C. The Petition properly relies on evidence-supported expert testimony in accordance with Federal Circuit precedent.

Patent Owner's assertion that Petitioner's reliance on expert evidence is somehow detrimental contradicts Federal Circuit precedent. The foundational decisions upon which patent law is based—*Phillips*, *KSR*, etc.—require the adjudicator to evaluate the patent and prior art from the perspective of a POSITA. That perspective is established with evidence, often in the form of expert declarations. Attorney argument is insufficient. Here, Petitioner's expert, Michael Kotzin, provides that perspective with testimony supported by numerous tertiary references in accordance with 37 CFR § 42.65 and *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 (Aug. 24, 2022) (precedential).

1. Federal Circuit precedent requires the perspective of a POSITA.

It is well established that patent claims are construed based on the understanding of a POSITA. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (“We have made clear, moreover, that the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.”) (citing *Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc.*, 381 F.3d 1111, 1116 (Fed. Cir. 2004) (“A court construing a patent claim seeks to accord a claim the meaning it would have to a person of ordinary skill in the art at the time of the invention.”)); *Home Diagnostics, Inc. v. LifeScan, Inc.*, 381 F.3d 1352, 1358 (Fed. Cir. 2004) (“customary meaning” refers to the “customary meaning in [the] art field”); *Ferguson Beauregard/Logic Controls v. Mega Sys., LLC*, 350 F.3d 1327, 1338 (Fed. Cir. 2003) (claim terms “are examined through the viewing glass of a person skilled in the art”); see also *PC Connector Solutions LLC v. SmartDisk Corp.*, 406 F.3d 1359, 1363 (Fed. Cir. 2005) (meaning of claim “must be interpreted as of [the] effective filing date” of the patent application); *Schering Corp. v. Amgen Inc.*, 222 F.3d 1347, 1353 (Fed. Cir. 2000) (same)).

Obviousness grounds are likewise evaluated from the perspective of a POSITA. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) (“If a person of

ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.”), 418 (“[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.”), 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”).

The Federal Circuit has also made it clear that attorney argument alone is not evidence and should be given little weight. *Icon Health & Fitness, Inc. v. Strava, Inc.*, 849 F.3d 1034, 1043 (Fed. Cir. 2017) (“Attorney argument is not evidence.”) (citing *Gemtron Corp. v. Saint-Gobain Corp.*, 572 F.3d 1371, 1380 (Fed. Cir. 2009) (“[U]nsworn attorney argument . . . is not evidence and cannot rebut . . . other admitted evidence . . .”)); see also *Elbit Sys. Of Am., LLC, v. Thales Visionix, Inc.*, 881 F.3d 1354, 1359 (Fed. Cir. 2018) (“Elbit fails to present any evidence supporting this contention beyond attorney argument . . . and ‘[a]ttorney argument is not evidence’ and cannot rebut other admitted evidence.”). Because attorney argument is not evidence, expert testimony is *essential* to properly support IPR claim construction and obviousness positions that are evaluated from the

perspective of a POSITA. The Board recently confirmed this: “It is well settled that mere attorney argument unsupported by factual evidence is entitled no probative value.” *PLR Worldwide Sales LTD. v. Flip Phone Games, Inc.*, IPR2024-00209, Paper 28 at 32 (April 24, 2025).

The Petition presents and relies upon the testimony of Dr. Kotzin as required. *See* Petition, 18-74 (relying on testimony of Dr. Kotzin to support obviousness grounds). The unpatentability grounds set forth in the Petition are fully supported by the references themselves—Dr. Kotzin’s testimony serves to confirm, support, and explain the disclosures of the references from the perspective of a POSITA. *See id.*

Importantly, Dr. Kotzin was a POSITA as of the critical date of the ’500 patent (Ex.1003, ¶¶ 7-28), and his testimony is supported by corroborating evidence in the form of the disclosure of the references relied upon in the unpatentability grounds (e.g., Zeira (Ex.1004), Khan (Ex.1005), Krishnan (Ex.1006), Tong (Ex.1007), Dick (Ex.1008), Andersson (Ex.1009), Baker (Ex.1010)) and one or more tertiary references (e.g., Exs.1012, 1016, 1025, 1027, 1029, 1030, and/or 1031). *See generally*, Ex.1003. Further still, Dr. Kotzin repeatedly provides technical reasoning to support his statements and understandings of the references. *See generally*, Ex.1003.

Moreover, the Federal Circuit has recognized that “when the technology is

complex and ‘beyond the comprehension of laypersons,’ expert testimony is ‘sometimes essential.’” *Synopsys, Inc. v. Mentor Graphics Corp.*, 814 F.3d 1309, 1320 (Fed. Cir. 2016) (internal quotations removed), *overruled on other grounds* by *Aqua Prods., Inc. v. Matal*, 872 F.3d 1290, 1296 n.1 (Fed. Cir. 2017) (en banc); *see also Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1330 (Fed. Cir. 2009) (“If the relevant technology were complex, the court might require expert opinions.”). This is precisely the situation here. Dr. Kotzin’s expertise is utilized to explain the technical background of complicated concepts relevant to the ’500 patent (*see, e.g.*, Ex.1003, ¶¶ 37-45). Dr. Kotzin also provides detailed explanations regarding how a POSITA would have understood the technical descriptions found in the ’500 patent and the prior art references (*see, e.g.*, Ex.1003, ¶¶ 46-188). Dr. Kotzin’s testimony serves these essential purposes and is a strength of the Petition.

2. Dr. Kotzin’s testimony is fully supported by evidence under *Xerox*.

Patent Owner fails to even allege that Dr. Kotzin’s testimony is not supported by evidence or lacks technical reasoning. Nor could it—Dr. Kotzin’s testimony is fully supported by extensive underlying evidence including specific quotes from the references relied upon in the unpatentability grounds and a variety of tertiary references establishing the knowledge of a POSITA. Dr. Kotzin relies upon numerous tertiary references to support his opinions:

- Harri Holma & Antti Toskala, WCDMA for UMTS: Radio Access for Third Generation Mobile Communications (2d ed. 2002) (Ex. 1012);
- Shin & Zeira et al., “Pathloss-Aided Closed Loop Transmit Power Control for 3G UTRA TDD,” IEEE (2003) (Ex. 1016);
- Andrew S. Tanenbaum, “Computer Networks,” 4th ed. (2002) (Ex. 1025);
- Behrouz A Forouzan, “Data Communications and Networking,” (3rd ed. 2003) (Ex. 1027);
- Prabhakar Chitrapu, et al., “Wideband TDD: WCDMA for the Unpaired Spectrum,” (2004) (Ex.1029);
- U.S. Patent No. 7,519,390 (Ex.1030); and
- U.S. Patent No. 6,351,460 (Ex.1031).

Patent Owner's reliance on *Xerox* is misplaced. PO Brief, 13 (citing *Xerox* at 15-17). Patent Owner alleges that “paragraphs of the expert declaration essentially parrot the Petition word-for-word” and “[f]or that reason, the declaration is entitled to little if any weight.” PO Brief, 12. *Xerox*, however, does not stand for the proposition that a petition and supporting declaration cannot be similar. Instead, *Xerox* instead focuses on whether the expert testimony cites to “supporting evidence or provide[s] any technical reasoning.” *Xerox*, 15. Expert testimony is only afforded less weight if it “adds little to the conclusory assertion for which it is offered to support.” *Id.* Here, as illustrated above and in the declaration itself, Dr.

Kotzin's testimony is fully supported by evidence. Further, Patent Owner's reference to the length of Dr. Kotzin's declaration has no bearing on whether the Petition impermissibly relies on expert testimony. Instead, Dr. Kotzin's fulsome explanations that are supported by objective evidence are a "feature, not a bug of his testimony." *Tesla, Inc. v. Charge Fusion Tech., LLC*, IPR2025-00032, Paper 11 at 39 (May 19, 2025) ("To the contrary, that [Petitioner's expert] Mr. Andrews's supports his extensive explanations of his opinions with citations to dozens of pieces of objective evidence, *is a feature, not a bug of his testimony*. Mr. Andrews, and Petitioner by extension, leave virtually none of the substance of his testimony unsupported by objective evidence, *a practice that we applaud.*").

Accordingly, the Petition's proper reliance on evidence-backed expert testimony to support the unpatentability grounds favors institution.

D. There are no gaps in the cited references.

Patent Owner alleges "extensive and improper" expert testimony used for "[g]ap-filling" a single element of claim 11 in Ground 1. PO Brief, 15-16. Patent Owner is incorrect. The Petition maps every claim element to actual disclosure in the references—there are no gaps. The merits of the Petition are strong and favor institution³.

³ Notwithstanding Patent Owner's "gaps" argument as to Ground 1, Patent Owner

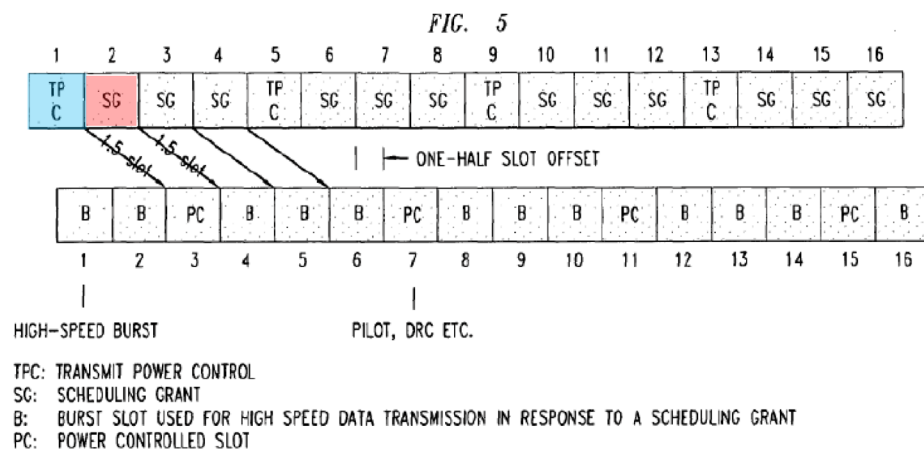
1. The Petition identifies a single physical channel carrying both scheduling information and power control information.

Patent Owner first alleges that the “references cited by Petitioner do not disclose a single physical channel that carries both scheduling information and power control information.” PO Brief, 16. However, instead of identifying the alleged gap in the Petition’s mapping, Patent Owner instead quotes (without context) a portion of Dr. Kotzin’s declaration related to a POSITA’s reasonable expectation of success in combining the Andersson and Khan references. *Id.* This misdirection fails because the mapping in the Petition *explicitly* illustrates that the Khan reference discloses a single physical channel that carries both scheduling information and power control information:

fails to address Grounds 4, 5, and 6, which independently establish the unpatentability of claims 11-22.

To the extent Andersson does not explicitly teach receiving “an allocation of an uplink resource” on the same single physical channel as its multi-level TPC command, it would have been obvious to a POSITA for Andersson’s “other bits” in the DPCCH (*single physical channel*) to include an uplink resource, as discussed above in Section X.C.3. Ex.1003, ¶86 (citing Ex.1009, 9:18-24, Fig. 5). Indeed, these aspects were well known to POSITAs as illustrated by Khan, for example. See Ex.1005, Fig. 5. Khan’s Fig. 5, reproduced below, shows scheduling grants (“SG”; example annotated in red) multiplexed on the same Walsh channel (physical channel) as TPC bits (“TPC”; example annotated in blue).

(physical channel) as TPC bits (“TPC”; example annotated in blue).



Ex.1005, Fig. 5 (annotated); Ex.1003, ¶86

Petition, 30-31.

Accordingly, Dr. Kotzin did not need to (and did not) “gap-fill” with respect to this claim element.

IV. The new Interim Process should not govern the decision to institute.

The above briefing addresses the USPTO's most recent guidance on institution as best as Petitioner understands it. But, for at least the reasons articulated below, Petitioner respectfully requests the USPTO Director to maintain the standards for institution in place at the time this Petition was filed, until such time as new guidance is issued following a notice and comment period, as required by the Administrative Procedure Act ("APA").

Petitioner developed the Petition and corresponding litigation strategy based on the standards outlined in the June 21, 2022 Interim Procedure for Discretionary Denials issued by the Office (the "June 2022 Procedures"). After the Petition was filed, however, the USPTO rescinded the June 2022 Procedures and reverted to former procedures through a short posting on the USPTO website followed by the March 24, 2025 Memorandum of Chief Administrative Patent Judge Scott Boalick (the "Boalick Memo"). Two days later, on March 26, Acting Director Stewart issued a Memorandum (the "Director Memo") introducing an entirely new "interim procedure" that bifurcates institution between "(i) discretionary considerations and (ii) merits and other non-discretionary statutory considerations." Director Memo, 1. Under this new procedure, "the Director, in consultation with at least three PTAB judges" will determine whether discretionary denial is appropriate based on "all relevant considerations," including several newly enumerated factors. *Id.* Three weeks after the Director Memo issued, the

USPTO held an oral webcast setting forth additional substantive details of the new interim procedure not found in the Director Memo. Then, eight days after the webcast, the USPTO posted on its website “FAQs for Interim Processes for PTAB Workload Management” with even more substantive details, some potentially in conflict with details provided during the oral webcast. Petitioner submits that the recission notice, the Boalick Memo, the Director Memo, the oral webcast, and the FAQs (together, the “Announcements”) do not satisfy the requisite statutory and constitutional obligations for new regulations.

By way of example, 35 U.S.C. § 316(a) mandates that “[t]he **Director shall prescribe regulations**” including regulations “(2) setting forth the standards for the showing of sufficient grounds to institute a review under section 314(a).” The Announcements fall short of 35 U.S.C. § 316(a) by:

- (1) Making changes to substantive rules or directives without going through notice-and-comment rulemaking, particularly given the agency's representation that it will make any further changes to the institution process through notice-and-comment rulemaking. *See* 88 Fed. Reg. 24,503 (April 21, 2023). The Announcements violate the notice-and-comment requirements under the APA and are arbitrary and capricious.
- (2) Proposing considerations that lack clarity so that they fail to set “forth the standards for the showing of sufficient grounds to institute review.” 35

U.S.C. § 316(a). For example, many of the new “considerations” set forth in the Director Memo lack a basis in Federal Circuit or PTAB case law such that petitioners cannot anticipate how the Director will apply them. *See* Director Memo, 2-3 (“[s]ettled expectations,” “reliance on expert testimony,” “workload,” and “[c]ompelling economic, public health, or national security interests”).

(3) Lacking a sufficiently reasoned explanation for the changes in the factors relevant to institution, including changes that directly contradict the agency's prior guidance in the June 2022 Procedures—such as the controlling effect of a *Sotera* stipulation and the relevance of compelling merits. The reference to “workload needs of the PTAB” in the Announcements does not explain how the changes will aid that goal.⁴ *See Food & Drug Admin. v. Wages & White Lion Invs., L.L.C.*, 145 S. Ct. 898, 906 (2025) (explaining that when an agency changes position, it must “offer ‘good reasons for the new policy’”); *see also F.C.C. v. Fox Television Stations, Inc.*, 556 U.S. 502 (2009) (agency changing position must show

⁴ The Director Memo does not contain any objective data illustrating how the workload of the PTAB has changed, or, if it has changed, how such change impacts the PTAB's ability to meet its statutory obligations.

“that the new policy is permissible under the statute, that there are good reasons for it, and that the agency believes it to be better, which the conscious change of course adequately indicates”).

- (4) Applying the Announcements retroactively to petitions filed prior to issuance of the new policies (such as in this case), thereby undermining stakeholders' reliance interests and prejudicing petitioners, including the Petitioner in this case, with respect to strategies between district court and USPTO proceedings. This is particularly true where the retroactive application of a new rule was not first subjected to notice-and-comment rulemaking under the Administrative Procedure, despite the agency's stated intent to follow such procedures. *See NetworkIP, LLC v. F.C.C.*, 548 F.3d 116, 122–23 (D.C. Cir. 2008).
- (5) Implementing the new bifurcated process without first collecting input from stakeholders or adequately apprising stakeholders of the logistics. The Director Memo lacks procedural details, and the later-created FAQs webpage that purportedly “controls the interim processes” is “frequently” updated. Ex.1066, 1 (encouraging stakeholders to “check back frequently for updates”). Further, there is no way for the parties to know who is designated to advise the Director and, thus, whether there are any conflicts of interest or other procedural concerns related to the process. *See, e.g.*, IPR2025-00250,

Paper 14 at 1 (caption of Acting Director's decision on request for

discretionary denial listing only the Acting Director).

In the face of this non-exclusive list of deficiencies in the Announcements, Petitioner urges the Board and Director to consider whether to institute based on the standards articulated in the June 2022 Procedures until such time as the Board issues new regulations in accordance with 35 U.S.C. § 316 and the rulemaking procedures of the APA.⁵

⁵ If the Office alters the "Interim Processes" before the decision on IV's request for discretionary denial, Petitioner requests authorization to address such changes.

V. Conclusion

For the above reasons, Petitioner respectfully requests that the Director refrain from exercising her discretion to deny this petition, and instead pass it to a merits panel for consideration.

Respectfully submitted,

Date: May 27, 2025

HAYNES AND BOONE, LLP
2801 N. Harwood Street, Ste 2300
Dallas, Texas 75201
Customer No. 27683

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

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), Petitioner hereby certifies, in accordance with and reliance on the word count provided by the word-processing system used to prepare this Opposition, that the number of words in this paper is 6,966.

Pursuant to 37 C.F.R. § 42.24(d), this word count excludes the table of contents, table of authorities, mandatory notices under § 42.8, certificate of service, certificate of word count, appendix of exhibits, and any claim listing.

Date: May 27, 2025

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

/Scott T. Jarratt/

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

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 May 27, 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 Opposition to Patent Owner's Request for Discretionary Denial; Exhibits Ex.1053-Ex.1063 and Ex.1065-Ex.1068.

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