

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 MOTION TO STRIKE
A PORTION OF PATENT OWNER'S SUR-REPLY**

Petitioner submits this Motion to Strike a Portion of Patent Owner's Sur-Reply ("Sur-Reply," Paper 19) pursuant to the Board's e-mail authorization. *See* Ex.1073. As explained below, the Sur-Reply presents, for the first time, a new "stand-alone" theory not included in prior briefing—i.e., that there is a disclosure "gap" with respect to the claimed "*allocation*." Sur-Reply, Section I. The Trial Practice Guide prohibits this new argument. *See* Trial Practice Guide ("TPG"), §II.K ("Motion to Strike").¹ Allowing Patent Owner to rely upon this new theory during the oral hearing would prejudice Petitioner, who has not had an opportunity to address the theory in the written record and will not have proper counterarguments to present during the hearing. *See* TPG, §II.K. In light of this potential prejudice, Petitioner requests that the Board strike from the record the portions of the Sur-Reply containing the improper new theory (Section I, pages 1-5) and disregard the arguments therein in their entirety. *See* TPG, §II.K.

I. Section I of the Sur-Reply includes improper new argument and should be stricken from the record

The TPG states that a Motion to Strike is appropriate where "a party believes the Board should disregard arguments or late-filed evidence in its entirety." TPG, §II.K. The TPG notes that "where a reply clearly relies on a new theory not included

¹ Citations to the Trial Practice Guide refer to the online version available at <https://www.uspto.gov/patents/ptab/trial-practice-guide>.

in prior briefing, and where addressing this new theory during oral hearing would prejudice the opposing party, striking the portion of the brief containing that theory may be appropriate.” TPG, §II.K. Because Section I of the Sur-Reply meets both of these requirements, the Board should grant the present motion and strike it from the record.

A. Section I of the Sur-Reply relies on a new theory not included in prior briefing

For the first time in the Sur-Reply, PO alleges that there is a “gap” in the Andersson and Zeira grounds with respect to the “allocation of an uplink resource” limitation of independent claims 11 and 17. Sur-Reply, 1-5. Specifically, PO argues the Petition “never identifies a cognizable ‘allocation’ tied to a specific ‘uplink resource.’” *Id.* This missing limitation argument was not made in the PO Response (Paper 15, “POR”). The POR argues only that “Petitioner has not properly established a motivation to combine” the Andersson and Khan references (Ground 1) and the Zeira and Khan references (Ground 4). *See* POR, 30-42 (“these documents [] lead away from the alleged combination”), 49-60 (“these references would, instead, require a complete re-design of Zeira’s system”). The POR does not allege these references lack an “allocation” altogether. Petitioner’s Reply (Paper 18, “Reply”) is similarly silent on this issue.

Further, Section I of the Sur-Reply is not responsive or tied to any relevant portion of the prior briefing. In fact, Patent Owner explicitly refers to this argument

as a “stand-alone matter.” Sur-Reply, 5. Section I of the Sur-Reply cites only one page of the POR (page 44, cited four times), but that page contains only argument regarding the different “*accumulation of TPC commands*” limitation. Sur-Reply, 1-5; POR, 44 (“Accordingly, in Andersson, accumulation is always enabled...”). Section I also cites one page of the Reply (page 8, cited eleven times), but that page only addresses PO’s arguments regarding the reasons to combine Andersson and Khan. Sur-Reply, 1-5; Reply, 8. Thus, Section I of the Sur-Reply “clearly relies on a new theory not included in prior briefing.” TPG, §II.K.

B. Addressing PO’s new theory during oral hearing would prejudice Petitioner

PO’s new theory does not have merit. However, because the “allocation” theory in the Sur-Reply is new, Petitioner would be unable to present any counterarguments at oral hearing, as no such arguments are present in the record. Accordingly, allowing PO to address its new theory at oral hearing would prejudice Petitioner, and therefore, per the TPG, striking the portion of the Sur-Reply containing the theory (Section I) is appropriate. *See* TPG, §II.K.

II. Conclusion

Thus, because the Sur-Reply “clearly relies on a new theory not included in prior briefing,” and “addressing this new theory during oral hearing would prejudice” Petitioner, the Board should grant the present Motion and strike the portion of the Sur-Reply containing the new theory (Section I, pages 1-5).

Respectfully submitted,

Date: March 13, 2026
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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)

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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 (the "'390 patent")
Ex.1031	U.S. Patent No. 6,351,460 (the "'460 patent")
Ex.1032- Ex.1052	Reserved
Ex.1053	Statistics on District Court Timing (Dec. 31, 2024)

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Ex.1054	WDTX 2024 Statistical Public Report, available at https://www.txwd.uscourts.gov/court-information/district-statistics/
Ex.1055	Amended Order Assigning the Business Of the Court (Judge Moses, Jan. 31, 2025)
Ex.1056	LexMachina docket report
Ex.1057	LexMachina docket report
Ex.1058	"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	Bifurcation Order – Videolabs, Inc. v. Asustek Computer, Inc. 6:22-cv-00720-ADA (WDTX)
Ex.1060	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	"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	"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 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	“Tesla’s California Footprint,” https://www.tesla.com/blog/teslas-california-footprint (retrieved Apr. 25, 2025)
Ex.1066	“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	Notice of <i>Sotera</i> Plus 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	Defendant’s Final Invalidity Contentions, <i>Intellectual Ventures II, LLC v. Tesla, Inc.</i> , 1:24-cv-884-ADA (WDTX) (May 22, 2025)
Ex.1069	Gandal et al., <i>Standards in wireless telephone networks</i> , Telecommunications Policy 27, pp. 325–332 (2003)
Ex.1070	Parameshwar et al., <i>A Comparative Study of CDMA2000 and W-CDMA</i> , 1999 IEEE Emerging Technologies Symposium - Wireless Communications and Systems (1999)
Ex.1071	Deposition Transcript of Dr. Gary R. Lomp, Ph.D., November 24, 2025
Ex.1072	Supplemental Declaration of Michael D. Kotzin, Ph.D.
Ex.1073 (New)	Board email authorizing Motion to Strike (March 9, 2026)

CERTIFICATE OF SERVICE

The undersigned certifies that, in accordance with 37 C.F.R. § 42.6(e),
service was made on Patent Owner as detailed below.

Date of service March 13, 2026

Manner of service Electronic Service by E-mail: BTheiss@vklaw.com;
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Documents served **PETITIONER'S MOTION TO STRIKE A
PORTION OF PATENT OWNER'S
SUR-REPLY; EXHIBIT Ex.1073**

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