

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. IPR2025-00220
U.S. Patent No. 11,206,670

**BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

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PATENT OWNER'S EXHIBIT LIST

Ex. 2001	Petitioner's Answer to Complaint and Counterclaim, dated June 20, 2024, in <i>Intellectual Ventures II LLC v. Tesla, Inc.</i> , C.A. 1:24-cv-00884-ADA (W.D. Tex.)
Ex. 2002	Docket from District Court Litigation, <i>Intellectual Ventures II LLC v. Tesla, Inc.</i> , C.A. 1:24-cv-00884-ADA (W.D. Tex.)
Ex. 2003	Scheduling Order from District Court Litigation, <i>Intellectual Ventures II LLC v. Tesla, Inc.</i> , C.A. 1:24-cv-00884-ADA (W.D. Tex.)
Ex. 2004	Defendant's Second Supplemental Preliminary Invalidity Contentions, dated January 9, 2025, in District Court Litigation, <i>Intellectual Ventures II LLC v. Tesla, Inc.</i> , C.A. 1:24-cv-00884-ADA (W.D. Tex.)
Ex. 2005	File History of U.S. Patent Appl. 14/372,363

I. INTRODUCTION

Pursuant to the Memorandum by the Acting Director dated March 26, 2025, setting forth the “Interim Processes for PTAB Workload Management” (the Memorandum), Patent Owner hereby sets forth the applicable bases for discretionary denial of institution. This filing is being made within one month of the issuance of the Memorandum. As explained more fully below, all of the *Fintiv* factors established in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB March 20, 2020) (“*Fintiv*”), as well as several additional factors set forth in the Memorandum and the *Advanced Bionics* framework established in *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6 at 7-9 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”), favor the discretionary denial of institution in this case.

With respect to the *Fintiv* factors, Petitioner filed a Counterclaim on June 20, 2024 challenging the validity of U.S. Patent No. 11,206,670 (“‘670 Patent,” Ex. 1001) in *Intellectual Ventures II LLC v. Tesla, Inc.*, C.A. 1:24-cv-00884-ADA (W.D. Tex.) (the “Parallel Litigation.”) Ex. 2001, 89-90 and Ex. 2002, 6-7. As discussed in detail below, the Parallel Litigation has already progressed significantly, including completion of Preliminary Infringement and Invalidity Contentions, and the filing of all claim construction briefing. The Court is scheduled to hold the Markman Hearing in a few days (on April 10, 2025). By the anticipated date of the institution

decision in this matter (July 9, 2025), the parties will be well into fact discovery, service of Final Infringement and Invalidity Contentions will be complete, and the Court will in all likelihood have issued its claim construction ruling. Ex. 2003, 2-3. The Trial is scheduled for May 14, 2026, about 2 months before the statutory deadline for issuing a Final Written Decision in this matter on July 9, 2026. Ex. 2003, 4.¹

With respect to other factors identified in the Memorandum, the Petition relies heavily on expert testimony that largely parrots *verbatim* the wording of the Petition. These aspects of the Petition also weigh in favor of a discretionary denial.

Finally, discretionary denial is appropriate under the *Advanced Bionics* framework and the factors established in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first para.) (“*Beckton, Dickinson*”). The Examiner was specifically directed to the pertinence of Wallen, which is the base reference in the current IPR, and which was subjected to detailed analysis in a parent case. The Petition has not come close to demonstrating that the Examiner erred.

¹ The Petition (at 76, note 4) incorrectly asserts that “[t]he district court has not entered an order scheduling a trial date.” As shown on the last page of the Court’s Scheduling Order, a jury trial is scheduled for May 14, 2026. Ex. 2003, 4.

For all of these reasons, and as explained more fully below, the Director should exercise her discretion to deny institution.

II. THE FINTIV FACTORS FAVOR DISCRETIONARY DENIAL

The precedential order in *Fintiv* identifies six factors for the Board to consider in deciding whether to exercise discretion to deny institution based on parallel proceedings involving the same Patent. Application of the present facts to these factors demonstrates that there are strong reasons for exercising discretion to deny institution here.

A. Factor 1 Weighs Against Institution Because A Stay Has Not Been Granted In The Parallel Litigation And There Is No Evidence That A Stay Would Be Granted If This IPR Was Instituted

No stay has even been requested in the Parallel Litigation. Pet., 76. In addition, even if this IPR was instituted (which would not occur until on or around July 9, 2025) it is unlikely that the Court (Judge Albright) would grant a stay. *See, generally, Continental Intermodal Grp. v. Sand Revolution LLC*, No. 7:18-cv-00147 (W.D. Tex. July 22, 2020) (Judge Albright) *Multimedia Content Mgmt. LLC v. Dish Network*, No. 6:18-CV-00207-ADA, 2019 U.S. Dist. LEXIS (W.D. Tex. May 30, 2018) (Judge Albright) (denying stay).

Thus, the first factor weighs against institution.

B. Factor 2 Weighs Against Institution Because The Parallel Litigation Has A Trial Date Scheduled Before The Projected Statutory Deadline For The Board's Final Written Decision

The Trial in the Parallel Litigation is scheduled for May 14, 2026, about 2 months before the statutory deadline for issuing a Final Written Decision in this matter on July 9, 2026. Rather than looking at the actual date the trial is scheduled; the Petition relies on the median time from filing to case disposition in the Western District of Texas. However, on February 28, 2025, the Office *rescinded* former Director Vidal's 2022 memorandum on discretionary denials which had directed that such statistics be considered. The announcement rescinding former Director Vidal's 2022 memorandum went on to state that decisions relying on the 2022 memo will be "neither binding or persuasive on the PTAB." In view of the above, Petitioner's arguments based on the time to trial statistics cannot be considered persuasive and must be rejected.

Given that the actual trial date is before the due date for the Final Written Decision, the second factor favors discretionary denial.

C. Factor 3 Weighs Against Institution Because The Parties Will Have Invested Significant Effort In The Parallel Litigation By The Time The Board's Institution Decision Is Due

Factor 3 relates to investment in the Parallel Litigation by the District Court and the parties. *Fintiv*, Paper 11 at 9. This factor is judged from the date of the institution decision, which is expected to be no later than July 9, 2025. *Id.* By the

time the Board's institution decision is due, the following will have been completed in the Parallel Litigation:

- PO's Preliminary Infringement Contentions (served August 1, 2024);
- Petitioner's Preliminary Invalidity Contentions (served October 24, 2024);
- Parties exchanged claim terms for construction (November 14, 2024);
- Parties exchanged proposed claim constructions (December 5, 2024);
- Parties disclosed extrinsic evidence for claim construction (December 12, 2024);
- Petitioner's Opening Claim Construction Brief (January 9, 2025);
- PO's Responsive Claim Construction Brief (February 10, 2025);
- Petitioner's Reply Claim Construction Brief (March 3, 2025);
- PO's Sur-Reply Claim Construction Brief (March 24, 2025);
- Parties technical tutorials submitted to Court (March 31, 2025);
- Markman Hearing (scheduled for April 10, 2025);
- Fact discovery (opens April 11, 2025); and
- Final Infringement and Invalidity Contentions (due May 22, 2025).

Ex. 2003, 1-2. Clearly, the parties and the Court will have made a substantial investment in the Parallel Litigation by the expected date of the institution decision on July 9, 2025.

The Petition was filed on November 25, 2024. At that time, Petitioner asserted that “[t]he investment in the co-pending litigation has been minimal.” Pet., at 75. Patent Owner disagrees that the investment in the co-pending litigation was minimal as of November 25, 2024. However, even if Petitioner’s assertion about the state of affairs on November 25, 2024 was accurate, it is irrelevant. As explained in *Fintiv*, the investment in the Parallel Litigation by the District Court and the parties is judged from the date of the anticipated institution decision, which is expected to be about July 9, 2025 -- rather than November 25, 2024. *Fintiv*, Paper 11 at 9. There can be no argument that by July 9, 2025, the District Court and the parties will have made a substantial investment in the Parallel Litigation.

Thus, the third factor weighs against institution.

D. Factor 4 weighs against institution because there is substantial overlap between the Parallel Litigation and this IPR

As mentioned above Petitioner filed a Counterclaim in the Parallel Litigation challenging the validity of ‘670 Patent as a whole. Ex. 2001, 89-90. The Counterclaim is not limited to any particular claim(s) of the ‘670 Patent, and therefore covers all claims of the ‘670 Patent -- including the claims challenged in this IPR.

On January 9, 2025, Petitioner filed its Second Supplemental Preliminary Invalidity Contentions in the District Court. As explained below, there is almost

complete overlap between the prior art references advanced by the Petitioner in this IPR and those advanced by the Petitioner in the Parallel Litigation. Set forth below is a summary of the grounds raised in the Petition, and the prior art asserted in each ground:

B. Statutory grounds for challenges

Grounds	Claims	Basis (pre-AIA)
#1	1-18	35 U.S.C. § 103 over Wallen in view of Berggren

Pet., 16. Set forth below is an excerpt from Petitioner’s Second Supplemental Preliminary Invalidity Contentions in the Parallel Litigation showing the prior art relied on by Petitioner for the challenging the ‘670 Patent in the District Court:

K. The ‘670 Patent

1. Prior Art Patents and Patent Publications

Ex. No.	Patent/ Publication	Referenced As	Publication / Priority Date
K1	U.S. Pat. App. Pub. No. 2011/0,269,475	Berggren	January 4, 2010
K2	U.S. Pat. App. Pub. No. 2012/0,327,895	Wallen	June 27, 2011

J. The '670 Patent

NAME	DESCRIPTION:				
	The Master Information Block References	The Frequency and Time Resources References	The Control Information References	The Bandwidth Switching References	The PDSCH References
Berggren			✓	✓	
Wallen	✓	✓	✓	✓	✓
Dahlman	✓		✓		✓
Tripathi	✓	✓			✓
R1-113659		✓			✓

Ex. 2004, 26; 191-194. Thus, both Wallen and Berggren – the references cited in the sole ground in this IPR – are also being asserted in the Parallel Litigation. There are no references unique to the IPR.

At the time the Petition was filed on November 25, 2024, Petitioner argued that “[t]he extent of overlap is ... speculative at this point in time.” Pet., 77. However, on January 9, 2025, Petitioner filed its Second Supplemental Preliminary Invalidity Contentions in the Parallel Litigation setting forth in detail Petitioner’s invalidity contentions for the ‘670 Patent in the Parallel Litigation, which rely on essentially the same references asserted in this IPR. At this point in time, the high degree of overlap between the proceedings is far from being “speculative.”

Because there is a significant overlap between this IPR and the Parallel Litigation, there are particularly strong “concerns of inefficiency and the possibility of conflicting decisions” if this IPR is instituted. *Fintiv*, Paper 11 at 12.

Thus, the fourth factor weighs against institution.

E. Factor 5 weighs against institution because the patent owner is the same and the Petitioner are the same parties as in the Parallel Litigation

Patent Owner and Petitioner are the same parties as in the Parallel Litigation.

Thus, the fifth factor weighs against institution.

F. Factor 6 weighs against institution because the merits of Petitioner's challenge is weak

The challenges set forth in the Petition are flawed. For example, the Petition extensively relies on an expert declaration that largely parrots *verbatim* the wording of the Petition. Ex. 1003. For example, the following paragraphs of the expert declaration essentially parrot the Petition word-for-word, with little additional information: Ex. 1003, ¶¶ 29-46, 50-143, 145.² The differences between the wording of these paragraphs from the declaration and that of the Petition are insubstantial. For example, in cases where the Petition provides a point citation to a given reference, the declaration includes a quotation from the reference corresponding to the point citation. For these reasons, the declaration is entitled to little if any weight. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15-17 (PTAB August 24, 2022) (designated precedential) (according “little weight” to

² The portions of the expert declaration that do not parrot the Petition include information such as the expert's background, the materials he considered, and boilerplate describing application legal standards. (Ex. 1003, ¶¶ 1-2 and 47-498.)

declaration testimony that contains a verbatim restatement of a petition’s conclusory assertions without additional supporting evidence or reasoning). The Petition’s extensive reliance on expert testimony that is mostly a verbatim restatement of the Petition is a further factor that favors discretionary denial. *See also, Facebook v. Windy City Innovations, LLC*, 973 F.3d 1321, 1340-41 (Fed. Cir. 2020) (affirming the Board’s holding that claim was not unpatentable when “the Board considered Facebook’s expert’s testimony but determined that it did not add materially to Petitioner’s unpersuasive attorney argument,” “because it merely repeated Petitioner’s argument, nearly verbatim, without citation to the basis for his testimony.”)

Thus, the sixth factor weighs against institution.

In summary, all of the *Fintiv* factors weigh against institution. Under §314(a) and, based on the totality of the *Fintiv* factors, institution should be denied.

III. DISCRETIONARY DENIAL IS ALSO APPROPRIATE UNDER THE *ADVANCED BIONICS* AND *BECTON, DICKINSON* FRAMEWORKS

Section 325(d) provides that the Director may elect not to institute a proceeding if the challenge to the Patent is based on matters previously presented to the Office. 35 U.S.C. § 325(d) states, in pertinent part,

In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or

substantially the same *prior art* or arguments *previously were presented to the Office*. (emphasis added).

A. The Advanced Bionics Framework

Under 35 U.S.C. § 325(d), the Director has discretion to deny institution because the same or substantially the same prior art or arguments were previously presented to the Office. *Advanced Bionics*, 7-9. In *Advanced Bionics*, the Board applied a two-part framework in considering whether to exercise discretion to deny institution under § 325(d): “(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics*, 8.

Within the two-part framework of *Advanced Bionics*, the Board considers a number of non-exclusive factors in evaluating whether to exercise its discretion under § 325(d). See *Becton, Dickinson*; see also *Advanced Bionics* at 9–11.

B. The Becton Dickinson Factors

The precedential section of *Becton, Dickinson* sets forth the following non-exclusive factors (“BD Factors”) for consideration:

- (a) The similarities and material differences between the asserted art and

the prior art involved during examination;

(b) The cumulative nature of the asserted art and the prior art evaluated during examination;

(c) The extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection

(d) The extent of overlap between the arguments made during examination and the manner in which petitioner relies on the prior art;

(e) Whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and

(f) The extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson, 17-18.

BD Factors (a), (b) and (d) can be applied broadly to determine whether “substantially the same art” or the “same or substantially the same arguments previously were presented to the Office” under Part 1 of the two-part Advanced Bionics framework (“Advanced Bionics Part 1”). *Advanced Bionics*, 18-20.

If it is determined that Advanced Bionics Part 1 is met, Becton Dickinson Factors (c), (e), and (f) can be applied broadly to determine whether “petitioner has demonstrated that the Office erred in a manner material to the patentability of

challenged claims” under Part 2 of the two-part Advanced Bionics framework (“Advanced Bionics Part 2”) is met. *Id.*

Here, each factor weighs in favor of denying institution. “At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” [Id., 9].

As a result, the Board should exercise its discretion under 35 U.S.C. § 325(d) to deny institution of *inter partes* review of the challenged claims of the ‘670 Patent.

The prior art references and arguments relied upon in the Petition are substantially identical to, or cumulative with, those already considered and rejected by the USPTO during prosecution. Under the *Advanced Bionics* framework and the *Becton Dickinson* factors, the Petitioner has failed to establish any material error in the Office’s prior evaluation of Wallen, or the cumulative nature of Berggren. The lack of new evidence or compelling reasoning to revisit these prior determinations supports deferring to the USPTO’s original conclusions, ensuring that the integrity and efficiency of the patent examination process are upheld. Accordingly, the Petition does not warrant institution of review.

1. The Similarities Between The Asserted Art And The Prior Art Considered During Examination Favors Discretionary Denial Under Factor (A)

The only prior art references asserted in the Petition, in the sole ground (Ground 1) raised against the Challenged Claims of the ‘670 Patent, are Wallen (Ex.

1005) and Berggren (Ex. 1007). Petitioner concludes that § 325(d) denial is inappropriate, but each of Petitioner's statements regarding the basis for § 325(d) denial is misleading, patently false, or both. See Petition, 73-74.

Wallen

For example, regarding Wallen, petitioner argues that “[a]lthough Wallen is listed on the face of the ‘670 patent, it was not relied upon during prosecution to reject the pending claims.” Petition, 73.

Petitioner correctly states that Wallen is listed on the face of the ‘670 Patent:

US 11,206,670 B2			
Page 2			
Related U.S. Application Data		2012/0213143 A1	8/2012 Zhang et al.
continuation of application No. 14/372,363, filed as		2012/0250564 A1	10/2012 Marque-Pucheu et al.
application No. PCT/GB2013/050126 on Jan. 21,		2012/0263093 A1	10/2012 Roessel et al.
2013, now abandoned.		2012/0289286 A1	11/2012 Miki
		2012/0327894 A1*	12/2012 Axmon H04W 48/16
			370/330
(51) Int. Cl.		2012/0327895 A1	12/2012 Wallén et al.
<i>H04L 5/00</i>	(2006.01)	2013/0064119 A1	3/2013 Montojo et al.
<i>H04W 72/12</i>	(2009.01)	2013/0083749 A1*	4/2013 Xu H04W 74/004
			370/329
(52) U.S. Cl.		2013/0088986 A1	4/2013 Xiao et al.
CPC <i>H04L 5/0092</i> (2013.01); <i>H04W 4/70</i>		2013/0114555 A1	5/2013 Sato
(2018.02); <i>H04W 72/1263</i> (2013.01)		2013/0242821 A1	9/2013 Wei et al.
		2014/0036851 A1	2/2014 Seo et al.
		2014/0094183 A1	4/2014 Gao et al.
(56) References Cited		2014/0307697 A1	10/2014 Beale
U.S. PATENT DOCUMENTS		OTHER PUBLICATIONS	

However, Petitioner misleadingly states that Wallen was not relied upon during prosecution to reject the pending claims. See Petition, 73. This is not the standard for discretionary denial under § 325(d). Under § 325(d) “...the Director may take into account whether, and reject the petition or request because, the same or

substantially the same prior art or arguments previously were presented to the Office. (emphasis added) which is incontrovertibly true in this case.

Further to Wallen being listed on the face of the '670 Patent, there is unambiguous evidence that the Examiner was not only aware of, but expressly considered Wallen during prosecution.

For example, Patent Owner expressly cited Wallen in an IDS filed May 28, 2021. See Ex.1002, 28-36, 76-84.

Petitioner acknowledges that "Wallen was submitted in an Information Disclosure Statement (IDS) along with over 50 other references, see Ex.1002, 76-84", but argues that "...there is no Examiner signature on the IDS, see id., 82." Petition, 73. This statement by Petitioner is both misleading and false for several reasons.

First, Petitioner's statement that the IDS filed May 28, 2021 was unsigned is entirely false. Petitioner misleadingly cites to an as-filed, unsigned version of the IDS at Ex.1002, 76-84. However, the signed copy of this same IDS, attesting that the Examiner duly considered all of the listed references, appears in Petitioner's own exhibit at Ex.1002, 28-36. Thus, it is clear that Wallen was presented to the Office, and that the Examiner acknowledged having considered this reference by signing the IDS.

Receipt date: 05/28/2021

17/184,127 - GAU: 2415

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number	17184127
	Filing Date	2021-02-24
	First Named Inventor	Young
	Art Unit	2415
	Examiner Name	Sulaiman Nooristany
	Attorney Docket Number	IPW2-USCN213451

24	20120213143	A1	08-23-2012	Zhang et al.
25	20120250564	A1	10-04-2012	Marque-Pucheu et al.
26	20120263093	A1	10-18-2012	Roesel et al.
27	20120289286	A1	11-15-2012	Miki
28	20120327894	A1	12-27-2012	Axmon et al.
29	20120327895	A1	12-27-2012	Wallén et al.
30	20130064119	A1	03-14-2013	Montejo et al.
31	20130088986	A1	04-11-2013	Xiao et al.
32	20130114555	A1	05-09-2013	Sato
33	20130242821	A1	09-19-2013	Wei et al.
34	20140094183	A1	04-03-2014	Gao et al.

EFS Web 2.1.16

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /S.N/

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Receipt date: 05/28/2021

17/184,127 - GAU: 2415

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number	17184127
	Filing Date	2021-02-24
	First Named Inventor	Young
	Art Unit	2415
	Examiner Name	Sulaiman Nooristany
Attorney Docket Number		IPW2-USCN213451

12	J.S. Patent Application No. 17/184,234, Non-Final Rejection, mailed May 17, 2021.
13	J.S. Patent Application No. 17/185,442, Non-Final Rejection, mailed May 3, 2021.
14	J.S. Patent Application No. 17/185,533, Non-Final Rejection, mailed May 3, 2021.

If you wish to add additional non-patent literature document citation information please click the Add button

Add

EXAMINER SIGNATURE

Examiner Signature	/SULAIMAN NOORISTANY/	Date Considered	08/20/2021
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ See Kind Codes of USPTO Patent Documents at www.USPTO.GOV or MPEP 901.04. ² Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). ³ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁴ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁵ Applicant is to place a check mark here if English language translation is attached.

EFS Web 2.1.18

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /S.N/

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TESLA. INC.

Second, Petitioner attempts to minimize the significance of Wallen by implying that Patent Owner buried the Wallen reference among many other references cited in the IDS filed May 28, 2021. See Petition, 73. However, contrary to this insinuation, the evidence clearly shows that the Office had retrieved and considered Wallen several times, and in great detail, well before Wallen was cited by Patent Owner in the IDS filed May 28, 2021.

For example, Wallen appears clearly, and individually, in the EAST search history³ for the '670 patent, which is also a part of Petitioner's own exhibit at Ex.1002, 37-44, at 37 and 41, and 109-116 at 110 and 113:

³ The EAST Search history is a record of patent search queries run by Examiners during patent examination using the Examiners' Automated Search Tool (EAST), and is of record in the file wrapper of the '670 patent.

EAST Search History

EAST Search History (Prior Art)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
S1	1	"16190420"	US-PGPUB; USPAT	OR	OFF	2019/08/13 16:30
S2	134,943	Young.in.	US-PGPUB; USPAT	OR	OFF	2019/08/13 16:31
S3	0	Young.in. and (SSS same PSSS same PBCH same MIB).clm.	US-PGPUB; USPAT	OR	OFF	2019/08/13 16:31
S4	5	Young.in. and (PBCH same MIB).clm.	US-PGPUB; USPAT	OR	OFF	2019/08/13 16:32
S5	0	Young.in. and (PBCH same MIB same restrict\$3).clm.	US-PGPUB; USPAT	OR	OFF	2019/08/13 16:32
S6	0	Young.in. and (MIB same restrict\$3).clm.	US-PGPUB; USPAT	OR	OFF	2019/08/13 16:32
S7	0	Young.in. and (MIB same restrict\$3 near6 bandwidth).clm.	US-PGPUB; USPAT	OR	OFF	2019/08/13 16:32
S8	6	Young.in. and (restrict\$3 near6 bandwidth).clm.	US-PGPUB; USPAT	OR	OFF	2019/08/13 16:32
S9	5	(MIB near6 restrict\$3 near6 bandwidth)	US-PGPUB; USPAT	OR	OFF	2019/08/13 16:45
S10	5	(MIB near10 restrict\$3 near6 bandwidth)	US-PGPUB; USPAT	OR	OFF	2019/08/13 16:46
S11	26	(MIB same restrict\$3 near6 bandwidth)	US-PGPUB; USPAT	OR	OFF	2019/08/13 16:46
S12	2	"20120327895"	US-PGPUB; USPAT	OR	OFF	2019/08/13 16:55
S13	2	"20100015969"	US-PGPUB; USPAT	OR	OFF	2019/08/13 17:16
S14	34	(MIB same restrict\$3 near6 (bandwidth band))	US-PGPUB; USPAT	OR	OFF	2019/08/13 17:35
S15	0	(MIB same restrict\$3 near6 (bandwidth band)) same less	US-PGPUB; USPAT	OR	OFF	2019/08/13 17:36
S16	4,537	H04W72/048.cpc.	US-PGPUB; USPAT	OR	OFF	2019/08/15 17:31
S17	7	H04W72/048.cpc. and (MIB same restricted near3 (bandwidth band))	US-PGPUB; USPAT	OR	OFF	2019/08/15 17:33
S18	0	TELECOMMUNICATIONS SYSTEMS AND METHODS FOR MACHINE TYPE COMMUNICATION	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO;	ADJ	OFF	2019/12/09 20:35

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TESLA, INC.

S12	2	"20120327895"	US-PGPUB; USPAT	OR	OFF	2019/08/13 16:55
S13	2	"20100015969"	US-PGPUB; USPAT	OR	OFF	2019/08/13 17:16
S14	34	(MIB same restrict\$3 near6 (bandwidth band))	US-PGPUB; USPAT	OR	OFF	2019/08/13 17:35
S15	0	(MIB same restrict\$3 near6 (bandwidth band)) same less	US-PGPUB; USPAT	OR	OFF	2019/08/13 17:36
S16	4,537	H04W72/048.cpc.	US-PGPUB; USPAT	OR	OFF	2019/08/15 17:31
S17	7	H04W72/048.cpc. and (MIB same restricted near3 (bandwidth band))	US-PGPUB; USPAT	OR	OFF	2019/08/15 17:33
S18	0	TELECOMMUNICATIONS SYSTEMS AND METHODS FOR MACHINE TYPE COMMUNICATION	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO; DERWENT; IBM_TDB	ADJ	OFF	2019/12/09 20:35
S19	0	SYSTEMS AND METHODS FOR MACHINE TYPE COMMUNICATION	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO; DERWENT; IBM_TDB	ADJ	OFF	2019/12/09 20:35
S20	229	Beale.in. and MACHINE TYPE COMMUNICATION	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO; DERWENT; IBM_TDB	ADJ	OFF	2019/12/09 20:36
S21	50	Beale.in. and (restricted frequency)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO; DERWENT; IBM_TDB	ADJ	OFF	2019/12/09 20:37
S22	11	Beale.in. and (restricted frequency) .clm.	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO; DERWENT; IBM_TDB	ADJ	OFF	2019/12/09 20:37
S23	12	"2013093436"	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO; DERWENT; IBM_TDB	ADJ	OFF	2019/12/09 20:38

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This clearly evidences that not only was the Examiner aware of Wallen, but that Wallen was individually selected for retrieval via the EAST system at least on August 13, 2019.

In fact, before Patent Owner cited Wallen in the IDS filed May 28, 2021, Wallen was first cited by the Office during prosecution of US Pat. App. No. 14/372,363, (“the ‘363 Application”), of which the ‘670 Patent is a continuation, in Office Actions dated August 18, 2017 and June 14, 2018. See Ex. 2005 at 72-86, at 86, and 97-111, at 111.

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Page 2

Related U.S. Application Data			
continuation of application No. 14/372,363, filed as application No. PC1/GB2013/050126 on Jan. 21, 2013, now abandoned.			
(51) Int. Cl.		2012/0213143 A1	8/2012 Zhang et al.
H04L 5/00 (2006.01)		2012/0250564 A1	10/2012 Marque-Pucheu et al.
H04W 72/12 (2009.01)		2012/0263093 A1	10/2012 Roessel et al.
(52) U.S. Cl.		2012/0289286 A1	11/2012 Miki
CPC H04L 5/0092 (2013.01); H04W 4/70 (2018.02); H04W 72/1263 (2013.01)		2012/0327894 A1 *	12/2012 Axmon H04W 48/16 370/330
(56) References Cited		2012/0327895 A1	12/2012 Wallén et al.
		2013/0064119 A1	3/2013 Montojo et al.
		2013/0083749 A1 *	4/2013 Xu H04W 74/004 370/329
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U.S. PATENT DOCUMENTS		OTHER PUBLICATIONS	

Notice of References Cited	Application/Control No. 14/372,363	Applicant(s)/Patent Under Reexamination YOUNG, PHILIP	
	Examiner JONATHAN B. WOOD	Art Unit 2415	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	CPC Classification	US Classification
*	A	US-2010/0029283 A1	02-2010	Iwamura; Mikio	H04J11/0069	455/437
*	B	US-2010/0130218 A1	05-2010	Zhang; Guodong	H04W48/12	455/450
*	C	US-2010/0323633 A1	12-2010	Pani; Diana	H04W24/10	455/67.14
*	D	US-2011/0085457 A1	04-2011	Chen; Wanshi	H04L1/1812	370/252
*	E	US-2011/0194515 A1	08-2011	Nakao; Seigo	H04L5/0053	370/329
*	F	US-2011/0317581 A1	12-2011	Hoshino; Masayuki	H04L1/0026	370/252
*	G	US-2012/0289286 A1	11-2012	Miki; Nobuhiko	H04W48/12	455/552.1
*	H	US-2012/0327895 A1	12-2012	Wallen; Anders	H04W48/12	370/330
*	I	US-8,923,274 B2	12-2014	Wang; Yiping	H04L1/08	370/351
	J	US-				
	K	US-				
	L	US-				
	M	US-				

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*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	CPC Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

U.S. Patent and Trademark Office
PTO-892 (Rev. 01-2001)

Notice of References Cited

Part of Paper No. 20170731

Further, there is clear evidence that not only was Wallen presented to the Office and considered by the Examiner during prosecution, but that Wallen was in fact treated in great depth by the Office in several Office Actions during prosecution of the '363 Application. See Ex. 2005 72-86, at 75-83, and 97-111, at 100-108.

Art Unit: 2415

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 40, 45, 46 and 51** are rejected under pre-AIA 35 U.S.C. 102(e) as being anticipated by **Wallen et al. USPG-Pub 2012/0327895-A1 (hereinafter Wallen).**

Art Unit: 2415

Therefore, the specification and drawings of the instant application fail to provide support for the full scope of the newly recited limitation regarding subordinate bandwidth resource elements being based on the length of the scMIB. Thus, the limitation is construed to be new subject matter, and is rejected under 35 USC 112 Second paragraph.

6. Dependent **claims 41-45 and 47-51** fail to correct the deficiencies of parent **claims 40 and 46**, and are likewise rejected.

Claim Rejections - 35 USC § 103

7. The following is a quotation of pre-AIA 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 40, 45, 46 and 51** are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over **Wallen et al. USPG-Pub 2012/0327895-A1 (hereinafter Wallen)**, in view of Lee et al. USPG-Pub 2010/0015969-A1 (hereinafter Lee).

For example, in the Office Action of August 18, 2017, the Office provided detailed arguments directly regarding aspects of Wallen that were relied upon heavily in the Petition, such as, *inter alia*, the Master Information Block (MIB), System Information Blocks (SIBs), M-PDCCH, and Figure 9 of Wallen. See e.g., See Ex. 2005 97-111, at 100-108. These arguments span nine pages of the Office Action of August 18, 2017. See *id.* Later, the Office again provided similarly detailed arguments in the Office Action of June 14, 2018. See Ex. 2005 72-86, at 75-83.

Still further, in addition to citing Wallen in the IDS filed May 28, 2021, Patent Owner in fact cited these specific Office Actions themselves in the IDS filed May 28, 2021. See Ex.1002, 28-36 at 33. It is noted that regardless of the IDS, while the specific Examiner changed from prosecution of the ‘363 Application to prosecution of the ‘670 Patent, “The Examiner will consider information which has been considered by the Office in a parent application ... when examining ... a continuation application... [and] a listing of the information need not be resubmitted in the continuing application...” MPEP 609.2 II. A. 2. However, by signing the IDS, the Examiner expressly acknowledged both having considered Wallen when examining the Contested Claims, and having also considered these Office Actions and the detailed arguments involving Wallen therein when examining the Contested Claims. See Ex.1002, 28-36 at 33.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number	17184127
	Filing Date	2021-02-24
	First Named Inventor	Young
	Art Unit	2415
	Examiner Name	Sulaiman Nooristany
	Attorney Docket Number	IPW2-USCN213451

1	DAHILMAN ET AL., "Access Procedures (Chapter 14)," 4G LTE/LTE-Advanced for Mobile Broadband, Academic Press in Elsevier, p. 301-321 (March 2011).
2	HUAWEI ET AL., "Considerations on the bandwidth reduction for low cost MTC UE," 3GPP TSG RAN WG1#67, R1-113659, San Francisco, USA (November 14 -18, 2011).
3	NTT DOCOMO, "Issues Regarding LTE Network for Low Cost MTC," 3GPP TSG RAN WG1 Meeting #67, R1-114082, San Francisco, USA (November 14 -18, 2011).
4	U.S. Patent Application No. 14/372,363, Non-Final Rejection, mailed March 11, 2016.
5	U.S. Patent Application No. 14/372,363, Non-Final Rejection, mailed August 18, 2017.
6	U.S. Patent Application No. 14/372,363, Final Rejection, mailed December 16, 2016.
7	U.S. Patent Application No. 14/372,363, Final Rejection, mailed June 14, 2018.
8	U.S. Patent Application No. 16/190,420, Non-Final Rejection, mailed August 20, 2019.
9	U.S. Patent Application No. 16/190,420, Final Rejection, mailed February 3, 2020.
10	U.S. Patent Application No. 16/190,420, Non-Final Rejection, mailed June 17, 2020.
11	U.S. Patent Application No. 16/190,420, Notice of Allowance, mailed October 26, 2020.

EFS Web 2.1.18

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /s.N/

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From the foregoing, it is clear that the Office was entirely aware of Wallen, that the Office engaged in a detailed analysis of Wallen, that Wallen was neither

obscured by Patent Owner nor glossed over by the Office during prosecution of the ‘670 Patent, and that Wallen was explicitly acknowledged as considered by the Office during prosecution of the Contested Claims.

2. The Cumulative Nature Of The Asserted Art And The Prior Art Considered During Examination Favors Discretionary Denial Under Factor (B)

Berggren

In *Becton, Dickinson*, the court found that references were cumulative where the petitioner has articulated no substantive difference between the prior art, and there is no disparity, stating that “[p]etitioner has not articulated any substantive differences between the prior art alone or in combination, nor do we discern any significant disparity based on our review of these references.” *Becton, Dickinson* p. 22.

Petitioner applies Berggren solely for the purpose of arguing that it would be obvious to carry the MIB of Wallen on a physical broadcast channel (PBCH) as, for example, in claim 1 “...receive ... (PBCH) including a master information block (MIB)...”:

Wallen's MIB is broadcast. Ex.1005, [0006] ("[T]he broadcast information" includes "a Master Information Block (MIB)."); Ex.1006, 7. It would have been obvious for Wallen's MIB carrying broadcast information to be transmitted in LTE's physical broadcast channel (PBCH), because the PBCH already transmits MIBs as was standardized in LTE, as discussed in Section X.C.3.b (Reasons to Combine Wallen and Berggren) above. Ex.1003, ¶74. Berggren confirms that the LTE standard specifies that a physical broadcast channel (PBCH) carries the MIB, thereby rendering obvious that Wallen's MIB carrying broadcast information is carried in a physical broadcast channel (PBCH):

In order to give an understanding of the present disclosure it is first described how the number of primary RBs is communicated in the LTE system....**The downlink**

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system bandwidth is included in the so called master information block (MIB) which ... is transmitted ... on the BCH (Broadcast Channel). The BCH is a transport channel which in turn is mapped to the PBCH (Physical BCH)...

Ex.1007, [0073]-[0074]; Ex.1003, ¶74. As explained in the Section X.C.3.b above, a POSITA would have been motivated to transmit Wallen's MIB using Berggren's PBCH, which already carries MIBs.

Petition pp. 41-46.

[0073] In order to give an understanding of the present disclosure it is first described how the number of primary RBs is communicated in the LTE system.

[0074] For establishing a connection to a cell in LTE, a UE first detects and synchronizes to the cell by receiving the synchronization signals, and then acquires the system information needed for operating within a cell. This system information is divided into several parts, depending on its priority, and is transmitted with different type of periodicity. One of the crucial parts of the information is the downlink system bandwidth, i.e., the total number of available RBs of the component carrier. The downlink system bandwidth is included in the so called master information block (MIB) which contains only a small part of the system information and is transmitted with a periodicity of 40 ms on the BCH (Broadcast Channel). The BCH is a transport channel which in turn is mapped to the PBCH (Physical BCH) which is always located in the 6 central RBs of the component carrier. Hence, the UE can receive the PBCH (and thus the MIB) without any prior information of the system bandwidth. The information contained in the MIB makes it possible to receive the channels that occupy the whole component carrier bandwidth, e.g., the control information in the PDCCH (Physical Downlink Control Channel) associated with the PDSCH (Physical Downlink Shared Channel), which contains the scheduled data transmissions.

Ex. 1007, [0073]-0074]. During prosecution of the '670 Patent, Xu was applied essentially for this purpose:

Claim 1-21 is/are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Xu US 20130083749 in view of Axmon US 20120327894

1. A user equipment (UE) comprising:
 - a transceiver (**Xu: fig. 6**); and
 - a processor, operatively coupled to the transceiver (**Xu: fig. 6**); wherein
 - the transceiver and the processor are configured to receive a primary synchronization signal (PSS), a secondary synchronization signal (SSS), and a physical broadcast channel

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(PBCH) including a master information block (MIB), the PSS, SSS and PBCH are in a first bandwidth of a cell having a cell bandwidth, wherein the first bandwidth is a first portion of the cell bandwidth (**XU: fig. 7, [0064-0069]** - **The narrow bandwidth UE(s) monitor a narrow bandwidth control channel assignment for message 2, while the regular UE(s) are able to monitor the PDCCH which spans the whole bandwidth The ePDCCH can be carried within the center six resource blocks, so the UE can acquire PSS/SSS/PBCH and SIB1 scheduling information all from the same center six resource blocks**); and

the transceiver and the processor are configured to acquire the additional system information using the indication of the frequency resources and the time resources (**Xu: fig. 7 [0068-0069]** - **SIB1 is transmitted with a fixed schedule having a periodicity of 80 milliseconds (ms) and repetitions within 80 ms. The first transmission is scheduled in subframe #5 with SFNmod8=0. Repetition is scheduled in subframe #5 for all radio frames where SFNmod2=0. SIB2 is mapped to the system information (SI) message and corresponds to the first entry in the list of system information messages in "schedulingInfoList" in SIB1.**

See e.g., Ex. 1002 pp. 97-98

[0062] In one aspect, Messages 1 and 3 may be transmitted in a center resource block region as illustrated in FIG. 7A. Alternately, in another aspect, the Messages 1 and 3 may be transmitted in a narrow band region other than the center resource blocks, as illustrated in FIG. 7B.

[0063] For Message 1, the initial access may be based on the physical random access channel (PRACH), which spans six resource blocks (RBs). The location in time and frequency of the PRACH is set by higher layers (e.g., set in frequency at the edge of the uplink transmission bandwidth to avoid fragmentation of data transmissions). For narrow bandwidth operation, the location of PRACH opportunities may be identified via the detection of system information blocks (SIBs).

[0064] In one aspect for operating a narrow bandwidth UE in a wider bandwidth system, the eNodeB broadcasts two sets of RACH configurations: one for regular UEs and one for narrow bandwidth UEs (i.e., those UEs operating in a narrow bandwidth mode). The narrow bandwidth UEs monitor a narrow bandwidth control channel assignment for message 2, while the regular UEs are able to monitor the PDCCH which spans the whole bandwidth.

[0065] The different configurations for narrow bandwidth UEs may include different PRACH configuration indices, PRACH root sequences, frequency positions or different radio access radio network temporary identifiers (RA_RNTI) such as NB_RA_RNTI (narrow bandwidth RA_RNTI).

[0066] In particular, when the UE transmits Message 1, at time 810, the eNodeB can then identify the UE as a narrow bandwidth UE or a regular UE, and can configure Message 2 accordingly. The RACH frequency can be restricted in the center six resource blocks, or optionally in other frequency locations. If other frequency location are supported, flexible duplexing separation between the downlink and uplink central frequencies may be implemented to allow the six resource blocks for downlink (PSS/SSS/PBCH/SIB/Paging) and the six resource blocks for uplink transmission (of PRACH) to be at multiple places.

Ex. 1019 [0062]-[0066].

In *Advanced Bionics*, the court found that a reference cited in the petition was cumulative with a reference cited during prosecution where “...Petitioner relies on

[a first reference] in substantially the same manner as the Examiner cited [a second reference] during prosecution, such that [the first reference] discloses substantially the same information as [the second reference] in relevant part. *Advanced Bionics*, p. 15. In the instant case, Petitioner relies upon Berggren to teach that MIB can be carried on PBCH, and the Examiner relied on Xu for essentially the same purpose.

In *Becton, Dickinson*, the court found that references were cumulative where petitioner has articulated no substantive difference between the prior art, and there is no disparity, stating that “[p]etitioner has not articulated any substantive differences between the prior art alone or in combination, nor do we discern any significant disparity based on our review of these references.” *Becton, Dickinson* p. 22. In the instant case, Petitioner has not articulated any differences between the way that Berggren and Xu were applied.

Thus, factors (a) and (b) from *Becton, Dickinson* support discretionary denial.

3. The Extent To Which The Asserted Art Was Evaluated During Examination, Including Whether The Prior Art Was The Basis For Rejection; The Extent Of The Overlap Between The Arguments Made During Examination And The Manner In Which Petitioner Relies On The Prior Art Favor A Discretionary Denial Under Factors (C) And (D)

As set forth above, Wallen was extensively evaluated during prosecution of the ‘363 Application, of which the ‘670 Patent is a continuation, and was also clearly considered by the Examiner during prosecution of the ‘670 Patent.

In this context, it is clear that Wallen not being argued as the basis for rejection during prosecution of the '670 Patent is not evidence that Wallen was not substantively considered – rather, it is evidence that Wallen was indeed substantively considered but was found to be unsuitable by the Examiner (or merely cumulative of the existing Xu reference). Accordingly, given the application of Wallen in the Petition and the evident view of the Examiner that Wallen was unsuitable for establishing a rejection, along with the cumulative and minimal application of Berggren, factors (c) and (d) from *Becton, Dickinson* support discretionary denial.

4. Whether Petitioner Has Pointed Out Sufficiently How The Examiner Erred In Its Evaluation Of The Asserted Prior Art And The Extent To Which Additional Evidence And Facts Presented In The Petition Warrant Reconsideration Of Prior Art Or Arguments Favor A Discretionary Denial Under Factors (E) And (F)

The burden is on the Petitioner to demonstrate that the Office erred in a manner material to the patentability of the challenged claims. See *Advanced Bionics*, Paper 8, at 20-23. The Board in *Advanced Bionics* stressed the significance of the Petitioner's burden in this regard. As the Board stated in *Advanced Bionics*:

If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, *the Director generally will exercise discretion not to institute inter partes review. If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.* At bottom, this framework reflects a commitment to defer to

previous Office evaluations of the evidence of record
unless material error is shown

Advanced Bionics, Paper 6 at 8-9 (emphasis added).

Regarding alleged material error, the petition makes no comment whatsoever regarding the cumulative nature of Berggren, and makes a single, conclusory statement that “[t]o the extent the Examiner considered Wallen with respect to the Challenged Claims, it was material error for the Examiner to have allowed the Challenged Claims for the reasons presented in the Grounds above.” Petition, p. 73.

This statement by Petitioner fails to demonstrate that the Office erred in a manner material to the patentability of challenged claims as required by Advanced Bionics. According to BD factor (e), for example, “Petitioner must demonstrate that the Examiner erred in the evaluation of the prior art, for example, by showing that the Examiner misapprehended or overlooked specific teachings in the relevant prior art such that the error by the Office was material to the patentability of the challenged claims.” *Advanced Bionics*, at 21.

Instead of the identification of specific misapprehensions or specific teachings by the Examiner, Petitioner offers only the conclusory statement that the Examiner erred because he did not reject the claims on the same basis as Petitioner now wishes he had. However, it is fundamental that “conclusory expert testimony and attorney

argument cannot constitute substantial evidence.” *Acoustic Tech., Inc. v. Itron Networked Sols., Inc.*, 949 F.3d 1366, 1375 (Fed. Cir. 2020).

Accordingly, for Ground 1, it is clear that, with respect to *Advanced Bionics*, the Petitioner has failed to demonstrate that the Office erred in a manner material to the patentability of the challenged claims.

In sum, all six Becton, Dickinson factors—(a) through (f)—support discretionary denial of institution under 35 U.S.C. § 325(d).

This is precisely the type of case § 325(d) and Becton, Dickinson are intended to address: a Petition that merely repackages art already vetted by the Office, without identifying error or providing sufficient justification for further consideration. Accordingly, the Board should decline to institute *inter partes* review in the exercise of its discretion under § 325(d).

IV. CONCLUSION

Institution of *inter partes* review should be denied under 35 U.S.C. § 314(a) based on the totality of the circumstances presented in this case. All six *Fintiv* factors weigh against institution, including the advanced stage of the Parallel Litigation, the scheduled trial date occurring months before the projected Final Written Decision, the parties’ substantial investment in the litigation, and the complete overlap of parties, issues, and prior art between the district court and this IPR. These factors

raise serious concerns about duplicative proceedings, inefficiency, and the risk of conflicting outcomes.

In addition, the Petition's excessive and improper reliance on expert testimony also favors a discretionary denial. As explained above, Petitioner is attempting to use its expert to rewrite the prior art to meet the claim limitations. Use of expert testimony for this type of gap-filling is particularly inappropriate where, as here, the expert declaration largely mirrors the Petition's language without offering independent analysis.

Discretionary denial is also warranted under 35 U.S.C. § 325(d) and the Advanced Bionics framework. The Petition relies on Wallen – a reference that was repeatedly and substantively considered by the Examiner over a lengthy prosecution history in the priority chain, and minimal cumulative further art. The Petitioner has not identified any error in the Examiner's evaluation, nor has it presented new evidence or materially different arguments. The Petition is precisely the type of duplicative challenge that § 325(d) was designed to prevent.

Further, every factor of the *Becton Dickinson* framework weighs in favor of discretionary denial under § 325(d). As such, this case exemplifies the circumstances where discretionary denial under § 325(d) is appropriate: a petition based on art and arguments previously and thoroughly evaluated by the Office, with no showing of error. As the *Becton Dickinson* decision makes clear, when the same or substantially

the same art and arguments were already presented, and the Petitioner fails to identify any error in the Office's evaluation, institution should be denied.

In view of the cumulative application of the *Fintiv*, *Advanced Bionics*, and *Becton Dickinson* frameworks—each of which independently supports discretionary denial—the Director should decline to institute *inter partes* review.

Respectfully submitted,

Dated: April 7, 2025

By: /Brandon R. Theiss/
Brandon R. Theiss
Registration No. 70,507

Counsel for Patent Owner
Intellectual Ventures II LLC

CERTIFICATE OF COMPLIANCE WITH WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), I certify that this **BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** complies with the type-volume limits set forth in the Memorandum and 37 C.F.R. § 42.24 because it contains 4,951 words, excluding the parts of the Brief that are exempted by 37 C.F.R. § 42.24(a), according to the word processing system used to prepare this Brief.

Respectfully submitted,

Dated: April 7, 2025

By: /Brandon R. Theiss/
Brandon R. Theiss
Registration No. 70,507

*Counsel for Patent Owner
Intellectual Ventures II LLC*

CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** was served via email (as consented to by counsel) on April 7, 2025 to lead and backup counsel of record for Petitioner as follows:

Scott T. Jarratt
scott.jarratt.ipr@haynesboone.com
HAYNES AND BOONE, LLP
2801 N. Harwood Street, Suite 2300
Dallas, TX 75201

Jonathan R. Bowser
jon.bowser.ipr@haynesboone.com
HAYNES AND BOONE, LLP
2801 N. Harwood Street, Suite 2300
Dallas, TX 75201

Clint Wilkins
clint.wilkins.ipr@haynesboone.com
HAYNES AND BOONE, LLP
2801 N. Harwood Street, Suite 2300
Dallas, TX 75201

Paul Margulies
pmargulies@tesla.com
TESLA, INC.
1 Tesla Road
Austin, Texas 78725

Dated: April 7, 2025

By: /Brandon R. Theiss/
Brandon R. Theiss
Registration No. 70,507
Counsel for Patent Owner
Intellectual Ventures II LLC