

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

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

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I. STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.75, Patent Owner Intellectual Ventures II LLC requests Director Review of Paper 30, the Final Written Decision (“FWD”). The FWD determines claims 1–18 of U.S. Patent No. 11,206,670 unpatentable based on Wallen and Berggren. FWD 30–31. Its result turns on an antecedent ruling that Wallen qualifies as prior art as of its February 2012 nonprovisional filing date because the ’670 patent is not entitled to the January 20, 2012 filing date of GB1201000. Id. at 15–19.

Patent Owner asks the Director to grant review, vacate the unpatentability determination, and remand with instructions to decide Wallen’s prior-art status under the priority theories actually presented with particularity in the Petition, including whether Wallen’s provisional application supports the specific Wallen disclosures on which Petitioner relied, as required by *In re Riggs*, 131 F.4th 1377, 1384–85 (Fed. Cir. 2025).

II. QUESTIONS PRESENTED

(1) Whether § 312(a)(3) and Rules 42.22(a)(2), 42.104(b)(5), and 42.23(b) permit the Board to deny foreign priority based on unspecified “other limitations” when the Petition developed only one alleged written-description deficiency, Patent Owner produced evidence responsive to that deficiency, and the Reply first made the absence of a complete claim mapping independently dispositive.

(2) Whether that error requires vacatur where it allowed the Board to

rely on Wallen’s intervening nonprovisional filing date and avoid the disclosure-specific inquiry required by *In re Riggs*.

III. DIRECTOR REVIEW IS WARRANTED

This request presents an erroneous conclusion of law, an abuse of discretion, and an important issue of law and policy within 37 C.F.R. § 42.75. The FWD announces a categorical rule: a petitioner need not “specifically or substantively challenge” foreign priority to trigger a claim-wide production burden. FWD 17–18. That rule allowed a generalized footnote to displace the Petition’s principal prior-art theory, expand after the Response into an objection to every claim limitation, and decide the proceeding without addressing the priority showing Petitioner actually developed for Wallen.

This is not a request to revisit the institution threshold. It challenges the theory the FWD used after trial as the dispositive basis for cancellation.

The issue extends beyond this case. The FWD’s rule would permit a petitioner to deny priority in a sentence, identify one example, reserve the particulars until Reply, and require the patent owner to anticipate every conceivable written-description objection. That conflicts with § 312(a)(3)’s requirement that the Petition identify the challenge and supporting evidence with particularity, and turns *Dynamic Drinkware*’s production framework into an exception to petition particularity.

Patent Owner preserved the issue by arguing that the Petition “did not

meaningfully develop a full priority challenge,” particularized no deficiency beyond the compound SIB1 limitation, and could not be expanded in Reply into a claim-wide proof requirement. PO Sur-reply 13–21. Section 312(a)(3) and the authorities cited here supply governing law for that preserved objection, not a new factual theory. Director-level remand is appropriate where a final decision rests on a material theory that the affected party lacked a fair opportunity to meet with responsive evidence. *ASSA ABLOY AB v. CPC Patent Technologies Pty Ltd.*, IPR2022-01006, Paper 49 at 5–7 (Director Mar. 15, 2024).

IV. RELEVANT RECORD

The ’670 patent identifies GB1201000, filed January 20, 2012, as its foreign-priority application. Ex. 1001, code (30). Wallen’s nonprovisional application was filed February 16, 2012—after that claimed date—and asserts the benefit of a June 27, 2011 provisional application (“Wallen-Prov”). Ex. 1005, codes (22), (60); Pet. 16–17. The Petition therefore developed the theory that Wallen qualified under pre-AIA § 102(e) as of Wallen-Prov’s June 2011 date. Pet. 17–29.

The Petition’s priority discussion did not present a claim-by-claim challenge. It called January 20, 2012, the earliest “possible” date, asserted that all relied upon art predated it, and “reserve[d] the right” to contest Patent Owner’s showing. Pet. 15. As to Wallen, that assertion depended on Wallen-Prov; the February 2012 nonprovisional postdated January 20. The alternative theory appeared in footnote 3:

Wallen is also prior art . . . as of its non-provisional filing date of February 16, 2012 because the '670 patent is not entitled to claim the benefit of GB 1201000 due to its lack of written description support of the Challenged Claims . . . , such as lack of written description of the limitation wherein the indicated frequency resources and the time resources include control information for use by the UE to acquire a system information block 1. Pet. 17 n.3.

The footnote supplied no GB1201000 analysis, claim mapping, other allegedly missing limitation, or expert opinion. Its only particularized example was the compound SIB1-control limitation. Patent Owner responded with GB1201000's disclosure that, in each radio frame and a central frequency portion, the MIB provides information to access "the first of the System Information Blocks (SIB1)." PO Resp. 57–58 (quoting Ex. 1018, 25). Patent Owner separately challenged support in Wallen-Prov for specific Wallen disclosures. Id. at 43–57; Ex. 2010 ¶¶ 80–91.

The Institution Decision treated Wallen's June 2011 provisional date as undisputed at the preliminary stage and did not adjudicate GB1201000. Inst. 11.

In its Reply, Petitioner expanded its alternative theory. It argued that the "analysis can end" with Wallen's February 2012 date because Patent Owner supposedly had to demonstrate support in GB1201000 for the challenged claims in their entirety, with evidence concerning a skilled artisan's understanding. Pet. Reply 13–16. Patent Owner objected that this was "classic goalpost moving": the Petition particularized only the compound SIB1 limitation, Patent Owner supplied responsive disclosure, and the Reply could not transform the footnote into an

unbounded challenge to every limitation. PO Sur-reply 13–21.

The FWD adopted the Reply’s new, expanded theory. It held that *Dynamic Drinkware* did not require a specific or substantive priority challenge and faulted Patent Owner because, “aside from addressing a system information block 1,” Patent Owner had not addressed “any other limitations.” FWD 17–18. It therefore denied the January 20, 2012 date and declared Wallen prior art based on its later nonprovisional filing. *Id.* at 18–19. On that basis, the Board expressly declined to decide whether Wallen-Prov supports Wallen. *Id.* at 19.

V. THE FWD APPLIED AN ERRONEOUS BURDEN-SHIFTING RULE AND ADOPTED A REPLY-EXPANDED PRIORITY THEORY

A. *Dynamic Drinkware* does not displace the Petition’s particularity obligations

Section 312(a)(3) requires an IPR petition to identify, “with particularity,” the claims, grounds, and supporting evidence. Rules 42.22(a)(2) and 42.104(b)(5) likewise require an explanation of relevance and the supporting portions. The petitioner must present a clear argument; the Board need not decode a vague petition. *Netflix, Inc. v. DivX, LLC*, 84 F.4th 1371, 1377–78 (Fed. Cir. 2023); *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016). Those requirements reflect that “the petitioner’s contentions” define the proceeding. *SAS Institute Inc. v. Iancu*, 584 U.S. 357, 366 (2018).

Prior-art status is indispensable to the asserted ground. Here, Petitioner’s

obviousness case depended on Wallen. Petitioner thus retained the ultimate burden to prove Wallen was prior art and the claims were unpatentable by a preponderance. 35 U.S.C. § 316(e); *Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). The Board may not relieve Petitioner of that burden by supplying reasoning Petitioner could have developed. *In re Magnum Oil Tools International, Ltd.*, 829 F.3d 1364, 1380–81 (Fed. Cir. 2016).

Dynamic Drinkware recognizes a temporary production burden when a patent owner invokes an earlier date, but not one untethered from the presented challenge or exempt from § 312(a)(3). 800 F.3d at 1379–80. *Technology Licensing* explains the sequence: the invalidity proponent produces prior art; the patentee responds for the earlier date; and the burden returns to the proponent, which retains the ultimate burden. 545 F.3d 1316, 1327–28 (Fed. Cir. 2008).

Patent Owner does not dispute that it bore a temporary burden of production. Nor does it contend that Petitioner was required to prove the absence of written-description support before that burden arose. *Purdue Pharma L.P. v. Iancu*, 767 F. App'x 918, 923–24 (Fed. Cir. 2019), confirms that a petitioner need not submit rebuttal expert evidence when the patent owner's affirmative priority showing is itself inadequate. But Purdue did not address whether a petitioner may identify one alleged deficiency in the Petition and then prevail on different, unidentified deficiencies made dispositive only in Reply. There, the Board evaluated the specific

disclosure and expert testimony on which the patent owner relied and found that showing inadequate to support the claimed combination. Here, the FWD did not find Patent Owner's cited SIB1 disclosure inadequate and identified no different unsupported limitation; it instead treated the absence of a claim-wide mapping—first made independently dispositive in Reply—as sufficient by itself.

Even accepting that Patent Owner bore this temporary production burden, the FWD's statement that no “specific[] or substantive[]” priority challenge was required went further than *Dynamic Drinkware, Technology Licensing*, or *Purdue Pharma*. FWD 17–18. A production burden cannot fairly be defined without identifying what proposition must be produced against. Nor can a generalized denial of priority immunize the prior-art theory from the particularity rules. The FWD's categorical rule converts a responsive burden into an obligation to prepare an affirmative, limitation-by-limitation priority case against objections never stated.

B. The Petition did not particularize a claim-wide attack on GB1201000

Petitioner will emphasize that footnote 3 used the phrase “Challenged Claims” and introduced SIB1 with “such as.” But a legal conclusion followed by one example is not a particularized claim-wide showing. The Petition did not identify which “other limitations” were absent, where GB1201000 allegedly failed, or what a skilled artisan would understand. Compare Pet. 17 n.3, with FWD 18. It offered no evidence directed to those unidentified deficiencies. A “reservation” to contest

priority later likewise could not enlarge the Petition. Pet. 15.

This is not a demand for ideal phrasing. It distinguishes a developed issue from notice that an unidentified issue may later be developed. *Netflix* allows a natural reading of the Petition but requires no decoding for arguments beyond those clearly made. 84 F.4th at 1377. Here, neither the Petition nor its evidence identified the supposed “other limitations.”

Parus Holdings does not support the FWD’s result. There, a patent owner attempting to antedate a reference submitted voluminous evidence without explaining where the relevant proof could be found. 70 F.4th 1365, 1373–74 (Fed. Cir. 2023). The court held that a production burden requires specific citations and explanation—not a demand that the Board search the record. *Id.* Patent Owner did precisely that as to the only deficiency actually particularized here: it identified the Petition’s one specified deficiency, quoted the exact responsive passage, and cited the specific page in GB1201000. PO Resp. 57–58; Ex. 1018, 25. Patent Owner did not ask the Board to search for support. The FWD instead demanded proof addressing objections Petitioner had never identified.

C. Patent Owner produced evidence responsive to the only particularized deficiency

Footnote 3 specifically alleged that GB1201000 lacked the compound limitation concerning indicated time-and-frequency resources containing control information used to acquire SIB1. Pet. 17 n.3. The Response reproduced

GB1201000's statement that, in each radio frame and the central frequency portion, its MIB provides sufficient information to gain access to SIB1. PO Resp. 57–58; Ex. 1018, 25. That was record evidence directed to the identified limitation. It was not a bare citation or incorporation by reference.

Petitioner contended in Reply that the passage did not map every component of that compound limitation. Pet. Reply 15. The FWD did not decide that dispute. It did not find the quoted disclosure absent or inadequate as to the compound limitation. And it did not identify any particular “other limitation” that GB1201000 lacked. Instead, it denied priority because, “aside from addressing a system information block 1,” Patent Owner had not addressed every other limitation. FWD 18. Whether Patent Owner's cited passage fully satisfied its responsive burden as to the identified limitation was a question for the Board to adjudicate, not bypass in favor of unnamed deficiencies.

Dynamic Drinkware does not require a patent owner to invent additional objections for the Petitioner and then disprove them. Once Patent Owner placed evidence and argument responsive to the particularized deficiency before the Board, the Board had to resolve that dispute and hold Petitioner to its ultimate burden. 800 F.3d at 1378–80; *Technology Licensing*, 545 F.3d at 1327–28. The question is not whether Patent Owner may bear a responsive production burden; it may. The question is whether Petitioner may define that burden through an unsupported

conclusion, identify one alleged deficiency, and prevail because Patent Owner did not anticipate different deficiencies never identified.

The rule creates an asymmetry: Petitioner was excused from identifying any limitation beyond SIB1, yet Patent Owner lost for not addressing every limitation beyond SIB1. The FWD should have decided the priority dispute actually particularized, not hypothetical defects never identified.

D. The Reply made the unparticularized claim-wide theory dispositive, and the FWD adopted it

The Reply did not merely argue that GB1201000's SIB1 passage was inadequate. It argued instead that Patent Owner had failed to prove the challenged claims in their entirety and that no further prior-art inquiry was necessary. Pet. Reply 13–16. That changed the question from whether GB1201000 supports the only identified limitation to whether Patent Owner had affirmatively mapped every limitation against all possible unspecified challenges.

A Reply may respond to a Patent Owner Response, but it may not supply a materially different theory needed to establish the ground. 37 C.F.R. § 42.23(b); *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1330–31 (Fed. Cir. 2019); *Yita LLC v. MacNeil IP LLC*, 69 F.4th 1356, 1366–67 (Fed. Cir. 2023); *Wasica Finance GmbH v. Continental Automotive Systems, Inc.*, 853 F.3d 1272, 1286 (Fed. Cir. 2017). *Rembrandt Diagnostics, LP v. Alere, Inc.*, permits responsive elaboration within the original theory; it does not permit a reply to transform a skeletal assertion

into a new theory. 76 F.4th 1376, 1383–84 (Fed. Cir. 2023). The difference is substantive here: the FWD denied priority not because Patent Owner lost the identified compound-limitation dispute, but because Patent Owner did not address unnamed “other limitations.” FWD 18.

Axonics does not authorize the Reply’s claim-wide theory. There, the patent owner first proposed a new claim construction after institution, and the petitioner’s Reply applied the same prior art to that newly proposed construction. *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1378–84 (Fed. Cir. 2023). The court explained that a petition need not anticipate every possible construction a patent owner might later advance. *Id.* at 1381. Here, Patent Owner introduced no new claim construction or new priority theory. It answered the only written-description deficiency the Petition particularized—the compound SIB1 limitation—with disclosure responsive to that deficiency. The Reply did not further develop that dispute. It substituted a different criterion: the absence of a limitation-by-limitation mapping, without identifying any additional deficient limitation. *Axonics* permits a reply to meet a new issue raised by the patent owner; it does not permit the petitioner to create the issue that makes its ground viable.

Axonics also confirms the resulting prejudice. An IPR is a formal adjudication subject to the APA, which requires notice of the matters of fact and law asserted and an opportunity to submit facts, arguments, and rebuttal evidence. 5 U.S.C. §§

554(b)(3), (c), 556(d); *Axonics*, 75 F.4th at 1382–83. Patent Owner could contest Petitioner’s new legal premise in Sur-reply, but Rule 42.23(b) prevented it from supplying the claim mapping or expert evidence the Reply first declared indispensable. Patent Owner therefore never received a fair opportunity to meet the theory the FWD made dispositive. If the Board believed a claim-wide showing was required, it had to identify that requirement while Patent Owner could still supply responsive evidence; it could not adopt the Reply’s new criterion and then treat the resulting absence of evidence as a failure of proof.

Patent Owner timely raised the issue in Sur-reply. PO Sur-reply 13–21. That paper explained that the Petition’s claim-wide statement was conclusory, the compound SIB1 limitation was its only particularized example, and Patent Owner supplied evidence responsive to that example. *Id.* at 15–16, 18. The FWD nevertheless adopted the Reply’s claim-wide formulation, allowing Petitioner to obtain a dispositive ruling on a theory unsupported by the Petition’s evidence.

The resulting prejudice is concrete. Although Patent Owner could contest Petitioner’s new legal position in Sur-reply, Rule 42.23(b) prevented Patent Owner from introducing the claim mapping or expert evidence that Petitioner first asserted was indispensable after the evidentiary record had closed. The Board then made the absence of that evidence dispositive without identifying any unsupported “other limitation.” The error therefore cannot be dismissed as a harmless pleading

technicality, particularly because it supplied the sole basis on which the Board avoided the disclosure-specific Wallen-Prov inquiry required by *Riggs*.

VI. THE ERROR WAS OUTCOME-DETERMINATIVE BECAUSE IT ALLOWED THE BOARD TO AVOID *RIGGS*

The relevant chronology shows that the error was outcome-determinative. GB1201000 was filed January 20, 2012. Wallen’s nonprovisional application was filed February 16, 2012. Although the FWD twice refers to “February 12,” the Wallen cover and the parties’ papers establish February 16. Ex. 1005, code (22); Pet. 16; PO Resp. 43. If the ’670 patent receives its entitled to and claimed January 20 date, Wallen’s nonprovisional filing cannot supply the necessary earlier date.

Petitioner therefore had to establish that Wallen was entitled to Wallen-Prov’s June 27, 2011 date. That was the Petition’s developed theory. Pet. 17–29. *Riggs* requires more than support for one claim of the later reference: the provisional must also provide written-description support for the specific portions of the later patent or publication identified and relied upon in the invalidity challenge. 131 F.4th at 1384–85.

Patent Owner developed that dispute. It argued that Petitioner relied on Wallen’s later-added Figure 13, expressly describing a limited-bandwidth communication device such as an MTC device, while the provisional figures cited in Petitioner’s comparison showed only a generic UE. PO Resp. 44–53; Ex. 2010 ¶¶ 80–91. Wallen-Prov does disclose a UE having a processor, memory, transceiver,

and antenna and states that its processor may implement functionality described above. Ex. 1006, 12. The parties nevertheless disputed whether that disclosure conveyed possession of Figure 13's expressly limited-bandwidth/MTC architecture. Ex. 2010 ¶¶ 86–91; Pet. Reply 16–19. They also disputed support for Wallen paragraph 72's MTC-specific SIB path: Patent Owner compared paragraph 72 with Wallen-Prov page 9, while Petitioner invoked context and the provisional's separate statement that MTC-PDCCH points to SIBs intended for the device. PO Resp. 53–57; Pet. Reply 19–21; PO Sur-reply 21–25; Ex. 1006, 9, 11.

Petitioner disputed those points in Reply, confirming they present substantive written-description questions. Pet. Reply 16–21. The Board decided none of them. It stated: “We need not address whether Wallen is entitled to the June 27, 2011, earlier filing date of Wallen-Prov,” solely because it had denied the '670 patent's foreign-priority claim. FWD 19.

That unresolved alternative cannot make the error harmless. Whether Wallen-Prov supports the specific relied-upon disclosures is a fact-intensive inquiry the FWD deliberately bypassed. *Riggs* vacated and remanded where the Board applied an incomplete priority analysis to a reference provisional. 131 F.4th at 1384–86. The same remedy is appropriate here: vacate the unpatentability determination and remand for the Board to decide, on the existing record and under *Riggs*, whether Petitioner proved that Wallen qualifies as prior art for the subject matter actually

relied upon.

VII. CONCLUSION

The Director should grant review, vacate the determination that claims 1–18 are unpatentable, and remand for the Board to decide Wallen’s prior-art status under the theories actually presented in the Petition and the disclosure-specific requirements of *Riggs*.

Respectfully submitted,

Dated: July 23, 2026

/Brandon R. Theiss/
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CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW** was served via email (as consented to by counsel) on **July 23, 2026** to lead and backup counsel of record for Petitioner as follows:

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