

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

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

**AUTHORIZED RESPONSE TO
DIRECTOR REVIEW REQUEST**

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I. INTRODUCTION

Petitioner Tesla, Inc. (“Tesla”) respectfully submits this authorized response opposing Patent Owner Intellectual Ventures II LLC’s (“IV”) Request for Director Review (Paper 33, “Request”) of the Final Written Decision (Paper 30, “FWD”). The Request should be denied because IV identifies no error in the Board’s decision finding claims 1-18 (the “Challenged Claims”) of U.S. Patent No. 11,206,670 (“the ’670 patent”) unpatentable.

IV acknowledges that the *Dynamic Drinkware* burden-shifting framework applies to its attempt to show the ’670 patent is entitled to the filing date of its foreign priority application. Its Request therefore raises nothing more than dissatisfaction with the Board’s correct application of that framework. Indeed, the Board properly determined that, once Tesla presented Wallen as prior art, the burden of production shifted to IV to demonstrate that the ’670 patent is entitled to the filing date of its foreign priority application. IV failed to do that by showing written description support in the foreign priority application for only a single claim limitation rather than the full scope of the Challenged Claims. IV’s strategic failure does not constitute Board error.

Regardless, even if IV had established the ’670 patent’s entitlement to its foreign priority date, Tesla independently established that Wallen is prior art as of its provisional filing date, which *pre-dates* the ’670 patent’s earliest possible

priority date. Thus, even if the Director remanded, the outcome would not change.

The Request should be denied.

II. THE RELEVANT RECORD

The '670 patent issued from an application filed February 24, 2021.

Ex.1001, code (22). The '670 patent claims priority to a chain of continuation

applications, the earliest of which was filed January 21, 2013. Ex.1001, code (63).

The '670 also claims priority to GB 1201000 (Ex.1018), filed on January 20, 2012.

Ex.1001, code (30); Ex.1002, 179. Thus, the '670 patent's earliest possible priority date is January 20, 2012.

U.S. Patent Pub. No. 2012/0327895 ("Wallen," Ex.1005) was filed on

February 16, 2012, and claims the benefit of Provisional Application No.

61/501,547, filed June 27, 2011 ("Wallen-Prov," Ex.1006). The Petition asserted

that Wallen is prior art as of its non-provisional filing date 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 under pre-AIA 35 U.S.C. § 112, first

paragraph, 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." Petition, 17 n.3.

The Petition further established that Wallen is also prior art as of the filing

date of Wallen-Prov (June 27, 2011). Petition, 17. The Petition demonstrated that

Wallen's claim 1 was supported by Wallen-Prov's disclosures, providing a claim chart mapping each limitation of Wallen's claim 1 to Wallen-Prov. Petition, 18-29. Additionally, when mapping the limitations of the Challenged Claims, the Petition provided parallel citations to Wallen and Wallen-Prov. Petition, 29 ("[I]n this Petition, Petitioner provides dual citations to Wallen and Wallen-Prov."); *see also* Petition, 38-73 (citing Ex.1006).

In an attempt to antedate Wallen's *non-provisional* filing date (February 16, 2012), IV tried to show entitlement to the benefit of the filing date of GB 1201000 (January 20, 2012). POR, 57-58; Sur-reply 13-21. In doing so, IV addressed only one element of the limitation in claim 1 specifically identified in the Petition: a system information block. POR, 57-58. IV also argued that Wallen was not entitled to Wallen-Prov's priority date (June 27, 2011). POR, 43-57; Sur-reply, 21-25.

Tesla's Reply explained that IV failed to meet its burden of demonstrating the '670 patent's entitlement to the filing date of the foreign priority application. Reply, 13-16. The Reply separately reiterated that Wallen-Prov provides written description support for the cited excerpts of Wallen. Reply, 16-21.

III. THE REQUEST SHOULD BE DENIED BECAUSE IV FAILS TO DEMONSTRATE REVIEWABLE ERROR

Requests for Director Review of a final written decision are limited to: (a) an abuse of discretion; (b) important issues of law or policy; (c) erroneous findings of material fact; and (d) erroneous conclusions of law. Director Review Process, 2.B

available at <https://www.uspto.gov/patents/ptab/decisions/director-review-process>.

The Request does not credibly raise any such abuse, issue, or error. Accordingly, the Request should be denied.

IV's Request merely re-argues positions that the Board considered and rejected. IV contends that the Board applied an "erroneous burden-shifting rule" and adopted a "reply-expanded priority theory." Request, 5-13. But the Board applied the settled framework of *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378-81 (Fed. Cir. 2015)—a framework IV does not dispute governs this proceeding. IV's real complaint is not that the Board applied the wrong legal standard, but that it correctly found IV's evidence insufficient under that standard.

A party's disagreement with the Board's weighing of the evidence and evaluation of the sufficiency of a patent owner's priority showing does not constitute an "erroneous conclusion of law" or an "abuse of discretion" warranting Director Review. The Board's finding that IV failed to carry its burden of production is well within the Board's adjudicatory expertise, and IV identifies no basis to disturb that determination.

IV. THE BOARD CORRECTLY DETERMINED THAT IV FAILED TO SHOW THE '670 PATENT IS ENTITLED TO ITS FOREIGN PRIORITY DATE

IV's central argument is that the Board applied an "erroneous burden-

shifting rule” that excused Tesla from identifying particular deficiencies in

GB 1201000 while requiring IV to provide claim-wide written description support.

Request, 5-13. This argument mischaracterizes both the governing law and the Board’s reasoning.

A. To antedate the Wallen prior art reference, IV bore the burden of proving that the claims of the ’670 patent were entitled to the foreign priority date.

As IV acknowledges, under *Dynamic Drinkware*, the burden of production shifts between the parties. 800 F.3d at 1378-81; *Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365 (Fed. Cir. 2023) (applying *Dynamic Drinkware* framework to IPRs). A petitioner has the initial burden of providing evidence of invalidating prior art. *Id.* at 1379. The burden then shifts to the patent owner to “produc[e] additional evidence and present[] persuasive argument” that a reference does not render the patent claims unpatentable or that the patented claims are “entitled to the benefit of a filing date prior to the alleged prior art.” *Id.* at 1379-80 (quoting *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1327 (Fed. Cir. 2008)). The burden then returns to the petitioner to show that the challenged patent is not entitled to the benefit of an earlier filing date or that the prior art reference is entitled to an earlier filing date. *Id.* at 1379-80. IV does not dispute this burden shifting framework. Request, 5-7. IV merely disputes what is required of patent owner when the burden shifts from petitioner to patent owner, as it did here.

The patent owner's burden of production requires demonstrating that an earlier-filed application provides § 112 written description support for the **entire** claimed invention. *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306-07 (Fed. Cir. 2008) (“[A] patent application is entitled to the benefit of the filing date of an earlier filed application only if the disclosure of the earlier application provides support for **the claims** of the later application” (emphasis added)); *Nat. Alternatives Int’l, Inc. v. Iancu*, 904 F.3d 1375, 1383 (Fed. Cir. 2018) (“An applicant can obtain an earlier effective filing date for claims in a CIP application only if **those claims** find support in an earlier-filed nonprovisional application”); *In re Katz Interactive Call Processing Pat. Litig.*, 639 F.3d 1303, 1322 (Fed. Cir. 2011) (To establish priority over a prior art reference, “the parent application need[s] to disclose the invention of **those claims**”) (all emphasis added).

That principle applies equally when a patent owner seeks the benefit of a foreign priority date. Indeed, “**claims** set forth in a United States application are entitled to the benefit of a foreign priority date if the corresponding foreign application supports **the claims** in the manner required” by the written description requirement of § 112, first paragraph. *Uniloc USA, Inc. v. Sega of Am., Inc.*, 711 F. App’x 986, 989 (Fed. Cir. 2017) (emphasis added) (quoting *In re Gosteli*, 872 F.2d 1008, 1010 (Fed. Cir. 1989)).

To show § 112 written description support for the **entire** claimed invention,

one must show that they are “‘in possession’ of *the invention* by describing *the invention*, ***with all its claimed limitations.***” *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (italic emphasis original; bold and italic emphasis added) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991); *see also Uniloc*, 711 F. App’x at 989-90 (discussing same)).

This is black-letter patent law. A patent owner seeking the benefit of an earlier filing date must demonstrate that the earlier application supports the *full scope* of what is claimed—not merely one isolated limitation. The Board’s decision rests squarely on this established principle.

B. The Board applied the correct burden-shifting framework and determined that IV failed to meet its burden.

The Board applied the correct burden-shifting framework. FWD, 15-19. The Board determined that “Petitioner meets its initial burden of going forward with evidence (i.e., production) by asserting that the earliest filing date on the face of the ‘670 Patent is January 21, 2013, presenting Wallen as a prior art basis for unpatentability, and asserting that Wallen is prior art as of its February 16, 2012, filing date.” FWD, 16. The Board correctly recognized that “the shifting burden of production framework of *Dynamic Drinkware* does not require Petitioner to specifically or substantively challenge Patent Owner’s claim for the benefit of an earlier filing date.” FWD, 17-18.

The Board then explained that “the burden of production shifts to Patent

Owner to argue or produce evidence that . . . Wallen is not prior art because the challenged claims of '670 Patent are entitled to the benefit of a filing date prior to Wallen's February 16, 2012, filing date." FWD, 16; *see also id.* 18. The Board determined that IV failed to meet its burden because "aside from addressing a system information block 1, Patent Owner's arguments do not substantively address how GB 1201000 provides written description support for any other limitations of the claimed invention." FWD, 18 (citing POR, 43, 57). Although claim 1 of the '670 patent recites numerous additional limitations—including a UE comprising a transceiver and a processor, reception of primary synchronization signal, secondary synchronization signal, and physical broadcast channel on a first bandwidth less than a cell bandwidth, among others—IV failed to address these limitations. Ex.1001, claim 1; POR, 57-58; Sur-Reply, 15-16.

The Board thus determined that "the '670 Patent is not entitled to the benefit of the January 20, 2012, filing date of foreign priority application GB1201000" and the burden of production did not shift back to Tesla. FWD, 18-19.

Although IV criticizes the Board for applying a "categorical rule" that petitioners need not specifically challenge foreign priority, Request, 2, 7, the Board's analysis reflects a straightforward application of *Dynamic Drinkware's* burden-shifting requirements and the standards for establishing priority to an earlier filing date. Moreover, IV ignores the governing precedent. As explained in

§ IV.A above, the shifting burden of production requires a patent owner to provide evidence demonstrating written description support for the *entire* claimed invention in the earlier-filed application. *See, e.g., PowerOasis*, 522 F.3d at 1306; *Lockwood*, 107 F.3d at 1572; *Uniloc*, 711 F. App'x at 989-90. Tesla was not required to identify specific limitations lacking written description support in the '670 patent's foreign priority application, as IV argues. Request, 5-13.

IV's reliance on *Parus* actually supports the Board's decision. Request, 8. *Parus* explains that "when a patent owner attempts to antedate an asserted prior art reference, the patent owner assumes a temporary burden of production." 70 F.4th at 1371 (citing *Dynamic Drinkware*, 800 F.3d at 1378-79). The patent owner "bears the burden of establishing that *its claimed invention* is entitled to an earlier priority date than an asserted prior art reference." *Id.* (emphasis added) (quoting *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1376 (Fed. Cir. 2016)). A patent owner does not meet the burden of production "without explanation or identification of the relevant portions" of cited evidence. *Id.* *Parus* thus confirms the Board's determination that IV bore burden of establishing that its entire claimed invention was entitled to an earlier priority date by citing the relevant portions of GB 1201000, and that IV failed to do so. FWD, 18-19.

C. IV's cited authority does not alter the *Dynamic Drinkware* framework

IV cites to § 312(a)(3), Rules 42.22(a)(2) and 42.104(b)(5), and several

cases, but none of this authority requires a petitioner to initially identify all

limitations that are not entitled to an earlier priority date.

Section 312(a)(3) requires a petition to identify “with particularity” “each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” Rule 42.22(a)(2) requires a petition to include “a detailed explanation of the significance of the evidence including material facts, and the governing law, rules, and precedent.” And Rule 42.104(b)(5) requires a petition to identify “[t]he exhibit number of the supporting evidence relied upon to support the challenge and the relevance of the evidence to the challenge raised, including identifying specific portions of the evidence that support the challenge.” None of these provisions impose a specificity requirement for identifying deficiencies in a challenged patent’s priority chain or otherwise alter the *Dynamic Drinkware* burden-shifting framework. The Petition satisfied these requirements by identifying that claims 1-18 of the ’670 patent are unpatentable over Wallen based on Wallen’s non-provisional and provisional filing date, with specific supporting citations to Wallen and Wallen-Prov. Petition, 16-30, 38-73.

IV’s reliance on *Netflix, Inc. v. DivX, LLC*, 84 F.4th 1371 (Fed. Cir. 2023), *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359 (Fed. Cir. 2016), and *SAS Institute Inc. v. Iancu*, 584 U.S. 357 (2018) is inapposite. Request,

5. *Netflix* and *Intelligent Bio-Systems* address a petitioner's obligation to explain its grounds of unpatentability with clarity. *Netflix*, 84 F.4th 1371, 1377-78; *Intelligent Bio-Systems*, 821 F.3d at 1369-70. And *SAS Institute* governs the scope of claims that must be addressed in an IPR. 584 U.S. at 366-70. None of these cases address the specificity required to satisfy a petitioner's initial burden under the *Dynamic Drinkware* framework. Nor do they need to—*Dynamic Drinkware* itself holds that the petitioner's initial burden is satisfied simply by “going forward with evidence” of invalidating prior art. 800 F.3d at 1379 (“Dynamic also had the initial burden of production, and it satisfied that burden by arguing that Raymond anticipated the asserted claims of the '196 patent”).

D. The Reply properly established that IV's foreign priority showing was deficient.

To the extent the burden of production shifted back to Tesla, the Reply met that burden by confirming that (i) the '670 patent was not entitled to the benefit of the filing date of GB 1201000 and (ii) that Wallen was entitled to the Wallen-Prov filing date, as originally established in the Petition. Reply, 16-21; *see Dynamic Drinkware*, 800 F.3d at 1379-80; *see also* § V below.

Contrary to IV's arguments, the Reply did not raise an impermissible new claim-wide theory for priority. Request, 10-14. Under *Dynamic Drinkware*, IV *always* bore the burden of establishing priority for each of the Challenged Claims after the Petition established that Wallen was prior art as of its non-provisional

filing date. *See* § IV.A above. The Reply simply identified the deficiency in IV's showing: that IV failed to meet its burden by addressing only a single claim limitation, rather than the entire claimed invention. Reply, 15.

IV's reliance on *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), and *Wasica Finance GmbH v. Continental Automotive Systems, Inc.*, 853 F.3d 1272, 1286 (Fed. Cir. 2017) is misplaced. Those cases concern situations where a petitioner introduces an entirely new invalidity theory or prior art argument in reply. *Henny Penny*, 938 F.3d at 1330-31 (“[A]n IPR petitioner may not raise in reply ‘***an entirely new rationale***’ for why a claim would have ***been obvious***.” (emphasis added)); *Yita*, 69 F.4th at 1366-67 (addressing the Board's discretion to “consider ***a new theory of unpatentability*** raised for the first time in reply” (emphasis added)); *Wasica*, 853 F.3d at 1286 (explaining that a petitioner reply argument raised “***an entirely new theory of prima facie obviousness*** absent from the petition”) (bold and italic emphasis added)). Here, Telsa's theory remained the same throughout: Wallen is prior art because the '670 patent is not entitled to GB 1201000's priority date. The Reply merely explained that IV's response was insufficient to carry its burden.

Rembrandt Diagnostics, LP v. Alere, Inc. confirms the Reply argument was permissible. 76 F.4th 1376 (Fed. Cir. 2023). *Rembrandt* explains that “a reply may

be proper if it is responsive and simply expands on previously raised arguments.”

Id. at 1384. Here, the Petition established that Wallen is prior art as of its non-provisional filing date because GB 1201000 lacked written description support for “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.*” Petition, 17 n.3. The Petition also “reserve[d] the right,” consistent with the *Dynamic Drinkware* framework, “to contest” any assertion by IV that the ’670 patent was entitled to the filing date of GB 1201000. Petition, 15. The Reply expanded on this initial position by explaining that IV failed to meet its burden for entitlement to the foreign priority date because it addressed only a single limitation rather than the entire claimed invention. Reply, 15.

IV’s reliance on *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374 (Fed. Cir. 2023) is even further afield. *Axonics* addresses the permissible scope of reply argument when the patent owner offers, or the Board adopts, a new claim construction after institution—which is irrelevant here. *Id.* at 1380-85. Moreover, IV’s claims as to lack of notice and prejudice are unfounded. Request, 11-12. From the outset, IV was on notice that Tesla challenged the ’670 patent’s foreign priority claim. Petition, 15, 17 n.3. IV had a full and fair opportunity to present its arguments as to entitlement of foreign priority both in the Response and the Sur-

Reply after seeing Tesla's Reply arguments. IV's decision to address only one limitation rather than the claimed invention, as well as dispute its obligation under the burden-shifting framework, was a strategic choice. POR, 57-58; Sur-reply 13-21. IV cannot now claim prejudice from its own decision not to map all claim limitations to GB 1201000, as required under *Dynamic Drinkware*.

Because the Board applied the proper burden of production and correctly determined that IV failed to establish the '670 patent's entitlement to the GB 1201000 filing date, the Request should be denied.

V. WALLEN IS PRIOR ART EVEN IF THE '670 PATENT IS ENTITLED TO ITS FOREIGN PRIORITY DATE

Although the Board stated that it "need not address whether Wallen is entitled to the June 27, 2011, earlier filing date of Wallen-Prov" (FWD, 19), Tesla independently established, in the Petition, that Wallen is entitled to the Wallen-Prov filing date. Thus, even assuming IV satisfied its burden in showing that the Challenged Claims of the '670 patent are entitled to the filing date of its foreign priority application (it did not), Wallen remains prior art.

To show that a prior art reference is entitled to the priority date of a provisional application, a petitioner must show that "the disclosure of the provisional application provides support for the claims in the reference patent in compliance with § 112, ¶ 1." *Dynamic Drinkware*, 800 F.3d at 1381. Further, under *In re Riggs*, 131 F.4th 1377, 1384-85 (Fed. Cir. 2025), the provisional must

provide written description support for the specific portions of the later reference relied upon in the invalidity challenge.

Tesla satisfied both requirements. The Petition provided a detailed claim chart mapping every limitation of Wallen’s claim 1 to specific disclosures in Wallen-Prov. Petition, 18-29. Further, the Petition “provide[d] dual citations to Wallen and Wallen-Prov” and specifically cited to Wallen-Prov (Ex.1006) for each claim limitation. Petition, 29, 38-73. The Reply addressed the limitations IV disputed in Wallen by showing written description support in Wallen-Prov. Reply, 16-21. Based on this showing, Wallen remains prior art to the ’670 patent.

Because Wallen is prior art to the ’670 patent as of the Wallen-Prov filing date, the Request should be denied on this independent ground.

VI. CONCLUSION

For the reasons above, the Request does not establish any abuse of discretion, erroneous findings of material fact, or erroneous conclusions of law. The Board applied the correct burden-shifting framework and correctly determined that IV failed to establish that the ’670 patent is entitled to its earliest priority date. Moreover, a review of the ’670 patent priority ruling would not result in a different outcome because Wallen remains prior art as of Wallen-Prov’s June 27, 2011, filing date—a date that antedates any possible priority date for the ’670 patent. The Request should be denied.

Respectfully submitted,

Date: July 30, 2026

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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 July 30, 2026

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