

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. IPR2025-00339

U.S. Patent No. 7,916,180

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

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I. INTRODUCTION

Patent Owner Intellectual Ventures II LLC respectfully requests Director Review of the Final Written Decision, as corrected (the “Decision”). The Board denied the ’180 patent the benefit of its August 25, 2004 provisional filing date based on an alleged written-description deficiency that Tesla never identified in its priority papers and that the Decision made dispositive without prior notice permitting Patent Owner to develop responsive evidence and briefing.

Tesla’s Petition asserted two enumerated omissions from Provisional Application No. 60/604,854 (the “Provisional”): different-field-of-view (“FOV”) channels and multiple optics components configured with multiple sensors. Pet. 4. Tesla added that the Provisional did not disclose those features, “much less” combining data captured through channels with different FOVs. *Id.* at 5; Ex. 1003 ¶¶ 62–66. Patent Owner answered those contentions with pinpoint citations and focused expert testimony. PO Resp. 60–64; Ex. 2020 ¶¶ 152–155. The Reply and Sur-reply continued to litigate the different-FOV and multiple-sensor issues, without identifying element [22.3] as a priority deficiency. Pet. Reply 28–31; PO Sur-reply 25–27.

The Decision nevertheless denied priority because Patent Owner had not separately mapped “independently controlling simultaneous data acquisition with each of the first and second channels during a frame” (“[22.3]”). Decision 23–24.

Nothing in the Petition, Institution Decision, Reply, or Sur-reply identified lack of provisional support for [22.3] as a priority deficiency. The Institution Decision’s discussion of [22.3] in claim construction and in the obviousness analyses under Grounds 1 and 3 addressed different inquiries; it did not notify Patent Owner that a limitation-specific written-description inquiry would become dispositive. The Board acknowledged that Patent Owner addressed the deficiencies “identified by Petitioner,” but faulted Patent Owner for not anticipating an additional deficiency that had never before been raised. *Id.*

That procedure violated the Administrative Procedure Act (“APA”), materially mischaracterized Patent Owner’s focused priority showing, and improperly used a temporary production burden to excuse a party-unpresented theory. The error controlled Ground 3: Tesla stated that “only Ground 3 depends on this priority analysis,” Pet. 5, and Labaziewicz could qualify as prior art only after the Board denied the provisional date. Decision 36–43. The Director should vacate the Ground 3 determinations for claims 22, 23, 28, and 30 and remand for focused briefing.

II. QUESTION PRESENTED AND GROUNDS FOR REVIEW

Whether the Board may deny priority based on a limitation-specific written-description deficiency that no party presented, after Patent Owner provided focused evidence responding to every deficiency Petitioner identified, without notice or an

opportunity to address the new issue.

The Decision presents an abuse of discretion, erroneous conclusions of law, erroneous findings of material fact, and an important issue of law and policy under 37 C.F.R. § 42.75. No new evidence is offered. Patent Owner relies only on the official record and does not ask the Director to adopt a new merits mapping of [22.3]. It seeks vacatur and remand so the Board's dispositive issue can be decided after adversarial presentation.

III. RELEVANT RECORD

A. Tesla particularized its priority challenge.

The '180 patent claims the benefit of the Provisional's August 25, 2004 filing date. Ex. 1001, code (60); Ex. 1047, 1. Ground 3 relies on Labaziewicz, filed February 18, 2005. Pet. 9. Tesla's priority section enumerated two alleged omissions: "(1) providing multiple channels having different FOVs" and "(2) configuring multiple optics components relative to multiple sensors respectively to form these multiple channels." Pet. 4. Tesla asserted that the Provisional did not disclose those features, "much less combining data captured with the channels with different FOVs." *Id.* at 5. Tesla's declaration identified the same matters. Ex. 1003 ¶¶ 62–66. Neither the Petition nor Tesla's declaration identified [22.3] as a priority deficiency. The Institution Decision addressed [22.3] in claim construction and in its obviousness analyses of Grounds 1 and 3, but did not identify lack of provisional support for that limitation as a priority deficiency. Inst. Dec. 6–12, 17–23, 30–33.

B. Patent Owner answered the identified deficiencies with focused evidence.

Patent Owner devoted a five-page section of its Response to priority. PO Resp. 60–64. It cited the Provisional and expert testimony for multiple arrays paired with multiple lenses; lenses differing in size and shape; lens positioning tied to the specific focal length of the lens tailored for each array; exposure control applied differently to each array; different integration times; and processing that combines the array signals into a composite image. *Id.* (citing Ex. 1047, 4–5, 7–8, 10, 12; Ex. 2020 ¶¶ 152–155). Patent Owner argued that those disclosures answered Tesla’s different-FOV, multiple-sensor, and related combining-data contentions and therefore established that Labaziewicz was not prior art. PO Resp. 62–64; Ex. 2020 ¶¶ 153–155.

That presentation was not a bare citation to an earlier application. In the priority section itself, the Response quoted the Provisional’s disclosures that exposure control may occur differently for each array and that different arrays may have different integration times, and identified the corresponding Provisional passage. PO Resp. 61, 63 (citing Ex. 1047, 10). Patent Owner also supported its priority analysis with the declaration of its expert, Dr. Eli Saber. Ex. 2020 ¶¶ 152–155. The Response, relying on Dr. Saber, applied particular disclosures to Tesla’s two alleged omissions and its related combining-data assertion: array/lens pairings and lens-specific focal lengths for different-FOV channels; multiple arrays/lenses

and per-array exposure control for multiple sensors and channels; and focal-length and signal-combination disclosures for combining data captured with different-FOV channels. PO Resp. 62–64; Ex. 2020 ¶¶ 153–155. Neither the Response nor Dr. Saber separately mapped [22.3], an alleged priority deficiency Tesla had not identified. The parties thus developed a concrete evidentiary record on the priority contentions Tesla presented; the Decision made a different, previously unrepresented deficiency dispositive.

Tesla’s Reply confirmed the priority dispute’s boundaries. Its two priority subheadings addressed different-FOV channels and multiple sensors. Pet. Reply 29–31. Its next subsection discussed [22.3] only as part of Ground 3’s obviousness ground on the merits, not related to priority. *Id.* at 31. The Sur-reply followed the same division. PO Sur-reply 25–27.

C. The Decision made a different, party-unpresented deficiency dispositive.

The Decision accurately summarized Tesla’s priority challenge and Patent Owner’s responses concerning multiple sensors, different FOVs, and combining channel data. Decision 21–23. It nevertheless held that, “aside from addressing deficiencies of written description support identified by Petitioner,” Patent Owner had not shown support “for all of the limitations.” *Id.* at 23–24. The Decision then made [22.3] the dispositive omission and held that Patent Owner’s production burden never shifted back to Tesla, without previously identifying provisional

support for that limitation as an issue requiring separate treatment. *Id.* The Board consequently treated Labaziewicz as prior art and held claims 22, 23, 28, and 30 unpatentable under Ground 3. *Id.* at 36–43.

IV. ARGUMENT

A. The Board denied priority on a party-unpresented factual theory without notice or an opportunity to respond.

The APA requires timely notice of “the matters of fact and law asserted” and an opportunity to present evidence and argument. 5 U.S.C. §§ 554(b)(3), 554(c), 556(d). The Board therefore “must base its decision on arguments that were advanced by a party, and to which the opposing party was given a chance to respond.” *In re Magnum Oil Tools International, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016); see *Dell Inc. v. Acceleron, LLC*, 818 F.3d 1293, 1301–02 (Fed. Cir. 2016).

The Decision crossed that line. Tesla identified two numbered omissions and a related combining-data assertion. Patent Owner answered those contentions with record citations and expert analysis. The Reply and Sur-reply continued the different-FOV and multiple-sensor disputes without introducing [22.3] as a priority issue. Yet the Board denied priority solely because Patent Owner had not separately shown support for [22.3]—an alleged omission rebutting a theory that Tesla never presented. That was not a refinement of Tesla’s identified factual contentions; it was a different written-description deficiency that became outcome-determinative. The

Decision itself confirms the pivot: Patent Owner answered the deficiencies “identified by Petitioner,” but lost because it did not disprove an additional deficiency that had not been placed in dispute. Decision 23–24.

The petition’s statutory role reinforces the notice problem. A petition must identify with particularity the challenged claims, grounds, and supporting evidence. 35 U.S.C. § 312(a)(3). Patent Owner does not invoke that provision to exclude priority analysis from the proceeding; priority was a necessary predicate to Ground 3 and was properly disputed. But the particularity requirement explains why the trial proceeds on the factual contentions actually identified. A temporary production burden cannot authorize the Board to construct a different *prima facie* priority case after the parties have completed briefing. See *Magnum Oil*, 829 F.3d at 1375–81; *VLSI Technology LLC v. Intel Corp.*, 53 F.4th 646, 653–54 (Fed. Cir. 2022).

EmeraChem Holdings, LLC v. Volkswagen Group of America, Inc. is directly analogous. There, a petition’s broad language and use of a reference elsewhere did not notify the patent owner that the Board would use the reference for a different limitation. 859 F.3d 1341, 1348–52 (Fed. Cir. 2017). When a petition targets contentions with precision, it directs the patent owner to those particular bases; discussion of the ultimately relied-on material for a different claim or purpose does not cure the notice defect. *Id.* at 1349–52. Likewise, reliance on other portions of the same reference does not notify a patent owner of a distinct factual assertion that

becomes critical. *In re NuVasive, Inc.*, 841 F.3d 966, 970–75 (Fed. Cir. 2016); see *Oren Technologies, LLC v. Proppant Express Investments LLC*, 5 F.4th 1350, 1362–64 (Fed. Cir. 2021) (nonprecedential) (a theory advanced for one limitation did not provide notice that the Board would use it for another).

Those decisions reject the premise that scattered discussion of the same evidence or claim language supplies notice for every possible use. *EmeraChem* required no word-for-word parity between a petition and the Board’s analysis, but held that notice turns on the specificity with which the petition framed its contentions. 859 F.3d at 1351–52. *Oren* likewise found notice inadequate where a theory appeared in the record for one purpose and the Board repurposed it to satisfy another limitation. 5 F.4th at 1362–64. Here, the record’s careful separation between priority and the merits makes the notice defect stronger, not weaker.

So too here. Claim construction asks what the issued claim means; obviousness asks what the asserted references teach; written description asks whether the Provisional reasonably conveyed possession to a skilled artisan in August 2004. See *Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). Litigation of [22.3] in the first two contexts did not notify Patent Owner that provisional support for [22.3] would become a separate and dispositive priority deficiency. If the panel believed that limitation required focused treatment in the priority analysis, it could have identified the concern and ordered

targeted briefing. See 37 C.F.R. §§ 42.5(a), 42.20(d). It did not do so.

The Board's description of [22.3] as the "heart" of the claim-construction dispute underscores, rather than cures, the prejudice. Decision 24. That description shows the panel appreciated the limitation's importance, but importance in one disputed inquiry is not notice that the same words will be used to resolve a different factual inquiry. It instead reinforces why targeted notice and briefing were warranted before the Board made provisional support for [22.3] dispositive.

Patent Owner does not dispute the Board's authority to decide priority as a predicate to Ground 3. See *Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365, 1373–74 (Fed. Cir. 2023). The error was deciding that predicate on a case-specific factual deficiency no party advanced and Patent Owner had no meaningful opportunity to answer through evidence and briefing. *Parus* itself reiterates that the Board must decide based on party-advanced arguments to which the opponent could respond. *Id.* at 1372. Here, the Board's procedure was arbitrary, capricious, an abuse of discretion, and not in accordance with law within the meaning of 5 U.S.C. § 706(2)(A), and the Director should vacate and remand under 37 C.F.R. § 42.75.

Vacatur and remand are the ordinary remedy because the defect is the lost opportunity to respond, not merely the wording of the Decision. *NuVasive*, 841 F.3d at 975; *EmeraChem*, 859 F.3d at 1352. Allowing Patent Owner to brief [22.3] after vacatur would not reward waiver or reopen an issue it chose to omit. It would provide

a first opportunity to address the factual theory the Board actually used.

B. Neither the record nor Patent Owner's production burden supports resolving the unpresented issue against Patent Owner.

The existing record confirms why notice matters: Patent Owner successfully defeated the only priority arguments that Petitioner actually made. Patent Owner's priority section quoted the Provisional's statements that exposure control may occur for each array "differently" and that different integration times may be used for each array. PO Resp. 61, 63 (quoting Ex. 1047, 10); Ex. 2020 ¶¶ 152, 154. Those per-array acquisition-control disclosures bear on the independent-control component of [22.3] and are cited here only to show materiality and prejudice, not as a completed mapping. Separately, Patent Owner discussed circuitry that processes array signals and combines them into a composite image. PO Resp. 61, 63–64; Ex. 2020 ¶¶ 152, 155. That latter disclosure answered Tesla's related combining-data assertion and corresponds to adjacent limitation [22.4]; Patent Owner does not rely on it as support for [22.3].

Patent Owner cites this existing record only to establish materiality and prejudice, not to offer a new limitation mapping or ask the Director to decide written description in the first instance. It does not contend that its Response separately mapped [22.3]. That omission underscores, rather than cures, the notice defect: Tesla identified different alleged deficiencies, and Patent Owner responded to them. Without adversarial briefing, the Decision treated the absence of a separate mapping

as dispositive rather than evaluating whether the quoted per-array disclosures bear on [22.3]. Whether the Provisional ultimately supports [22.3] should be decided after both parties have an opportunity to address that question.

This case is unlike *Parus*'s separate antedating dispute, where the patent owner submitted approximately forty exhibits totaling 1,300 pages, plus claim charts exceeding 100 pages, but cited only small portions of that material without meaningful explanation. 70 F.4th at 1368–70. Here, the Response itself quoted the disclosures, supplied pinpoint citations, cited focused expert testimony, and connected the evidence to each priority contention Tesla presented. PO Resp. 60–64; Ex. 2020 ¶¶ 152–155. The Board was not asked to search declarations or hundreds of pages for an unstated argument. No record archaeology was required.

The notice posture also differs. As to written description in *Parus*, the challengers asserted that the common specification failed to support the challenged claims, and the dispute specifically concerned the limitation requiring a computing device to periodically search for and add new websites. 70 F.4th at 1369, 1373–74. *Parus* responded that the disputed limitation was supported, so the Federal Circuit reviewed the sufficiency of a showing made on a factual question the parties had litigated. *Id.* Here, Tesla identified different alleged omissions, and the parties litigated those omissions. The Board did not resolve whether Patent Owner's showing answered Tesla's framed FOV and sensor contentions; it instead treated the

absence of a separate [22.3] mapping as dispositive.

The burden framework does not excuse the notice defect. Tesla retained the ultimate burden of proving unpatentability. 35 U.S.C. § 316(e); *Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375, 1378–80 (Fed. Cir. 2015); *Magnum Oil*, 829 F.3d at 1375–76. Patent Owner recognizes that an intervening reference may impose a temporary production burden to identify the earlier application and explain why it supports the claimed subject matter, including all limitations.

But the all-limitations rule does not itself give notice of a new, case-specific factual contention after Tesla itemized different alleged omissions and the parties tried those disputes. The substantive support requirement and APA notice operate together: the Board may evaluate the showing the parties litigated, but it may not make a party-unpresented missing limitation dispositive in the final decision without prior notice and an opportunity to respond. Nor is this merely application of settled law to an issue and evidence squarely litigated. Cf. *Merck Serono S.A. v. Hopewell Pharma Ventures, Inc.*, 159 F.4th 10, 22–27 (Fed. Cir. 2025). The surprise was the Board’s new factual theory that [22.3], specifically, lacked support.

Tech. Licensing Corp. v. Videotek, Inc., 545 F.3d 1316, 1327–29 (Fed. Cir. 2008) and *Dynamic Drinkware* define what a patent owner must produce and preserve the challenger’s ultimate burden; neither addresses an adjudicator’s authority to introduce an unlitigated factual deficiency in the final decision. And

Merck Serono rejected a notice challenge where the Board applied a longstanding legal rule to the very issue and evidence the parties disputed. 159 F.4th at 22–27. Patent Owner accepts the longstanding legal rule. It challenges the absence of notice that the Board would find this particular limitation unsupported on a record developed only around different asserted defects.

At minimum, once the panel concluded that [22.3] required separate treatment, it should have provided notice and allowed a focused response. The Director need not—and Patent Owner does not ask the Director to—decide whether the existing record conclusively establishes provisional support for [22.3]. Vacatur and remand would allow both parties to address that specific question and permit the Board to apply the production-burden framework on a properly noticed record. The Board can determine whether Patent Owner’s showing, together with authorized supplemental submissions, satisfies its temporary production burden while preserving Tesla’s ultimate burden of persuasion. That remedy leaves the technical merits with the panel and restores the proper adversarial process.

C. The error was prejudicial, outcome-determinative, and important to IPR administration.

Labaziewicz was filed after the Provisional. Pet. 9; Ex. 1010, code (22). Tesla stated that only Ground 3 depends on priority. Pet. 5. The Board used Labaziewicz against claims 22, 23, 28, and 30 only after denying the provisional date. Decision 36–43. Had [22.3] been identified as disputed, Patent Owner could have developed

a targeted mapping, supporting expert analysis, and responsive legal argument addressing that limitation, including the significance a skilled artisan would have attributed to the per-array integration-time and exposure-control disclosures already quoted in Patent Owner's priority section. PO Resp. 61, 63; Ex. 2020 ¶¶ 152, 154. The reliance on the absence of such a mapping demonstrates the prejudice: notice would have changed the evidence and argument Patent Owner presented. That lost opportunity cannot be deemed harmless by predicting the result on a record the parties were never permitted to develop.

The issue is recurring and important. Priority disputes often determine whether an intervening reference is available. Director guidance is warranted on how the all-limitations production requirement coexists with a petitioner's particularized factual attack and the APA's notice requirement. Permitting a final written decision to identify a new dispositive deficiency risks forcing patent owners to brief a full provisional-to-claim mapping even when the petition identifies only discrete alleged gaps, while allowing petitioners to prevail on rationales they never advanced. Focused adversarial presentation is fairer and more efficient.

The requested rule would preserve, not restrict, the Board's ability to decide priority correctly. A panel remains free to decide the factual contentions the parties have presented. If the panel identifies an overlooked, potentially dispositive question before issuing its decision, it may notify the parties and order targeted supplemental

briefing under 37 C.F.R. §§ 42.5(a) and 42.20(d), including any appropriately authorized evidentiary submissions. Here, once the panel concluded that provisional support for [22.3] might independently defeat priority, a short order identifying that precise question could have created a focused record without disturbing the statutory schedule. What the APA forecloses is making a party-unpresented factual deficiency dispositive in the final written decision without previously providing notice and a meaningful opportunity to develop responsive evidence and briefing. Review would therefore provide practical guidance for future priority disputes while leaving the technical written-description merits to the panel after both parties have been heard.

V. CONCLUSION

For these reasons, the Director should grant review, vacate the challenged portions of the Decision, and remand for focused briefing and reconsideration on a properly noticed record.

Dated: August 17, 2026

Respectfully submitted,

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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 **August 17, 2026** to lead and backup counsel of record for Petitioner as follows:

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