

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

IPR2025-00339
U.S. Patent No. 7,916,180

**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 29, “Request”). Tesla interprets the Request to challenge the Corrected Final Written Decision (Paper 31, “FWD”). The Request should be denied because IV identifies no error in the Board’s decision finding claims 22, 23, 28, and 30 of U.S. Patent No. 7,916,180 (“the ’180 patent”) unpatentable.

IV does not dispute that the burden-shifting framework described in *Dynamic Drinkware* governs its effort to antedate the Labaziewicz prior art reference. Nor does IV dispute that, once Tesla established Labaziewicz as prior art in the Petition, the burden of production shifted to IV to prove that the ’180 patent is entitled to an earlier effective filing date. IV’s complaint instead concerns the consequence of IV’s failure to make that required showing. It is black-letter law that IV must show written-description support in the provisional application for all limitations of the claims at issue. The Board correctly applied the governing framework and correctly found that IV failed to carry its burden because it addressed only select limitations. IV’s failure is not Board error.

Unable to identify any legal or factual error in the Board’s priority analysis, IV reframes its challenge as one of notice and opportunity to respond. But IV had adequate notice and opportunity to establish entitlement to the provisional filing

date, and failed to do so. The notice-and-opportunity-to-respond requirement does not relieve IV of its burden under *Dynamic Drinkware* or require the Board (or Tesla) to identify deficiencies in IV's priority showing before enforcing that burden. The Board thus properly concluded that the challenged claims are unpatentable, and the Request should be denied.

II. THE RELEVANT RECORD

The '180 patent issued from an application filed April 19, 2007. Ex. 1001, code (22). The '180 patent claims priority to several provisional applications, including Application No. 60/695,946 ("the '946 provisional," Ex.1048), filed on July 1, 2005, and Application No. 60/604,854 ("the '854 provisional," Ex.1047), filed on Aug. 25, 2004. Ex. 1001, code (60).

The Petition asserted that "[t]he effective filing date" of claims 22, 23, 28, and 30 of the '180 patent "is no earlier than July 1, 2005, the filing date of Provisional Application 60/695,946." Petition, 4. The Petition explained that "[f]or a claim in a later-filed application to be entitled to the filing date of an earlier application, the earlier application must provide written description support for the claimed subject matter." Petition, 4 (citing *Anascape, Ltd. v. Nintendo of Am. Inc.*, 601 F.3d 1333, 1337 (Fed. Cir. 2010)). The Petition identified three limitations without support in the earlier '854 provisional application: (1) providing multiple channels having different FOVs; (2) configuring multiple optics components

relative to multiple sensors respectively to form these multiple channels; and

(3) combining data captured with channels with different FOVs. Petition, 4-5. As such, “the effective filing date” for the relevant claims “is no earlier than July 1, 2005, the filing date of the ’946 provisional.” Petition, 5. The Petition clarified that this priority analysis only applies to Ground 3. Petition, 5; *see also id.* 70-93.

Relevant to this Request, Ground 3 relied on U.S. Patent No. 7,206,136 (“Labaziewicz,” Ex. 1010). Petition, 9-10, 70-93. Labaziewicz was filed on February 18, 2005, and published August 24, 2006. Ex.1010, codes (22), (65). The Petition asserted that Labaziewicz is “prior art under §102(e),” as Labaziewicz’s filing date (February 18, 2005) predates the ’180 patent’s earliest effective filing date (July 1, 2005). Petition, 9.

IV’s Preliminary Patent Owner Response (Paper 8) did not address the priority issue. As a result, the Institution Decision (Paper 13) also did not address the priority issue. In the Patent Owner Response (“POR,” Paper 16), however, IV attempted to antedate Labaziewicz and show entitlement to the earlier ’854 provisional filing date. POR, 60-64. In doing so, IV addressed *only* the above limitations (1)-(3) identified in the Petition. POR, 60-64. IV’s Sur-reply (Paper 20) similarly focused on the same three limitations. Sur-reply, 25-27.

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.

The Board correctly 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. FWD, 21-24. And although IV frames its challenge as one of notice and opportunity to respond, those procedural principles do not relieve IV of its burden of production under *Dynamic Drinkware*. Accordingly, IV identifies no abuse, issue, or error warranting Director Review. The Request should be denied.

IV. THE BOARD CORRECTLY DETERMINED THAT IV FAILED TO SHOW THE '180 PATENT IS ENTITLED TO ITS PROVISIONAL PRIORITY DATE

IV principally argues that it lacked notice and an opportunity to address limitations not specifically identified by Tesla or the Board as lacking provisional priority. But the governing law itself defines IV's obligation for establishing provisional priority. The Board's correct application of that governing law did not deprive IV of notice and opportunity to respond.

A. To antedate the Labaziewicz prior art reference, IV bore the burden of proving that the '180 patent claims were entitled to the provisional priority date—regardless of any notice requirement.

As IV acknowledges, under *Dynamic Drinkware*, the burden of production shifts between the parties. 800 F.3d at 1378-81; *see also Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365, 1371 (Fed. Cir. 2023) (both applying burden-shifting framework to IPRs); Request, 12-13. A petitioner has the initial burden of providing evidence that an asserted reference qualifies as 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, 12. IV merely disputes what is required of a 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”); *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 emphases added). This requires a patent owner to show “not only the existence of the earlier application, but why the written description in the earlier application supports the claim.” *Dynamic Drinkware*, 800 F.3d at 1379 (quoting *Tech. Licensing*, 545 F.3d at 1327).

That principle applies equally when the patent owner seeks the benefit of a provisional priority date. Indeed, “the specification of the *provisional* must ‘contain a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms,’ 35 U.S.C. § 112 ¶ 1, to enable an ordinarily skilled artisan to practice the invention *claimed* in the *non-provisional* application.” *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294 (Fed. Cir. 2002) (emphasis original).

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 *New Railhead*, 298 F.3d at 1295 (to meet the written description

requirement, “the disclosure must show he had invented *each feature that is included as a claim limitation*” (emphasis added)); *see also Uniloc*, 711 F. App’x at 989-90 (discussing same); Request, 12 (confirming production burden applies to “all limitations”).

This is black-letter patent law for which no notice is required. 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 individual limitations. 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, 21-24. The Board determined that “Petitioner meets its initial burden of going forward with evidence (i.e., production) by asserting that the earliest filing date of the ’180 Patent is no earlier than July 1, 2005, presenting Labaziewicz as a prior art basis for unpatentability, and asserting that Labaziewicz is prior art as of its February 18, 2005, filing date.” FWD, 21-22.

The Board then explained that “the burden of production shifts to Patent Owner to argue or produce evidence that . . . Labaziewicz is not prior art because the challenged claims of ’180 Patent are entitled to the benefit of a filing date prior to the February 18, 2005, filing date of Labaziewicz.” FWD, 22; *see also id.* 23.

The Board determined that IV failed to meet its burden because “aside from

addressing deficiencies of written description support identified by Petitioner,

Patent Owner does not substantively address how the '854 Provisional Application provides written description support for all of the limitations of the claimed invention.” FWD, 23-24 (citing POR, 60-64; Sur-reply, 25-28). For example, the Board explained that IV “does not address written description support in the '854 Provisional Application for ‘independently controlling simultaneous data acquisition with each of the first and second channels during a frame’—limitation [22.3].” FWD, 24 (citing POR, 60-64; Sur-reply, 25-27). Accordingly, the Board determined that IV had not “met its burden of production in coming forward with evidence or argument to show possession of the claimed invention in the '854 Provisional Application.” FWD, 24.

Because IV failed to meet its burden, the Board correctly determined that “the burden of production [did] not shift back to Petitioner, and, therefore, the '180 Patent is not entitled to the benefit of the August 25, 2004, filing date of the '854 Provisional Application.” FWD, 24.

The Board’s analysis reflects a straightforward application of *Dynamic Drinkware*’s burden-shifting requirements and the standards for establishing provisional priority. 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* § IV.A above; *see also* *PowerOasis*,

522 F.3d at 1306; *Lockwood*, 107 F.3d at 1572; *New Railhead*, 298 F.3d at 1295;

Uniloc, 711 F. App'x at 989-90. This is because “the PTO does not examine priority claims unless necessary,” so “the Board has no basis to presume”

entitlement to a provisional priority date. *Dynamic Drinkware*, 800 F.3d at 1380.

IV's failure to meet its burden is not error requiring review by the Director.

C. IV had sufficient notice that it needed to establish priority for all claim limitations.

IV frames its own failure to meet its burden of production as a procedural error under the Administrative Procedure Act (“APA”). The APA provides for 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). IV received both.

Regarding notice, the Petition put the priority date of the '180 patent claims at issue. Petition, 4-6. The Petition also identified the governing standard: “[f]or a claim in a later-filed application to be entitled to the filing date of an earlier application, the earlier application must provide written description support for the claimed subject matter.” Petition, 4 (citing *Anascape, Ltd. v. Nintendo of Am. Inc.*, 601 F.3d 1333, 1337 (Fed. Cir. 2010)).

Under *Anascape*, “[f]or a parent application to provide the filing date for claims of a continuing application, the description in the parent must meet the requirements of 35 U.S.C. § 112, first paragraph, as to *that claimed subject matter*.” 601 F.3d at 1337 (citing *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158

(Fed. Cir. 1998)); *see also id.* at 1335 (“To obtain the benefit of the filing date of a parent application, the claims of the later-filed application must be supported by the written description in the parent ‘in sufficient detail that one skilled in the art can clearly conclude that the inventor invented ***the claimed invention*** as of the filing date sought.’”) (all emphasis added). Taken together, the Petition and the cited authority put IV on notice that, to establish entitlement to the ’854 provisional filing date, it had to demonstrate written-description support for the entirety of the claimed subject matter, not merely selected claim limitations.

Even if the Petition had not cited the relevant authority, the legal framework outlined in § IV.A itself independently placed IV on notice of its obligation to show written description support for *all* claim limitations. IV cannot reasonably claim a lack of notice based on its own misunderstanding of settled law.

IV also had ample opportunity to make its provisional priority showing. In both its Patent Owner Response and Sur-reply, IV devoted substantial briefing to arguing that Labaziewicz is not prior art to the ’180 patent. POR, 60-64; Sur-reply, 25-27. IV therefore had both notice that priority of the ’180 patent was at issue and a full and fair opportunity to present its evidence and argument on that issue. Its misunderstanding as to the showing required to establish priority to a provisional application as discussed in § IV.A above and its strategic decision to address only the limitations identified in the Petition do not provide a basis for Director Review.

The Board should thus reject IV's attempt to mischaracterize its failure to satisfy black letter law as a notice violation under the APA. A party cannot ignore its burden and then fault the Board for enforcing it.

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

None of IV's cited authority discussing the APA—including *Magnum Oil* and similar cases—excuses IV from its burden to establish provisional priority by showing written-description support for all claim limitations. And two of IV's cited cases confirm that notice and an opportunity to respond does not apply to the burden-shifting requirements for provisional priority.

IV principally relies on *In re Magnum Oil Tools International, Ltd.*, 829 F.3d 1364 (Fed. Cir. 2016), arguing that the Board denied IV's priority claim based on a factual theory that neither side presented without notice and opportunity to respond. Request, 6-7. But *Magnum Oil* distinguishes between a party's burden of production and the procedural requirements of notice and an opportunity to respond. Properly understood, *Magnum Oil*'s discussion of notice and opportunity to respond applies to *obviousness*, not a patent owner's burden to establish entitlement to an earlier priority date.

In *Magnum Oil*, the Federal Circuit recognized that “[i]n an *inter partes* review, the burden of persuasion is on the petitioner to prove ‘unpatentability by a preponderance of the evidence,’ 35 U.S.C. § 316(e), and that burden never shifts to

the patentee.” 829 F.3d at 1375 (emphasis original) (quoting *Dynamic Drinkware*, 800 F.3d at 1378). But “for the purposes of establishing a priority date, the burden of production can shift from the patent challenger to the patentee.” *Id.* The Court reasoned that although “a patent challenger has the burden of producing evidence to support a conclusion of unpatentability under § 102 or § 103,” “a patentee bears the burden of establishing that its claimed invention is entitled to an earlier priority date than an asserted prior art reference.” *Id.* at 1375-76. The Court recognized that “the shifting of the burden of production is warranted because the patentee affirmatively seeks to establish a proposition not relied on by the patent challenger and not a necessary predicate for the unpatentability claim asserted—effectively an affirmative defense.” *Id.* at 1376.

In the context of obviousness, however, burden shifting does not make sense because “the patentee’s position is that the patent challenger failed to meet its burden of proving obviousness.” *Id.* Thus, in addressing whether the Board may adopt obviousness arguments that petitioners could have raised but did not, the Court explained that “the Board must base its decision on arguments that were advanced by a party, and to which the opposing party was given a chance to respond.” *Id.* at 1381. For this reason, the Board does not have the authority to “raise, address, and decide ***unpatentability theories*** never presented by the petitioner and not supported by record evidence.” *Id.* (emphasis added).

Accordingly, *Magnum Oil* does not give IV a free pass to address only the limitations raised in the Petition when IV *itself* had the affirmative burden to show provisional priority for all the limitations in the relevant claims of the '180 patent.

IV's other cited cases similarly apply to notice and an opportunity to respond in the unpatentability context and are thus also inapposite to the priority issue here. *See Dell Inc. v. Acceleron, LLC*, 818 F.3d 1293, 1301 (Fed. Cir. 2016) (addressing whether patent owner had notice and an opportunity to respond to the Board's determination that a prior art feature met the "caddies" claim limitation); *EmeraChem Holdings, LLC v. Volkswagen Grp. of Am., Inc.*, 859 F.3d 1341, 1348-52 (Fed. Cir. 2017) (addressing whether patent owner had notice and an opportunity to respond to "the Board's reliance on Stiles for determining claims 3, 16, and 20 of the [challenged] patent would have been obvious"); *In re NuVasive, Inc.*, 841 F.3d 966, 970-75 (Fed. Cir. 2016) (analyzing whether a patent owner had notice and an opportunity to respond to the Board's determination that a prior art figure taught a claim limitation).¹

¹ IV relies on *Oren Technologies, LLC v. Proppant Express Investments LLC*, 5 F.4th 1350, 1362-64 (Fed. Cir. 2021), but that citation is for a Court of Federal Claims appeal that is unrelated to the issues in this case. If IV intended to cite *Oren Technologies, LLC v. Proppant Express Investments LLC*, No. 2019-1778, 2021

Further, *VLSI Technology LLC v. Intel Corp.*, 53 F.4th 646 (Fed. Cir. 2022) and *Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365, (Fed. Cir. 2023), cited in IV's Request, undermine IV's argument. In *VLSI*, the Federal Circuit acknowledged that "the Board must base its decision on arguments that were advanced by a party and to which the opposing party was given a chance to respond," yet held that "the Board *is not limited to* the claim constructions proffered by the parties, but may adopt its own claim construction of a disputed claim term." 53 F.4th at 653-54 (emphasis added). *VLSI* thus confirms that notice and an opportunity to respond does not apply to every aspect of an IPR.

Parus further confirms that IV failed to meet its burden, regardless of the requirements of the APA. In *Parus*, the Federal Circuit explained that when a patent owner "[chooses] to take on an affirmative burden" to antedate a prior art reference, the patent owner "[bears] the responsibilities that [come] with it." 70 F.4th at 1371. That includes "assum[ing] a temporary of burden of production" of "establishing that [a] claimed invention is entitled to an earlier priority date than the asserted prior art reference." *Id.* (quoting *Magnum Oil*, 829 F.3d at 1376). That burden requires "citing the relevant record evidence with specificity and explaining

WL 3120819, at *3-5 (Fed. Cir. July 23, 2021), that case is also inapposite because it addresses notice and an opportunity to respond in the unpatentability context.

the significance of the produced evidence.” *Id.* at 1372. As in *Parus*, IV’s failure to identify record evidence establishing provisional priority for all limitations of claims 22, 23, 28, and 30 means it did not meet its burden of production to establish an earlier priority date.

IV also cites to 35 U.S.C. § 312(a)(3), but this statute does not limit the Board’s priority determination to only the limitations disputed in the IPR. Section 312(a)(3) simply 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.” Section 312(a)(3) does not alter the burden-shifting framework of *Dynamic Drinkware and Technology Licensing*, or IV’s burden to address all claim limitations under that framework. The Petition satisfied § 312(a)(3) by identifying that claims 22, 23, 28, and 30 of the ’180 patent are unpatentable over Labaziewicz in combination with other references with specific citations to the prior art. Petition, 4-6, 9-10, 70-93.

V. CONCLUSION

For the reasons above, the Request does not establish any abuse, issue, or error. The Board applied the correct burden-shifting framework and correctly determined that IV failed to establish that the ’180 patent is entitled to its provisional priority date. Moreover, IV had sufficient notice and opportunity to respond. The Request should be denied.

Authorized Response to Director Review Request
IPR2025-00339 / U.S. Patent 7,916,180

Respectfully submitted,

Date: August 24, 2026

/Jonathan R. Bowser/

HAYNES AND BOONE, LLP
2801 N. Harwood Street, Ste 2300
Dallas, Texas 75201
Customer No. 27683

Jonathan R. Bowser
Lead Counsel for Petitioner
Registration No. 54,574

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 August 24, 2026

Manner of service Electronic Email: BTheiss@addyhart.com;
rigby@intven.com

Documents served ***Authorized Response to Director Review Request***

Persons served Brandon R. Theiss
AddyHart
10 Glenlake Parkway, Suite 130
Atlanta, GA 30328

Russell J. Rigby
Intellectual Ventures II LLC
14360 SE Eastgate Way
Bellevue, WA 98007

/Jonathan R. Bowser/
Jonathan R. Bowser
Lead Counsel for Petitioner
Registration No. 54,574