

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. IPR2025-00340

U.S. Patent No. 6,894,639

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

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PATENT OWNER'S EXHIBIT LIST

EX2001	Petitioner's Answer to Complaint and Counterclaim, dated June 20, 2024, in <i>Intellectual Ventures II LLC v. Tesla, Inc.</i> , C.A. 1:24-cv-00884-ADA (W.D. Tex.)
EX2002	Docket from District Court Litigation, <i>Intellectual Ventures II LLC v. Tesla, Inc.</i> , C.A. 1:24-cv-00884-ADA (W.D. Tex.)
EX2003	Scheduling Order from District Court Litigation, <i>Intellectual Ventures II LLC v. Tesla, Inc.</i> , C.A. 1:24-cv-00884-ADA (W.D. Tex.)
EX2004	Defendant's Second Supplemental Preliminary Invalidity Contentions, dated January 9, 2025, in District Court Litigation, <i>Intellectual Ventures II LLC v. Tesla, Inc.</i> , C.A. 1:24-cv-00884-ADA (W.D. Tex.)
EX2005	Letter from Patent Owner to Associate General Counsel for Petitioner, dated August 7, 2020, enclosing copy of U.S. Pat. No. 6,894,639 and Claim Chart Presentation

I. INTRODUCTION

Pursuant to the Memorandum by the Acting Director dated March 26, 2025, setting forth the “Interim Processes for PTAB Workload Management” (the Memorandum), Patent Owner hereby sets forth the applicable bases for discretionary denial of the institution. This filing is being made within one month of the Memorandum. As explained more fully below, all of the *Fintiv* factors, as well as several additional factors set forth in the Memorandum, favor the discretionary denial of institution in this case.

With respect to the *Fintiv* factors, Petitioner filed a Counterclaim on June 20, 2024 challenging the validity of U.S. Patent No. 6,894,639 (“‘639 Patent,” EX1001) in *Intellectual Ventures II LLC v. Tesla, Inc.*, C.A. 1:24-cv-00884-ADA (W.D. Tex.) (the “Parallel Litigation.”) EX2001, at 88-89 and EX2002, at 6-7. As discussed in detail below, the application of the *Fintiv* factors to the present facts overwhelmingly supports discretionary denial. The district court litigation is significantly advanced and set for trial on May 14, 2026,¹ well before the Board’s statutory deadline; the parties and the court have already invested substantial resources; the issues in both forums overlap substantially; and the Petition is substantively deficient, raising weak and inconsistent arguments regarding claim construction and unpatentability.

¹ The Petition (at 78, note 7) incorrectly asserts that “[t]he district court has not entered an order scheduling a trial date.” As shown on the last page of the Court’s Scheduling Order, a jury trial is scheduled for May 14, 2026. EX2003, 4.

With respect to other factors identified in the Memorandum, the Petition improperly relies on extensive expert testimony to fill gaps in the prior art—particularly with respect to the claim limitation requiring the use of “data statistics to select target specific feature information” limitation—contrary to the statutory requirements of 35 U.S.C. § 311(b), which restrict IPRs to challenges based solely on patents and printed publications. Additionally, the claims of the ‘639 Patent were in force for 17 years, and the Patent expired almost 3 years ago (May 17, 2022). Despite having been specifically alerted to the ‘639 Patent on August 7, 2020 (and provided with a copy of ‘639 Patent at that time), Petitioner waited more than four years to file this IPR challenging the ‘639 Patent. EX2005, at 1-4, 5-19 (copy of ‘639 Patent enclosed with letter) and 20-24 (claim chart mapping representative product to claim 1 of ‘639 Patent).² These factors also weigh in favor of a discretionary denial.

Finally, as explained more fully below, the application that matured into the ‘639 Patent was subjected to an extraordinary level of scrutiny by the United States Air Force, which imposed and renewed annually a secrecy order over the course of

² The Petition (at 84) asserts that “Petitioner only learned which claims were being asserted in August 2024.” However, for almost 5 years Petitioner has been in possession of a claim chart supplied by Patent Owner mapping claim 1 of the ‘639 Patent to Petitioner’s products. EX2005, at 20-24. Claim 1 is the only independent claim that Petitioner is challenging in this IPR.

more than a decade, from 1992 through 2002. This sustained classification—based on annual determinations that the disclosed technology was critical to national security and subject to export control—strongly supports the conclusion that the invention was both novel and non-obvious. Despite the applicant’s objections, the Air Force repeatedly reaffirmed that public disclosure of the invention would be detrimental to national interests, ultimately lifting the secrecy order only after the eleventh review in 2003. This extensive review history reflects the government’s recognition that the invention was technically significant and not in the public domain. These facts weigh heavily against permitting a hindsight-based validity challenge through inter partes review.

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

II. THE FINTIV FACTORS FAVOR DISCRETIONARY DENIAL

The precedential order in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB March 20, 2020) (“*Fintiv*”) identifies six factors for the Board to consider in deciding whether to exercise discretion to deny institution based on parallel proceedings involving the same Patent. Application of the present facts to these factors demonstrates that there are strong reasons for exercising discretion to deny institution here.

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

No stay has even been requested in the Parallel Litigation. Pet., 77. In addition, even if this IPR was instituted (which would not occur until on or around August 25, 2025) it is unlikely that the Court (Judge Albright) would grant a stay. *See, generally, Continental Intermodal Grp. v. Sand Revolution LLC*, No. 7:18-cv-00147 (W.D. Tex. July 22, 2020) (Judge Albright) *Multimedia Content Mgmt. LLC v. Dish Network*, No. 6:18-CV-00207-ADA, 2019 U.S. Dist. LEXIS (W.D. Tex. May 30, 2018) (Judge Albright) (denying stay).

Thus, the first factor weighs against institution.

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

The Trial in the Parallel Litigation is scheduled for May 14, 2026, over 3 months before the statutory deadline for issuing a Final Written Decision in this matter on August 25, 2026.

Rather than looking at the actual trial date scheduled, the Petition relies on the median time from filing to case disposition in the Western District of Texas. However, on February 28, 2025, the Office *rescinded* former Director Vidal's 2022 memorandum on discretionary denials which had directed that such statistics be considered in lieu of the actual trial date scheduled by the court. The announcement

rescinding former Director Vidal’s 2022 memorandum went on to state that decisions relying on the 2022 memo will be “neither binding or persuasive on the PTAB.” In view of the above, Petitioner’s arguments based on the time to trial statistics cannot be considered persuasive and must be rejected. Finally, while the Memorandum issued by Administrative Patent Judge Boalick on March 24, 2025 indicates that time-to-trial statistics “may” still be considered along with any other evidence the parties may submit, the Acting Director’s rescission of the 2022 Vidal Memo (which had directed the application of such statistics in lieu of an earlier actual trial date) demonstrates that such statistics have lesser importance where, as here, an actual trial date has been set by the Court.

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

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

Factor 3 relates to investment in the Parallel Litigation by the District Court and the parties. *Fintiv*, Paper 11 at 9. This factor is judged from the date of the institution decision, which is expected to be no later than August 13, 2025. *Id.*

On April 10, 2025, the District Court held a Markman Hearing. Prior to the Hearing, the Court issued preliminary constructions based on extensive briefing submitted by the parties. The Markman Hearing occurred on time as set forth in the

Scheduling Order. This demonstrates that the Parallel Litigation is on schedule, and that there has already been a significant investment by the Court and the parties in the Parallel Litigation.

The investment by the Court and the parties in the Parallel Litigation will continue to increase between the time of this filing and August 25, 2025, when the Board's institution decision is due. By that time, all of the following will have been completed in the Parallel Litigation:

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

EX2003, 1-3.

In addition, by the anticipated date of the institution decision on August 25, 2025, the parties will be more than half-way through fact discovery (which opened April 11, 2025) and the Court will in all likelihood have issued its claim construction ruling.

Therefore, the Parallel Litigation has already progressed significantly, including the filing of all claim construction briefing, completion of the Markman Hearing on April 10, 2025, and service of Preliminary Infringement and Invalidity Contentions. By the anticipated date of the institution decision in this matter (August 25, 2025), service of Final Infringement and Invalidity Contentions will be complete, the parties will be more than half-way through fact discovery (which opened April 11, 2025) and the Court will in all likelihood have issued its claim construction ruling. EX2003, 2-3. The Trial is scheduled for May 14, 2026, over 3 months before the statutory deadline for issuing a Final Written Decision in this matter on August 25, 2026. EX2003, 4.

Clearly, the parties and the Court will have made a substantial investment in the Parallel Litigation by the expected date of the institution decision on August 25, 2025.

At the time the Petition was filed on January 17, 2025, Petitioner asserted that “[t]he investment in the co-pending litigation has been minimal.” Pet., at 83. Patent

Owner disagrees that the investment in the co-pending litigation was minimal as of January 17, 2025. Yet, even if Petitioner's assertion about the state of affairs on January 17, 2025, was accurate, it is irrelevant. As explained in *Fintiv*, the investment in the Parallel Litigation by the District Court and the parties is judged from the date of the anticipated institution decision, which is expected to be about August 25, 2025 -- rather than January 17, 2025. *Fintiv*, Paper 11 at 9. There can be no argument that by August 25, 2025, the District Court and the parties will have made a substantial investment in the Parallel Litigation.

Thus, the third factor weighs against institution.

In a co-pending IPR challenging a different patent that is being asserted against Petitioner in the Parallel Litigation, Petitioner predicts that the Parallel Litigation will be bifurcated, causing a delay of the trial date set forth in the Scheduling Order. *See*, IPR2025-00218, Paper #7, at 1. In support of this prediction, Petitioner relies on an article (IPR2025-00218, EX1021) quoting an out of court statement made by Judge Albright five years ago at a conference, and a prior bifurcation order in an unrelated case (IPR2025-00218, EX1020). However, Petitioner fails to acknowledge that the bifurcation order it cites resulted from a **joint motion** to bifurcate. No such motion has been filed in the Parallel Litigation, nor has either party sought bifurcation of the district court proceedings. In addition, Petitioner also omits the portion of the article in which "Judge Albright said he's

presiding right now over a case with ‘seven or eight’ patents, and the parties have made opposite requests about how to try the case.” IPR2025-00218, EX1021. This undercuts Petitioner’s position, as it demonstrates that trial structure decisions depend on actual party requests—which are absent here. In short, there is no evidence in the record that the district court will bifurcate the Parallel Litigation.

For these reasons, Factor 3 weighs in favor of discretionary denial.

D. Factor 4 Weighs Against Institution Because There Is Substantial Overlap Between The Parallel Litigation And This IPR

As mentioned above Petitioner filed a Counterclaim in the Parallel Litigation challenging the validity of ‘639 Patent as a whole. EX2001, at 88-89. The Counterclaim is not limited to any particular claim(s) of the ‘639 Patent, and therefore covers all claims of the ‘639 Patent -- including the claims challenged in this IPR.

On January 9, 2025 -- more than a week before filing this IPR -- Petitioner served its Second Supplemental Preliminary Invalidity Contentions in the District Court. As explained below, there is complete overlap between the prior art references advanced by Petitioner in this IPR and those advanced by Petitioner in the Parallel Litigation. Set forth below is a summary of the grounds raised in the Petition, and the prior art asserted in each ground:

Grounds	Claims	Pre-AIA Basis
#1	1-3, 6, and 7	§103 over Barnard
#2	7	§103 over Barnard in view of Knecht
#3	1-7	§103 over Barnard in view of Lawrence
#4	7	§103 over Barnard in view of Lawrence and Knecht

Pet., 10. Set forth below is an excerpt from Petitioner’s Second Supplemental Preliminary Invalidity Contentions in the Parallel Litigation showing the prior art relied on by Petitioner for challenging the ‘639 Patent in the District Court:

Ex. No.	Patent/ Publication	Referenced As	Publication / Priority Date
A1	U.S. Pat. No. 5,027,413	Barnard	June 25, 1991
A6	U.S. Patent No. 4,881,270	Knecht	November 14, 1989
A7	WO 1990/016,038 A1	Lawrence	December 27, 1990

EX2004, 10; *see also*, 38-54. Thus, there is complete overlap between the references being used by Petitioner in the District Court to challenge the claims of the ‘639 Patent and the references being used by Petitioner in these proceedings to challenge the ‘639 Patent.

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

Thus, the fourth factor weighs against institution.

At the time the Petition was filed on January 17, 2025, Petitioner argued that “[t]he extent of overlap is ... speculative at this point in time.” Pet., at 79. In pertinent part, the Petition stated:

The co-pending litigation is in its early stages. Petitioner served its preliminary invalidity contentions on October 24, 2024 and supplemental invalidity contentions on November 27, 2024. However, Petitioner will not serve its final invalidity contentions until May 22, 2025, near when the Board would issue an institution decision in this case. Ex.1011, 3. The extent of overlap is thus speculative at this point in time. Pet., 79.

The Petition’s description of the state of affairs at the time neglected to inform the Board that a week before the filing of the Petition on January 9, 2025, Petitioner served its Second Supplemental Preliminary Invalidity Contentions in the Parallel Litigation relying on the exact same prior art being relied on in these proceedings. Clearly, at the time Petitioner filed this IPR on January 17, 2025, Petitioner not only had every reason to anticipate that there would be significant overlap between the prior art references advanced by Petitioner in this IPR and those advanced by Petitioner in the Parallel Litigation, it in fact knew there was complete overlap. After all, the issue of overlap is completely within Petitioner’s control -- as Petitioner is the party that chose which references to assert in each forum. However, rather than deal with the overlap that was known to Petitioner, Petitioner made the strategic decision in the Petition to play games and characterize the extent of overlap as “speculative.” Pet., 79. To the extent Petitioner abandons its position that the overlap

is “speculative” in its reply in favor of a *Sotera* stipulation, Petitioner’s stipulation should be rejected.

In *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, (2018), the United States Supreme Court held that an IPR must proceed in accordance with the petition. *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 365 (2018); see 35 U.S.C. § 312(a)(3). Because of the expedited nature of IPR proceedings, “[i]t is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition” lay out the entirety of Petitioner’s position, including all of Petitioner’s theories and evidence. *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1330 (Fed. Cir. 2019). This requirement extends to a Petitioner’s theories as to why discretionary denial is not warranted, which likewise should be set forth in the Petition. In fact, the rules authorize a pre-institution reply only in circumstances where “good cause” exists, and a Petitioner lacks “good cause” to reply to arguments that Petitioner should have anticipated would have been made by Patent Owner. 37 C.F.R. 42.108(c) (“A petitioner may seek leave to file a reply to the preliminary response in accordance with §§ 42.23 and 42.24(c). Any such request must make a showing of good cause”).

Moreover, even in cases where a Petitioner is granted an opportunity to file a pre-institution reply, the rules are clear that a Petitioner cannot pivot to a new theory in a reply, but instead “may only respond to arguments raised in the corresponding

opposition.” 37 C.F.R. 42.23(b); see e.g., *Juniper Networks, Inc. v. Swarm Technology, LLC*, IPR2021-01445, Paper 62 (P.T.A.B. 2023) (refusing to consider new theory presented for first time in a reply and citing statement in Trial Practice Guide that a “Petitioner may not submit new evidence or arguments in reply that it could have presented earlier”) (*citing*, Patent Trial and Appeal Board Consolidated Practice Guide 73 (Nov. 2019)). “Respond” in the context of 37 C.F.R. § 42.23(b), does not mean proceed in a new direction with a new approach as compared to the positions taken in a prior filing.” *Juniper Networks*, Paper 62, at 28. “While replies and sur-replies can help crystallize issues for decision, a reply or sur-reply that raises a new issue or belatedly presents evidence may not be considered.” *Id.*

As noted above, the issue of overlap was completely within Petitioner’s control, and Petitioner was fully aware at the time of filing the Petition that there was complete overlap between the prior art in this IPR and the Parallel Litigation. Nonetheless, Petitioner made the strategic decision to play games and falsely characterize the extent of overlap as “speculative” in the Petition. Pet., 79. If Petitioner attempts in its reply to pivot from its “speculative” argument in the Petition to a *Sotera* stipulation, Petitioner would be improperly proceeding “in a new direction with a new approach as compared to the positions taken in a prior filing.” *Juniper Networks*, Paper 62, at 28. Accordingly, to the extent Petitioner belatedly submits a *Sotera* stipulation with its reply, the stipulation should be rejected as

beyond the scope of a proper reply. Allowing a Petitioner who knows at the time of filing the Petition that there is complete overlap in the prior art applied in both proceedings to hold back a *Sotera* stipulation in order “to wait and see” Patent Owner’s arguments before deciding whether to later commit to a *Sotera* stipulation in a reply would improperly “open the door to gamesmanship.” *NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556, Paper #13, at 4 (precedential).

For all of the above reasons, the fourth factor weighs against institution.

E. Factor 5 Weighs Against Institution Because The Patent Owner Is The Same And Petitioner Are The Same Parties As In The Parallel Litigation

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

Thus, the fifth factor weighs against institution.

F. Factor 6 Weighs Against Institution Because The Merits Of Petitioner’s Challenge Is Weak

Under 37 C.F.R. § 42.22(a)(2), a petition for inter partes review must include a “full statement of the reasons for relief requested, including a detailed explanation of the significance of the evidence including material facts,” and must further provide a clear articulation of “[h]ow the challenged claim is to be construed” and “[h]ow the construed claim is unpatentable.” 37 C.F.R. § 42.104(b)(3)-(4). For at least two reasons explained below, the Petition fails to satisfy these fundamental requirements.

1. Petitioner Failed To Inform That Board That Petitioner Was Taking Inconsistent Claim Construction Positions In This IPR And The Parallel Litigation

Independent claim 1 recites “generating said target feature information from said data statistics.” In the Parallel Litigation, Petitioner maintains that this term is indefinite. Specifically, in its Second Supplemental Preliminary Invalidity Contentions in the Parallel Litigation (served *before* Petitioner filed this IPR), Petitioner alleged:

A. Indefiniteness Under 35 U.S.C. § 112, ¶ 2 and 112(b)

Subject to the reservation of rights above, Tesla provides below an identification of Asserted Claims along with an identification of the specific limitations that are invalid pursuant to 35 U.S.C. § 112 ¶ 2 or 112(b) as indefinite. Specifically, at least the following terms are not explained in the specifications of the Asserted Patents such that a POSITA would be able to determine their meaning and scope with reasonable certainty:

1. The '639 Patent

Claim(s)	Claim Language
1[c]	“generating said target feature information from said data statistics”
7	“said feature information is further used to distinguish two target classes or a plurality of target classes from one another”

Ex. 2004, 227-228. Petitioner failed to inform the Board that it was contending in the Parallel Litigation that the challenged claims were indefinite. On the contrary, in these proceedings, Petitioner’s expert testified that he gave all of the claim terms

their ordinary and customary meaning in light of the specification and prosecution history. In this regard, Petitioner's expert testified in these proceedings as follows:

38. It is my understanding that in order to properly evaluate the '639 Patent, the terms of the claims must first be interpreted. It is my understanding that for the purposes of this *inter partes* review, the claims are to be given their ordinary and customary meaning as would be understood by one of ordinary skill in the art at the time of invention in light of the specification and prosecution history, unless the inventor has set forth a special meaning for a term.

39. It is my opinion that none of the claim terms require a specific construction for the purposes of my analysis in this declaration, and all will be given their ordinary and customary meaning in light of the specification and prosecution history of the '639 Patent. EX1003, ¶¶38-39 (emphasis added).

It is impossible to reconcile Petitioner's position in the Parallel Litigation that a POSITA would be unable to determine the meaning and scope of the challenged claims, with the testimony of Petitioner's expert in these proceedings giving all of the claim terms "their ordinary and customary meaning as would be understood by one of ordinary skill in the art."

Simply put, it is improper for the Petition to maintain that the challenged claims are obvious in these proceedings based on the ordinary and customary meaning of the claim terms as would be understood by one of ordinary skill in the art when, in the Parallel Litigation, Petitioner asserts that the same person of ordinary skill in the art would be unable to ascertain the meaning of such claim terms.

Under 37 C.F.R. § 42.104(b)(3), Petitioner must provide a clear articulation of “[h]ow the challenged claim is to be construed.” Petitioner failed to meet this burden by basing the Petition on a claim construction that Petitioner believes is incorrect and cannot be reconciled with Petitioner’s claim construction position in the Parallel Litigation. These aspects of the Petition favor discretionary denial.

2. The Petition Fails To Articulate How The Construed Claims Are Unpatentable

In addition to articulating “[h]ow the challenged claim is to be construed,” the Petition is also required to explain “[h]ow the construed claim is unpatentable.” 37 C.F.R. § 42.104(b)(3)-(4). With respect to the latter requirement, the Petition is deficient, as it glosses over a key limitation recited in the challenged claims.

Claim 1 of the ‘639 Patent recites in pertinent part:

(b) calculating data statistics from said data and using said data statistics to select target specific feature information to distinguish specific targets from background clutter;

This claim language requires that calculated data statistics be used to select target specific feature information which, in turn, is used to distinguish specific targets from background clutter. The plain meaning of “target specific” feature information is feature information that is specific to a given target, and therefore, what constitutes “target specific” feature information will vary across targets. As noted above, the ‘639 Patent relates to the identification of a target (e.g., a missile or

a fighter jet) in radar samples, and was the subject of secrecy orders from the U.S. Air Force. EX1001, 5:19-20 and EX1003, 162-166, 93-101, 82. In military applications, “target specific” feature information selected for distinguishing a missile (one specific target) in radar samples will differ from “target specific” feature information selected for distinguishing a fighter jet (a different specific target) in radar samples. The Petition glosses over the requirement that the feature information selected for distinguishing the target be “target specific,” effectively rewriting the claim language as follows:

(b) calculating data statistics from said data and using said data statistics to select ~~target-specific~~ feature information to distinguish specific targets from background clutter;

Under the analysis set forth in the Petition, any feature information that is “select[ed] to distinguish a target from background clutter” would meet the claim language -- even if the selected feature information is generic to all targets. This approach is severely flawed because the claims require the use of “target specific” feature information to “distinguish specific targets from background clutter.”

As explained more fully in Section III below, Petitioner’s expert maps the subject claim language to a disclosure in Barnard (Ex. 1005) that simply discards a feature or an area of an image if its statistical distribution is too wide. Pet., 17. Significantly, Barnard applies generic criteria -- rather than target specific criteria - - to identify which features or areas to discard. Completely absent from Barnard is

any use of “target specific” feature information to “distinguish specific targets from background clutter” as recited in the claims. As explained more fully in Section III below, Petitioner’s arguments rest on an impermissible attempt to rewrite both the claims and the cited prior art through conclusory expert opinion, which is an additional factor which weighs against institution.

Thus, the sixth factor weighs against institution.

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

III. ADDITIONAL FACTORS SET FORTH IN THE MEMORANDUM SUPPORT DISCRETIONARY DENIAL

In addition to the *Fintiv* factors, the Board’s discretionary authority under 35 U.S.C. § 314(a) encompasses other relevant considerations, including the relationship of the ‘639 Patent to national security, the extent of a petition’s reliance on expert testimony, the timing of the petition relative to the Patent’s expiration, and the settled expectations of the parties. Memorandum, 1.

The patent application that matured into the ‘639 Patent was subject to a secrecy order issued and repeatedly renewed by the United States Air Force over the course of more than a decade. This extraordinary history reflects a sustained government determination that the invention was outside the scope of the public domain (and therefore, novel and non-obvious), and of critical importance to

national security. Under these circumstances, allowing institution would invite hindsight review of a patent whose technical significance was established by actions taken by the United States Air Force over three decades ago.

Moreover, the Petition is deficient in multiple respects that independently and collectively support discretionary denial. Most notably, the Petition relies heavily on conclusory expert testimony to fill critical gaps in the prior art, rather than grounding its arguments in the disclosures of the cited reference. Petitioner's expert attempts to rewrite both the claim limitations and the teachings of Barnard, improperly substituting inference for evidence and reading into the prior art functionality that is simply not disclosed. This use of expert testimony is not only excessive, but it also contravenes the statutory requirement that unpatentability be shown based on patents or printed publications, not unsupported opinions.

Finally, the timing and context of this Petition further favor denial. Petitioner was placed on explicit notice of the '639 Patent and its relevance to its products more than four years ago, yet waited until nearly three years after the Patent's expiration to file this challenge. That prolonged and unjustified delay undermines the integrity of the inter partes review process and weighs heavily against institution under the guidance set forth in the Memorandum.

A. The Application That Matured Into The ‘639 Patent Was Reviewed Extensively By The United States Air Force

The ‘639 Patent relates to the identification of a target (e.g., a missile or a fighter jet) in radar samples, and was the subject of Secrecy Order issued by the United States Airforce. EX1001, 5:19-20 (discussing radar samples) and EX1002, 162-166, 93-101, 82 (secrecy orders). In 1991, after the patent application that would mature in the ‘639 Patent was filed, the Department of the Air Force “determined that this patent application discloses critical technology with military or space application, the unauthorized disclosure of which would be detrimental to the national security and which is subject to export control...” EX1002, 162.

Under 35 U.S.C. § 181, a Secrecy Order remains in effect for a period of 1 year from its date of issuance. However, the Secrecy Order may be renewed for “additional periods of one year upon notification by the head of the department or the chief officer of the agency who caused the order to be issued *that an affirmative determination has been made that the national interest continues to so require.*” 35 U.S.C. 181 (emphasis added). Over the Applicant’s objection (see EX1002, 108), the United States Air Force renewed the Secrecy Order in 1993, 1994, 1995, 1996, 1997, 1998, 1999, 2001 and 2002. (see EX1002, 70-71, 73-82, 86-91, 93-98 and 100-101) It was not until 2003 that the United States Air Force rescinded the secrecy Order. EX1002, 70-71.

The repeated imposition and renewal of the Secrecy Order by the United States Air Force over the course of more than a decade strongly reinforces the novelty and non-obviousness of the invention disclosed in the '639 Patent. Each annual review—spanning from 1992 through 2002—resulted in a renewed determination by the United States Air Force that the subject matter of the application disclosed critical military technology, the unauthorized release of which would be detrimental to national security. Such steps would not have been necessary if the technology was already in the public domain, or obvious based on public domain information, as argued in the Petition. This pattern of continued secret classification, despite the Applicant's objections, reflects the government's recognition that the claimed invention was not conventional or routine, but instead disclosed innovative capabilities with significant defense applications. That the Secrecy Order remained in place until the eleventh review further confirms that the invention was regarded as both technically advanced and non-obvious, underscoring the inappropriateness of a hindsight-based validity challenge at this late date, and providing a further basis for discretionary denial.

B. The Petition Relies Extensively on Expert Testimony

Another relevant consideration for discretionary denial under 35 U.S.C. § 314(a), as identified in the Memorandum, is “[t]he extent of the petition’s reliance on expert testimony.” Memorandum, at 1. In this case, the Petition relies heavily on

a 114-page expert declaration (EX1003) comprising 182 paragraphs—well beyond what is appropriate under the statutory framework governing inter partes review.

Specifically, under 35 U.S.C. § 311(b), “[a] petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.”

Here, Petitioner’s attempt to establish unpatentability hinges on an improper use of expert testimony to rewrite both the challenged claims and the cited prior art. Rather than grounding its arguments in the actual disclosures of Barnard, Petitioner relies on its expert to fill critical gaps in the reference—most notably, the absence of any disclosure of using data statistics to select target-specific feature information to distinguish specific targets from background clutter, as expressly required by the claims. Petitioner’s expert does not point to any portion of Barnard that describes this limitation; instead, the expert attempts to manufacture it through interpretation and inference, effectively reading the limitation out of the claims and attributing functionality to Barnard that simply is not present.

This tactic is impermissible. The claims expressly recite not just the calculation of data statistics, but the use of those statistics to affirmatively select target specific features tailored to distinguish specific targets. Yet Petitioner’s expert reduces this limitation to a generic process of excluding statistically unreliable

data—conflating discarding with selecting—and asserts, without evidentiary support, that this somehow satisfies the requirement for target-specific feature selection. In doing so, the expert is not interpreting Barnard; he is attempting to rewrite it because he too realizes there is no such disclosure in the reference. Such conclusory expert assertions cannot substitute for the clear and unambiguous teachings required to support a finding of unpatentability.

As shown below, Barnard is entirely silent on selection of target specific features for different target classes, and makes no mention of tailoring such selection to distinguish, for example, a seagull from a sea-skimming missile. The expert's effort to fill that silence with opinion testimony—rather than citation to actual disclosure—is precisely the type of post hoc rationalization the Board has repeatedly rejected. Because Petitioner's expert improperly reads out a key claim limitation and fills the resulting gap with *ipse dixit* speculation rather than evidence, the Petition fails to meet the procedural and substantive standards required for institution.

1. Barnard Does Not Disclose Selecting Target-Specific Features, and Petitioner's Expert Improperly Attempts to Fill This Gap Through Unsupported Testimony

To compensate for the absence of this required functionality in the prior art, Petitioner's expert relies on Barnard and its Figure 2 to assert that the reference discloses the selection of target specific features based on statistical analysis. However, as demonstrated below, the cited portions of Barnard describe only a

statistical filtering process that generically excludes features irrespective of target type (or class) based on excessive distribution width or variability. There is no disclosure in Barnard of selecting target specific features for this process, e.g., ones tailored to a particular target type or class, nor any discussion of how such a selection would be made. Petitioner's expert fails to identify any portion of Barnard that teaches or suggests the claimed use of statistical analysis to affirmatively select target specific features used to distinguish specific types of targets. Rather, the expert attempts to fill a fundamental gap in the reference by reading in limitations not found in the text, thereby improperly using expert testimony to substitute for the required disclosure.

For example, Petitioner's expert alleges that in "Fig. 2, Barnard provides the specific example of distinguishing specific targets, such as a point source 15 and a sea-skimming source 16 (e.g., a sea-skimming missile), from background clutter, such as wave crests 17." EX1003, ¶70, citing EX1005,1:24-36, 3:34-41.

However, as shown below, Barnard at 1:24-36 and 3:34-41 (reproduced below) offers no example or description that target specific features are selected to distinguish the point source 15. Similarly, the cited portions are silent with regard to selection of target specific features to distinguish the detect the sea-skimming source 16.

A target detection system in accordance with the invention may be characterised in that means are provided to calculate the width of the statistical distributions of the background and target features and to discard a feature as a threshold parameter if the width of the statistical distribution of that feature exceeds a predetermined amount, or if the feature mean varies by more than a preset amount over a succession of scene images. EX1005, 1:24-36.

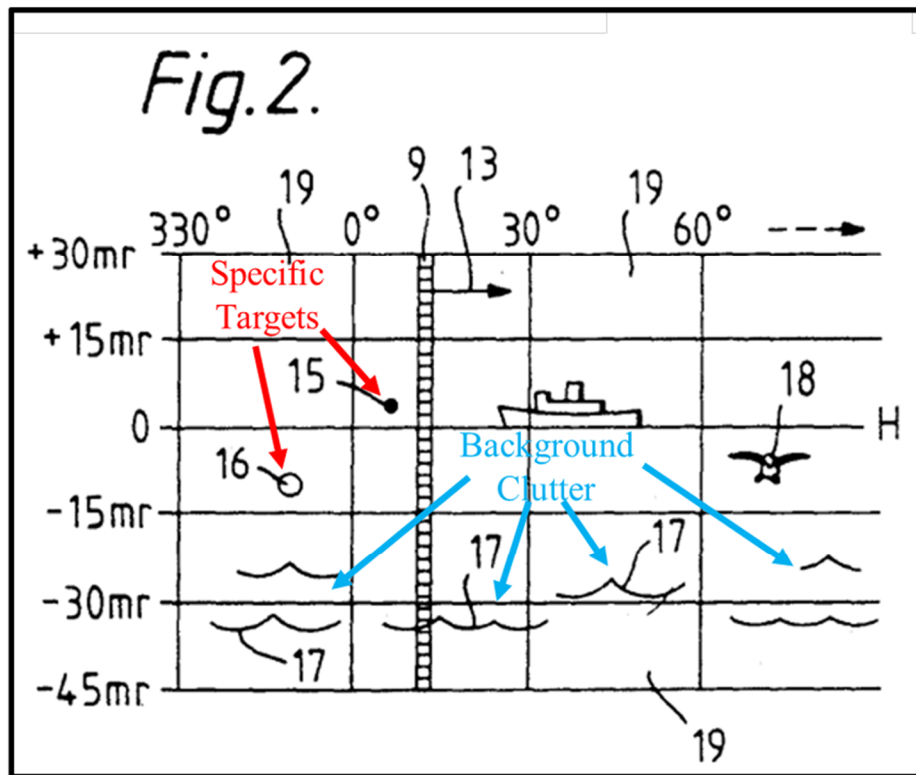
As shown in FIG. 2, 30 mr above the horizon and 45 mr below the horizon are 35 covered. Thus a point source 15 some 5 mr above the horizon is seen against a sky background and a closer sea-skimming source 16 some 10 mr below the horizon is seen against a sea background. Wave crests 17 closer to the apparatus can also constitute point sources of 40 radiation, as can a seagull 18. EX1005, 3:34-41.

While the above passages (and Barnard as a whole) refer to identification of generic target features (such as edges), there is no mention of “target specific” features, e.g., ones tailored to a particular target type or class. The reference merely discloses that if a statistical distribution associated with a generic target feature or area is too wide or its average value varies too much across, the target feature or area can be discarded and not subjected to further analysis. *See also*, EX1005, 1:24-39. Absent from Barnard is any disclosure involving the selection of target specific features.

Therefore, when read in full context, it is clear that Barnard is using the statistical distributions calculated on generic target features or areas of the image to

exclude generic target features or areas from further analysis (e.g. target identification) because they are unreliable. Accordingly, there is absolutely nothing in Barnard to support the assertion of Petitioner’s that the reference discloses the use of “the calculated data statistics to select target specific feature information—the set of features and associated target detection threshold—used to distinguish specific targets from background clutter.” EX1003, ¶69.

Further, Figure 2 of Barnard, as annotated by Petitioner’s expert (reproduced below), shows no evidence of a selection of “target specific feature information to distinguish specific targets from background clutter,” as required by the challenged claims.



Barnard, Fig. 2 (annotated).

Instead, Fig. 2 shows the amount of radiation in milliradians (mr) that are received from a point source 15, a sea-skimming missile 16, a seagull 18, and wave crests 17. Petitioner's expert does not assert that in Barnard the target features selected for target 15 (a point source) are any different from the target features selected for target 16 (a missile) or target 18 (a seagull), nor does he provide any explanation as to how the figure shows a selection of "target specific feature information to distinguish specific targets from background clutter," as required by the challenged claims.

As a result, Petitioner’s argument that Barnard discloses the selection of “target specific feature information to distinguish specific targets from background clutter” is not supported by the reference. The passages relied upon by Petitioner’s expert merely describe a statistical filtering process in which features generic to all targets are discarded based on the width of their statistical distribution or variability across images—i.e., a process for excluding generic features, not selecting target-specific ones. Indeed, Barnard is silent as to any selection of target specific features for the purpose of distinguishing targets such as the point source 15 or sea-skimming source 16 from background clutter. Petitioner’s expert fails to identify any disclosure in Figure 2 (or elsewhere) that provides a target specific feature selection, nor does the expert provide any technical rationale for reading such a limitation into Barnard. Instead, the cited portions of Barnard demonstrate that the system filters out inconsistent or statistically noisy data or generic target features, not that it performs any target specific feature selection as required by the challenged claims. Accordingly, Petitioner’s reliance on Barnard is misplaced, and its attempt to fill this critical gap with expert testimony is improper.

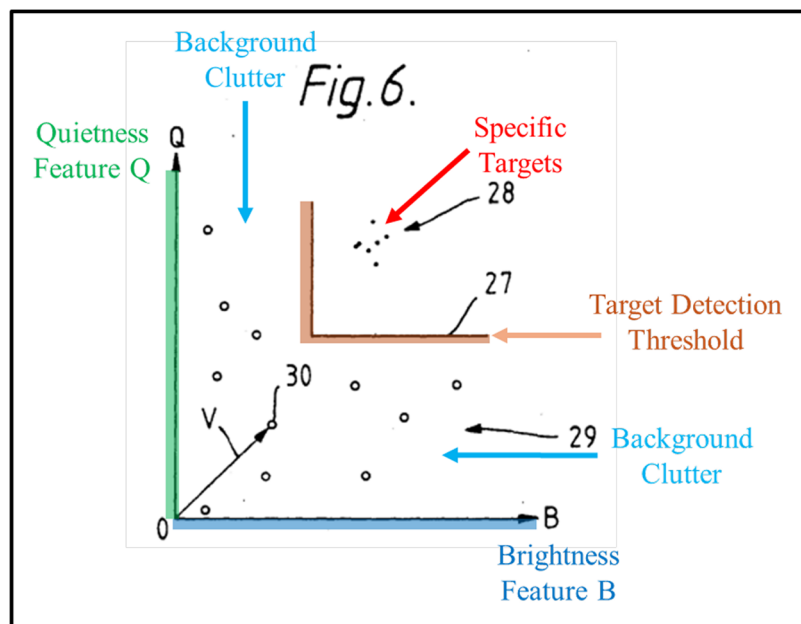
2. Petitioner’s Expert Improperly Relies on Barnard’s Figure 6 to Fill Gaps in the Reference Concerning the Selection of Target Specific Feature Information

Petitioner also attempts to rely on Barnard’s Figure 6 and accompanying discussion to argue that the reference discloses a system for selecting “target specific

feature information to distinguish specific targets from background clutter,” as required by the challenged claims. In support, Petitioner’s expert points to a passage in Barnard stating that “a selection of features can usually be found in which it is possible to place a threshold hypersurface in the feature space which effectively separates target objects from background objects.” EX1003, ¶68, citing EX1005, 5:13–19. Petitioner’s expert further annotates Figure 6 to illustrate a hypothetical threshold hypersurface drawn across two clusters in a simplified feature space.

However, this reliance on Barnard is fundamentally misplaced. As explained below, Barnard provides no discussion of how such a hypersurface is a target specific feature, e.g., one that differs based on target type of class, nor does it describe the selection of target specific features, e.g., tailored to the identification of specific target classes, such as seagulls versus sea-skimming missiles. Instead, Barnard teaches that features generic to all targets which exhibit excessive statistical variability are simply discarded. Despite this, Petitioner’s expert improperly attempts to reframe Barnard’s feature exclusion mechanism as a target specific feature selection process, thereby inserting limitations into the reference that are not disclosed. This approach reflects an improper attempt to fill gaps in the prior art through conclusory expert opinion rather than relying on what Barnard actually teaches.

Petitioner's expert offers an annotated version of Fig. 6 (reproduced below) and cites Barnard as explaining that "A selection of features can usually be found in which it is possible to place a threshold hypersurface in the feature space which effectively separates target objects from background objects. FIG. 6 illustrates this known approach using only two features B and Q, but only for clarity of drawing." EX1003, ¶68, citing EX1005, 5:13-19.



Barnard, Fig. 6 (annotated).

However, Petitioner's expert provides no explanation of how the hypersurface 27 is a target specific feature, e.g., one associated with a particular target type or class -- as opposed to a generic feature applicable to targets in general. For example, Petitioner does not assert that Barnard's hypersurface 27 is selected for seagulls 18

as compared to sea skimming missile 16. That is because the reference lacks any disclosure of selection of target specific features.

As a result, Petitioner's expert improperly attempts to fill critical gaps in Barnard by offering conclusory assertions that are not supported by the reference itself. Although the expert relies on Figure 6 and Barnard's discussion of threshold hypersurfaces to suggest that features are selected to distinguish specific targets from background clutter, Barnard contains no disclosure explaining how such a hypersurface corresponds to a target specific feature. For instance, Barnard never states that one hypersurface is selected for seagulls while another is selected for sea-skimming missiles. This omission is significant, given that the challenged claims explicitly require the selection of target specific feature information.

In short, Petitioner's expert is not interpreting Barnard, but rewriting it, using the '639 patent's claim 1 as a guide. By asserting that Barnard discloses the selection of target specific feature information where none is described, the expert impermissibly fills gaps in the prior art with result-oriented hindsight.

3. Petitioner's Expert Rewrites Barnard Through Conclusory Testimony Unsupported by the Reference, Rendering the Petition Legally Deficient and Warranting Discretionary Denial

Petitioner's reliance on Barnard is fundamentally flawed because it is not predicated on what the reference actually discloses. As demonstrated above, Barnard

does not describe a process for selecting target specific feature information based on calculated data statistics. The challenged claims require not just the selection of features in general, but the selection of target-specific features tailored to distinguish specific targets from background clutter. Barnard does not disclose that its hypersurface would vary based on the target type or class, and the cited portions of the reference make no mention of, e.g., selecting different features for seagulls versus sea-skimming missiles. By glossing over the requirement that the selected features be “target specific,” Petitioner’s expert attempts to read into Barnard a level of functionality that simply is not present. This amounts to an impermissible effort to rewrite the reference to align with the claim language.

Simply put, the expert’s testimony lacks support in Barnard and is inconsistent with both the reference and the plain language of the claims. As such, the Petition fails to satisfy the requirements of 37 C.F.R. §§ 42.22(a)(2) and 42.104(b), which demand a clear and substantiated explanation of how the prior art renders the claims unpatentable. Without a disclosure of how Barnard selects target specific features, Petitioner’s assertions remain conclusory and legally insufficient.

The extensive and improper use of expert testimony further supports discretionary denial under 35 U.S.C. § 314(a) and the guidance of the Memorandum.

**C. The ‘639 Patent Has Been Expired for Almost 3 Years And
Petitioner Has Been Aware Of The ‘639 Patent Since At Least
2020**

A further relevant consideration identified in the Memorandum was “[s]ettled expectations of the parties, such as the length of time the claims have been in force.” Memorandum, at 1. In this case, the ‘639 Patent expired almost 3 years ago, on May 5, 2022, after having been in force for 17 years. Despite having been specifically alerted to the ‘639 Patent on August 7, 2020 (and provided with a copy of ‘639 Patent at that time), Petitioner waited more than four years to file this IPR challenging the ‘639 Patent. Under these circumstances, Petitioner’s delay in filing this IPR is a further factor that favors discretionary denial.

Specifically, Patent Owner sent a letter to the Associate General Counsel of Petitioner on August 7, 2020 (hereinafter, “the Letter”), which is more than four years ago. EX2005, at 1-4. The Letter was sent by email and contained several attachments, including a copy of ‘639 Patent (at 5-19), and a claim chart mapping a representative product to claim 1 of ‘639 Patent (at 20-24) (hereinafter “the Claim Chart”).

The Letter was addressed to Petitioner’s Associate General Counsel, and stated in part:

The following is a list of exemplary patents and exemplary infringing products. I am further attaching brief descriptions of the exemplary IV patents listed below in the form of patent infringement summaries. In addition to the attached patent

overview summaries, I am attaching a copy of each Patent for your convenience. EX2005, at 2.

The Letter included a list of patents which, as shown below, included the ‘639 Patent.

List of Exemplary Patents and Products:

U.S. Patent No.	Title	Inventor	Tesla Products
7,639,943	Computer-implemented system and method for automated image uploading and sharing from camera-enabled mobile devices	Kalajan, Kevin E	Models S, X, 3, Y
9,934,628	Video recorder	Kreiner, Barrett Morris et al.	Models S, X, 3, Y
7,810,140	System, method, and computer readable medium for processing a message in a transport	Lipari, Paul A et al.	Models S, X, 3, Y
9,866,632	Reusable multimodal application	Anderl, Ewald C.	Models S, X, 3, Y
7,484,008	Apparatus for vehicle internetworks	Gelvin, David C et al.	Models S, X, 3, Y
7,206,672	Vehicle data bus system	Mueller, Achim	Models S, X, 3, Y
7,336,805	Docking assistant	Gehring, Ottmar et al.	Models S, X, 3, Y
6,894,639	Generalized hebbian learning for principal component analysis and automatic target recognition, systems and method	Katz, Alan Jerry	Models S, X, 3, Y

EX2005, at 3. The Letter also included the Claim Chart identifying how Petitioner infringed Claim 1 of the ‘639 Patent. EX2005, at 20-24.

In addition, the Claim Chart clearly identified that Petitioner’s usage of its “Autopilot” function infringed claim 1 of the ‘639. EX2005, at 24 (“At least Claim

1 of Patent 6,894,639 reads on Tesla MODEL 3 Autopilot.”) As noted above, Claim 1 is the only challenged independent claim in this IPR.

Accordingly, on August 7, 2020, the Patent Owner notified Petitioner of the ‘639 Patent, furnished Petitioner with a copy of the ‘639 Patent and notified Petitioner that it infringed claim 1 of the ‘639 Patent. Patent Owner and Petitioner subsequently discussed the content of the Letter.

Despite this irrefutable evidence to the contrary, the Petition states:

Petitioner only learned which claims were being asserted in August 2024. See Ex.1014 (infringement contentions cover pleading). Since then, Petitioner has worked expeditiously to file this Petition within four months. Pet., at 79.

Petitioner’s assertion that it only learned which claims were being asserted in August 2024 is belied by the facts, which demonstrate that Petitioner was aware of at least the only independent claim challenged over four years prior in August 2020. Despite having early and detailed notice, Petitioner waited more than four years to file the present Petition. The settled expectations of the parties, the length of time the claims have been in force, and Petitioner’s prolonged and unexplained delay all weigh strongly in favor of discretionary denial under 35 U.S.C. § 314(a) and the guidance set forth in the Memorandum.

IV. CONCLUSION

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

In addition to the *Fintiv* factors, multiple discretionary considerations outlined in the Memorandum independently support denial of institution under 35 U.S.C. § 314(a). The patent application that matured into the '639 Patent was subjected to a Secrecy Order by the U.S. Air Force, renewed annually for over a decade, confirming the government's determination that the invention disclosed critical, novel, non-obvious technology of significant national security importance. In addition, the Petition improperly relies on a voluminous and conclusory expert declaration to fill critical gaps in the cited prior art, effectively rewriting both the claims and Barnard through unsupported inference rather than pointing to actual disclosures. Finally, Petitioner delayed more than four years after receiving explicit notice of its infringement of the '639 Patent before filing this IPR—years after the

Patent had expired—contrary to the settled expectations of the parties and undermining the objectives of inter partes review.

Each of these issues independently supports discretionary denial. Considered together, they present the paradigmatic case for the Director to exercise her discretion and deny institution of this untimely and inefficient Petition in accordance with § 314(a).

Respectfully submitted,

Dated: April 22, 2025

By: /Brandon R. Theiss/
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*Counsel for Patent Owner
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CERTIFICATE OF COMPLIANCE WITH WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), I certify that this **BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** complies with the type-volume limits set forth in the Memorandum and 37 C.F.R. § 42.24 because it contains 7,977 words, excluding the parts of the Brief that are exempted by 37 C.F.R. § 42.24(a), according to the word processing system used to prepare this Brief.

Respectfully submitted,

Dated: April 22, 2025

By: /Brandon R. Theiss/
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*Counsel for Patent Owner
Intellectual Ventures II LLC*

CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** was served via email (as consented to by counsel) on April 22, 2025 to lead and backup counsel of record for Petitioner as follows:

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