

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

---

**PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW**

## TABLE OF CONTENTS

|                                                                                                                                                                                                                                                                                           |     |
|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-----|
| PATENT OWNER’S EXHIBIT LIST .....                                                                                                                                                                                                                                                         | iii |
| I. INTRODUCTION .....                                                                                                                                                                                                                                                                     | 1   |
| II. STATEMENT OF FACTS .....                                                                                                                                                                                                                                                              | 2   |
| A. The Petition And The Patent Owner Preliminary Response .....                                                                                                                                                                                                                           | 2   |
| B. Petitioner’s Pre-Institution Reply .....                                                                                                                                                                                                                                               | 3   |
| C. The Institution Decision .....                                                                                                                                                                                                                                                         | 6   |
| III. THE OFFICE HAS EMPHASIZED THE IMPORTANCE OF<br>CONSISTENCY BETWEEN THE CLAIM CONTRUCTION APPLIED IN<br>THE PTAB AND THE FEDERAL COURT, AND THE NEED TO<br>PREVENT CHALLENGERS FROM TAKING INCONSISTENT CLAIM<br>CONSTRUCTION POSTIONS BEFORE THE PTAB AND THE<br>FEDERAL COURT ..... | 9   |
| IV. EXCEPT IN LIMITED CIRCUMSTANCES NOT PRESENT HERE, THE<br>BOARD MUST DENY INSTITUTION IF IT CANNOT ASCERTAIN THE<br>SCOPE OF THE CHALLENGED CLAIMS WITH REASONABLE<br>CERTAINTY .....                                                                                                  | 11  |
| V. THE HOLDING IN <i>CAMBRIDGE</i> IS CONTRARY TO THE<br>INSTITUTION DECISION.....                                                                                                                                                                                                        | 13  |
| VI. CONCLUSION.....                                                                                                                                                                                                                                                                       | 15  |

## 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 20, 2020, enclosing copy of U.S. Pat. No. 7,181,143 and Claim Chart Presentation                                              |
| EX2006 | Sanger, T. D. “Optimal Unsupervised Learning.” Neural Networks vol. 2, pp. 459-473 (1989)                                                                                                                        |
| EX2007 | Declaration of Dr. Majumder In Support Of Patent Owner’s Preliminary Response.                                                                                                                                   |
| EX2008 | CV of Dr. Majumder                                                                                                                                                                                               |

## I. INTRODUCTION

Patent Owner hereby requests Director Review of the Board’s Decision Granting Institution of Inter Partes Review (Paper #13) (“the Institution Decision”) because the Board failed to follow *Cambridge Mobile Telematics, v. Sfara*, IPR2024-00952, Paper 12 (designated informative Mar. 20, 2025), or *Samsung Elecs. Am. Inc. v. Priusa Eng’g Corp.*, 948 F.3d 1342, 1355 (Fed. Cir. 2020) and *Intel Corp. v. Qualcomm Inc.*, 21 F.4th 801, 813 (Fed. Cir. 2021).

In the district court, Petitioner contends that a POSITA would not be able to ascertain the meaning of the claims, while Petitioner posits to the Board that a POSITA would understand the ordinary and customary meaning of the claims. Neither Petitioner, nor the Institution Decision, provided any explanation why inconsistent claim positions are warranted here, as required by *Cambridge*.

Petitioner emphasized in the district court that the claim language was indefinite because it has “multiple, equally plausible” interpretations, while before the Board, the Petitioner adopts only one of those “equally plausible” interpretations. Neither Petitioner nor the Board explained how it is logically possible for the Board to assess patentability over the prior art based on only one of “multiple, equally plausible” interpretations of the claim language, as required by *Samsung* and *Intel*.

For these reasons, the Institution Decision erred as a matter of law and should be vacated.

## II. STATEMENT OF FACTS

### A. The Petition And The Patent Owner Preliminary Response

Independent claim 1 of the ‘639 Patent recites “generating said target feature information from said data statistics” (hereinafter, the “Generating Limitation”). As explained in the Patent Owner Preliminary Response (Paper #8) (“POPR”), in the district court, Petitioner took the position that the Generating Limitation is *indefinite* because a POSITA would not be able to determine the “meaning and scope” of this limitation “with reasonable certainty.” EX2004, 227-228; POPR, 9-10.

By contrast, in this IPR, Petitioner stated “no claim term requires express construction” (Petition, 10), and Petitioner’s expert stated that each claim term should be given its *ordinary and customary meaning* in light of the specification and prosecution history:

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).

See, POPR, 10-11. Petitioner’s inconsistent claim construction positions in the district court and this IPR cannot be reconciled. POPR, 11. In the district court, Petitioner contends that a POSITA would not be able to ascertain the meaning of the claim language, while in this IPR, the Petition posits that such a person would understand the ordinary and customary meaning of the same claim language.

The Petition lacked any explanation why inconsistent positions were warranted in this case, or how the Board could assess the patentability of the challenged claims over the prior art if a POSITA would be unable to ascertain the meaning of the claim language with reasonable certainty.

## **B. Petitioner’s Pre-Institution Reply**

Petitioner filed a Pre-Institution Reply (Paper #11) (“Reply”), where Petitioner, once again, failed to address its contention in the district court that a POSITA would not be able to determine the “meaning and scope” of the Generating Limitation “with reasonable certainty.” EX2004, 227-228. Instead, the Reply pivoted to another argument that Petitioner advanced in the district court, namely, that “said target feature information” in claim 1 was indefinite because “it lacks antecedent basis and can potentially be interpreted in multiple ways.” Reply, 6; EX1070, 8-11. With respect to indefiniteness based on “lack of antecedent basis,” Petitioner emphasized to the district court:

The term “said target feature information” is indefinite because it lacks antecedent basis and can potentially be interpreted in multiple

ways. The claim language and specification provide multiple, equally plausible, ways to address the lack of antecedent basis, and the prosecution history only adds confusion. ...

There can be no dispute the term “said target feature information” lacks antecedent basis. The term refers to “said target feature information” even though the claims do not previously introduce “target feature information.” Thus, the term must be construed to correct the absence of an antecedent basis. But it is unclear how that can be accomplished because there are at least two ways to remedy the absence of antecedent basis and neither is more likely correct than the other. First, “said target feature information” could refer to “a target feature information,” which means the word “said” was drafted erroneously. This rewrite would introduce a concept (“target feature information”) to the claim that is not found in any of the other limitations. Second, “said target feature information” could refer to “said target specific feature information,” which would mean “specific” was omitted erroneously. This second rewrite would make all the “feature information” the same throughout the claim, but it would change the meaning of the term entirely. Neither option is more likely correct than the other in view of the intrinsic record and, thus, neither is appropriate. ...

Therefore, a POSITA would not know if “said target feature information” is intended to (i) introduce “target feature information” (another type of information distinct from and broader than the previously introduced “target specific feature information”), or (ii) refer back to the previously introduced “target specific feature information.” EX1070, 8-11 (citations omitted) (emphasis added).

Thus, with respect to “said target feature information,” Petitioner represented to the district court that the “claim language and specification provide multiple, equally plausible, ways to address the lack of antecedent basis, and the prosecution history only adds confusion.” EX2004, 227-228; EX1070, 8-11. While before the Board, the Petitioner adopts only one of those “equally plausible” interpretations. *Compare*, EX1070, 8-11 (Petitioner’s claim construction in the district court alleging

that it is equally plausible that “said target feature information” could refer to (i) “a target feature information” which would introduce a new concept (“target feature information”) into the claim, or (ii) “said target specific feature information”) *with* Institution Decision, at 11 (“the Petition assumes, for purposes of the unpatentability grounds presented herein, that ‘said target feature information’ recited in [1.3] is the ‘target specific feature information’ recited in [1.2], as well as [1.4] and [1.5]”)

In the Reply, Petitioner argued that its assertion that the claim language was indefinite in the district court was not inconsistent with its position that the same claim language be interpreted according to its plain and ordinary meaning in this IPR, “because Petitioner cannot raise indefiniteness challenges in this IPR.” Reply, 6. However, one does not follow from the other: the fact that Petitioner cannot raise indefiniteness in this IPR does not make Petitioner’s claim construction positions here and in the district court any less inconsistent.

In the Reply, Petitioner went on to argue:

... [E]ven if Petitioner’s claim construction positions are viewed as “inconsistent,” the Board has made clear that its “rules do not necessarily prohibit petitioners from taking inconsistent claim construction positions before the Board and a district court.” *Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper 12 at 8 (Dec. 13, 2024) (designated informative Mar. 20, 2025). Rather, *Cambridge* provides that if a petitioner is taking different claim construction positions in the IPR and parallel litigation, the petitioner should explain “why the inconsistent positions are warranted.” *Id.* Petitioner did that here, explicitly explaining how the claim terms of [1.3] and claim 7 were being interpreted “for purposes of the

unpatentability grounds presented [in the Petition].” Pet., 23 n.3; 36 n.4. Reply, 6-7 (emphasis added).

Focusing on the language underlined above, Petitioner's assertions that the claim language can be interpreted one way “for purposes of the unpatentability grounds presented [in the Petition],” and the opposite way in district court, demonstrate only the existence of Petitioner’s inconsistent positions. Absent is an explanation why inconsistent positions are warranted here. Also missing is an explanation how the Board could assess the patentability over the prior art based on only one interpretation of the claim language if, as Petitioner emphasized to the district court, “[t]he claim language and specification provide multiple, equally plausible” interpretations.” EX1070, 8.

### **C. The Institution Decision**

In the Institution Decision, the Board reasoned:

In the Petition, Petitioner contends that “no claim term requires express construction” for the purposes of this proceeding. Pet. 10.

In response, Patent Owner argues the Board should deny institution because “the Petition fails to satisfy the requirement to provide a clear and consistent articulation of how the challenged claims are to be construed” as “Petitioner’s claim construction theory in this proceeding rests on a meaning it disputes elsewhere.” Prelim. Resp. 11. More particularly, Patent Owner argues Dr. Rodriguez’s statement that the claims “are to be given their ordinary and customary meaning as would be understood by one of ordinary skill in the art” cannot be reconciled with Petitioner’s district court claim construction position, namely that the limitation reciting “generating said target feature information from said data statistics” in claim 1 is indefinite. *Id.* at 9–11 (quoting Ex. 1003 ¶¶ 38–39; Ex. 2004, 227–28).

Petitioner responds that its claim construction positions in the district court litigation are not inconsistent with the plain and ordinary meaning it applies here. Reply 5–6. Petitioner contends that in the district court litigation, it argued that “the term ‘said target feature information’ in claim 1 and the term ‘said feature information’ in dependent claim 7 are indefinite for lack of antecedent basis”—an argument Petitioner cannot raise in an *inter partes* review. *Id.* at 6.

We decline to deny institution based on Petitioner’s claim construction positions. The issue before us under 37 C.F.R. § 42.104(b) is whether the Petition provides Patent Owner sufficient notice of its claim construction and how Petitioner applies the asserted prior art in light of that construction. *10X Genomics, Inc. v. Bio-Rad Laboratories*, IPR2020-00086 Paper 8 at 18–19, 21 (PTAB Apr. 27, 2020). The Petition includes an analysis of each claim limitation of the challenged claims that shows how Petitioner is applying the prior art. *See, e.g.*, Pet. 23 n. 3 (citing Ex. 1003 ¶ 79) (explaining that “the Petition assumes, for purposes of the unpatentability grounds presented herein, that ‘said target feature information’ recited in [1.3] is the ‘target specific feature information’ recited in [1.2], as well as [1.4] and [1.5]”). *The difference in Petitioner’s construction in one forum versus another is not necessarily inconsistent, and the Board’s rules “do not necessarily prohibit petitioners from taking inconsistent claim construction positions before the Board and a district court.”* *Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper 12 at 8 (Dec. 13, 2024) (designated informative Mar. 20, 2025). As Petitioner notes (Reply 6), indefiniteness challenges cannot be raised in an *inter partes* review. *See* 35 U.S.C. § 311(b). *Moreover, indefiniteness “does not necessarily preclude the Board from addressing the patentability of the claims on section 102 and 103 grounds.”* *Samsung Elecs. Am. Inc. v. Priusa Eng’g Corp.*, 948 F.3d 1342, 1355 (Fed. Cir. 2020); *see also Intel Corp. v. Qualcomm Inc.*, 21 F.4th 801, 813 (Fed. Cir. 2021) (“The indefiniteness of a limitation . . . precludes a patentability determination only when the indefiniteness renders it logically impossible for the Board to reach such a decision.”) Institution Decision, 10-12 (emphasis added).

The Board erred in its analysis of Petitioner’s inconsistent claim construction positions, and its application of *Cambridge*, *Samsung Elecs.*, and *Intel* to the present

facts. Missing from the Board’s analysis was an acceptable rationale (as required by *Cambridge*) as to why inconsistent positions are warranted here. *Cambridge* held that where, as here, a Petitioner emphasized to the district court that the claim language was indefinite, the mere fact that a Petitioner cannot raise indefiniteness in an IPR (without more) is not an explanation why inconsistent positions are warranted.

In addition, the *Samsung* and *Intel* decisions relied on in the Institution Decision stand for the general rule that a claim cannot be both indefinite and invalid over the prior art. While the *Samsung* and *Intel* decisions identified two limited exceptions to that rule (neither of which even arguably applies here) and therefore found in those cases that indefiniteness does not necessarily preclude the Board from addressing patentability based on prior art, those decisions make clear that if the claim language is indefinite, the Board cannot proceed unless the circumstances logically permit application of the prior art to the claims. The Institution Decision fails to explain how it would be logically possible to apply the prior art to the claims if, as Petitioner contends in the district court: (i) a POSITA would not be able to determine the “meaning and scope” of the Generating Limitation “with reasonable certainty,” and (ii) with respect to “said target feature information,” the “claim language and specification provide multiple, equally plausible, ways to address the lack of antecedent basis, and the prosecution history only adds confusion.” EX2004, 227-228; EX1070, 8-11.

### **III. THE OFFICE HAS EMPHASIZED THE IMPORTANCE OF CONSISTENCY BETWEEN THE CLAIM CONSTRUCTION APPLIED IN THE PTAB AND THE FEDERAL COURT, AND THE NEED TO PREVENT CHALLENGERS FROM TAKING INCONSISTENT CLAIM CONSTRUCTION POSITIONS BEFORE THE PTAB AND THE FEDERAL COURT**

On October 11, 2018, the Office issued a Final Rule directed to “Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before The Patent Trial and Appeal Board.” 83 FR 51340, Docket No. PTO-P-2018-0036. Document No. 2018-22006 (“the Final Rule”). Prior to that time, “the PTAB construed unexpired patent claims and proposed substitute claims in AIA proceedings using the BRI standard.” *Id.* The Final Rule changed that practice by requiring the PTAB to “apply the same standard applied in federal courts to construe patent claims,” i.e., the standard articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), and its progeny. *Id.* In making the change, the Office found that “[m]inimizing differences between claim construction standards used in the various fora will lead to greater uniformity and predictability of the patent grant, improving the integrity of the patent system.” *Id.* (emphasis added). In the Final Rule, the Office found that “the possibility of differing constructions for the same claim term is troubling, especially when claim construction takes place at the same time in parallel district court proceedings and USPTO proceedings.” *Id.* (emphasis added).

In issuing the Final Rule, the Office stressed the importance that there be consistency between what occurs in the Federal Courts and the PTAB. For example,

the Final Rule explained that “[b]y maintaining consistency among the various proceedings, the integrity, predictability and reliability of the patent system is thus enhanced.” *Id.* at 51345, *see also*, 51346 (“applying the federal court claim construction standard in AIA proceedings” will “lead to greater consistency with the federal courts and the ITC, where such consistency will lead to greater certainty as to the scope of issued patent claims, but it will also help achieve the goal of increasing judicial efficiency”) (emphasis added).

In the Final Rule, the Office agreed “that harmonizing the claim construction standards would prevent parties from taking inconsistent positions.” *Id.* at 51347, (Comment 8 and Response) (emphasis added). In keeping with this goal, the Final Rule explained:

... With a uniform application of the Phillips standard, patent challengers will have less flexibility to advance inconsistent arguments about claim scope, and will instead be required to choose a single claim construction that best captures the true meaning of the patent claim, because they will not be able to justify different constructions as being the mere result of different claim construction standards.” *Id.* at 51350 (emphasis added).

\* \* \*

.. This will increase the likelihood that claims are not argued one way in order to maintain their patentability (or to show that the claims are unpatentable) and in a different way against an opposing party in an infringement case, ... *Id.* at 51350, (emphasis added).

#### **IV. EXCEPT IN LIMITED CIRCUMSTANCES NOT PRESENT HERE, THE BOARD MUST DENY INSTITUTION IF IT CANNOT ASCERTAIN THE SCOPE OF THE CHALLENGED CLAIMS WITH REASONABLE CERTAINTY**

As a general rule, a claim cannot be both indefinite and invalid over the prior art. *Enzo Biochem, Inc. v. Applera Corp.*, 599 F.3d 1325, 1332 (Fed. Cir. 2010) (“a claim cannot be both indefinite and anticipated”). In *Samsung*, the Court reiterated this general rule by stating that if the Board “cannot ascertain the scope of a claim with reasonable certainty for purposes of assessing patentability,” the “proper course for the Board to follow ... is to decline to institute the IPR.” *Samsung*, 942 F.3d 1342, 1353. In *Samsung*, the Court identified a potential exception to the general rule that a claim cannot be both indefinite and invalid over the prior art. There, the challenger asserted that the claim in question was indefinite because the claim combined two statutory classes, namely, an apparatus and a method. *Id.*, 1349, 1353.<sup>1</sup> The Court explained that the mere fact that the claim combined two statutory classes “does not speak to whether the claim is also invalid for obviousness, regardless of whether it is treated as being directed to an apparatus or a method.” *Id.*, 1355. Based on those facts, the Court held that the indefiniteness “does not necessarily” preclude the Board for addressing patentability based on anticipation

---

<sup>1</sup> In *IPXL Holdings, LLC v. Amazon.com, Inc.*, 430 F.3d 1377, 1883-1384 (Fed. Cir. 2005), the Court held that “a single claim covering both an apparatus and a method of use of that apparatus is invalid” based on indefiniteness.

or obviousness, and remanded the case to the Board to address whether it was possible to assess invalidity based on prior art in that limited situation. Significantly, the Court in *Samsung* explained that its decision was “limited to IPXL-type indefiniteness and does not affect claims that are indefinite for other reasons.” *Id.*, 1356, note 5. In so doing, the Court cited its decision in *Enzo Biochem* stating that “a claim cannot be both indefinite and anticipated.” *Id.*, citing, *Enzo Biochem*, 599 F.3d 1325, 1332.

In *Intel*, the Court reiterated that the statutory obligation to issue a final written decision “does not mean that the Board must reach a determination of the patentability of a claim on the presented prior-art grounds if such a determination is rendered impossible because of the indefiniteness of an essential claim limitation.” *Intel*, 21 F. 4th 801, 812. Citing the narrow exception addressed in *Samsung*, the Court noted that “it is not always impossible to adjudicate a prior-art challenge, one way or the other, just because some aspect of a claim renders the claim indefinite. *Id.* Then, the Court articulated further situations where indefiniteness “does not necessarily preclude the Board from addressing the patentability of the claims on section 102 and 103 grounds”:

... For example, the indefiniteness of one limitation may not preclude the Board from rejecting a challenge by finding that another limitation is missing from the argued prior art and its argued combinations and modifications. In the other direction, if a claim limitation requires alternative limitations A or B, and A is indefinite, but B is not, the Board may well be able to determine that the argued prior art and its

argued combinations or modifications cover the B option, thus satisfying the A or B limitation. *Id.* (emphasis added).

The Court's decisions in *Samsung* and *Qualcomm* do not diminish the general proposition that a claim cannot be both indefinite and invalid over the prior art. *Enzo Biochem*, 599 F.3d 1325, 1332. Rather, those cases articulate limited exceptions to that general rule, none of which are present here.

Neither *Samsung* nor *Qualcomm* even remotely suggest that where, as here, a Petitioner emphasized to the district court that there are “multiple, equally plausible” interpretations” of the claim language, it would be logically possible for the Board to assess patentability by applying the prior art to only one of such “multiple, equally plausible” interpretations. That is because it is not logically possible to assess patentability by applying the prior art to only one of “multiple, equally plausible” interpretations. Neither the Petition nor the Institution Decision provide any explanation to the contrary.

## **V. THE HOLDING IN *CAMBRIDGE* IS CONTRARY TO THE INSTITUTION DECISION**

In *Cambridge*, the Petitioner argued in parallel district court proceedings that several terms in the challenged claims “should be means-plus-function terms governed by §112(f) and that such terms are indefinite for failure to identify corresponding structure to perform the recited functions.” *Cambridge*, IPR2024-00952, Paper #12 , at 7 (emphasis added). However, in the IPR the Petitioner took a

contrary position that the claim terms should be given their “plain and ordinary meaning ... consistent with Patent Owner’s litigation position.” *Id.*, at 7 (emphasis added). In denying institution, the Board reasoned:

Under these facts we determine that 37 C.F.R. § 42.104(b)(3) mandates that the Petition “identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function.” The Petition failed to do so. At a minimum, the Petition should have explained why the plain and ordinary meaning of the “component” terms should apply in this proceeding (why the inconsistent positions are warranted) or set forth an alternative means-plus-function claim construction. CTPG 45.

While the Board clarified that Petitioners are “not necessarily” prohibited from taking inconsistent claim constructions, the Board made clear that the Petition must explain why inconsistent positions are warranted. The holding of *Cambridge* makes clear that where a Petitioner asserts in district court that a claim term is indefinite, the Petition is deficient if it merely argues that the Board in the IPR should apply the “plain and ordinary meaning” of the term. The present Petition is on all fours with *Cambridge*, because the present Petitioner asserts in district court that claim terms are indefinite, and merely argues that the Board in the IPR should apply the “plain and ordinary meaning” of the term because a Petitioner cannot allege indefiniteness in an IPR (a constraint also present in *Cambridge* and every other IPR). Under *Cambridge*, the fact that a Petitioner cannot allege indefiniteness in an IPR standing alone does not suffice for explaining why inconsistent positions are warranted.

## VI. CONCLUSION

In rule making, the Office has stressed the need for consistency between what occurs in the Federal Courts and the PTAB, and the importance of requiring challengers to choose a single claim construction. Consistent with those policies, the Board in *Cambridge* declined to institute and stated that when a Petition presents inconsistent positions, an IPR can only go forward if the Petition presents an explanation why the circumstances warrant doing so. No such explanation was present here, and the Institution Decision therefore erred as a matter of law in allowing this IPR to proceed.

Moreover, as a general matter, a claim cannot be both indefinite and invalid over the prior art. While there may be limited exceptions to this rule, *Samsung* and *Qualcomm* explain that those exceptions are limited to situations where, despite the indefiniteness, it is still logically possible for the Board to assess patentability over the prior art. The Institution Decision here failed to provide any explanation how it is logically possible for the Board to assess patentability by applying the prior art to only one of “multiple, equally plausible” interpretations, and as a practical matter it is not logically possible to do so. For this additional reason, the Institution Decision erred as a matter of law in allowing this IPR to proceed.

For these reasons, the Institution Decision should be vacated and institution of the IPR should be denied.

Respectfully submitted,

Dated: September 5, 2025

By: /Brandon R. Theiss/  
Brandon R. Theiss  
Registration No. 70,507  
*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 **PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW** was served via email (as consented to by counsel) on September 5, 2025 to lead and backup counsel of record for Petitioner as follows:

Jonathan R. Bowser  
[jon.bowser.ipr@haynesboone.com](mailto:jon.bowser.ipr@haynesboone.com)  
HAYNES AND BOONE, LLP  
2801 N. Harwood Street, Suite 2300  
Dallas, TX 75201

Gregory P. Webb  
[greg.webb.ipr@haynesboone.com](mailto:greg.webb.ipr@haynesboone.com)  
HAYNES AND BOONE, LLP  
2801 N. Harwood Street, Suite 2300  
Dallas, TX 75201

Scott T. Jarratt  
[scott.jarratt.ipr@haynesboone.com](mailto:scott.jarratt.ipr@haynesboone.com)  
HAYNES AND BOONE, LLP  
2801 N. Harwood Street, Suite 2300  
Dallas, TX 75201

Matthew Beck  
[matthew.beck.ipr@haynesboone.com](mailto:matthew.beck.ipr@haynesboone.com)  
HAYNES AND BOONE, LLP  
2801 N. Harwood Street, Suite 2300  
Dallas, TX 75201

Paul Margulies  
[pmargulies@tesla.com](mailto:pmargulies@tesla.com)  
TESLA, INC.  
1 Tesla Road  
Austin, Texas 78725

Dated: September 5, 2025

By: /Brandon R. Theiss/  
Brandon R. Theiss  
Registration No. 70,507  
*Counsel for Patent Owner*  
*Intellectual Ventures II LLC*