

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

IPR2025-00340
U.S. Patent No. 6,894,639

**PETITIONER'S REQUEST FOR REHEARING OF THE
DIRECTOR REVIEW DECISION UNDER 37 C.F.R. § 42.71(d)**

I. Introduction

Petitioner Tesla, Inc. (“Tesla”) requests rehearing under 37 C.F.R. § 42.71(d)¹ of the Director’s Order Granting Director Review, Vacating the Decision Granting Institution, and Denying Institution of *Inter Partes* Review (“Order”) (Paper 18). The Order misapprehends or overlooks the fact that Tesla was never given an opportunity to address *Revvo Techs.*, which “clarifies how a petitioner should approach different claim construction positions and how the Office will assess those positions.” *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20, 5 (Director Nov. 3, 2025) (precedential). Rather than terminate an instituted IPR based on a new precedential decision that Tesla did not have an opportunity to address, the Director should instead remand this IPR to the Board for the parties to submit additional briefing to address the impact of *Revvo Techs.* on this proceeding, consistent with the Director’s guidance in *Revvo Techs.*

Further, the Order misapprehends or overlooks the fact that the Order

¹ Director Review Process, <https://www.uspto.gov/patents/ptab/decisions/director-review-process>, § 5.C.ii (“Within the time frame allotted under 37 C.F.R.

§ 42.71(d), a party ... dissatisfied with a Director Review decision may file a

conflicts with the Federal Circuit's precedential decision in *Intel Corp. v. Qualcomm Inc.*, holding that "[t]he indefiniteness of a limitation . . . precludes a patentability determination **only when** the indefiniteness renders it **logically impossible** for the Board to reach such a decision." *Intel Corp. v. Qualcomm Inc.*, 21 F.4th 801, 813 (Fed. Cir. 2021). Here, the Board found it possible to reach—and in fact did reach—a patentability determination in the Institution Decision.

II. Tesla was never given an opportunity to address *Revvo Techs.*

The Order faulted Tesla for failing to comply with the new requirements of the *Revvo Techs.* decision that issued just two days before the Order and long **after** the Petition was filed and trial was instituted. Order (issued Nov. 5, 2025), 3 (citing *Revvo Techs.*, which issued on Nov. 3, 2025). The Order relied on a new requirement set forth in *Revvo Techs.* that did not previously exist. Specifically, the Order explained that "when a petitioner advances different positions before the Board and a district court, that petitioner is *required* to explain why those different positions are warranted. . . . Here, Petitioner's statement that it cannot raise indefiniteness challenges in an *inter partes* review is not a sufficient explanation." Order 3 (citing *Revvo Techs.*, IPR2025-00632, Paper 20 at 3–5 (emphasis

single request for rehearing without prior authorization, and that party carries the burden of showing the Director Review decision should be modified.").

original)).

However, *Revvo Techs.* explicitly recognized that “[b]ecause this decision clarifies how a petitioner should approach different claim construction positions and how the Office will assess those positions, the appropriate course of action is to ... remand the case to the Board” and the “Board may authorize additional briefing, as necessary, to determine whether Petitioner has provided a sufficient reason why different claim construction positions are warranted.” *Revvo Techs., Inc.*, Paper 20, 5. The Board in *Revvo Techs.* granted both parties “a brief up to twelve (12) pages” to address the Office’s new approach. *Revvo Techs.*, IPR2025-00632, Paper 22, 2. Here, contrary to *Revvo Techs.*, Tesla was never given the opportunity to address the Office’s new approach for assessing different claim construction positions. In other words, Tesla was denied “the appropriate course of action” set forth in *Revvo Techs.* Not allowing Tesla the opportunity to address *Revvo Techs.*’ new requirement to explain why different claim construction positions are warranted contradicts the notice and opportunity requirements of the Administrative Procedure Act. *See* 5 U.S.C. §§ 554(b)-(c), 702.

Remand is not only procedurally appropriate, but also substantively appropriate. Tesla’s situation satisfies at least two of the specific examples provided by the Director as to when different claim constructions are warranted. First, the Director noted that a petitioner’s explanation for different claim

constructions may have risen to a sufficient level when “notwithstanding the alleged indefiniteness of the claim term, an ordinarily skilled artisan would understand that the asserted art satisfies the claim limitation.” Order, 3-4. In this IPR, Tesla showed that—despite the potential indefiniteness—a person of ordinary skill in the art would have understood that the challenged claims are obvious over the prior art. The Board preliminarily agreed in instituting this IPR. Second, the Director noted that a petitioner may rely on different claim construction positions when a district court declines to adopt a party's construction and that party advances the court-adopted construction in the proceeding before the Board. *Revvo Techs.*, Paper 20, 5 (citing *Sun Pharm. Indus. Inc. v. Nivagen Pharm., Inc.*, IPR2025-00893, Paper 18 at 3 (Director Sept. 19, 2025)). That is precisely the situation here. At the *Markman* hearing in the parallel proceeding, the district court adopted Patent Owner's proposed plain and ordinary meaning construction.² In the

² While the district court has not yet issued a formal *Markman* order, the district court adopted Patent Owner's plain and ordinary meaning construction at the *Markman* hearing. Transcript of Markman Hearing, *Intellectual Ventures II, LLC v. Tesla, Inc.*, 1:24-cv-884-ADA, ECF No. 84, 41:13-24 (The Court stated, “I'm going to maintain our preliminary constructions,” which were “Plain and ordinary meaning. Not indefinite.”) (WDTX) (April 10, 2025).

Institution Decision (“ID,” Paper 13), the Board applied the same plain and ordinary meaning construction adopted by the district court. ID, 11-12.

Accordingly, Tesla should be able to rely on the construction adopted by the district court in this IPR because there is no risk of inconsistent claim construction decisions between this IPR and the district court proceeding, furthering the Office’s stated goal of “providing greater predictability and certainty in the patent system.” *Revvo Techs.*, Paper 20, 4-5.

The Order overlooks that Tesla was not given a chance to address the Office’s new approach on remand, which the Director deemed “the appropriate course of action.” Moreover, the Order overlooks that the circumstances of the present case are consistent with the examples provided by the Director as to when different claim construction positions are warranted. Accordingly, rehearing should be granted and, consistent with *Revvo Techs.*, the case should be remanded to the Board for briefing by the parties on this issue.

III. The Order conflicts with Federal Circuit Precedent

The Order also misapprehends or overlooks that it is in direct conflict with the Federal Circuit's precedential decision in *Intel Corp. v. Qualcomm Inc.*, 21 F.4th 801 (Fed. Cir. 2021). In *Intel*, the Federal Circuit held that "[t]he indefiniteness of a limitation . . . precludes a patentability determination **only when** the indefiniteness renders it **logically impossible** for the Board to reach such a decision." *Id.* at 813; Paper 16 at 5 (citing *Intel*, 21 F.4th at 813). Here, the Order misapprehends or overlooks the controlling *Intel* decision as well as the fact that the Board was able to apply the prior art to the claims in the Institution Decision ("ID," Paper 13). ID, 11-12, 26-28.

The Order fails to address its fundamental conflict with *Intel*. In fact, the Order does not address any of the controlling Federal Circuit precedential decisions regarding the interplay between indefiniteness and IPRs, including *Intel* and *Samsung Elecs. Am. Inc. v. Priusa Eng'g Corp.*, 948 F.3d 1342, 1355 (Fed. Cir. 2020). Paper 16 at 5 (citing *Samsung*, 948 F.3d at 1355; *Intel*, 21 F.4th at 813). As explained in Petitioner's Authorized Response to Patent Owner's Director Review Request (Paper 16), the Federal Circuit has repeatedly held that "indefiniteness does not preclude the Board from addressing patentability." Paper 16, 9-10 (citing *Samsung*, 948 F.3d at 1355 and *Intel*, 21 F.4th at 813). More specifically, *Intel* requires it to be "logically impossible" for the Board to render a

patentability determination before indefiniteness will preclude such a determination. *Intel* at 813.

Here, the Board showed that it was possible to apply the prior art to the claims in the Institution Decision and preliminarily determined the prior art teaches the claim limitation. ID, 11-12. In instituting review, the Board thus showed that it is **not** logically impossible to address patentability despite the alleged indefiniteness of the challenged claims. Accordingly, the Board's analysis and determination in the Institution Decision satisfies the requirements of *Intel* for addressing patentability (i.e., it is **not** logically impossible to determine patentability). Further, the Board's analysis in the Institution Decision also shows that, notwithstanding the alleged indefiniteness of the claim term, an ordinarily skilled artisan would understand that the asserted prior art satisfies the claim limitation. Therefore, the Board's analysis and determination in the Institution Decision also satisfies the new requirements of *Revvo Techs.*

Accordingly, rehearing should be granted and, consistent with *Intel* and *Revvo Techs.*, the case should be remanded to the Board for briefing by the parties on this issue.

IV. Conclusion

In summary, the Order misapprehends or overlooks that Tesla was never given an opportunity to address the new requirements of *Revvo Techs.* and that the Order conflicts with the Federal Circuit's precedential decision in *Intel*.

Petitioner respectfully requests that the Director reconsider the Order, grant rehearing, and remand to the Board for briefing by the parties.

Respectfully submitted,

Dated: December 5, 2025
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CERTIFICATE OF SERVICE

The undersigned certifies, under 37 C.F.R. § 42.6, that service was made on the Patent Owner as detailed below.

Date of service December 5, 2025

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