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. IPR2025-00342
U.S. Patent No. 7,336,805

SUPPLEMENTAL PATENT OWNER'S RESPONSE

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PATENT OWNER'S EXHIBIT LIST

EX2001	Petitioner's Answer to Complaint and Counterclaim, dated June 20, 2024, in *Intellectual Ventures II LLC v. Tesla, Inc*., C.A. 1:24-cv-00884-ADA (W.D. Tex.)
EX2002	Docket from District Court Litigation, *Intellectual Ventures II LLC v. Tesla, Inc*., C.A. 1:24-cv-00884-ADA (W.D. Tex.)
EX2003	Scheduling Order from District Court Litigation, *Intellectual Ventures II LLC v. Tesla, Inc*., 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, *Intellectual Ventures II LLC v. Tesla, Inc*., 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	R. Sedgewick, Algorithms in C, Addison-Wesley Pub. Comp. Inc., 1990
EX2007	Declaration of Dr. Majumder In Support Of Patent Owner's Preliminary Response.
EX2008	CV of Dr. Majumder
EX2009	Ninomiya et al., U.S. Patent No. 5,220,508
EX2010	Declaration of Dr. Majumder In Support Of Patent Owner's Response.

I. THE BOARD SHOULD FOLLOW *REVVO* AND *TESLA* AND VACATE THE INSTITUTION DECISION BECAUSE THE PETITION FAILED TO EXPLAIN WHY INCONSISTENT CLAIM CONSTRUCTION POSITIONS WERE WARRANTED

The Petition failed to inform the Board that Petitioner was taking inconsistent claim construction positions. In the district court, Petitioner alleges that the following two limitations in claim 1 are indefinite: (i) "may at least partially describe a potential destination" and (ii) "potential geometric objects for plausibility using a matching algorithm to identify one or more possible objects." Ex. 1060, 3. Petitioner's indefiniteness allegations in the district court cannot be reconciled with Petitioners' assertion that, "[f]or purposes of this proceeding" (in which Petitioner purports to map the alleged indefinite limitations to the prior art), "no claim term requires express construction." Petition, 7, 43-48. Petitioner's claim construction positions are clearly inconsistent because a claim term cannot be both indefinite and, at the same time, have an ordinary and customary meaning under *Phillips*.

Recently, in *Revvo Technologies v. Cerebrum Sensor Technologies*, IPR2025-00632, Paper 20 (Nov. 3, 2025) (precedential) and *Tesla. v. Intellectual Ventures II,* IPR2025-00340, Paper 18 (Nov. 5, 2025) (informative), the Director vacated two institution decisions for failing to follow the holding of *Cambridge Mobile Telematics, v. Sfara,* IPR2024-00952, Paper 12 at 8-9 (PTAB 2024) (informative) that "when a petitioner advanced different positions before the Board and a district court, that petitioner is ***required*** to explain why alternate positions are warranted."

Tesla, IPR2025-00340, Paper 18, at 3 (emphasis in original). As was the case in *Revvo* and *Tesla*, the present Petition is *deficient on its face* for failing to offer *any* explanation why inconsistent claim construction positions are warranted.[1] The Board should therefore follow *Revvo* and *Tesla* and vacate the Institution Decision in this case.

II. THE PETITION ALSO FAILED TO EXPLAIN HOW IT WOULD BE LOGICALLY POSSIBLE TO APPLY THE PRIOR ART TO ALLEGEDLY INDEFINITE CLAIMS

The Petition also failed to explain how this case fit into any of the narrow exceptions that make it "logically possible" to apply the prior art to a claim alleged to be indefinite. In *Intel Corp. v. Qualcomm*, 21 F.4th 801 (Fed. Cir. 2021) and *Samsung Elecs., v. Priusa Eng'g,* 948 F.3d 1342 (Fed. Cir. 2020), the Court identified two exceptions to the rule forbidding application of the prior art to an indefinite claim where the prior art can be applied in a way that completely avoids the indefinite aspect of the claim, thereby making it "*logically possible*" for the Board to address patentability based on prior art:

> ... For example, ... 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. *Intel*, 21 F.4th at 812.

[1] The inability to argue indefiniteness in an IPR is *insufficient* to explain why inconsistent positions are warranted. *Tesla,* IPR2025-00340, Paper 18, at 3.

Thus, it may be logically possible to adjudicate obviousness where "A is indefinite, but B is not" by entirely side stepping the alleged indefiniteness of "A" and simply mapping the prior art to "B" which was not indefinite. Similarly, in *Samsung*, the Court identified a further narrow exception where the indefiniteness results from the claim spanning both the apparatus and method classes. There, the indefiniteness "does *not necessarily*" preclude the Board from addressing patentability because the challenger might be able to demonstrate that the prior art satisfied the claim, *regardless* of whether the claim was treated as an apparatus or a method, thereby making it "logically possible" to apply the asserted art to the claim. *Samsung*, 942 F.3d at 1349-1355.

In *Tesla*, the Director suggested another situation where the indefinite aspect of the claim might be avoided -- thereby making it logically possible for the Board to adjudicate obviousness -- if, "the limitation prescribed a range and only the bounds of the range were unclear." *Tesla, Inc*., IPR2025-00340, Paper 18, at 3-4.

Here, the Petition failed to explain at the outset how the present facts fit into any of the exceptions set forth in *Intel*, *Samsung* and *Tesla*, and now that the trial has advanced to the point where Patent Owner's Response and the supporting Declaration of Patent Owner's Expert (Ex. 2010) have been submitted, it is too late for Petitioner to offer such an explanation. It would be fundamentally unfair for Petitioner to be allowed to *first* present an explanation arguing why it is "logically

possible" to apply the prior art to allegedly indefinite limitations at this point in the trial when Patent Owner cannot counter Petitioner's belated arguments with responsive evidence such as a further Expert Declaration or exhibits. 37 CFR 42.23(b) (precluding submission of evidence by Patent Owner with Sur-Reply).

III. PETITIONER'S WAIVER AND MOOTNESS ARGUMENTS ARE WITHOUT MERIT

Petitioner has suggested that Patent Owner waived the issue of Petitioner's inconsistent positions by not raising it earlier. However, as the Board explained in *American Airlines and Southwest Airlines v. Intellectual Ventures I LLC*, IPR2025-01055, Paper #11, at 13 (PTAB November 21, 2025) (routine opinion), the Petitioner has a "duty of candor and good faith to the Office during the course of a proceeding pursuant to 37 C.F.R. § 42.11," and "Patent Owner should not have been the first party to inform the Board as to Petitioner's different claim construction positions in the two forums." It would be wrong to reward Petitioner's concealment. Further, there is also no prejudice to allowing Patent Owner to raise the issue now, as Petitioner has been granted an opportunity to respond to Patent Owner's present submission.

Petitioner has also suggested that a remark by the district court during the *Markman* hearing renders Petitioner's inconsistent positions moot, even though the district court has not issued a *Markman* Order. Patent Owner disagrees. Had the Petitioner done what was required and candidly identified *in the Petition* that

Petitioner was taking inconsistent claim construction positions, the issue of inconsistent positions would have been judged at the time of the institution decision and the institution would have been denied because no justification for inconsistent positions was set forth in the Petition. Moreover, Petitioner's inconsistent positions will *not* be mooted even if the district court rejects the alleged indefiniteness, because the issue will remain a subject for appeal where Petitioner can again advance its inconsistent indefiniteness position.

Allowing these proceedings to continue if the district court were to reject Petitioner's indefiniteness theory would only further encourage Petitioners to take inconsistent claim constructions before the institution decision, because doing so would be advantageous to the Petitioner regardless of the district court's ruling, i.e., if, after the institution decision, the district court finds the claim indefinite then the Petitioner has won and the IPR is of no consequence; while, if, after the institution decision, the district court finds the claim is not definite, Petitioner can proceed with the IPR based on a construction that was inconsistent at the time of the Petition. Permitting such gamesmanship will not further the policy of "providing greater predictability and certainty in the patent system. *Revvo*, IPR2025-00632, Paper 20, at 4, *citing*, 83 FR 51342-43. The Board should therefore follow *Revvo* and *Tesla* and vacate the Institution Decision in this case for failing to explain at the outset why inconsistent positions were warranted.

Respectfully submitted,

Dated: December 17, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **SUPPLEMENTAL PATENT OWNER'S RESPONSE** was served via email (as consented to by counsel) on December 17, 2025 to lead and backup counsel of record for Petitioner as follows:

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