

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORD MOTOR COMPANY
Petitioner,

v.

SAFE DRIVING TECHNOLOGIES LLC
Patent Owner.

IPR2021-01353
Patent 10,532,709 B2

Before SCOTT C. MOORE, RYAN H. FLAX, and BRENT M. DOUGAL,
Administrative Patent Judges.

FLAX, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

Ford Motor Company (“Petitioner”) filed a Petition for *inter partes* review challenging claims 1–7 and 14–16 of U.S. Patent 10,532,709 (“the ’709 patent”). Paper 1 (“Pet.”). Safe Driving Technologies LLC is the Patent Owner. *See* Paper 4. On February 10, 2022, we instituted trial in this proceeding. Paper 9 (“DI”).

There are several other matters related to this proceeding, including other *inter partes* reviews, including IPR2021-01341, which is scheduled to have a final hearing on November 14, 2022. *See* DI 3; *see also* Scheduling Order (Paper 12) in that proceeding. November 14, 2022, is also the scheduled date for the final hearing in this proceeding. Paper 10. On September 29, 2022, Petitioner requested oral argument in this proceeding. Paper 12. Subsequently, on October 25, 2022, via a series of emails, Patent Owner indicated that “Patent Owner has not filed a Patent Owner Response (“POR”) in this matter (or other papers beyond a Preliminary Patent Owner response (“PPOR”)) and desires to dedicate the subject matter of the challenged claims (claims 1-7 and 14-16) to the public” and also that “Patent Owner intends to file a disclaimer for claims 1-7 and 14-16.” Ex. 3002.

At the same time, in a related responsive email to the parties, we stated:

Regarding Patent Owner’s email of October 25, 2022, indicating that it desires to dedicate the subject matter of the challenged claims 1-7 and 14-16 to the public, if Patent Owner intends to file a statutory disclaimer directed to these claims, which we will treat as a request for adverse judgement and terminate the proceeding, it should immediately inform the Board. If Patent Owner elects not to file a statutory disclaimer, this email request shall be treated as a request for adverse judgement under 37 C.F.R. § 42.73(b)(2) and the Board will issue an order in due course terminating the proceeding in

IPR2021-01353 and determining that claims 1-7 and 14-16 have been shown to be unpatentable on all asserted grounds.

Id.

As noted above, Patent Owner indicated (in response to our statement) that it intends to file a statutory disclaimer to the challenged claims; however, the Board has not been informed that such a disclaimer has been filed nor do we discern any evidence of such in the Office's records.

In view of the approaching scheduled oral argument in the related *inter partes* review and the contemporaneously scheduled final hearing in this proceeding, we order Patent Owner to immediately file, if it still intends to do so, the aforementioned statutory disclaimer in the record of the '709 patent and inform the Board of such filing. This certification to the Board shall be accomplished by Patent Owner no later than November 9, 2022.

If we do not receive notice by Patent Owner of the statutory disclaimer's filing by this date, Patent Owner's October 25, 2022 email (Ex. 3002) shall be treated as a request for adverse judgement under 37 C.F.R. § 42.73(b)(2) and the Board will issue an order in due course terminating this proceeding and determining that claims 1-7 and 14-16 have been shown to be unpatentable on all asserted grounds. Moreover, in view of Petitioner's request for oral argument, absent such a certification by Patent Owner, Petitioner shall be allotted time at the scheduled final hearing on November 14, 2022, to present oral argument in this matter.

ORDER

Accordingly, it is hereby:

ORDERED that Patent Owner shall inform the Board no later than November 9, 2022, that it has filed a statutory disclaimer to the claims of the '709 patent challenged in this proceeding;

FURTHER ORDERED that, if Patent Owner does not make the aforementioned certification, Patent Owner's October 25, 2022 email (Ex. 3002) shall be treated as a request for adverse judgement under 37 C.F.R. § 42.73(b)(2); and

FURTHER ORDERED that, if Patent Owner does not make such the aforementioned certification, Petitioner shall be allotted time during the scheduled November 14, 2022, final hearing to present oral argument in this proceeding.

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For PETITIONER:

John S. LeRoy
Christopher C. Smith
John P. Rondini
BROOKS KUSHMAN P.C.
FPGP0136IPR@brookskushman.com
jleroy@brookskushman.com
csmith@brookskushman.com
jrondini@brookskushman.com

For PATENT OWNER:

Michael E. Shanahan
Scott H. Kaliko
YK LAW LLP
pattman2@gmail.com
skaliko@yklaw.com