

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORD MOTOR COMPANY,
Petitioner,

v.

SAFE DRIVING TECHNOLOGIES LLC,
Patent Owner.

U.S. Patent No. 10,532,709 to Naboulsi

Case No.: IPR2021-01353

PATENT OWNER'S PRELIMINARY RESPONSE

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37 C.F.R. § 42.65	35

EXHIBIT LIST

Exhibit No.	Description
2001	SDT Initial Infringement Contentions `709, `108, `994, `170 Patents
2002	SDT Document Requests with Petitioner Ford's Responses
2003	Email from Mr. Smith, Ford's Counsel, re Source Code
2004	Email from Mr. LeRoy regarding Scheduling Order
2005	Draft Scheduling Order April 12, 2021
2006	Ford's Invalidity Contentions Excerpts for the `709 Patent
2007	Declaration of Mr. Mouhamad Naboulsi
2008	2004 Email to Ford Employee, Mr. Wu, with License Terms and Response
2009	List of Patents Prosecuted by Brooks Kushman citing `108 Naboulsi Patent
2010	Exemplary Brooks Kushman IDS (2) Citing `108 Patent

2011	Ford Global Technologies (FGT) is a Subsidiary of Petitioner Ford
2012	USPTO Office Action Citing `108 Patent
2013	US Patent 9,457,816
2014	Ford Aerospace is a Subsidiary of Petitioner Ford

Pursuant to 35 U.S.C. § 313.37 C.F.R. § 42.107 and the Notice of Filing Date Accorded to Petitioner, dated August 19, 2021, Safe Driving Technologies, LLC (“SDT” or “Patent Owner”) hereby timely submits its Preliminary Response to the Petition for *Inter Partes* Review of U.S. Patent No. 10,532,709 (“’709”) filed by Ford Motor Company (“Ford” or “Petitioner”).

I. INTRODUCTION

The Board should not institute review because all *Fintiv* factors weigh against such institution including the merits of the Petition (*Apple Inc. v. Fintiv, Inc.*, IPR2020-00019).

The instant Petition is one of four related Petitions filed by Ford including IPR2021-01341, IPR 2021-01446, and IPR2022-00086 related to District Court case *Safe Driving Technologies LLC v. Ford Motor Company*, No. 21-cv-64-MN (referred to herein as “the Litigation” or the “Underlying Litigation”). At issue are U.S. Patent Nos. 8,301,108 (the “’108”), 9,047,170 (the “’170”) and 9,713,994 (the “’994”) together with the ‘709, collectively referred to herein as the “Challenged Patents” all of which share a substantially common specification.

The first two Petitions (01341 and 01353), are directed to a minority of the claims (18 of 54) in the Challenged Patents and, even if instituted, will not be resolved until during trial or a mere 5 days before trial. The last two Petitions (01446 and 00086), directed to the majority of claims in the Challenged Patents (36 of 54),

will not be resolved until after trial, with the final Petition (00086), having 20 of 54 claims challenged not being resolved until well after trial (approximately three months after¹). Petitioner Ford provides no explanation as to why it waited so long to file its four Petitions, even though they rely on many of the same references. Moreover, both Ford and its attorneys of record on this matter were well aware of and had detailed information and licensing interactions regarding Patent Owner's portfolio, including at least for the '108 patent (the parent case) for years before the Litigation and the Petitions' filing dates.

This concern is further exacerbated by other *Fintiv* related factors. For example, Ford provides no specific claim constructions to guide the Board, contending Plain and Ordinary meaning applies, with no further guidance or explanation. But, in some key instances, with no helpful disclosure in the prior art itself, Ford attempts to redefine certain well understood claim terms through the use of expert testimony which seeks to "rewrite" the prior art references to create features completely missing based on the extensive use of hindsight reconstruction. In other instances, Ford simply ignores the definition of certain claim terms provided in the specification, as required by the *Phillips* standard in order to justify arriving at its incorrect conclusion. Ford provides no adequate explanation as to why the

¹ On or about May 19, 2023.

Board should accept Ford's flawed "Plain and Ordinary" meaning for these claim terms, when it conflicts with the '709 specification.

Furthermore, because of the timing of Ford's Petitions, a Stay will likely not be considered by the District Court until most, if not all, asserted claims have an institution determination. For example, a Stay will likely not be granted based on the outcome of this Petition because it only addresses 10 of 54 challenged claims (and merely 7 of 46 claims asserted in the Litigation). In fact, until a determination of last-filed Petition (IPR2022-0088) issues, - related to the final 20 of the 46 asserted claims in the Underlying Litigation - a Stay will not be seriously considered. By then, the procedural posture of the litigation will have significantly advanced to the point where fact discovery is complete, final contentions exchanged, Markman briefing complete, with expert discovery well underway with trial less than about 9 months from the filing of any grantable Stay request. In addition, the Defendant in the Litigation and Petitioner are the same entity and the Petitions and the Litigation deal with substantially the same invalidity issues (all 46 asserted claims challenged).

Lastly, the technical merits of Petitioner's arguments have significant weaknesses which render them unconvincing. For example, Petitioner does not appear to use the definition of the claim term "telematics" provided in Patent Owner's specification and chooses instead to use a definition suitable for its needs despite it being legally unsupportable under *Phillips* and contrary to the teachings of

the ‘709 specification. Similarly, Petitioner attempts to redefine the meaning of other well understood terms that have an established Plain and Ordinary meaning.

For example, one of Petitioner’s primary arguments with respect to prior art reference *Krueger* outright admits that it must redefine the simple and well understood plural term telematics “features” to mean a singular “feature” to meet the disclosure in the reference its relies on and, as a result, that the “third mode of operation” and the “third set of telematics features” specified by the claim are completely missing from the reference and any opinions based thereon are unsustainable as conclusory.

Moreover, with respect to the arguments based on *Tan* in Ground 3, Petitioner and its expert fail to address at all the claim term “set of telematics features” - it is completely missing from its invalidity position altogether and thus unaddressed. This appears to be fatal to its position as a conclusory expert opinion with no evidentiary support. Moreover, also completely missing from the reference and the allegation is an identification of a third mode of operation. Petitioner’s use of a non-functional home screen as a third mode of operations fails immediately upon inspection as non-qualifying because it is missing the third mode of *operation* (which is not a mode of non-operation as used for support in the Petition).

Accordingly, for at least the foregoing reasons, and as further explained below, the Board should exercise its discretion and decline to institute this Petition and the

three other related Petitions in favor of resolution at the District Court level.

Patent Owner provides a more detailed explanation regarding the merits below which focuses on the shortcomings and deficiencies of Ford's invalidity allegations as best as they can be understood by Patent Owner.

II. Overview of the '709 Technology

The '709 patent arose from Mr. Naboulsi's lifelong passion for vehicle safety technology. One aspect of his invention relates to driver safety through the monitoring, selective filtering and/or reduction of distracting events from the driving environment that may compromise or otherwise diminish a vehicle operator's ability to concentrate on the primary task of safely operating the vehicle. The use of telematic systems in general, such as "infotainment" systems now commonly found in passenger vehicles, tends to increase the possibility of an accident or other unsafe condition because such use not only diverts the driver's attention from driving, but also generally requires the use of at least one of the driver's hands and frequently distracts the driver's eyes from both the road and traffic. Vehicle-based telematics systems typically include warnings to inform the driver about the risk of using these devices while driving and discourage such use. However, compliance is difficult to enforce.

For example, danger exists when a driver uses one hand for holding or dialing the telephone or when he or she attempts to control audio and/or video equipment,

or environmental controls like adjusting heat, air conditioning, seat position or other vehicle settings requiring direct attention.

Moreover, there are other potentially dangerous conditions and inherent risks associated with driving that depends on the act of driving itself, such as rapidly accelerating or decelerating, excessive maneuvering, merging on to or exiting a freeway, passing, changing lanes, changing gears, depressing the clutch, driving at high speed, negotiating a turn or other challenging road geometry, braking, driving in reverse, or a stress condition on the part of the driver. Such inherent risk is also dependent on the purpose for driving. For example, driving a delivery truck or emergency service vehicle such as an ambulance or police car is typically more dangerous than the personal or recreational use of a sedan, *etc.*

The '709 provides an integrated multifunction telematics system and methods for mitigating or minimizing such risks by monitoring for potentially distracting events and selectively filtering or otherwise modifying telematics system operations in a responsive and adaptive manner based on the distraction level determined or calculated by the system to improve driver safety. This is generally illustrated in FIGs.1 and 4 of the '709 patent as shown below.

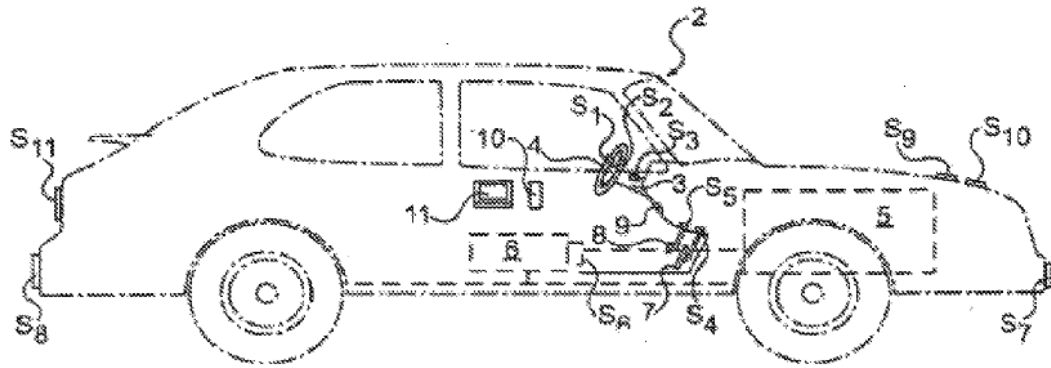
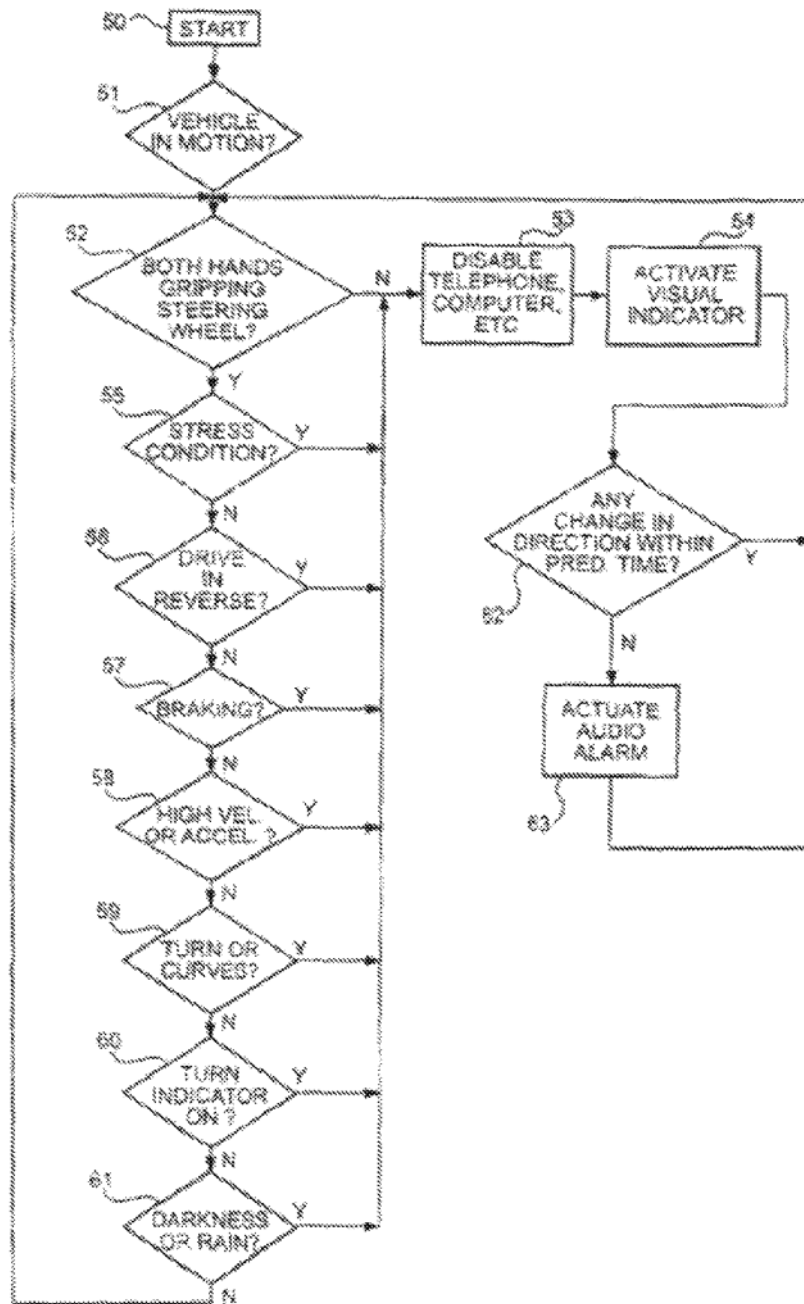


Figure 1

**Figure 4**

In operation, in accordance with aspects of the invention, the integrated telematics system of the invention may include the sensors labelled S1- S10 in vehicle 2 of FIG. 1, and as shown in FIGs. 2 and 5B monitor certain operational characteristics of the vehicle for potentially distracting events. This is generally illustrated in FIG. 4.

As shown, at block 51, which in accordance with a preferred embodiment of the invention, after the vehicle is in motion, the sensors shown in FIGs. 1 and 2 monitor the conditions illustrated in the flowchart of FIG. 4. This includes stress conditions 55, drive in reverse 58, braking 57, high velocity or acceleration 58, turn or curves 59, turn indicator ON 60, and darkness or rain sensor 61. In the event that one or more of these conditions is outside a predetermined threshold associated with these conditions, the output of the multifunction telematics device or system which is a display screen output having both audio and video attributes accessible to a driver, may be modified to be more restrictive based on the distraction level assessed. See generally, for example, FIG. 5B col. 18, lines 3-14, col. 3, lines 35-40, col. 17, lines 14-27 and col. 1, lines 20-26.

According to further features in the described preferred embodiment, the certain functional features of applications running on the integrated telematics device, such as the audio portion of a navigation system output may also be disabled when the vehicle is traveling in the reverse direction, or is being braked, or is within

a predetermined proximity of another vehicle, is traveling at a high velocity, accelerating, decelerating, merging onto or exiting a freeway, passing, changing lanes, changing gears, depressing the clutch, or a driver is occupied using other accessories in the vehicle. Because a high degree of attention of the driver is required under all the foregoing conditions, operation of the vehicle telephone, for example, even the ringing signal of an incoming telephone call, could be highly distracting to the driver and is therefore disabled or modified to avoid the possibility of increasing the risk of an accident.

This is consistent with the monitored conditions shown in FIG. 5B. and explained for example, at col. 19, lines 4-27.

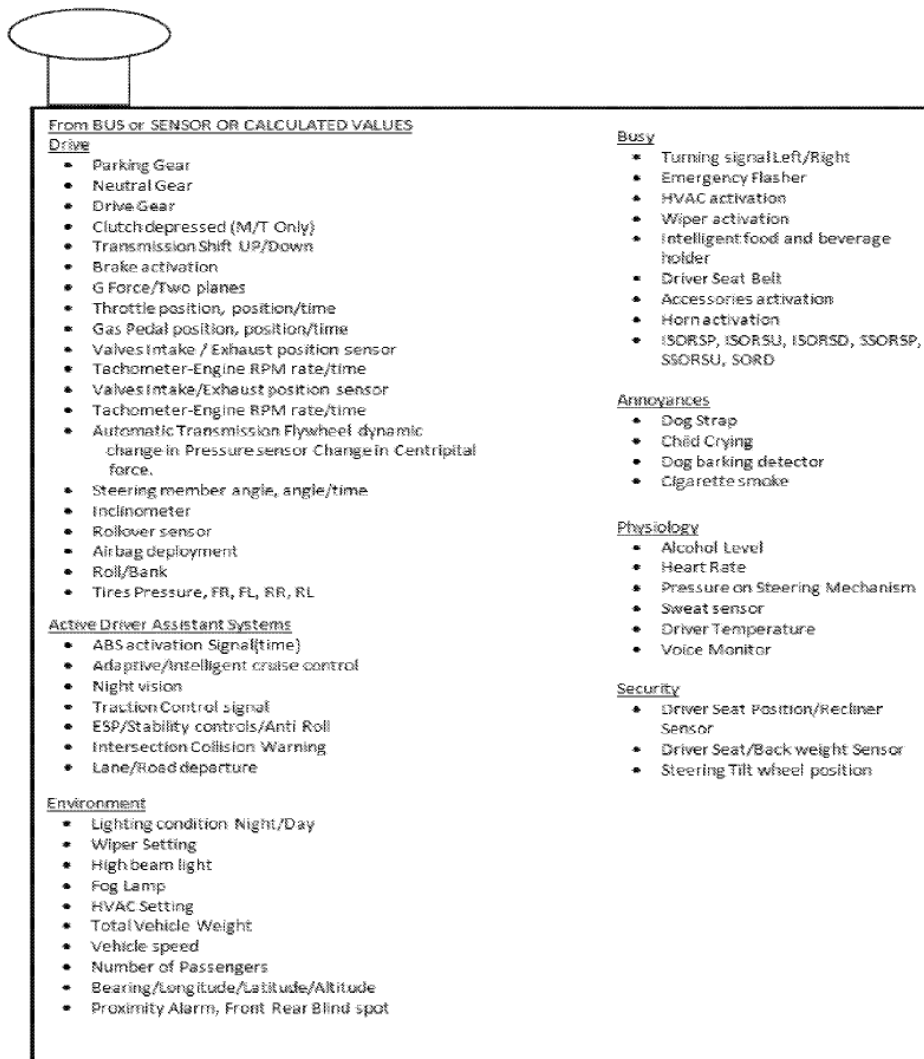


Figure 5B

One primary benefit of this approach is it reduces and/or minimizes driver distraction based on an adaptive or scaled approach to analyzing a plethora of diverse operating conditions, assessing a threat level and appropriately modifying telematics output in an adaptive way to avoid a driving environment that impedes the driver's ability to adequately concentrate on the act of driving thereby improving the safety of not only the driver but of other motorists and pedestrians alike.

Telematics Device and Output

Telematics in accordance with the Plain and Ordinary meaning of this term and as confirmed by the '709 specification is a central multifunction device or system that integrates together the features of automotive information, communication, computing, and entertainment technologies. See *e.g.*, FIELD OF THE INVENTION - col. 1, lines 20-26, col. 3, lines 35-40, and FIG. 5B. It is indisputable that the multiple applications such as navigation, mobile phone interface, Internet access, radio, and vehicle status (low battery *etc.*) and others that are provided by a telematics device to a driver are necessarily done through a singular integrated multimedia output device and/or system such as a multifunction screen having both audio and visual components.

To the extent that Petitioner's expert ignores this definition, as required by *Phillips*, and attempts to rely on some long, overly complicated historical explanation of what this term *might* have meant between the 1970's and the late 1990's (Ex. 1003. pages 36-63) - this is unhelpful at best and appears to be done in a not-so-subtle effort to redefine this term to suit its own needs (*i.e.*, necessary to support its conclusions). Such an approach is improper for multiple reasons. First, it ignores or attempts to redefine the Plain and Ordinary meaning of this term at some point in the past rather than at the time of filing of the invention (2001-2002). Further, and perhaps more problematically, it also ignores the definition provided by

the inventor himself, which Petitioner's expert is obligated to consider and use, when, as here, the inventor acts as his own lexicographer (which, in this case, is the same as the Plain and Ordinary meaning). Because Petitioner and its expert have not used this definition in its analysis, or even addressed it – all of Petitioner's opinions are legally insufficient and/or otherwise fatally flawed (as further explained below).

III. The Board Should Deny Institution Under *Fintiv* Because The District Court Will Decide Validity Well Before A Final Written Decision On The Majority Of Asserted Claims

Congress created IPRs as a “complete substitute” for and an “alternative” to District Court litigation for assessing patent validity. *WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1317 (Fed. Cir. 2018). In the precedential *Apple Inc. v. Fintiv, Inc.* decision, the Board identified the following relevant factors when considering discretionary denial under 35 U.S.C §314 because of a parallel District Court proceeding: (1) whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted; (2) proximity of the court's trial date to the Board's projected statutory deadline for a Final Written Decision; (3) investment in the parallel proceeding by the Court and the parties; (4) overlap between issues raised in the petition and in the parallel proceeding; (5) whether the Petitioner and the Defendant in the parallel proceeding are the same party; and (6)

other circumstances that impact the Board's exercise of discretion, including the merits. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential).

Petitioner fails to acknowledge or address the *Fintiv* analysis at all in its Petition. Here, all six factors weigh strongly against institution in view of the parallel Underlying Litigation where Patent Owner asserted four patents, including the '709 against Petitioner.

A. Fintiv Factor #1: A Stay in the District Court Is Unlikely

The first *Fintiv* factor is “whether a stay exists or is likely to be granted if a proceeding is instituted.” *Fintiv* (Paper 11) at 6. In the Underlying Litigation, 46 claims have been asserted (Ex. 2001), no motion to Stay has been filed and none will be considered by the Judge on this case until each Petition has received an institution determination. See *Omega Flex, Inc. v. Ward Manufacturing, LLC*, C.A. 18-1004 (D. Del. Jan. 24, 2020), D.I. 128, ORAL ORDER re 107 MOTION to Stay - Defendant's motion to stay is DENIED without prejudice to renew if and when the PTAB issues its decision on Defendant's Petition for *inter partes* review of U.S. Patent No. 7,004,510. Ford cites no relevant case law by Judge Noreika to the contrary.

Although Ford could presumably file a Motion to Stay after the February 22, 2022 institution decision deadline as to the seven asserted claims challenged in this

Petition – it will almost certainly gain no traction, because the large majority (39 of 46 asserted claims) are unaffected by its outcome, even if favorable to Petitioner. Further, because each Motion to Stay will be considered on its own based on the claims it affects with respect to totality of claims asserted in the litigation, and in view of the procedural posture at the time it is filed, it is unlikely a Stay will be granted prior to an institution determination of the last-to-be-filed Petition (IPT2022-00086) – which will not be until about May 19, 2022², at which point the procedural posture of the Litigation will be quite advanced with significant resources expended - with final infringement and invalidity contentions filed (April 8, 2022 and April 14, 2022, respectively), fact discovery complete (April 29, 2022), Markman briefing complete (April 11, 2022), with expert discovery well underway, and with trial less than nine months away making the grant of a Stay unlikely. Ex. 1028.

Furthermore, Ford has yet to produce source code in this case for the accused products. Despite being explicitly requested in SDT's June 16, 2021, document requests (Ex. 2002), Ford has refused to commit to a date by which the source code will be produced (Ex. 2003). SDT reserves the right to update its Infringement Contentions after its expert has had ample time to review the code and complete any follow up discovery – which very well may result in new unchallenged claims being

² Best approximation of institution determination date.

asserted in the Litigation, making it further unlikely that a Stay will be granted.

Accordingly, any parallel proceeding before the Patent Office would cause a duplicative and unnecessary expense. Furthermore, granting such a Stay at that time would thwart Congressional intent to streamline the resolution of patent disputes by causing the Litigation to more than double its time to trial from that point forward (from nine months to trial over a year and nine months depending on the District Court's trial calendar).

Thus, this factor weighs in favor of exercising discretion to deny institution.

B. *Fintiv* Factor #2: The Final Written Decision for the Majority of the Challenged Claims is Due After the Trial Date

“If the court's trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*.” *Fintiv* (Paper 11) at 9. Ford seeks *Inter Partes* Review of all four of SDT's asserted patents. The District Court trial date is set for February 21, 2023, which involves additional issues beyond patent validity which include, among others, written description allegations not present in the Petitions (Ex. 1028 and Ex 2006). The due date for the Final Written Decision for this Petition is February 21, 2023, *i.e.*, during the trial³. However, as explained above, this is only for 7 of 46

³ Due February 19, 2023, a Sunday, with Monday, February 20, 2023, a Federal holiday.

asserted claims. The Final Written Decision date for the majority of asserted claims in IPR2021-01446 (14 asserted of 46 claims) is after the trial date (March 15, 2023), and in IPR2022-00086 (20 of 46 asserted claims) is about three months after the trial date (about May 19, 2023).

The Board routinely exercises its discretion to deny institution where, as here, the scheduled District Court trial date is after the projected date of the Board's Final Written Decisions. *See e.g., Next Caller Inc. v. TRUSTID Inc.*, IPR2019-00961, Paper 10, 9-15 (PTAB Oct. 16, 2019) (denying institution where trial was scheduled three months before FWD); *E-One, Inc. v. Oshkosh Corp.*, IPR2019-00161, Paper 16, 6- 9 (PTAB May 15, 2019) (denying institution where trial was scheduled one month before FWD); *ZTE USA Inc. v. Fractus SA*, IPR2018-01461, Paper 10, 16-17 (PTAB Feb. 28, 2019) (denying institution where District Court "likely to go to trial before a final decision is reached"); *Intel Corp. v. VLSI Tech. LLC*, IPR2020-00112 (Paper 15) (May 19, 2020) at 10.

Accordingly, this factor weighs strongly against institution.

C. *Fintiv* Factor #3: Petitioner Waited Too Long to File its Petitions, Knowing there Would be Significant Investment in the Litigation Prior to A Final Written Decision

If "the evidence shows that the petitioner did not file the petition expeditiously... or even if the petitioner cannot explain the delay in filing its petition, these facts have favored denial." *Fintiv* (Paper 11) at 11–12; *see also Next Caller*,

Inc. v. TRUSTID, Inc., IPR2019-00961, Paper 10 at 16 (PTAB Oct.16, 2019) (the petitioner’s unexplained delay in filing the petition supported denial). “[M]ore work completed by the parties and court in the parallel proceeding tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting a stay would lead to duplicative costs.” *Fintiv* (Paper 11) at 10.

Despite knowing on or before April 12, 2021, that the Underlying Litigation may go to trial as early as January 23, 2023 (Ex. 2004 and 2005 at page 12), as is common in Delaware, Ford decided to wait an additional approximately 4 months after that date to file its *first of four* Petitions understanding that the Final Written Decision (“FWD”) on this Petition would come after the start of trial – with the later 2 Petitions not receiving an institution determination until after or during the trial - including the final Petition with the majority of asserted claims on or about May 19, 2023. Even using the February 21, 2022, date for an institution determination of the instant Petition, substantial resources will have already be expended - the parties will have exchanged opening Markman briefs with document production substantially complete on March 1, 2022 (Ex. 1028).

Using the May 19, 2022 institution determination date as the more accurate date for a Stay determination, results in a substantially more unfavorable procedural posture where significant time, money, and resources will have been expended - fact discovery and final contentions exchanged as discussed above in connection with

Fintiv Factor #1 (April 29, 2022), Markman briefing fully complete (joint brief filed with the Court May 9, 2022), with expert discovery well underway with trial a mere nine months (or less) away making the investment in the Underlying Litigation very substantial (Ex. 1028).

Because of Petitioner's delay and the status of the Litigation, this far outweighs against institution.

D. *Fintiv* Factor #4: Substantially the Same Issues Are Raised in the Petition and in the Parallel Proceeding

“[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” *Fintiv* (Paper 11) at 12. Here, Petitioner relies upon the same primary references and substantially the same invalidity arguments, under the same claim construction standard, as in the Underlying Litigation including all claims asserted in the Litigation. Indeed, the 3 Grounds in the Petition include the same primary references – *Tan*, *Gelvin*, *Trauner*, and *Krueger* – as in Petitioner's Invalidity Contentions in the Litigation and used in the same way. Ex. 2006. Petitioner adds new references *Mahvi*, and *Ordinak* in the Litigation in an effort to address the lack of proof and numerous other deficiencies in the positions asserted in this Petition as explained further herein and asserted in an additional contention based on the same or similar references in the same or similar way.

Nevertheless, although Petitioner asserts an additional invalidity theory in the Litigation, the Board has regularly and repeatedly denied institution where Petitioner asserts additional grounds in District Court. *See, e.g., Google LLC v. Uniloc 2017 LLC*, IPR2020-00115, Paper 8, 8 (PTAB Mar. 27, 2020) (denying institution under *Fintiv* where petitioner raised “hundreds of obviousness combinations” in parallel District Court action); *Sand Revolution II, LLC, v. Continental Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 12, 16-17 (PTAB Feb. 5, 2020) (denying institution under 35 U.S.C. § 314(a) where petitioner’s litigation defenses raised 16 additional combinations).

In *Fintiv*, the Board denied institution where, as here, Petitioner raised substantially the same invalidity arguments in both forums and the District Court trial date was two months before the IPR’s FWD. IPR2020-00019, Papers 11 and 15 (PTAB Mar. 20, 2020). The posture in this case also resembles the circumstances of *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, where the Board denied institution for similar reasons. IPR2018-00752, Paper 8, 20 (PTAB Sept. 12, 2018). (denying petition under §314(a) due to advanced stage of District Court proceeding, the occurrence of the District Court trial months before the scheduled final written decision, and the use of the same prior art and arguments in the District Court and IPR proceedings). Consistent with *Fintiv* and *NHK*, the Board should exercise its discretion to deny institution as an inefficient use of Board resources and a waste

of the parties' time.

This factor weighs strongly against institution.

E. *Fintiv* Factor #5: Petitioner Ford and Defendant Ford in the Parallel Proceeding are the Same

Petitioner Ford Motor Company (including the real party-in-interest) is the same party as defendant Ford Motor Company in the Underlying Litigation, see Petition at *xii*.

This factor weighs against institution.

F. *Fintiv* Factor #6: Other Circumstances, Including Lack of Diligence and the Merits of Petitioner's Arguments, Weigh Against Institution

Further to *Fintiv* Factor 3 above, Ford cannot claim it was diligent in pursuing its Petitions. In fact, it would appear the opposite is true. Ford and Mr. Mouhamad Naboulsi, the solo inventor of the four Challenged Patents have a long history together prior to these PTAB proceedings in which Ford and its attorneys were aware of Mr. Naboulsi and his patent portfolio years before the commencement of the Litigation and these proceedings.

Mr. Naboulsi filed U.S. Provisional Patent Application No. 60/336,293, on October 24, 2001, and U.S. Provisional Patent Application No. 60/390,877, on June 21, 2002, from which all four of the challenged patents claim priority. He is the sole inventor of both applications, which includes the US patents that emerged therefrom

and are the subject matter of the four current separate challenges before the PTAB (8,301,108, 9,047,170, 9,713,994 and 10,532,709). (Ex. 2007 ¶ 3).

After filing these applications, Mr. Naboulsi exhibited the inventions in various automotive shows and regulatory sessions throughout the US, which were attended by various representatives from the automotive industry including Ford. This included: Transport Canada, in Ottawa October 2003; Department of Transportation in Washington, D.C. U.S. Department of Transportation Secretary LaHood Distracted Driving Summit September 30 - October 1, 2009, and again in September of 2010; National Congress for State Legislature in Salt Lake City July 2004 and in Louisville in July 2010; and Governors Highway Safety Association in Kansas in 2010. (Ex. 2007 ¶ 4).

In March 2003, Mr. Naboulsi was hired to work in Petitioner Ford's Safety Office. (Ex. 2007 ¶ 5).

Prior to employment with Petitioner Ford, Mr. Naboulsi disclosed to Ford that he had filed the above-mentioned provisional patent applications relating to driver safety and distraction. (Ex. 2007 ¶ 6).

In May 2004, Mr. Naboulsi was asked by two Ford Executives to give a demonstration of these inventions at the Ford Advanced Design Center in Michigan, and to give a presentation and a demonstration regarding the same to researchers at Ford's Michigan offices. This included Dev Kotchar, Luis Trajena and Jeff Rupp

Senior Manager in Autonomous Vehicles, ADAS, and Crash Safety R&D. (Ex. 2007 ¶ 7)

On or about October of 2004, a Ford in-house IP attorney contacted him and inquired about his patent applications. (Ex. 2007 ¶ 8).

After providing Ford with terms for licensing his patent pending technology in 2004 (Ex. 2008), Ford required Mr. Naboulsi to waive his rights to assert his technology IP prior to negotiating any license agreement which he refused. (Ex. 2007 ¶ 9).

Mr. Naboulsi was terminated by Petitioner Ford in December 2004 by Mazen Hammoud, a manager at Ford. The official reason for termination was “a conflict of interest,” which, however, as he understands it, was because of his refusal to assign the inventions in his pending patent applications to Ford. (Ex. 2007 ¶ 10).

In January 2007, at the North American International Auto Show in Detroit, Michigan, Ford announced the adoption of its SYNC infotainment module, which implemented the inventions described in Mr. Naboulsi’s patents four of which are asserted in the Delaware patent infringement Litigation. (Ex. 2007 ¶ 11)

Mr. Naboulsi has made many presentations about his inventions including for a group of engineers at Ford’s Advanced Features & Technology, Development & Implementation Center, located at 20300 Rotunda Drive, Dearborn, MI 48124 in September, 2008. During the meeting, the Ford engineers commented about the

similarity between his presentation and the features in the Ford SYNC system. (Ex. 2017 ¶ 12)

Mr. Naboulsi was awarded the prestigious MIT-SAE Innovator of the Year award in April 2010 for the inventions disclosed in his provisional patent applications. (Ex. 2007 ¶ 13)

Accordingly, Ford has long known about and had a detailed understanding of Mr. Naboulsi's inventions and his intellectual property since no later than 2008.

Furthermore, Petitioner Ford and its attorneys at Brooks Kushman knew about Mr. Naboulsi and his patent portfolio, including the '108 patent (challenged in IPR2022-00086) through numerous interactions with the USPTO prosecuting similar Ford patents. This is demonstrated, for example by Ford's IDSs filed pursuant to Rule 56 in which Petitioner brought to the attention of the USPTO the '108 patent in at least the 23 Ford patents and associated applications. Ex. 2009 and Ex. 2010.

In addition, Petitioner Ford's legal department⁴ including Mr. Bejin Bieneman was expressly aware of at least the '108 patent as it was used as the basis of a USPTO rejection in an Office Action dated November 24, 2015, against one of Ford's own

⁴ Ford Global Technologies is a wholly owned subsidiary of Petitioner Ford and handles all aspect of Petitioner's Intellectual property (Ex. 2011).

safe driving patent applications entitled “Controlling Access to an in-Vehicle Human-machine Interface,” ultimately issuing as US Patent 9,457,816. Ex. 2012, Page 5. Ford was required to read and understand the contents of the ‘108 patent in order to distinguish over this reference and obtain its own patent in the same technology area. Ex. 2013.

In view of the above, Petitioner Ford cannot contend in good faith that it has been “diligent” in filing its Petitions which now have the majority of the FWD’s (3) due after the trial date. Because Ford had a long and ongoing relationship with Mr. Naboulsi that provided it with a deep and detailed institutional understanding of his technology from multiple first-hand technical interactions as well as having read the ‘108 patent specification⁵ and its claims years before these proceedings, Ford clearly had the time, resources and ability to move with reasonable diligence and file its Petitions such that all FWDs would issue long before, and not after, the trial date. It did not do so. Patent Owner respectfully submits that this decision should not inure to Patent Owner’s detriment. Ford should not be allowed to now introduce additional delay and uncertainty into the resolution of the Litigation after all this time has passed simply because it chose to act slowly for its own convenience.

⁵ All of the Challenged patents have substantially the same specification and claim priority to the ‘108.

Moreover, in addition to the above, the merits of the Petition are weak, and therefore are more efficiently handled in the Litigation which will have been underway for more than a year by the time any institution decision is made on this Petition.

Thus, this factor, and the factors as a whole, weigh against institution.

IV. **THE PETITION FAILS TO ESTABLISH OBVIOUSNESS**

A. **Legal Standard**

To institute an IPR, the Board must determine that the Petition satisfies the following statutory threshold:

(a) Threshold – The Director *may not authorize* an inter partes review to be instituted *unless* the Director determines that the *information presented in the petition* filed under section 311 and any response filed under section 313 *shows* that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

35 U.S.C. § 314(a).⁶

“In an IPR, the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic*, 815 F.3d at 1363. The Board is not “free to adopt arguments on behalf of petitioners that could

⁶ All emphasis is added unless otherwise indicated.

have been, but were not, raised by the petitioner during an IPR.” *In re Magnum Oil Tools, Int’l, Ltd.*, 829 F.3d 1365, 1381 (Fed. Cir. 2016). “The petitioner must instead articulate specific reasoning, based on evidence of record,” as set out in its petition “to support the legal conclusion of obviousness.” *Id.* at 1380. The Board “must base its decision on arguments that were advanced by a party.” *Id.* at 1381. The PTAB cannot “decide unpatentability theories never presented by the petitioner.” *Id.*

To prevail on any obviousness ground, Petitioner may not simply identify individual claim components—it must show why a “skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) *emphasis added*. A petitioner must support even simple modifications to a reference with some motivation to make the change. *See In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984).

In addition, a petitioner cannot rely on “mere conclusory statements.” *Magnum Oil*, 829 F.3d at 1380. Rather, the petitioner must set forth “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418-19 (2007) (internal citation omitted). Similarly, a petitioner cannot simply rely on an expert’s unsubstantiated and conclusory opinions. *See* 37 C.F.R. § 42.65 (“Expert testimony that does not disclose the underlying facts or data on which the opinion

is based is entitled to little or no weight.”); *Harmonic*, 815 F.3d at 1363 (affirming that Petitioner failed to establish obviousness where expert testimony “add[ed] nothing beyond the conclusory statements in [the] petition.”).

An appropriate obviousness inquiry cannot involve even a “hint of hindsight.” *Star Sci., Inc. v. R.J. Reynolds Tobacco Co.*, 655 F.3d 1364, 1375 (Fed. Cir. 2011) *emphasis added*. Petitioner may not “simply retrace[] the path of the inventor with hindsight, discount[] the number and complexity of the alternatives, and conclude[] that the invention . . . was obvious.” *Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc.*, 520 F.3d 1358, 1364 (Fed. Cir. 2008). Likewise, “[c]are must be taken to avoid hindsight reconstruction by using the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.” *In re NTP, Inc.*, 654 F.3d 1279, 1299 (Fed. Cir. 2011) (internal quotations omitted).

In arriving at an obviousness determination, the Petitioner must sufficiently explain and support the conclusions that the prior art references disclose all the elements recited in the Challenged Claims and a relevant skilled artisan not only could have made but would have been motivated to combine all the prior art references in the way the patent claims. *Pers. Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017). That is, even if all the claim elements are found across a number of references, an obviousness determination must consider whether

a person of ordinary skill in the art would have been motivated to combine those references. *Intelligent Bio Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1368 (Fed. Cir. 2016); *Los Angeles Biomedical Res. Inst. at Harbor-UCLA Med. Ctr. v. Eli Lilly Co.*, 849 F.3d 1049, 1067 (Fed. Cir. 2017) (vacating and remanding an obviousness determination, in part, because the Board did not make factual findings as to whether there was an apparent reason to combine all three prior art references to achieve the claimed invention and whether a POSITA would have had a reasonable expectation of success from such a combination). This combination determination, as supported by an articulated motivation to combine, requires a plausible rationale as to why those prior art references would have worked together. *Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1335 (Fed. Cir. 2013). Absent some articulated rationale, a “common sense” finding is no different than the conclusory statement “would have been obvious.” *In re Van Os*, 844 F.3d 1359, 1361 (Fed. Cir. 2017). Of additional importance, “knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references.” *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1373 (Fed. Cir. 2008).

The appropriate claim construction standard is provided by *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*). Under the *Phillips* standard, “the specification ‘is always highly relevant to the claim construction analysis. Usually,

it is dispositive....’ and claim terms are generally given their ordinary and customary meaning.” (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)).

The “only two exceptions to this general rule [are] 1) when a patentee sets out a definition and acts as his own lexicographer, or 2) when the patentee clearly and unmistakably disavows the full scope of a claim term either in the specification or during prosecution.” See *Thorner v. Sony Computer Entm’t Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012) (citing *Vitronics*, 90 F.3d at 1580). Moreover, a patentee is said to act as his own lexicographer when he “sets out a definition” with the “clear[] express ... intent to define the term.” *Thorner*, 669 F.3d at 1365. “When the patentee acts as his own lexicographer, that definition governs” *Phillips* 415 F.3d at 315.

B. The Petition Fails to Make Out a Prima Facie Case of Obviousness for at least Independent Claim 15.

Petitioner presents three separate Grounds of unpatentability. Ground 1 is directed toward claims 1-4 and 15 (claims 1 and 15 independent) and is based on U.S. Patent No. 7,711,355 (“*Krueger*”) and U.S. Patent No. 7,484,008 (“*Gelvin*”) and the knowledge of an ordinary artisan.

Ground 2 is directed toward claims 1-3, 5-7 and 14 (claims 1, 5 and 14 are independent) and is based on U.S. Patent Publication No. 2002/0070852 (“*Trauner*”)

and *Gelvin* and the knowledge of an ordinary artisan.

Ground 3 is directed toward claims 15 and 16 (claim 15 is independent) and is based on U.S. Patent No. 6,574,530 (“*Tan*”) and *Gelvin* and the knowledge of an ordinary artisan.

Although many reasons exist as to why the challenged claims are patentable over the theories advanced in the current Petition, Patent Owner focuses on certain straightforward deficiencies in Petitioner’s analysis of independent claim 15, element 15.1 and 15.2 for the convenience of the Board.

Claim 15 - Ground 1

The crux of Petitioner’s argument regarding claims 15 and 16 in Ground 1 may be found on pages 29-30 of its Petition where it attempts to convince the Board that the functions of *two* devices as disclosed in *Krueger*⁷, a telephone and a radio, somehow equate to *three* different operating modes with three sets of different telematic features that are different from each other. It simply does not. As

⁷ *Krueger* alone is used as a basis for elements 15.1 and 15.2 in Ground 1. Petitioner’s expert makes a conclusion based on an alleged combination with *Gelvin* but provides no features supplied by *Gelvin* or discussion of any combination of *Gelvin*’s features or teaching to arrive at element 15.1 and 15.2 at all. No knowledge of one of ordinary skill in the art is contended by Petitioner as a basis for its position.

explained below, there are only two devices shown in *Krueger*, which operate differently from one another. However, the claim element *a third operating mode having a third set of telematic features* is completely missing. And, in fact, the alleged presence of a “third operating mode” and “third set of telematic features” is precluded by the definition of the first operating mode and first set of telematic features relied on by Petitioner.

Examining claim element 15.1 and the support and analysis offered shows a complete lack of evidence and basis for Petitioner’s invalidity theory.

[15.1] a first mode of operation, a second mode of operation, and a third mode of operation each being respectively configured to operate a first, a second, and a third set of telematics features;

Petitioner contends on pages 29-30 that:

Krueger discloses three modes of operation that are configured to operate a first, second and third set of telematic features. Krueger discloses a first mode of operation wherein the telephone can be operated to place a telephone call from the vehicle. Krueger discloses a second mode of operation wherein the operating panel 14 of the car radio can be operated. Krueger discloses a third mode of operation wherein the telephone can be operated to receive a telephone in the

vehicle. (Ex.1026, 2:48-3:2; Ex.1003, ¶188.)

However, completely missing here is any explanation of how or why *Krueger* discloses three different modes of operation having *3 different sets of telematic features*. Petitioner's expert at ¶188 merely parrots the exact wording of this paragraph above. No explanation of telematic *features* is provided at all – just a discussion of modes. Accordingly, no evidence or analysis regarding three sets of telematic features is provided.

Next, at pages 30-31 Petitioner essentially contends that a phone making a phone call is a first mode of operation with a first set of telematic features, that a radio is a second mode of operation with a second set of telematic features (radio operability) and then using *the same phone* for receiving a call constitutes a third mode of operation with a third set of telematic features. The supporting expert declaration again is a word-for-word copy of Petitioner's brief. Exhibit 1003 ¶190-191.

This conclusion, however, is internally inconsistent and clearly incorrect. For example, the claim terms clearly specify first, second and third **sets** of telematic featuress. The claim term **set** when combined with featuress (plural) demonstrates that each telematic operating mode requires multiple telematic features (*i.e.*, a set).

Petitioner and its expert, however, merely provide *one feature* per mode of operation, not a set (plural) of telematic features as the Plain and Ordinary meaning

of the claim requires. For example, making a phone call is one telematic feature (singular) in the first mode of operation. It is not a set of telematic features (plural). Similarly, operability of the radio by itself is another singular telematic feature – not plural.

Last and most problematically, the alleged “third set” of telematic features is completely missing. This is because in order to satisfy a first mode of operation with a first set of telematic features, the phone has to be able to make calls (a first telematic feature) and receive calls (a second telematic feature) in order to satisfy the required first mode of operation with a set (plural) of telematic features- leaving Petitioner completely unable to satisfy the third mode of operation limitation. Conversely, all three modes of operation only have one telematic feature. No explanation or evidence is provided as to why one feature - such as the ability to make a call - qualifies as a “set” of features. It is merely one feature. This is true of all three modes of operation.

Because Petitioner has no evidence or analysis on how to reconcile this shortcoming, its Petition must fail on this point (no disclosure of element 15.1).

As a result, because element 15.2 requires all the elements of 15.1 to be present and further defines their interaction and relationships, claim element 15.2 is also missing, unexplained and wholly without any supporting evidence, thus suffers from same or similar deficiencies as 15.1 above.

Consequently, for at least the reasons above, claim 15 and claim 16, which depends therefrom, is sustainable over the positions advanced in Ground 1.

Claim 15 - Ground 3

Petitioner's argument regarding claims 15 and 16 in Ground 3 may be found on pages 68-71 of its Petition where it attempts to convince the Board that the two functional screens and one non-functional screen as disclosed in *Tan*⁸, somehow show or suggest *three* different operating modes with three sets of different telematic features that are different from each other. It does not. Similar to *Krueger* above, *Tan* does not teach a telematics system having a third operating mode with a third set of telematic features. It is completely missing as demonstrated below.

Examining claim element 15.1 and the support and analysis offered shows a complete lack of evidence and basis for Petitioner's invalidity opinion.

[15.1] a first mode of operation, a second mode of operation, and a third mode of operation each being respectively configured to operate a first, a

⁸ *Tan* alone is used as a basis for elements 15.1 and 15.2 in Ground 3. Petitioner's expert makes a conclusion based on an alleged combination with *Gelvin* but provides no features supplied by *Gelvin* or discussion of any combination of *Gelvin*'s features or teachings to arrive at element 15.1 and 15.2 at all. No knowledge of one of ordinary skill in the art is contended or used by Petitioner.

second, and a third set of telematics features;

As above, claim element 15.1 specifies three operating modes and three related telematic features sets. At the outset, Patent Owner points out that nowhere in the Petition with respect to Ground 3 is any correspondence drawn whatsoever between first, second and third sets of *telematic features* and the disclosure of *Tan* or in supporting declaration Ex. 1003 ¶¶374-382. In fact, the claim term “first, a second, and a third set of *telematics features*” appears to be unaddressed and completely absent from both the Petition and the declaration. Accordingly, it seems indisputable that there exists a *prima facie* lack of evidentiary basis for Petitioner’s invalidity theory of element 15.1 in Ground 3. Thus, claim 15 is sustainable in view of the reasons set forth in the Petition for this reason alone.

Despite this apparent fatal circumstance, Petitioner’s allegations fail on other bases in any event. For example, Ford essentially contends that a “full function” Internet news screen is a first mode of operation, that a limited functionality screen is a second mode of operation, and a third non-functional common screen is a third mode of operation. The supporting expert declaration again is essentially a word-for-word copy of Petitioner’s (Ex. 1003 ¶¶374-382).

This conclusion, however, is incorrect. For example, the alleged third mode of operation is not a mode of operation at all but rather a common screen that is available only when the limited functionality screen is not available (*i.e.*, non-

functional screen). Furthermore, the common screen mode is application agnostic and provided by an operating system, not any one of the telematic applications that have telematic features. Ex. 1025 col. 4, line 61 – col. 5, line 4. Therefore, *Tan* provides no telematics at all in the alleged “third mode” because all telematic applications are non-functional. Accordingly, as above in connection with *Krueger*, *Tan*, either alone or in combination with other references fails to show or suggest either a third mode of operation or a third set of telematic features associated with the third mode of operation.

Because Petitioner has no evidence or analysis regarding these deficiencies, its Petition must fail on this point (no disclosure of element 15.1).

Therefore, because element 15.2 requires all the elements of 15.1 to be present and further defines their interaction and relationships, claim element 15.2 is also missing, unexplained and wholly without supporting evidence, thus suffers from the same or similar deficiencies as 15.1 above.

Consequently, for at least the reasons above, claim 15 and claim 16 which depends therefrom are sustainable over the positions advanced in Ground 3.

Petitioner Acknowledges Its Claim 15 Position is Weak

Petitioner knows its invalidity theories as articulated in the Petition with respect to claims 15 and 16 have little merit. This is demonstrated in its invalidity contentions in the Underlying Litigation. Ex. 2006. In a tacit admission that claims

15 and 16 are sustainable over the prior art in the Petition because Ford supplements the references in Grounds 1 and 3 with new prior art references *Malvi* and *Odinak*, which it contends show the claimed 3 mode operation. Example shown below.

Safe Driving Technologies LLC v. Ford Motor Company
Case No. 21-cv-64-MN

Exhibit D-4

U.S. Patent No. 10,532,709 Invalidity Chart – U.S. Patent No. 7,406,421 (“Odinak”) alone or in combination with U.S. Patent No. 7,484,008 (“Gelvin”)

The following chart compares certain asserted claims of U.S. Patent No. 10,532,709 (hereinafter, “’709 patent”) against prior art U.S. Patent No. 7,406,421 (hereinafter, “Odinak”) alone or in combination with U.S. Patent No. 7,484,008 (hereinafter, “Gelvin”). More specifically, the following chart compares claims 15 and 16 of the ‘709 patent with *Odinak* alone or in combination with *Gelvin*. At the very least, claims 15 and 16 of the ‘709 patent are not entitled to the priority date of SDT’s first provisional application 60/336,293 (hereinafter, “’293 application”) dated 10/24/2001 because they lack written description support. *See* 35 U.S.C. § 112. These claims are generally related to a telematics device having three modes of operation and configured to operate three sets of telematics features. The ‘293 application, however, discloses nothing about such three modes of operation or three sets of telematic features. Accordingly, these claims are not entitled to the priority date of the ‘293 application. Without the priority date of the ‘293 application, claims 15 and 16 of the ‘709 patent are invalid as obvious over *Odinak* alone or in combination with *Gelvin*. The *Odinak* patent was filed on February 14, 2002 and claims priority to U.S. provisional patent application No. 60/332,025 which was filed on October 26, 2001. *Odinak* published on May 1, 2003, and thus, qualifies as prior art to the claims of the patent-in-suit identified below under at least 35 U.S.C. § 102(e). *Gelvin* was filed on October 4, 2000 and claims priority to provisional application No. 60/158,013 filed on October 6, 1999, was issued on January 27, 2009, and thus qualifies as prior art to the claims of the patent-in-suit identified below under at least 35 U.S.C. § 102(e). *Odinak* alone or in view of *Gelvin* render obvious, at least these claims of the ‘709 patent:

10,532,709: 15-16

However, as Ford admits, *Odinak* is not prior art based on the accorded filing dates to the ‘709 and has asserted a written description defense in the Litigation – which it does not raise in this proceeding. Accordingly, it would not be efficient use of the Board’s resources to institute against these claims, given the small chance of success as demonstrated above and the pending additional dispute that is raised in the Litigation only. Accordingly, the Board should deny institution.

Mr. Andrews' Past Employment by Petitioner Ford

Ex. 1004 - CV of Scott Andrews, page 4 shows that Mr. Andrews was employed by Petitioner Ford for 3 years.⁹

1977-1979 Ford Aerospace, Advanced Development Operation
Designed, tested and delivered microwave radar receiver systems

Although Mr. Andrews represents in his declaration that his compensation for work on *this matter* is not dependent on its outcome, this is merely the beginning of the inquiry. At this point, neither the Board or Patent Owner has any way of knowing what other ongoing lifelong associations Mr. Andrews may have with Petitioner – his former employer – that may impede (or preclude altogether) his ability to act as an independent expert. For example, Mr. Andrews may still have financial ties to Ford through a pension plan or stock options, may still have substantial professional associations with colleagues from Ford and/or may still work with Ford on other matters, *etc.* In fact, given the nature of his work as a consultant in the automotive safety industry, and in view of his past employment by Ford, it would hardly be surprising to find he still has significant personal or

⁹ Ford Aerospace is a wholly owned subsidiary of Petitioner Ford Motor company.

professional connections with Petitioner, one of the biggest auto manufacturers in the world. Until Patent Owner takes some discovery on this point to test for any such associations or business relationships, it cannot be assumed that Mr. Andrews is completely independent and impartial and therefore little if any deference should be given to his opinions unless bias has been fully explored and vetted¹⁰.

This concern appears to be justified in view of the highly attenuated and unsupported positions Mr. Andrews takes in his declaration including, at least for example, in connection with his opinions regarding claim 15 elements 15.1 and 15.2 where there is insufficient evidence presented to support an invalidity conclusion. Mr. Andrews then appears to read or assume the missing features into the reference in order to support his conclusions - contrary to the required legal standards.

Many other qualified experts with no such potentially problematic association with the Petitioner were available to choose from – Patent Owner believes Petitioner could have easily chosen one that was clearly uncompromised to avoid the specter of any bias or impropriety on its part, and its potential effect of calling into question the integrity of these proceedings.

¹⁰ Such discovery would include both written and deposition discovery not only of Mr. Andrews himself, but third parties too - well beyond the scope of these proceedings at the pre-institution phase.

C. Claims 1-4 Ground 1 are Not Obvious Over the Cited Art

Claims 1-4 are not obvious over Petitioner's proposed combination of *Krueger* and *Gelvin* for numerous reasons. This is true because at least the references themselves, either alone or in combination, fail to show or suggest each element of the claims and because it is not obvious to combine the references as proposed by Petitioner. Furthermore, Petitioner relies on extensive use of hindsight reconstruction in arriving at its flawed conclusions and fails to provide any motivation to combine the references as proposed or show any likelihood of success or expectation of such.

Moreover, the references themselves teach away from each other in material respects such that combining them as proposed by Petitioner results in an inoperable system or device or one that is unsuitable for its intended purpose – discouraging any such combination. Moreover, Petitioner fails to articulate or use the Plain and Ordinary meaning for each claim term it contends is obvious and ignores the specification of the '709 when it provides the appropriate definition, and in many instances its positions conclusory, having no valid supporting evidence and contrary to the understanding of an ordinarily skilled artisan.

D. Claims 1-3, 5-7 and 14 in Ground 2 are Not Obvious Over the Cited Art

Claims 1-3, 5-7 and 14 are not obvious over Petitioner's proposed combination of *Trauner* and *Gelvin* for numerous reasons. This is true at least

because the references themselves, either alone or in combination, fail to show or suggest each element of the claims and because it is not obvious to combine the references as proposed by Petitioner. Furthermore, Petitioner relies on extensive use of hindsight reconstruction in arriving at its flawed conclusions and fails to provide any motivation to combine the references as proposed or show any likelihood of success or expectation of such.

Moreover, the references themselves teach away from each other in material respects such that combining them as proposed by Petitioner results in an inoperable system or device or one that is unsuitable for its intended purpose – discouraging any such combination. Moreover, the Petitioner fails to articulate or use the Plain and Ordinary meaning for each claim term it contends is obvious and ignores the specification of the ‘709 when it provides the appropriate definition and in many instances its positions conclusory, having no valid supporting evidence and contrary to the understanding of a ordinarily skilled artisan.

V. RESERVATION OF RIGHTS

Should the Board decide to institute an *Inter Partes* Review, SDT reserves all rights to make additional arguments in and present claim constructions and evidence with its Patent Owner’s Response. SDT’s silence on any particular claim or limitation at this time is not a concession that the Petition’s discussion of that claim

or limitation is properly based. Accordingly, SDT reserves the right to submit additional or alternative arguments of patentability, and nothing in this Preliminary Response acts or should be construed to act as an admission, acquiescence, or estoppel on the merits of the Petition.

VI. CONCLUSION

For the reasons above, the Petition should be denied in view of the *Fintiv* factors including on the merits. In addition, because the co-pending litigation is set to resolve 3 months before a Final Written Decision all pending petitions, discretionary denial is appropriate. SDT respectfully requests the Board deny the Petition.

Respectfully submitted,

Dated: November 19, 2021

/s/ Michael E. Shanahan

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), Counsel for Patent Owner Safe Driving Technologies LLC hereby certifies that this document complies with the type-volume limitation of 37 C.F.R. § 42.24(b). According to Microsoft Office Word 2010's word count, this document contains under 14,000 words, including any statement of material facts to be admitted or denied in support, and excluding the table of contents, table of authorities, mandatory notices under § 42.8, exhibit list, certificate of service or word count, or appendix of exhibits or claim listing.

Dated: November 19, 2021

/s/ Michael E. Shanahan

Michael E. Shanahan (Reg. No. 43,914)

CERTIFICATE OF SERVICE

I hereby certify that, pursuant to 37 C.F.R. § 42.6(e) and with the agreement of counsel for Petitioner, a true and correct copy of **PATENT OWNER'S PRELIMINARY RESPONSE AND EXHIBITS 2001-2014** are being served electronically on November 19, 2021, to the e-mail addresses shown below:

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