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

PRELIMINARY REPLY

Updated List of Exhibits

Exhibit No.	Description	Identifier
1001	U.S. Patent No. 10,532,709	'709 Patent
1002	U.S. Patent No. 10,532,709 File History	'709 Patent FH
1003	Declaration of Scott Andrews	Andrews Decl.
1004	Curriculum Vitae of Scott Andrews	
1005	*Safe Driving Technologies LLC v. Ford Motor Company*, No. 21-cv-64-MN, Ford's First Interrogatories (No. 1) served April 28, 2021	
1006	*Safe Driving Technologies LLC v. Ford Motor Company*, No. 21-cv-64-MN, Safe Driving Response to Interrogatory No. 1	
1007	https://timeandnavigation.si.edu/multimedia-asset/magellan-nav-1000-gps-receiver-1988 (accessed 11/19/2017)	
1008	TravTek Global Evaluation and Executive Summary (Publication No. FHWA-RD-96-031 March 1996)	TravTek1
1009	TravTek System Architecture Evaluation (Publication No. FHWA-RD-94-141 July 1995)	TravTek2
1010	TravTek Evaluation Orlando Test Network Study (Publication No. FHWA-RD-95-162 January 1996)	TravTek3
1011	U.S. Patent No. 5,923,294	Bacelon
1012	U.S. Patent No. 5,808,566	Behr
1013	Vehicle Location and Navigation Systems by Yilin Zhao, ©1997	Zhao
1014	Computer Networks, 3rd Ed., by Andrew S. Tanenbaum, ©1996, Prentice Hall, ISBN 0-13-394248-1	Tanenbaum
1015	Automotive Electronics Handbook, by Ronald Jurgen	Jurgen
1016	U.S. Patent No. 3,906,166	Cooper

Exhibit No.	Description	Identifier
1017	An Introduction to GSM by Redl, Weber, and Oliphant, ©1995Artech House, ISBN 0-890067-785-6	An Introduction to GSM
1018	GSM and Personal Communications Handbook, by Redl, Weber, and Oliphant, ©1998 Artech House, ISBN 0-89006-957-3	GSM and Personal Communications Handbook
1019	"History of Pagers and Beepers." ThoughtCo, Jan. 31, 2021, thoughtco.com/history-of-pagers-and-beepers-1992315	History of Pagers and Beepers
1020	Post Office Code Standardisation Advisory Group	
1021	Map Design: An On-the-Road Evaluation of the Time to Read Electronic Navigation Displays By Christopher Nowakowski and Paul Green, Report Date June 1998	UMTRI Report 98-4
1022	Map Design: An On-the-Road Evaluation of the Time to Read Electronic Navigation Displays By Christopher Nowakowski and Paul Green, Report Date June 1998	UMTRI Report 98-20
1023	U.S. Patent No. 6,612,682	Andrews
1024	Japanese Patent H10-232992	Nojima
1025	U.S. Patent No. 6,574,531	Tan
1026	U.S. Patent No. 7,711,355	Krueger
1027	U.S. Patent No. 7,484,008	Gelvin
1028	*Safe Driving Technologies LLC v. Ford Motor Company*, No. 21-cv-64-MN, D.I. 21, Scheduling Order	
1029	U.S. Patent Publication No. 2002/0070852	Trauner
1030	U.S. Patent No. 9,047,170	‘170 Patent
1031	*Intentionally Left Blank*	
1032	*Intentionally Left Blank*	
1033	60/336,293 Provisional Patent Application	‘293 provisional
1034	60/390,877 Provisional Patent Application	‘877 provisional

Exhibit No.	Description	Identifier
1035	*Huvepharma EOOD v. Associated British Foods, PLC*, Civil Action No. 18-129-RGA, 2019 U.S. Dist. LEXIS 139034, at *2-3 (D. Del. August 12, 2019 and *Ethicon LLC v. Intuitive Surgical, Inc.*, No. 17-871-LPS, 2019 U.S. Dist. LEXIS 45452, at *2 (D. Del. Mar. 20, 2019)	
1036	*Safe Driving Technologies LLC v. Ford Motor Company*, No. 21-cv-64-MN, Signed Stipulation to Modify Scheduling Order (DI 50) dated Aug. 26, 2021	
1037	*Safe Driving Technologies LLC v. Ford Motor Company*, No. 21-cv-64-MN, SDT Notice of Service of Initial Claim Charts (DI 41) dated July 12, 2021	

TABLE OF AUTHORITIES

Cases

Apple Inc. v. Fintiv, Inc.,
IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020)..... 3

Apple Inc., v. Seven Networks, LLC,
IPR2020-00707, Paper 11 (PTAB Oct. 22, 2020) 3

Ethicon LLC v. Intuitive Surgical, Inc., No. 17-871-LPS,
2019 U.S. Dist. LEXIS 45452 (D. Del. Mar. 20, 2019)..... iii, 1, 2

Facebook, Inc. v. USC IP Partnership, L.P.,
IPR2021-00033, Paper 13 (PTAB Apr. 30, 2021).....2, 4

Huvepharma EOOD v. Associated British Foods, PLC,
Civil Action No. 18-129-RGA,
2019 U.S. Dist. LEXIS 139034 (D. Del. August 12, 2019)..... iii, 1

SDT's *Fintiv* response focuses on a later-filed petition (IPR2022-00086 for the '108 Patent) to request denial of this earlier-filed Petition, which will reach final determination ***on or before***[1] the Feb. 21, 2023 trial date. As Ford explains in IPR2022-00086[2] and below, the Board should not exercise its discretion and deny institution pursuant to *Fintiv*.

A. Factor 1: The District Court is likely to Stay the Case

The location of the parallel litigation—the District of Delaware—has a history of staying proceedings when an IPR is instituted. *Huvepharma EOOD v. Associated British Foods, PLC*, Civil Action No. 18-129-RGA, 2019 U.S. Dist. LEXIS 139034, at *2-3 (D. Del. Aug. 12, 2019); *Ethicon LLC v. Intuitive Surgical, Inc.*, No. 17-871-LPS, 2019 U.S. Dist. LEXIS 45452, at *2 (D. Del. Mar. 20, 2019). (Ex.1035.) In *Ethicon*, there were seven patents all with IPR challenges. And even though all challenged claims were not instituted, claim construction had already occurred, and

[1] The deadline for final determination is no later than Sunday, Feb. 19, 2023, but because Feb. 20, 2023 is a federal holiday, the last possible date is Feb. 21, 2023.

[2] SDT alleges that "Petitioner Ford provides no explanation as to why it waited so long to file its [] Petitions." (POPR at 10.) But SDT ignores that Ford addressed the relevant *Fintiv* factors—*e.g.*, the trial date, diligence, and stay. (*Ford Motor Company v. Safe Driving Technologies, LLC*, IPR2022-00086, Paper 1 at 1-3.)

fact discovery had closed, the Delaware court granted a stay pending the outcome of all instituted IPRs because "the potential for simplification of the issues in this case is quite substantial." *Id.* at *3-4.

A stay is even more appropriate in this case. Here, the current IPR would be instituted no later than Feb. 21, 2022[3], ***before*** the claim construction hearing on Aug. 19, 2022, ***before*** the close of fact discovery on April 29, 2022, and ***before*** the beginning of expert discovery on May 16, 2022. (Ex.1036 at 2-3.) And there will be a final determination no later than Feb. 20, 2023, ***before*** trial on Feb. 21, 2023. (*Id.*) Even if the Board considers IPR2022-00086, its institution decision is due no later than May 18, 2022—still before the claim construction hearing and trial, and while expert discovery is just beginning. In addition, Ford's IPRs collectively challenge all asserted claims in the parallel litigation. Ford's IPRs thus have the potential to moot SDT's case. For the reasons discussed in *Ethicon,* the district court in the parallel litigation is likely to grant a stay.[4]

[3] The actual deadline is Feb. 19, 2022, which is a Saturday.

[4] At a minimum this factor is neutral because a stay has not yet been requested, and "it would be improper to speculate, at this stage, what the district court might do regarding a motion to stay, should one be granted." *Facebook, Inc. v. USC IP Partnership, L.P.*, IPR2021-00033, Paper 13, at *9 (PTAB Apr. 30, 2021).

B. Factor 2: Proximity to the District Court's Trial Date

As stated above, a final determination for this IPR would occur on or before the Feb. 21, 2023 trial date in the parallel litigation. Thus, this factor does not favor exercising a discretionary denial.

SDT focuses its analysis on the statutory deadline for IPR2022-00086. SDT ignores that it did not provide its infringement positions to Ford—including its identification of the allegedly infringed claims—until July 12, 2021. (Ex.1037.) SDT identified 47 claims out of 170 total claims in the four asserted patents. Given the volume of claims, Ford waited until the claims were identified before filing its IPRs, which it did promptly, filing this IPR on Aug. 6th, IPR2021-01341 on Aug. 3rd, and IPR2021-01446 on Aug. 30th—all around or before the roughly 18-months until trial deadline. Ford filed IPR2022-00086 on Oct. 22, 2021, specifically because the '108 Patent includes 113 claims—making it more difficult to predict which claims were going to be asserted before SDT served its infringement contentions. The proximity that the IPRs were filed to SDT's infringement contentions weighs against denying institution. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at *11 (PTAB Mar. 20, 2020) ("[i]f the evidence shows that the petitioner filed the petition expeditiously, ***such as promptly after becoming aware of the claims being asserted***, this fact has weighed against exercising the authority to deny institution") (emphasis added); *Apple Inc. v. Seven Networks, LLC,* IPR2020-00707, Paper 11, at *13

(PTAB Oct. 22, 2020).

C. Factor 3: Investment in the Parallel Proceeding

As discussed above, the current IPR would be instituted ***before*** the claim construction hearing, the close of fact discovery, and the beginning of expert discovery. And the latest institution date for IPR2022-00086 is May 18, 2022—still before the claim construction hearing and at the beginning of expert discovery. In contrast, the denial decisions cited by SDT (many pre-*Fintiv*) were further advanced with at least claim construction rulings completed before the institution decisions. (*See Next Caller, E-ONE, ZTE, Intel, NHK Spring, Fintiv*, POPR at 24, 27-28.)

Thus, even looking solely at IPR2022-00086, the limited investment by the district court and parties weighs against denial. *Fintiv* at *10 ("[i]f at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution"). And, as discussed, Ford was diligent in filing its petitions soon after SDT served its infringement contentions, which also weighs against the Board exercising its discretion under this factor. *See Facebook* at *13.

D. Factor 6: Other circumstances do not support discretionary denial[5]

[5] Regarding Factor 4, Ford has raised the invalidity grounds it raises here in the parallel litigation to ensure that it has reserved its rights to make all invalidity

SDT argues that Ford was not diligent because of Ford's alleged exposure to the inventor Naboulsi's patent family from 2003-2015—***6-to-18 years before SDT filed its lawsuit***. (POPR at 28-33.) However, the '709 Patent did not issue until 2020, so the claims at issue in this Petition did not even exist when SDT argues Ford was not diligent. (Ex.1001.) SDT's diligence argument is meritless.

SDT further contends the Board should exercise its denial discretion because "the merits of the Petition are weak." (POPR at 33.) Ford disagrees for all the reasons set forth in its Petition. For example, for Grounds 1 and 2, SDT does not even identify a specific element it contends is missing from the proposed obviousness combinations, nor a specific reason why the references are not obvious to combine. (POPR at 48-49.) The merits of Ford's Petition are strong and clearly demonstrate that each challenged claim of the '709 Patent are obvious in view of the cited prior art.

For all the reasons discussed above, the Board should not exercise its discretion to deny IPR2021-001353.

Dated: December 17, 2021 /Christopher C. Smith/
John S. LeRoy (Reg. No. 48,158)

arguments if there is no institution by the Board. However, to the extent the Board institutes Ford's petition, the need (if any) for those grounds to be argued before the district court will be substantially reduced.

Christopher C. Smith (Reg. No. 59,669)
John P. Rondini (Reg. No. 64,949)
Brooks Kushman P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075
(248) 358-4400

Attorneys for Petitioner

Certificate of Service

The undersigned hereby certifies that on December 17, 2021, a complete and entire copy of **Petitioner's Preliminary Reply**, was served via electronic mail to pattman2@gmail.com and skaliko@yklaw.com which provides service to the following counsel of record:

LEAD COUNSEL	BACK-UP COUNSEL
Michael E. Shanahan (Reg. No. 43,914) YK Law LLP 32 E. 57th Street, 8th Floor New York, NY 10022 Telephone: (646) 286-9286	Scott H. Kaliko (Reg. No. 45,786) YK Law LLP 32 E. 57th Street, 8th Floor New York, NY 10022 Telephone: (646) 286-9286

Respectfully submitted,

Dated: December 17, 2021

/Christopher C. Smith/
John S. LeRoy (Reg. No. 48,158)
Christopher C. Smith (Reg. No. 59,669)
John P. Rondini (Reg. No. 64,949)
Brooks Kushman P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075
(248) 358-4400

Attorneys for Petitioner

Certificate of Compliance Pursuant to 37 C.F.R. § 42.24

This paper complies with the type-volume limitation of 37 C.F.R. § 42.24. The paper contains five (5) pages, as provided by the Board in its email dated December 3, 2021.

This paper also complies with the typeface requirements of 37 C.F.R. § 42.6(a)(ii) and the type style requirements of § 42.6(a)(iii)&(iv).

Respectfully submitted,

Dated: December 17, 2021

/Christopher C. Smith/

John S. LeRoy (Reg. No. 48,158)
Christopher C. Smith (Reg. No. 59,669)
John P. Rondini (Reg. No. 64,949)
Brooks Kushman P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075
(248) 358-4400

Attorneys for Petitioner