

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FORD MOTOR COMPANY,  
Petitioner,

v.

SAFE DRIVING TECHNOLOGIES LLC,  
Patent Owner.

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

Case No.: IPR2021-01353

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**PATENT OWNER'S *FINTIV* REPLY**

**Updated List of Exhibits**

<b>Exhibit No.</b>	<b>Description</b>
<b>2001</b>	<b>SDT Initial Infringement Contentions `709 Patent</b>
<b>2002</b>	<b>SDT Document Requests with Petitioner Ford's Responses</b>
<b>2003</b>	<b>Email from Mr. Smith, Ford's Counsel, re Agreement to Produce Source Code</b>
<b>2004</b>	<b>Email from Mr. LeRoy regarding Scheduling Order</b>
<b>2005</b>	<b>Draft Scheduling Order April 12, 2021</b>
<b>2006</b>	<b>Ford's Invalidity Contentions Excerpts for the `709 Patent</b>
<b>2007</b>	<b>Declaration of Mr. Mouhamad Naboulsi</b>
<b>2008</b>	<b>2004 Email to Ford Employee, Mr. Wu, with License Terms and Response</b>
<b>2009</b>	<b>List of Patents Prosecuted by Brooks Kushman citing `108 Naboulsi Patent</b>
<b>2010</b>	<b>Exemplary Brooks Kushman IDS (2) Citing `108 Patent</b>
<b>2011</b>	<b>Ford Global Technologies (FGT) is a Subsidiary of Petitioner Ford</b>

<b>2012</b>	<b>USPTO Office Action Citing `108 Patent</b>
<b>2013</b>	<b>US Patent 9,457,816</b>
<b>2014</b>	<b>Ford Aerospace is a Subsidiary of Petitioner Ford</b>
<b>2015</b>	<b>SDT Initial Infringement Contentions `994 Patent</b>
<b>2016</b>	<b>SDT Initial Infringement Contentions `170 Patent</b>
<b>2017</b>	<b>SDT Initial Infringement Contentions `108 Patent</b>
<b>2018</b>	<b>Original Complaint filed January 21, 2021</b>
<b>2019</b>	<b>Emails regarding Ford's Late production of Core Technical Documents</b>
<b>2020</b>	<b>Unified Patents Bulletin providing Prior art and Invalidity Charts to Ford, May 2021</b>
<b>2021</b>	<b>Ford's September 2021 Response to SDT Interrogatory 3</b>
<b>2022</b>	<b>Original Scheduling Order April 14, 2021</b>

## **TABLE OF AUTHORITIES**

### **Cases**

<i>Ethicon LLC v. Intuitive Surgical, Inc.</i> , No. 17-871-LPS, 2019 U.S. Dist. LEXIS 45452 (D. Del. Mar. 20, 2019) .....	2
<i>Huvepharma EOOD v. Associated British Foods, PLC</i> , Civil Action No. 18-129-RGA, 2019 U.S. Dist. LEXIS 139034 (D. Del. August 12, 2019).....	2
<i>Bell Atlantic Corporation v. Twombly</i> , 550 U.S. 544 (2007).....	3

## **Objections**

SDT objects to Ford's *Fintiv* Reply filed December 17, 2021, as Ford's Petition on the merits now exceeds the 14,000-word limit allowed by 37 C.F.R. § 42.24. The Petition as filed contained 12,916 words, (Petition at 79) *which failed to address Fintiv at all* - which should now be deemed waived. *Fintiv* was hardly new law as of the August 5, 2021 filing date and Ford should have addressed it then as SDT did in its POPR. Otherwise, Ford gains a tactical advantage. This reply includes an additional 1,143 words placing the effective length of Ford's Petition over 14,000 words violating statutory limits.

## **Introduction**

The foregoing notwithstanding, Ford's reply fails to provide any compelling rebuttal to SDT's POPR *Fintiv* positions relying on mischaracterization, omitted facts, and confusion with the content of its other later filed petitions. For the reasons set forth below, and in the *Fintiv* sections of the POPR at pages 21-33 and 46-47 the Board should exercise discretion and deny institution.

### **A. Factor 1: The District Court is not likely to Stay the Case**

Ford confirms that there are *no* instances, including in reported case law, where Judge Noreika, - the trial judge - issues a Stay based on institution *of some* of the claims in the case. None. Instead, it relies on cases from Judge Andrews

(*Huvepharma*) and former Judge Stark (*Ethicon*) even though those cases have different fact patterns – both which are favorable to SDT. For example, in *Huvepharma* - *all claims* asserted in the litigation were instituted before the Stay was granted. In *Ethicon*, the vast majority of the claims (from 6 of 7 asserted patents) were instituted before a Stay was granted. The clear takeaway from these cases is that most or all of the claims need to be instituted *before* the Court will even consider a Stay. This is SDT’s exact position in its POPR at 21-25.

However, the opposite is true for *this* IPR where only 7 of 46 asserted claims, about 15%, are at issue in this Petition. From Ford’s own case law and Judge Noreika’s record, it’s clear that a Stay won’t be considered until *all* the IPRs have an institution determination, and *at least a majority* (or all) of the asserted claims, are, in fact, *instituted*. This will not be known until about May 18, 2022, as pointed out in SDT’s POPR at 21-25. Ford’s analysis for other dates regarding Factor 1 are irrelevant. Moreover, any speculation that any Stay request would go against the weight of past performance evidence on the record is unrealistic. Accordingly, this factor weighs strongly against institution. Moreover, if source code review results in new claims being asserted - no Stay will likely be granted (POPR at 22).

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

A FWD for this IPR would occur on February 21, 2023, the same day as trial in the parallel litigation. Accordingly, this factor is neutral and does not outweigh the other factors strongly against institution. Ford’s other arguments in this section

mischaracterize or omit key facts which materially change the complexion of its positions. *This IPR* deals with only the '709 patent and SDT treats it as such. The '709 has only *15 claims*, 7 of which are asserted. Ford essentially complains it had no notice of which of the 15 claims in the '709 were asserted until July 12, 2021 when infringement contentions were served. This is simply not true. The Complaint (Ex. 2018) at Count 3, filed and served on January 21, 2021, which is *Twombly* compliant, identifies with great detail why claim 1 is infringed. Asserted independent Claims 14 and 15 include all of the same or similar elements and are infringed for exactly the same reasons as claim 1, as are asserted dependent claims 2-4 and which merely specify data source and a data bus, all of which can be readily seen from the explanation in the Complaint. Accordingly, given the small number of claims in the '709 and the similarity to the claims asserted in the Complaint – Ford knew with reasonably certainty by January 21, 2021 which, if not all of the 15 claims of the '709 would be asserted and could have easily proceeded on that basis without any prejudice or undue expense. The argument regarding other IPRs and other claims are irrelevant to the *Fintiv* factors for *this* Petition and are addressed in other papers filed by the parties.

Moreover, this is a problem of Ford's own making. Ford was required to produce its core technical documents by June 7, 2021 (Ex. 2022) from which SDT would produce infringement contentions. However, this did not occur until late June 2021 (Ex. 2019) necessitating SDT to provide its contentions later than the original

date - on July 12, 2021. SDT should not be prejudiced by Ford's failure to timely produce core technical documents resulting in a delay that it now complains of as a basis for relief. Furthermore, Ford is a member of "patent killing" entity Unified Patents which awarded prize money and provided the results of its prior art search including an invalidity chart for all of the claims in the parent patent (9,713,994 - IPR 2021-01341) from Apex Standards, Techson IP (and others) to Ford in early May 2021. Ex. 2020. Despite having all this information, and only 15 claims to address, Ford still waited *three* months to file its second IPR from that date. Accordingly, this factor weighs against institution.

**C. Factor 3: Investment in the Parallel Proceeding**

Despite Ford's characterization to the contrary, as of May 18, 2022 a very substantial investment on this case will have been made with final contentions filed (April 8, 2022 and April 14, 2022, respectively), fact discovery complete (April 29, 2022), Markman briefing complete (April 11, 2022), with Opening Expert reports exchanged (May 16, 2022). See POPR at 21-25. Even as of February 21, 2022, almost all claim construction briefing is complete (February 14, 2022) and document production completion only a week away. Ford's observation that the Markman hearing is not until August does not change the fact that roughly 80% of case expenses will be incurred by May 18, 2022, at which point the case will just "start in the PTAB" extending the date to complete the District Court case out into late 2024, thus clearly thwarting Congressional intent of a speedy resolution to patent matters.



**Factors 4 and 5** – Ford does not dispute that these factors weigh in favor of discretionary denial.

**D. Factor 6: Other circumstances support discretionary denial**

Ford in-house and IPR counsel do not deny extensive and longstanding knowledge of the Naboulsi portfolio which included IDSs filed in connection with at least 5 patents that have issued in the last 3 years (Ex. 2009). Moreover, when asked by SDT through interrogatory about Ford’s knowledge of the asserted patents, Ford unbelievably responded it had no knowledge at all before the filing of the suit and admits it has taken **no steps** to investigate such as of September 2021. Ex. 2021. This is **not diligence**, but rather an attempt to obfuscate well established facts for Ford’s benefit. Any claim by Ford that it was diligent is simply not credible. Moreover, the merits of the Petition are fundamentally flawed as set forth in the POPR at 37-50.

Accordingly, this factor weighs strongly in favor of the Board exercising its discretion to deny institution.

Respectfully submitted,

Dated: December 31, 2021

/s/ Michael E. Shanahan  
Michael E. Shanahan (Reg. No. 43,914)  
Lead Counsel for SDT  
YK LAW LLP  
32 E. 57<sup>th</sup> Street, 8<sup>th</sup> Floor  
New York, NY 10022  
Tel.: (646) 286-9286  
[pattman2@gmail.com](mailto:pattman2@gmail.com)

Scott H. Kaliko (Reg. No. 45,786)  
[skaliko@yklaw.com](mailto:skaliko@yklaw.com)

**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).

Dated: December 31, 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 **SDT'S *FINTIV* RESPONSE AND EXHIBITS 2001-2022** are being served electronically on December 31, 2021, to the e-mail addresses shown below:

John S. LeRoy (Reg. No. 48,158)  
Brooks Kushman P.C.  
1000 Town Center, 22<sup>nd</sup> Floor  
Southfield, MI 48075  
(248) 358-4400  
[jleroy@brookskushman.com](mailto:jleroy@brookskushman.com)

Christopher C. Smith (Reg. No. 59,669)  
Brooks Kushman P.C.  
1000 Town Center, 22<sup>nd</sup> Floor  
Southfield, MI 48075  
(248) 358-4400  
[csmith@brookskushman.com](mailto:csmith@brookskushman.com)

John P. Rondini (Reg. No. 64,949)  
Brooks Kushman P.C.  
1000 Town Center, 22<sup>nd</sup> Floor  
Southfield, MI 48075  
(248) 358-4400  
[jrondini@brookskushman.com](mailto:jrondini@brookskushman.com)

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Dated: December 31, 2021

/s/ Michael E. Shanahan  
Michael E. Shanahan (Reg. No. 43,914)  
Scott H. Kaliko (Reg. No. 45,786)

Attorneys for SDT  
Safe Driving Technologies

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