

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZF FRIEDRICHSHAFEN AG, ZF ACTIVE SAFETY AND
ELECTRONICS US LLC,
AND NISSAN MOTOR COMPANY, LTD.,

Petitioners,

v.

FORAS TECHNOLOGIES LTD.,

Patent Owner.

Case IPR2024-00969
U.S. Patent No. 7,502,958

**PATENT OWNER'S PRELIMINARY RESPONSE
TO THE PETITION**

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TABLE OF AUTHORITIES

Cases

<i>Ericsson Inc. v. Uniloc 2017 LLC</i> , IPR2020-00420, Paper 7 (PTAB June 18, 2020)	5
<i>General Plastic Industries Co. v. Canon Kabushiki Kaisha</i> , IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017)	1

TABLE OF EXHIBITS

Exhibit No.	Description
2001	<i>Foras Technologies Ltd. v. Nissan Motor Company, Ltd., et al.</i> , No. 1:23-cv-00640-RP, Dkt. 1, Complaint (filed June 6, 2023)
2002	<i>Foras Technologies Ltd. v. Nissan Motor Company, Ltd., et al.</i> , No. 1:23-cv-00640-RP, Dkt. 20, Summons Returned Executed as to Nissan Motor Company, Ltd. (filed February 6, 2024)
2003	<i>Foras Technologies Ltd. v. Nissan Motor Company, Ltd., et al.</i> , No. 1:23-cv-00640-RP, Dkt. 13, Summons Returned Executed as to ZF Friedrichshafen AG (filed December 6, 2023)

Patent Owner Foras Technologies Ltd. respectfully requests that the Board decline to institute *inter partes* review of claims 9-12 and 23-25 of U.S. Patent No. 7,502,958 (the “958 Patent”) as requested by Petitioners.

I. INTRODUCTION

The Board should deny institution because the Petition is a serial petition that runs afoul of the guidelines laid out in *General Plastic Industries Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i). This is the second petition filed by Petitioners to challenge the ’958 Patent. Substantial portions of the Petition are identical to arguments made in the first petition, based on exactly the same alleged prior art. As to the three new references introduced here, Petitioners admit they were aware of them when the first petition was filed months ago.

II. DENIAL IS APPROPRIATE UNDER *GENERAL PLASTIC*

The guidance of both the precedential *General Plastic* decision and the Trial Practice Guide strongly favors denial of the Petition. Petitioners admit that the Petition presents grounds for challenging the limitations of claim 1 that are identical to the grounds for challenging those

limitations in its first IPR petition. And Petitioners also admit to having known of the art asserted here since the time when the first petition was filed. As the Trial Practice Guide explains, “if a petitioner files two or more petitions challenging the same patent, then the petitioner should ... identify: (1) a ranking of the petitions ..., and (2) a succinct explanation of the differences between the petitions, why the issues addressed are material,” (TPG 59-60) but Petitioners here provided no ranking of the petitions and did not argue whether the new references relied upon here are more material to the validity of the '958 Patent than the references previously relied upon. Institution should be denied.

A. Factor 1: Whether the same petitioner previously filed a petition directed to the same claims of the same patent

Petitioners' first IPR challenged, among others, claim 1 of the '958 Patent. The Petition here challenges claims 9-12 and 23-25 of the '958 Patent. Claims 9-12 depend from claim 1, and Petitioners admit that “the grounds herein for challenging the limitations of claim 1 are identical to those in the Joinder IPR.” Pet. 73. Because claim 1 was previously challenged and Petitioner must show that the limitations of claim 1 are met to demonstrate unpatentability of dependent claims 9-12, the

Petition does in effect challenge the same claims. Petitioner's suggestion that the outcome as to those claims will be "effectively controlled" by the Joinder IPR is unsupported. If the Petition is instituted, Petitioner will have a roadmap with which to tailor its arguments and evidence throughout this proceeding. This factor favors denial.

B. Factor 2: Whether at the time of filing the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it

Petitioners readily admit that they knew of the new prior art relied upon in the Petition (Goodrum, Safford, and Suffin) at the time of filing the first IPR. Pet. 73. Thus, this factor undeniably favors denial. Petitioners' contention that their inability to add references to their first IPR while still seeking joinder is irrelevant here. Petitioners were not required to file a joinder petition. Their strategic choice to do so cannot be used here to excuse their knowledge of the prior art at the time the first petition was filed.

C. Factor 3: Whether at the time of filing the second petition the petitioner already received patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition

This factor strongly favors denial. At the time the Petition was filed, Petitioners admit they had already received Patent Owner's preliminary response and the institution decision to the first petition. Pet. 73. Petitioner's argument that availability of the POPR and institution decision should be given less weight because the POPR was directed only to the *Fintiv* analysis and the decision on institution was directed to different claims is flawed. Petitioners had the benefit of both documents, and the Board's analysis in the institution decision of claim 1 is directly relevant here, as those limitations must be satisfied for Petitioners to succeed on their challenges to claims 9-12. In addition, Petitioners' challenge to claims 23-25 relies on the same base combination of Bigbee and Nguyen that the Board's prior institution decision addressed.

D. Factor 4: Length of time elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition

Petitioners do not say when they learned of the prior art asserted in the Petition, although they do admit they were aware of it at least as far back as April 19, 2024. Pet. 73. The Petition was filed on June 25, 2024, more than three months after their first IPR petition was filed. This factor favors denial.

E. Factor 5: Whether petitioner provides adequate explanation for the time elapsed between filing of multiple petitions

Petitioners' explanation for the delay in filing the Petition demonstrates their entirely strategic motivations. Petitioners allege that the delay is a result of district-court infringement contentions being served on April 1, 2024. Pet. 73-74. But Petitioners cite to no case law in support of their view that delays between serial petitions are excused when district-court infringement contentions are served in the interim. To the contrary, as the Board has determined, "[i]n the context of factor five, Petitioner's accounting must begin from when it first learned that Patent Owner had filed suit accusing products designed and manufactured by Petitioner of infringing claims of the [challenged] patent." *Ericsson Inc. v. Uniloc 2017 LLC*, IPR2020-00420, Paper 7 at 12 (PTAB June 18, 2020). In other words, this factor refers to "when Petitioner first had a reason to file a petition." *Id.* at 12-13. Here, Petitioners were aware of the lawsuit accusing their products of infringing the '958 Patent by no later than December 18, 2023. EX2001 (complaint) at 8-9; EX2002 (Nissan service papers) at 1-2; EX2003 (ZF

service papers) at 1-2. Petitioners' explanation for the delay is insufficient. This factor favors denial.

F. Factors 6 and 7: The finite resources of the Board; and the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review

Petitioners allege that the Petition would not be inefficient as it challenges different claims than Petitioners' first IPR. Pet. 74. This is incorrect. Each of Petitioners' grounds in the Petition are based fundamentally on the combination of Bigbee and Nguyen. *See* Pet. 21. As to the motivation to combine those references and the mechanism for combining those references, Petitioners acknowledge presenting an identical argument to that raised in the first petition. Pet. 74. As a result, the Board's decision on the merits here would necessarily address substantially overlapping issues based on the same prior art. But, as this matter develops, it would likely involve new arguments and evidence (e.g., in the form of new reply arguments and expert testimony). This would represent an enormously inefficient use of the Board's resources.

Date: October 16, 2024

Respectfully submitted,

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Lead counsel for Patent Owner

CERTIFICATION REGARDING WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), Patent Owner certifies that there are no more than 1,207 words in the paper excluding the portions exempted under 37 C.F.R. § 42.24(a)(1).

Dated: October 16, 2024

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that the above document was served on October 16, 2024, by filing this document through the Patent Trial and Appeal Case Tracking System as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioner:

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