

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,
Petitioner,

v.

NIKOLA CORPORATION,
Patent Owner.

Case No. IPR2019-01646
U.S. Patent No. 10,077,084

**PATENT OWNER'S PRELIMINARY RESPONSE TO THE PETITION
FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 10,077,084**

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I. INTRODUCTION

Nikola Corporation (“Nikola” or “Patent Owner”) submits this Preliminary Response to the Petition for *Inter Partes* Review (the “Petition” or “Pet.”) of U.S. Patent No. 10,077,084 (the “’084 patent”) filed by Tesla, Inc. (“Tesla” or “Petitioner”) on September 24, 2019.

The Petition fails to demonstrate a reasonable likelihood that the Petitioner would prevail with respect to any claim of the ’084 patent. Specifically, no reference cited in the Petition discloses or suggests the following claim features required by independent claim 1:

1. “[A]t least a portion of the door being positioned behind the seat and;”
2. “at least a portion of the seat is disposed to be forward of a line defining the rearmost portion of the front wheel well;”
3. “such that the door opens to provide ingress and egress into the cabin from a backside of the seat.”

Ex. 1001, claim 1 (the “relative positioning limitations”).¹ The Petition insists that the relative positioning limitations are “trivial” and “not innovative” but, presumably

¹ This language is found in independent claim 1 and claims 2-15 depend from and include all limitations of claim 1. Independent claim 26, the only other independent claim, includes nearly identical, though not exact, versions of these limitations.

after performing an extensive search for prior art, Petitioner cites only a single reference as allegedly disclosing those limitations. Because that reference, Modec,² does not disclose or suggest the precise relative positioning of the seat, wheel well, and door required by all claims of the '084 patent, the Petition must be denied.

The Petition relies exclusively on FIG. 1 to support of its assertion that Modec discloses the relative positioning limitations:

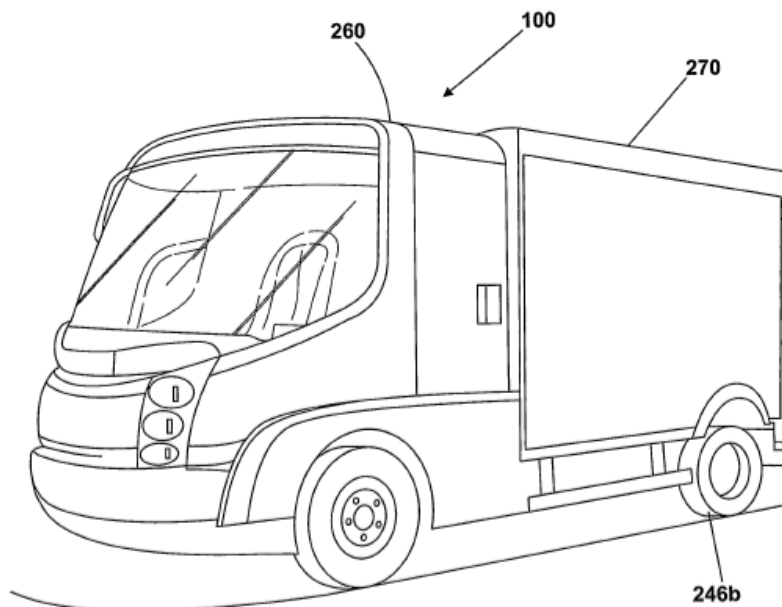


Fig. 1

As seen here, FIG. 1 shows a rough drawing of a vehicle from an unspecified angle and height, with no dimensions or markings showing or suggesting the relative positions of the seat, wheel well, and door. Notably, the Petition cites no written description describing the relative positions of the seat, wheel well, and door, and

² WO 2009/001086 to Modec (“Modec”).

Modec provides no such description. The only other Modec disclosure cited for this limitation provides no information on the relative positioning of the elements in FIG. 1: “The door module can then, optionally, unlock a door lock mechanism 940 associated with that module to allow the driver to access the vehicle through the door.” Ex. 1004 at 22:18-20.³ The relevant portion of Petitioner’s expert declaration, like the Petition itself, merely repeats the exact claim language with no supporting analysis or explanation, and therefore should be afforded no weight.

To summarize, the entire Petition rests on a single rough figure, FIG. 1 of Modec, to satisfy what the Petition alleges are the key limitations of the two independent claims. That figure is not marked with dimensions and Modec does not assert that the figure is drawn to scale. Although Patent Owner does not dispute that Modec FIG. 1 discloses a wheel well, a door, and a seat, neither FIG. 1 nor any other disclosure in Modec teaches or suggests “at least a portion of the door being positioned behind the seat,” “at least a portion of the seat is disposed to be forward of a line defining the rearmost portion of the front wheel well,” or “such that the door opens to provide ingress and egress into the cabin from a backside of the seat.” No amount of bluster or hand waving can distract from that clear deficiency in

³ This Response uses an abbreviated citation method for patent references in which, e.g., a citation of 22:18-20 refers to column 22, ll. 18-20.

Modec. None of the other references cited in the Petition remedy these deficiencies of Modec, and the Petition does not so allege.

For at least these reasons, the Petition does not establish a reasonable likelihood that any claim of the '084 patent is invalid and therefore must be denied.

II. STATEMENT OF THE PRECISE RELIEF REQUESTED

Patent Owner requests that the Board deny institution of the Petition with respect to all challenged claims and all asserted grounds. A full statement of the reasons for the relief requested is set forth in Sections V. and VIII.

III. TECHNICAL BACKGROUND AND THE '084 PATENT

The '084 patent discloses an electric powered semi-truck that increases user safety by simplifying entry into a cabin of the semi-truck and by leveraging the lack of a traditional combustion engine to locate the driver's seat closer to the front of the cabin such that the driver has greatly increased visibility compared to drivers of prior art semi-trucks.

The '084 patent explains that “vehicle doors, and particularly semi-truck doors, often provide immediate access to a seat located in the body of the vehicle,” and “require a user to enter or exit the vehicle at an angle that may be uncomfortable or even dangerous.” Ex. 1001, 1:36-40. Because “[s]emi-truck doors and seats are located a significant distance above the ground,” “a user must be cautious to avoid injury when ascending the steps to the semi-truck door, opening the hinged semi-

truck door, and sliding on to the seat while closing the hinged door.” *Id.* at 1:40-45. The ’084 patent solves these problems by positioning the door such that at least a portion of the door is behind the seat so that “the door opens to a landing . . . and a person may comfortably step into the vehicle body 102 while facing forward into the vehicle body 102.” *Id.* at 6:11-14. In the claimed invention, the door is also positioned “adjacent to a rearmost portion of a front wheel well.” *Id.* at 16:10-12; *see also* 5:23-25 and FIG. 1.

The ’084 patent also notes that “the inclusion of an electric motor, and the elimination of a standard combustion engine, may allow for the reconfiguration of the layout and structure of a standard semi-truck” in ways that are “advantageous to a user.” *Id.* at 4:22-28. After experimenting and exploring optimal placement, the inventors of the ’084 patent discovered that one such advantage is that “the at least one seat [can] be located at a position nearer the front of the vehicle body 102 than in a conventional semi-truck.” *Id.* at 4:28-32. Specifically, the inventors found that the seat could be located at least partially above the wheel well, and thereby the driver would be positioned closer to the windshield, providing several advantages. *Id.* at 7:36-38. “[L]ocating a seat 510 near the front of the vehicle body 102 and providing a panoramic view of the surroundings will increase safety and visibility when operating the vehicle.” *Id.* at 7:42-45.

IV. CLAIMS OF THE '084 PATENT

The '084 patent contains twenty-six (26) claims. Ex. 1001 at 15:64-18:26. Claims 1 and 26 are independent and claims 2-25 depend from and add limitations to claim 1. Challenged independent claims 1 and 26 are reproduced below for ease of reference.

Claim 1

1. A semi-truck vehicle comprising:

an electric drive train;

a body;

a cabin located within the body of the semi-truck vehicle, wherein the cabin comprises an interior that is configured to accommodate at least one person;

a seat located in the interior of the cabin that is configured for seating a user; and

a door comprising a width extending a horizontal length of the door, wherein the door provides ingress and egress to the interior of the cabin of the semi-truck vehicle;

wherein the door is located on the body such that a frontmost side of the door is adjacent to a rearmost portion of a front wheel well and the width of the door is disposed between the frontmost side

of the door and a rearmost side of the door, at least a portion of the door being positioned behind the seat and at least a portion of the seat is disposed to be forward of a line defining the rearmost portion of the front wheel well such that the door opens to provide ingress and egress into the cabin from a backside of the seat; and

wherein the door is the foremost door providing ingress or egress into the interior of the cabin.

Claim 26

26. A semi-truck vehicle comprising:

an electric drive train;

a body;

a cabin located within the body of the vehicle, wherein the cabin comprises an interior that is configured to accommodate at least one person;

a first seat and a second seat located in the interior of the cabin;

a door that provides ingress and egress to the interior of the cabin, the door being located on the body such that a frontmost side of the door is adjacent to a rearmost portion of a front wheel well and

at least a portion of the door being positioned behind the first seat, at least a portion of the first seat is disposed to be forward of a line defining the rearmost portion of the front wheel well; and

an entryway provided between the first seat and the second seat, wherein the entryway comprises a vertical height extending from a floor of the cabin to at least a top of the first seat or the second seat;

wherein the entryway provides access to either of the first seat or the second seat.

V. CLAIM CONSTRUCTION

Petitioner seeks construction of two claim terms: 1) “Adjacent to” and 2) “electric drive train.” Both terms appear in all claims of the ’084 patent.

The claims here are to be construed, if necessary, under the *Phillips* standard. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc); *see* 37 C.F.R. § 42.100(b). Under that standard, the words of a claim generally are given their ordinary and customary meaning. *Phillips*, 415 F.3d at 1312. “[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.” *Id.* at 1313. The person of ordinary skill in the art is deemed to read the claim term not

only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification. *Id.*

The Board need only construe terms “that are in controversy, and only to the extent necessary to resolve the controversy.” *Nidec Motor Corporation v. Zhongshan Broad Ocean Motor Co. Ltd. Matal*, 868 F.3d 1013, 1017 (Fed. Cir. 2017); citing *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). When construction of a claim term is not “material to the [obviousness] dispute,” that term need not be construed. *Id.*

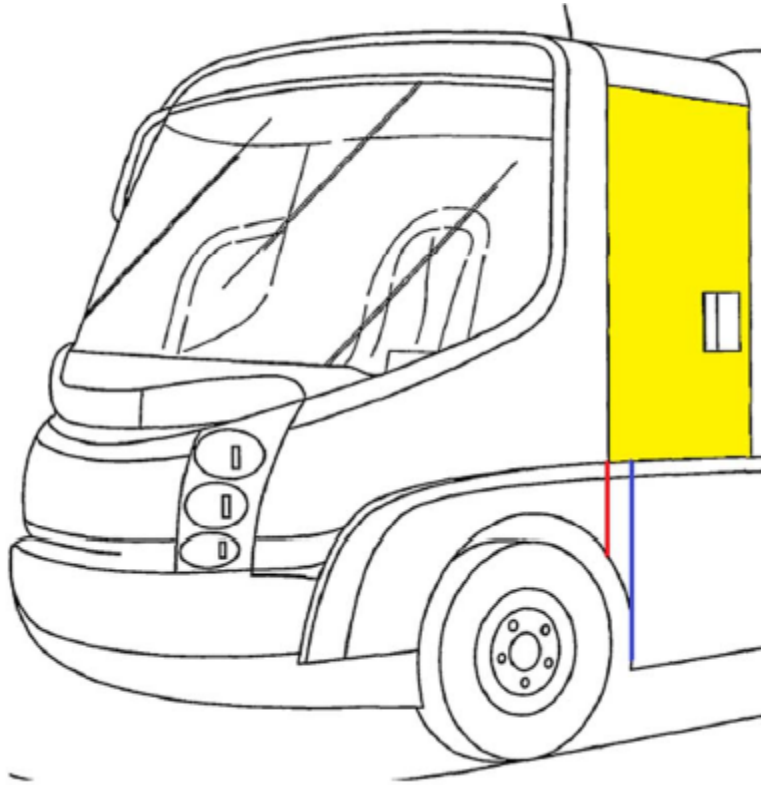
A. “adjacent to” (all claims)

Petitioner asserts that the proper construction of “adjacent to” is “nearby but not touching.” Petitioner’s proposed construction should be rejected for several reasons.

i. “Adjacent” should not be construed because its construction is not material to the obviousness dispute raised by the Petition

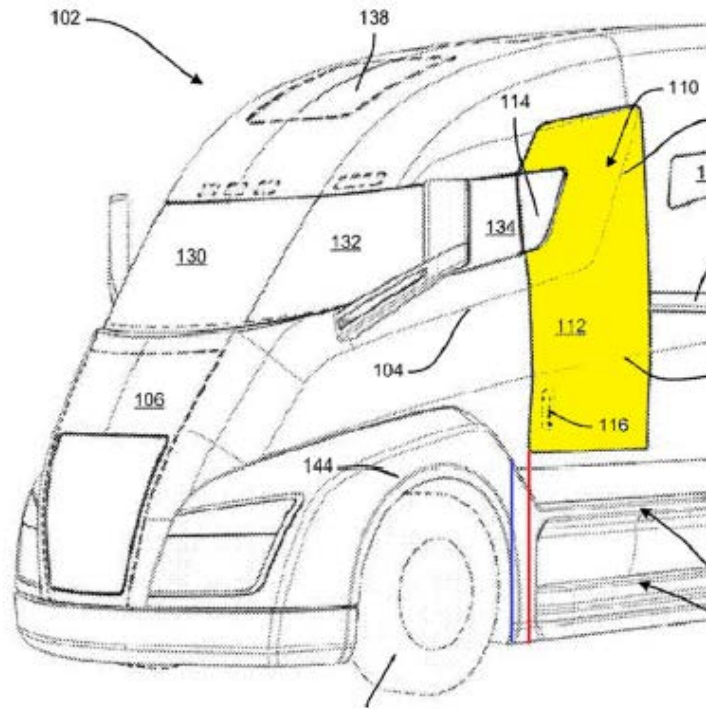
First, the construction of “adjacent to” is not material to the validity determination sought by the Petition and therefore the term need not be construed to resolve this Petition. The term “adjacent to” is used in each of the two independent claims of the ’084 patent to describe the relative positions of the door and the front wheel well. As recited in claim 1, “the door is located on the body such that the frontmost side of the door is adjacent to a rearmost portion of a front wheel well.”

(emphasis added).⁴ The Petition cites only one reference, Modec, as disclosing the “adjacent to” limitation. *See* Pet. at pp. 34-37 and 560. Specifically, the Petition presents a marked-up version of Modec FIG. 1 to show that the door is adjacent to a front wheel well:



Pet. at 48-49; *see* Ex. 1004. FIG. 1. As the Petition notes, the position of the Modec door relative to a front wheel well is nearly identical to the relative position of those elements as shown in FIG. 1 of the '084 patent:

⁴ Claim 26 of the '084 patent recites a nearly identical limitation: “the door being located on the body such that a frontmost side of the door is adjacent to a rearmost portion of a front wheel well.”



Pet. at 50; *see* Ex. 1004. FIG. 1. Patent Owner does not dispute that, under the ordinary and customary meaning of “adjacent to,” Modec discloses a door that is “adjacent to” a rearmost portion of a front wheel well. As a result, there is no need to construe “adjacent to” because there is no dispute as to whether Modec discloses the “adjacent to” limitation. *See Vivid Techs.*, 200 F.3d at 803; *see also* Pet. at 12 (noting that “the Board need only construe claim terms as necessary to resolve the parties’ disputes” but failing to set forth any reason why construction of “adjacent to” addresses any dispute raised in the Petition).

That is especially true where, as here, Petitioner attempts to read into the claims a negative limitation that is not found in or supported by the specification. As detailed below, the ’084 patent never uses the phrase “but not touching” and does

not support including that phrase in any construction of “adjacent to.” Coupled with the irrelevance of Petitioner’s proposed construction to the obviousness dispute at hand, this raises questions about the ultimate purpose of Petitioner’s proposed construction and the Petition as a whole. For example, Petitioner uses over three full Petition pages arguing for a construction of “adjacent to” that would import an unsupported negative limitation into all claims of the ’084 patent, but only dedicates two short paragraphs to its obviousness case for the relative positioning limitations, which Petitioner asserts are the limitations most key to the obviousness analysis. For at least these reasons, “adjacent to” need not and should not be construed here.

ii. If construction is necessary, the proper construction is “nearby,” not “nearby but not touching”

Second, if the Board finds that construction of “adjacent to” is necessary, the proper construction of the term is “nearby.” Petitioner’s proposed construction, which attempts to import the unsupported negative limitation “but not touching” into the claims, is not supported, much less required, by the specification of the ’084 patent or the ordinary and customary meaning of the term “adjacent to.” The ’084 patent does not suggest that the term “adjacent to” has a specialized meaning in the relevant art, and neither the Petitioner nor its expert alleges any such special meaning. *See* Pet. at 8-12; *see also* Ex. 1002 at ¶¶ 35-42. Thus, the term should be given the “full range of its ordinary meaning” (*Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342 (Fed. Cir. 2001)) as demonstrated by the intrinsic evidence and

dictionary definitions, which “are often useful to assist in understanding the commonly understood meaning of words.” *Phillips*, 415 F.3d at 1322.

The specification passages and figures cited in the Petition are consistent with “adjacent to” meaning “nearby.” Nothing in the specification of the ’084 patent dictates or supports reading the negative limitation “but not touching” into the claims. The intrinsic evidence cited by Petitioner merely shows that, in some embodiments of the invention, a door is spaced apart from the wheel well. There is nothing in the intrinsic record that *requires* separation between the door and wheel well, and the Petition cites no evidence that Patent Owner intended to limit the claims to any particular embodiment described in the specification. Thus, the intrinsic evidence does not support reading “but not touching” into the claims. *See Liebel–Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 913 (Fed. Cir. 2004) (“it is improper to read limitations from a preferred embodiment described in the specification—even if it is the only embodiment—into the claims absent a clear indication in the intrinsic record that the patentee intended the claims to be so limited.”)

Moreover, the dictionary cited by the Petitioner’s expert does not support the inclusion of “but not touching” in the construction. In relevant part, that dictionary presents the following definitions of “adjacent”:

ad·ja·cent *adjective* ˌæ-ˈjā-səntl

1 a : not distant or far off

<the city square and the *adjacent* streets>

<Chicago and *adjacent* suburbs>

: nearby but not touching

< ... only two species exist, and they occur on the South Island of New Zealand and on *adjacent* islands. — Benjamin B. Normark, *Natural History*, September 2004>

b : having a common border : **ABUTTING, TOUCHING**

<two *adjacent* properties>

< ... fishes only in the waters immediately *adjacent* to the island. — Michael Rothschild, *Bionomics*, 1990>

: living nearby or sitting or standing relatively near or close together

<hills ... composed of oyster shells ... the *adjacent* inhabitants burn them — Mark van Doren>

c : immediately preceding or following with nothing of the same kind intervening

< ... it was attempted by a would-be bank robber who mistook the entrance to an *adjacent* store for his objective. — William Murray, *The New Yorker*, 5 Oct. 1987>

2 of two angles : having the same vertex and one side in common

Ex. 1016. As seen here, the primary definition of “adjacent” is “not distant or far off,” i.e., nearby. *Id.* The dictionary also presents two definitions, “having a common border” and “having...one side in common” that are directly opposed to Petitioner’s proposed construction. Thus, while the definitions cited by Petitioner make it clear that objects that are “nearby but not touching” are adjacent, the fact that two objects have a common border (i.e., they are touching) does not render those objects non-adjacent. Other dictionary definitions also support an ordinary and customary meaning of “adjacent” that includes situations where there is “nothing in between” two objects and when objects are “next to” each other. *See* Ex. 2001 and

2002. In fact, the Petitioner’s own expert⁵ admits that the definitions “not distant or far off” and “nearby but not touching” are both consistent with the ordinary meaning of adjacent and the usage of the phrase in the specification, and that only the definition that *requires* a common border is inconsistent with the specification’s usage of “adjacent to.” Ex. 1002 at ¶ 36. Thus, if construction of “adjacent to” is deemed necessary, the proper construction is “nearby.”

iii. Petitioner’s proposed construction conflicts with other constructions of “adjacent” on similar facts

Third, at least two cases have construed “adjacent” in a situation where, as here, the term was not alleged to have a meaning specific to a particular art. The courts in those cases construed “adjacent” in a manner that is consistent with “nearby” and inconsistent with Petitioner’s proposed construction of “nearby but not touching.” In *Free Motion Fitness, Inc. v. Cybex Intern., Inc.*, 423 F.3d 1343, 1349

⁵ Little or no weight should be accorded to expert testimony on claim construction where, as here, the expert does not allege that a term has a special or accepted meaning in the art. *See Symantec Corp. v. Computer Associates Intern., Inc.*, 522 F.3d 1279, 1290-1291 (Fed. Cir. 2008) (“Such expert testimony, which does not identify the ‘accepted meaning in the field’ to one skilled in the art, is unhelpful.”) (citing *Sinorgchem Co., Shandong v. Int’l Trade Comm’n*, 511 F.3d 1132, 1137 n. 3 (Fed. Cir. 2007)).

(Fed. Cir. 2005), the Federal Circuit construed “adjacent” to mean “not distant” when it found nothing in the record that would exclude from the construction a situation where two objects of the same kind were touching. *Id.* In *Boss Industries, Inc. v. Yamaha Motor Corp. U.S.A., Inc.*, 333 Fed.Appx. 531, 541 (Fed. Cir. 2009), the court upheld the district court’s construction of “adjacent” as “next to or adjoining,” noting that “adjacent” is a commonly understood word.

iv. Even if construction is necessary, adding the negative “but not touching limitation” to a construction of “nearby” is not necessary to resolve the obviousness dispute and should therefore be avoided

Finally, as described above, the “but not touching” portion of Petitioner’s construction has no bearing on whether Modec discloses the “adjacent to” limitation – Modec would disclose that limitation regardless of whether “adjacent to” was construed to mean “nearby” or “nearby but not touching.” It therefore appears likely that Petitioner is asking the Board to include the “but not touching” limitation for purposes unrelated to the invalidity positions presented by the Petition. Thus, if construction of “adjacent to” is deemed necessary, there is no need to limit “adjacent” to a narrower construction than “nearby” because the parties agree on that portion of the construction and adding “but not touching” does not help in resolving the obviousness dispute raised by the Petition.” *See Nidec Motor*, 868 F.3d at 1017 (“Board need only construe terms ‘only to the extent necessary to resolve the controversy.’”).

B. “electric drive train” (all claims)

Patent Owner agrees with Petitioner that this limitation “would be readily understood by a POSITA and does not need an express construction.” Pet. at 12. As such, no construction is necessary. Moreover, Petitioner’s proposed clarification does nothing to aid in resolving the obviousness dispute raised by the Petition, and the Board therefore need not construe or clarify this term.

VI. LEVEL OF ORDINARY SKILL IN THE ART

Patent Owner takes no position at this time on the level of ordinary skill in the art. This is not to be taken as a concession that Patent Owner either agrees or disagrees with Petitioner’s proposed level of ordinary skill in the art.

VII. LEGAL STANDARD

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(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.

To prevail post-institution, the Petitioner must prove unpatentability by “a preponderance of the evidence.” 35 U.S.C. § 316(e). Therefore, *inter partes* review should be instituted only when the Petition and evidence submitted therewith

demonstrates a reasonable likelihood that the Petitioner will be able to prove unpatentability by a preponderance of the evidence.

The Petition presents eleven grounds, each based on obviousness under 35 U.S.C. § 103. The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); *see also KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 399 (2007).

The Petition's evidence must address every limitation of every challenged claim and must identify “with particularity” the “evidence that supports the grounds for the challenge to each claim.” *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1362, 1369 (Fed. Cir. 2016); 35 U.S.C. § 312(a)(3). “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at 418 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

VIII. ARGUMENT

The Petition does not establish a reasonable likelihood that any claim of the '084 patent is unpatentable. The Petition should therefore be denied with respect to all challenged claims and grounds.

A. Petitioner Fails to Establish that There Is a Reasonable Likelihood that Modec and Messano Render Obvious Claims 1-5, 15-16, and 25 (Ground 1)

Petitioner fails to meet its burden with respect to Ground 1 of the Petition. As noted in the Petition, the '084 patent was allowed after the following limitations were added to claim 1 (referred to herein as the “relative positioning limitations”):

4. “[A]t least a portion of the door being positioned behind the seat and;”
5. “at least a portion of the seat is disposed to be forward of a line defining the rearmost portion of the front wheel well;” and
6. “such that the door opens to provide ingress and egress into the cabin from a backside of the seat.”

Pet. at 4-5. In contrast to the Petition’s allegations, these limitations are far from trivial – they were not taught or suggested by the prior art considered by the Examiner during original prosecution and they are not taught or suggested by Modec, the only reference cited in the Petition as allegedly disclosing them, or any other reference cited in the Petition.⁶ Modec in view of Messano also fails to teach

⁶ Ground 1 of the Petition combines U.S. Patent No. 7,338,335 to Messano (“Messano,” Ex. 1005) with Modec, but the Petition relies on Messano exclusively to show an electric semi-truck and does not assert that Messano discloses any of the relative positioning limitations. *See* Pet. at 27 and 39.

or suggest “wherein the door is the foremost door providing ingress or egress into the interior of the cabin,” as recited in claim 1.

For at least these reasons, Petitioner cannot demonstrate a reasonable likelihood that it will prevail in proving, by a preponderance of the evidence, that Modec discloses those features.

i. Petitioner cannot demonstrate a reasonable likelihood that it can prevail in proving that Modec in view of Messano discloses the relative positioning limitations

Modec does not teach or suggest the relative positioning limitations. The Petition and the accompanying expert declaration rely exclusively on a marked-up version of Modec FIG. 1 provided by Petitioner’s expert, Mr. Baker:

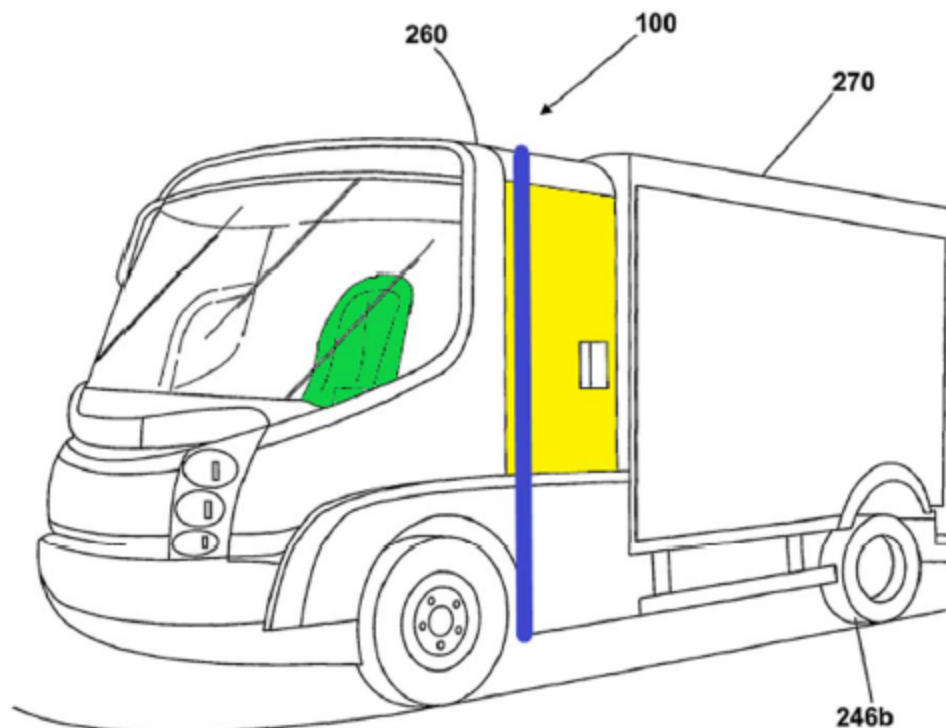


Fig. 1

Pet. at 39; Ex. 1002 at ¶ 53. This is the beginning and end of the evidence submitted by Petitioner. The Petition first states that FIG. 1 shows that “at least a portion of the door [yellow]” is “positioned behind the seat [green].” *Id.* But there is no information in FIG. 1 that would allow a person of ordinary skill in the art to arrive at that conclusion. The specification of Modec is silent as to the angle or perspective FIG. 1 is intended to represent. But it is apparent from the relative sizing of the front and rear wheels (with the rear wheel smaller than the front) and other drawing features (e.g., that a large portion of the front face of the cabin is visible while none of the back face is visible), that FIG. 1 is drawn from the perspective of a person standing some distance away from a front corner of the vehicle, and not directly from the side of the vehicle.

Thus, FIG. 1 merely discloses that the seat is to the left of the door in the angled drawing of FIG. 1. FIG. 1 provides no information as to whether any portion of the door is positioned **behind** the seat, i.e., between the seat and a rear face of the cabin. To discern that, the drawing would need to show the perspective of a person standing directly to the side or from directly above the cab, or specific relative positioning would need to be marked on the figure or described in the specification. None of those circumstances apply here. For at least the same reasons, FIG. 1 provides no information regarding whether “the door opens to provide ingress and egress into the cabin **from a backside of the seat,**” as recited in claim 1.

Similarly, FIG. 1 cannot teach or suggest that at least a portion of the seat is disposed to be forward of a line defining the rearmost portion of the front wheel well. The most that can be deduced from Mr. Baker's marked-up FIG. 1 is that the visible portion of the seat appears to the left of the blue line when viewing the figure from left to right. FIG. 1 provides no information as to whether any portion of the seat is actually positioned **forward of** a line defining the rearmost portion of the wheel well, i.e., that "at least a portion of the seat is positioned between the front face of the cabin and the rearmost portion of the wheel well," as recited in claim 1.

The inadequacy of the Petition's analysis is especially evident, where, as here, the invalidity position relies solely on a rough drawing. Modec does not disclose that FIG. 1 is drawn to scale or that it is intended to be an accurate representation of the position of any feature of the cabin relative to any other feature. No detail is given about the angle or perspective from which FIG. 1 is drawn. In such situations, opinions based on visual inspection of a drawing are of little value. *See Hockerson–Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956 (Fed. Cir. 2000) (holding that when the reference does not disclose that drawings are to scale and is silent as to dimensions, "arguments based on measurement of a drawing are of little value").

No other disclosure in Modec sheds light on FIG. 1. FIG. 1 is discussed in only three sentences of the Modec specification:

- "Figure 1 shows an electric vehicle 100." Ex. 1001 at 14.

- “The vehicle in this example is a specialist delivery vehicle, but through a simple change to the vehicle body it could be a box van or minibus or any other commercial or domestic use vehicle.” Ex. 1001 at 14-15.
- “At the rear the chassis carries a body 270 such as a closed van body as shown in Figure 1 (although other bodies can be provided).” Ex. 1001 at 16.

This lack of detail and precision regarding FIG. 1 makes sense, because Modec is primarily concerned with the specifics of a “control system for a battery powered vehicle.” Ex. 1001 at Abstract, Title. Indeed, the other nine figures and the vast majority of the thirty-page specification of Modec explain how various electrical, hardware, and software systems interact – the cabin layout is irrelevant to the Modec disclosure. There would have been no reason for an illustrator to attempt to draw FIG. 1 to scale or to accurately map out the relative positioning of elements in the vehicle’s cabin. Thus, even if Modec FIG. 1 did show the relative positioning limitations, which it does not, those relative positions could not be relied upon because there is no indication that the figure is intended to provide accuracy in cabin layout. Moreover, even if FIG. 1 did clearly show relative positions of specific elements, which it does not, those positions could be merely drawing errors or drafting mistakes, which is exactly the reason the Federal Circuit has repeatedly warned that drawings are of little probative value when not drawn to scale or accompanied by dimensions.

ii. Petitioner’s arguments regarding the relative positioning limitations are of little value because they are conclusory and rely solely on FIG. 1 of Modec, which is a rough general illustration not drawn to scale

The Petition cites FIG. 1 of Modec as disclosing all three of the relative positioning limitations. Pet. at 39-40. Petitioner cites no supporting specification passages other than an irrelevant section that “discloses that the door can be unlocked ‘to allow the driver to access the vehicle through the door.’” Pet. at. 39-40; citing Ex. 1004 at 22:18-20. To emphasize the paucity of analysis and lack of supporting rationale presented for the mapping of Modec to the relative positioning limitations, the complete section of the Petition addressing these limitations is reproduced below.

- i. “at least a portion of the door being positioned behind the seat and at least a portion of the seat is disposed to be forward of a line defining the rearmost portion of the front wheel well such that the door opens to provide ingress and egress into the cabin from a backside of the seat”

The following annotated Figure 1 of Modec shows that “at least a portion of the door [yellow]” is “positioned behind the seat [green] and at least a portion of the seat [green] is disposed to be forward of a line defining the rearmost portion of the wheel well [blue line extended from rearmost edge].” Ex. 1002 ¶ 82.

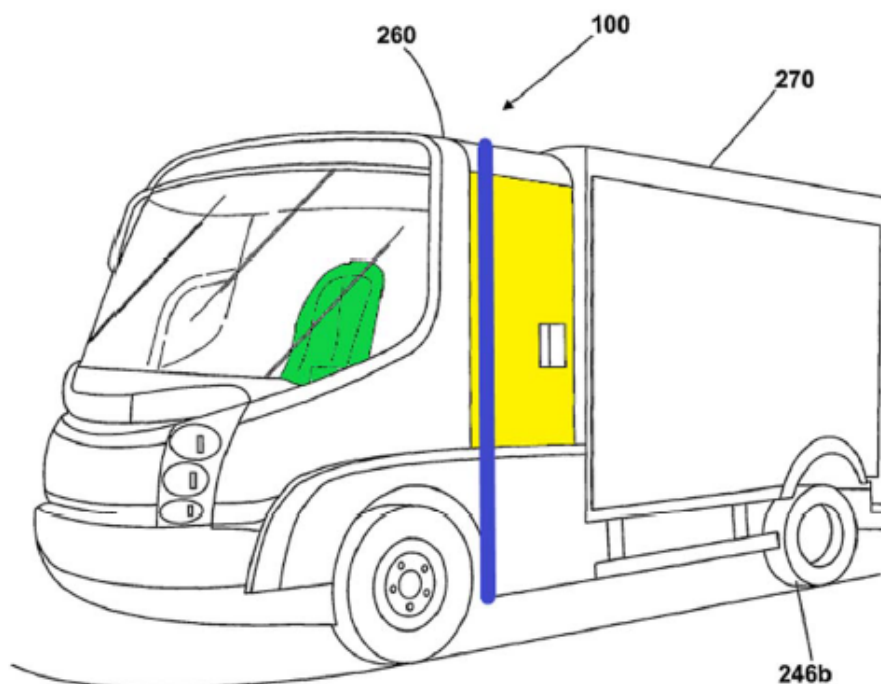


Fig. 1

Modec further discloses that the door can be unlocked “to allow the driver to access the vehicle through the door” (Ex. 1004 at 22:18-20), thereby establishing that “the door opens to provide ingress and egress into the cabin.” As explained above, the door is positioned behind the seat. Therefore, ingress and egress into the cabin, as provided by the door, can only be “from a backside of the seat.” Ex. 1002 ¶ 83.

Pet. at 39-40.⁷ This passage amounts to nothing more than a recitation of the exact claim language prefaced by “Modec shows that... .” The second paragraph demonstrates only that the door opens to allow a user to enter some portion of the cabin, which is uncontested as well as irrelevant to establishing whether the relative positioning limitations are shown by Modec.

The relevant portion of the declaration submitted by Tesla’s expert, Mr. Baker, is an exact, verbatim copy of the Petition (or vice versa). Ex. 1002 at ¶¶ 82-83. The declaration does not provide any explanation of how the expert was able to conclude from FIG. 1 that the three relative positioning limitations are taught or suggested by Modec. Moreover, neither the Petition nor the expert declaration alleges that Mr. Baker’s interpretation of FIG. 1 is based on his special knowledge as one skilled in the art, and Mr. Baker does not purport to be an expert on drawing interpretation. Mr. Baker is merely offering an unsupported and conclusory interpretation of a roughly drawn figure. This conclusory testimony cannot qualify as substantial evidence of invalidity, much less meet the higher preponderance of the evidence standard Petitioner would face post-institution. *See TQ Delta, LLC v. CISCO Systems, Inc.*, 942 F.3d 1352, 1358-1359 (Fed. Cir. 2019) (“Conclusory expert testimony does not qualify as substantial evidence.”); *see also Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1366 (Fed. Cir. 2016) (conclusory statements by expert

⁷ The colored lines on FIG. 1 were added by the Petitioner’s expert. Ex. 1002 ¶ 82.

in support of obviousness analysis may not be relied upon). This is especially true when the conclusory testimony is based on a rough drawing that is not drawn to scale and is not described in any detail in the specification. *See Hockerson–Halberstadt, Inc.*, 222 F.3d at 956. For these reasons, neither the Petition nor Mr. Baker’s declaration provide any evidence that contradicts the plain appearance of FIG. 1 or that demonstrate a reasonable likelihood that Petitioner will succeed in proving that Modec discloses the relative positioning limitations.

iii. Petitioner cannot demonstrate a reasonable likelihood that it can prevail in proving that Modec teaches or suggests “wherein the door is the foremost door providing ingress or egress into the interior of the cabin”

As detailed above, FIG. 1 of Modec is not drawn to scale and is not described with any specificity in the specification. Moreover, FIG. 1 of Modec shows only one side of the cabin and is completely silent as to whether there are doors on the opposite side of the vehicle. None of the other figures of Modec show the opposite side of the cabin. For at least those reasons, Modec provides no information that would allow one skilled in the art to conclude that the door shown in FIG. 1 is the “foremost door into the interior of the cabin,” as required by claim 1. At most, FIG. 1 allows one of ordinary skill in the art to conclude that the door in FIG. 1 is the foremost door on the **driver’s side** of the cabin, which does not satisfy this limitation. The Petition and Mr. Baker’s expert declaration provide no explanation or rationale for concluding that the door in FIG. 1 is the foremost door on the cabin,

merely stating that “Figure 1 of Modec shows that ‘the door [yellow] is the foremost door’” and presenting another marked-up version of FIG. 1 of Modec:

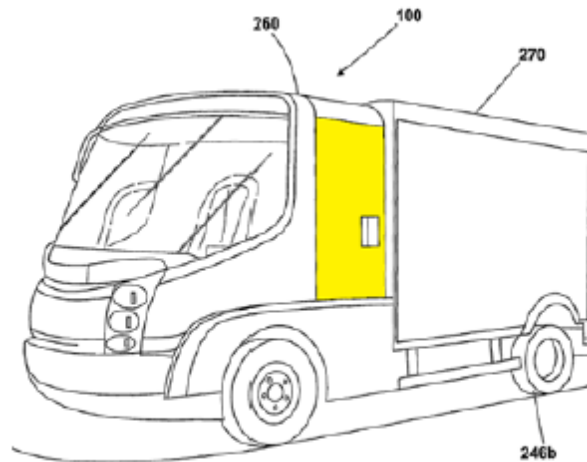


Fig. 1

Pet. at 40; Ex. 1002 at ¶ 84. Such conclusory testimony, especially when based on a rough figure, cannot be relied on to buttress Petitioner’s otherwise unsupported mapping of Modec to this limitation. *Arendi S.A.R.L.*, 832 F.3d at 1366. For at least these reasons, Modec fails to disclose “wherein the door is the foremost door providing ingress or egress into the interior of the cabin.”

iv. Messano does not cure the deficiencies of Modec regarding claim 1, and Petitioner has not met its burden on claims 2-5, 15-16, and 25 because they include all limitations of claim 1

As detailed previously, Messano fails to cure the deficiencies of Modec at least because Messano does not teach or suggest, whether alone or in combination with Modec, the relative positioning limitations or “wherein the door is the foremost door providing ingress or egress into the interior of the cabin,” as required by claim

1. Petitioner has therefore failed to establish a reasonable likelihood that it can prevail in showing that Modec in view of Messano renders claim 1 obvious. Claims 1-5, 15-16, and 25 depend from and include all limitations of claim 1, and the Petition therefore also fails to meet its burden on those claims. Institution on Ground 1 should therefore be denied.

v. Petitioner has also failed to meet its burden as to Claims 3 and 25 because the cabin of Modec would not function in the hybrid combustion engine vehicle of Messano

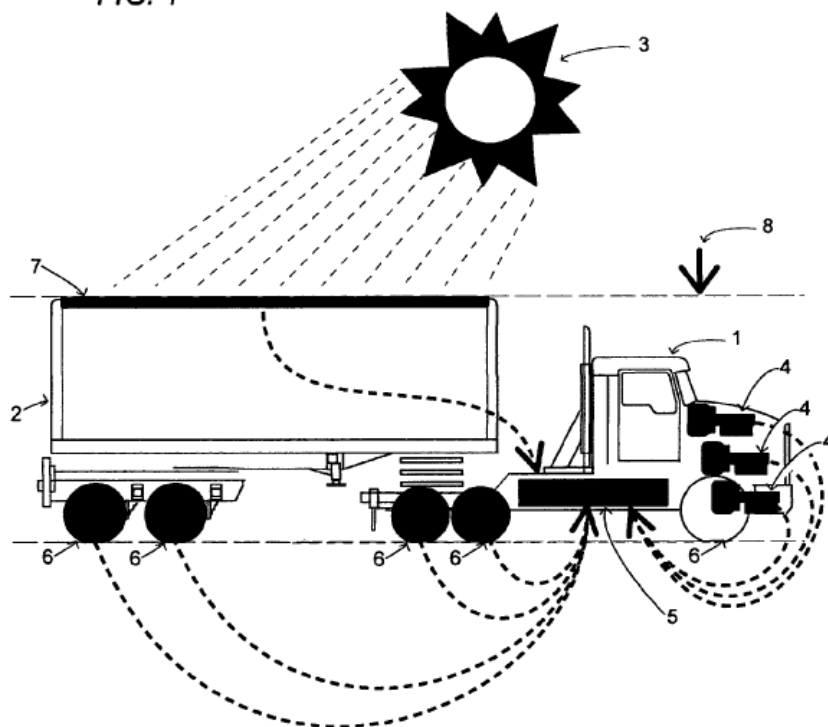
Claim 3 of the '084 patent recites “wherein the semi-truck vehicle comprises a combustion engine configured to generate power by using combustion energy of fuel” and claim 25 recites “wherein the semi-truck vehicle is a hybrid vehicle comprising electrical and combustion components.” In addition to the reasons detailed in Sections VIII.A.i-iii above, Petitioner has not demonstrated a reasonable likelihood that Modec in view of Messano discloses these limitations at least because, even if Modec discloses the relative positioning limitations and foremost door limitations, which it does not, the cabin of Messano could not simply be replaced by the purported cabin of Modec.

Petitioner notes that Messano “claims ‘[a] hybrid semi-trailer truck system comprising: an electric drive road tractor that incorporates: a multiplicity of constant-speed internal combustion engines maximized for fuel efficiency.’” Pet. at 46; citing Ex. 1005 at 19:28-31. This is the only supporting rationale provided by

either the Petition or Mr. Baker's declaration, which is again identical to the Petition as to this limitation. *See* Ex. 1002 at ¶ 95. The Petitioner presents no evidence or rationale for how the combustion engine features of Messano would be incorporated into the Modec vehicle, or vice versa. Such conclusory, unsupported assertions do not provide a sufficient rationale to combine. *See In re Kahn*, 441 F.3d at 988 (Fed. Cir. 2006).

Moreover, if the Modec cabin were arranged in a way that actually showed the relative positioning limitations, which it is not, replacing the Messano cabin with the Modec cabin would necessitate removing the very combustion engines and combustion components required by claims 3 and 25. FIG. 1 of Messano shows a variety of elements "which lower fuel consumption of a vehicle":

FIG. 1



Ex. 1005, 8:11-13, FIG. 1. Those components include three GenSets 4 and a Battery Module 5. *Id.* at 8:16-17. Each of the GenSets consists of an internal combustion engine 13 that drives an electrical generator or alternator 14. *Id.* at 8:50-53. Thus, GenSets 4 are the combustion engines of Messano and are also the combustion components of Messano.

As shown in FIG. 1, GenSets 4 are positioned in front of the cabin, and, more specifically, are positioned approximately in line with the front wheel of Messano, as are conventional combustion engine designs. As such, even if Modec did, as Petitioner asserts, disclose a seat as least partially disposed in front of a rear portion of a rear wheel, that configuration could not be used with the semi-truck of Messano

because of the space taken up by GenSets 4. That is especially true if, as asserted by Petitioner, the door was positioned to allow ingress and egress to the cabin behind the seat. Put simply, a full redesign of the Messano cabin and combustion components would be required to both (i) keep the key combustion components positioned in the front of the truck and (ii) use a cabin with a seat, door, and wheel well having the relative positioning limitations required by claim 1 of the '084 patent, from which claims 3 and 25 depend.

Petitioner has therefore failed to provide a sufficient rationale explaining how the combination of Modec and Messano would be made in a way that renders claims 3 and 25 obvious (*see In re Kahn*, 441 F.3d at 988). Moreover, the proposed combination would not function for its intended purpose and Messano, by use of combustion engines in the front of the vehicle, teaches away from the combination proposed by Petitioner. *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1382 (Fed. Cir. 2007) (“[A] reference teaches away from a combination when using it in that combination would produce an inoperative result.”). For at least these additional reasons, Modec in view of Messano fails to teach or suggest the limitations of claims 3 and 25.

B. Petitioner Fails to Establish that There Is a Reasonable Likelihood that Modec, Messano, and Future Truck Report Render Obvious Claims 13 (Ground 2)

At least because claim 13 depends from and includes all limitations of claim 1, Petitioner has failed to establish a reasonable likelihood of success on Ground 2.

C. Petitioner Fails to Establish that There Is a Reasonable Likelihood that Modec, Messano, and Marlowe Render Obvious Claims 7, 8, 21, and 26 (Ground 3)

At least because claims 7, 8, and 21 depend from and include all limitations of claim 1, Petitioner has failed to establish a reasonable likelihood of success on those claims.

Independent claim 26 recites “at least a portion of the door being positioned behind the first seat, at least a portion of the first seat is disposed to be forward of a line defining the rearmost portion of the front wheel well.” For at least the reasons detailed above in Sections VIII.A.i-iii with respect to claim 1, neither Modec nor Messano, taken alone or in combination, teach or suggest this limitation.

The Petition does not suggest that Marlowe remedies the deficiencies of Modec and Messano. Moreover, Marlowe does in fact fail to remedy the deficiencies of Modec and Messano at least because Marlowe does not disclose “at least a portion of the first seat is disposed to be forward of a line defining the rearmost portion of the front wheel well,” as recited in claim 26.

In addition, the combination of Modec, Messano, and Marlowe fails to disclose or suggest “an entryway provided between the first seat and the second seat, wherein the entryway comprises a vertical height extending from a floor of the cabin to at least a top of the first seat or the second seat” as required by claim 26. The Petition asserts that “a POSITA would read Modec as implicitly disclosing the claimed ‘entryway’ of claim 26.” Pet. at 56-57. The Petition also asserts that “[b]ecause the door [of Modec] is at least partially behind the seat, a POSITA would also understand that there is an entryway behind and between the two seats. . .” *Id.* at 57. Mr. Baker’s expert analysis is, again, an exact verbatim copy of the Petition, and adds no more rationale or explanation for why a person skilled in the art would “understand that there is an entryway **between** the two seats.” See Ex. 1002 at ¶ 120. Thus, it appears that the Petition asserts that it would have been inherent that if Modec did show that a portion of the seat is in front of the rear portion of the wheel well and a portion of the door was positioned behind the seat, which it does not actually show, **and** if a second seat were positioned in the cabin of Modec, it would have been inherent that there would be a passageway between those two seats. But a petitioner cannot carry its burden on inherency merely by showing that a characteristic **may** or **could** be present in the prior art. *In re Oelrich*, 666 F.2d 578, 581-82 (CCPA 1981) (allegations based on “mere probabilities or possibilities” fall short of demonstrating that the missing element is necessarily present).

Petitioner also argues that, even if locating the hypothetical passageway between the seats is not inherently disclosed by Modec, it would have been obvious to provide an entryway between the two seats. In support, the Petition and expert declaration state only that such positioning would be “the most convenient and easiest pathway for the driver to get from the door to the driver seat upon entering the cabin.” Pet. at 58. Ex. 1002 at ¶ 119. This is nothing more than an inherency argument dressed up as obviousness and should be accorded no weight. For example, Petitioner has failed to establish that the seats in the hypothetical modified Modec cabin would be spaced apart from each other near the windows such that there would even be a space between the seats for a passageway.

Thus, Petitioner has also failed to demonstrate a reasonable likelihood that the Modec cabin as modified by Messano and Marlowe discloses a passageway between two seats in a cabin, as required by claim 26.

D. Petitioner Fails to Establish that There Is a Reasonable Likelihood that Modec, Messano, and Eltra Render Obvious Claims 9-11 (Ground 4)

At least because claims 9-11 depend from and include all limitations of claim 1, Petitioner has failed to establish a reasonable likelihood of success on those claims.

E. Petitioner Fails to Establish that There Is a Reasonable Likelihood that Modec, Messano, and Racz Render Obvious Claim 12 (Ground 5)

At least because claim 12 depends from and includes all limitations of claim 1, Petitioner has failed to establish a reasonable likelihood of success on claim 12.

F. Petitioner Fails to Establish that There Is a Reasonable Likelihood that Modec, Messano, and Kia Render Obvious Claim 13 (Ground 6)

At least because claim 13 depends from and includes all limitations of claim 1, Petitioner has failed to establish a reasonable likelihood of success on claim 13.

G. Petitioner Fails to Establish that There Is a Reasonable Likelihood that Modec, Messano, and Marlowe Render Obvious Claim 14 (Ground 7)

At least because claim 14 depends from and includes all limitations of claim 1, Petitioner has failed to establish a reasonable likelihood of success on claim 14.

In addition, the combination proposed by Petitioner would not result in a cabin that meets the limitations of claim 14. Claim 14 recites “wherein the door is located approximately at a midpoint of the body of the semi-truck vehicle to provide ingress and egress into the cabin.” Petitioner asserts that it would have been obvious to modify Modec and Messano to meet this limitation based on the teachings of Messano. Pet. at 66; *see also* Ex. 1002 at ¶¶ 135-136. Petitioner further argues that “[a] person of ordinary skill in the art would have been motivated to modify the combination of Modec and Messano with the door location from Marlowe because locating the door at the midpoint of the body is an obvious design choice, which

provides provide [sic] additional space behind the seat.” Ex. 1002 at ¶ 136; *see also* Pet. at 67. But, as is readily apparent from viewing FIG. 1 of Modec, moving the door of Modec to the midpoint of the body would result in the door being near the front of the wheel well as opposed to “adjacent to a **rearmost** portion of the wheel well,” as required by claim 1:

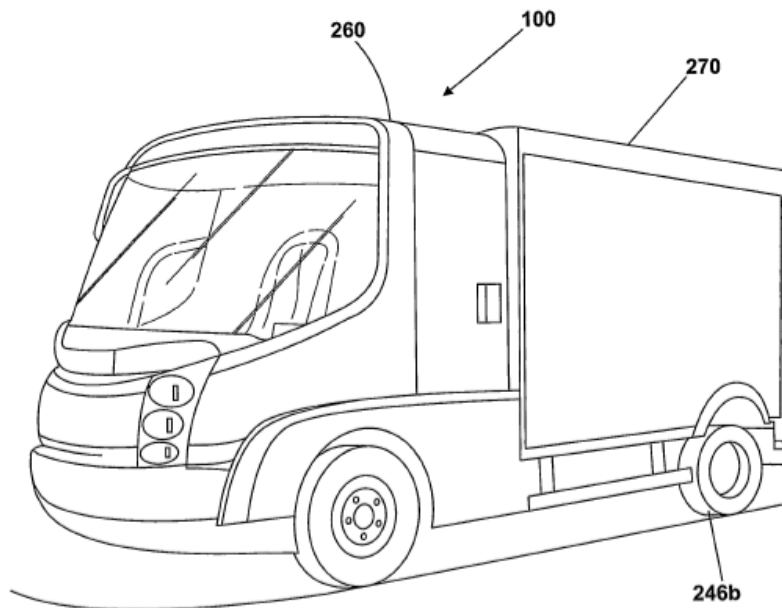


Fig. 1

Ex. 1004 at FIG. 1. Therefore, if the door of Modec were moved as proposed by Petitioner, the relative positioning limitations would not be met, and Marlowe therefore actually teaches away from the features of claim 7. *See In re ICON Health & Fitness*, 496 F.3d at 1382. For this additional reason, Petitioner has failed to establish a reasonable likelihood of success on claim 14.

H. Petitioner Fails to Establish that There Is a Reasonable Likelihood that Modec, Messano, and Plummer Render Obvious Claims 17 and 19 (Ground 8)

At least because claims 17 and 19 depend from and include all limitations of claim 1, Petitioner has failed to establish a reasonable likelihood of success on those claims.

I. Petitioner Fails to Establish that There Is a Reasonable Likelihood that Modec, Messano, and Marlowe Render Obvious Claims 18 and 20 (Ground 9)

At least because claims 18 and 20 depend from and include all limitations of claim 1, Petitioner has failed to establish a reasonable likelihood of success on those claims.

J. Petitioner Fails to Establish that There Is a Reasonable Likelihood that Modec, Messano, and Man Annual Report Render Obvious Claim 22 (Ground 10)

At least because claim 22 depends from and includes all limitations of claim 1, Petitioner has failed to establish a reasonable likelihood of success on claim 22.

K. Petitioner Fails to Establish that There Is a Reasonable Likelihood that Modec, Messano, and Freightliner Render Obvious Claims 23-24 (Ground 9)

At least because claims 23-24 depend from and include all limitations of claim 1, Petitioner has failed to establish a reasonable likelihood of success on those claims.

IX. CONCLUSION

To summarize, the entire Petition rests on the rough drawing shown in FIG. 1 of Modec. That figure that is drawn from an undisclosed angle and is not marked with dimensions, and Modec does not assert that the figure is drawn to scale. As detailed herein, Modec provides no information from which a person of ordinary skill in the art could discern the relative positions of the wheel well, seat, and door shown in Modec FIG. 1. Petitioner's expert merely parrots the exact claim language without any supporting analysis, and neither the Petition nor Petitioner's expert cites any passage of the Modec specification that is relevant to the inquiry into whether Modec discloses the relative positioning limitations, which are required by all claims of the '084 patent. For at least these reasons, the Petition does not establish a reasonable likelihood that any claim of the '084 patent is invalid and should be denied.

In addition, Petitioner's proposed construction of "adjacent to" should be rejected because construction of that term is not necessary to resolve the validity issues presented in the Petition and, even if construction were necessary, neither the intrinsic nor extrinsic evidence support including the negative limitation "but not touching" in the construction.

Appendix A
Table of Exhibits

Exhibit No.	Description
2001	<i>Adjacent</i> , Cambridge Dictionary (2019)
2002	<i>Adjacent</i> , Oxford Learner's Dictionaries (2019)

Appendix B
Certificate of Service

I certify that on January 3, 2020 a copy of this **PATENT OWNER'S PRELIMINARY RESPONSE TO THE PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 10,077,084** is being filed via PTAB E2E and served on the following Petitioner's counsel by electronic mail this 3rd day of January, 2020.

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CERTIFICATE OF COMPLIANCE WITH 37 C.F.R. § 42.24

I hereby certify that the word count for the foregoing Patent Owner Preliminary Response totals 8,070 words, excluding the parts which are exempted by 37 C.F.R. § 42.24(a)(1).

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