

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KOITO MANUFACTURING CO., LTD.,

Petitioner,

v.

LONGHORN AUTOMOTIVE GROUP LLC,

Patent Owner.

Patent No. 8,810,803
Filing Date: April 16, 2012
Issue Date: August 19, 2014

Inventor: Matthew Bell

Title: LENS SYSTEM

PATENT OWNER'S PRELIMINARY RESPONSE

Case No. IPR2025-00955

TABLE OF CONTENTS

	<u>Page(s)</u>
I. INTRODUCTION	1
II. CLAIM CONSTRUCTION	4
III. LEVEL OF SKILL IN THE ART	4
IV. PETITIONER HAS NOT DEMONSTRATED A REASONABLE LIKELIHOOD OF SUCCESS FOR THE GROUNDS ADVANCED IN THE PETITION, AND THE PETITION SHOULD BE DENIED	4
A. Grounds 1, 4, 7, and 8: Claims 1-17 Are Not Rendered Obvious by Weidel and Secondary References Because the Petition Fails to Disclose or Suggest “a condenser lens [which] concentrates light from each of the plurality of emitters towards a center of the cluster of lenses”	7
B. Ground 2: Claims 1 through 8 Are Not Rendered Obvious by Mizusawa Because the Petition Fails to Disclose or Suggest “a condenser lens [which] concentrates light from each of the plurality of emitters towards a center of the cluster of lenses”	9
C. Ground 3: Claim 15 Is Not Rendered Obvious by Tatsukawa and Secondary References Because the Petition Fails to Disclose or Suggest “the condenser lens concentrating light from each of the plurality of emitters towards a center of the cluster of lenses”	10
D. Grounds 5 and 6: Claims 1-17 Are Not Rendered Obvious by Chinniah and Secondary References Because the Petition Fails to Disclose or Suggest ”the condenser lens is configured to concentrate light from each of the plurality of emitters towards a center of the cluster of lenses”	12

V. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE DIRECTOR UNDER 35 U.S.C. § 314(A).....15

A. The Parallel District Court Litigation and the Petition Involve the Same Parties17

B. The District Court Litigations Involve Substantially the Same Claims.....17

C. Proximity of the District Court’s Trial Date18

D. Significant Investment in the Parallel Litigations Support Discretionary Denial.....20

E. No Stay of the Parallel District Court Litigations.....21

F. Other Factors Favor Discretionary Denial22

VI. CONCLUSION.....22

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020)	15, 20
<i>Apple, Inc. v. Contentguard Holdings, Inc.</i> , IPR2015-00355, Paper 9 at 9-10 (P.T.A.B. June 26, 2015)	5
<i>Broadcom Corp. v. Emulex Corp.</i> , 732 F.3d 1325 (Fed. Cir. 2013)	6
<i>Cisco Sys., Inc. v. Estech Sys., Inc.</i> , IPR2021-00329, Paper 13 (P.T.A.B. Jul. 6, 2021)	19
<i>Cisco Sys., Inc. v. Oyster Optics, LLC</i> , IPR2021-00238, Paper 10 (P.T.A.B. June 1, 2021)	19
<i>Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.</i> , IPR2020-00122, Paper 15 (P.T.A.B. May 15, 2020)	17, 19
<i>Edward LifeSciences Corp. v. Evalve, Inc.</i> , IPR2019-01479, Paper 7 (P.T.A.B. Feb. 26, 2020).....	18
<i>F5 Networks, Inc. v. WSOU Invs., LLC</i> , IPR2022-00239, Paper 12 (P.T.A.B. May 19, 2022)	19
<i>Force Mos Tech., Co. v. ASUSTek Comput., Inc.</i> , No. 2:22-cv-00460-JRG, 2024 WL 1586266 (E.D. Tex. Apr. 11, 2024)	21
<i>Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha</i> , IPR2016-01357, Paper 19 (P.T.A.B. Sept. 6, 2017).....	16
<i>Google LLC v. EcoFactor, Inc.</i> , IPR2021-00488, Paper 12 (P.T.A.B Aug. 11, 2021).....	19

<i>Graham v. John Deere Co. of Kansas City</i> , 383 U.S. 1 (1966).....	5
<i>Innogenetics, N.V. v. Abbott Lab'ys.</i> , 512 F.3d 1363 (Fed. Cir. 2008)	6
<i>Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.</i> , 821 F.3d 1359 (Fed. Cir. 2016)	6
<i>KSR Int'l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007).....	5
<i>LBT IP I LLC v. Apple Inc.</i> , No. 2022-1613, 2023 WL 3914920 (Fed. Cir. June 9, 2023).....	7
<i>Longhorn Auto. Grp. LLC v. Hyundai Motor Co.</i> , Case No. 2:24-cv-00554-JRG (E.D. Tex.)	3
<i>Longhorn Auto. Grp. LLC v. Mazda Motor Corp.</i> , Case No. 2:24-cv-00686-JRG (E.D. Tex.)	3
<i>Longhorn Auto. Grp. LLC v. Mitsubishi Motors Corp.</i> , Case No. 2:24-cv-00685-JRG (E.D. Tex.)	3
<i>Longhorn Auto. Grp. LLC v. Nissan Motor Co.</i> , Case No. 2:24-cv-00397-JRG (E.D. Tex.)	3
<i>Longhorn Auto. Grp. LLC v. Volkswagen AG</i> , Case No. 2:24-cv-00933-JRG (E.D. Tex.)	<i>passim</i>
<i>Longhorn Auto. Grp. LLC v. Volvo Car Corp.</i> , Case No. 2:24-cv-00603-JRG (E.D. Tex.)	3
<i>Los Angeles Biomedical Rsch. Inst. at Harbor-UCLA Med. Ctr. v. Eli Lilly & Co.</i> , 849 F.3d 1049 (Fed. Cir. 2017)	6
<i>NHK Spring Co. v. Intri-Plex Techs., Inc.</i> , IPR2018-00752, Paper 8 (P.T.A.B. Sept. 12, 2018).....	16

<i>Nissan Motor Co. v. Longhorn Auto. Grp. LLC</i> , IPR2025-01089, Paper 5 (P.T.A.B. June 25, 2025)	21
<i>Pers. Web Techs., LLC v. Apple, Inc.</i> , 848 F.3d 987 (Fed. Cir. 2017)	5
<i>Pers. Web Techs., LLC v. Apple, Inc.</i> , 917 F.3d 1376 (Fed. Cir. 2019)	7
<i>Samsung Elecs. Co. v. Truesight Commc'ns LLC</i> , IPR2025-00123, Paper 12 (P.T.A.B. Apr. 22, 2025)	19
<i>Stratoflex, Inc. v. Aeroquip Corp.</i> , 713 F.2d 1530 (Fed. Cir. 1983)	5
<i>Supercell Oy v. Gree, Inc.</i> , IPR2020-00513, Paper 11 (P.T.A.B. June 24, 2020)	18
<i>In re Van Os</i> , 844 F.3d 1359 (Fed. Cir. 2017)	6
Statutes	
35 U.S.C. 314(b)	18
35 U.S.C. § 312(a)(3).....	8
35 U.S.C. § 314(a)	<i>passim</i>
35 U.S.C. § 314(b)(1).....	18
35 U.S.C. § 316(a)(11).....	18
Other Authorities	
37 C.F.R. 42.104(B)(4)	8, 9, 14
37 C.F.R. § 42.75	8, 20

LIST OF EXHIBITS

Exhibit No.	Description of Document
2001	Second Amended Docket Control Order, Dkt. 69, <i>Longhorn Auto. Grp. LLC v. Hyundai Motor Co.</i> , Case No. 2:24-cv-00554-JRG-RSP (Lead Case) (E.D. Tex. July 9, 2025)
2002	Fourth Amended Docket Control Order, Dkt. 58, <i>Longhorn Auto. Grp. LLC v. Volkswagen AG, et al.</i> , Case No. 2:24-cv-00933-JRG-RSP (Lead Case) (E.D. Tex. May 15, 2025)
2003	Longhorn Automotive Group LLC's Second Amended Infringement Contentions and P.R. 3-1 and 3-2 Disclosures in <i>Longhorn Auto. Grp. LLC v. Hyundai Motor Co.</i> , Case No. 2:24-cv-00554-JRG-RSP (Lead Case) (E.D. Tex.), dated July 25, 2025

I. INTRODUCTION

On April 30, 2025, Koito Manufacturing Co., Ltd. (“Petitioner” or “Koito”) submitted a Petition (Paper 1, “Petition” or “Pet.”) to institute *inter partes* review (“IPR”) of U.S. Patent No. 8,810,803 (Ex. 1001, the “’803 Patent”), challenging Claims 1-17 (the “Challenged Claims”). The Petition asserts that Claims 15 and 16 are anticipated by German Patent Application No. DE 101 29 743.2-22 to Weidel (Ex. 1004 or “Weidel”); Claims 1 and 8 are anticipated by U.S. Patent No. 7,733,574 to Mizusawa (Ex. 1008 or “Mizusawa”); Claim 15 is rendered obvious by U.S. Patent No. 7,736,036 to Tatsukawa (Ex. 1007 or “Tatsukawa”) in view of German Patent Application No. 10 2006 004 587.4 to Brandenburg (Ex. 1006 or “Brandenburg”); Claims 1-6, 8-13, and 15-16 are obvious by Weidel in view of U.S. Patent No. 7,563,008 to Chinniah et al. (Ex. 1005 or “Chinniah”); Claims 1-6, 8-13, and 15-16 are obvious by Chinniah in view of Brandenburg and Japanese Patent Application Publication No. 2004-214144 to Osawa (Ex. 1011 or “Osawa”); Claims 7, 14, and 17 are obvious by Chinniah in view of Brandenburg and further in view of U.S. Patent Application Publication No. US 2007/0263903 to St. Hilaire et al. (Ex. 1009 or “St. Hilaire”) and Korean Patent Application No. 10-2002-0026751 to Cheon (Ex. 1010 or “Cheon”); Claims 3-4 and 10 are obvious by Weidel in view of Chinniah and in further view of Osawa; and Claims 7, 14, and 17 are obvious by Weidel in view of Chinniah and in further view of St. Hilaire and/or Cheon (Pet. 6-

7). The Board should deny the Petition for at least the reasons described briefly below.

First, regarding Claims 1 through 16, Petitioner fails to demonstrate in each of the Grounds submitted that any of the references or combinations disclose or render obvious the limitation “the condenser lens is configured to concentrate light from each of the plurality of emitters towards a center of the cluster of lenses” (or similar element as found in each of the independent claims). Each of Weidel, Mizusawa, Tatsukawa, and Chinniah do not disclose “a condenser lens” to “concentrate light . . . towards a center of the cluster of lenses” and the disclosures Petitioner relies upon does not support its arguments. Petitioner presents no real expert testimony on expectation of success, and Petitioner’s purported reliance on its expert to address deficiencies in the references is improper under the July 31, 2025 Memorandum from the Acting Director of the United States Patent and Trademark Office. Petitioner’s expert submits a copy-cat Declaration restating the same paragraphs of conclusory, unsupportable attorney argument and this “general knowledge” cannot be used to fill in missing limitations in the claims.

Second, the Board should exercise its discretion to deny the Petition under 35 U.S.C. § 314(a). The Petition identifies the following co-pending litigations: *Longhorn Auto. Grp. LLC. v. Volkswagen AG*, Case No. 2:24-cv-00933-JRG (E.D.

Tex.) (the “*Volkswagen Case*”); *Longhorn Auto. Grp. LLC v. Mazda Motor Corp.*, Case No. 2:24-cv-00686-JRG (E.D. Tex.); *Longhorn Auto. Grp. LLC v. Mitsubishi Motors Corp.*, Case No. 2:24-cv-00685-JRG (E.D. Tex.); *Longhorn Auto. Grp. LLC v. Volvo Car Corp.*, Case No. 2:24-cv-00603-JRG (E.D. Tex.); *Longhorn Auto. Grp. LLC v. Hyundai Motor Co.*, Case No. 2:24-cv-00554-JRG (E.D. Tex.) (the “*Kia Case*”); and *Longhorn Auto. Grp. LLC v. Nissan Motor Co.*, Case No. 2:24-cv-00397-JRG (E.D. Tex.) (collectively, the “District Court Litigations”).¹ With Patent Owner’s Preliminary Response due September 2, 2025, institution of any grounds will result in the issuance of a Final Written Decision (“FWD”) by December 2, 2026. The Board should exercise discretion to deny the Petition under 35 U.S.C. § 314(a) for at least the following reasons: (i) the parallel District Court Litigations exist between the same parties or real-parties-in-interest; (ii) the District Court Litigations involve the same subject patent, the ’803 Patent, with the same claims; (iii) the District Court’s first trial will be *six months* before the projected statutory deadline for FWD; (iv) the parties will have heavily invested in the District Court

¹ Several of these cases have been consolidated for the purpose of pre-trial proceeding. For example, the *Volkswagen* and *Mazda* matters have been consolidated, and the *Kia* and *Nissan* matters have been consolidated.

Litigations, and a Claim Construction Hearing is scheduled in the *Kia* Case for December 3, 2025, just a day after the institution deadline; and (v) settled expectations have been created because the '803 Patent was issued over eleven (11) years ago. Accordingly, the Board should exercise discretion to deny the Petition.

II. CLAIM CONSTRUCTION

For purposes of this Preliminary Response, Patent Owner does not adopt any meanings other than the plain and ordinary meaning of terms not identified by Petitioner.

III. LEVEL OF SKILL IN THE ART

For the purposes of this Preliminary Response only, Patent Owner utilizes Petitioner's proposed level of skill in the art: "an undergraduate bachelor's degree in physics or optical science, or equivalent knowledge, training or experience, with at least 2 years of work experience in the design or analysis of optical systems. Additional education or industry experience may compensate for a deficit in one of the other aspects of the requirements stated above." Pet. at 12 (citations omitted).

IV. PETITIONER HAS NOT DEMONSTRATED A REASONABLE LIKELIHOOD OF SUCCESS FOR THE GROUNDS ADVANCED IN THE PETITION, AND THE PETITION SHOULD BE DENIED

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, (3) the level of skill in the art, and (4) so-called secondary considerations where in evidence. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537 (Fed. Cir. 1983).

The Board has held that a failure to identify the differences between the claimed subject matter and the prior art is fatal to an obviousness challenge. *See Apple, Inc. v. Contentguard Holdings, Inc.*, IPR2015-00355, Decision Denying Institution of *Inter Partes Review*, Paper 9 at 9-10 (P.T.A.B. June 26, 2015) (denying institution for failure to identify the differences between the claimed subject matter and the prior art).

In arriving at an obviousness determination, the Board 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 and reasonably expected success. *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 the motivation to combine those references. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1368 (Fed. Cir. 2016); *Los Angeles Biomedical Rsch. 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 finding as to whether there was an apparent reason to combine all three prior art references to achieve the claimed invention and whether a person of skill in the art would have had a reasonable expectation of success from such a combination). This combinability 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 Lab’ys.*, 512 F.3d 1363, 1373 (Fed. Cir. 2008).

To demonstrate inherent obviousness, an inherent limitation must necessarily be present in the combination of references. *See Pers. Web Techs., LLC v. Apple, Inc.*, 917 F.3d 1376 (Fed. Cir. 2019); *LBT IP I LLC v. Apple Inc.*, No. 2022-1613, 2023 WL 3914920, at *3 (Fed. Cir. June 9, 2023). It is not enough to merely show that it is likely to be present. *Id.*

A. Grounds 1, 4, 7, and 8: Claims 1-17 Are Not Rendered Obvious by Weidel and Secondary References Because the Petition Fails to Disclose or Suggest “a condenser lens [which] concentrates light from each of the plurality of emitters towards a center of the cluster of lenses”

Petitioner fails to show Weidel alone or in combination with the secondary references teaches or suggests the claimed features of Claims 1-17. For example, Weidel does not disclose or suggest a condenser lens which concentrates light from each of the plurality of emitters towards a center of the cluster of lenses. *See* Claims 1, 8, 15.

Petitioner relies solely on Weidel for this claim requirement. Petitioner maps the Weidel’s converging lens to the claimed condenser lens. Pet. at 18-19. However, Petitioner fails to adequately describe how Weidel’s converging lens is configured in any way to concentrate light toward a center of the cluster of lenses. Instead, Petitioner relies on a single paragraph in which Weidel describes the converging lens “collimating” light and that the light diverges. Pet. 19 citing Ex. 1004 at [0028].

Petitioner does not explain how the Weidel’s “collimating” and “diverging” features meet the claimed requirement of a converging lens configured to concentrate light towards a center of the cluster of lenses. To the extent Petitioner relies on unsupported general knowledge or expert testimony to fill in the missing elements, such use is prohibited as a violation of 37 C.F.R. 42.104(B)(4). *See* July 31, 2025 Memorandum from Acting Director Stewart to Members of the PTAB. This is not a case where expert testimony and general knowledge is used to support any motivation to combine; instead, it is clear that Weidel does not disclose or suggest the claimed element, and Petitioner is impermissibly using general knowledge and/or expert testimony to supply the missing elements. Pursuant to 35 U.S.C. § 312(a)(3), an IPR Petition must identify “in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” Further, Rule 104(b)(4) states, an IPR Petition “must specify where each element of the claim is found in the prior art patents or printed publications relied upon.” Under the July 31, 2025 Memorandum, “expert testimony, common sense, and other evidence that is not ‘prior art consistent of patents or printed publications’ (collectively, ‘general knowledge’) *may not be used to supply a missing claim limitation.*”

https://www.uspto.gov/sites/default/files/documents/aapa_memo_final__signed.pdf

f?utm_campaign=subscriptioncenter&utm_content=&utm_medium=email&utm_name=&utm_source=govdelivery&utm_term= (emphasis added). Here, Petitioner does not identify any disclosure from Weidel or its secondary references to show that this element is met, and Petitioner relies on conclusory expert testimony that finds no factual basis in the reference. The Phenis Declaration does nothing to remedy such deficiencies in a manner that does not violate Rule 104(b)(4), merely repeating the same arguments offered by Petitioner. *See, e.g.*, Ex. 1003, ¶¶ 56-59.

Accordingly, because Petitioner has failed to adequately show how Weidel discloses or suggests a condenser lens which concentrates light from each of the plurality of emitters towards a center of the cluster of lenses, Petitioner has failed to show a reasonable likelihood of success as to Claims 1 through 17, and the Petition should be denied.

B. Ground 2: Claims 1 through 8 Are Not Rendered Obvious by Mizusawa Because the Petition Fails to Disclose or Suggest “a condenser lens [which] concentrates light from each of the plurality of emitters towards a center of the cluster of lenses”

Petitioner fails to demonstrate that Mizusawa discloses or suggests “a condenser lens is configured to concentrate light from each of the plurality of emitters towards a center of the cluster of lenses,” as required by Claims 1 through 8.

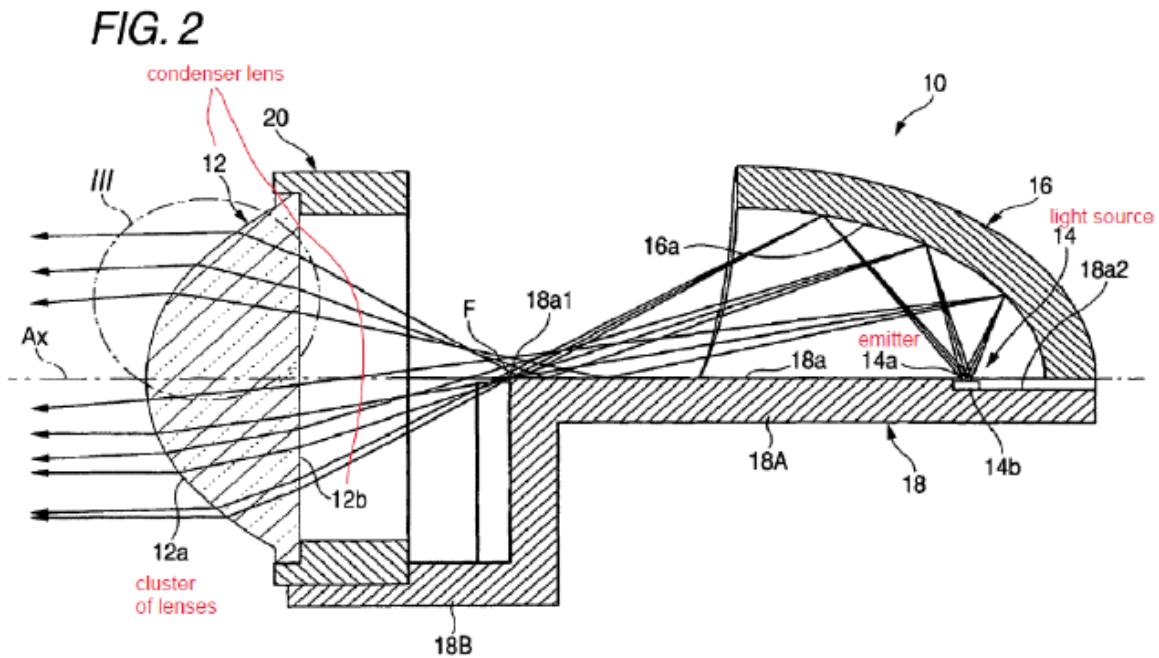
Like Weidel, Mizusawa does not disclose “a condenser lens [which] concentrates light from each of the plurality of emitters towards a center of the cluster of lenses.” Petitioner points to Mizusawa’s description of the “focusing lens 16” but none of the disclosures pointed to by Petitioner show that the focusing lens concentrates light “towards a center of the cluster of lenses.” Rather, FIG. 1A, as pointed to and annotated by Petitioner, shows that the condenser lens focuses the light onto the “front focal plane F2 of the second group 4b.” Ex. 1008, 8:58-60. The “first group 4a [is] arranged adjacent to the plurality of light-emitting sections 2 and a second group 4b arranged adjacent to the fly-eye lens 6.” *Id.*, 7:55-57. The Figure pointed to by Petitioner shows that the collimator lens 17 receives the light from the first group 4a and guides these collimated beams onto the fly-eye lens. *Id.*, 8:1-5. Petitioner does not map the collimator lens to the claimed “condenser lens,” and thus, Petitioner has failed to show a reasonable likelihood of success as to Claims 1 through 8, and the Petition should be denied.

C. Ground 3: Claim 15 Is Not Rendered Obvious by Tatsukawa and Secondary References Because the Petition Fails to Disclose or Suggest “the condenser lens concentrating light from each of the plurality of emitters towards a center of the cluster of lenses”

Petitioner fails to demonstrate that Tatsukawa discloses or suggests “a condenser lens [which] concentrate[es] light from each of the plurality of emitters

towards a center of the cluster of lenses,” as required by Claim 15.

Petitioner points to the projector lens as disclosing the “condenser lens” element. Pet. at 39-40. However, the ’803 Patent requires “a cluster of lenses” and separately, a condenser lens. As pointed to by Petitioner, Tatsukawa discloses a single projector lens. Pet. at 40-41. Tatsukawa discloses that a light source reflects light through a projector lens which results in diverging light. Each of the disclosures of Tatsukawa relating to the projector lens are limited to “a light diverging function.” *See, e.g.*, Ex. 1007, 2:45-46. For example, Tatsukawa discloses that this projector lens emits light which can be “diverged considerably in the up and down direction.” Ex. 1007, 4:61-62. Petitioner does not explain how Tatsukawa meets the claimed requirement of a converging lens configured to concentrate light “towards a center of the cluster of lenses” where disclosures are limited to diverging light.



EX1007, FIG. 2 (annotated)

Accordingly, because “the condenser lens concentrating light from each of the plurality of emitters towards a center of the cluster of lenses,” as required by Claim 15, Petitioner has failed to show a reasonable likelihood of success as to Claim 15, and the Petition should be denied.

D. Grounds 5 and 6: Claims 1-17 Are Not Rendered Obvious by Chinniah and Secondary References Because the Petition Fails to Disclose or Suggest “the condenser lens is configured to concentrate light from each of the plurality of emitters towards a center of the cluster of lenses”

Petitioner fails to demonstrate that Chinniah in view of secondary references discloses or suggests “the condenser lens is configured to concentrate light from each

of the plurality of emitters towards a center of the cluster of lenses,” as required by Claims 1 through 17.

Petitioner points to the condenser lens 30 and, specifically, Figure 3 of Chinniah, as “concentrating” light from the light source to “bend inwards.” However, the corresponding disclosure in the specification for Figure 3 discloses that the condenser lens provides a “beam spreading function.” Ex. 1005, 4:2-4. Further, the condenser lens is described as providing a “predetermined beam pattern” which has “increased horizontal spread as well as increased vertical spread.” *Id.*, 5:1-4. Specifically, through the use of the “horizontally spaced and vertically extended facets,” the “horizontal spread and vertical spread functions of the condenser lens” are separated. Pet. at 68-69. The disclosures of Chinniah do not support Petitioner’s conclusion that the condenser lens meets “the condenser lens is configured to concentrate light from each of the plurality of emitters towards a center of the cluster of lenses” element.

Alternatively, Petitioner points to the “reflector 26 and/or a shield 28” of Chinniah to argue that it would have been obvious to a POSITA to replace the condenser lens. However, the reflector and/or shield of Chinniah is a separate element used by Chinniah’s system which is coupled with the condenser lens to “provide a light output that is suitable for automotive headlight applications while

also having the desired beam characteristics.” Ex. 1005, 3:25-31. Rather, Chinniah specifically discloses that the “function of beam spread” is moved from the reflector to the condenser lens, and thus, Petitioner does not explain why it would have been obvious to a POSITA to replace the very function it aimed to replace. *Id.*, 3:36-27. To the extent Petitioner relies on unsupported general knowledge or expert testimony to fill in the missing elements, such use is prohibited as a violation of 37 C.F.R. 42.104(B)(4). *See* July 31, 2025 Memorandum from Acting Director Stewart to Members of the PTAB. This is not a case where expert testimony and general knowledge is used to support any motivation to combine; instead, it is clear that Chinniah in view of Brandenburg does not disclose or suggest the claimed element, and Petitioner is impermissibly using general knowledge and/or expert testimony to supply the missing elements.

Accordingly, because “the condenser lens is configured to concentrate light from each of the plurality of emitters towards a center of the cluster of lenses” element” (or similar element) is required by each and every independent claim, Petitioner has failed to show a reasonable likelihood of success as to Claims 1 through 17, and the Petition should be denied.

V. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE DIRECTOR UNDER 35 U.S.C. § 314(A)

Based on Petitioner's reasons regarding § 314(a), the Board should exercise its discretion to deny this Petition.

The parallel District Court Litigations warrants denial of the Petition under the Board's precedent. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (P.T.A.B. Mar. 20, 2020) (precedential) (considering (a) "whether the petitioner and the defendant in the parallel proceeding are the same party"; (b) "overlap between issues raised in the petition and in the parallel proceeding" (c) "proximity of the court's trial date to the Board's projected statutory deadline for a final written decision"; (d) "investment in the parallel proceeding by the court and the parties"; (e) "whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted"; and (f) "other circumstances that impact the Board's exercise of discretion, including the merits.").

As set forth below, these factors collectively demonstrate that efficiency and integrity of the AIA are best served by denying review. First, while the Petitioner is not the Defendant in the parallel proceeding, Petitioner has correctly identified that there are numerous pending District Court Litigations with the '803 Patent asserted against those defendants. *See infra* Section VII.A. Second, the District Court

Litigations involve the same claims at issue in the Petition. *See infra* Section VII.B. Third, trial in the *Kia* Case is set for June 1, 2026 (Ex. 2001) and the *Volkswagen* Case for August 17, 2026 (Ex. 2002), more than six and nine months, respectively, prior to the projected statutory deadline for a Final Written Decision of this Petition on December 2, 2026. *See infra* Section VII.C. Fourth, the parties (and Patent Owner in particular) have invested significant resources on developing legal and factual issues of validity and infringement in the District Court Litigations and will have invested substantially more resources before any decision on this Petition. *See infra* Section VII.D. Fifth, none of the defendants have moved for a stay of the District Court Litigation, and regardless, it is likely that the Court will deny the request for a stay where there are numerous other asserted patents. *See infra* Section VII.E. Finally, no other factors favor institution. *See infra* Section VII.F.

Accordingly, the Board should exercise its discretion under § 314(a) and deny the Petition because institution of this proceeding would not be consistent with the objective of the AIA to “provide an effective and efficient alternative to district court litigation.” *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018) (quoting *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16–17 (P.T.A.B. Sept. 6, 2017) (precedential)).

A. The Parallel District Court Litigation and the Petition Involve the Same Parties

As Petitioner notes, there exist a number of parallel District Court Litigations between the real parties-in-interest—Kia Corporation, Hyundai Motor Company, Volkswagen AG, Audi AG, Mazda Motor Corporation, Nissan Motor Co., Ltd., Mitsubishi Motors Corporation, AB Volvo, and Volvo Car Corporation—regarding the real parties’ Accused Products, which include a variety of vehicles from nine (9) manufacturers and the same subject patent (the ’803 Patent) with the same claims—Accordingly, this factor weighs strongly in favor of discretionary denial.

B. The District Court Litigations Involve Substantially the Same Claims

There is complete overlap between the claims at issue in this Petition and the District Court Litigations because the Petition challenges all claims asserted in the District Court Litigations. “In at least these ways, the parallel proceedings would duplicate effort. This is an inefficient use of Board, party, and judicial resources and raises the possibility of conflicting decisions.” *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 at 10 (P.T.A.B. May 15, 2020).

Accordingly, this factor weighs strongly in favor of discretionary denial.

C. Proximity of the District Court’s Trial Date

The proximity of the trial dates in at least the *Kia* and the *Volkswagen* Cases to the Board’s projected statutory deadline for a Final Written Decision weighs strongly in favor of discretionary denial.

Trial in the *Kia* Case is scheduled for June 1, 2026. Ex. 2001. Trial in the *Volkswagen* Case is scheduled for August 17, 2026. Ex. 2002. Pursuant to 35 U.S.C. §§ 314(b)(1) and 316(a)(11), the projected statutory deadline for a Final Written Decision of this Petition is December 2, 2026.² As the trial date in the *Kia* Case will take place *six months* before the projected statutory deadline, and the trial in the *Volkswagen* Case will take place over *three months* before the projected statutory deadline, this factor weighs in favor of denying institution. *See Supercell Oy v. Gree, Inc.*, IPR2020-00513, Paper 11 at 10-12 (P.T.A.B. June 24, 2020) (denying institution where the jury trial was scheduled to conclude approximately ten months before the statutory deadline); *Edward LifeSciences Corp. v. Evalve, Inc.*, IPR2019-

² Under 35 U.S.C. 314(b), the statutory deadline for institution is Monday, December 2, 2025. If instituted, the statutory deadline for a Final Written Decision is Tuesday, December 2, 2026, “not later than 1 year after the date on which the Director notices the institution of a review.”

01479, Paper 7 at 6-13 (P.T.A.B. Feb. 26, 2020) (denying institution where trial was scheduled to conclude “several months” before a final decision would be due); *Cisco Sys., Inc.*, IPR2020-00122, Paper 15 at 8 (“Because the trial date is substantially earlier than the projected statutory deadline for the Board’s final decision, this factor weighs in favor of discretionary denial.”); *Cisco Sys., Inc. v. Estech Sys., Inc.*, IPR2021-00329, Paper 13 at 7-15 (P.T.A.B. Jul. 6, 2021) (denied when two related trials predate FWD by eleven months and seven months, respectively); *F5 Networks, Inc. v. WSOU Invs., LLC*, IPR2022-00239, Paper 12 at 7-8 (P.T.A.B. May 19, 2022) (denied when trial predates FWD by six months); *Google LLC v. EcoFactor, Inc.*, IPR2021-00488, Paper 12 at 11-12 (P.T.A.B. Aug. 11, 2021) (denied when trial predates FWD by six months); *Cisco Sys., Inc. v. Oyster Optics, LLC*, IPR2021-00238, Paper 10 at 11-13 (P.T.A.B. June 1, 2021) (denied when trial predates FWD by seven months); *Samsung Elecs. Co. v. Truesight Commc’ns LLC*, IPR2025-00123, Paper 12 at 6-7 (P.T.A.B. Apr. 22, 2025) (denied when trial predates FWD by six months). The nearly significant difference between the June 1, 2026 and August 17, 2026 trial dates and the December 2026 FWD justifies discretionary denial.

The justification is compounded when considering the deadline for a request for Director Review, which is within 30 days of the entry of the FWD (*i.e.*, January

2, 2027), let alone the ultimate decision of any Director Review. Notably, it was only on October 1, 2024, that the U.S. Patent and Trademark Office (USPTO) issued a final rule governing Director Review of PTAB decisions in contested proceedings brought under the AIA, Rules Governing Director Review of Patent Trial and Appeal Board Decisions, effective Oct. 31, 2024, as 37 C.F.R. § 42.75, 89 Fed. Reg. 79744 (Oct. 1, 2024). As such, the Board's *Apple Inc. v. Fintiv, Inc.* decision was unable to consider the extended period of time for the PTAB Director to opine on a FWD.

Accordingly, because the trial dates are well before the projected statutory deadline of a FWD and any determination from a Director Review of a FWD, this factor weighs strongly in favor of discretionary denial.

D. Significant Investment in the Parallel Litigations Support Discretionary Denial

Patent Owner's and the Court's investment in the parallel proceeding weigh strongly in favor of discretionary denial. In at least the *Kia* Case, Plaintiff has submitted two sets of amended infringement contentions. Ex. 2003. The Claim Construction Hearing is scheduled in that case for December 3, 2025, only two (2) days after the institution decision is due in this matter. Ex. 2001. Similarly, in the *Volkswagen* Case, Patent Owner has also served infringement contentions, and claim

construction proceedings will begin on October 23, 2025, more than a month before the institution deadline. Ex. 2002. Therefore, on the December 2, 2025, statutory deadline for an institution decision, the parties in the *Kia Case* and the *Volkswagen Case* will have completed infringement contentions, served invalidity contentions, conducted months of discovery, and essentially completed claim construction in one matter. *See Exs. 2001, 2002.*

Accordingly, the Patent Owner's and Court's substantial investment in this proceeding weighs in favor of denial of institution.

E. No Stay of the Parallel District Court Litigations

There is no stay of the parallel District Court Litigations. Even if any of the defendants in the District Court Litigations move to stay the pending cases, the Eastern District of Texas routinely denies requests to stay pending IPRs before institution on all asserted claims of all asserted patents. *See Force Mos Tech., Co. v. ASUSTek Comput., Inc.*, No. 2:22-cv-00460-JRG, 2024 WL 1586266, at *4 (E.D. Tex. Apr. 11, 2024) (citation omitted). A stay in the District Court Litigations is unlikely before the institution decision in this matter because the most recently filed petition for *inter partes* review against a patent asserted in the District Court Litigations will not have an institution decision entered until December 26, 2025. *See Nissan Motor Co. v. Longhorn Auto. Grp. LLC*, IPR2025-01089, Paper 5

(P.T.A.B. June 25, 2025) (according to the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response).

Accordingly, the lack of a stay and the future unlikelihood of a stay before an institution decision weighs strongly in favor of denial of institution.

F. Other Factors Favor Discretionary Denial

The Petition should be denied for the additional reason that the Petition is weak. The substantive portion of the Petition setting forth the challenging grounds is approximately 87 pages long. *See* Pet. at 13-99. The expert declaration submitted by Petitioner does nothing to remedy any deficiencies and merely copies the same arguments set forth by the Petitioner. When viewing the factors together, the Petition should be denied in the Board's discretion under 35 U.S.C. § 314(a).

VI. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Director exercise discretion to deny institution of the Petition in its entirety.

Respectfully submitted,

September 2, 2025

By: /Vincent J. Rubino, III /
Vincent J. Rubino, III (Reg. No. 68,594)
Lead Counsel for Patent Owner
FABRICANT LLP
411 Theodore Fremd Avenue
Suite 206 South
Rye, New York 10580

IPR2025-00955
PATENT NO. 8,810,803

Tel. 212-257-5797
Fax. 212-257-5796
vrubino@fabricantllp.com
ptab@fabricantllp.com

CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S PRELIMINARY RESPONSE specified in 37 C.F.R. § 42.24 has 4,612 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word for Office 365.

Respectfully submitted,

September 2, 2025

By: /Vincent J. Rubino, III /
Vincent J. Rubino, III (Reg. No. 68,594)
Lead Counsel for Patent Owner
FABRICANT LLP
411 Theodore Fremd Avenue
Suite 206 South
Rye, New York 10580
Tel. 212-257-5797
Fax. 212-257-5796
vrubino@fabricantllp.com
ptab@fabricantllp.com

CERTIFICATE OF SERVICE

A copy of the foregoing PATENT OWNER'S PRELIMINARY RESPONSE
has been served on Petitioner's counsel of record as follows:

William H. Mandir
Email: wmandir@sughrue.com
John F. Rabena
Email: jrabena@sughrue.com
Tyler P. Del Rosario
Email: tdelrosario@sughrue.com
Derek C. True
Email: dtrue@sughrue.com
koitoIPR@sughrue.com
SUGHRUE MION PLLC
2000 Pennsylvania Ave, NW
Washington, D.C. 20006

Attorneys for Koito Manufacturing Co., Ltd.

September 2, 2025

By: /Vincent J. Rubino, III /
Vincent J. Rubino, III (Reg. No. 68,594)
Lead Counsel for Patent Owner
FABRICANT LLP
411 Theodore Fremd Avenue
Suite 206 South
Rye, New York 10580
Tel. 212-257-5797
Fax. 212-257-5796
vrubino@fabricantllp.com
ptab@fabricantllp.com