

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TESLA, INC.,  
Petitioner

v.

GRANITE VEHICLE VENTURES LLC,  
Patent Owner

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*Inter Partes* Review Case Nos. IPR2025-01034 and IPR2025-01035  
U.S. Patent No. 12,037,004

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**PETITIONER'S EXPLANATION OF MULTIPLE PETITIONS  
CHALLENGING U.S. PATENT NO. 12,037,004**

## **I. INTRODUCTION**

Petitioner filed two petitions challenging U.S. Patent 12,037,004 (“the ’004 Patent”), both of which are based on the same primary and secondary prior art references and include significant portions of substantively identical analysis. “To aid the Board in determining” why “more than one petition is necessary,” Petitioner provides the information below. *See* PTAB Consolidated Trial Practice Guide (“TPG”) (November 2019), 59–60.

## **II. RANKING**

Per the TPG, Petitioner requests the Board consider the petitions in the following order: 1) IPR2025-01034 (challenging claims 1-9, 29-39); and 2) IPR2025-01035 (challenging claims 10-24, 27). That is, Petitioner ranks IPR2025-01034 (claims 1-9, 29-39) first.

## **III. EXPLANATION OF DIFFERENCES BETWEEN PETITIONS**

Both Petitions are necessary for several reasons: First, Patent Owner has asserted each of the challenged claims against Petitioner in related district court litigation. (Ex. 1058, p. 2). Patent Owner also asserts a large number of claims (36 total). Thus, Petitioner has a concrete, non-speculative interest in the IPR challenges against each claim.

Second, the number, length, and complexity of the challenged claims warrant Petitioner’s two petitions. There are 36 challenged claims comprising a very large

number of words and limitations: the first petition challenges Claims 1–9 and 29–39 (totaling 2711 words of claim language alone), while the second petition challenges Claims 10–24 and 27 (totaling 1794 words of claim language). The claims recite numerous hardware components and functions, including performing weighted voting, transitioning between driving modes, receiving active learning data for multiple cohorts of other vehicles or drivers, determining control processor competence and human driver competence levels, and determining if one or more faults have occurred and using a fault-remediation table to look up a corresponding corrective action to take, where a plurality of specific corrective actions are claimed. Many of the claims, including dependent claims, recite numerous features. *See, e.g.*, Claims 2, 6-9, 16-18. The Board has regularly instituted parallel petitions in cases with similar circumstances. *See, e.g., Abbott Diabetes Care Inc. v. Dexcom, Inc.*, IPR2024-00891, Paper 9 at 3–5 (PTAB Dec. 16, 2024) (Patent Owner’s assertion of 40 claims, along with the length of the claims and complexity of the subject matter, warranted two petitions); *Samsung Elecs. Co., Ltd. v. Maxell, Ltd.*, IPR2024-00777, Paper 11 at 8–9 (PTAB Nov. 8, 2024) (the combination of the number of challenged claims (27) and the number of limitations justified two petitions); *Adobe Inc. v. Synklound Techs., LLC*, IPR2020-01392, Paper 8 at 8–10 (PTAB Mar. 11, 2021) (Patent Owner’s assertion of 20 claims, along with the length of the claims, warranted two petitions).

Each Petition also divides the independent claims between the Petitions based on subject matter class, but otherwise, both Petitions present much of the same material and substantive analysis. For example, the grounds in each Petition rely on the same primary and secondary prior art references, and each Petition only relies on unique tertiary prior art references to address dependent claims and/or limitations unique to that Petition. And while the combinations of prior art are different between the petitions, that is necessary to address differences between the independent claims in each petition, i.e., some limitations found in a dependent claim depending from one independent claim are recited in another independent claim. The Board has likewise found multiple petitions justified under these circumstances. *See, e.g., Abbott*, IPR2024-00891, Paper 9 at 4 (instituting where each petition challenges different claims); *Adobe*, IPR2020-01392, Paper 8 at 9 (instituting where each petition challenges different claims using the same prior art); *Intel Corp. v. VLSI Tech. LLC*, IPR2019-01199, Paper 19 at 10–12 (PTAB Feb. 6, 2020) (instituting where each petition challenges a different independent claim, each directed to a different subject matter class and containing different claim terms); *Apple Inc. v. Seven Networks, LLC*, IPR2020-00156, Paper 10 at 28 (PTAB June 15, 2020) (instituting where each petition challenges mutually exclusive dependent claims and asserts overlapping prior art).

Pursuant to TPG recommendations, Petitioner provides the table below to aid the Board in identifying the similarities and differences between the petitions. As shown, the Petitions generally rely on the same prior art as primary references in both petitions (overlapping prior art color-coded). The only exceptions (shown in black text) are prior art references used as tertiary references to address dependent claims and/or limitations unique to each Petition:

IPR2025-01034	IPR2025-01035
<p><b><u>Ground 1:</u></b> Claim 1 is obvious under § 103(a) over <i>Hampiholi</i>, <i>Attard</i>, <i>McNew</i>, and <i>Frazer</i>.</p> <p><b><u>Ground 2:</u></b> Claims 2–5 are obvious under § 103(a) over <i>Hampiholi</i>, <i>Attard</i>, <i>McNew</i>, <i>Frazer</i>, <i>DeRuyck</i>, <i>Gunderson</i>, <i>An</i>, <i>Kang</i>, and <i>Schunder</i>.</p> <p><b><u>Ground 3:</u></b> Claims 6-7 are obvious under § 103(a) over <i>Hampiholi</i>, <i>Attard</i>, <i>McNew</i>, <i>Frazer</i>, and <i>Sako</i>.</p> <p><b><u>Ground 4:</u></b> Claim 8 is obvious under § 103(a) over <i>Hampiholi</i>, <i>Attard</i>, <i>McNew</i>, <i>Frazer</i>, and <i>Coelingh</i>.</p> <p><b><u>Ground 5:</u></b> Claim 9 is obvious under § 103(a) over <i>Hampiholi</i>, <i>Attard</i>, <i>McNew</i>, <i>Frazer</i>, <i>Coelingh</i>, <i>DeRuyck</i>, <i>Gunderson</i>, <i>An</i>, <i>Kang</i>, and <i>Schunder</i>.</p> <p><b><u>Ground 6:</u></b> Claim 29 is obvious under § 103(a) over <i>Hampiholi</i>, <i>Attard</i>, <i>McNew</i>, <i>Frazer</i>, and <i>Hada</i>.</p> <p><b><u>Ground 7:</u></b> Claim 30 is obvious under § 103(a) over <i>Hampiholi</i>, <i>Attard</i>, <i>McNew</i>, <i>Frazer</i>, and <i>Hada</i>, and <i>Tsimhoni-637</i></p> <p><b><u>Ground 8:</u></b> Claims 31-32 are obvious under § 103(a) over <i>Hampiholi</i>, <i>Attard</i>, <i>McNew</i>, <i>Frazer</i>, <i>Hada</i>, <i>Tsimhoni-637</i>, <i>DeRuyck</i>, <i>Gunderson</i>, <i>An</i>, <i>Kang</i>, and <i>Schunder</i>.</p> <p><b><u>Ground 9:</u></b> Claims 33-34 are obvious under § 103(a) over <i>Hampiholi</i>, <i>Attard</i>, <i>McNew</i>, <i>Frazer</i>,</p>	<p><b><u>Ground 1:</u></b> Claims 10-14 are obvious under § 103(a) over <i>Hampiholi</i>, <i>Attard</i>, <i>McNew</i>, <i>Yamada</i>, <i>Gunderson</i>, <i>Grimm</i>, and <i>Frazer</i>.</p> <p><b><u>Ground 2:</u></b> Claim 15 is obvious under § 103(a) over <i>Hampiholi</i>, <i>Attard</i>, <i>McNew</i>, <i>Gunderson</i>, <i>Grimm</i>, <i>Frazer</i>, <i>Duncan</i>, and <i>Engelman</i>.</p> <p><b><u>Ground 3:</u></b> Claims 16-17 is obvious under § 103(a) over <i>Hampiholi</i>, <i>Attard</i>, <i>McNew</i>, <i>Gunderson</i>, <i>Grimm</i>, <i>Frazer</i>, <i>Duncan</i>, <i>Engelman</i>, and <i>Strauss</i>.</p> <p><b><u>Ground 4:</u></b> Claims 18-20 are obvious under § 103(a) over <i>Hampiholi</i>, <i>Attard</i>, <i>McNew</i>, <i>Gunderson</i>, <i>Grimm</i>, <i>Frazer</i>, <i>Duncan</i>, <i>Engelman</i>, <i>Strauss</i>, and <i>Sako</i>.</p>

<p><i>Hada</i>, <i>Tsimhoni-637</i>, <i>DeRuyck</i>, <i>Gunderson</i>, <i>An</i>, <i>Kang</i>, <i>Schunder</i>, and <i>Nagasaka</i>.</p> <p><b>Ground 10:</b> Claims 35-36 are obvious under § 103(a) over <i>Hampiholi</i>, <i>Attard</i>, <i>McNew</i>, <i>Frazer</i>, <i>Hada</i>, <i>Tsimhoni-637</i>, <i>DeRuyck</i>, <i>Gunderson</i>, <i>An</i>, <i>Kang</i>, <i>Schunder</i>, <i>Nagasaka</i>, and <i>Duncan</i>.</p> <p><b>Ground 11:</b> Claims 37-39 are obvious under § 103(a) over <i>Attard</i>, <i>Hampiholi</i>, <i>McNew</i>, and <i>Frazer</i>.</p>	<p><b>Ground 5:</b> Claims 21-24, 27 are obvious under § 103(a) over <i>Hampiholi</i>, <i>Attard</i>, <i>McNew</i>, <i>Gunderson</i>, <i>Grimm</i>, <i>Frazer</i>, <i>Duncan</i>, <i>Engelman</i>, <i>Strauss</i>, <i>Sako</i>, and <i>Hada</i>.</p>
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Given the above-described overlap of issues between the petitions, additional efficiencies can be gained by holding consolidated depositions and a single oral hearing for both proceedings. This further supports institution of both petitions. *Abbott*, IPR2024-00891, Paper 9 at 5; *Google LLC v. Hammond Dev. Int’l, Inc.*, IPR2020-00305, Paper 16 at 58 (PTAB June 30, 2020); *Microsoft Corp. v. IPA Techs. Inc.*, IPR2019-00810, Paper 12 at 15 (PTAB Oct. 16, 2019).

#### IV. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests institution of IPR2025-01034 and IPR2025-01035 so that the Board can consider both petitions and all of Patent Owner’s asserted claims on the merits.

Respectfully submitted,

BY: /s/ Jennifer C. Bailey

Jennifer C. Bailey, Reg. No. 52,583

COUNSEL FOR PETITIONER

**CERTIFICATE OF SERVICE ON PATENT OWNER**  
**UNDER 37 C.F.R. § 42.105**

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105, the undersigned certifies that on May 28, 2025, a complete and entire copy of this *Explanation of Multiple Petitions* was provided via Federal Express to the Patent Owner by serving the correspondence address of record for the '004 Patent as listed on PAIR:

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