

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

---

TESLA, INC.  
Petitioner,

v.

PERCEPTIVE AUTOMATA LLC  
Patent Owner.

---

Case No. IPR2025-01575  
Patent 11,753,046

---

**PETITIONER'S OPPOSITION TO PATENT OWNER'S  
DISCRETIONARY DENIAL BRIEF**

## TABLE OF CONTENTS

I.	INTRODUCTION .....	1
II.	FACTUAL BACKGROUND.....	2
	A.    The Challenged Patent .....	2
	B.    The Undisclosed Cox Application .....	3
	C.    The Parallel District Court Actions.....	4
III.	THIS IPR GIVES THE PTAB A CHANCE TO CONSIDER COX.....	6
IV.	NO SETTLED EXPECTATIONS SUPPORT DENIAL.....	7
V.	THE FINTIV FACTORS FAVOR INSTITUTION .....	9
	A.    Factor 1 (Stay of Litigation).....	9
	B.    Factor 2 (Proximity of District Court Trial Date).....	10
	C.    Factor 3 (Investment in Parallel Proceeding).....	11
	D.    Factor 4 (Overlap with Parallel Proceeding).....	12
	E.    Factor 5 (Identify of the Parties) .....	14
	F.    Factor 6 (Other Circumstances) .....	14
VI.	CONCLUSION.....	16

## TABLE OF AUTHORITIES

	Page(s)
<b>CASES</b>	
<i>Anthony Inc. v. ControlTec, LLC</i> , IPR2025-00559 and IPR2025-00636, Paper 9 (PTAB July 16, 2025) .....	6
<i>Apple Inc., v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 .....	11, 12
<i>Cambridge Ind. USA, Inc. v. Applied Optoelectronics, Inc.</i> , IPR2025-00436, Paper 10 (Acting Director June 26, 2025) .....	7
<i>Cambridge Ind. USA, Inc. v. Applied Optoelectronics, Inc.</i> , IPR2025-00436, Paper 11 (Acting Director June 26, 2025) .....	1
<i>Google LLC v. Withrow Networks Inc.</i> , IPR2025-00775, Paper 10 (Acting Deputy Chief APJ August 14, 2025) .....	7
<i>Innolux Corp., v. Phenix Longhorn LLC</i> , IPR2025-00043 Paper 10 (P.T.A.B. May 15, 2025) .....	14
<i>iRhythm Techs., Inc. v. Welch Allyn, Inc.</i> , IPR2025-00363, Paper 10 (Acting Director June 6, 2025) .....	9
<i>Liberty Energy Servs. LLC, v. U.S. Well Servs., LLC</i> , IPR2025-00139 Paper 14 (P.T.A.B. June 11, 2025) .....	14
<i>Meetrix IP, LLC v. Cisco Sys., Inc.</i> , No. 1-18-CV-309-LY, 2018 WL 8261315 (W.D. Tex. Nov. 30, 2018) .....	8
<i>Mercedes-Benz Group AG, v. The Phelan Group, LLC</i> , IPR2025-00413, Paper 13 (Acting Director June 25, 2023) .....	10
<i>Microsoft Corp. v. Edge Networking Sys., LLC</i> , IPR2025-00617, Paper 12 (Acting Director July 31, 2025) .....	7
<i>MIM Software Inc. v. Progenics Pharms., Inc.</i> , IPR2025-00630, Paper 13 (Acting Director July 24, 2025) .....	7

<i>Motorola Sols., Inc. v. Stellar, LLC,</i> IPR2024-01205, Paper 19 (Acting Director Mar. 28, 2025).....	13
<i>POSCO Co. Ltd. v. ArcelorMittal,</i> IPR2025-00370, 00371 .....	8
<i>Samsung Elecs. Co. v. Wilus Inst. of Standards &amp; Tech. Inc.,</i> IPR2025-00933, Paper 11 (Acting Director Oct. 10, 2025).....	13
<i>Shenzhen TuoZhu Tech Co. v. StratasyS, Inc.,</i> IPR2025-00438, Paper 10 (Acting Director July 17, 2025).....	13
<i>Tesla, Inc. v. Charge Fusion Techs., LLC,</i> IPR2025-00032, Paper 11 (PTAB May 19, 2025) .....	15
<i>Tesla, Inc. v. Intellectual Ventures II LLC,</i> IPR2025-00217, Paper 9 (Acting Director June 13, 2025) .....	13
<b>STATUTES</b>	
35 U.S.C. §102 .....	12
35 U.S.C. §103 .....	12

## LIST OF EXHIBITS

Ex. No.	Description	New
1001	U.S. Patent No. 11,753,046 (“’046 Patent”)	
1002	File History of U.S. Patent No. 11,753,046	
1003	Declaration of Dr. Jason Janét	
1004	U.S. Patent Application Publication No. 2017/0099200 (“Ellenbogen”)	
1005	U.S. Patent No. 10,496,091 (“Ross”)	
1006	U.S. Patent Application Publication No. 2016/0162456 (“Munro”)	
1007	International Publication WO 2014/210334 (“Cox”)	
1008	File History of U.S. Patent No. 10,402,687	
1009	File History of U.S. Patent No. 10,614,344	
1010	File History of U.S. Patent No. 11,126,889	
1011	Complaint in <i>Perceptive Automata LLC v. Tesla, Inc.</i> , Case No. 2:25-cv-00742 (E.D. Tex. filed July 23, 2025)	
1012	U.S. Patent No. 10,733,506 (“Ogale”)	
1013	CV of Dr. Jason Janét	
1014	Tesla’s Notice of Sotera Stipulation	
1015	Patent Owner Voluntary Dismissal – EXTX-2:25-cv-00742 (filed December 29, 2025)	<b>X</b>
1016	Patent Owner Complaint – WDTX-7:25-cv-00594 (filed December 29, 2025)	<b>X</b>
1017	Motion to Stay – WDTX-7:25-cv-00594 (filed January 5, 2025)	<b>X</b>
1018	Docket Navigator – Judge David Counts Statistics	<b>X</b>
1019	Docket Navigator – Time to Trial Statistics for WDTX	<b>X</b>
1020	Tesla Renewed Sotera-Plus Stipulation for WDTX	<b>X</b>
1021	Docket – WDTX-7:25-cv-00594	<b>X</b>
1022	Personal Website of Dr. Samuel English Anthony	<b>X</b>

## I. INTRODUCTION

There is no basis to deny institution of this IPR. To the contrary, a material error necessitates review, Patent Owner does not have any settled expectations given the recent issuance of the challenged patent, and there is no scheduled trial date in a parallel litigation.

The IPR filed by Petitioner Tesla, Inc. represents the Patent Office's first opportunity to address prior art *of a named inventor* that was never submitted or considered during prosecution. *See* EX1006 (cover, listing inventor Samuel Anthony). As a matter of fairness and a clear example of prosecution error, a patent owner should not be allowed to withhold its own relevant prior art from the examiner during the examination of a patent application, and then argue that "settled expectations" or any other discretionary factors prohibit the Patent Office from later considering the withheld prior art during an IPR proceeding.

Moreover, the challenged patent (U.S. Patent No. 11,753,046) issued on September 12, 2023— less than two years and one month before this IPR was filed. Patents that have been in force for less than six years "have not been in force for a significant period of time [. . .], and, accordingly, Patent Owner has not developed strong settled expectations that favor discretionary denial[.]" *Cambridge Ind. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00436, Paper 11 at 2–3 (Acting

Director June 26, 2025) (declining discretionary denial for patents in force for five years and four months, five years and six months, and four years and three months).

As for *Fintiv* considerations, every argument made by Patent Owner Perceptive Automata LLC must be disregarded because, after submitting its discretionary denial brief, Perceptive *voluntarily dismissed* the Eastern District of Texas case against Tesla. As such, there is currently no district court trial scheduled in any court. And although Perceptive filed a new case in the Western District of Texas against Tesla, this new case — filed months after this IPR — is no reason to deny institution. Tesla’s IPR is now the first-filed and still-pending action on the ’046 Patent, and any Final Written Decision in this proceeding will likely occur *years prior* to a potential trial in the district court. As such, there is no risk of contradictory outcomes and minimal risk of duplicative effort. The most efficient use of resources would be a review of this petition on the merits.

## **II. FACTUAL BACKGROUND**

### **A. The Challenged Patent**

The Challenged Patent, U.S. Patent No. 11,753,046 (“the ’046 Patent”), is a continuation of U.S. Application No. 16/828,823, now U.S. Patent No. 11,126,889 (“the ’889 Patent”), filed on March 24, 2020, which is a continuation of U.S. Application No. 16/512,560, now U.S. Patent No. 10,614,344 (“the ’344 Patent”), filed on July 16, 2019, which claims priority to a non-provisional application filed

on December 4, 2017 by three inventors: Samuel Anthony, Kshitij Misra, and Avery Faller. The '046 Patent generally relates to (1) training a machine learning model using human labeled training data and (2) applying the trained model to new input data to generate an output that replicates how humans would have labeled the new input data. *See, e.g.*, EX1001, Abstract, 6:14-7:50.

### **B. The Undisclosed Cox Application**

Grounds 1 through 4 of this IPR rely on International Publication No. WO2014/210334 to Cox et al. (“Cox”). Cox lists Samuel Anthony as an inventor. Dr. Anthony is also a named inventor on the '046 Patent, and Cox describes the same methods of training a predictive machine learning model as are disclosed and claimed in the '046 Patent. *Compare* EX1007, ¶0004 (“[C]lassification module 185 is utilized to make predictions . . . that are more consistent with the decisions of the human annotators.”) with EX1001, 12:30-35 (explaining how a machine learning model is “trained” when “the difference between the summary statistics output by the neural network and the summary statistics calculated from the responses of the human observers [] is minimized.”). Cox published on December 31, 2014, years before the claimed 2017 priority date of the '046 Patent. As explained in the Petition, the disclosure in Cox is directly relevant to all claim elements of claim 1, which includes, *inter alia*, “receiving, from each of the plurality of human observers, a response representing a judgment by the human observer of the state of mind of the

user in the image,” “generating summary statistics describing the state of mind of the user in the image based on the received responses from the plurality of human observers,” “storing the summary statistics in association with the image as part of the training data,” and “training a model using the training data.” Paper 1 at 14-28. Nonetheless, Cox was never submitted to the Patent Office during prosecution of the ’046 Patent.

Cox appears to be based on Dr. Anthony’s work at the Harvard Vision Sciences Lab during Dr. Cox’s pursuit of a PhD. *See* EX1022, 1-2. Notably, Dr. Anthony’s personal website admits that there is *a direct link* between this prior work (reflected in Cox) and the ’046 Patent, stating that *this “PhD work was at the heart of the technology we built at Perceptive Automata.”* *Id.*, 1. However, despite recognizing the disclosure of Cox as the “heart” of Perceptive Automata’s technology, the inventors failed to disclose this material prior art to the Patent Office. EX1001, Cover Page; EX1002. The Patent Office therefore never had an opportunity to consider Cox until Tesla filed this IPR.

### **C. The Parallel District Court Actions**

Perceptive originally filed a complaint for patent infringement against Tesla in the U.S. District Court for the Eastern District of Texas on July 23, 2025, asserting the ’046 Patent and four other patents. *See* EX1010. In response, in a little more than two months, Tesla promptly filed this IPR on October 1, 2025, and four other

IPRs for each remaining asserted patent between September 30 and October 10, 2025.

Challenged Patent	IPR
U.S. Patent No. 10,614,344	IPR2025-01573
U.S. Patent No. 11,126,889	IPR2025-01574
U.S. Patent No. 11,753,046	IPR2025-01575
U.S. Patent No. 11,467,579	IPR2025-01576
U.S. Patent No. 11,520,346	IPR2025-01577

Because Tesla wasted no time getting these IPRs on file, any Final Written Decisions on these IPRs had been expected before the now-vacated trial date in the Eastern District of Texas.

Despite featuring prominently in Perceptive’s Discretionary Denial Brief, the Eastern District of Texas litigation is no longer relevant.<sup>1</sup> On December 29, 2025, Perceptive voluntarily dismissed all claims in the Eastern District of Texas. EX1015. That same day, Perceptive filed a new complaint in the Western District of Texas. EX1016. Tesla’s response to the Western District of Texas Complaint is

---

<sup>1</sup> While now moot because of the dismissal, Tesla maintains that the *Fintiv* factors would still have favored institution, even if Perceptive had not dismissed the Eastern District of Texas case. In particular, the Eastern District of Texas case was still in its early stages, with only limited discovery and no substantive rulings.

due January 20, and the only activity in that case to date has been Tesla filing a motion to stay the case pending its IPRs. EX1017.

### **III. THIS IPR GIVES THE PTAB A CHANCE TO CONSIDER COX**

The Patent Office has an interest in rectifying material errors made during patent prosecution. *See Anthony Inc. v. ControlTec, LLC*, IPR2025-00559 and IPR2025-00636, Paper 9 (PTAB July 16, 2025). Here, there was a material error (or misconduct) *by the applicant* during prosecution: the applicant should have disclosed Cox, which was plainly known to the inventor which the inventor admitted goes to “the heart” of the claimed inventions. *See EX1022*, 1. Because the Cox reference was withheld, the original prosecution rested on an incomplete record, and this IPR represents the first opportunity for the Patent Office to consider Cox. Discretionary denial is therefore inappropriate. Instituting the IPR will allow the Board to efficiently address a critical gap in the original prosecution history for the benefit of Tesla, Perceptive, and the public.

Relatedly, a patent owner such as Perceptive should not be permitted to rely on “settled expectations” for a patent when the applicant and the inventors should have, but did not, submit a critical prior art reference of an inventor. The applicant and the inventors should have disclosed Cox — the inventor’s own prior art — to the Patent Office during prosecution. Because Cox was not provided during prosecution, Perceptive cannot complain now that the Patent Office is going to

consider that withheld reference. The Patent Office should have considered Cox before granting the '046 Patent, and Tesla's IPR now gives the Patent Office a chance to fulfill that responsibility.

#### **IV. NO SETTLED EXPECTATIONS SUPPORT DENIAL**

Even apart from the applicant's failure to disclose Cox, there are no settled expectations that would support discretionary denial because the '046 Patent was issued less than six years ago in 2022. Instead, "early challenges," like Tesla's, "favor robust, predictable patent rights and weigh against discretionary denial." *MIM Software Inc. v. Progenics Pharms., Inc.*, IPR2025-00630, Paper 13 at 2 (Acting Director July 24, 2025). Prior Discretionary Denial decisions confirm that settled expectations do not support discretionary denial for patents issued less than six years prior to the filing of an IPR petition. *See Cambridge Ind. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00436, Paper 10 at 2–3 (Acting Director June 26, 2025) (no settled expectations for patents issued in 2019 and 2020); *Google LLC v. Withrow Networks Inc.*, IPR2025-00775, Paper 10 at 2 (Acting Deputy Chief APJ August 14, 2025) (no settled expectations for patent issued in 2020); *Microsoft Corp. v. Edge Networking Sys., LLC*, IPR2025-00617, Paper 12 at 2 (Acting Director July 31, 2025) (no settled expectations for patents that issued between 2020 and 2023).

To create an atmosphere of "settled expectations," Perceptive also focuses on "the nearly four years" since the '344 Patent was disclosed on an IDS during the

prosecution of one of Tesla’s unrelated patent applications.<sup>2</sup> But this is not an IPR on the ’344 Patent, and the IDS Perceptive cites excludes any reference to the ’046 Patent that is at issue in this IPR. Moreover, four years is not sufficient time to create settled expectations, as discussed above, regardless of any alleged notice. Perceptive again cites no prior decisions finding settled expectations based on alleged notice so recently, and other cases have found recent notice of a patent family insufficient. For example, in *POSCO Co. Ltd. v. ArcelorMittal*, a petitioner had previously litigated the validity of a related patent in another IPR that concluded four years earlier, and the Acting Director still found that arguments about settled expectations “tip the balance *against* discretionary denial.” IPR2025-00370, 00371, Paper 10 at

---

<sup>2</sup> Moreover, citations to a related patent during prosecution do not constitute notice. *See Meetrix IP, LLC v. Cisco Sys., Inc.*, No. 1-18-CV-309-LY, 2018 WL 8261315, at \*2 (W.D. Tex. Nov. 30, 2018) (citation to related patent “too attenuated to plausibly infer” pre-suit notice). Nor does Perceptive argue that it relied on (or was even aware of) the prosecution citations to the ’344 Patent. The number of times that the ’344 Patent was cited in an IDS is also immaterial. As reflected in EX2001 through EX2020, to comply with its duty of candor, Tesla submitted a nearly identical IDS for each Tesla patent application, each IDS listing several hundred references.

2-3 (Acting Director June 25, 2025) (emphasis added). The timeline from *POSCO* is much closer to the present case, and thus more informative than the *iRhythm* decision cited by Perceptive, which involved a citation to a patent more than ten years earlier. *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 3 (Acting Director June 6, 2025). If directly challenging a related patent in *POSCO* does not trigger settled expectations, then certainly Tesla's IDS citation does not trigger settled expectations in this case.

## **V. THE FINTIV FACTORS FAVOR INSTITUTION**

Because the prior litigation from the Eastern District of Texas has been dismissed, all of Perceptive's prior arguments about *Fintiv* and the Eastern District of Texas litigation are irrelevant and moot. The only case between the parties now is a newly-filed case in the Western District of Texas, which has no trial date, no schedule, no infringement contentions, and no discovery to date. As such, the *Fintiv* analysis now strongly supports institution. Indeed, Tesla is unaware of any decision discretionarily denying institution of an IPR based on a lawsuit filed months *after* an IPR petition.

### **A. Factor 1 (Stay of Litigation)**

Due to the close proximity between the filing of the Western District of Texas litigation and this brief, Tesla has only recently filed a motion to stay on January 5, 2026. EX1017. There is an increased likelihood that the parallel district court action

will be stayed given the unique circumstances of this case and that Tesla filed its motion to stay promptly after Perceptive filed its complaint in the Western District of Texas. Indeed, the case is in its infancy, there has yet to even be a case management conference, and this IPR if instituted will likely simplify issues for the trial since it challenges all claims.

The analysis presented by Perceptive for this factor is now void because it focuses on the Eastern District of Texas litigation, which Perceptive voluntarily dismissed. As such, this factor should be considered to weigh in favor of institution or, at most, be neutral.

**B. Factor 2 (Proximity of District Court Trial Date)**

This factor weighs heavily in favor of institution because there is no trial date set for the newly-filed Western District of Texas litigation. *See Mercedes-Benz Group AG, v. The Phelan Group, LLC*, IPR2025-00413, Paper 13 at 2 (Acting Director June 25, 2023) (holding that discretionary denial was not appropriate because there was “no scheduled trial date in the district court proceeding.”). Perceptive’s arguments related to this factor are now entirely moot as Perceptive voluntarily dismissed the Eastern District of Texas litigation on December 29, 2025.

In addition, there are no available time to trial statistics for the judge now assigned to the Western District of Texas: Judge Counts has *never* had a patent case go to trial. EX1018. But even using the fastest time to trial in the Western District

of Texas over the past year (39 months) would not result in a trial date close to the anticipated Final Written Decision date, which is in April 2027. *See* EX1019. For a case filed in December 2025, that would put trial at March 2029—almost two years after the anticipated Final Written Decision date. So, even if Judge Counts moves this case to trial as fast as any case in the Western District of Texas over the last year, trial would still be years after a Final Written Decision in this IPR. Thus, there is no risk of conflicting rulings, and this proceeding is the most efficient way for the parties to adjudicate patentability. This factor strongly favors institution.

**C. Factor 3 (Investment in Parallel Proceeding)**

The parties have made almost zero investment in the new Western District of Texas litigation. Tesla has not responded to the Complaint, no discovery has taken place, and the court has not issued a scheduling order or substantive order related to the '046 Patent. EX1021. In fact, the only activity in this case to date is the filing of Tesla's Motion to Stay, pending its IPRs. Therefore, there is no risk of “duplicative costs” in instituting this IPR because minimal resources have been invested in the parallel proceeding. *See Apple Inc., v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 9–11. Moreover, it would be illogical for Perceptive to complain about parallel burden from the Western District of Texas case, which Perceptive filed *after* Tesla filed this IPR. If Perceptive did not want to engage in a parallel proceeding,

then Perceptive should not have filed the Western District of Texas case (or Perceptive could simply agree to Tesla's Motion to Stay).

All of Perceptive's arguments about investment in the Eastern District of Texas are now moot because that case has been dismissed. But even considering the activity in the Eastern District of Texas, this factor still favors institution. Because Tesla moved so quickly to file its IPRs, the parties had minimal investment in the Eastern District of Texas case, and the Court did not issue any substantive orders related to the '046 Patent. Indeed, Tesla filed its Petition just 70 days after the filing of the original complaint in the Eastern District of Texas case (July 23, 2025), and one day after Perceptive served its infringement contentions. Tesla's exceptionally prompt action weighs in favor of institution. IPR2020-00019, Paper 11 at 11 ("If the evidence shows that the petitioner filed the petition expeditiously, such as promptly after becoming aware of the claims being asserted, this fact has weighed against exercising the authority to deny institution."); *see also Savant Tech. LLC v. Feit Elec. Co., Inc.*, IPR2025-00260, Paper 16 at 3 (Acting Director June 12, 2025) (no discretionary denial where "Petitioners acted diligently in filing this Petition less than three months after Patent Owner asserted claims 11 and 12 in district court.").

**D. Factor 4 (Overlap with Parallel Proceeding)**

Tesla has filed a *Sotera-Plus* stipulation tailored to ensure that the IPR "would be a 'true alternative' to the district court proceeding" regarding invalidity under 35

U.S.C. §§102 and 103. EX1020. *See Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3–4 (Acting Director Mar. 28, 2025). In *Motorola*, the Director vacated the Board’s decision granting institution despite the petitioner’s *Sotera* stipulation because the petitioner’s invalidity arguments in the district court included combinations of the prior art asserted in the IPR with unpublished system art. *Id.* Here, Tesla’s *Sotera-Plus* stipulation mitigates any such concern of duplication. In this way, Perceptive’s reliance on *Motorola* is misguided. Paper 7 at 12-13. Tesla’s *Sotera-Plus* stipulation avoids the exact scenario contemplated in the *Motorola* decision.

Indeed, the Director has previously found that stipulations similar to those filed by Tesla strongly favor institution. *Samsung Elecs. Co. v. Wilus Inst. of Standards & Tech. Inc.*, IPR2025-00933, Paper 11 at 3 (Acting Director Oct. 10, 2025) (noting for a nearly identical stipulation that “Petitioner has filed a broad stipulation that reduces the concern of inconsistent outcomes or significant duplication of efforts.”); *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 at 2 (Acting Director June 13, 2025); *Shenzhen Tuozhu Tech Co. v. Stratasy, Inc.*, IPR2025-00438, Paper 10 at 3 (Acting Director July 17, 2025). This factor thus weighs in favor of institution.

Perceptive also argues that Tesla’s stipulations are insufficient because they do not include Tesla’s inequitable conduct claim. Paper 7 at 13-14. This position

misunderstands the purpose of the stipulation, as inequitable conduct is not an issue that can be adjudicated by the PTAB. It is also startling for Perceptive to suggest that misconduct by the named inventors — withholding relevant prior art from the Patent Office — is a basis for penalizing *Tesla*. Tesla’s IPRs should not be denied because of wrongdoing by the applicant.

**E. Factor 5 (Identity of the Parties)**

Tesla does not dispute that it is the defendant in the newly-filed Western District of Texas case. However, this factor has been historically viewed as neutral, or at worst, only “slightly” favoring denying institutions when petitioner and defendant are the same party. *See Liberty Energy Servs. LLC, v. U.S. Well Servs., LLC*, IPR2025-00139 Paper 14 at 14 (P.T.A.B. June 11, 2025) (weighing factor 5 “slightly in favor of denying institution”); *Innolux Corp., v. Phenix Longhorn LLC*, IPR2025-00043 Paper 10 at 13 (P.T.A.B. May 15, 2025) (weighing factor 5 as “neutral”).

**F. Factor 6 (Other Circumstances)**

No other factors warrant discretionary denial. Each of Perceptive’s flawed arguments under this factor are addressed below. *Contra* Paper 7 at 14-17.

Settled expectations: As explained above, the ’046 Patent issued too recently for Perceptive to rely on settled expectations.

Strength of merits: Perceptive does not make any specific arguments about the

merits of the Petition. However, Tesla submits that the merits are particularly strong including because, as described above, the Petition asserts two grounds using the Cox reference that the inventor himself has stated is “at the heart of the technology we built at Perceptive Automata.” EX1022.

Use of expert testimony: Perceptive incorrectly states that Tesla relies on expert testimony to “plug holes” that are allegedly not disclosed in the references. Paper 7 at 14-15. To the contrary, the Petition uses expert testimony to simply explain the knowledge of a person of ordinary skill in the art at the time and to clarify the relationship between well-known concepts recited in the art and the language used in the claims of the '046 Patent. Indeed, in the examples cited by Perceptive, the Petition first points to the specific recitation in the prior art that meets the limitation, then provides further clarity from the expert. *See id.* The Board has previously applauded this type of thorough expert testimony, grounded in objective evidence. *Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00032, Paper 11 at 39 (PTAB May 19, 2025). It is also irrelevant that the term “POSITA” appears 52 times in the Petition; obviousness is always evaluated from the perspective of a POSITA.

Claim construction: Perceptive does not make any specific arguments about how Tesla’s claim construction positions might warrant discretionary denial. And

contrary to Perceptive's vague assertions, Tesla's claim construction positions have remained consistent. *Contra* Paper 7, 16-17.

## **VI. CONCLUSION**

For the above reasons, Tesla respectfully requests that the Director deny Perceptive's request for discretionary denial, and institute this IPR.

Respectfully Submitted,

Date: January 8, 2026

*/Roger Fulghum/*

Roger Fulghum  
Reg. No. 39,678

*Attorney for Petitioner, Tesla, Inc.*

**CERTIFICATE OF COMPLIANCE WITH PAGE LIMITATION,  
TYPEFACE REQUIREMENTS, AND TYPE STYLE REQUIREMENTS**

1. This Brief complies with the 20-page limit, excluding the parts exempted by 37 C.F.R. § 42.24(a).

2. This Petition complies with the general format requirements of 37 C.F.R. § 42.6(a) and has been prepared using Microsoft® Word in 14-point Times New Roman.

Respectfully submitted,

BAKER BOTTS L.L.P.

*/Roger Fulghum/*

Roger Fulghum  
Reg. No. 39,678

*Lead Attorney for Petitioner, Tesla, Inc.*

Date: January 8, 2026

Baker Botts L.L.P.  
910 Louisiana Street  
Houston, TX 77002  
Phone: (713) 229-1707  
roger.fulghum@bakerbotts.com

## CERTIFICATE OF SERVICE

The undersigned certifies that on January 8, 2026, a complete and entire copy of the **PETITIONER'S OPPOSITION TO PATENT OWNER'S DISCRETIONARY DENIAL BRIEF**, including exhibits, were served on Patent Owner electronically via email on the following counsel of record for Patent Owner:

Charles Austin Ginnings (austin@nelbum.com)

John P. Murphy (murphy@nelbum.com)

peceptive@nelbum.com

Date: January 8, 2026

*/Roger Fulghum/*

Roger Fulghum, Reg. No. 39,678  
*Attorney for Petitioner, Tesla, Inc.*