

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

EMERGING AUTOMOTIVE LLC,

Plaintiff,

v.

KIA CORPORATION, ET AL.,

Defendants.

Civil Action No. 2:23-cv-0437-JRG
(Lead Case)

EMERGING AUTOMOTIVE LLC,

Plaintiff,

v.

TOYOTA MOTOR CORP., ET AL.,

Defendants.

Civil Action No. 2:23-cv-0434-JRG
(Member Case)

DEFENDANTS' RESPONSIVE CLAIM CONSTRUCTION BRIEF

TABLE OF CONTENTS

I. INTRODUCTION 1

II. THE DISPUTED CLAIM TERMS 1

A. E-Key Patents – U.S. 10,407,026, 11,738,659, and 9,365,188..... 1

1. “electronic key” / “eKey” / “e-key” (’026 claims 1, 2, 6, 10, 13, 15, 19; ’659 claims 1, 3, 4, 6–8, 11, 13–15, 17, 18, 20–21; ’188 claims 1, 3, 7, 9-12, 16–17)..... 1

2. “the unique access code is associated with privileges for use of the vehicle, the privileges are defined for the unique access code” (’026 claims 1, 2, 7, 11, 14); “the e-key being assigned with the condition of use for the vehicle” / “the e-key being associated with the condition of use of the vehicle” (’188 claims 1, 16) 4

3. “privileges for use of the vehicle” (’026 claim 1) / “privilege settings for use of the vehicle” (’659 claim 18) / “condition of use of the vehicle” (’188 claims 1, 16)..... 5

4. “communications circuitry of the vehicle . . . programmable to communicate with the server of the cloud system and communicate with a mobile device” (’026 claim 1) / “the vehicle having wireless communication systems for communicating with the server or other servers and for communicating with devices local to the vehicle” (’188 claim 1)..... 8

5. “transmitting, by the server, the e-key to the recipient using the identifying information so that a device of the recipient is implemented to use the e-key” (’188, claim 1)..... 10

6. “a server” / “the server” / “said server” (’026 claims 1, 2, 6, 13, 15; ’659 claims 1, 3, 4, 12, 13, 20; ’188 claims 1, 11, 16, 17); (’268 claims 10, 18) 11

7. “the vehicle is configured to receive information from the server to authenticate the request by the mobile device, and if the request is authentic, and the mobile device is provided with data to enable an electronic key to use the vehicle and the electronics of the vehicle instructs the subsystem of the vehicle to enable unlocking of the vehicle and enable starting of the vehicle for use of the vehicle via the electronic key consistent with the privileges of the unique access code” (’026 claim 1)..... 14

8.	“a subsystem of the vehicle for enabling unlocking of the vehicle . . . a subsystem of the vehicle for enabling starting of the vehicle for use of the vehicle . . . the electronics of the vehicle instructs the subsystem of the vehicle to enable unlocking of the vehicle and enable starting of the vehicle” (’026 claim 1)	18
9.	“the vehicle sends data to the server during the use of the electronic key on the vehicle, the data including at least use metrics of the vehicle, the use metrics being stored by the server as history of use for the electronic key” (’026 claim 13) / “use of the vehicle using the eKey is tracked to identify and log actions taken using the vehicle while the eKey is used” (’659 claim 1) / “use data regarding use of the vehicle for when the vehicle is used via the e-key” (’188 claims 1, 16)	21
10.	“settings that should or may be made to the vehicle when using the e-key” (’188 claim 17)	22
11.	“wherein the vehicle is configured to receive or securely store information from the server to perform authentication or verification that the coded data received from the mobile device should activate the eKey” (’659 claim 3)	24
B.	User Profile Patent – U.S. 9,171,268 (’268 Patent)	25
12.	“identifying a selected vehicle for applying the user profile, the selected vehicle having a plurality of settable settings, the selected vehicle being one of a plurality of vehicles identified as available by the server” (’268 claim 10)	25
13.	“determining, by the server, applicable settings for the selected vehicle, the applicable settings being settings that are preferred to be set as identified from the user profile and are compatible with settings that are settable in the selected vehicle”(’268 claim 10) / “the user profile having user settings for the vehicle, wherein certain of the user settings are determined to be compatible for use with the vehicle” (’268 claim 20).....	28
14.	“communicating to the cloud processing system by the vehicle, changes to user settings, the cloud processing system processing the changes and other changes to the user settings to learn behavior associated with the changes to the user settings; receiving by the vehicle, from time to time, automatic changes to the user settings of the vehicle, wherein a repeat pattern of the changes is qualified as learned behavior before the automatic changes are sent to the vehicle for programming on the vehicle, wherein the user profile is configured	

to be updated to account for the automatic changes made to the user
settings of the vehicle” (*268 patent claim 20)29

III. CONCLUSION.....30

TABLE OF AUTHORITIES

	Page(s)
Federal Cases	
<i>Allen Eng’g Corp. v. Bartell Indus., Inc.</i> , 299 F.3d 1336 (Fed. Cir. 2002).....	14, 17, 19, 29
<i>Baldwin Graphic Sys., Inc. v. Siebert, Inc.</i> , 512 F.3d 1338 (Fed. Cir. 2008).....	13, 14
<i>Bd. of Regents of the Univ. of Tex. Sys. v. BENQ Am. Corp.</i> , 533 F.3d 1362 (Fed. Cir. 2008).....	23, 25, 30
<i>Chef Am., Inc. v. Lamb-Weston, Inc.</i> , 358 F.3d 1371 (Fed. Cir. 2004).....	20
<i>CUPP Computing AS v. Trend Micro Inc.</i> , 53 F.4th 1376 (Fed. Cir. 2022)	28
<i>Curtiss-Wright Flow Control Corp. v. Velan, Inc.</i> , 438 F.3d 1374 (Fed. Cir. 2006).....	5, 8
<i>Halliburton Energy Servs., Inc. v. M-I LLC</i> , 514 F.3d 1244 (Fed. Cir. 2008).....	21
<i>Image Processing Techs., LLC v. Samsung Elecs. Co.</i> , No. 2:16-cv-505, 2017 WL 2672616 (E.D. Tex. Jun. 21, 2017).....	29
<i>Interval Licensing LLC v. AOL, Inc.</i> , 766 F.3d 1364 (Fed. Cir. 2014).....	22, 23
<i>Nautilus, Inc. v. Biosig Instruments, Inc.</i> , 572 U.S. 898 (2014).....	14, 16, 19, 30
<i>Novo Indus., L.P. v. Micro Molds Corp.</i> , 350 F.3d 1348 (Fed. Cir. 2003).....	17
<i>O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co., Ltd.</i> , 521 F.3d 1351 (Fed. Cir. 2008).....	3
<i>Personalized Media Commc’ns, LLC v. Google LLC</i> , No. 2:19-cv-90-JRG, Dkt. No. 185, 2020 WL 1666462 (E.D. Tex. Apr. 3, 2020).....	29
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005).....	2, 4

Salazar v. AT&T Mobility LLC,
64 F.4th 1311 (Fed. Cir. 2023)12, 13

Salazar v. AT&T Mobility LLC,
No. 2:20-cv-4-JRG, Dkt. No. 131, 2020 WL 5608640 (E.D. Tex. Sep. 18,
2020)12

Smith v. ORBCOMM, Inc.,
No. 2:14-cv-666-JRG, 2015 WL 5302815 (E.D. Tex. Sept. 10, 2015)17

UltimatePointer, L.L.C. v. Nintendo Co., Ltd.,
816 F.3d 816 (Fed. Cir. 2016).....9, 11

In re Varma,
816 F.3d 1352 (Fed. Cir. 2016).....12

WAPP Tech Ltd. P’ship v. Bank of Am., N.A.,
No. 4:21-cv-670, 2022 WL 2463569 (E.D. Tex. July 6, 2022)21, 22

State Cases

In re Taasera Licensing LLC, Pat. Litig.,
No. 2:22-md-03042-JRG, 2023 WL 8628323 (E.D. Tex. Dec. 13, 2023)21

Regulations

37 C.F.R. § 1.114.....17

TABLE OF EXHIBITS

Exhibit	Description	Citation
Dkt. No. 132-2	U.S. Patent No. 10,407,026	'026
Dkt. No. 132-3	U.S. Patent No. 11,738,659	'659
Dkt. No. 132-4	U.S. Patent No. 9,365,188	'188
Dkt. No. 132-5	U.S. Patent No. 9,171,268	'268
A	Declaration of Matthew Shoemake, Ph.D.	Shoemake Dec.
B	Reply Declaration of Matthew Shoemake, Ph.D.	Shoemake Reply Dec.
C	Prosecution History of U.S. Patent No. 11,738,659	'659 FH
D	Prosecution History of U.S. Patent No. 10,407,026	'026 FH
E	Prosecution History of U.S. Patent No. 9,171,268	'268 FH
F	Prosecution History of U.S. Patent No. 9,365,188	'188 FH
G	Patent Owner's Preliminary Response in '026 IPR	'026 POPR
H	Patent Owner's Preliminary Response in '268 IPR	'268 POPR

I. INTRODUCTION

The Toyota and Kia Defendants hereby respond to the opening *Markman* brief submitted by Plaintiff Emerging Automotive LLC (“EA”). EA currently asserts four patents against Toyota and three against Kia. The three patents asserted against both Defendants—the ’026, ’659, and ’188 patents—relate to “electronic keys” (or “e-keys/ekeys”) for vehicles. The ’268 patent, asserted only against Toyota, relates to “user profiles” for vehicles. The Court should adopt Defendants’ proposed constructions and reject EA’s blanket proposal of “no construction necessary” (for *every* term), which fails to address, let alone resolve, the parties’ disputes.

II. THE DISPUTED CLAIM TERMS

A. E-Key Patents – U.S. 10,407,026, 11,738,659, and 9,365,188

1. “electronic key” / “eKey” / “e-key” (’026 claims 1, 2, 6, 10, 13, 15, 19; ’659 claims 1, 3, 4, 6–8, 11, 13–15, 17, 18, 20–21; ’188 claims 1, 3, 7, 9–12, 16–17)

Plaintiff’s Proposed Construction	Defendants’ Proposed Construction
No construction necessary	electronic data that can be used to operate a vehicle consistent with privileges or conditions

The e-key patents are directed to “systems and methods for generating and sharing electronic keys (e-Keys).” ’026, 1:54–57. The terms “electronic key,” “ekey,” and “e-key” correspondingly appear throughout the asserted claims.

The specification explains that an “e-key” is electronic *data* (usually encrypted) which serves the same purpose as a physical car key but can be transmitted to a user for storage on their mobile device, as shown, for instance, in Figure 31A. *See also* ’026, Figs. 32–34. An “e-key” provides a user with the same capabilities as a normal, physical car key. *See, e.g., id.*, 3:6–13, 6:31–34, 8:38–42, 8:50–54, 47:1–6, 47:16–20, 48:55–60, 49:57–61 (describing unlocking, locking, starting, and driving as vehicle functions enabled by an e-key). However, these

capabilities may be limited via defined “privileges” associated with, for example, a user to whom an “e-key” is shared. *See, e.g., id.*, 2:23–25, 43:25–26, 42:65–43:5, 43:51–58, 45:11–15, 45:43–50, 49:6–43. Thus, in the context of the e-key patents, an “e-key” is not a physical car key or a key fob,¹ nor is it merely “a key that is electronic,” as EA contends. Dkt. 132 (“EA Br.”), 4.

Consistent with the patents’ disclosure, the asserted claims recite that an e-key enables “use” of a vehicle, subject to privileges or conditions. *See, e.g.*, ’026, cl. 1 (“starting of the vehicle for use of the vehicle via the electronic key consistent with the privileges of the unique access code”); ’659, cl. 1 (“the coded data enables functions of said eKey for said unlocking and use of the vehicle . . . and the coded data includes privilege settings associated with the eKey for limiting types of use of the vehicle”); ’188, cl. 1 (“generate an electronic key (e-key) for an identified recipient to use the vehicle . . . the e-key being assigned with the condition of use of the vehicle”). Thus, the claims specify that an “e-key” is electronic data that enables use (i.e., operation) of a vehicle like a normal car key, with the further potential for this use to be restricted consistent with privileges or conditions. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (“[T]he claims themselves provide substantial guidance as to the meaning of particular claim terms.”).

While EA contends no construction is necessary, its arguments highlight its deviation from the term’s plain meaning as informed by the specification. For example, EA asserts that “electronic keys, just like non-electronic keys, *may* enable a variety of functions, none of which are required to qualify as an electronic key.” EA Br., 4–5. EA is mistaken in asserting that this is “like non-electronic keys.” While a driver may choose not to use their “non-electronic key” for *all* functions of a vehicle in a given instance (i.e., they may choose to solely unlock the door without starting

¹ The e-key patents disclose that an “e-key” could be *stored in* a key fob, *see* ’026, 4:19–21, but the key fob itself is not an “e-key.”

the engine), any ordinary key enables full use of the vehicle’s functions—e.g., unlocking and starting so the vehicle can be used. No vehicle owner would expect a key to be capable of only unlocking their vehicle but not starting and driving it. And EA offers no evidence that a vehicle owner would expect to receive a ring of keys, each capable of enabling a single function of their vehicle. Thus, EA’s interpretation is contrary to the plain and ordinary meaning of a key, and a construction is necessary to resolve this dispute. *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co., Ltd.*, 521 F.3d 1351, 1361 (Fed. Cir. 2008).

The sole disclosure that EA cites in support of its argument (’026, 4:9–13 and claim 9 of the ’188 patent) supports Defendants’ construction. For example, claim 9 of the ’188 patent recites that an e-key provides access to “at least one of” several functions. Read in the context of claim 1, which recites that the e-key is “assigned with [a] condition of use of the vehicle,” this means that the e-key’s functionality is limited due to the “condition of use” recited in claim 1. Dependent claim 9 cannot expand the meaning of “e-key” in claim 1 beyond the specification’s disclosure, such that the term encompasses something that is incapable of performing the functions of a normal key (setting aside the defined condition of use). The disclosure EA cites in column 4 of the ’026 patent, which parrots claim 9 of the ’188 patent, similarly refers to an embodiment having an “e-key” that is “associated with [a] condition of use of the vehicle.” *Id.*, 3:20–27, 4:9–13. Thus, when read in context of the surrounding claim language and specification disclosures, these descriptions support Defendants’ construction that an “e-key” provides use of the vehicle, subject to associated privileges or conditions.

EA takes issue with the reference to “privileges or conditions” in Defendants’ proposed construction, arguing that it is redundant of the surrounding claim language. EA Br., 5–6. But EA cannot dispute that the context of the surrounding claim language must be considered in

determining the meaning of “e-key,” *Phillips*, 415 F.3d at 1314, nor can EA dispute that the claimed “e-key” enables a vehicle to be used in the same ways as a normal key, subject to the separately recited privileges or conditions, consistent with Defendants’ construction.

2. **“the unique access code is associated with privileges for use of the vehicle, the privileges are defined for the unique access code” (’026 claims 1, 2, 7, 11, 14); “the e-key being assigned with the condition of use for the vehicle” / “the e-key being associated with the condition of use of the vehicle” (’188 claims 1, 16)**

Plaintiff’s Proposed Construction	Defendants’ Proposed Construction
No construction necessary	the unique access code/ekey corresponds to privileges/conditions of use of the vehicle that are defined for the unique access code/ekey

In the e-key patents, a unique access code or e-key corresponds to privileges or conditions of use of the vehicle, and these privileges or conditions of use are defined for the unique access code or e-key. The nature of those privileges or conditions of use is described further in the context of term 3. With respect to this term, the Parties’ dispute centers on what it means for a unique access code or e-key to be “associated with” or “assigned with” privileges or conditions of use. EA argues that these terms are not synonymous with “corresponds to” but offers no explanation of how these terms are different. EA Br., 7–8. Defendants’ proposal reflects the specification’s description of e-keys (and “unique codes”) as being assignable to different users to provide these users with different privileges; i.e., a particular e-key or unique code has a set of privileges or conditions of use bound to it. *See, e.g.*, ’026, 45:43–46:6, 50:34–42. Thus, Defendants’ construction properly captures the meaning of the claim terms in view of the specification. Lastly, EA’s criticism of Defendants’ proposal for construing different terms together is inconsistent with the claim drafters’ use of different terminology to define the same subject matter in these claims

(a practice that is often employed in claim drafting). *Curtiss-Wright Flow Control Corp. v. Velan, Inc.*, 438 F.3d 1374, 1380–81 (Fed. Cir. 2006).

3. **“privileges for use of the vehicle” (’026 claim 1) / “privilege settings for use of the vehicle” (’659 claim 18) / “condition of use of the vehicle” (’188 claims 1, 16)**

Plaintiff’s Proposed Construction	Defendants’ Proposed Construction
No construction necessary	permitted uses of the vehicle when using the e-key, such as what type of access, speed limits, geographic restrictions, or the amount of time the e-keys will be valid

The intrinsic record, including the claim language, the specification, and the prosecution history, confirms that privileges and conditions for “*use*” of a vehicle modify *how* the vehicle is used after it is accessed, and not merely *whether* it can be accessed. For example, claim 1 of the ’026 patent requires instructions that “enable unlocking of the vehicle and enable starting of the vehicle for use of the vehicle via the electronic key *consistent with the privileges of the unique access code.*” Thus, the privileges for use of the vehicle modify *how* the vehicle can be used, and the specification provides examples such as by the type of access, speed limit, geographic restriction, or amount of time the e-key is valid. EA’s non-construction of these terms invites the incorrect possibility that mere (unrestricted) access alone might be a privilege within the context of the e-key patents, contradicting the claim language and specification.

The e-key patents feature an e-key being associated with “privileges for use,” “privilege settings for use” or “conditions of use” of a vehicle. The specification explains that “drivers will each have different roles that define[] the type of user and associated privileges.” ’026, 36:39–40. One user could be an owner or administrator (with full privileges to use the vehicle), while “[o]ther users can be assigned as drivers, such as teenagers of the family, valet drivers, guest drivers, etc. Each of these drivers can be associated with their own user account, which provides specific

privileges (use capabilities, restrictions, limits, parameters, etc.).” *Id.*, 36:40–50 (emphasis added), 39:45–49. The “user-owner” of the vehicle can provide access to a valet with “*account privileges (e.g., what type of access, speed limits, geographic restrictions, amount of times the e-keys will be valid (or else expire)*.” *Id.*, 10:25–34 (emphasis added), 3:57–61 (“the condition of use is one of a geographic restriction for where the vehicle is allowed to be used, or a speed restriction, or an occupancy restriction, or a time frame of use, or a time expiration of use, or combinations thereof . . .”). Thus, “privileges” are tied to an e-key and define *how* a particular user is permitted to use a vehicle with the e-key.

Defendants’ construction is also supported by the prosecution history. During prosecution of the ’026 patent, EA relied on the “privileges for use” claim language to distinguish the access code of a prior art rental car system that allowed the user to access the vehicle but did not disclose “how *privileges* are defined for the unique access code” (emphasis EA’s). Ex. D (“’026 FH”), 207–09. EA recently made this same point in opposing IPR for the ’026 patent, arguing that “[t]he e-key allows use of the vehicle, and can *further include* privileges for the user, including speed limits, geographic restrictions, amount of time, etc.” Ex. G (“’026 POPR”), 3–4. EA argued that cited prior art did not disclose the claimed “privileges” because it provided “unfettered” vehicle access. *Id.*, 10. Therefore, the claimed “privileges for use” and “conditions of use” do not define whether “unfettered” access to the vehicle is permitted. Instead, they define permitted uses that restrict *how* the vehicle can be used with the e-key, such as speed restrictions, geographic limits, or the like, and not merely *whether* the vehicle can be accessed.

Defendants’ construction makes clear that “privileges for use” are permitted uses of the vehicle when using the e-key, such as what type of access, speed limits, geographic restrictions, or the amount of time the e-keys will be valid.” There can be no dispute that “privileges” modify

permitted uses of the vehicle. *See* '026, 36:46–50 (describing “privileges” as “use capabilities, restrictions, limits, parameters, etc.”). And these privileges are applicable *when using the e-key* since they are specifically associated with the e-key. *See, e.g., id.*, 45:11–15 (“The access code is then sent as activated e-keys 724 back to Bob’s device 704. Bob’s device 704 can now access the vehicle *in accordance with the privileges set by John*, the owner of the vehicle.”).

EA’s disputes with Defendants’ construction fail. First, EA argues the examples are confusing. But these examples are from the specification and illustrate how privileges modify permitted uses, rather than simply unfettered access to a vehicle. Indeed, as described above, EA itself used these same examples before the PTO: “[t]he e-key allows use of the vehicle, and can further include privileges for the user, *including speed limits, geographic restrictions, amount of time, etc.*” ’026 POPR, 3–4.

Second, EA objects to grouping “privileges” and “conditions” but identifies no distinction between them. The ’188 patent’s claim language indicates that a “condition of use” (like a “privilege for use” in the ’026 patent) is a permitted use of the vehicle that is set by the e-key requester. ’188, cl. 1 (“the request [for an e-key] includes *a condition of use* of the vehicle as set by the user via the user account”). This same concept, in slightly different words, is recited in the ’026 claims, *see* ’026, cl. 1 (“the unique access code is associated with *privileges for use* of the vehicle, the privileges are defined for the unique access code”) (emphasis added), and the ’659 claims (*see* ’659, cl. 18: “the coded data includes *privilege settings for use of the vehicle when using the eKey with the vehicle*”).² The specification also uses the terms interchangeably. *See* ’026,

² Claim 1 and claim 11 of the ’659 patent recite similar, but narrower language, e.g., “the coded data includes privilege settings associated with the eKey for limiting **types of use** of the vehicle when using the eKey with the vehicle.” ’659, 52:33–36 (emphasis added); *see also id.*, 53:38–40 (claim 11 similarly referring to “types of use”).

4:41 (“privileges or conditions of use”), 4:65–66 (“the condition of use defines one or more privileges associated to use of the e-key”), 6:60–63 (“use of the vehicle in accordance with *conditions defined in the privilege settings.*”). Claim drafters often use different terminology to define the same subject matter, *see Curtiss-Wright*, 438 F.3d at 1380–81, and EA fails to establish why they should not be construed consistently here.

Third, EA argues that “when using the ekey” in Defendants’ construction is superfluous, but the tie between the e-key and the privileges/conditions is undeniable based on the claim language and the specification disclosures referenced above. This link between privileges/conditions and e-keys is central to the disclosure and the claimed invention of the e-key patents.

4. **“communications circuitry of the vehicle . . . programmable to communicate with the server of the cloud system and communicate with a mobile device” (’026 claim 1) / “the vehicle having wireless communication systems for communicating with the server or other servers and for communicating with devices local to the vehicle” (’188 claim 1)**

Plaintiffs’ Proposed Construction	Defendants’ Proposed Construction
No construction necessary	communications circuitry in the vehicle configured to wirelessly communicate with a remote server and also wirelessly communicate with a local mobile device

The crux of the parties’ dispute is whether the communication circuitry/systems recited in ’026 claim 1 and ’188 claim 1 must communicate with *both* a remote server *and* a mobile device, or whether it is sufficient to only communicate with a server, which then separately communicates with a mobile device. The claim language, the specification, and the file history confirm Defendants’ interpretation.

First, the plain language of the claims specifies that the “communications circuitry/systems” of the vehicle communicates with a server *and* with a mobile device. Interpreting the requirement for communication with a mobile device to encompass communications through a server to a mobile device would read out the requirement that the “communications circuitry/systems” communicate with the mobile device. In other words, the claims’ recitation of “communications circuitry/systems” that distinctly communicate with a mobile device makes no sense if this encompasses communications with a server that in turn communicates with the mobile device—in that instance, the communications circuitry/system is communicating with the server, not with the mobile device. Furthermore, ’026 claim 1 requires the vehicle to receive information “from the mobile device,” e.g., “a request from the mobile device for unlocking of the vehicle,” that it authenticates with information received specifically “from the server,” e.g., “information from the server to authenticate the request by the mobile device.” *See* ’026, 52:8–10, 52:17–19. Again, this supports the requirement for two separate communications paths—one between the vehicle’s communications circuitry and the server, and another between that communications circuitry and the mobile device.

Although “communications circuitry” appears only in the claims, the specification confirms Defendants’ interpretation. In every disclosed embodiment regarding the claimed e-keys, the vehicle communicates with a local mobile device to receive requests and *separately* communicates with a remote server to authenticate those requests. *See, e.g.*, ’026, Figs. 28, 29, 30A–B, 32, 33 (all showing transfer of e-key to vehicle by a mobile device). An e-key is never disclosed as being used by a mobile device via a request sent from the mobile device to the vehicle through a server. *UltimatePointer, L.L.C. v. Nintendo Co., Ltd.*, 816 F.3d 816, 823–24 (Fed. Cir. 2016) (rejecting “ordinary meaning” construction not supported by the specification).

EA attempts to pick off words in Defendants’ construction as an allegedly improper “rewrite” and otherwise conjures absurd hypotheticals not at issue. But EA fails to identify any described embodiment (1) where communication with a mobile device is not wireless or not local, or (2) where communication with a server is not remote. EA criticizes Defendants’ construction for doing what any sensible construction must do, namely provide a helpful explanation to the jury of the terms’ meaning in the context of the specification. Accordingly, Defendants’ proposed construction should be adopted.

5. “transmitting, by the server, the e-key to the recipient using the identifying information so that a device of the recipient is implemented to use the e-key” (’188, claim 1)

Plaintiffs’ Proposed Construction	Defendants’ Proposed Construction
No construction necessary	transmitting, by the server, the ekey to a device of the recipient so that the device is able to locally communicate the ekey to the vehicle

This phrase captures the same notion as the “communications circuitry” limitation discussed above. Defendants’ proposed construction confirms that a device that receives an e-key from a server is “implemented to use” that e-key by being able to locally transmit the e-key to the vehicle, via the vehicle’s “wireless communication systems for . . . communicating with devices local to the vehicle.” In other words, the device that receives the e-key from the server is local to the vehicle when the e-key is used.

As shown in Figures 30A and 30B, the recipient’s (“guest’s”) device receives an e-key from the server and communicates the e-key to the vehicle via local communication like WiFi or Bluetooth. *See, e.g.*, ’188, 41:33–40, 42:24–33, 42:57–62, 43:6–10, Figs. 32, 33. The patents also discuss the advantages of direct communication between the recipient’s device and the vehicle—e.g., when the recipient’s device transfers the “encrypted e-keys” to the vehicle, it also transfers

its “device ID,” such that future accesses using the e-keys can be verified as coming from the *same device*. *Id.*, 44:49–45:4. Thus, the recipient’s device is “implemented to use the e-key” via the claimed local communications path, consistent with Defendants’ construction. *See UltimatePointer*, 816 F.3d at 823–24.

EA argues Defendants’ construction “excludes embodiments of the specification where the recipient’s device (e.g., a mobile phone) uses the e-key via a server using wireless communications.” EA Br., 12–13. But EA cites descriptions of embodiments that *do not even mention* the word “key,” let alone describe the use of an e-key. *Id.* (citing ’188, 12:16–20, 13:66–14:2, 15:50–52, 20:43–48, 21:53–62, 22:63–66, 27:59–64, 30:52–67, 33:62–34:8, Figs. 11, 15, 17). The only disclosures EA cites relating to use of an e-key are Figure 28, 40:34–63, and 41:33–47, which EA incorrectly describes as showing that a valet can “use” an e-key by communicating with “Cloud Services.” EA Br., 12. Instead, the specification states only that the valet can *receive* the e-key via cloud services 120, consistent with Defendants’ construction. ’188, 44:9–12. In other words, these cloud services supply the e-key to the valet’s device in the first instance, while Figure 28 shows that the valet’s use of the e-key with the vehicle *would be via direct communication* with “CAR A.” *Id.*, 40:37–45, Fig. 28. The valet’s device is “implemented to use the e-key” when it receives the e-key from the server. EA’s reliance on column 41 fares no better, because that discussion merely states that the guest’s device and the vehicle could use different forms of wireless communications; it does not state that the recipient’s device could use the e-key by sending it to the vehicle through a server. *Id.*, 41:37–47.

6. “a server” / “the server” / “said server” (’026 claims 1, 2, 6, 13, 15; ’659 claims 1, 3, 4, 12, 13, 20; ’188 claims 1, 11, 16, 17); (’268 claims 10, 18)

Plaintiffs’ Proposed Construction	Defendants’ Proposed Construction
--	--

No construction necessary	a networked computer (the/said refers to the same networked computer)
---------------------------	---

The crux of the parties’ dispute is whether a claim limitation reciting “a server” and later “the server” must refer to the *same* server, or whether it can be met by a different server. While “a server” means one or more servers, there must be at least one server of the one or more servers that performs each of the server functions recited in the claims.

Defendants’ proposed construction for “the/said server,” requiring that there be at least one server that performs all the recited functions, mirrors the Court’s construction of “said microprocessor” in *Salazar v. AT&T Mobility LLC*, No. 2:20-cv-4-JRG, Dkt. No. 131, 2020 WL 5608640, at *18–19 (E.D. Tex. Sep. 18, 2020), *aff’d*, 64 F.4th 1311 (Fed. Cir. 2023). In *Salazar*, the Federal Circuit held that this Court “properly interpreted ‘a microprocessor for generating . . . , said microprocessor creating . . . , a plurality of parameter sets retrieved by said microprocessor . . . , said microprocessor generating . . . ’ to mean ‘one or more microprocessors, **at least one of which** is configured to perform the generating, creating, retrieving, and generating functions.’” 64 F.4th at 1317 (emphasis added). That is, the “said microprocessor” required by the claims must be the same “a microprocessor” introduced earlier in the claim. *Id.* at 1316; *see also In re Varma*, 816 F.3d 1352, 1362–63 (Fed. Cir. 2016). The same reasoning applies here.

Here, beginning with claim 10 of the ’268 patent,³ the claim recites “a server” that receives information for a user profile, and then “the server” identifies a vehicle for applying the user profile, “the server” determines settings, and “the server” sends settings for programming to the vehicle. ’268, 33:1–26. As a result, “it does not suffice to have multiple [servers], each able to perform just one of the recited functions; the claim language requires at least one [server] capable

³ The ’268 patent is not an “E-Key Patent,” but it claims “server” terms and so is briefed here together with the E-Key Patents.

of performing each of the recited functions.” *Salazar*, 64 F.4th at 1318. The claim language requires the *same* server perform the receiving, identifying, determining, and sending functions.

Claim 1 of the ’188 patent similarly recites “a server” that receives a request, then “the server” generates the e-key, “the server” transmits the e-key to the recipient, “the server” transmits data to the vehicle, “the server” receives use data, and “the server” processes logic to generate the e-key and analyze vehicle use. ’188, 49:29–57. Dependent claims 11, 16, and 17 recite further functions performed by “the server,” which must also be the same server. *Id.*, cls. 11, 16–17.

Similarly, claim 1 of the ’026 patent requires “a server of a cloud system” where the vehicle communicates with “the server[,]” the mobile device obtains a unique access code from “the server[,]” and the vehicle receives “information from the server to authenticate the request[.]” ’026, 51:61–52:25. Dependent claims 2, 6, 13, and 15 specify further functions of “the/said server.” Again, the server must be the same server providing the claimed functions. *See also* ’659, cl. 1 (reciting communication with “a server”); cls. 3–4 (dependent claims specifying the vehicle is “configured to receive or securely store information from the server” and “coded data [is] generated by the server”).

In drafting these claims, EA consistently chose to claim “a server” performing multiple functions. EA’s *post-hoc* attempt to rebrand “a server” as a “broad concept” including any number of systems providing services to other systems is an improper attempt to broaden the claims by ignoring how EA itself chose to draft them, i.e., “a server” doing X, followed by “the/said server” doing Y, “the/said server” doing Z, and so forth. The same server must do X, Y, and Z because that is how EA drafted its claims.⁴

⁴ To be clear, Defendants’ proposed construction does not limit the claims to a single server or a single networked computer, and Defendants do not dispute the general rule of *Baldwin Graphic*

7. **“the vehicle is configured to receive information from the server to authenticate the request by the mobile device, and if the request is authentic, and the mobile device is provided with data to enable an electronic key to use the vehicle and the electronics of the vehicle instructs the subsystem of the vehicle to enable unlocking of the vehicle and enable starting of the vehicle for use of the vehicle via the electronic key consistent with the privileges of the unique access code” (’026 claim 1)**

Plaintiffs’ Proposed Construction	Defendants’ Proposed Construction
No construction necessary	Indefinite

Claim 1 of the ’026 patent fails to “inform those skilled in the art about the scope of the invention with reasonable certainty.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910 (2014); *see also* Ex. A, (“Shoemake Dec.”), ¶¶ 58–72; Ex. B, (“Shoemake Reply Dec.”), ¶¶ 17--27. Specifically, the claim contains a conditional “if” clause that is never closed, instead reciting multiple conditions with no corresponding “then” clause, either explicit or implicit. As drafted, the claim element is incomplete, and this Court should find it indefinite. *See Allen Eng’g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1348–49 (Fed. Cir. 2002) (finding indefinite a truncated claim that “ends in the middle of a limitation”).

There are multiple possible ways to rewrite the claim language to make it coherent, each requiring ignoring an instance of the word “and” to create the missing “then” clause. However, the scope of the claim changes depending on how the claim language is rewritten (i.e., which “and” is removed from the relevant element). *See* Shoemake Dec., ¶¶ 60–67. After the preliminary “if the request is authentic,” clause, there are three subsequent “and” clauses, any of which could be the corresponding “then” clause for the claim element. For example, the phrase “and the mobile device

Sys., Inc. v. Siebert, Inc., that “a” means “one or more.” 512 F.3d 1338 (Fed. Cir. 2008). Defendants’ construction is instead directed to the requirement that, regardless of the number of servers that may exist in a cloud processing or other system, the same server must perform each of the functions recited in the claims as being performed by “a server” and then “the/said server.”

is provided with data to enable an electronic key to use the vehicle” could be a part of the conditional “if” *or* a part of the resultant “then.” *Id.*, ¶¶ 60–62. If this phrase is part of the conditional language, the “if” clause (the condition) is narrower—i.e., there are more requirements to the condition—than if it is part of the resultant “then” clause. *Id.*, ¶ 63.

Each alternative finds support in the specification. For example, the Abstract and column 2 of the ’026 patent state that the vehicle receives information from the server to authenticate the request by the mobile device, and “if the request is authentic, the mobile device is provided with data to enable an electronic key to use the vehicle, and the electronics of the vehicle instructs the subsystem of the vehicle to enable unlocking of the vehicle and enable starting of the vehicle for use of the vehicle via the electronic key consistent with the privileges of the unique access code.” ’026, Abstract, 2:43–52. This would be consistent with a first way to render the claim coherent, which requires ignoring the first “and” in the disputed phrase. Shoemake Dec., ¶ 64.

But the specification contains other disclosures that are more consistent with the second (or third) interpretations, and that require ignoring the second (or third) “and” in the disputed phrase. *Id.*, ¶¶ 65–67. For example, in describing Figures 31A–33, the specification states that Bob receives “encrypted ekeys” to a vehicle owned by John. ’026, 44:35–43. Bob transfers the encrypted e-keys to the vehicle, which decrypts the ekeys to get an “access code” that will “enable the e-keys to be activated e-keys.” *Id.*, 44:49–58, 45:6–10. The vehicle sends the “activated e-keys” back to Bob’s device, after which Bob’s device can “access the vehicle in accordance with the privileges set by John.” *Id.*, 45:11–21. In this scenario, Bob’s mobile device being “provided with data to enable an electronic key to use the vehicle” (as recited in claim 1) would be part of the condition that enables unlocking, starting, etc., via the electronic key, which is more consistent

with the second (or third) alternative interpretations of claim 1. Shoemake Dec., ¶¶ 65–67 (further identifying 8:49–54 as consistent with the second or third alternatives).

These three alternatives, each of which is equally plausible and supported by the specification, preclude a person of ordinary skill from obtaining reasonable certainty concerning the scope and meaning of the claim, rendering it indefinite. *See Nautilus*, 572 U.S. at 911, n. 8. (a term is indefinite when it “might mean several different things and no informed and confident choice is available among the contending definitions.”).

EA was aware of the flaw in this claim language during prosecution of the '026 patent. Several weeks after the Examiner issued a Notice of Allowance, EA filed an amendment asking the Examiner to delete the “and” that appears before “the mobile device is provided with data.” *See* '026 FH, 244–51. EA sought to justify its proposed change as “address[ing] antecedent basis issues and correct[ing] minor grammar typos.” *Id.*, 251. But the Examiner *rejected* EA’s amendment, noting that it “broadens the scope by removing a limitation from an if-clause through deletion of the ‘and.’ Further consideration would be required in light of the broader claim scope.” *Id.*, 254. EA never responded to the Examiner’s statement, opting instead to leave the term as written.

EA now seeks to have this Court rewrite claim 1 through claim construction in the same way the Examiner *rejected* during prosecution. Specifically, EA suggests claim 1 be interpreted to mean “if a request is deemed authentic, ‘a mobile device is provided with data to enable an electronic key . . . ,’” EA Br., 17, thereby re-writing the claim to ignore the *first* “and”—i.e., EA’s interpretation is the proposed claim amendment that was rejected during prosecution. But ignoring this “and” would be improper because it changes the scope of the examined claim. If EA wanted to fix this limitation, it should have done so through the Patent Office via continued prosecution,

thereby giving the Examiner a chance to further consider the broadened claim scope. EA chose not to do so, and “[i]t is not [the Court’s] function to rewrite claims to preserve their validity.” *Allen*, 299 F.3d at 1349.

Although the Court is empowered to correct clear typographical errors in claims, it may do so only if (1) the correction is not subject to reasonable debate based on consideration of the claim language and the specification, and (2) the prosecution history does not suggest a different interpretation of the claims. *Novo Indus., L.P. v. Micro Molds Corp.*, 350 F.3d 1348, 1357 (Fed. Cir. 2003). This Court has previously noted that the “no reasonable debate” standard is “difficult to overcome.” *Smith v. ORBCOMM, Inc.*, No. 2:14-cv-666-JRG, 2015 WL 5302815, *12–13 (E.D. Tex. Sept. 10, 2015) (finding claims indefinite and rejecting request for correction).

Here, the correction is subject to reasonable debate. As noted above, a skilled artisan could choose several plausible modifications to “fix” the claim, each resulting in different claim scope. *See Shoemake Dec.*, ¶¶ 60–67. In other words, even if a skilled artisan understood there to be a typographical error, there would be a reasonable debate as to how the error should be corrected. And the prosecution history suggests that EA’s interpretation is incorrect. Its decision to allow the claims to issue rather than correct the claim during prosecution—e.g., by filing a request for continued examination under 37 C.F.R. § 1.114—confirms that its proposal to ignore the first “and” is *not* appropriate, particularly where the Examiner explained that this would *broaden* the claim scope beyond what was deemed allowable. Thus, as in *Smith*, EA’s refusal to address this issue before the Patent Office shows that the correction is subject to reasonable debate (and counter to the prosecution history), and therefore inappropriate. *Smith*, 2015 WL 5302815, *13.

EA also argues the “and” “would have been understood to signal an additional limitation” and contends that this is “common in patent claim drafting.” EA Br., 18. But EA offers nothing to

establish that claim 1’s usage of *multiple* successive “and” terms is “common in patent drafting,” and EA does not identify any other example in which the term “and” was used to identify the result of a conditional “if” clause (let alone do so with multiple successive “and” terms). Nor is it common in the English language, as confirmed by EA’s misleading analogy to “If it rains, you will get wet.” As explained by Dr. Shoemake, a more accurate analogy would be: “If it rains, *and* you get wet *and* you take a taxi home.” Like claim 1, this makes no sense. Shoemake Reply Dec., ¶¶ 21–22. In this analogy, it is not clear whether you take a taxi only if it rains *and* you get wet, or whether you necessarily *always* get wet and take a taxi if it rains (or whether some unnamed action may occur if it rains, you get wet and take a taxi). EA’s reliance on the comma, EA Br., 17, is also misplaced. There are multiple ways that a comma can be used, including before the conjunction “and” to join clauses. Here, that indicates the language following “, and” is part of the conditional clause, not part of the result as EA contends.

Because this claim limitation is nonsensical as written—as acknowledged by EA’s own unsuccessful attempt to fix it after allowance—and because there are multiple possible ways to fix the error, each with a different scope, the court should find this limitation indefinite.

8. **“a subsystem of the vehicle for enabling unlocking of the vehicle . . . a subsystem of the vehicle for enabling starting of the vehicle for use of the vehicle . . . the electronics of the vehicle instructs the subsystem of the vehicle to enable unlocking of the vehicle and enable starting of the vehicle” (’026 claim 1)**

Plaintiffs’ Proposed Construction	Defendants’ Proposed Construction
No construction necessary	Indefinite

Claim 1 of the ’026 patent recites two different subsystems of a vehicle: “*a subsystem . . . for enabling unlocking of the vehicle,*” and “*a subsystem . . . for enabling starting of the vehicle.*” The claim further recites that the “electronics of the vehicle instructs *the*

subsystem of the vehicle to enable unlocking of the vehicle and enable starting of the vehicle.” While this clause references “the subsystem” to claim antecedent basis to one of the prior recited “a subsystem[s],” the claim language does not identify *which* of the two “a subsystem[s]” provides antecedent basis to “the subsystem.” As a result, it is not clear which of the “a subsystem[s]” must be instructed to “enable unlocking of the vehicle and enable starting of the vehicle” (or that there is any singular “subsystem” that can perform both functions). Shoemake Dec., ¶¶ 73–80. Because a person of ordinary skill could not be reasonably certain about which subsystem provides antecedent basis for “the subsystem,” this term is indefinite. *Nautilus*, 572 U.S. at 910.

The claim is indefinite as written, and it is not the province of this Court to rescue it. *Allen*, 299 F.3d at 1349. A correction of the claim would be subject to reasonable debate because nothing in the intrinsic record indicates which subsystem receives instructions to enable both “unlocking” and “starting” of the vehicle. *See* Shoemake Dec., ¶¶ 74–80. For example, the specification refers to an “interface” between an unlocking subsystem and a starting subsystem but contains no teaching of such an “interface” being used to communicate instructions from one subsystem to the other to enable unlocking and starting of the vehicle. *See* Shoemake Dec., ¶¶ 75–76 (citing ’026, Abstract, 2:28–33, 2:48–50). And claim 1 contains no reference to an “interface” between the separately recited “a subsystem[s].” Thus, even if the Court *were* to try to correct the claim—e.g., to clarify which subsystem receives instructions from the electronics of the vehicle to enable unlocking and starting, or that both of the subsystems receive those instructions—there are multiple corrective interpretations and the specification provides no guidance regarding which is correct. Shoemake Dec., ¶ 76.

EA’s attempt to rewrite claim 1 is nonsensical. EA suggests it be interpreted such that the “electronic key” is enabled to do two separate things: (1) “use the vehicle and the electronics of

the vehicle instructs the subsystem of the vehicle to enable unlocking of the vehicle”; and (2) “enable starting of the vehicle for use of the vehicle.” EA Br., 19–20. This is contrary to how a person of ordinary skill would read claim 1. Shoemake Reply Dec., ¶¶ 29–32. Claim 1 first recites the purpose for providing data to the mobile device (“the mobile device is provided with data to enable an electronic key to use the vehicle”), and then recites functions of “the electronics of the vehicle” (it “instructs the subsystem of the vehicle to enable unlocking of the vehicle and enable starting of the vehicle for use of the vehicle via the electronic key consistent with the privileges of the unique access code”). *Id.*, ¶¶ 30–32. This reading is consistent with the description of the two recited “subsystems” in the specification. *Id.*, ¶ 36; ’026, 2:48–50. EA cannot now redraft the claim to avoid indefiniteness. *Chef Am., Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1374 (Fed. Cir. 2004).

EA’s arguments in support of its interpretation are meritless. First, EA ignores the claim’s explicit requirement for the electronics of the vehicle to instruct “the subsystem” to **both** “enable unlocking of the vehicle **and** enable starting of the vehicle,” by asserting that claim 1 does not require instructions to the subsystem for enabling starting. EA Br., 20–21. Second, EA only further confuses the issue by asserting that the word “use” is recited in claim 1 in two different ways, one relating to unlocking and one relating to starting. *Id.*, 21. The first instance of “use” is not specific to unlocking—it relates to the purpose for the mobile device being provided with data (“to enable an electronic key to use the vehicle”). But even if this “use” did relate specifically to unlocking as EA contends, it would have no impact on claim 1’s explicit requirement for the electronics to instruct “the subsystem” to “enable unlocking of the vehicle **and enable starting of the vehicle.**” Lastly, EA asserts that the specification discloses the same electronic key may be used to both enable unlocking and starting. *Id.*, 21–22. Again, while it is true that the patent describes electronic keys must be capable of enabling a variety of functions (including unlocking, starting, and driving

a vehicle), that has no impact on the lack of antecedent basis for “the subsystem.” Shoemake Reply Dec., ¶ 37.

A claim term is invalid for indefiniteness where it “does not have proper antecedent basis where such basis is not otherwise present by implication or the meaning is not reasonably ascertainable.” *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1254 (Fed. Cir. 2008). Because “the subsystem” has two different potential antecedent bases, with no guidance between them in the intrinsic record, it is indefinite. *Id.*; see also *In re Taasera Licensing LLC, Pat. Litig.*, No. 2:22-md-03042-JRG, 2023 WL 8628323, *13–14 (E.D. Tex. Dec. 13, 2023) (claim indefinite due to lack of antecedent basis); *WAPP Tech Ltd. P’ship v. Bank of Am., N.A.*, No. 4:21-cv-670, 2022 WL 2463569, *18–20 (E.D. Tex. July 6, 2022) (same).

9. **“the vehicle sends data to the server during the use of the electronic key on the vehicle, the data including at least use metrics of the vehicle, the use metrics being stored by the server as history of use for the electronic key” (’026 claim 13) / “use of the vehicle using the eKey is tracked to identify and log actions taken using the vehicle while the eKey is used” (’659 claim 1) / “use data regarding use of the vehicle for when the vehicle is used via the e-key” (’188 claims 1, 16)**

Plaintiffs’ Proposed Construction	Defendants’ Proposed Construction
No construction necessary	tracking vehicle use metrics to determine whether the vehicle is used consistent with the privileges/conditions of the electronic key

The claims require “use metrics” and/or “vehicle tracking” to be stored “as a history of use for the electronic key” (’026), tracking while the vehicle is “using the eKey” (’659), or storing use data “for when the vehicle is used via the e-key” (’188). The ’026 and ’659 claims require that “use” of the vehicle via the electronic key must be “consistent with [] privileges,” ’026 cl. 1, and subject to “privilege settings associated with the ekey,” respectively. ’659, cl. 1. The ’188 claims further recite that use data “identifies a violation of the condition of use.” ’188, cls. 1, 16. Thus,

despite slight variations in claim language, each of the phrases is linked to *use* of the e-key (which has associated privileges/conditions of use) and tracking of use data to determine whether use is consistent with those privileges or conditions. Defendants’ construction tracks these requirements.

Defendants’ construction is also grounded in the specification, which describes that “the user’s use metrics can be monitored” and provides as examples “use of APPS, use be [sic] of system components of the vehicle, use of the vehicle, environment conditions, and historical actions taken by the user via the input/output controls of the vehicle . . .” *Id.*, 11:14–18, Fig. 5. In relation to use of a vehicle via an e-key, the specification states that the vehicle can report data “associated with the condition that caused the e-keys to be violated,” and “[r]eporting data and history of use can also be logged separately for each e-key,” while noting that “the e-keys can be assigned for particular privileges.” *Id.*, 47:60–63, 48:1–3. Thus, Defendants’ proposal properly captures the meaning of these terms in light of the intrinsic record.

10. “settings that should or may be made to the vehicle when using the e-key” (’188 claim 17)

Plaintiffs’ Proposed Construction	Defendants’ Proposed Construction
No construction necessary	Indefinite

Claim 17 of the ’188 patent claims changes to settings in permissive, optional language—“settings that *should or may be made* to the vehicle[.]” But whether a setting “should or may be made to the vehicle” is “highly subjective and, on its face, provides little guidance to one of skill in the art.” *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1371 (Fed. Cir. 2014). Accordingly, this term should be found indefinite. Though the ’188 patent discloses settings that *can* be changed, it does not provide any “objective indication” for what renders a setting that “should or may be made” to the vehicle. *Id.*

The specification refers to “recommendations” in the context of vehicle settings. *See, e.g.*, ’188, 3:25–31 (“recommendations . . . for settings that should or may be made to the vehicle when using the e-key.”), 6:53–57. But nothing in the ’188 patent explains what criteria to use when determining whether any given setting *should* or *may* be made to the vehicle. *See* Shoemake Dec., ¶¶ 83–84. Without guidance, the determination of whether a setting should or should not be made is left to the subjective opinion of whomever reads the claim—and the term is therefore indefinite.⁵ *See id.*, ¶ 82; *Interval Licensing*, 766 F.3d at 1371. EA contends that the specification provides examples of settings that “may or should be made” to the vehicle, EA Br., 23–24, but none of the cited descriptions support this assertion. Instead, they merely mimic the claim language, are inconsistent with the claim by describing “automatically implemented” settings (not “recommended” settings), ’188, 3:25–4:8, or are wholly unrelated to use of an e-key or providing recommendations as recited in claim 17, ’188, 13:8–21, 13:60–66, 18:45–59, 28:14–32, 27:59-30:44, Figs. 15–16D, 16A–16D; Shoemake Reply Dec., ¶¶ 39–41.

Additionally, “should” and “may” have different meanings—a setting that “should” be made implies a preference for it to actually be set, but a setting that “may” be made is merely permissive; children “should” eat their vegetables but “may” eat desert—yet the ’188 patent fails to define what that difference is in the context of this limitation. *See Bd. of Regents of the Univ. of Tex. Sys. v. BENQ Am. Corp.*, 533 F.3d 1362, 1371 (Fed. Cir. 2008) (“Different claim terms are presumed to have different meanings.”). The specification does not provide any “threshold or condition at which a setting that ‘may be made to the vehicle’ transitions to a setting that ‘should

⁵ The specification separately references “recommendations” for “settings to users’ profiles,” stating that settings can be “recommended to the user or can be automatically added to the profile.” ’188, 28:58–61. But this disclosure does not reference settings made to a vehicle “when using the e-key” as claim 17 requires. Shoemake Dec., ¶ 84.

[] be made to the vehicle.” Nor does it explain whether a setting that “may be made to the vehicle” encompasses all settings of the vehicle or if it is narrower than all settings. *See* Shoemake Dec., ¶ 82. A skilled artisan would not understand the scope of this term with reasonable certainty, and the Court should find it indefinite.

11. “wherein the vehicle is configured to receive or securely store information from the server to perform authentication or verification that the coded data received from the mobile device should activate the eKey” (’659 claim 3)

Plaintiffs’ Proposed Construction	Defendants’ Proposed Construction
No construction necessary	Indefinite

There are multiple plausible interpretations of the phrase “perform authentication or verification that the coded data received from the mobile device should activate the eKey” because neither the claim language nor the specification make clear whether the “or” in “authentication or verification” is fully disjunctive. In other words, a person of ordinary skill in the art would not have reasonable certainty whether the claim requires:

- (1) “(authentication [e.g., via user login]) or (verification that the coded data received from the mobile device should activate the eKey)” or
- (2) “(authentication or verification) (that the coded data received from the mobile device should activate the eKey).” ’659, cl. 3

(colored annotations added to distinguish plausible interpretations); *see* Shoemake Dec., ¶ 87.

These two interpretations have differing scope, and both are supported by the intrinsic record. A skilled artisan would understand that “authentication,” by itself, could verify that a person is who they purport to be (option 1), or that a message is what it purports to be (option 2). Shoemake Dec., ¶¶ 88-90. The specification provides an example of user authentication in relation to Figure 1, ’659, 19:23–34 (describing an “authentication” process for user login), which is

consistent with the first interpretation of claim 3 described above. But the specification also supports the second interpretation (“authentication . . . that the coded data received from the mobile device should activate the eKey”), in describing that “the vehicle is configured to receive information from the server to authenticate the request by the mobile device.” *Id.*, Abstract, 2:55–58; Shoemake Dec., ¶ 89. Thus, a POSITA could also interpret “authentication” to refer to the context of message authentication, such as when a request from a mobile device to use an electronic key is sent to a vehicle. Shoemake Dec., ¶ 90.

EA’s assertion that the first interpretation described above “makes no sense grammatically,” EA Br., 25, is incorrect. Both the first and second interpretations are grammatically correct, and the ’659 patent provides a specific example of log-in type user authentication. *See* Shoemake Reply Dec., ¶¶ 45–46; ’659, 19:23–34. A person of ordinary skill in the art would not ignore this disclosure of “authentication” in interpreting claim 3. EA’s reliance on the prosecution history, *see* EA Br., 25, is similarly misplaced. Before the claim language was changed in the preliminary amendment referenced by EA, it recited authentication “to activate the eKey.” Ex. C (“’659 FH”) at 136 (original claim 4 became issued claim 3). EA’s amendment injected ambiguity and could be interpreted in multiple ways, each of which is supported by the specification, and the pre-amendment claim language does not provide reasonable certainty regarding which interpretation of the *amended* claim language is correct.

B. User Profile Patent – U.S. 9,171,268 (’268 Patent)

- 12. “identifying a selected vehicle for applying the user profile, the selected vehicle having a plurality of settable settings, the**

selected vehicle being one of a plurality of vehicles identified as available by the server” (’268 claim 10)

Plaintiff’s Proposed Construction	Toyota’s Proposed Construction
No construction necessary	The server identifies two or more vehicles that are available to the user and identifies one of them as a selected vehicle for applying the user profile, the selected vehicle having two or more settable settings

Toyota’s proposed construction clarifies the language of the claim, which by its terms requires identifying the selected vehicle as one among “a plurality of vehicles” that are “identified as available” by the server. The language of claim 10 requires a “plurality” (i.e., two or more) vehicles be identified as available for possibly applying the user profile, where the selected vehicle is one of that plurality. The intrinsic record supports Toyota’s proposed construction. The ’268 patent is entitled “Methods and Systems for Setting and Transferring User Profile to Vehicles and Temporary Sharing of User Profiles to *Shared-Use* Vehicles” (emphasis added). The concept of “shared-use” vehicles in a network pervades the ’268 patent, from its opening sentence (“providing access to a shared vehicle of a shared vehicle network”) to its claims (“[a] method for locating and providing access to a shared vehicle of a shared vehicle network”). ’268, Abstract; cl. 1 (not asserted); cl. 10 (“one of a plurality of vehicles identified as available by the server”).

In explaining its “context,” the ’268 patent describes the ubiquity of vehicles and “recent” technological advancements to allow better wireless interfacing and networking with such vehicles. *Id.*, 1:38–49. The patent purports to be broadly applicable to shared vehicles of a “car sharing system,” *id.*, 3:38–48, and systems in which many vehicles are scattered “at different locations throughout an urban city,” *id.*, 16:40–42. The specification explains, “[u]sers wishing to find a vehicle to use can access an application or website . . . to find the vehicle closest to the particular user.” *Id.*, 16:34–45. With reference to Fig. 9A, the specification describes a process

including an operation 362 where servers 350 “forward *a list of available vehicles* proximate to the *user* or for a *user* identified area.” *Id.*, 18:20–24 (emphasis added).

During prosecution, EA narrowed to avoid prior art by adding and emphasizing the feature of the server identifying a vehicle selected from a plurality of available ones. EA amended claim 10 to recite “identifying a selected vehicle for applying the user profile, the selected vehicle having a plurality of settable settings, the selected vehicle being one of a plurality of vehicles identified as available by the server.” Ex. E (“268 FH”), 197. EA had initially argued there was no teaching in Hendrix (US 2012/0330494) regarding configuring “user preferences of the vehicle” that the user selected. *Id.*, 159. The Examiner disagreed, finding that the claims were broad enough that the claimed “user profile” “could indicate to one of the many preferences of a vehicle” *Id.*, 172. EA then amended the claims, seeking to highlight that its claimed server, apparently in contrast to Hendrix, identifies multiple vehicles to which the user *could* apply the user profile so that settings “can be transferred for programming on the vehicle.” *Id.*, 203. EA lumped together its description of features in arguing against the rejections of amended claims 1, 10, and 20. *Id.*, 204. Ultimately, the Examiner referenced these features together in his reasons for allowance. *Id.*, 214 (citing, among others, the feature of “**providing an option of vehicles within a range of a location identified by the request**” of the user). Toyota’s construction captures EA’s differentiation.

EA asserts that Toyota’s construction improperly imports the limitation “to the user,” but this is how the applicant and Examiner understood the claims. (*See id.*) EA again emphasized this prosecution history in its POPR, arguing that the claims have “specific elements requiring a server” Ex. H (“268 POPR”), 24–33. EA argued that “Applicant further clarified the vehicle settings that ‘are identified in the user preferences of the user profile’ (claim 10[b] amendments)” to support its allegation that the claim specifies “the way in which the user profile is used to enable

transfer of certain vehicle settings to the vehicle.” *Id.*, 25. EA has repeatedly touted the role of the server performing allegedly specific functions to overcome art in prosecution. Dkt. 103, ¶¶ 53–57. This context provided by EA clarifies what EA itself considered to be the invention, i.e., a server performing specific functions, covering scenarios where users can access multiple vehicles that are identified as available for applying the user’s profile.

13. **“determining, by the server, applicable settings for the selected vehicle, the applicable settings being settings that are preferred to be set as identified from the user profile and are compatible with settings that are settable in the selected vehicle” (’268 claim 10) / “the user profile having user settings for the vehicle, wherein certain of the user settings are determined to be compatible for use with the vehicle” (’268 claim 20)**

Plaintiff’s Proposed Construction	Toyota’s Proposed Construction
The parties agree these limitations require a “compatibility check” where the server / cloud based system determines whether settings are compatible with the vehicle. Otherwise, no construction necessary	the server / cloud based system determines applicable settings by performing a compatibility check to determine which settings that are preferred to be set as identified from the user profile are able to be set in the selected vehicle

In the ’268 patent IPR, EA asserted that claim 10 requires *the server* to “determin[e] compatibility between settings in the user profile against settings available on the specific vehicle,” ’268 POPR, 2–3, 30. EA’s statements in the IPR are binding against it in the district court. *CUPP Computing AS v. Trend Micro Inc.*, 53 F.4th 1376, 1383 (Fed. Cir. 2022). To resolve the issues in dispute here, Toyota agrees that the server / cloud based system performs the compatibility check. Toyota further contends that the compatibility check must determine which settings that are preferred to be set as identified from the user profile are able to be set in the selected vehicle. EA appears to agree with this proposition also. *Id.*

To be clear, claim 10 does not recite *the server* actively determining that the applicable settings are “compatible.” Toyota does not agree that the plain and ordinary language of claim 10

requires *the server* to perform a compatibility check, but for simplicity in this litigation only, Toyota believes the parties should be able to agree on constructions for term 13.

14. “communicating to the cloud processing system by the vehicle, changes to user settings, the cloud processing system processing the changes and other changes to the user settings to learn behavior associated with the changes to the user settings; receiving by the vehicle, from time to time, automatic changes to the user settings of the vehicle, wherein a repeat pattern of the changes is qualified as learned behavior before the automatic changes are sent to the vehicle for programming on the vehicle, wherein the user profile is configured to be updated to account for the automatic changes made to the user settings of the vehicle” (’268 patent claim 20)

Plaintiffs’ Proposed Construction	Toyota’s Proposed Construction
No construction necessary	Indefinite

Claim 20 recites that the cloud processing system “learn[s] behavior associated with the changes to the user settings,” and that “a repeat pattern of the changes is qualified as learned behavior.”⁶ But the claim includes multiple types of “changes,” and the antecedent basis for the later-recited “the changes” (highlighted in red and pink) is unclear. ’268, 34:52–64 (emphasis added). This renders the claim indefinite. *See Personalized Media Commc’ns, LLC v. Google LLC*, No. 2:19-cv-90-JRG, Dkt. No. 185 at 37, 2020 WL 1666462, at *18 (E.D. Tex. Apr. 3, 2020).

A party cannot “rewrite claims to preserve their validity.” *Allen*, 299 F.3d at 1349 (Fed. Cir. 2002); *Image Processing Techs., LLC v. Samsung Elecs. Co.*, No. 2:16-cv-505, 2017 WL 2672616, at *15 (E.D. Tex. Jun. 21, 2017) (refusing to “rewrite” a “nonsensical,” indefinite claim). However, that is precisely what EA attempts to do. Inexplicably, EA would have the same phrase “the changes” refer to different things within the same claim. EA Br., 28–29 (asserting that the yellow-highlighted “the changes” means changes communicated from the vehicle, while the red-

⁶ Shoemake Dec., ¶ 93 (quoting ’268, 34:52–64) (colored annotations from expert).

highlighted “the changes” means both changes from the vehicle and those not necessarily communicated from the vehicle); *see also* Shoemake Reply Dec., ¶52.

The red-highlighted instance of “the changes” ambiguously could refer to either or both of “changes to user settings” and “other changes to the user settings.” Shoemake Dec., ¶¶ 103–105 (listing possible interpretations).⁷ The intrinsic record sheds no light on the matter, referring permissively to “changes” that *can* be used for learning behavior, but never changes that *must* or *must not* be used for this purpose. *See id.*, ¶¶ 96–100. This means, once again, that either *or* both of “changes” or “other changes” could be used for learning with no “informed and confident” choice as to which combination of the two is correct. *See Nautilus*, 572 U.S. at 911, n. 8.

The pink-highlighted instance of “the changes” ambiguously could refer to any combination of “changes to user settings,” “other changes to the user settings,” and/or “automatic changes to the user settings.” *See* Shoemake Dec., ¶¶ 103, 106–110 (providing possible combinations). For the same reasons, the intrinsic record is of no assistance and simply describes types of changes that *can* be used to learn behavior with no guidance on which ones are invoked by the term “the changes.” *See id.*, ¶¶ 96–100. Any, some, or all of these recited “changes” *could* be used to “learn behavior,” and the claim is wholly unclear as to which ones *actually are*. *See id.*

Because both highlighted instances of “the changes” ambiguously refer back to some combination of preceding “changes” with no guidance on which combination to use, this term should be found indefinite.

III. CONCLUSION

For the foregoing reasons, Defendants ask that the Court adopt its proposed constructions.

⁷ Despite different claim terms being presumed to have different meanings, *see Bd. of Regents*, 533 F.3d at 1371, the claim also leaves unclear how, if at all, the claimed “changes” differ in scope from “other changes,” “the changes” and “the changes.” *See* Shoemake Dec., ¶ 95.

Dated: December 19, 2024

Respectfully submitted,

/s/ James R. Barney
James R. Barney (LEAD)
(DC Bar No. 473732)
Ryan T. Davies (DC Bar No. 1686044)
Alexander E. Harding (admitted *pro hac vice*)
Nicholas A. Eitsert (admitted *pro hac vice*)
Ariel Batiste (admitted *pro hac vice*)
FINNEGAN, HENDERSON,
FARABOW, GARRETT &
DUNNER, LLP
901 New York Avenue, NW
Washington, DC 20001-4413
Tel.: (202) 408-4000

Aidan C. Skoyles (admitted *pro hac vice*)
FINNEGAN, HENDERSON,
FARABOW, GARRETT &
DUNNER, LLP
1875 Explorer St Suite 800
Reston, VA 20190-6023
Tel.: (571) 203-2700

Michael C. Smith (TX Bar No.
18650410)
SCHEEF & STONE, LLP
State Bar No. 18650410
113 E. Austin Street
Marshall, Texas 75670
Office: (903) 938-8900
michael.smith@solidcounsel.com

*Counsel for Defendants Toyota
Motor Corp., Toyota Motor North
America, Inc., and Toyota Motor
Sales, U.S.A., Inc.*

/s/ Brett N. Watkins
Brett N. Watkins (TX Bar No.
24106816)
QUINN EMANUEL URQUHART
& SULLIVAN LLP

700 Louisiana Street, Suite 3900
Houston, TX 77002
Tel.: (713) 221-7030
Fax: (713) 221-7100
brettwatkins@quinnemanuel.com

D. James Pak (LEAD) (admitted *pro hac vice*)
QUINN EMANUEL URQUHART
& SULLIVAN LLP
865 S. Figueroa Street, 10th Floor
Los Angeles, CA 90017
Tel.: (213) 443-3000
Fax: (213) 443-3100
djamespak@quinnemanuel.com

Deron R. Dacus (TX Bar No.
00790553)
THE DACUS FIRM, P.C.
821 ESE Loop 323, Suite 430
Tyler, TX 75701
Tel.: (903) 705-1117
Fax: (903) 581-2543
ddacus@dacusfirm.com

*Counsel for Defendants Kia
Corporation and Kia America, Inc.*

CERTIFICATE OF SERVICE

The undersigned certifies that on December 19, 2024, a true and correct copy of the above document was served on all counsel of record via the Court's CM/ECF system.

/s/ James R. Barney
James R. Barney