

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORP.
and
KIA CORPORATION,

Petitioners,

v.

EMERGING AUTOMOTIVE LLC,
Patent Owner.

Case IPR2026-00059
U.S. Patent No. 11,104,245

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Reserved
2002	Civil Docket Report for <i>Emerging Automotive LLC v. Toyota Motor Corp. et al.</i> , No. 2:23-cv-0437-JRG (lead case)
2003	Google Patents search, U.S. Patent No. 11,104,245, available at https://patents.google.com/patent/US11104245B2/en?q=11%2c104245#citedBy (identifying assignees of patents and patent applications which cited to U.S. Patent No. 11,104,245)
2004	Final Written Decision, IPR2024-00981
2005	Discovery Order for <i>Emerging Automotive LLC v. Toyota Motor Corp. et al.</i> , No. 2:25-cv-00782-JRG (lead case)
2006	Defendant's Claim Construction Brief, <i>Emerging Automotive LLC v. Toyota Motor Corp. et al.</i> , No. 2:23-cv-0437-JRG
2007	Civil Docket Report for <i>Emerging Automotive LLC v. Toyota Motor Corp. et al.</i> , No. 2:23-cv-0434-JRG (member case)
2008	Civil Docket Report for <i>Emerging Automotive LLC v. Toyota Motor Corp. et al.</i> , No. 2:25-cv-0782-JRG (lead case)
2009	Civil Docket Report for <i>Emerging Automotive LLC v. Toyota Motor Corp. et al.</i> , No. 2:25-cv-0799-JRG (lead case)
2010	Order Denying Motion to Stay, <i>Digital Doors, Inc. v. Int'l Bus. Machines Corp.</i> , No. 2:22-cv-00457-JRG-RSP (E.D. Tex. July 24, 2023)

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Pursuant to the Interim Processes Memorandum, issued March 26, 2025, Patent Owner Emerging Automotive LLC (“Emerging Auto” or “Patent Owner”) respectfully submits this request and brief on discretionary denial, setting forth reasons why the Petition for *inter partes* review (“IPR”) of all claims of U.S. Patent 11,104,245 (the “’245 patent”), as requested by Kia Corporation and Toyota Motor Corporation (“Petitioners”), should be denied pursuant to the Director’s discretion.

I. INTRODUCTION

Discretionary denial is warranted here for several reasons:

(1) Petitioners’ inconsistent claim construction positions—involving alleged disclaimer of the very same reference relied upon in this Petition—risks inconsistent decisions across the two proceedings and thwarts “the Office’s goal of providing greater predictability and certainty in the patent system”;

(2) the weak Petition is a waste of the Board’s resources, as the Board has already rejected Petitioners’ misplaced reliance on Zaid, and there are glaring gaps in the Petition’s additional primary reference, Kleve, which are propped up by dubious expert testimony;

(3) all four of the Petition’s references were already known to and evaluated by the Office during prosecution, yet Petitioners do not and cannot claim any material error, warranting another basis for denial under 35 U.S.C. § 325(d);

(4) the parallel district court case in the Eastern District of Texas is not likely

to be stayed, such that any institution would result in duplicative workload and risk inconsistent outcomes, especially where Petitioners advance inconsistent claim construction positions for each of the two proceedings;

(5) substantial discovery has already been completed in the parties' first litigation, and all parties will rely on this already-completed discovery in the second district court litigation;

(6) the parties of the parallel proceedings are identical; and

(7) Petitioners have known of the challenged patent's family for years, having cited to Patent Owner's patents and patent applications in a number of their own applications, e.g., in 2019, 2020, and 2021, and Patent Owner informed Petitioners of the '245 Patent in 2023.

II. BACKGROUND

A. Innovations of U.S. Patent No. 11,104,245

U.S. Patent No. 11,104,245 ("the '245 Patent") issued on August 31, 2021. EX1001, Face Page. The '245 patent is titled "Vehicles and Cloud Systems for Sharing E-Keys to Access and Use Vehicles" and "relates to systems and methods for generating and sharing electronic keys (e-Keys) with users and cloud-based processing systems[.]" *Id.* at 1:1-3, 1:59-62. Companies like Apple, Ford, Samsung, Audi, General Motors, Volkswagen, and even Petitioner Toyota and Petitioner Kia's parent, Hyundai, have all cited to the '245 Patent in their own patent applications.

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EX2003, (identifying assignees of patents and patent application publications which cited to the '245 Patent). Apart from these patent applications citing to the '245 Patent and its family, Petitioners have known of the '245 Patent since at least as early as September 2023, when Patent Owner filed its first lawsuit against Petitioners, asserting the 11,738,659 Patent, a continuation of an application which is “now Pat. No. 11,104,245.” EX2002, Dkt. No. 1-4 (Complaint filed September 22, 2023, Ex. 4, Face Page).

The '245 Patent describes innovations that allow a vehicle owner to assign, refine, and control the generation of any number of e-keys to any number of users for a vehicle—each unique e-key having its own privileges. EX1001, 43:26-40. For example, the owner can set a restriction associated with a mode of allowed use of the vehicle, such as “valet mode,” in which “the vehicle will have restricted use parameters, and will also provide for reporting back to the user in case violations occur in accordance with the predefined privileges assigned to a valet.” *Id.*, 38:21-30.

The claims recite that the vehicle receives coded data from the mobile device for unlocking and use of the vehicle, that the coded data includes a unique access code including a unique access code received from the server. EX1001, (independent claim 1). Accordingly, each e-key is unique, and “being unique, can be cancelled and eliminated without affecting other issued e-keys.” *Id.*, 48:53-59, 47:57-61.

Additionally, the claims recite that “privileges are set via the server,” the “privileges for the unique access code,” and the privileges are “responsive to a restriction set by an administrator of the vehicle” and that “restriction is associated with a mode of allowed use of the vehicle.” *Id.*, claim 1.

B. Related and Parallel Litigation Proceedings

In July 2025, Patent Owner asserted patent infringement of the '245 Patent against Petitioners in the Eastern District of Texas. EX2008; EX2009. Patent Owner has asserted two other Emerging Automotive patents, U.S. Patent Nos. 12,337,715 and 12,337,716 against Petitioner Toyota, and asserted the 12,337,715 Patent against Petitioner Kia. *Id.* Discovery is underway in these two consolidated district court proceedings (“*Emerging Automotive v. Toyota/Kia, IP*”). EX2008.

Previously, in September 2023, Patent Owner filed two prior patent infringement lawsuits against Petitioner Toyota and Petitioner Kia, asserting infringement of U.S. Patent No. 10,407,026, U.S. Patent No. 11,738,659, U.S. Patent No. 9,365,188, and U.S. Patent No. 9,171,268 (against Petitioner Toyota only), and the two proceedings were consolidated. EX2002; EX2007. These 2023 consolidated proceedings (“*Emerging Automotive v. Toyota/Kia, I*”) were stayed on the eve of trial, following the district court’s summary judgement order on a non-instituted asserted patent. EX2002. In *Emerging Automotive v. Toyota/Kia, I*, fact discovery, expert discovery, claim construction proceedings, and a pretrial conference had been

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completed. *Id.* The district court issued a Markman Order on May 14, 2025. EX1015.

For the *Emerging Automotive v. Toyota/Kia, II* district court proceedings, the parties have agreed to utilize the discovery completed in *Emerging Automotive v. Toyota/Kia, I*. EX2005, ¶¶ 5, 12(g)-(h).

Regarding the IPR/EPR proceedings on related patents, the Board did not institute on IPR2024-00785, which had challenged claims of U.S. Patent No. 10,407,026. The Board instituted proceedings on IPR2024-00981, and issued a Final Written Decision in which the Board found that all of the challenged claims of U.S. Patent No. 9,365,188, were shown to be unpatentable. EX2004. Regarding U.S. Patent No. 11,738,659, the Board instituted proceedings on IPR2024-01167, and that matter is pending; additionally, the Office issued a final rejection in Reexamination No. 90/019,456, for which an appeal is pending. Pet. 1-2; EX1019.

III. THE DIRECTOR SHOULD DENY INSTITUTION

The Director can and should deny this Petition, by exercising its discretion under 35 U.S.C. § 314(a) based on Petitioners' inconsistent claim construction positions, which highlight the meritless challenges, risk incongruent decisions and undermine the Office's goals of promoting predictability and certainty.

A. Petitioners' Inconsistent Claim Construction Positions—Involving Alleged Disclaimer of the Petition's Primary Reference, Zaid—Demonstrates Discretionary Denial is Warranted.

Petitioners have taken inconsistent positions in district court and in the IPR

Petition regarding the “privileges” terms recited in each of the challenged claims of the ’245 Patent, which directly undermine the Petition’s primary reference, Zaid, for Grounds 3 and 4. As shown below, Petitioners advised the Board that apart from “e-key,” “no other terms need construction here.” Pet. 14:

VI. Claim Construction

The District Court construed “electronic key”/“eKey”/“e-key” as “electronic data that enables one or more functions of the vehicle.” Ex.1015. Claims only need to be construed to the extent necessary, and no other terms need construction here.

However, Petitioners’ position in this IPR proceeding is inconsistent and irreconcilable with their proposed construction of the “privileges” terms in district court, terms which are found in each of the challenged claims of the ’245 Patent— i.e., “privileges set by the server responsive to a restriction,” “privileges are for the unique access code” and “privileges are defined for each sharing session of the vehicle.” EX1001, claim 1. In district court Petitioners advanced a narrower construction of “privileges” to specifically exclude “unfettered access”—and Petitioners’ narrower construction was in fact adopted by the district court. EX1015, at 12-13. Specifically, Petitioners’ proposed construction in district court was based on Patent Owner’s alleged disclaimer of Zaid—e.g., that Zaid could not disclose the recited privileges limitations in light of Zaid’s “unfettered access” to the vehicle, and Zaid did not disclose “a unique access code that includes privilege settings.” *Id.*

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In Zaid, a user reserves a vehicle using a server. “[T]he vehicle reservation is communicated to a wireless communication device of the user, “and the wireless communication device receives and caches the reservation.”

After decrypting the reservation, the wireless communication device forwards the decrypted reservation to a “vehicle access kit” of the vehicle. Then, unfettered “vehicle access is provided based on the received reservation.”

Id. (internal citations omitted). Plaintiff then emphasized its prosecution remarks that Zaid did not disclose “a unique access code that includes privilege settings set for additionally limiting types of use of the vehicle.” *Id.* at 17. In other words, Plaintiff equated “unfettered access” with the absence, not presence, of “privileges.” Given that, the Court agrees with Defendants that “privileges for use of the vehicle” cannot simply be “unfettered access” to the vehicle, which is the “plain and ordinary meaning” of these phrases on this record.

EX1015, at 12-13; Defendants’ Claim Construction Brief, EX2006, at 6:

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.

Petitioners failed to disclose to the Board that the district court had construed the “privileges” terms to specifically exclude “unfettered access,” based on alleged disclaimer of Zaid, despite the Petition’s substantial reliance on Zaid to challenge each of the claims of the ’245 Patent, and the fact that each of the challenged claims requires both that “the unique access code is associated *with privileges* set by the server” and that those “*privileges* are for the unique access code.” Pet. 14. And here Zaid is not merely the Petition’s primary reference for Grounds 3 and 4. As detailed below, Zaid was already considered and applied in multiple rejections during

examination of the ’245 Patent, Zaid was determined to be the closest prior art in the Office’s Reasons for Allowance, and the Petition purports to adopt many of the Examiner’s Zaid-based rejections in an attempt to fill in the Petition’s evidentiary gaps.

Accordingly, this is not merely a case in which Petitioners made inconsistent claim construction arguments in two different proceedings—facts which alone “detract[] from the Office’s goal of providing greater predictability and certainty in the patent system”—but instead risks a Board decision that may be merely advisory, as Petition has failed to offer alternative invalidity arguments based upon the district court’s construction. *See Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 (Director, Nov. 5, 2025) (informative) (granting Director Review, vacating Decision granting institution, and denying Petition that advanced inconsistent claim construction positions) (quoting *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 at 3-5 (Director, Nov. 3, 2025) (precedential) (requiring petitioner to justify different claim construction positions in different proceedings)). Here, the Petition has failed to inform the Board of the narrowed district court construction—a construction Petitioners sought—which not only has direct relevance to the “privileges” limitations at issue in each of the challenged claims of the Petition, but also relevance as to whether the Petition’s reference, Zaid, actually discloses those “privileges” limitations.

Here, the Petition failed to even acknowledge the existence of inconsistent positions, let alone justify them. *See Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00966, Paper 12 at 8 (PTAB Dec. 13, 2024) (informative).

And because the Petition did not advise the Board of the narrower construction, and did not include any alternative invalidity arguments based on any narrower claim construction of the “privileges” claim term found in all claims of the ’245 Patent, the Board’s consideration of challenges applying an incorrect construction would be merely advisory, resulting in a waste of the Board’s already-limited resources.

B. Denial is Warranted Because the Petition Fails to Present Any Compelling Challenge to the Claims.

Even under a cursory review, the Petition fails to meet the required threshold for any claim, as the Petition relies on conclusory expert opinions to try to fill the glaring evidentiary gaps for multiple limitations required of independent claim 1 (and therefore required by dependency for all challenged claims). These deficiencies alone, which will be described more fully in the Patent Owner’s Preliminary Response, demonstrate that the merits of the Petition are weak and therefore institution is not “an efficient use of the Board’s time and resources.” *See, e.g., Chevron Oronite Company LLC v. Infineum USA L.P.*, IPR2018-00923, Paper 9 at 10-11 (PTAB Nov. 7, 2018), and *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310,

Paper 7 at 42-43 (PTAB Jan. 24, 2019).

For example, for **Grounds 1-2**, the Petition points to Kleve’s “matrix barcode” as the independent claim’s recited “coded data ... for unlocking and use of the vehicle.” Pet. 19. But even if Kleve’s barcode were to meet each of the required features of the claims’ recited “coded data,” neither Kleve nor any other reference discloses or teaches “**the coded data ... including a unique access code**”—let alone a unique access code associated with any “*privileges*, set by the server ... privileges are for the unique access code.” EX1001, independent claim 1 (emphases added).

The Petition attempts to fill Kleve’s gaps with expert testimony, but the Petition’s grounds crumble after one look at that testimony. Pet. 19-20, *citing* EX1004, ¶¶ 121-22. For example, rather than point to any actual disclosure in Kleve, Petitioners’ expert provides the conclusory opinion that Kleve’s “matrix barcode,” like “QR codes,” by their very nature, “encode a unique access code” or “encode a unique value[.]” EX1004, ¶ 122 (citing EX1005, ¶¶ 44, 69).

As anyone who has scanned a QR code for a restaurant menu can affirm, the QR codes at each table of a restaurant will reveal the same menu for each table, and therefore QR codes, like Kleve’s matrix barcode, do not inherently encode a “unique” value as Petitioners’ expert submits. And indeed, Kleve itself affirms this *lack of* “unique-ness,” likening its “matrix barcode” to a “code word that the Temporary User may enter/send to the vehicle when ready to begin the rental term.”

EX1005, ¶ 69. Kleve simply does not disclose any “coded data ... including a unique access code,” and without any disclosure of that required “unique access code,” the Petition likewise cannot show the remaining claim limitations requiring specific features of Kleve’s non-existent “unique access code,” e.g.: (1) “the unique access code is associated with privileges set via the server” (claim 1[g]); (2) the “privileges are for the unique access code” (claim 1[g]); (3) the recited privileges set by the server being “responsive to a restriction set by an administrator of the vehicle” (claim 1[g]); or (4) the “unique access code functioning for the e-key” (claim 1[i]). EX1001.

Similarly deficient are the Petition’s Zaid-based challenges, **Grounds 3 and 4**, in which the Petition first points to Zaid’s vehicle reservation as the claims’ recited “coded data,” next identifies Zaid’s “decrypted vehicle reservation” as the required “unique access code,” and then, for the requirement that the recited “privileges set via the server *responsive to a restriction set by an administrator of the vehicle, the restriction is associated with a mode of allowed use of the vehicle ...*” (claim 1), the Petition makes the conclusory assertion that “Zaid’s time-limited access and use privileges are set via Zaid’s central server responsive to the selected time period being within the vehicle owner’s identification of availability.” Pet. 54, *citing* EX1004, ¶ 226. But like the Examiner, who found that Zaid “fails to expressly teach ... the restriction is associated with a mode of allowed use that sets limits for operation of the vehicle while the vehicle is accessible” (EX1002, 124), the Petition

fails to identify any disclosure from Zaid that satisfies this limitation. Pet. 54. Indeed, although the Examiner relied on a distinct reference, Joao, for alleged disclosure of the missing “restriction set by an administrator” limitations, the Petition never even mentions the Joao reference, but instead relies solely on Zaid. *Id.* One glaring problem, though, is that the Board already concluded that it is Zaid’s *vehicle renter* that makes the reservation and the time set for that reservation, *not the vehicle owner*. EX2004 at 45-46. Since Zaid’s vehicle owner does not set *any* condition of use for the vehicle reservation, Zaid cannot meet the independent claims’ recited “*restriction set by an administrator* ...,” let alone the recited features of that set “restriction” (e.g., “associated with a mode of allowed use of the vehicle”). *Id.*

In dismissing each of Petitioners’ Zaid-based grounds in its Final Written Decision on related e-key Patent 9,365,188, the Board not only rejected the idea that Zaid’s vehicle owner sets any condition of use for the vehicle reservation, the Board also determined that the “vehicle renter uses his or her own account to make a reservation and to send a request that generates an electronic key” (EX2004 at 45), and concluded that Zaid offered neither “teaching or suggestion that such a user account would encompass the vehicle owner” (*id.* at 46). This Petition’s renewed reliance on Zaid is equally misplaced, as it is the vehicle renter that makes the vehicle reservation and sets the time for said reservation—not the vehicle owner. *Id.* at 45-46. Zaid’s alleged “restrictions” are not “set by an administrator.” EX1001, claim 1.

Discretionary denial is warranted because the Petitioners' inconsistent claim construction positions, bearing directly on the Petition's merits, undermine the Office's goals and waste time and resources, and further, the Petition fails to provide any compelling challenge.

C. Judge Gilstrap is Unlikely to Grant a Stay of the District Court Proceeding.

Petitioners have not sought a stay, and under the facts here, a stay would not be granted. Patent Owner has asserted three different patents in the parallel district court proceeding, including eleven claims of the '245 Patent, all thirteen claims of the 12,337,716 Patent, and all twenty-four claims of U.S. Patent No. 12,337,715. EX2008. The Eastern District trial court has publicly stated that it will not even consider a stay unless the defendant shows "that every asserted claim has a reasonable likelihood of being invalidated by the PTAB." EX2010 (Order Denying Motion to Stay, *Digital Doors, Inc. v. Int'l Bus. Machines Corp.*, No. 2:22-cv-00457-JRG-RSP (E.D. Tex. July 24, 2023)), at 5.

Accordingly, this factor favors discretionary denial.

D. The Stage of Discovery Favors Denial.

The district court has already spent substantial time and resources conducting the Markman hearing and issuing a Markman Order that undisputedly bears on the claim terms of the challenged '245 Patent. Section II.B., *supra*. Additionally, the

parties have already spent substantial resources conducting discovery in the first district court matters—discovery which all sides have agreed to utilize in the present district court matters. EX2005, Discovery Order, ¶¶ 5, 12(g)-(h). This already-completed discovery includes: twenty-three fact depositions, thirteen expert depositions, over seventy-seven interrogatories propounded, over 230,000 documents produced, and nine third-party subpoenas issued. EX2002.

Discretionary denial is favored in light of the investment by the Court and the parties in the first district court Markman hearing, numerous already-resolved substantive and discovery motions, and the substantial discovery that has already been completed to date. *Id.*

E. The Parties and Issues of the Parallel Proceedings Overlap.

The Petitioners are also defendants in the parallel district court litigation, which favors discretionary denial. Moreover, save dependent claims 4-5, and 7-10, the remaining challenged claims are also at issue in the district court proceeding. EX2002. Petitioners’ “*Sotera*” stipulation does not fully resolve concerns about overlap, duplicative efforts, and conflicting decisions, since Petitioners can pursue any invalidity challenge in the district court that (1) is described in a printed publication that could have been raised in the IPR (e.g., same system art) and/or (2) relies on the same patents or printed publications from the IPR to support theories of invalidity unavailable in an IPR. *See Ingenico v. IOENGINE*, No. 2023-1367, D.I.

58 (Fed. Cir. May 7, 2025). And the risk of conflicting decisions is of particular concern where, as here, Petitioners advance inconsistent and irreconcilable claim construction positions in the two proceedings.

IV. DISCRETIONARY CONSIDERATIONS UNDER SECTION 325(D) STRONGLY FAVOR DENIAL.

The Board should exercise its discretion to deny the Petition under 35 U.S.C. § 325(d) because, as shown below, each the *Becton Dickinson* factors weigh in favor of discretionary denial here. *Becton, Dickinson & Co. v. B. Braun Melsungen AG* (“*Becton*”), IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph). Not only were all of the Petition’s references already considered by the Office, but the Petition also parrots many of the relied-upon disclosures and art combinations which were applied during examination. Accordingly, the Petition has not and cannot contend that the Examiner committed material error without also undermining the very evidence relied upon in the already weak Petition.

A. Each of the Petition’s Four References Was Known to, and Already Considered by, the Patent Office.

The first *Becton* factor—the similarities and material differences between the asserted art and the prior art involved during examination—strongly favors Patent Owner, as there is complete overlap between the Petition’s references and the prior art involved during examination. Moreover, given this complete overlap, the second

Becton factor—the cumulative nature of the asserted art and the prior art evaluated during examination—likewise strongly favors Patent Owner. As shown below, the Petition's use of these same four references yet again is clearly cumulative over the prior examination.

Zaid, relied on by the Petition for **Grounds 3 and 4**, was not only considered by the Examiner, but also the Examiner relied on Zaid for three different obviousness rejections of pending claims, in Office Actions on December 6, 2019 (EX1002, at 381-92), April 30, 2020 (*id.*, at 233-51), and again on October 20, 2020 (*id.*, at 118-35). Mottla, relied upon by Petitioners for **all grounds**, was also applied by the Examiner in combination with Zaid, for each of the Office's three obviousness rejections. *Id.*, at 122-35, 237-51, 385-92. Goudy, used in **Grounds 2 and 4** of the Petition, was also relied upon by the Examiner in two of the Office's obviousness rejections, and was specifically applied in combination with Zaid and Mottla. *Id.*, at 130-35, 240-51. And Kleve, used by the Petition in **Grounds 1 and 2**, was also considered by the Examiner, as shown by the Examiner's December 4, 2019 EAST search. EX1002, at 334 (showing search including Kleve patent application publication 2014/0129053), 85 (same), 198 (same), 399 (same).

Accordingly, all four of the Petition's references were already considered during the prosecution of the '245 Patent.

B. Zaid, Mottla and Goudy Were Used in the Office's Obviousness Rejections and Kleve was Repeatedly Considered.

The third *Becton* factor—the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection—strongly favors Patent Owner, as the record shows a clear indication that the Examiner had evaluated the merits of the references, and had ultimately determined that the issued claims were patentable over those references.

As described above, the Examiner relied on Zaid and Mottla for obviousness rejections of pending claims in three different Office Actions and further added Goudy to the Zaid/Mottla obviousness combination in its second and third Office Actions. EX1002, at 381-92 (December 2019 Office Action applying Zaid and Mottla), 233-51 (April 2020 Office Action applying Zaid, Mottla and Goudy), 118-35 (October 2020 Office Action again applying Zaid, Mottla and Goudy).

Moreover, Kleve was considered by the Examiner during examination of the '245 Patent. EX1002, at 334 (EAST search) , 85 (same), 198 (same), 399 (same).

Accordingly, this factor weighs in favor of discretionary denial.

C. The Petition Relies on the Prior Art References in the Same Manner—and with the Same Deficiencies—as was Done During Examination.

The fourth *Becton* factor—the extent of the overlap between the arguments made during examination and the manner in which Petition relies on the prior art or

Patent Owner distinguishes the prior art—clearly favors Patent Owner because the Petition relies on the same references in the same manner, and Patent Owner's arguments as to the deficiencies of those references likewise apply here.

Neither of the Petition's primary references discloses or suggests the independent claim's recited limitation that "the unique access code functioning for the e-key that is managed via one or more graphical user interface inputs rendered on a screen of the mobile device." EX1001, claim 1[i]. Instead, Petitioners parrot the Examiner's reliance on Mottla to try to fill these gaps. *See, e.g.*, EX1004, ¶ 232 ("the Office determined that Mottla's 'vehicle remote entry application' discloses this limitation. ... I agree with the Office."); *and see, e.g.*, EX1002, at 239.

Further, Grounds 2 and 4 of the Petition rely on Goudy in a manner cumulative to the Examiner's rejections, as the Petition merely repeats the Examiner's relied-upon disclosures. *See, e.g.*, EX1004, 299 ("the Office determined that Goudy 'teaches a vehicle has a function to disable the vehicle's infotainment device.' ... I agree with the Office.").

Likewise, in Grounds 3 and 4, the Petition relies on Zaid in a manner cumulative to the Examiner's use of Zaid. *E.g.*, EX1004, ¶¶ 187 ("the Office determined that Zaid's 'vehicle 104' discloses this limitation. [] I agree with the Office."), 190 ("the Office determined that Zaid's 'ECA 308' discloses this limitation. [] I agree with the Office."), 201 ("the Office determined that Zaid's

‘vehicle access control component 206’ discloses this limitation. [] I agree with the Office.”), 207 (same), 213 (same).

And although the Examiner knew of Kleve, there were no arguments made in the prosecution regarding Kleve, for unlike the Petition, the Examiner did not make the incredible claim that a “matrix barcode,” like other QR codes, inherently encodes any “unique” code. *See, e.g.*, Section III.B., *supra*.

D. The Petition Has Not and Cannot Show that the Examiner Committed Material Error Which Warrants Yet Another Review of the Same Prior Art References.

The fifth *Becton* factor—whether the Petition has shown material error by the Examiner—strongly favors Patent Owner, as the Petition has not set forth any discussion of how or whether the Examiner erred, let alone any material error. To the contrary, the Petition’s heavily relied-upon expert testimony repeatedly parrots the Examiner’s conclusions. *See* Sections III.B. and IV.C., *supra*.

E. No Additional Evidence or Facts Presented in the Petition Warrant Reconsideration of the Prior Art or Arguments.

This final *Becton* factor strongly favors Patent Owner because, as explained in Section III.B., *supra*, the proposed invalidity grounds depend on patently dubious expert testimony which infects the entirety of the Petition.

The Patent Office’s prior consideration of the Petition’s references provides both an independent basis for discretionary denial under § 325(d) and provides yet

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another consideration among the totality of discretionary denial factors which warrant denial of institution. *See, e.g., TankLogix, LLC v. SitePro, Inc.*, IPR2025-00761, Paper 10 (Director, Sept. 3, 2025) (denying institution because the same prior art was previously presented to the Office, though time-to-trial statistics suggested trial 10 months after FWD, and no finding of settled expectations).

V. CONCLUSION

For the reasons presented above, the Petition should be discretionarily denied, and no *inter partes* review should be instituted.

Dated: December 23, 2025

/Brenda Entzminger/
Brenda Entzminger, Reg. No. 76,896

CERTIFICATE OF SERVICE

Petitioners have consented to e-mail service in this proceeding. Pursuant to 37 C.F.R. §42.6, the undersigned certifies that, on the date indicated below, a copy of the foregoing document was served by email upon the following counsel at the below email addresses:

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