

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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TOYOTA MOTOR CORP.

Petitioner,

v.

EMERGING AUTOMOTIVE LLC,  
Patent Owner.

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Case IPR2026-00070  
U.S. Patent No. 12,337,716

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**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	U.S. Patent No. 8,737,913 to Xiao, et al.
2004	Final Written Decision, IPR2024-00786
2005	Defendant's Responsive Claim Construction Brief, <i>Emerging Automotive LLC v. Toyota Motor Corp. et al.</i> , No. 2:23-cv-0437-JRG (lead case)
2006	Preliminary Constructions, <i>Emerging Automotive LLC v. Toyota Motor Corp. et al.</i> , No. 2:23-cv-0437-JRG (lead case)
2007	Claim Construction Order, dated May 14, 2025, <i>Emerging Automotive LLC v. Toyota Motor Corp. et al.</i> , No. 2:23-cv-0437-JRG (lead case)
2008	Discovery Order, <i>Emerging Automotive LLC v. Toyota Motor Corp. et al.</i> , No. 2:25-cv-0782-JRG (lead case)
2009	Order Denying Motion to Stay, <i>DigitalDoors, Inc. v. International Business Machines Corporation</i> , Case No. 2:22-cv-457-JRG-RSP (E.D. Tex. July 24, 2023)
2010	Civil Docket Report for <i>Emerging Automotive LLC v. Toyota Motor Corp. et al.</i> , No. 2:25-cv-0782-JRG (lead case)
2011	Civil Docket Report for <i>Emerging Automotive LLC v. Kia Corporation</i> , No. 2:25-cv-00799 (member case)
2012	Civil Docket Report for <i>Emerging Automotive LLC v. Toyota Motor Corp. et al.</i> , No. 2:23-cv-0434-JRG (member case)
2013	IPR2024-00814, Final Written Decision

## IPR2026-00070 Patent Owner’s Request for Discretionary Denial

Pursuant to the Interim Processes Memorandum, issued on 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 12,337,716 (the “’716 patent”), as requested by Toyota Motor Corporation (“Petitioner”), should be denied pursuant to the Director’s discretion.

### **I. INTRODUCTION**

Discretionary denial is warranted here for several reasons:

(1) Petitioner’s inconsistent claim construction positions—involving a claim term already construed by the district court and directly relevant to the substantive deficiencies of this Petition—risk 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 an inefficient use of the Board’s resources, as the Board’s Final Written Decision in related IPR2024-00786 demonstrates the inherent deficiencies for each of the Petition’s grounds;

(3) all five of the Petition’s references were already known to and considered by the Office during prosecution, yet Petitioner does not cite to any alleged 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 Petitioner advances inconsistent claim construction positions for each of the two proceedings;

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

(6) the parties of the parallel proceedings are identical.

## **II. BACKGROUND**

### **A. Innovations of U.S. Patent No. 12,337,716**

U.S. Patent No. 12,337,716 ("the '716 Patent") issued on June 24, 2025. EX1001, Face Page. The '716 patent is titled "Systems for Transferring User Profiles Between Vehicles Using Cloud Services" and "related to systems and methods for managing user profiles for vehicles and exchange of information with cloud-based processing systems." *Id.*, at 1:1-3, 1:41-43.

The '716 Patent discloses inventive systems and methods enabling the automatic transfer of user profile settings to vehicles, providing, for example, a server compatibility check to determine settings that are compatible based on the type of vehicle before transferring the profile settings for programming on a vehicle. EX1001, 1:35-4:64, 2:50-55; *see also* claim 1[c], claim 7[c].

**B. Related and Parallel Litigation Proceedings**

In July 2025 Patent Owner asserted patent infringement of the '716 Patent against Petitioner Toyota in the Eastern District of Texas. EX2010, Pet. 73-74. The lawsuit against Toyota also asserts infringement of two additional patents issued to Patent Owner, U.S. Patent No. 11,104,245 and U.S. Patent No. 12,337,715. *Id.* Patent Owner has also filed a patent infringement action against Kia Corporation in the Eastern District of Texas, which asserts U.S. Patent No. 11,104,245 and U.S. Patent No. 12,337,715. EX2011. Discovery is underway in these two consolidated proceedings ("*Emerging Automotive v. Toyota/Kia, IP*"). EX2010.

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. 9,171,268 (against Petitioner Toyota only), a patent family member of the '716 Patent, along with four other Emerging Automotive patents. EX2012; Pet. 1, 73-74; EX1017 (U.S. Patent No. 9,171,268). Patent Owner had asserted three Emerging Automotive patents against Kia Corporation, and the two proceedings were consolidated. EX2002. These 2023 consolidated proceedings ("*Emerging Automotive v. Toyota/Kia, I*") were stayed on the eve of trial, following the district court's summary judgment 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 completed. *Id.*

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The district court issued a Markman Order on May 14, 2025. EX2007.

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*. EX2008, at ¶¶ 5, 12(g)-(h).

Regarding the related patent, 9,171,268, the Board issued a Final Written Decision in IPR2024-00786, in which the Board found that six of the challenged claims were shown to be unpatentable, five of the challenged claims were not shown to be unpatentable, and nine of the claims were not challenged in the IPR. EX2004. The Board instituted proceedings in IPR2024-00814 and issued a Final Written Decision finding that all challenged claims of U.S. Patent No. 11,296,244 were shown to be unpatentable. EX2013.

### **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 Petitioner's inconsistent claim construction positions, which highlight the meritless challenges, risk incongruent decisions, and undermine the Office's goals of promoting predictability and certainty.

#### **A. Petitioner's Failure to Advise of the District Court Claim Construction Directly Impacts the Board's Merits Review and Demonstrates Discretionary Denial is Warranted.**

Petitioner has taken inconsistent claim construction positions in the district court and in the IPR Petition regarding the "compatibility" / "incompatibility" terms

required of all challenged claims. For example, independent claim 1 requires “a server for processing ... user information to verify the access, the profile having a plurality of *settings of the user preferred for the vehicle having a vehicle type*” and further requires “a server for transferring ... based on *determining settings that are compatible, by said server, for said vehicle type*, one or more settings ... .” EX1001, claim 1 (emphases added). Additionally, independent claim 7 requires “the server performs processing *to determine incompatibility* of one or more of the plurality of *settings of the user based on a type of the vehicle*, and the server transfers one or more settings ... .” *Id.*, claim 7 (emphases added).

In district court, it was Petitioner who advanced a construction for all claims containing a “compatible” term, specifically proposing the requirement that the server performs a “compatibility check”:

<p>M. <u>Term 13:</u>  “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 Patent, 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 Patent, Claim 20)</p>	
Plaintiff’s Construction	Toyota’s Construction
<p>The parties agree these limitations require a <u>“compatibility check”</u> where the server / cloud based system determines whether settings are compatible with the vehicle. Otherwise, no construction necessary.</p>	<p>the server / cloud based system determines applicable settings by performing a <u>compatibility check</u> 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</p>

EX2005, at 29. This requirement, that a server performs this “compatibility check,” was ultimately adopted by the district court on May 14, 2025, long before the instant

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Petition was filed. *See, e.g.:*

M	“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 Patent, 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 patent, claim 20)	Plain and ordinary meaning [NOTE: these limitations require a “compatibility check” where the server / cloud based system determines whether settings are compatible with the vehicle”]
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EX2006, at 4 (district court preliminary constructions); EX2007, at 29 (district court claim construction order).

In this proceeding, however, Petitioner advised the Board that “no terms require construction,” and gave no indication that the “compatibility” term had ever been construed in the district court. Pet. 12-13.

## V. Claim Construction

No terms require construction for purposes of IPR because the ’716 Patent claims read on the prior art under any construction consistent with *Phillips*.

*Id.*

According to the Petition’s oversimplification of the claims, the only distinguishing feature of the ’716 Patent, relative to a related 11,296,244 Patent (which also relates to user profiles), is that “[t]he ’716 Patent purportedly adds a ‘compatibility’ concept that was already addressed in IPR2024-00786[.]” Pet. 2. In spite of this simplistic characterization of the challenged claims, Petitioner has failed to alert the Board that the “compatibility” term was already construed by the district court in a manner different from how Petitioner interprets it here. Indeed, the Petition

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leaves unexplained its inconsistent positions as to “compatibility,” and offers no alternative invalidity arguments based upon the district court's construction.

Moreover, these “compatibility” terms are not only found in each of the challenged claims of the '716 Patent, as described above, but were also cited by Patent Owner as distinguishing features to traverse prior art rejections during prosecution. EX1020, at 1198. The clarifying amendments made by Patent Owner, following the Examiner's Section 102 rejection of all pending claims, expressly included these compatibility terms:

17. **(Currently amended)** A cloud-based system including one or more data centers, and each data center of the cloud-based system includes one or more servers, wherein some of said one or more servers have program instructions for enabling connections with vehicles and providing services to vehicles, wherein one service includes enabling access to settings associated with profiles of user accounts of the cloud-based system, comprising:

- a server for receiving a request from a vehicle to access a profile for a user account, the request identifies user information related to a user;
- a server for processing at least part of the user information to verify the access, the profile having a plurality of settings of the user preferred for the vehicle having a vehicle type, at least part of the plurality of settings of the profile being stored on storage accessible to said one or more servers; and
- a server for transferring, upon verification of the user information and based on determining settings that are compatible, by said server, for said vehicle type, one or more settings of the plurality of settings to the vehicle, the transferring is configured to instruct software and hardware associated the vehicle to enable said one or more settings on [[one]] the vehicle for customizing said vehicle for the user, the request and the transferring being via wireless communication of said vehicle.

*Id.*, at 1192 (current claim 1), 1194 (current claim 7).

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Undercutting the alleged merits of its challenges, Petitioner not only fails to alert the Board of the district court’s specific “compatibility check” construction, but also fails to apply that compatibility check construction in any of its challenges. For example, rather than point to any reference whose server conducts a “check” for compatibility based on *vehicle type*, the Petition relies on primitive disclosures in which a server pulls settings that already correspond to a selected vehicle, i.e. settings that are specific to an individual vehicle without regard to the vehicle’s type:

In the end, despite EA drafting the claims of the ’716 Patent with knowledge of the Board’s institution findings in the ’244 IPR and ’268 IPR, the ’716 Patent merely combines elements the Board already considered in instituting those IPRs—*Rector* and *Kleve* (server/profile/settings/verification/transfer pathway), *Xiao* or *Hayashi* (vehicle-specific applicability for the “compatible settings” feature), *Xiao* (server updates based on user vehicle inputs), and *Patenaude* (pattern-based learning engine). The ’716 Patent claims nothing beyond what the Board has already found reasonably likely unpatentable on closely-matched claim language.

Pet. 3. Indeed, the Board already found in related IPR2024-00786 that “Xiao teaches command codes are stored *for specific vehicles* and that those command codes are *already set with the operator’s preferences*.” EX2004, at 76 (emphases added). Notwithstanding Xiao’s “already set” preferences, “for specific vehicles,” the Petition relies on expert testimony to tell the Board that Xiao’s *vehicle-specific* operations allegedly satisfy the claim limitations of the ’716 Patent: the “server generates or retrieves ‘appropriate command codes 632’ corresponding to an

operator’s desired settings and *a particular vehicle.*” EX1004, ¶¶ 102, 104 (“the operator’s desired setting can be achieved using a command code (632) *specific to that automobile*”). This is wrong.

The Petition never points to any disclosure from Xiao that a server determines compatibility / incompatibility of settings for or based on *vehicle type*, let alone that Xiao’s server actually transfers settings “based on determining settings that are compatible [] for said vehicle type” (claim 1[c]) or that, before transferring settings, its “server performs processing to determine incompatibility of ... settings of the user based on a type of the vehicle” (claim 7[c]). Indeed, the Petition acknowledges that Xiao has no such disclosure based on “vehicle type,” as it instead relies on two other references, Rector and Kleve, for alleged disclosure of “vehicle type”:

*Kleve* expressly teaches that vehicles have a “*vehicle type*” that users can request, Ex. 1006, ¶[0087], and *Rector* likewise expressly treats “*vehicle*” as a class with different types (cars, trucks, buses, aircraft, watercraft), satisfying “vehicle having a vehicle type.” Ex. 1005, ¶¶[0028], [0039]; Ex. 1004, ¶149.

Pet. 34. Despite proposing a combination with Rector and Kleve, the Petition fails to argue that Xiao’s server somehow determines the user profile settings compatibility / incompatibility based on “said vehicle type.” Pet. 38-39.

Petitioner provides no reason for advancing a different claim construction before the district court, and these inconsistent claim construction positions alone

would justify discretionary denial. *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)). But here Petitioner takes this error further, because it fails to inform the Board of its own narrowed district court construction and then fails to apply that narrowed construction in its challenges.

Because the Petition did not advise of the Board of the narrower construction and did not include any alternative invalidity arguments based on any narrower claim construction of the “compatibility” claim terms found in all claims of the ’716 Patent, the Board’s consideration of the challenges as presented 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.**

As shown in Section III.A., above, the Petition fails to identify any reference which performs a compatibility check based on vehicle type, relying instead on the individual vehicle-specific operations of Xiao, where “command codes are stored for specific vehicles and that those command codes are already set with the

operator’s preferences.” EX2004, at 76. Moreover, the Petition offers nothing more than conclusory assertions for combining its various references. For example, as shown above, the Petition relies on Rector and Kleve for alleged disclosure of “vehicle type,” i.e., “car, truck, boat, or aircraft,” but purports to combine these disclosures with Xiao, a reference that never even acknowledges these “vehicle types,” let alone teach any server performing a check for compatibility *based on vehicle type*. See Section III.A., above.

Likewise deficient is the Petition’s combination of Xiao and Hayashi, relied upon for Ground 3, which merely rehashes proposed modifications already rejected by the Board as nonsensical in related IPR2024-00786:

In combination with Hayashi, Petitioner contends that Xiao’s database would be modified to include “None” commands. Petitioner’s annotated Figure 6 is provided below:

AUTOMOBILE COMMAND INFORMATION			606
AUTOMOBILE ID	COMMAND ID	COMMAND CODE	632
—	—	—	630
—	—	—	
—	—	—	
1234	Abcd	None	

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Annotated Excerpt of Fig. 6 of Xiao

EX2004, 78; and see Pet. 70-73, citing EX1004, ¶ 282 (relying on same “annotated Figure 6 of Xiao”). The Board reasoned, “Xiao teaches command codes are stored for specific vehicles and that those command codes are already set with the operator’s preferences.” EX2004, at 76. “Contrary to Dr. Almeroth’s testimony and

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Petitioner's position, Xiao's server already does not attempt to command vehicles to do things they cannot do," but instead "generates commands for command codes that exist and are settable in the vehicle." *Id.*, at 78. The Board concluded, therefore, there was no motivation: "why would a POSITA make this modification to store a 'None' command code in Xiao's database when Xiao's database already stores settings that are known to be settable in a specific vehicle per the operator's preferences." *Id.*, at 79-80.

It is readily apparent, therefore, the Petition fails to meet the required threshold for any claim, as the Petition relies on deficient references and nonsensical combinations for at least the "compatibility" / "incompatibility" limitations required of independent claims 1 and 7 (and therefore required by dependency for all challenged claims), and relies on already-rejected modifications for Ground 3. These deficiencies, 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).

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

Petitioner has 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 all thirteen claims of the '716 Patent, all twenty-four claims of U.S. Patent No. 12,337,715, and eleven claims of U.S. Patent No. 11,104,245. EX2010. The Eastern District of Texas 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.” EX2009 (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 Claim Construction Order that undisputedly bears on the claim terms of the challenged '716 Patent. EX2007. Additionally, the parties have already spent substantial resources conducting discovery in *Emerging Automotive v. Toyota/Kia, I*—discovery which all sides have agreed to utilize in the present district court matters. EX2008, ¶¶ 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. Moreover, the parties have submitted a pretrial order and participated in a pretrial conference. *Id.*

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

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

The Petitioner is also a defendant in the parallel district court litigation, which favors discretionary denial. Moreover, all challenged claims are also at issue in the district court proceeding. EX2010. Petitioner's "*Sotera*" stipulation does not fully resolve concerns about overlap, duplicative efforts, and conflicting decisions, since Petitioner can pursue invalidity challenges in district court (1) based on art that is described in a printed publication that could have been raised in the IPR (e.g., same system art) and/or (2) rely 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, Petitioner advances inconsistent claim construction positions in the two proceedings, directly impacting the Board's review of the Petition's merits.

**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, most, if not all, of 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 five of the Petition’s references already considered by the Office, the Examiner also knew of specific art combinations relied upon by Petitioner and knew of Petitioner’s IPRs challenging related patents. Moreover, the Petition has not even argued, let alone demonstrated, any material error.

**A. Each of the Petition’s Five 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 five 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 five references is clearly cumulative over the prior examination.

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Rector, relied on by the Petition for all grounds, was submitted in an IDS, considered by the Examiner, as shown below, and included in two different Examiner searches.

6/9/2011	US20110137520A1	Rector	381
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Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant. Page 10 of 11

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ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /F.M.B/

EX1020, at 2935 (initialed as considered by the Examiner), 1043 (IDS), 981 (August 14, 2024 EAST search), 2902 (February 19, 2025 EAST search). Additionally, the Examiner was aware of IPR2024-00814, which presented unpatentability challenges based on Rector and the specific Rector/Kleve combination relied upon in this Petition. *Id.*, at 1199-1200.

Kleve is used in all grounds of the Petition, and Kleve, too, was submitted in an IDS, considered by the Examiner, and included in an Examiner search. *Id.*, at 2935 (initialed as considered by Examiner), 1043 (IDS), 2908 (February 19, 2025 EAST search). And, like Rector, the Examiner knew of IPR2024-00814, which also relied upon Kleve, and the specific Rector/Kleve combination cited in this Petition. *Id.*, at 1199-1200.

The Xiao reference used by the Petition, patent application publication 2012/0164989 (EX1007), issued as U.S. Patent No. 8,737,913, and includes the same disclosures relied upon by the Petition. EX2003. The Examiner not only

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considered the Xiao patent (EX2003), but also specifically knew of the Xiao patent application publication (EX1007). EX1020, at 2935-36 (initialed as considered by Examiner), 1043-44 (IDS). Indeed, the Examiner was aware of IPR2024-00786, which had relied on Xiao, and specifically relied on the same Xiao/Hayashi and Xiao Patenaude combinations used in this Petition. *Id.*, at 1199-1200.

Patenaude, used in the Petition for Ground 2, was considered by the Examiner (*id.*, at 2935-36), submitted in an IDS (*id.*, at 1043-44), and the Examiner was aware of IPR2024-00786, which had used the specific Xiao/Patenaude combination identified in Ground 2 (*id.* at 1199-1200).

The Hayashi reference, like each of the other four references used in the Petition, was already considered by the Examiner during prosecution. EX1020, at 2936 (initialed as considered by Examiner), 1044 (IDS), 1120-29 (translated document submitted). And, as noted above, the Examiner already knew of IPR2024-00786, and was therefore aware of the specific Xiao/Hayashi combination relied upon here. *Id.*, at 1199-1200. Moreover, the Board already determined that the Petition's specific modifications to Xiao, in view of Hayashi, are nonsensical. EX2004, 76-80; *see* Section III.B., *supra*.

Accordingly, all five of the Petition's references were already considered during the prosecution of the '716 Patent.

**B. Rector, Kleve, Xiao, Patenaude, and Hayashi Were Repeatedly Considered, Though the Examiner Applied Different Prior Art for its 102 Rejection.**

The third *Becton* factor concerns the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection. As shown in Section IV.A., above, the Petition's five references were all considered by the Examiner, however these five references were not applied in the Examiner's rejections. The extent to which the Examiner substantively evaluated the claims is borne out by the variety of substantive rejections and application of identified prior art. Indeed, the examination included: (1) a Section 102 rejection of all pending claims, based on the disclosures of patent application publication US2009/0144622A1 to Evans, titled "On-Board Vehicle Computer System" (EX1020, at 142); (2) a § 112(a) written description rejection (*id.*, at 140-41); (3) a § 112(a) enablement rejection (*id.*); and (4) a non-statutory double-patenting rejection (*id.*, at 139-40). The Applicant explained the missing features in Evans, provided new claims and made "clarifying amendments, reciting among other things, '... a server for transferring upon verification of the user information and based on determining settings compatible for said vehicle type, one or more settings of the plurality of settings to the vehicle ... .' " *Id.*, at 1192 (compatibility amendment to pending claim 17), 1193-96 (new claims), 1197-99 (remarks).

Accordingly, the prosecution history provides a clear indication that the

Examiner thoroughly evaluated the pending claims and considered each of the Petition’s references during that examination. This factor either favors or is neutral as to discretionary denial.

**C. There is Direct Overlap Between the Arguments Made During Examination and the Manner in which Patent Owner Distinguishes the Prior Art.**

The fourth *Becton* factor—the extent of the overlap between the arguments made during examination and the manner in which Patent Owner distinguishes the prior art—favors Patent Owner because Patent Owner distinguished the cited prior art, Evans, and traversed the Examiner’s anticipation rejection, relying in part on the same “compatibility” features missing from each of the references of the Petition. EX1020, at 142; *see also* Sections III.A.-B., IV.B., *supra*.

**D. The Petition Has Not and Cannot Show that the Examiner Committed Material Error Which Warrants 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.

**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 are far from compelling.

## IPR2026-00070 Patent Owner's Request for Discretionary Denial

The Petition depends on individual vehicle-specific server operations (without regard for vehicle type) of Xiao for alleged disclosure of the required compatibility operations based on vehicle type, proposes dubious combinations with a reference that does not even contemplate vehicle type, and for Ground 3, rehashes failed modifications to Xiao in view of Hayashi. *Id.*

The Patent Office's prior consideration of the Petition's references provides both an independent basis for discretionary denial under 35 U.S.C. § 325(d) and provides yet 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**

Petitioner has 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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