

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORP.,
Petitioner,

v.

EMERGING AUTOMOTIVE LLC,
Patent Owner.

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

**EMERGING AUTOMOTIVE LLC'S
PATENT OWNER PRELIMINARY RESPONSE**

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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	Docket Control 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

I. Introduction

First, Petitioner’s inconsistent claim construction positions—involving the “compatible” / “compatibility” claim terms already construed by the district court and directly relevant to the Petition’s failures of proof here—warrants denial of institution. “[P]etitioner [wa]s required to explain why those different positions are warranted,” *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18, at 3 (Director Nov. 5, 2025) (informative) (“*Tesla*”), but failed to even acknowledge, let alone justify those alternative positions in the Petition. Despite the district court’s construction of the terms at issue in each of the challenged claims here, the Petition failed to identify “how the challenged claim is to be construed,” as expressly required by 37 C.F.R. § 42.104(b)(3). Moreover, because the Petition did not advise the Board of the district court’s narrower construction, and did not include any alternative invalidity arguments based on any narrower claim construction of the “compatibility” / “incompatibility” claim terms found in all claims of the ’716 Patent, the Board’s consideration of the challenges as presented risks decisions which are, at best, inconsistent with those of the district court, and at worst, merely advisory.

Second, the Petition does not even remotely satisfy 37 C.F.R. §42.104(b)(4), which requires that the Petition “specify where each element of the claim is found in the prior art patents or printed publications relied upon.” For example, for

independent claim 7, and by dependency, claims 8-13, instead of identifying prior art disclosures for limitation 7[c], the Petition merely refers back to its discussion of other claims—*claims with distinct claim language*—leaving the Board to solve the mystery of where in the reference any relevant disclosures might be found.

7[c]: “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 of the plurality of settings to storage of the vehicle, the transferring is configured to instruct software and/or hardware associated with said electronics of the vehicle to apply said one or more settings to the vehicle for customizing said vehicle to use said one or more settings associated with the profile,”

These limitations are satisfied by *Rector* in view of *Kleve* and *Xiao* for the same reasons as claim 1[c] (*see also* claim 5), incorporated herein. *Id.*, ¶¶207, 218.

Pet. 52. Accordingly, the Petition should be denied for this reason alone.

Third, as explained in more detail below, Petitioner has failed to demonstrate that a POSITA would have been motivated to combine *Rector* and *Kleve* with *Xiao* (Grounds 1, 2 and 3) or to further combine *Rector/Kleve/Xiao* with *Hayashi* (Ground 3), nor has Petitioner offered evidence that a POSITA would have had a reasonable expectation of success in doing so. For example, neither the Petitioner nor its expert ever explains how *Xiao*’s constrained operations, i.e., that *Xiao*’s “server *must* look up or retrieve the appropriate command codes 632 for operation *of a selected vehicle*” (EX2004 (Final Written Decision in IPR2024-00786), at 54)

(emphases added)¹, would somehow be applied to “determine settings that are compatible, by said server, for *said* vehicle type.” This deficiency is readily apparent where Petitioner relies on “said vehicle type” from Rector and Kleve:

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. Nor does the Petition explain why a POSITA would have been motivated to combine Xiao’s “vehicle-specific” operations (Pet. 3) with the “wide variety of vehicle types,” of Kleve and Rector, i.e., “cars, trucks, buses, aircraft, watercraft,” when the Petition never points to any disclosure from Xiao that a server determines compatibility / incompatibility of settings for, or based on, said *vehicle type*. EX1001, claim 1[c] (“determining settings that are compatible ... for said vehicle type”), claim 7[c] (“processing to determine incompatibility ... of settings ... based on a type of the vehicle”).

Equally insufficient is Petitioner’s proposed combination of Xiao and Hayashi, where Petitioner merely rehashes rationale and modifications of Xiao in view of Hayashi which were already summarily rejected by the Board in a related proceeding: “Contrary to Dr. Almeroth’s testimony and Petitioner’s position, Xiao’s

¹ Emphasis herein added unless otherwise noted.

server already does not attempt to command vehicles to do things they cannot,” but instead only “generates commands for command codes that exist and are settable in the vehicle.” EX2004, at 78. Here, too, the Petition begs the same question (but does not answer) posed when the Board previously rejected Petitioner’s theory: “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.” EX2004, at 79-80. Ground 3 of the Petition fails for this reason alone.

Fourth, even if Xiao were somehow properly combined with Rector and Kleve, there is no plausible combination that results in the “transferring” operation “*based on determining settings that are compatible*, by said server, *for said vehicle type*”– which independent claim limitation 1[c] requires. At best, “Xiao discloses a map or mapping to determine the appropriate command codes 632 [] *for a selected vehicle.*” EX2004, at 71. As the Board already found in IPR2024-00786, “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. Because “Xiao’s database *already stores settings that are known to be settable in a specific vehicle* per the operator’s preferences,” and Xiao uses “a map for determining the appropriate command codes 632 [] *for a selected vehicle,*” Xiao’s “server *must* look up or retrieve the appropriate command codes 632 for operation *of a selected*

vehicle.” EX2004, at 53-54, 78, 80. There is no alternative. Xiao’s server only retrieves and generates commands for command codes that are preset as settable in the selected vehicle; there are no settings stored by, retrieved by, let alone determined to be compatible for, *vehicle type*. *See id.*, at 78. Xiao does not disclose or suggest transferring ... based on determining settings that are compatible, by said server, *for said vehicle type.*” EX1001, claim 1[c].

Finally, because Xiao’s server “*must* look up or retrieve the appropriate command codes” for only “*a selected vehicle*” (EX2004, at 54), not for vehicle type, there is likewise no disclosure or teaching that Xiao’s “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*”—as recited by independent claim 7[c]. Indeed, Petitioner’s expert already admitted in the related proceeding that Xiao’s server 118 “would *avoid determining applicable settings that are incompatible* with settings that are settable in the selected vehicle.” EX2004, at 73 (citing IPR2024-00786, EX1009, ¶ 190). The Petition does not even acknowledge, let alone justify this apparent and critical contradiction. Given this self-contradictory admission, Petition’s arguments for claim 7 regarding alleged motivation to combine and reasonable expectation of success are meritless.

Accordingly, for at least these reasons, Patent Owner Emerging Automotive respectfully submits that the Board should deny institution.

II. Overview and claim construction of the '716 Patent.

A. The '716 Patent enables the transferability of user-specific settings based on a server's compatibility check for "vehicle type" or server's incompatibility check based on "vehicle type."

The '716 Patent discloses inventive systems enabling the automatic transfer of user profile settings to vehicles and the employment of a cloud processing system to manage, update, learn from, improve upon, and automatically implement a personalized user experience in vehicles.² EX1001, 1:66-2:15. The personalized user experience is defined by preferences the user sets in a user profile, while achieving the scalability of a server processing, transferring and applying those personalized settings for various vehicle types—supporting a wide range of user preferences and vehicle types by transferring user profile settings *based on* a server performing a compatibility check to determine settings that are compatible for said vehicle type (independent claim 1) / performing an incompatibility check to determine settings

² The '716 Patent properly claims priority to Applications 13/452,881, 61/478,436, 61/745,729, 16/285,706, 13/842,158, 14/987,755, and 16/788,253, with the earliest-filed priority application dated April 22, 2011 (EX1020, at 45-46), and is properly supported under Section 112, as the Examiner found (*id.*, at. 140-41, 1202). Nonetheless, the Petition's entire analysis on effective filing date and priority is completely irrelevant because the Petition fails regardless. Pet. 10-12.

that are incompatible based on vehicle type (independent claim 7). *Id.*, 1:66-2:15, 11:52-65.

For example, independent claim 1[c] of the '716 Patent recites:

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.

Additionally, independent claim 7[c] recites:

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.

These “compatible” / “incompatible” terms are found in each of the challenged claims of the '716 Patent, as recited above, and were also cited by Patent Owner as distinguishing features to traverse prior art rejections during prosecution. EX1020, at 1198. Patent Owner made these clarifying amendments after a Section 102 rejection of all pending claims, expressly including these compatibility requirements (highlighted below):

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); *see also id.*, at 1194-95 (current claim 7):

23. (New) A cloud services system including a server for interfacing with one or more vehicles, comprising:

- the server receives a request from electronics of a vehicle to access a profile for a user account, the request includes an identifier for a user to use the vehicle;
- the server processes data related to the identifier to verify the user for accessing the profile associated with the user account, the profile having a plurality of settings of the user desired for the vehicle, wherein at least part of the plurality of settings for the profile being stored on storage accessible to the cloud services system; and
- 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 of the plurality of settings to storage of the vehicle, the transferring is configured to instruct software and/or hardware associated with said electronics of the vehicle to apply said one or more settings to the vehicle for customizing said vehicle to use said one or more settings associated with the profile,

wherein the vehicle uses wireless communication for exchanging data with the cloud services system and for receiving said one or more settings associated with the profile;

wherein the request is automatically generated by the electronics of the vehicle upon pairing a user device of the user with the electronics of the vehicle;

wherein the server is one or more servers of the cloud services system, the cloud services system is part of one or more data centers used for receiving and sending data to from and to said one more vehicles.

The Petition repeatedly attempts to reduce the claims of the '716 Patent to a mere replication of the '244 Patent (e.g., Pet. 1-3), but even Petitioner acknowledges that the aforementioned "compatibility" operations of the '716

Patent were not recited in any claims of the '244 Patent.³ *Id.*; EX1001, claims 1, 7; EX2013, at 5-7. And because both independent claims recite these specific “compatibility” / “incompatibility” operations, the Petition’s failures as to these operations alone are fatal to all grounds of the Petition. Pet. 4 (showing only ground 1 challenges independent claims 1 and 7).

B. Related District Court and IPR Matters.

1. The '716 Patent’s “compatibility” terms were already construed by the district court.

Patent Owner asserted infringement of the '716 Patent against Petitioner Toyota in the Eastern District of Texas (“*Emerging Automotive v. Toyota/Kia, II*”). EX2010; Pet. 73-74. Previously, in September 2023, Patent Owner filed a patent infringement lawsuit against Petitioner Toyota asserting infringement of U.S. Patent No. 9,171,268 (“the '268 Patent”), a family member of the '716 Patent, along with two other Emerging Automotive patents.⁴ EX2012; Pet. 1, 73-74; EX1017 (U.S.

³ For the related '244 Patent, the Board instituted proceedings in IPR2024-00814 and issued a Final Written Decision finding that all challenged claims of the '244 Patent were shown to be unpatentable. EX2013.

⁴ Emerging Automotive originally asserted U.S. Patent No. 11,296,244 (“the '244 Patent”) in its 2023 patent infringement action against Petitioner Toyota, but

Patent No. 9,171,268). The 2023 proceeding (“*Emerging Automotive v. Toyota/Kia, I*”) was stayed on the eve of trial, following the district court’s summary judgment order on a non-instituted asserted patent. EX2005. In *Emerging Automotive v. Toyota/Kia, I*, fact discovery, expert discovery, claim construction proceedings and a pretrial conference had been completed.⁵ *Id.* The district court issued preliminary constructions noting that the claim limitations reciting compatibility require a “compatibility check” by the server:

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). The Markman Order adopted the plain and ordinary meaning, noting: “The parties agree these claims

subsequently amended the complaint to withdraw the ’244 Patent from the lawsuit. EX2002.

⁵ For the *Emerging Automotive v. Toyota/Kia, II* district court proceedings, the parties agreed to utilize the discovery completed in *Emerging Automotive v. Toyota/Kia, I*. EX2008, at ¶¶ 5, 12(g)-(h).

require a ‘compatibility check.’” EX2007, at 29 (district court claim construction order).

2. The Board confirmed Xiao’s “vehicle-specific” constraints—a finding fatal to all grounds of the Petition.

Regarding the related ’268 Patent, 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 claims of the ’268 Patent were not challenged in the IPR. EX2004, at 83-84.

Like the ’716 Patent challenged here, the ’268 Patent included server operations requiring a determination of compatible settings, however the two patents differ in the specific nature of these compatibility checks. For example, independent claim 10 of the ’268 Patent recited a server performing a compatibility check for a selected vehicle, i.e., determining applicable settings “from the user profile and are compatible with settings that are settable in the selected vehicle.” EX2004, at 6-7.

The Petition oversimplifies the claims of the ’716 Patent, misstating that the only distinguishing feature of the ’716 Patent, relative to the ’244 Patent, is that “[t]he ’716 Patent purportedly adds a ‘compatibility’ concept that was already addressed in IPR2024-00786[.]” Pet. 2. The Petition’s mischaracterization of the challenged claims is belied by the record. First, Petitioner fails to inform the Board

that the “compatibility” operations recited in the ’716 Patent were relied upon by the Applicant in traversing the Examiner’s anticipation rejections, as shown above. EX1020, at 1192, 1194-95. Second, by pointing to what the Board’s *Institution Decision* “already addressed in IPR2024-00786,” Petitioner misapprehends both the law and the evidence. Pet. 2.

The law is clear that “the Board is not bound by any findings made in its Institution Decision,” as “the Board is considering the matter preliminarily without the benefit of a full record.” *TriVascular v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016). More fundamentally, in contrast to the challenged claims in IPR2024-00786, the independent claims of the ’716 Patent each recite a specific type of server compatibility check—“transferring ... based on *determining settings that are compatible*, by said server, *for said vehicle type*” (claim 1[c]), and “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*” (claim 7[c]). EX1001, claims 1, 7; EX2004, at 6-8 (’268 Patent, claims 10, 20). Indeed, none of the “compatibility” operations recited in the challenged claims of IPR2024-00786 had recited a specific compatibility determination based on “*vehicle type*,” nor had the claims challenged in IPR2024-00786 specified any server operation “to *determine incompatible [] settings*.” EX2004, at 6-8; but see EX1001, claims 1[c], 7[c].

In fact, in the Board’s Final Written Decision for IPR2024-00786, issued on the same day the instant Petition was filed (Paper 2; EX2004, at 1), the Board found independent claim 10 of the ’268 Patent unpatentable as anticipated by Xiao—that claim recited, in part, determining settings that “are compatible with settings that are settable *in a selected vehicle*”—while the Board determined that independent claim 20 was “not shown unpatentable.” EX2004, at 83-84. Claim 20 recited, in part, “certain of the user settings are determined to be compatible for use with the vehicle[.]” EX2004, at 6-8.

Accordingly, certain of the Board’s findings in IPR2024-00786 are relevant to these proceedings—e.g. (1) what the Xiao reference does and does not disclose or teach; (2) why Xiao is improperly combined with Hayashi; and (3) like the district court, the Board concluded that the “compatible” terms of the ’268 Patent are construed to require a “compatibility check.” Indeed, what the Board has “already addressed” in its Final Written Decision does not at all aid Petitioner, but in fact reinforces why all grounds herein fail. The “vehicle-specific” operations of Xiao are incapable of, let alone teach, the “*vehicle type*”-based compatibility check of the ’716 Patent claims.

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. The “vehicle-specific” constraints of *Xiao* require, e.g., that its database “stores settings that are *known to be settable in a specific vehicle* per the operator’s preferences” (EX2004, at 80) and its “server *must* look up or retrieve the appropriate command codes 632 for operation *of a selected vehicle*” (*id.*, at 54).

Put simply, the Petition cannot meet its burden because the Board’s prior findings in a Final Written Decision reinforce the failures of the Petition: *Xiao* cannot and does not perform any compatibility check for vehicle type, let alone any incompatibility check based on vehicle type, as the independent claims of the '716 Patent require.

III. Petitioner’s unexplained, inconsistent claim construction positions warrant denial of institution.

Petitioner has taken inconsistent claim construction positions in the district court and in the IPR Petition regarding the “compatibility” terms required of all challenged claims. The Petition should be denied because of Petitioner’s (1) failure to construe the claims, in light of the district court order, as required by 37 C.F.R.

§ 42.104(b)(3); (2) failure to explain Petitioner’s inconsistencies in the two forums, as required by *Revvo Technologies, Inc. v. Cerebrum Sensor Technologies, Inc.*, IPR2025-00632, Paper 20 (Director Nov. 3, 2025) (precedential) (“*Revvo*”), *Tesla*, Paper 18 (informative), and *TikTok, Inc. v. ShopSee, Inc.*, IPR2025-01485, Paper 13 (Director, Jan. 16, 2026) (denying institution where petitioner failed to explain inconsistent claim construction positions); and (3) failure to so much as alert the Board that these terms had already been construed by the district court—leaving it to Patent Owner to provide the evidence that enables the Board to render decisions consistent with its mandate. *See, e.g.*, 83 FR 51340, Docket No. PTO-P-2018-0036, Document No. 2018-22006 (Final Rule directed to “Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board”).

As described above, the district court previously construed the related ’268 Patent’s “compatible” terms, noting that as part of its plain and ordinary meaning construction, the limitations required that the server perform a “compatibility check.” EX2006, at 4 (district court preliminary constructions); EX2007, at 29 (district court claim construction order, giving compatible terms plain and ordinary meaning, noting “The parties agree these claims require a ‘compatibility check.’”). Indeed, Petitioner Toyota advocated a construction for all claims of the ’268 Patent

containing a “compatible” term, specifically proposing the requirement that the server / cloud processing system performs a “compatibility check”:

<p>M. <u>Term 13:</u></p> <p>“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)</p> <p>“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>	
<p>Plaintiff’s Construction</p>	<p>Toyota’s Construction</p>
<p>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.</p>	<p>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</p>

EX2005, at 29.

Here, Petitioner tells the Board that the very same “compatibility concept” of the challenged claims was “already addressed” in the IPR2024-00786 (Pet. 2)—“compatibility” terms for which Petitioner sought construction in district court (EX2005, at 29)—yet inexplicably, Petitioner argues that “no terms require construction for purposes of IPR[.]” Pet. 12. Indeed, in this proceeding, Petitioner gave absolutely no indication that the “compatible” terms had ever been construed in the district court.

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*.

Pet. 12-13.

These unexplained, unjustified omissions and inconsistencies warrant denial of the Petition. The Director’s precedential decision in *Revvo* provides that “when a petitioner takes alternative positions [on claim construction] before the Board and a district court, that petition should, at a minimum, explain why alternative positions are warranted.” *Revvo*, Paper 20 at 3-4. The Director also issued an informative decision in *Tesla*, in which the Petition was denied for failure to sufficiently explain the petitioner’s inconsistent claim construction positions. *Tesla*, Paper 18 at 3-4. Specifically, the Director determined “that petitioner is required to explain why those different positions are warranted,” but had failed to do so. *Id.* at 3 (citing *Revvo*, at 3-5).

Here, not only does Petitioner fail to explain its inconsistent claim construction positions, and fail to alert the Board of the district court’s specific “compatibility check” construction, but also Petitioner fails to apply any “compatibility check” for either claim limitation 1[c] or limitation 7[c]:

iii. **“transferring, [...] based on determining settings that are compatible, by said server, for said vehicle type”**

To the extent claim element 1[c] requires that the server determine compatible/applicable settings for the selected vehicle type, analogous art *Xiao* provides that exact refinement in a cloud pipeline: the server retrieves “appropriate command codes” for the operator’s desired settings based on the automobile ID, then generates and sends only those commands that the target vehicle can execute. Ex. 1007, ¶¶[0103]-[0104] (looking up codes by automobile ID 628 and command ID 630), ¶[0102]. The Board already read *Xiao*’s “appropriate” command codes as teaching “determining ... applicable settings ... compatible with settings that are settable in the selected vehicle.” Ex. 1011, pp. 22-29. Utilizing *Xiao*’s compatibility lookup between *Kleve*’s verification and *Rector*’s transfer/application yields the claimed “based on determining settings that are compatible ... for said vehicle type.” Ex. 1004, ¶¶166-168; see also *supra*, § VI.A.5.

Pet. 38-39 (no mention or application that the server is required to perform a “compatibility check” as applied to claim 1[c]’s transferring operation).

7[c]: **“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 of the plurality of settings to storage of the vehicle, the transferring is configured to instruct software and/or hardware associated with said electronics of the vehicle to apply said one or more settings to the vehicle for customizing said vehicle to use said one or more settings associated with the profile,”**

These limitations are satisfied by *Rector* in view of *Kleve* and *Xiao* for the same reasons as claim 1[c] (see also claim 5), incorporated herein. *Id.*, ¶¶207, 218.

Pet. 52 (no mention or application that the server is required to perform a “compatibility check” as applied to claim 7[c]’s processing operation).

The Petition provided no reason for advancing a different claim construction before the district court, and these unexplained inconsistent claim construction positions alone warrant denial. But here Petitioner took this error further, failing to inform the Board of its own narrowed district court construction and then failed to apply that narrowed construction in its challenges. The Petition's failure to comply with 37 C.F.R. § 42.104(b)(3), and failure to heed the Director's express requirements set forth in *Revvo* and *Tesla*, not only increases the risk of inconsistent decisions across the two forums, but also renders the Board's decision on the Petition's challenges as merely advisory.

For these reasons alone, Institution should be denied.

IV. Claim construction.

Consistent with (1) the district court's construction, (2) the agreed-upon construction proposed by Petitioner in district court, i.e., the construction on which the district court order was based, and (3) the Board's construction in IPR2024-00786—the “compatible” / “incompatible” terms of the '716 Patent, i.e., the operations containing these terms require that the server performs a “compatibility check” / “incompatibility check.” EX2006, at 4 (district court preliminary constructions: “these limitations require a ‘compatibility check’ ...”); EX2007, at 29 (district court claim construction order affirming EX2006); *see also* EX2004, at 12-21 (finding limitation 10[c] of the '268 patent “requires a compatibility check

as part of the server’s determination of applicable settings”); *see also* EX2005, at 29 (Toyota’s proposed construction requires the server perform “a compatibility check”). Like the plain language of claim 10 of the ’268 Patent, the plain and ordinary meaning of the limitations set forth in claims 1[c] and 7[c] require the server perform a “compatibility check.”

V. All Grounds fail because Petitioner has failed to show that it is more likely than not that any reference, alone or in combination, teaches or suggests the limitations of independent claim 1[c] or independent claim 7[c].

The Petition is insufficient to meet even a *prima facie* showing under 35 U.S.C. § 103, and Petitioner’s failures to satisfy independent claim elements 1[c] and 7[c] are fatal to all grounds of the Petition. Pet. 4 (only ground 1 challenges independent claims 1 and 7).

A strong petition does not rely on three distinct references, plus expert testimony, when trying to satisfy a single claim limitation. Bearing this out, the Petition’s arguments that Rector, Kleve, Xiao and Dr. Almeroth’s conclusory testimony allegedly render obvious independent claim limitations 1[c] and 7[c] are, in fact, weak. *See, e.g.*, Pet. 38-39:

iii. **“transferring, [...] based on determining settings that are compatible, by said server, for said vehicle type”**

To the extent claim element 1[c] requires that the server determine compatible/applicable settings for the selected vehicle type, analogous art *Xiao* provides that exact refinement in a cloud pipeline: the server retrieves “appropriate command codes” for the operator’s desired settings based on the automobile ID, then generates and sends only those commands that the target vehicle can execute. Ex. 1007, ¶¶[0103]-[0104] (looking up codes by automobile ID 628 and command ID 630), ¶[0102]. The Board already read *Xiao*’s “appropriate” command codes as teaching “determining ... applicable settings ... compatible with settings that are settable in the selected vehicle.” Ex. 1011, pp. 22-29. Utilizing *Xiao*’s compatibility lookup between *Kleve*’s verification and *Rector*’s transfer/application yields the claimed “based on determining settings that are compatible ... for said vehicle type.” Ex. 1004, ¶¶166-168; see also *supra*, § VI.A.5.

See also Pet. at 52:

7[c]: “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 of the plurality of settings to storage of the vehicle, the transferring is configured to instruct software and/or hardware associated with said electronics of the vehicle to apply said one or more settings to the vehicle for customizing said vehicle to use said one or more settings associated with the profile,”

These limitations are satisfied by *Rector* in view of *Kleve* and *Xiao* for the same reasons as claim 1[c] (see also claim 5), incorporated herein. *Id.*, ¶¶207, 218.

Rather than point to any reference whose server conducts a “check” for compatibility / incompatibility based on *vehicle type*, as claim 1[c] (“for said vehicle type”) and claim 7[c] (“based on a type of the vehicle”) require, the Petition

relies on primitive disclosures from the Xiao reference, which “teaches command codes are stored *for specific vehicles* and that those command codes are *already set with the operator’s preferences*.” EX2004, at 76. Xiao’s system is, in fact, constrained by the selected vehicle’s preset preferences. That is, “Xiao discloses that the server *must* look up or retrieve the appropriate command codes 632 *for operation of a selected vehicle*.” EX2004, at 54. Xiao offers no alternative. *See id.*

And even Petitioner’s expert agrees that Xiao’s “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*”). 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. This is wrong.

The Petition never points to any disclosure from Xiao that a server determines compatibility or 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]). EX1001, claims 1, 7.

Only ground 1 challenges the two independent claims of the '716 Patent. Pet.

4. Because the Petition fails to show that Xiao, alone or in combination, teaches or suggests the limitations of independent claims 1[c] or 7[c], all grounds fail.

A. The Petition fails to show that Xiao, alone or in combination, teaches or suggests the limitations of independent claim 1[c].

The Petition fails to present a reasonable likelihood of prevailing as to independent claim 1, and by dependency, claims 2-6, for at least three distinct reasons.

First, Petitioner fails to show a reasonable likelihood of prevailing on claim limitation 1[c] because the alleged “vehicle type” identified by Petitioner to satisfy limitation 1[b] is not the same “vehicle type” that Petitioner identifies in support of limitation 1[c]. The antecedent of claim 1[c]’s “said vehicle type” requires the “vehicle type” to be the same for both limitations. EX1001, claim 1. This deficiency alone is fatal to the Petition’s challenges to claims 1-6. *See, e.g., Activision Blizzard, Inc. v. Milestone Entertainment, LLC*, IPR2025-00713, Paper 15, at 21 (PTAB Oct. 16, 2025) (denying institution because relied upon “game play events” for one limitation were not the same “game play events” Petitioner cites in support of subsequent limitation).

As a second and independent reason why the Petition fails to show a reasonable likelihood of prevailing as to claims 1-6, there is no rationale for a POSITA to combine Rector and Kleve’s “vehicle type”—“pickup truck” (Kleve),

and “cars, trucks, buses, as well as aircrafts and watercrafts” (Rector)—with Xiao, which does not store, look up, retrieve or apply settings by “vehicle type,” let alone by the “vehicle type” identified: “cars, trucks, buses, as well as aircrafts and watercrafts.” Pet. 34, 38-39. Instead, “Xiao discloses that the server **must look up or retrieve the appropriate command codes 632 for operation of a selected vehicle[.]**” EX2004, at 54. The Petition fails to provide sufficient evidence regarding a POSITA’s alleged motivation to combine these disparate disclosures. As detailed below, Petitioner’s and Dr. Almeroth’s conclusory arguments as to what would have been “logical and straightforward” to implement in light of these three references’ disclosures does not remotely meet Petitioner’s burden. *See ActiveVideo Networks, Inc. v. Verizon Commc’ns, Inc.*, 694 F.3d 1312, 1328 (Fed. Cir. 2012) (citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (finding generic statements regarding motivation to combine to be deficient because they “fail[ed] to explain why a person of ordinary skill in the art would have combined elements from specific references *in the way the claimed invention does.*”) (emphasis in original)).

Even if Xiao were properly combined with Rector and Kleve, and even if the Petition’s failure to identify the same “vehicle type” for limitations 1[b] and 1[c] were not fatal to the Petition, the Petition fails regardless. As a third and independent reason why the Petition fails to show a reasonable likelihood of

prevailing as to claims 1-6, Xiao does not teach or suggest any server operation of “transferring ... based on determining settings that are compatible [] for said vehicle type[.]” EX1001, claim 1[c]. Claim 1 is not broadly claiming any compatibility check, but rather one “for said vehicle type,” and the recited transferring operation must be “based on” that specific compatibility check. Xiao teaches neither any capability to perform a compatibility check for “vehicle type,” nor any transferring operation “based on determining settings that are compatible [] for said vehicle type.” See EX1001, claim 1. Accordingly, the Petition’s challenges to claims 1-6 all fail.

1. The constraints of Xiao’s system teach away from any “transferring ... based on determining settings that are compatible, by said server, for said vehicle type.”

As the Board already found in IPR2024-00786, “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. This is because Xiao discloses a system in which an operator creates an account and, at the outset, each of the operator’s system preferences must be separately preset and stored “for each automobile 112 on the account.” EX1007, ¶¶ 65, 69-74. Xiao discloses that these “system preferences,” set by the operator and stored in operator profile information 614, “may contain climate control system preferences for the operator *for each automobile 112 on the account*” (*id.*, ¶ 69), “audio system preferences for the

operator *for each automobile 112 on the account*” (*id.*, ¶ 70), “comfort preferences for the operator *for each automobile 112 on the account*,” (*id.*, ¶ 71) “awareness system preferences for the operator *for each automobile 112 on the account*” (*id.*, ¶ 72), “engine system preferences for the operator *for each automobile 112 on the account*” (*id.*, ¶ 73), or “security system preferences for the operator *for each automobile 112 on the account*” (*id.*, ¶ 74).

Using these preset “system preferences for each automobile 112 on the account,” Xiao’s system can only store, retrieve and relay a command code corresponding to a particular setting that is fixed for a particular vehicle on the account. *Id.*, ¶¶ 69-75. Because the operator must first select an automobile 112 on the account before applying any preset operator preference for *that automobile 112*, Xiao’s server is constrained to look up, retrieve and apply settings only to *that automobile 112* on the account. *Id.*, ¶ 77, Fig. 6; EX2004, at 53-54, 78, 80.

After a specific automobile 112 has been selected “for which to provide the disclosed service for the operator” (EX1007, ¶ 77), the operator can use Xiao’s application 900 to issue command requests to apply only the automobile 112’s preset operator preferences to that selected automobile 112 (*id.*, ¶¶ 95-97). In response to receipt of such command requests, Xiao’s server must look up or retrieve “command codes [] already set with the operator’s preferences.” EX2004, at 76, 54. To do so,

Xiao uses “a map for determining the appropriate command codes 632 [] *for a selected vehicle.*” EX2004, at 53.

As the Board further concluded, “Xiao’s database *already stores settings that are known to be settable in a specific vehicle* per the operator’s preferences.” EX2004, at 53. Therefore, regardless of whether multiple vehicles are on an account, “Xiao discloses that the server *must* look up or retrieve the appropriate command codes 632 for operation *of a selected vehicle,*” and that vehicle must be preselected by the operator using “element 924.” EX2004, at 54.

And when Xiao’s server does “generate” a command, based on the server’s constrained look up operation (e.g., EX2004, at 54 (“must look up or retrieve codes...of a selected vehicle”)), this operation too is vehicle-specific and is nothing more than a relay of the retrieved command code 632 that already corresponds to the vehicle-specific automobile ID and vehicle-specific command ID contained in the command request. EX1007, ¶¶ 100 (upon server receiving “the start engine command request,” and “using the automobile ID 608 and the command ID 630,” server may retrieve “the command code 632 corresponding to the engine start command for the operator’s automobile 112[,] [t]hen *server 118 may transmit the retrieved command code 632 to the automobile 112*”), 101 (“[t]he lock/unlock door command may be generated and communicated to the automobile 112 in a similar manner as discussed above with respect to the start automobile command”), 102

(“automobile service server 118 may look up appropriate command codes 632 based on the automobile ID 627 and on the command IDs 630 ... [t]hen, automobile service server 118 may generate one or more commands based on the retrieved command codes 632”). Accordingly, when the server “generates” a command to be transmitted to the automobile 112 for subsequent programming, the command code retrieved and relayed by Xiao’s server is a foregone conclusion and necessarily vehicle-specific. *Id.*

Xiao’s server only retrieves and generates commands for command codes that are preset as “known to be settable in a selected vehicle per the operator’s preferences” (EX2004, at 80); there are no settings stored by, retrieved by, let alone transferred “based on” a server determining settings to be compatible for, *vehicle type*. *See also* EX2004, at 54, 78.

2. That the Petition points to three different references for a single claim term highlights its failures of proof.

Not only does the Petition rely on three different references for alleged disclosure of a single claim term, the also Petition ignores the antecedent requirements as to that claim term. Indeed, because the Petition fails to show that the identified disclosure for claim 1[c] is the same as the identified disclosure for the *same term* in claim 1[b], Petitioner’s challenges to claims 1-6 all fail.

Claim 1[a] recites a server for receiving a request *from a vehicle* to access a profile for a user account ...”

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;

EX1001, claim 1[a]. Next, for claim limitation 1[b], various terms find their antecedent basis in the limitation 1[a], for example, “the profile” of “the user” and “the vehicle”:

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

EX1001, claim 1[b].

Likewise, for claim limitation 1[c], the recited transferring and determining operations involve the same “the profile having a plurality of settings of the user,” “the vehicle,” and “said vehicle type,” as set forth in the prior limitation:

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 the vehicle for customizing said vehicle for the user, the request and the transferring being via wireless communication of said vehicle.

EX1001, claim 1[c].

Accordingly, limitation 1[c] requires that the server's transferring operation is "based on determining settings that are compatible, by said server, for said vehicle type," referring back to the vehicle type introduced in limitation 1[b]. Therefore, for claim 1[c], not only must Petitioner demonstrate 1[c]'s server operation of "transferring ... based on determining settings that are compatible, by said server, for said vehicle type ...," but also Petitioner must show that the recited "said vehicle type" of claim 1[c] is *the same* "a vehicle type" recited in claim 1[b]. EX1001, claim 1. Moreover, the "transferring" operation—which must be "based on" the server "determining" compatibility "for said vehicle type"—must at least transfer the one or more settings to the vehicle recited in limitation 1[a]. *Id.*

The Petition's mash-up of relied-upon disclosures, from three different references, does not remotely show a reasonable likelihood of prevailing as to claim 1 (and, by dependency, claims 2-6).

For alleged disclosure of the "request from a vehicle" recited by limitation 1[a], the Petition points to Rector's "[s]mart vehicle 100" transmitting a unique identifier to Rector's settings server 130. Pet. 29-31.

For limitation 1[b], however, Rector fails to teach a server processing the recited "user information to verify the access," instead teaching that its "smart vehicle" processes the unique identifier to identify the user. EX1005, ¶¶ 30-31. The Petition proposes a convoluted redesign of Rector's smart vehicle operations with

Kleve's *server* operations, contending: "it would have been obvious to modify Rector's method of controlling driver settings"—wherein each step of this method is performed by Rector's "smart vehicle," not any server (EX1005, ¶ 43, Fig. 3)—"to include Kleve's *server-side* verification for additional security." Pet. 31-34. For alleged disclosure of "vehicle type," as recited in 1[b], the Petition relies on both Rector and Kleve (but not, however, on any disclosure from Xiao):

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.

If, as the Petition argues, claim 1[b]'s "vehicle type" is satisfied by Kleve's "vehicle type requested ... pickup truck request," and Rector's "'vehicle' as a class with different types (cars, trucks, buses, aircraft, watercraft)," the Petition leaves wholly unanswered how Xiao's server is somehow "transferring" settings "based on determining settings that are compatible, by said server, for said "cars" vs. "trucks" vs. "buses" vs. "aircraft" vs. "watercraft." Pet. 38-39, citing EX1006, ¶ at 87 and EX1005, at ¶¶ 28, 39.

Having committed to this identification of "vehicle type," as identified from Kleve and Rector (Pet. 34), the Petition was required to show that the "vehicle type" it identified to satisfy limitation 1[b] was the same "said vehicle type" that

Petitioner cites in support of limitation 1[c]. *See, e.g., Activision Blizzard*, Paper 15 at 21 (“We agree with Patent Owner that Petitioner fails to show a reasonable likelihood of prevailing on this claim limitation because the game play events identified by Petitioner to satisfy limitation [1.a.ii] are not the same game play events that Petitioner cites in support of limitation [1.e].”). Like the Petitioner in *Activision*, Petitioner Toyota likewise fails to show a reasonable likelihood of prevailing on limitation 1[c] for the same reason—Petitioner ignored the antecedent basis required by the claim. *See id.*

Indeed, when trying to put these disparate disclosures together, the Petition falls apart. For example, the Petition’s conclusory statements about Xiao’s “compatibility look up” of “settings that are *settable in the selected vehicle*” do not even intimate how Xiao’s server is somehow *capable of* claim 1[c]’s server operation of “transferring ... based on determining settings that are compatible, by said server,” for **said “cars”** vs. **“trucks”** vs. **“buses”** vs. **“aircraft”** vs. **“watercraft,”** as identified by the Petition for claim 1[b], let alone provide any teaching thereof. Pet. 34, 38-39. Petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements,” but must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). Whether or not Xiao’s server can pull settings that are

already known to be “compatible with settings that are settable *in a selected vehicle*” only begs the question of how Xiao allegedly teaches “determining settings that are compatible, by said server,” for said “cars” vs. “trucks” vs. “buses” vs. “aircraft” vs. “watercraft.” Pet. 34, 38-39. The Petition leaves this glaring inconsistency wholly unexplained.

These failures of proof are enough to doom the Petition’s challenges to claims 1-6. But the mystery of how the Petition’s combination allegedly satisfies claim 1 does not end there. The Petition also leaves unanswered the question of how or why (*see* section IV.A.3., *infra*) a POSITA would be motivated to modify Rector’s server transmitting permitted settings to Rector’s smart vehicle “based on” determining settings that are compatible for “cars” vs. “trucks” vs. “buses” vs. “aircraft” vs. “watercraft.” Pet. 37-39. Also unexplained is why a POSITA would look to Xiao, when there is no identified disclosure that Xiao is even capable of such operations.

The Petition does not fulfill its basic obligations under 37 C.F.R. §42.104(b)(4), nor does it offer a *prima facie* showing of obviousness. For this reason alone, the Petition’s challenges to claims 1-6 all fail.

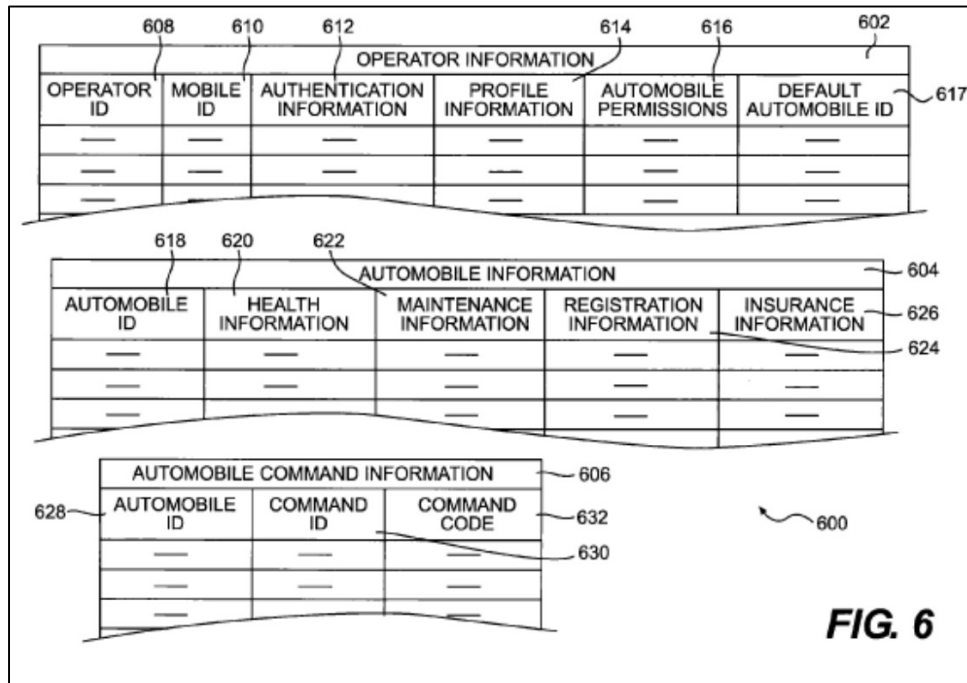
3. Xiao's constrained server operations demonstrate the flaws in the Petition's motivation to combine and alleged reasonable expectation of success.

In contrast to the '716 Patent's transferring / processing operations based on determining settings that are *compatible based on vehicle type*, Xiao is directed to storage and retrieval of preset command codes corresponding to "settings that are known to be settable in a specific vehicle per the operator's preference." EX2004, at 80. Indeed, the Board already determined that Xiao's "server *must* look up or retrieve the appropriate command codes 632 for operation *of a selected vehicle*" (EX2004, at 54, citing EX1007, at ¶ 103) and Xiao only "generates commands for command codes that exist and are *settable in the vehicle*" (EX2004, at 78).

Xiao's system does not contemplate compatibility of settings for, or based on, vehicle type. Instead, Xiao discloses a system in which an operator creates an account, identifies each automobile 112 on the account, and requires that each of the operator's system preferences must be separately preset and stored "for each automobile 112 on the account." EX1007, ¶¶ 69-72. Using these preset "system preferences for each automobile 112 on the account," Xiao's system can only store, retrieve and relay a command code corresponding to a particular setting that is fixed for a particular vehicle on the account. *Id.*, ¶¶ 69-75.

Indeed, Xiao "already stores settings that are known to be settable in a specific vehicle per the operator's preferences" (EX2004, at 80), begging the question how

Xiao's server *could* conduct a compatibility check for settings that are compatible for vehicle type. Rather, as the Board already determined, "Xiao teaches *command codes are stored for specific vehicles* and that those command codes are *already set with the operator's preferences.*" EX2004, at 76-77, citing EX1007, Figure 6:



EX1007, Fig. 6. In this way, Xiao's system ensures each of the operator's system preferences is fixed to a specific *automobile 112* on the operator's account. *Id.*; see also *id.*, ¶¶ 77 (each system preference corresponds to "a default automobile 112 for which to provide the disclosed wireless key service"), 103 (server will "retrieve" and "look up appropriate command codes 632 based on *the* automobile ID 627 and on *the* command IDs 630 associated with the operator's desired system settings 614"); EX2004, at 54, 76, 78.

Indeed, Petitioner’s expert reinforces Xiao’s constrained, vehicle-specific operations, describing Xiao’s “concept of compatibility of certain settings” as always fixed to a particular vehicle:

102. *Xiao* demonstrates the concept of compatibility of certain settings by disclosing “appropriate command codes” being sent to appropriate automobile modules. *Id.*, ¶¶ [0103]-[0104]. *Xiao* explains its server generates or retrieves “appropriate command codes 632” corresponding to an operator’s desired settings and a particular vehicle. *Id.*, ¶ [0103]. For example, Fig. 6 (shown below) includes a table of command code information 606 with entries for each of an automobile ID 628, a command ID 630 (which is “associated with the operator’s desired system settings 614”), and an appropriate command code 632. *Id.* These command codes 632 are “associated with each command that may be issued to the automobile 112.” *Id.*, ¶¶ [0088], [0103]. By listing them in the table of automobile command code information 606, *Xiao* shows that there are particular settings compatible with particular automobiles and particular desired settings.

EX1004, ¶ 102. Dr. Almeroth even specifies that each command code, retrieved by Xiao’s server, is only a “specific code or instruction” that may be “executed by a module [] aboard *the automobile 112*[.]” *Id.*, at ¶¶ 103-104:

103. Thus, *Xiao* demonstrates the necessarily present characteristics that certain settings (*e.g.*, commands) are compatible (or incompatible) with certain automobiles.

104. As an illustration, for an automobile having automobile ID 628, the operator's desired setting can be achieved using a command code (632) specific to that automobile. *Id.* *Xiao* explains that "command code 632 may be a specific code or instruction that may be broadcast on automobile network 420 and executed by a module 402-418 aboard the automobile 112 to cause the module 402-418 to perform the desired function." *Id.*, ¶ [0088]. "For example, command codes 632 may be CAN bus codes or other codes provided by the manufacturer of automobile 112 and/or the manufacturer of the automobile systems for controlling the systems to perform various functions." *Id.*

Dr. Almeroth further affirms that *Xiao*'s server is "performing a vehicle-specific command lookup" by "automobile ID" and is constrained to generate "only the commands the target vehicle can execute." *Id.*, at ¶ 168:

168. *Xiao* is also reasonably pertinent to at least one problem faced by the inventors of the '716 patent. The '716 patent identifies the problem of cloud-side determination of settings that are "compatible ... for [a] vehicle type" before transfer, and of applying those settings wirelessly from data-center servers. Ex. 1001, 7:16-21; 13:10-11; 35:42-43. *Xiao* addresses that same problem by performing a vehicle-specific command lookup keyed by model/year ("automobile ID") and generating only the commands the target vehicle can execute, then transmitting those settings/commands to the vehicle for application. Ex. 1007, ¶¶ [0086]-[0088], [0103]-[0104].

Accordingly, Dr. Almeroth's own characterization of *Xiao* makes clear that all command codes and commands are preset in *Xiao*'s Figure 6 tables according to a

certain pre-selected automobile. *Id.* And, as the Board already found, “if there is no corresponding automobile setting, then Xiao’s server would not list those command codes for retrieval.” EX2004, at 79.

Xiao’s vehicle-specific constraints notwithstanding, Petitioner’s expert makes the inexplicable combination of applying Xiao’s database, where “*command codes are stored for specific vehicles* and [] those command codes are *already set with the operator’s preferences*” (EX2004, at 76-77, citing EX1007, Figure 6), to a POSA’s ‘understanding’ that “settings for a car, truck, or bus would not be appropriate for (and likely not compatible with) an aircraft or watercraft.” EX1004, ¶ 119; Pet. 24-26. Petitioner’s cited expert testimony merely offers the conclusory assertion that “[i]t would have been logical and straightforward for a POSA to implement instructions in a server that is verifying and retrieving settings from a vehicle to also confirm that only settings compatible with the specific recipient vehicle type are delivered.” EX1004, ¶ 119.

But of course, Xiao does not discuss any of this. Petitioner’s expert identifies no disclosure from Xiao as objective support for his conclusion, and does not explain how or why, given the constraints of Xiao’s database and its server, a POSITA would apply Xiao to Rector’s “wide variety of vehicle types” to allegedly distinguish among settings for a car, versus settings for a truck, versus settings for a bus, or an aircraft or a watercraft. *Id.* Xiao never discusses a look up or retrieval of command

codes for vehicle type, let alone any transfer operation based on a server determining settings that are compatible for or based on vehicle type. EX1007. Instead, as the Board already concluded, Xiao’s “server must look up or retrieve the appropriate command codes 632 for operation *of a selected vehicle*” (EX2004, at 54)—not leaving room for any operation that somehow determines “settings for a car, truck, or bus would not be appropriate for (and likely not compatible with) an aircraft or watercraft” (EX1004, ¶ 119).

Neither Petitioner nor Dr. Almeroth explain why a POSITA would have been motivated to combine the references to “confirm that only those settings compatible with the identified vehicle type are delivered” (*see id.*; Pet. 24-25), where, as the Board determined, (1) “Xiao teaches *command codes are stored for specific vehicles* and that those command codes are *already set with the operator’s preferences*” (EX2004, at 76-77), (2) Xiao’s “server *must* look up or retrieve the appropriate command codes 632 for operation *of a selected vehicle*” (EX2004, at 54), and even Petitioner’s expert agrees Xiao is constrained to be “vehicle-specific,” and generate “only commands the target vehicle can execute” (e.g., EX1004, ¶¶ 168, 102-104, 119; Pet. 2).

Wholly absent from the Petition is any explanation why such a modification would have been obvious, or why a POSITA would have combined elements from Rector, Kleve and Xiao in the way claim 1 does. *TQ Delta, LLC v. CISCO Sys., Inc.*,

942 F.3d 1352, 1360 (Fed. Cir. 2019) (“We rejected [the expert’s] testimony because it ‘fail[ed] to explain why a person of ordinary skill in the art would have combined elements from specific references *in the way the claimed invention does.*’ We explained that ‘[k]nowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references.’” (citations omitted)). Accordingly, the Petition fails to provide sufficient evidence regarding a POSITA’s alleged motivation to combine Xiao with Rector and Kleve. *See Am. Airlines, Inc. & SW Airlines Co. v. Intellectual Ventures*, IPR2025-01055 Paper 11, at 18-19 (PTAB Nov. 21, 2025) (denying institution where motivation to combine insufficiently explained, finding “such conclusory, unsupported assertions by Petitioner’s declarant little or no weight”); *see also ActiveVideo Networks*, 694 F.3d at 1328 (citing *KSR*, 550 U.S. at 418).

The Petition further fails to point to anything in Xiao that would have given a POSITA a reasonable expectation of success in modifying Rector and Kleve in view of Xiao to allegedly obtain the recited “transferring ... based on determining settings that are compatible, by said server, for said vehicle type.” *Endo Pharm., Inc. v. Actavis LLC*, 922 F.3d 1365, 1373 (Fed. Cir. 2019); Pet. 24-25. Here again, the Petition leaves unexplained how Xiao would be successfully applied to the recited “vehicle type” of Rector and Kleve to determine “settings for a car, truck, or bus would not be appropriate for (and likely not compatible with) an aircraft or

watercraft.” EX1004, ¶ 119. Nor has Petitioner shown applying Xiao’s teachings to the “wide variety of vehicle types,” as taught in Rector, would lead to predictable results (or that such results would teach limitation 1[c]). *Id.*; Pet. 24-25.

4. Petitioner has not even explained Xiao’s alleged *capability* of “transferring ... based on determining that settings are compatible for said *vehicle type*,” let alone any teaching thereof.

Even if the Petition’s failure to recite the same disclosures for the “**vehicle type**” recited in limitations 1[b] and 1[c] were not fatal to its challenges to claims 1-6, and even if Xiao were properly combined with Rector and Kleve, the obviousness challenges fail regardless because the Petition has not identified any teaching or suggestion in Xiao of a server “transferring ... based on determining settings that are compatible [] for said vehicle type.” Pet. 38-39; EX1001, claim 1[c]. Instead, recognizing the constraints of Xiao, Petitioner resorts to misstating the claim language. At the outset of its scant analysis of claim 1[c], the Petition alleges that “claim element 1[c] requires that the server determine compatible/applicable settings for the *selected* vehicle type.” Pet. 38; *see also* Pet. 26 (“compatible with the *selected* vehicle type”). This is wrong.

Claim 1 has no mention of “applicable settings” nor anything that is “selected,” let alone any “selected vehicle type.” EX1001, claim 1. Rather, the specific compatibility check, on which claim 1[c]’s “transferring” operation must be

“based,” is “for said vehicle type.” *Id.* Without the Petition’s misstated claim language, there is absolutely no connection between the Petition’s identified disclosures and the specific “transferring” operation recited by claim 1[c]. Pet. 38-39. Instead, as shown in Sections IV.A.2-3., above, the Petition relies on conclusory testimony of its declarant, which merely repeats the Petition’s conclusory statements, without any explanation as to how Xiao teaches or suggests “transferring ... based on determining settings that are compatible ... for said vehicle type.” Pet. 38-39, citing EX1004, ¶¶166-168. Such reliance on conclusory testimony is deficient. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, at 16 (PTAB Aug. 24, 2022) (designated precedential Feb. 10, 2023) (citing *KSR*, 550 U.S. at 421 (finding reliance on conclusory and unsupported declaration testimony to be “particularly problematic” where it attempts to “supply a limitation missing from the prior art”); *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1366 (Fed. Cir. 2016) (finding that a missing a claim limitation cannot be determined obvious based on “conclusory statements and unspecific expert testimony”).

More fundamentally, as shown in Section IV.A.3. above, neither Petitioner nor its expert even explains how Xiao *could* transfer any settings “based on determining settings that are compatible, by said server, for said vehicle type.” Pet. 38-39, citing EX1004, ¶¶166-168. Because “Xiao teaches *command codes are stored for specific vehicles* and that those command codes are *already set with the*

operator's preferences" (EX2004, at 76-77), and because Xiao's "server *must* look up or retrieve the appropriate command codes 632 for operation *of a selected vehicle*" (EX2004, at 54), there is no reason to believe that it can do so, let alone any showing thereof. In sum, the Petition does not identify any teaching or suggestion in Xiao of "determining settings that are compatible for or based on vehicle type," nor does the Petition identify any transferring operation from Xiao that is based on this "vehicle type" compatibility check. Accordingly, the Petition fails to show any reasonable likelihood of prevailing on its obviousness challenges to claims 1-6.

B. The Petition fails to demonstrate a reasonable likelihood of prevailing as to claims 7-13—there is no showing that any reference, alone or in combination, teaches or suggests independent claim limitation 7[c].

The incompatibility check of claim 7 is specific. Claim limitation 7[c] recites that "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*" EX1001, claim 7[c]. While the Petition relies on the same conclusory deficiencies which were previously cited in its challenge of claim 1 (Pet. 52), Petitioner fails to meet its burden as to independent claim 7 for at least four reasons.

First, the Petition fails to “specify where each element of the claim is found in the prior art patents or printed publications relied upon” as required by 37 C.F.R. § 42.104(b)(4). On this basis alone, the Petition’s challenges to claims 7-13 all fail.

Second, Petitioner’s expert already testified that Xiao’s server 118 “would avoid determining applicable settings that are incompatible ...” EX2004, at 73, quoting IPR2024-00786, EX1009, at ¶ 190. This admission is fatal to the Petition’s argument that Xiao allegedly teaches the “processing to determine incompatibility” operation recited by claim 7[c]. EX1001, claim 7.

As a third distinct and independent basis for the Petition’s failure of proof as to independent claim 7, the Petition fails to show that Xiao is properly combined with Rector and Kleve, suffering from at least the same deficiencies as detailed above in Section IV.A.2.

Lastly, the Petition fails to present a reasonable likelihood of prevailing on any challenge to claims 7-13 because Petitioner fails to identify any disclosure from Xiao, or Xiao in combination with any other reference, teaching or suggesting the recited “*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*” EX1001, claim 7[c]. The Petition never even attempts to explain how Xiao’s server allegedly performs the recited function of “processing to determine incompatibility ... of

settings,” let alone show the specific incompatibility check “based on a type of the vehicle.” *Id.*

Each of these bases is sufficient on its own to show that the Petition has not met its burden as to independent claim 7, and, by dependency, claims 8-13.

1. Petitioner’s failure to comply with 37 C.F.R. § 42.104(b)(4) is fatal to the Petition.

Petitioner completely ignores its obligations under 37 C.F.R. § 42.104(b)(4). For alleged obviousness of claim limitation 7[c], the Petition directs the Board to “the same reasons as claim 1[c] (see also claim 5),” but neither claim 1[c] nor claim 5 recites the same claim language as claim 7[c]. Pet. 52; *but see* EX1001, claims 1, 5, 7. For example, at a minimum, neither claim 1[c] nor claim 5 recites the server operation to “perform[] processing to determine incompatibility of one or more ... settings of the user based on a type of the vehicle ...” EX1001, claim 7[c]. Accordingly, by its cursory reference to claims 1[c] and 5, the Petition does not “specify where each element of the claim is found in the prior art patents or printed publications relied upon” (37 C.F.R. § 42.104(b)(4)), but instead demands that the Board somehow figure it out from Petitioner’s obscure clues:

7[c]: “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 of the plurality of settings to storage of the vehicle, the transferring is configured to instruct software and/or hardware associated with said electronics of the vehicle to apply said one or more settings to the vehicle for customizing said vehicle to use said one or more settings associated with the profile,**”

These limitations are satisfied by *Rector* in view of *Kleve* and *Xiao* for the same reasons as **claim 1[c]** (*see also claim 5*), incorporated herein. *Id.*, ¶¶207, 218.

Pet. 52. This is not remotely compliant with 37 C.F.R. § 42.104(b)(4), nor does it afford Patent Owner an opportunity to demonstrate the flaws in this cryptic, circuitous challenge to the claims’ patentability. And contrary to Petitioner’s position, mere color-coding of distinct claim language does not somehow render the terms equivalent. EX1004, ¶ 218 (without explanation, expert’s “color-coded comparison” equates “determine incompatibility” of claim 1[c] with “determining settings that are compatible” of claim 7[c]).

This failure to heed 37 C.F.R. § 42.104(b)(4) is fatal to the Petition’s challenges to claims 7-13.

2. Petitioner’s expert’s admissions demonstrate that the Petition’s challenges to claims 7-13 as baseless.

Claim 7 requires that its server “determine incompatibility of ... settings,” but Petitioner’s expert already admitted that Xiao’s server “*would avoid* determining applicable settings that are incompatible with settings that are settable in the selected vehicle ... potentially resulting in unexpected and/or undesired

vehicle configurations or errors.” EX2004, at 73, quoting IPR2024-00786, EX1009 at ¶ 190:

used to identify a particular automobile command”). With such information, server 118 would determine applicable settings that are compatible with settings that are settable in the selected vehicle but would avoid determining applicable settings that are incompatible with settings that are settable in the selected vehicle, ensuring that server 118 does not attempt to command vehicles to do things they cannot do, potentially resulting in unexpected and/or undesired vehicle configurations or errors. For example, recognizing the heterogeneity of vehicles, one would have been motivated to determine applicable settings (e.g., command codes) that are compatible with settings that are settable in the selected vehicle but would avoid determining applicable settings that are incompatible with settings that are settable in the selected vehicle, ensuring that *Xiao*’s server 118 does not attempt to command vehicles to do things they cannot do, potentially resulting in unexpected and/or undesired vehicle configurations or errors. Avoiding such undesirable

Here, Dr. Almeroth’s testimony is fatal to the Petition. Petitioner never explains how, *on the one hand*, *Xiao*’s server operations allegedly satisfy both claims 1[c] and 7[c] because it “determine[es] applicable settings that are compatible with settings that are settable in the selected vehicle” (Pet. 38-39 (challenge to claim 1[c]); Pet. 52), while *on the other hand*, *Xiao*’s server “**would avoid determining applicable settings that are incompatible** with settings that are settable in the selected vehicle.” Petitioner’s expert appears to ignore the fact that claim 7[c] recites a specific processing operation to “**determine incompatibility ... of settings ...**”

EX1004, ¶ 218; *but see, e.g.*, EX1001, claims 1[c], 7[c]. Nor does the Petition explain how the same server operation can satisfy both of these distinct claim limitations while at the same time “*avoid* determining applicable settings that are incompatible...” Pet. 52. Indeed, the Petition does not even acknowledge, let alone justify, this apparent contradiction.

Just as it is not for the Board to solve the mystery of where the relevant disclosures are to be found in the prior art for claim limitation 7[c] (Pet. 52), it is likewise not the job of the Board to resolve the Petition’s internal contradictions.

Petitioner’s expert’s self-contradictory arguments for claims 1[c] and 7[c] are fatal to each of the Petition’s challenges to claims 7-13.

3. As with claim 1[c], Xiao’s constrained server operations demonstrate the flaws in the Petition’s motivation to combine and alleged reasonable expectation of success for claim 7[c].

Petitioner fails to meet its burden in showing any motivation to combine Xiao with Rector and Kleve, and further fails to show any reasonable expectation of success, for at least the same reasons set forth in Sections IV.A.3.-4., above. Pet. 52 (relying on claim 1[c] analysis for claim 7[c]). Moreover, if anything is proven by Petitioner’s expert testimony cited above in Section IV.B.2, it is that a POSITA *would not* be motivated to combine Xiao with Rector and Kleve and *would not* have had a reasonable expectation of success in modifying Rector and Kleve in view of

Xiao to allegedly obtain the recited “processing to determine incompatibility ... of settings ... based on a type of a vehicle.” EX1001, claim 7[c].

Because Petitioner’s expert testified that Xiao’s server allegedly satisfies claim 1[c]’s “determining settings that are compatible ... for said vehicle type” merely by “determining applicable settings that are settable *in the selected vehicle*” (it does not), it cannot also be true that Xiao’s server can satisfy the “*determine incompatibility* ... of settings ... based on a type of the vehicle,” since the expert testified that Xiao’s server “*would avoid determining applicable settings that are incompatible* with settings that are settable in the selected vehicle[.]” EX2004, at 73, quoting IPR2024-00786, EX1009, ¶190.

At bottom, Petitioner fails to point to any explanation, supported by evidence, that shows a POSITA would have been motivated to combine Xiao with Rector and Kleve. Pet. 52, 24-26. Neither the Petition nor the expert’s conclusory statements are supported by evidence. *Id.*; *see also* Sections IV.A.1.-3., IV.B.2. For example, neither Petitioner nor its expert points to any teaching in Xiao that it is even capable of “determin[ing] incompatibility of settings,” let alone that its system actually performs such an operation “based on a type of the vehicle.” Pet. 52. Yet somehow, the Petition demands that the Board accept the conclusory statement that Xiao would be combined with the other references “to ensure only support features are applied across different vehicle types” *Id.*; EX1004, ¶ 207. *See Xerox Corp.*

v. Bytemark, Inc., IPR2022-00624, Paper 12, at 2, 5 (PTAB Feb. 10, 2023) (“Board was correct in giving little weight to Petitioner’s expert because the expert declaration merely offered conclusory assertions...and repeated, *verbatim*, Petitioner’s conclusory arguments.”).

Similarly, Petitioner fails to identify any disclosure in Xiao that would have given a POSITA a reasonable expectation of success in modifying Rector and Kleve in view of Xiao to allegedly obtain the recited functionality of claim 7[c]: “the server performs processing to ***determine incompatibility*** ... of settings of the user ***...based on a type of the vehicle***[.]” EX1001, claim 7[c]; Pet. 52, citing EX1004, ¶¶ 207, 218. And given Dr. Almeroth’s admission that Xiao’s server “would avoid determining applicable settings that are incompatible ...,” even Petitioner’s expert has no expectation of success. *See* Section IV.B.2., *supra*.

Here, Petitioner’s arguments and evidence regarding the alleged motivation to combine Rector and Kleve with Xiao fall far short of meeting its burden. And, in light of the expert’s admission of what Xiao’s server ***would avoid***, there is no reason to believe a POSITA would have had a reasonable expectation of success in doing so.

4. **Petitioner has not even explained Xiao’s alleged *capability* to “perform processing to determine incompatibility ... of settings ... *based on a type of vehicle*,” let alone any teaching thereof.**

As with claim 1[c], the Petition’s asserted combination of Rector, Kleve, Xiao (and Dr. Almeroth’s testimony) fails to identify any disclosure which teaches or suggests the recited claim limitation: the server “processing to determine incompatibility of settings based on a type of vehicle.” EX1001, claim 7[c]; Pet. 52. Therefore, even if the Petition had complied with 37 C.F.R. § 42.104(b)(4) to specify the alleged prior art disclosures which allegedly satisfy claim 7[c] (it did not), even if Dr. Almeroth’s self-contradictory testimony did not already condemn the Petition’s showing of Xiao’s alleged “processing to determine incompatibility ... of settings” (it does), and even if Xiao were properly combined with Rector and Kleve (it is not), the Petition’s arguments for claim 1[c] and claim 5 still do nothing to fill the Petition’s evidentiary gaps for limitation 7[c]. Pet. 52.

As detailed in Section IV.A.3., *supra*, the Board has determined 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. The Board has also concluded that Xiao’s “server *must look up or retrieve the appropriate command codes 632 for operation of a selected vehicle.*” EX2004, at 54. There is no alternative. Despite these undisputed constraints of Xiao’s system, Petitioner’s

expert contends that the *absence* of a stored command code for a desired setting actually means that Xiao's server "identifies" *that non-existent setting* as incompatible for that vehicle type. EX1004, ¶ 207. Of course, Xiao does not discuss or suggest any of this, Petitioner's expert offers no disclosure from Xiao as objective support for this conclusion, and, as shown above, neither Petitioner nor its expert declarant offers any explanation as to *how* Xiao's server *could perform* "processing to determine incompatibility ... of settings ... *based on a type of vehicle.*" Pet. 52. Indeed, given the aforementioned storage and server "look up" constraints of Xiao's system, it is evident there is no such disclosure. EX2004, at 76 (Xiao's "command codes *are stored for specific vehicles* and that those command codes are already set with the operator's preferences"); *see also id.*, at 54 (Xiao's "server *must look up or retrieve the appropriate command codes 632 for operation of a selected vehicle*"); *id.*, at 80 ("Xiao's database already stores settings *that are known to be settable in a specific vehicle* per the operator's preferences").

To give credence to the assertion of Petitioner's expert—that the *absence* of incompatible settings in Xiao's tables *proves* its server "identifies" these non-existent, unmentioned incompatible settings—is to turn the law of obviousness on its head. In any event, Petitioner's expert already testified Xiao does not do so—

Xiao’s server “would avoid determining [] settings that are incompatible[.]”
EX2004, at 73, quoting IPR2024-00786, EX1009, ¶190.

Because claims 1 and 7 are the sole independent claims of the ’716 Patent, and each of Petitioner’s grounds builds on the Rector-Kleve-Xiao combination—a combination which does not show the limitations requiring the server’s determination of compatibility/incompatibility of settings based on vehicle type—all grounds of the Petition fail.

VI. Ground 3 fails because the Petition relies on the same flawed motivation to combine Xiao and Hayashi, which the Board already rejected.

The Petition’s combination of Xiao and Hayashi, relied upon for ground 3, merely rehashes the same proposed modifications to Xiao that the Board already rejected as nonsensical in its Final Written Decision in IPR2024-00786. EX2004, at 79-80. Indeed, the Petition even reproduces the same “annotated excerpt of Fig. 6 of Xiao,” which was flatly rejected by the Board:

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		
AUTOMOBILE ID	COMMAND ID	COMMAND CODE
—	—	—
—	—	—
—	—	—
1234	Abcd	None

628

606

632

630

1234

Abcd

None

Annotated Excerpt of Fig. 6 of *Xiao*

EX2004, at 78; *and see* Pet. 70-73, citing EX1004, ¶ 282 (relying on same “annotated Figure 6 of Xiao”):

AUTOMOBILE COMMAND INFORMATION		
AUTOMOBILE ID	COMMAND ID	COMMAND CODE
—	—	—
—	—	—
—	—	—
Abcd	1234	None

628

606

632

630

Annotated Fig. 6 of Xiao

In rejecting Petitioner’s proposed modification of Xiao in view of Hayashi, 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 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. Accordingly, the Board concluded that the references’ disclosures did not support the modification proposed: “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.

By way of background, Hayashi identifies a problem where a driver “misoperates a vehicle he/she does not normally use,” such as a rental car, but it is

“usually not possible for the driver to check the manual while driving.” EX1013, ¶¶ 2, 4. Hayashi seeks to solve that problem by guiding the driver with “operating instructions” for the functions in the unfamiliar car. *Id.*, ¶¶ 2, 4, 123, 120, Abstract. To do so, Hayashi teaches a comparison of the features of two vehicles: i.e., Hayashi’s system compares the vehicle reserved by a user and a vehicle with which the user is familiar (a vehicle owned or previously rented by the user)—and if the vehicle is an “unfamiliar” one, Hayashi’s system will then identify the functions of the unfamiliar vehicle and compare the vehicle functions with those of a “familiar” vehicle. *Id.*, ¶ 122. Those vehicle functions, Hayashi teaches, are the car’s shift lever, parking brake, etc. *Id.*, ¶ 120. The “operating methods” are instructions for how to use those vehicle functions, such as where to find that shift lever or parking brake in the car. *Id.*, ¶ 122.

If the result of Hayashi’s comparison reveals differences in the functions of the familiar and unfamiliar vehicles, then Hayashi’s “driving support apparatus” provides the driver visual and/or audio instructions for the driver, such as how to engage a parking brake. *Id.*, ¶ 123 (system “graphically depicts the positions of a shift lever, a parking brake, or the like on display portion 250 and guides the operating method thereof by voice.”). Hayashi’s “driving support apparatus” leaves it to the driver to manually follow the visual and audio instructions. *Id.*; *see also id.*, ¶¶ 2, 4, 122 (“The operating method may include information such as the positions

of levers, switches and the like”). Indeed, Hayashi provides no disclosure of user preferences for such functions or any preferred settings for any of these functions. EX1013. Instead, Hayashi provides guidance to a driver on the manual execution of a task, e.g., where to find or how to engage the parking brake on an unfamiliar vehicle, and leaves it to the driver to manually implement these instructions. EX1013, ¶¶ 122-123.

As detailed in Sections IV.A.1.-3., above, Xiao’s system is already constrained to retrieve command codes for stored settings that are known to be settable in a specific vehicle per the operator’s preferences.” EX2004, at 80. For example, “Xiao discloses that the server *must* look up or retrieve the appropriate command codes 632 for operation of *a selected vehicle*,” including a vehicle that may be selected via Xiao’s application. *Id.*, at 54, citing EX1007, ¶ 103. When Xiao’s server does “generate” a command, this operation too is vehicle-specific and is nothing more than a relay of the already-constrained retrieval of a command code 632 that corresponds to the vehicle-specific automobile ID and vehicle-specific command ID contained in the command request. EX1007, ¶¶ 100 (upon server receiving “the start engine command request,” and “using the automobile ID 608 and the command ID 630,” server may retrieve “the command code 632 corresponding to the engine start command for the operator’s automobile 112[,] [t]hen *server 118 may transmit the retrieved command code 632 to the automobile*

112”), 101 (“[t]he lock/unlock door command may be generated and communicated to the automobile 112 in a similar manner as discussed above with respect to the start automobile command”), 102 (“automobile service server 118 may look up appropriate command codes 632 based on the automobile ID 627 and on the command IDs 630 ... [t]hen, automobile service server 118 may generate one or more commands based on the retrieved command codes 632”).

Accordingly, when the server “generates” a command to be transmitted to the automobile 112 for subsequent programming, the command code retrieved and relayed by Xiao’s server already corresponds to “settings that are known to be settable in a specific vehicle per the operator’s preferences.” EX2004, at 80. One of the nonsensical results achieved by the proposed modification of Xiao to include “none” as taught by Hayashi “would be that Xiao’s server, at best, in response to the command request issued by the operator, could look up a command code to apply a vehicle-specific settings to that automobile 112, only to find that there is ‘none.’” EX2004, at 79. As the Board already concluded, the proposed modification leaves unanswered “why a POSITA would 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.

Because Xiao's operator's preferences are preset for each automobile on the account, if there is no corresponding automobile setting in Xiao's database, then Xiao's system already "would not list those command codes for retrieval." EX2004, at 79. Likewise, Xiao's server "would not send a command based on that retrieved command code to control the automobile systems to achieve the operator's desired settings because that command code is not in the database." *Id.* "The nonsensical result achieved by this combination would be that Xiao's server, at best, in response to the command request issued by the operator, could 'look up' a command code to apply a vehicle-specific setting to that automobile 112, only to find that there is 'none.'" *Id.*, at 79-80, quoting IPR2024-00786, EX2011 ¶ 135. For at least these reasons, Petitioner has not demonstrated that a POSITA would have been motivated to modify Xiao in view of Hayashi as proposed. EX2004, at 75-80.

Accordingly, the Petition has not met its threshold burden of showing that Rector and Kleve would be properly combined with Xiao (*see* Sections IV.A.3., IV.B.2.-3., *supra*), or that a POSITA would be motivated to combine Rector-Kleve-Xiao with Hayashi.

VII. Conclusion

For all of the reasons given above, including because Toyota has failed to explain its inconsistent claim construction positions, failed to comply with 37 C.F.R. § 42.104(b)(4), failed to meet its burden of proof, or even present credible

evidence in support of its proposed combinations of prior art references, the Board should deny the petition.

Dated: January 23, 2026

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

The undersigned certifies that the foregoing PATENT OWNER'S
PRELIMINARY RESPONSE complies with the type-volume limitation in 37
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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 January 23, 2026, a copy of the foregoing document was served by email upon the following counsel at the below email addresses:

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