

Petitioners' Opposition to Patent Owner's  
Request for Discretionary Denial  
U.S. Patent No. 12,337,715

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

---

**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

---

KIA CORP.,  
TOYOTA MOTOR CORP.,  
Petitioners,

v.

EMERGING AUTOMOTIVE LLC,  
Patent Owner.

---

Post Grant Review No. 2026-00008

U.S. Patent No. 12,337,715

---

**PETITIONERS' OPPOSITION TO PATENT OWNER'S REQUEST FOR  
DISCRETIONARY DENIAL OF INSTITUTION**

**TABLE OF CONTENTS**

	<b><u>Page</u></b>
I. INTRODUCTION .....	1
II. ARGUMENT .....	4
A. Patent Owner Has No Settled Expectations: Petitioners Brought This PGR Within Four Months of the ’715 Patent’s Issuance.....	4
B. <i>Fintiv</i> Timing and Efficiency Factors Weigh Against Denial .....	5
1. Factor 1 — Existence or Likelihood of a Stay .....	5
2. Factor 2 — Trial Date .....	6
3. Factor 3 — Investment in the District Court .....	6
4. Factor 4 — Overlap With Issues Raised in Court .....	7
5. Factor 5 — Whether the Parties Are the Same.....	7
6. Factor 6 — Other Circumstances Including Merits.....	7
C. Petitioners Have Not Taken Inconsistent Positions .....	8
1. The District Court Rejected Petitioners’ Construction and Adopted the Plain and Ordinary Meaning of “E-Key” .....	9
2. The District Court Adopted the Plain and Ordinary Meaning of the “Privileges” and “Conditions of Use” Terms.....	10
3. The Court Has Not Construed the ’715 Patent Claims.....	12
D. The Petition Is Not Barred by § 325(d) Because the Asserted Grounds and Combinations Were Not Previously Considered, and the Office Committed Multiple Material Errors .....	12
1. The Office Did Not Previously Consider the Asserted Grounds, Combinations, or Statutory Challenges .....	13
2. The Examiner Committed Material Error by Failing to Find the Claims Unpatentable Over the Asserted Combinations .....	15
3. The Examiner’s Stated Reason for Allowance Independently Reflects Material Legal and Factual Error.....	16
4. Other Circumstances Confirm Denial Is Unwarranted.....	17

Petitioners' Opposition to Patent Owner's  
Request for Discretionary Denial  
U.S. Patent No. 12,337,715

E.	The Petition Presents Strong Statutory Challenges.....	17
1.	The Petition Complies with 37 C.F.R. § 42.204(b)(4) .....	18
2.	The Petition Shows Invalidity Under §§103 and/or 112. ....	18
3.	Patent Owner's Attorney Argument Does Not Undermine the Petition's Challenges Under § 112(a).....	20

## I. INTRODUCTION

The Director should deny Patent Owner's ("PO") request for discretionary denial (Paper 8) ("PO DD Request") because this post-grant review was filed at the outset of the '715 patent's life, concerns a patent family whose materially similar claims have already been found unpatentable by the Board, the related district court litigation remains at an early stage, and the Board's review is projected to conclude with a final written decision by April 2027—months before the July 2027 trial.

Petitioners challenged the '715 patent within four months of issuance and only ten weeks after Patent Owner filed suit. There are therefore no settled expectations in the validity of this patent. To the contrary, it belongs to a family in which the Board has already invalidated all materially similar e-key claims of the related '188 patent over the Kleve and Sekiyama combination, and the related '659 patent is currently under Board review and under final rejection in *ex parte* reexamination. That track record further underscores the absence of any reasonable reliance interest. As the Director has explained, "[e]arly challenges favor robust, predictable patent rights and weigh against discretionary denial," particularly in post-grant reviews, which must be filed within nine months of grant and occur close in time to examination. *Toyota Motor Corp. v. AutoConnect Holdings LLC*, PGR2025-00041, Paper 9 at 2 (Acting Director Sept. 8, 2025).

Petitioners' Opposition to Patent Owner's  
Request for Discretionary Denial  
U.S. Patent No. 12,337,715

Timing and efficiency also strongly favor institution. The district court case is at an early stage, with *Markman* not until January 19, 2027, and trial July 2027. The Board's review here is projected to result in a FWD by April 2027—months before trial. Petitioners have further stipulated (Paper 7) that they will not pursue in court any ground raised, or that reasonably could have been raised, in this PGR, eliminating any risk of duplicative litigation or inconsistent outcomes. PGR2025-00041, Paper 9 at 2–3. Where the Board can resolve patentability first on a full record—and has already addressed the same family and prior art—discretionary denial would undermine, not promote, efficiency.

PO's remaining arguments fare no better. First, PO contends that Petitioners have taken “inconsistent claim construction positions” regarding “e-key” and “privileges” / “conditions of use” in litigation involving related patents. That is incorrect. Petitioners' proposal of plain and ordinary meaning (“PAOM”) for all terms is entirely consonant with: (1) the district court's construction of “e-key,” which rejected Petitioners' earlier narrowing proposal and adopted the term's PAOM; and (2) the court's adoption of the PAOM of “privileges” / “conditions of use,” with the clarification that the PAOM does not extend to “unfettered access.”

Further, the district court has not yet construed any claim terms of the recently issued '715 patent. The *Revvo* and *Tesla* decisions, in contrast, both involved alleged inconsistencies concerning the *same* patent. Moreover, the court's constructions are

Petitioners' Opposition to Patent Owner's  
Request for Discretionary Denial  
U.S. Patent No. 12,337,715

entirely consistent with the Petitions' prior art mapping—and PO does not show otherwise. In fact, in a recent FWD involving the same parties and related subject matter, the Board invalidated all challenged claims under a PAOM framework, with PO raising no dispute as to the meaning of “e-key” or “privileges” / “conditions of use”—underscoring that no genuine dispute exists regarding these terms.

Second, PO asserts that the Petition is “weak,” arguing that it fails to specify prior art for each limitation and that the specification “easily refutes” the § 112(a) challenges. That is incorrect—the Petition identifies prior art for each challenged limitation and explains, with expert support, why certain claim limitations lack written description and enablement support. In any event, these are merits disagreements, supported solely by attorney argument.

Third, PO invokes 35 U.S.C. § 325(d), asserting that the prior art was previously considered. As explained below, however, the Office did not evaluate the specific combinations and statutory challenges presented here, including the combined teachings of Sekiyama and Kleve as supplemented by Hatton and Xiao, and the '715 patent issued based on a multitude of legal and factual material errors.

For these reasons, Petitioners respectfully request that the Director deny PO's request for discretionary denial and refer this PGR to the Board on the merits.

## II. ARGUMENT

### A. Patent Owner Has No Settled Expectations: Petitioners Brought This PGR Within Four Months of the '715 Patent's Issuance

PO has no settled expectations in the '715 patent. The '715 patent, issued June 24, 2025 (EX1001 at 1), was first asserted in litigation on August 12, 2025 (EX2010; EX2011), and was challenged in this PGR within four months of issuance and approximately ten weeks after PO filed suit. Those facts alone weigh strongly against discretionary denial. As the Director and the Board have repeatedly explained, early challenges—particularly in post-grant review proceedings—occur close in time to examination and before expectations in patent rights are strongly settled. *See, e.g.*, PGR2025-00041, Paper 9 at 2.<sup>1</sup>

This case presents even stronger grounds. The '715 patent belongs to a family in which materially similar claims have already been found unpatentable by the Board. In a prior IPR, the Board invalidated all materially similar e-key claims of

---

<sup>1</sup> The Board has repeatedly rejected requests for discretionary denial where patents have been in force only a short time. *See, e.g., Multi-Color Corp. v. Brook & Whittle Ltd.*, PGR2025-00025, Paper 10 at 2–3 (Acting Director July 16, 2025); *Zhuhai CosMX Battery Co., Ltd. v. Ningde Amperex Tech. Ltd.*, IPR2025-00385, Paper 9 at 2–3 (Acting Director July 2, 2025) (“[E]arly challenges to patents tip the balance against discretionary denial.”)

the related '188 patent over Kleve and Sekiyama. IPR2024-00981, Paper 36 (EX2004.) *See, e.g., POSCO Co., Ltd. v. Arcelormittal*, IPR2025-00370, -00371, Paper 10 at 3 (Director Jun. 25, 2025) (“The fact that the Board previously determined related claims to be unpatentable—prior to the issuance of the challenged claims in this proceeding—tips the balance against discretionary denial.”) Further, the related '659 patent is currently under Board review (IPR2024-01167) and has also been finally rejected in EPR 90/019,456 (Pet. at 11-12.) That track record eliminates any reasonable reliance interest in the validity of the '715 patent and confirms there are no settled expectations for this family of claims.

**B. *Fintiv* Timing and Efficiency Factors Weigh Against Denial**

A holistic analysis under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) confirms discretionary denial is unwarranted.

**1. Factor 1 — Existence or Likelihood of a Stay**

The district court has not denied a stay or otherwise indicated that a stay would be unavailable. PO speculates that a stay would be denied, but the Board does not credit such speculation. Where a court has not expressed a view, this factor is neutral. *See* IPR2024-01372, Paper 17 at 10–11 (PTAB Apr. 23, 2025); IPR2019-01393, Paper 24 at 7 (PTAB June 16, 2020). Moreover, in the earlier related action involving this same patent family, the court granted a joint stay pending PTAB review—

confirming that stays are realistically available in this litigation.<sup>2</sup> (EX2002.) This factor is, at worst, neutral and does not support discretionary denial.

**2. Factor 2 — Trial Date**

Markman is scheduled for January 19, 2027, and trial for July 2027. (EX2010.) The Board's FWD is projected for April 2027, months before trial. Thus, the Board is expected to resolve patentability first—precisely the circumstance where discretionary denial is disfavored. *See, e.g.*, IPR2024-01420, Paper 12 at 44–45 (granting institution where projected FWD preceded trial); IPR2025-00148, Paper 7 at 44 (same). This factor weighs against discretionary denial.

**3. Factor 3 — Investment in the District Court**

At the time of the institution decision, the district court will not yet have held Markman, which is scheduled for January 19, 2027. Fact discovery will be ongoing and expert discovery will not be completed before March 29, 2027. This does not constitute “substantial investment” under *Fintiv*.

---

<sup>2</sup> Petitioner Toyota has a pending motion to stay the current litigation. In the prior suit, a motion to stay was originally denied due to no institution on one patent. The court subsequently granted the parties' joint motion to stay.

Petitioners have been diligent—filing this PGR within approximately ten weeks of suit and within four months of issuance—preventing the case from maturing before PTAB review. This factor weighs against discretionary denial.

**4. Factor 4 — Overlap With Issues Raised in Court**

Petitioners filed a broad *Sotera* stipulation agreeing not to pursue any invalidity ground that was raised or reasonably could have been raised in this PGR. (Paper 7.) That eliminates any risk of duplication or inconsistent rulings and strongly favors institution. PGR2025-00041, Paper 9 at 2–3. This factor weighs heavily against discretionary denial.

**5. Factor 5 — Whether the Parties Are the Same**

When the Petitioners are the same as the named defendants in the district court litigation, the Board has found that this factor adds “little if anything to the discretionary denial analysis.” *See, e.g., Aylo Freesites Ltd. f/k/a MG Freesites Ltd. v. WellcomeMat, LLC*, IPR2024-00710, Paper 13 at 17–18 (PTAB Sept. 5, 2024); *see Shenzhen Root Tech. Co. v. Chiaro Tech. Ltd.*, IPR2024-01296, Paper 9 at 19–20 (PTAB Feb. 25, 2025). This factor is neutral and does not outweigh the strong countervailing factors favoring institution.

**6. Factor 6 — Other Circumstances Including Merits**

Efficiency strongly favors institution for two independent reasons. *First*, this PGR raises substantial statutory challenges, including obviousness over Kleve and

Sekiyama, as supplemented by Hatton and Xiao, and written description defects that go to the heart of numerous claims. *See infra*. Section II.E.

*Second*—and critically—the '715 patent arises from the same family and materially similar subject matter that the Board has already adjudicated. The Board has already invalidated all of the related '188 patent claims over the Kleve/Sekiyama combination (IPR2024-00981, Paper 36; EX2004), and the related '659 patent is currently under Board review (IPR2024-01167) and under final rejection in *ex parte* reexamination. (EPR 90/019,456, Pet. 11-12). Allowing the Board to address the '715 patent against that established backdrop promotes consistency, conserves adjudicative resources, and avoids fragmented results across forums. IPR2025-00370, -00371, Paper 10 at 3. This factor weighs against discretionary denial.

Every meaningful *Fintiv* factor either favors institution or is, at most, neutral. None supports denial. The Board is positioned to decide patentability first, efficiently, and on a complete record—exactly what *Fintiv* was designed to facilitate.

### **C. Petitioners Have Not Taken Inconsistent Positions**

PO contends that Petitioners have “taken inconsistent positions in district court and in the IPR Petition concerning the ‘e-key,’ ‘privileges’ and ‘conditions of use’ terms.” (PO DD Request at 4.) That argument lacks merit. In this PGR, Petitioners propose to apply the PAOM of the challenged claim terms—an approach that is fully consistent with the court’s claim constructions in the related litigation.

**1. The District Court Rejected Petitioners' Construction and Adopted the Plain and Ordinary Meaning of "E-Key"**

There is no inconsistency between the district court's construction of "e-key" and Petitioners' position in this proceeding. In the earlier litigation, PO asserted that no construction was necessary for the term "e-key" in the related patents, while Petitioners' proposed a narrower construction—"electronic data that can be used to operate a vehicle consistent with privileges or conditions." (EX2005 at 9.) The court framed the dispute as whether an "e-key" must enable all of a vehicle's functions. (*Id.*) PO contended that it need not, whereas Petitioners argued that a vehicle owner would not expect a collection of keys, each capable of enabling only one vehicle function. (*Id.*) The court agreed with PO, rejected Petitioners' proposed construction, and determined the PAOM as shown below (*Id.* at 32.)

Disputed Term	The Court's Construction
"electronic key"/ "eKey"/ "e-key" (*026 patent, Claims 1, 2, 6, 13, 15; '659 Patent, Claims 1, 3, 4, 12, 13, 20; '188 Patent, Claims 1, 11, 16, 17; '268 Patent, Claims 10, 18)	"electronic data that enables one or more functions of the vehicle"

There was no finding of disavowal, lexicography or disclaimer—the court simply provided its understanding of the meaning in light of the specification. Moreover, because there is a "heavy presumption" that claim terms carry their ordinary and customary meaning, *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002), the district court's construction is properly understood

as reflecting the term's PAOM. Petitioners' position in this PGR—that “e-key” should be given its PAOM—therefore aligns squarely with the construction the district court applied. The fact that the court declined to adopt Petitioners' earlier proposed narrowing construction does *not* create any inconsistency. To the contrary, as *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 at 3–5 (Director Nov. 3, 2025) (precedential) makes clear, where a district court declines to adopt a narrowing construction and instead adopts PAOM, a party is justified in advancing PAOM in a later PTAB proceeding.<sup>3</sup> Moreover, in a related proceeding that reached final written decision (IPR2024-00981, Paper 36; EX2004), PO did not dispute the meaning of “e-key” while litigating validity over the Sekiyama and Kleve references raised here. The Board ultimately found all claims of the related '188 patent unpatentable based on those references. (*Id.*)

**2. The District Court Adopted the Plain and Ordinary Meaning of the “Privileges” and “Conditions of Use” Terms**

Similarly, the district court found that the “privileges” and “conditions of use” terms carry their PAOM. (EX2005 at 32.)

Disputed Term	The Court's Construction
---------------	--------------------------

---

<sup>3</sup> The Board granted institution on remand, finding the mere possibility that the court might reject Petitioner's narrowing construction justified its proposal of a broader construction in the IPR. IPR2025-00632, Paper 30 (PTAB Jan. 14, 2026).

Petitioners' Opposition to Patent Owner's  
Request for Discretionary Denial  
U.S. Patent No. 12,337,715

"privileges for use of the vehicle" (*026 Patent, Claim 1)	Plain and ordinary meaning
"privilege settings for use of the vehicle" (*659 Patent, Claim 18)	
"condition of use of the vehicle" (*188 Patent, Claims 1, 16)	

As with “e-key,” PO asserted that no construction was necessary for the “privileges” and “conditions of use” terms in the related patents, while Defendants proposed the following construction: “permitted uses of the vehicle when using the e-key, such as what type of access, speed limits, geographic restrictions, or the amount of time the e-keys will be valid.” (*Id.* at 12.)

The court framed the parties’ dispute as whether the terms could encompass “unfettered access” to the vehicle. (*Id.*) The court did not adopt Defendants’ proposed construction. Instead, it adopted the PAOM, as reflected in the table above summarizing its conclusions, and clarified in the body of its order that the PAOM does not extend to unfettered access. (*Id.* at 13, 32.)<sup>4</sup>

In the related proceeding that reached FWD (IPR2024-00981, Paper 36; EX2004), PO likewise did not dispute the meaning of “conditions of use” while litigating validity over the Sekiyama and Kleve references raised here. The Board ultimately found all claims of PO’s related ’188 patent unpatentable based on those

---

<sup>4</sup> The Petition does not depend on any argument that the prior art “privileges” or “conditions of use” extend to unfettered access.

references. (*Id.*) That history confirms that PO's position is not a genuine dispute over claim scope.

### **3. The Court Has Not Construed the '715 Patent Claims**

This case is even further removed from PO's cited authority, *Revvo* and *Tesla*—both of which involved alleged inconsistencies between constructions concerning the same patent in parallel proceedings before the court and PTAB. Those decisions therefore do not address the circumstances here, where the court has not yet construed the recently issued '715 patent. (EX2010; EX2011.) Accordingly, there is no court construction of the '715 patent claims against which Petitioners' positions in this PGR could be inconsistent. (*Id.*) PO's attempt to stretch *Revvo* and *Tesla* to fit this case thus fails for this independent reason.

#### **D. The Petition Is Not Barred by § 325(d) Because the Asserted Grounds and Combinations Were Not Previously Considered, and the Office Committed Multiple Material Errors**

PO urges discretionary denial under 35 U.S.C. § 325(d), asserting that “most, if not all” of the *Becton* factors favor denial because the references cited in the Petition were previously presented during prosecution. (PO DD Request at 16.) That argument fails under the governing framework.

Under *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential), the § 325(d) inquiry asks:

(1) whether the same or substantially the same art or arguments were previously presented to the Office; and

(2) if so, whether the petitioner has demonstrated that the Office erred in a manner material to patentability.

Even assuming the references were “presented” via submission along with 400 other references in an IDS, discretionary denial is unwarranted here because (i) the Office did not previously consider the asserted grounds, combinations, or statutory challenges advanced in the Petition (*Becton* factors 1-4), and (ii) the Office’s allowance of the ’715 patent rests on multiple material legal and factual errors (*Becton* factor 5), with additional circumstances weighing strongly against denial (*Becton* factor 6).

**1. The Office Did Not Previously Consider the Asserted Grounds, Combinations, or Statutory Challenges**

The Petition challenges the ’715 patent based on specific combinations of references, including Sekiyama and Kleve, as supplemented by Hatton and Xiao, and advances written description challenges under § 112(a). Nothing in the prosecution history reflects that the Examiner evaluated these combinations, rationales, or statutory challenges. (EX1002.)

Mere listing of references on a lengthy IDS does not present the Examiner with the combination theories, motivation-to-combine analyses, reasonable-expectation-of-success reasoning, or claim-by-claim arguments advanced in the

Petitioners' Opposition to Patent Owner's  
Request for Discretionary Denial  
U.S. Patent No. 12,337,715

Petition. *See, e.g., Ecto World, LLC and Sv3, LLC v. Rai Strategic Holdings, Inc.*, IPR2024-01280, Paper 13, 2025 WL 1528304, at \*4 (Acting Director May 19, 2025) (precedential as to §A) (“[T]he Board should consider a petitioner’s argument based on the volume of the references submitted to the Office during examination and any applicant information or assistance regarding the relevance of references. In this case, the IDS that includes the asserted prior art contains over 1,000 references[.]”). Nor does the record show that the Examiner substantively engaged with any of those theories during examination. (EX1002.)

Critically, although Patent Owner disclosed the existence of related post-grant proceedings, there is no indication in the prosecution record that the Examiner reviewed or considered the substance of the petitions or institution decisions that issued before allowance, including:

- the institution decision in *Kia Corp. and Toyota Corp. v. Emerging Auto. LLC*, No. IPR2024-00981, Paper 10 (PTAB Dec. 18, 2024); and
- the institution decision in *Kia Corp. and Toyota Corp. v. Emerging Auto. LLC*, No. IPR2024-01167, Paper 14 (PTAB Jan. 27, 2025).

Those decisions identified specific prior art combinations and patentability deficiencies directly relevant to the continuation claims that issued as the '715 patent. The record contains no notation, search summary, or examiner discussion indicating that those materials were reviewed or that their substance was considered during examination. (EX1002.)

Accordingly, the asserted grounds and arguments in the Petition were not previously presented to or evaluated by the Office, and *Becton* factors 1 through 4 weigh against discretionary denial.

**2. The Examiner Committed Material Error by Failing to Find the Claims Unpatentable Over the Asserted Combinations**

Even if the Board were to conclude that certain prior art was previously presented, discretionary denial would still be unwarranted because the Petition demonstrates material examiner error.

The Petition explains—supported by detailed expert testimony—why a POSITA would have found the challenged claims unpatentable over the asserted combinations, including Sekiyama and Kleve as supplemented by Hatton and Xiao. The Examiner did not address these combinations, did not analyze any motivation to combine, and did not consider whether a POSITA would have had a reasonable expectation of success. That omission goes directly to the heart of patentability and constitutes material error under *Advanced Bionics*.

The materiality of that omission is underscored by the Board's subsequent FWD in the related IPR2024-00981 (Paper 36, EX2004) proceeding involving closely related subject matter. In that proceeding, applying the PAOM of the relevant claim terms, the Board found materially similar claims unpatentable over the Kleve/Sekiyama combination. (*Id.*) Although that decision issued after the '715

patent allowed, it confirms that the Examiner's failure to engage with those combinations was not harmless, but went directly to patentability.

**3. The Examiner's Stated Reason for Allowance Independently Reflects Material Legal and Factual Error**

Material error is further confirmed by the Examiner's stated reason for allowance. In the Notice of Allowance dated March 12, 2025, the Examiner explained that the "closest prior art by Suyama (Pat. No.: 7,375,440 B2) does not teach or fairly suggest ... a server associated with the manufacturer of the vehicle." (EX1002 at 558.) That reasoning is materially erroneous for two reasons.

*First*, as explained in the Petition, the phrase "associated with a manufacturer of the vehicle" is nonfunctional descriptive material that is not entitled to patentable weight. (Pet. at 12.) The phrase merely identifies who owns or operates the server; it does not alter the server's structure. Under settled Federal Circuit law, such content-based limitations lack a functional relationship to the claimed invention and cannot confer patentability. *See Praxair Distrib., Inc. v. Mallinckrodt Hosp. Prods. IP Ltd.*, 890 F.3d 1024, 1031–32 (Fed. Cir. 2018).

*Second*, even if that limitation were entitled to patentable weight, the Examiner also erred factually. As detailed in Ground 1 of the Petition, a POSITA would have understood that Sekiyama's "center server" is associated with the vehicle manufacturer. (Pet. at 13, 51.) Sekiyama was invented by Toyota employees

and assigned to Toyota Motor Corp., describing an electronic key system developed for Toyota vehicles. (Pet. at 13, 51; EX1005; EX1003 at ¶¶62–63, 146.) It further would have been an obvious to host such functionality on a manufacturer-associated server, as confirmed by contemporaneous references such as Xiao. (Pet. at 51-52; EX1010; EX1003 at ¶¶63, 147.) Thus, the Examiner's stated reason for allowance rests on both legal and factual error, independently demonstrating material error.

#### **4. Other Circumstances Confirm Denial Is Unwarranted**

Finally, *Becton* factor 6 independently weighs against discretionary denial. This PGR was filed promptly. It presents the first and only post-grant challenge to the '715 patent and identifies material errors underlying allowance. Denying review under § 325(d) in these circumstances undermines the purpose of post-grant review as a timely and efficient mechanism for correcting improvidently issued patents.

#### **E. The Petition Presents Strong Statutory Challenges**

PO asserts that the Petition fails to present a “compelling” challenge to the claims. (*See* PO DD Request at 8–13.) That assertion is incorrect. The alleged “deficiencies” are based solely on attorney argument and at best present merit disputes for the Board. Far from being weak, the Petition presents detailed, well-supported statutory challenges appropriate for Board review.

**1. The Petition Complies with 37 C.F.R. § 42.204(b)(4)**

PO contends that the Petition violates § 42.204(b)(4) by cross-referencing analysis for overlapping limitations, citing claim 17[a]. (*See id.* at 9–10.) That argument misunderstands the rule and the Petition.

*First*, cross-referencing discussion of overlapping claim language is not a procedural defect; the rules do not require duplicative repetition where claims share common elements.

*Second*, the Petition does not “ignore” claim 17[a]’s added “receiving confirmation” language. The Petition states—citing to supporting expert testimony—that “[t]he written description contains no disclosure of (i) the system receiving a confirmation that a sharing request was sent.” (Pet. at 78.) Moreover, the Petition asserts that “[i]n any event, adding a recipient-side ‘accept/received’ confirmation back to the backend/server is a routine client-server pattern that fits Sekiyama and Kleve’s architecture without changing it.” (*Id.* at 68.)<sup>5</sup>

**2. The Petition Shows Invalidity Under §§103 and/or 112.**

With respect to limitation 1[a], PO argues that the Petition creates a “mash-up” and “strained combination” of Sekiyama and Kleve. (PO DD Request at 10.)

---

<sup>5</sup> The obviousness of the “receiving confirmation” language is addressed under the discussion of limitation 17[b]. (Pet. at 68-69; EX1003, ¶188.)

But such attorney argument ignores the substance of the analysis. The first clause of limitation 1[a] requires “processing a request to share an electronic key (e-key) of a vehicle with a recipient device.” (Pet. at 39–40.) The Petition and supporting expert declaration easily show how both Sekiyama and Kleve independently disclose and render this clause obvious. (*See id.*) PO does not contend otherwise.

Instead, PO claims the combination fails to disclose the second clause: “the request to share the e-key being received responsive to a message being sent to the recipient device from a sharing device.” (PO DD Request at 9–11.) But, as the Petition and supporting expert declaration explain, to the extent this limitation requires a “direct causal connection between a message being sent to a recipient and the issuance/processing of a request,” the '715 patent lacks written description and enablement and is invalid under § 112(a). (Pet. at 40–42; EX1003 at ¶¶132–33.) And the Petition explains that even under a non-causal reading, the combined system renders this clause obvious. (Pet. at 42–43; EX1003 at ¶134.) For example, Kleve discloses recipient-facing messages which trigger the owner/server request flow. (Pet. at 43; EX1004 at ¶¶[0038], [0062].) PO seems to contend that the recipient-facing messages are not sent from a “sharing device.” But, as mapped, the owner's device—from which the recipient-facing messages are generated and shared—constitutes the sharing device. (*Id.*)

**3. Patent Owner's Attorney Argument Does Not Undermine  
the Petition's Challenges Under § 112(a)**

PO argues—again, solely through attorney argument—that the specification “readily refutes” the § 112 challenges. (PO DD Request at 11.) These arguments fail. *First*, PO relies on its Abstract which it added with the filing of the continuation application in October 2023—thus, underscoring the absence of *written description support in the claimed priority application*. (EX1002 at 26.)

*Second*, PO's citations to the specification itself do not support its argument.

As Dr. Almeroth explains—without rebuttal—the specification does not describe:

(i) a message to the recipient that causes the server to receive or process a share request, nor (ii) the system receiving acknowledgment that a sharing request was sent or receiving acknowledgment from the recipient device. To the extent the claims require such causation or acknowledgments, the specification is silent on any mechanism, protocol, or architecture to implement them.

Pet. at 76–77 (citations omitted); *see also* EX1003, ¶¶212–19.

Date: January 23, 2026

Respectfully submitted,

By: /s/ James M. Glass

James M. Glass

*Counsel for Petitioners*

Petitioners' Opposition to Patent Owner's  
Request for Discretionary Denial  
U.S. Patent No. 12,337,715

**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6, I hereby certify that on January 23, 2026, the foregoing document was served via email on the following counsel of record:

Brenda Entzminger  
bentzminger@bdiplaw.com

Aaron R. Hand  
ahand@bdiplaw.com

BDIP\_  
EmergingAuto@bdiplaw.com

Date: January 23, 2026

By: /s/ James M. Glass  
James Glass  
QUINN EMANUEL URQUHART  
& SULLIVAN, LLP  
295 5<sup>th</sup> Avenue  
New York, NY 10014  
Tel: (212) 849-7000  
Fax: (212) 849-7100

*Counsel for Petitioners*