

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FORD MOTOR COMPANY  
Petitioner,

v.

AUTOCONNECT HOLDINGS, LLC  
Patent Owner.

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U.S. Patent No. 9,173,100 to Ricci

Case No.: IPR2026-00173

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**PETITIONER'S REQUEST FOR DIRECTOR REVIEW**

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1001	U.S. Patent No. 9,173,100 (“the ’100 Patent”)
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1003	Expert Declaration of Scott Andrews
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1005	<i>AutoConnect Holdings LLC v. Ford Motor Company</i> , Case No. 1:24-cv-01327-JCG (D. Del) (December 6, 2024) (“Complaint”)
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1010-1018	<i>Intentionally left blank.</i>
1019	Amirtahmasebi et al., “Vehicular Networks – Security, Vulnerabilities and Countermeasures, Master of Science Thesis in the program Networks and Distributed Systems,” and accompanying Librarian Declaration (“Amirtahmasebi”)
1020	U.S. Patent Application Pub. No. 2004/0185842 A1 to Spaur (“Spaur”)
1021	U.S. Patent No. 8,788,731 B2 to Peirce (“Peirce”)
1022-1049	<i>Intentionally left blank.</i>
1050	Bosch Handbook, (Automotive Handbook October 2004 6 <sup>th</sup> Edition) (“Bosch”)
1051	IEEE Dictionary, (IEEE 100 The Authoritative Dictionary of IEEE Standards Terms 2000 7 <sup>th</sup> Edition) (“IEEE Dictionary”)
1052	“Specification of The Bluetooth System” (June 30, 2010). Version 4.0 (Volumes 0-6) Available at <a href="https://www.bluetooth.com/specifications/specs/core-specification-4-0/">https://www.bluetooth.com/specifications/specs/core-specification-4-0/</a> (Accessed June 27, 2025) (“Bluetooth Specification”)

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1053-1057	<i>Intentionally left blank</i>
1058	Ghangurde, Mujund “Ford SYNC and Microsoft Windows Embedded Automotive Make Digital Lifestyle a Reality on the Road,” <i>SAE International</i> , Volume 3, Issue 2, October 19, 2010 SAE2010-01-02319 (Accessed April 25, 2025) (“Ghangurde”)
1059	<i>Intentionally left blank.</i>
1060	TCP/IP Tutorial and Technical Overview 6 <sup>th</sup> Ed. (International Business Machines Corporation – October 1998) (“IBM TCP/IP Tutorial”)
1061	Ford SYNC Supplemental Guide, November 2007 (“SYNC Guide 2007”)
1062-1081	<i>Intentionally left blank.</i>
1082	M. Wolf, A. Weimerskirch, and C. Paar, “Security in Automotive Bus Systems,” in Workshop on Embedded IT-Security in Cars, Bochum, Germany, November 2004 (“Wolf”)
1083	P. Golle, D. Greene and J. Staddon, “Detecting and correcting malicious data in VANETs.” in Proceedings of the first ACM workshop on Vehicular ad hoc networks, (2004), ACM Press, pp 29–36. (“Golle”)
1084	T. Hoppe, S. Kiltz, and J. Dittmann. “Security threats to automotive CAN networks-Practical examples and selected short-term countermeasures.” <i>Reliability Engineering &amp; System Safety</i> , Vol. 96, Issue 1, January 2011, pp. 11-25 (“Hoppe”)
1085	X. Lin, R. Lu, C. Zhang, H. Zhu, P.-H. Ho and X. Shen, “Security in vehicular ad hoc networks”, <i>IEEE communications magazine</i> . (Apr 30 2008), 46(4), pp.88-95. (“Lin”)
1086	M. Jusufovic and M. Nilsson. "Wireless Security in Road Vehicles-Improving Security in the SIGYN System." (2009). (“Jusufovic”)
1087	D. Nilsson, P. Phung, and U. Larson, “Vehicle ECU Classification Based on safety-Security Characteristics” In Proceedings of the 13th International Conference on Road Transport and Information Control (RTIC), 2008. (“Nilsson”)
1088	B. Parno and A. Perrig, “Challenges in Securing Vehicular Networks,” in Proceedings of the Workshop on Hot Topics in Networks (HotNets-IV), 2005. (“Parno”)
1089-1101	<i>Intentionally left blank.</i>
1102	U.S. Patent and Trademark Office - U.S. 9,020,697 Maintenance Fee Payment Records

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1103	U.S. Patent and Trademark Office - U.S. 9,123,186 Maintenance Fee Payment Records
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1108	U.S. Patent and Trademark Office - U.S. 9,290,153 Maintenance Fee Payment Records
1109	Intentionally left blank
1110	Flextronics “Flex celebrates 10 years of maintaining Ford’s prestigious Q1 quality certification in Guadalajara, Mexico” (Posted April 2, 2024) Available at <a href="https://flex.com/resources/10-years-of-maintaining-fords-q1-quality-certification">https://flex.com/resources/10-years-of-maintaining-fords-q1-quality-certification</a>
1111	<i>Intentionally left blank.</i>
1112	Scheduling Order, <i>AutoConnect Holdings LLC v. Ford Motor Company</i> , Case No. 1:24-cv-01327-JCG (D. Del) (“Scheduling Order”)
1113-1114	<i>Intentionally left blank.</i>
1115	Defendant’s Motion to Dismiss, <i>AutoConnect Holdings LLC v. Ford Motor Company</i> , Case No. 1:24-cv-01327-CFC (D Del.) Filed February 14, 2025 (“Motion to Dismiss”)
1116	<i>Intentionally left blank.</i>
1117	Zetter, Mark “Ford and Flextronics automotive EMS, Venture Outsource” February 2010 (Available at <a href="https://ventureoutsource.com/contract-manufacturing/industry-pulse/ford-and-flextronics-automotive-ems">https://ventureoutsource.com/contract-manufacturing/industry-pulse/ford-and-flextronics-automotive-ems</a> , accessed November 18, 2025) (“Ford Flextronics EMS”)
1118	Schröter, Anke “Ford partners with Flextronics, evertiq.com”, February 12, 2010, (Available at <a href="https://evertiq.com/news/16197?">https://evertiq.com/news/16197?</a> , accessed November 18, 2025) (“Ford Flextronics 2010”)
1119	“Which Ford vehicles are compatible with Apple CarPlay?” (Available at <a href="https://www.ford.com/support/how-tos/sync/getting-started-with-sync/which-vehicles-are-compatible-with-apple-carplay/">https://www.ford.com/support/how-tos/sync/getting-started-with-sync/which-vehicles-are-compatible-with-apple-carplay/</a> Accessed November 18, 2025) (“Ford AppleCarPlay”)

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1120	U.S. Patent and Trademark Office - U.S. 9,173,100 Assignment Abstract
1121	Declaration of Melissa Sheahan
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1125	<i>AutoConnect Holdings LLC v. Ford Motor Company</i> , AutoConnect Infringement Contentions, Case No. 1:24-cv-01327-JCG (D. Del.) Served December 19, 2025
1126-1127	<i>Intentionally left blank.</i>
1128	Ford Motor Company, “Production Purchasing Global Terms and Conditions” (Jan. 1, 2004) (Available at <a href="https://fsp.portal.covisint.com/documents/106025/25131282/Global_Production_Terms.pdf/fd1ed09d-7519-4ebb-928e-a7b302dc1331?version=1.0">https://fsp.portal.covisint.com/documents/106025/25131282/Global_Production_Terms.pdf/fd1ed09d-7519-4ebb-928e-a7b302dc1331?version=1.0</a> ) (“Ford production global terms and conditions 2004”)
1129	<i>Intentionally left blank.</i>
1130	<i>AutoConnect Holdings LLC v. Ford Motor Company</i> , AutoConnect Complaint, Ex. J3, ’100 Patent Infringement Charts, Case No. 1:24-cv-01327-JCG (D. Del.) Filed December 6, 2024
1131	<i>AutoConnect Holdings LLC v. Ford Motor Company</i> , AutoConnect Infringement Contentions, Ex. J2, ’100 Patent Infringement Charts, Case No. 1:24-cv-01327-JCG (D. Del.) Served December 19, 2025
1132	<i>Intentionally left blank.</i>
1133	<i>AutoConnect Holdings LLC v. Ford Motor Company</i> , Ford Motion to Stay, Case No. 1:24-cv-01327-JCG (D. Del.) (Redacted) (March 5, 2026)
1134-1136	<i>Intentionally left blank.</i>
1137	<i>Flextronics AP, LLC v. Christopher Ricci</i> No. 5:26-cv-00117-JCG (N.D. CA) (January 6, 2026) (“Flex v. Ricci Complaint”)
1138-1140	<i>Intentionally left blank.</i>
1141	Excerpt of <i>AutoConnect v. Toyota/GM</i> Case Schedule Correspondence, <i>AutoConnect Holdings, LLC v. General Motors LLC</i> , No. 2:24-cv-00877-JRG-RSP (E.D. Tex.) (March 4, 2026) (“Toyota/GM Case Schedule Correspondence Excerpt”)
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1160	File Wrapper of 61/715,699 (the “Tenth Provisional”)
1161	File Wrapper of U.S. Patent Publication No. 2013/0145482 (the “First Non-Provisional”)
1162	U.S. DOT Final Report, FHWA-JPO-17-483, “Development of DSRC Device and Communication System Performance Measures, Recommendations for DSRC OBE Performance and Security Requirements,” May 22, 2016. (“FHWA-JPO-17-483”)
1163	U.S. DOT, FHWA-JPO-12-061, “Communications Data Delivery System Analysis, Task 2 Report: High-Level Options for Secure Communications Data Delivery Systems,” June 21, 2012. (“FHWA-JPO-12-061”)
1164	U.S. DOT Final Draft, FHWA-JPO-18-686 “National Security Credential Management System (SCMS) Deployment Support, Potential SCMS Ownership and Governance Models,” June 22, 2018. (“FHWA-JPO-18-686”)
1165	U.S. DOT Final Report, FHWA-JPO-09-003, “Vehicle Infrastructure Integration Proof of Concept Executive Summary – Vehicle,” May 19, 2009. (“FHWA-JPO-09-003”)
1166	U.S. DOT Final Report, FHWA-JPO-09-043, “Vehicle Infrastructure Integration Proof of Concept Results and Findings Summary – Vehicle,” May 19, 2009. (“FHWA-JPO-09-043”)
1167	U.S. DOT Final Report, FHWA-JPO-09-017, “Vehicle Infrastructure Integration Proof of Concept Technical Description – Vehicle,” May 19, 2009. (“FHWA-JPO-09-017”)
1168	U.S. Patent No. 7,734,050 B2 to Tengler (“Tengler Digital Certificate Pool”)
1169	U.S. Patent No. 7,742,603 B2 to Tengler (“Tengler Security for Anonymous Vehicular Broadcast Messages”)

## I. INTRODUCTION

This Request for Director review of the Decision denying institution (Paper 9) presents important issues of law and policy concerning the Director’s holistic approach to discretionary denial analysis under 35 U.S.C. § 314(a), especially in view of the District Court’s April 16, 2026 Order staying the related District Court litigation pending the USPTO’s final patentability determinations of all related *inter partes* reviews and reexaminations concerning the several asserted patents. *AutoConnect Holdings LLC v. Ford Motor Company*, No. 1:24-cv-01327-JCG, ECF 72 (D. Del. Apr. 16, 2026) (“Related Litigation”). The stay is a material change in circumstances occurring after the discretionary denial, warranting Director Review to ensure the discretionary analysis reflects the current procedural posture.

Patent Owner’s primary argument<sup>1</sup> for discretionary denial was based on its allegation that Petitioner pursued claim constructions in the District Court (indefiniteness) that were different than the claim constructions presented in the Petition. That issue is moot for two reasons. First, in its initial claim construction

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<sup>1</sup> Because the Director’s written opinion supporting the Decision is forthcoming, Petitioner focuses on the District Court’s stay Order and the arguments Patent Owner presented in its Request for discretionary denial (Paper 6, “PO Request”).

disclosures in the District Court, Petitioner withdrew all indefiniteness arguments for all challenged claims of the '100 Patent. Second, the District Court recently stayed the litigation pending the several post-grant proceedings of the asserted patents. For these reasons, there will be no indefiniteness challenge at the District Court for the '100 Patent, and no basis for asserting Petitioner relies on inconsistent claim constructions in parallel proceedings.

Patent Owner's secondary argument for discretionary denial concerns settled expectations. Petitioner had settled expectations of non-suit at least because Petitioner's long-term supplier of the product accused of infringing the '100 Patent (Flextronics) applied for and originally owned the '100 Patent and did not inform Petitioner that it transferred the patent to Patent Owner in 2015. In addition, Patent Owner let the '100 Patent lapse for over three years for failure to pay maintenance fees. These factors and others created a well-settled expectation that Petitioner would not face an infringement claim on the '100 Patent.

For these reasons, Petitioner respectfully requests the Director's reconsideration of the Decision denying institution (Paper 9).

## **II. ARGUMENT**

### **A. The District Court Stayed the Litigation, Weighing the *Fintiv* Factors in Favor of Institution**

In view of the District Court's recent stay Order and other relevant facts, the

*Fintiv* factors strongly favor institution. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020) (Precedential).

**1. Factor 1: The Stay Strongly Favors Institution**

**Factor 1** strongly favors institution because the District Court stayed the Related Litigation pending resolution of the USPTO proceedings. *AutoConnect Holdings LLC*, 1:24-cv-01327-JCG, ECF 72. In granting the stay, the District Court found that “[g]iven the volume of patents at issue in this litigation and the reviews already instituted against ten of the thirteen asserted patents ... there is a strong likelihood that the USPTO proceedings will simplify the issues before the Court and conserve the resources of the Parties and this Court.” *Id.*, 3. The District Court therefore “ORDERED that the case is stayed pending the issuance of a final written decision in each of the respective *inter-partes* and *ex-parte* review proceedings.” *Id.*, 5.

Under *Fintiv*, “[a] district court stay of the litigation pending resolution of the PTAB trial allays concerns about inefficiency and duplication of efforts” and “[t]his fact has **strongly** weighed against exercising the authority to deny institution ... .” *Fintiv*, IPR2020-00019, Paper 11 at 6, citing *Precision Planting, LLC v. Deere & Co.*, IPR2019-01052, Paper 19 at 10 (PTAB Jan. 7, 2020) (emphasis added). Indeed, where a stay is in place, the Board has repeatedly held that discretionary denial concerns are effectively “rendered moot.” *Id.*

Consistent with this principle, the Board has explained that “[i]n light of [a stay], it is not necessary to analyze the *Fintiv* factors in detail because the Underlying Litigations are not currently proceeding in parallel with this case.” *Kea Cloud, Inc. v. Valyant AI, Inc.*, IPR2023-00450, Paper 12 at 17 (PTAB July 19, 2023). Likewise, in *Home Depot U.S.A., Inc. v. Lynk Labs, Inc.*, the Board emphasized that *Fintiv* factors “do not sufficiently weigh towards denial because the stay of litigation is **dispositive**[,]” PGR2022-00009, Paper 10 at 27–28, (PTAB May 25, 2022) (emphasis added).

**2. Factor 2: No Parallel Trial Date Weighs Against Discretionary Denial**

**Factor 2** strongly favors institution. The originally scheduled trial date of October 25, 2027 (Ex. 1112, 29) is now moot in view of the stay, which extends until “issuance of a final written decision in each of the respective inter-partes and ex-parte review proceedings.” *AutoConnect Holdings LLC*, 1:24-cv-01327-JCG, ECF 72, 5. The USPTO is now positioned to make patentability determinations for all of the patents asserted against Petitioner before the District of Delaware.

Referencing the timing of its litigation with Toyota and GM in the Eastern District of Texas, Patent Owner argues that it would be inefficient “to have three separate proceedings involving validity challenges of the ’100 patent[.]” (Paper 6, 11–12.) However, Patent Owner did not assert the ’100 Patent against Toyota.

*AutoConnect Holdings LLC v. Toyota Motor Corp.*, No. 2:24-cv-00802-JRG-RSP, ECF No. 1 at ¶17 (E.D. Tex. Oct. 3, 2024). Further, Petitioner is not a party to the Toyota/GM litigation, and those defendants have also filed a motion to stay that litigation. *Toyota Motor Corp.*, No. 2:24-cv-00802-JRG-RSP, ECF No. 124 (E.D. Tex., Dec. 5, 2025). The PTAB has “found that *Fintiv* factor 2 weighed strongly against exercise of discretion” when “Petitioner is not a party to the [other] Litigation.” *Bose Corp., v. Koss Corp.*, IPR2021-00612, Paper 15 at 24 (PTAB Sept. 15, 2021) citing *Owens Corning Roofing & Asphalt, LLC v. Kirsch Research & Dev., LLC*, IPR2020-01389, Paper 11 at 11 (PTAB Feb. 18, 2021). *See also Multi-Color Corp. v. Brook & Whittle Ltd.*, PGR2025-00025, Paper 10 at 2 (Dir. July 16, 2025).

**3. Factor 3: The Investment in Parallel Proceedings Weighs Against Discretionary Denial**

**Factor 3** strongly favors institution. Neither the parties nor the District Court invested significant resources in the Related Litigation prior to the stay. Discovery had just started and there had yet to be any depositions or expert reports, and the parties had just recently exchanged preliminary claim construction positions before any briefing occurred. (Ex. 1112, 28.)

**4. Factor 4: The Overlap Between Petition and Parallel Proceeding Weighs Strongly Against Discretionary Denial**

**Factor 4** strongly favors institution, particularly in view of the stay of the Related Litigation. As the Board explained in *Home Depot*, when litigation is stayed, concerns regarding overlap “do not sufficiently weigh towards denial because the stay of litigation is dispositive.” *Home Depot U.S.A., Inc.*, PGR2022-00009, Paper 10 at 27–28.

Petitioner challenged all claims of the '100 Patent in the IPR. (Pet., 3.) Petitioner filed a *Sotera* stipulation on January 14, 2026, mitigating concerns regarding duplicating efforts and inconsistent conclusions. (Paper 5.) *See Sotera Wireless, Inc v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020). The District Court has since stayed the litigation. Additionally, Petitioner withdrew its indefiniteness arguments for the '100 Patent in the District Court. (Ex. 3102, 1–2.) As the Board recently held in *Amazon.com, Inc. v. NL Giken Inc.*, a petitioner’s stipulation, combined with withdrawal of district-court indefiniteness positions, weighs against exercising discretion to deny institution under Factor 4. IPR2025-00050, Paper 12 at 11–12 (PTAB May 23, 2025).

Patent Owner argues that the Petition overlaps with the GM/Toyota litigation because GM included two of the four asserted references in its initial invalidity contentions. (Paper 6, 13–14; Ex. 2020.) Again, Patent Owner has not

asserted the '100 Patent against Toyota. Second, the asserted art is only two of the at least 32 references listed in Ex. 2020, which is merely an excerpt and does not include the full list. This undermines the impact of any alleged “overlap”. Further, Patent Owner asserts claims 9-11 and 15 against Petitioner, which it does not assert against GM, further reducing any alleged overlap. (Ex. 1125, 2–3; Ex. 1141, 1.)

**5. Factor 5: Whether the Parties Are the Same Is Neutral**

**Factor 5** is neutral. The parties before the Board and in the Related Litigation are the same. *See Shenzhen Root Tech. Co., Ltd. v. Chiaro Tech. Ltd.*, IPR2024-01296, Paper 9 at 19–20 (PTAB Feb. 25, 2025) (finding this factor neutral where parties are the same in both proceedings).

**6. Factor 6: Other Considerations Strongly Favor Institution**

**Factor 6** strongly favors institution, especially in view of the stay. *Home Depot U.S.A., Inc.*, PGR2022-00009, Paper 10 at 27–28 (*Fintiv* factors 4 and 6 “do not sufficiently weigh towards denial because the stay of litigation is dispositive.”)

Under *Revvo*, a petitioner must explain why it takes different claim construction positions in the petition and in district court. *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 (Dir. Nov. 3, 2025) (Precedential). Patent Owner argues that Petitioner has taken inconsistent claim construction positions without sufficient explanation. (Paper 6, 15–16.)

But Patent Owner’s argument is unfounded at least because: **(i)** Petitioner raised indefiniteness with respect to the *scope* of the claim language, which is permitted under *Tesla, Inc. v. Intell. Ventures II LLC*, IPR2025-00340, Paper 18 (Dir. Nov. 5, 2025) (Informative); **(ii)** Petitioner applied a *broader* construction in its Petition (Paper 2), which is permitted under *Sun Pharms. Indus., Inc. v. Nivagen Pharms., Inc.*, IPR2025-00893, Paper 18 at 3 (Dir. Sept. 19, 2025); **(iii)** Petitioner filed a *Sotera*-like indefiniteness stipulation conditioned on PTAB institution, which aligns with post-grant review stipulations where indefiniteness challenges are available, *see Samsung Elecs. Co. Ltd. v. CardWare Inc.*, PGR2023-00013, Paper 14 at 22–23 (PTAB Aug. 11, 2023); **(iv)** Petitioner withdrew its indefiniteness challenge in the District Court with its exchange of initial claim construction terms, based on recent PTAB guidance that disfavors conditional stipulations that “stress test claim constructions[,]” *Infineon Techs. Ams. Corp. v. MOSAID Techs. Inc.*, IPR2025-01456, Paper 27 at 4 (Dir. Mar. 17, 2026); and **(v)** the District Court recently stayed the Related Litigation in which the ’100 Patent is asserted pending the outcome of these proceedings (among others involving the patents asserted against Petitioner), weighing strongly against discretionarily denying institution. *Fintiv*, IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020) (Precedential) citing *Precision Planting, LLC*, IPR2019-01052, Paper 19 at 10 (PTAB Jan. 7, 2020).

**B. Petitioner Pursued Indefiniteness Consistent with *Tesla*, Pursuant to a *Sotera*-Like Stipulation, and Withdrew Indefiniteness When Subsequent Board Guidance Indicated that Conditional Stipulations Are Disfavored**

**1. Petitioner Pursued Indefiniteness Consistent with *Tesla* due to Unclear Claim Scope Boundaries**

In *Tesla*, the Director expressly rejected the notion that all indefiniteness challenges give rise to claim-construction gamesmanship. *Tesla*, IPR2025-00340, Paper 18. Instead, the Director drew a clear distinction between challenges premised on an inability to understand claim meaning and those based on uncertain claim scope boundaries, explaining that discretionary denial would not be warranted where, “notwithstanding the alleged indefiniteness of the claim term, an ordinarily skilled artisan would understand that the asserted art satisfies the claim limitation (such as if the limitation prescribed a range and only the outer bounds of the range were unclear).” *Id.*, 3–4. The challenged claims of the ’100 Patent fall squarely in this category.

The ’100 Patent does not use the terms “at least one,” “one or more[,]” and “and/or” in their conventional sense. Instead, the ’100 Patent expressly defines those terms as “open-ended expressions that are *both conjunctive and disjunctive* in operation.” (Ex. 1001, 6:37-44, emphasis added.) Petitioner argued in district court that this definition renders claims 1, 9, and 17 indefinite because a list of claim elements cannot be “both conjunctive and disjunctive.” (Ex. 1115, 3, 9–10, 14.)

While the District Court denied Petitioner’s motion to dismiss as premature at the pleading stage, explaining that “a determination on indefiniteness under 35 U.S.C. § 112 is not appropriate at the motion to dismiss stage,” and that indefiniteness is “intertwined with claim construction”, it agreed that Patent Owner’s definition for the terms provided in the patent specification was “nonsensical.” (Ex. 2006, 10, 8.) Overlooking the definition, Patent Owner argued that the “claim[s] cover[] both ‘the presence of more than one of the listed items’ and ‘the presence of a single listed item[,]’” but it does not have to “choose between the conjunctive and disjunctive meanings.” *Id.* at 7, citing Ex. 1006, 6, 7.

**2. Petitioner Pursued a Broad Construction After the District Court Rejected its Indefiniteness Argument as Premature, as Permitted by *Revvo***

The Director has explained that “a party may proffer a different, broader construction before the Board when the district court *already has rejected* petitioner’s narrower construction.” *Revvo Techs., Inc.*, IPR2025-00632, Paper 36 at 4 (emphasis in original), citing *Sun Pharms. Indus. Inc.*, IPR2025-00893, Paper 18 at 3. Petitioner proposed a broad construction of “*and/or*” as meaning simply “or” in the Petition after its indefiniteness argument was rejected by the District Court as premature, as permitted by *Revvo*. (Pet., 7–8; Ex. 2006, 8.)

**3. Petitioner Acted Reasonably Under Then-Existing Law and Eliminated Any Discrepancy Once Director Guidance Clarified Expectations**

Although the District Court found “Plaintiff’s use of ‘and/or’ as both conjunctive and disjunctive” to be “‘nonsensical’ because a limitation cannot have simultaneously A and B and C *and* A or B or C[;]” it denied Petitioner’s motion to dismiss the claims as being indefinite as procedurally premature. (Ex. 2006, 8, 10) (emphasis in original). To avoid waiver of its statutory defense, Petitioner served initial invalidity contentions on February 6, 2026 with indefiniteness grounds.

Before those contentions, Petitioner filed a *Sotera* stipulation on January 14, 2026 stating that: “If the PTAB institutes IPR2026-00173, Petitioner will not pursue against the ’100 Patent in [the Related Litigation] ‘the specific grounds [asserted in IPR2026-00173], or any other ground ... that was raised or could have been reasonably raised in an IPR ....” (Paper 5, 1–2.) Since post-grant review (PGR) provides for challenges under 35 U.S.C. § 112, a PGR *Sotera* stipulation includes indefiniteness. *See Samsung Elecs. Co. Ltd.*, PGR2023-00013, Paper 14 at 22–23 (granting institution of a PGR challenging patent claims under multiple grounds, including indefiniteness grounds, based on a finding that “Petitioner’s stipulation” to “not pursue section 101 or 112 invalidity grounds in the related district court litigation *if we institute*” “will reduce the potential overlap that may occur with the district court litigation,” (emphasis in original).)

Because a petitioner cannot challenge patent claims as indefinite in an IPR, and to eliminate any perceived discrepancy between forums, Petitioner made a

*Sotera*-like stipulation in its Opposition to PO's Request to withdraw all indefiniteness arguments against the '100 Patent from the Related Litigation if the PTAB instituted this IPR. (Paper 7, 19.) Petitioner's stipulation would therefore "resolve[] any potential inconsistency ... between forums[.]" *Caption Health, Inc. v. Univ. of B. C.*, IPR2025-01422, Paper 15 at 3 (Dir. Dec. 18, 2025).

In *Infineon*, the Director rejected a Petitioner's stipulation that included a condition precedent that was not controlled by the PTAB, i.e., "if the district court later determines that any of the challenged claims are indefinite, Petitioner will move to withdraw those claims from this proceeding." *Infineon Techs. Ams. Corp. v. MOSAID Techs. Inc.*, IPR2025-01171, Paper 27 at 4 (Dir. Feb. 19, 2026). Unlike *Infineon*, Petitioner's stipulation did not "wait and see" how a district court would later rule on indefiniteness. *Id.*

However, subsequent PTAB guidance indicated that the PTAB disfavors conditional stipulations that "stress test claim constructions". See e.g., *Infineon Techs. Ams. Corp. v. MOSAID Tech. Inc.*, IPR2025-01456, Paper 27 at 4 (Dir. Mar. 17, 2026) ("We are not in the business of aiding parties to stress test claim constructions to see which will prevail ... Petitioner's 'wait and see' approach again seeks the same unfair advantage discussed above[.]"). To eliminate any possible ambiguity, ***Petitioner withdrew its indefiniteness arguments concerning the '100 Patent from the Related Litigation at the beginning of the claim***

*construction process, thereby removing any condition precedent and any perceived discrepancy between forums.* (Ex. 3102.) Petitioner’s conduct reflects reasonable reliance on existing precedent, followed by prompt alignment with clarified Director guidance—precisely the behavior the Office has encouraged to promote predictability and fairness.

### **C. Settled Expectations of the Parties**

As in IPR2025-01342, IPR2025-01383, and IPR2025-01524, Flextronics is the original owner of the challenged patent and has continuously supplied the accused SYNC system to Petitioner for over ten years. Also, like IPR2025-01342, and IPR2025-01524, Patent Owner failed to pay the maintenance fee for the challenged patent causing it to lapse – for over three years. (Ex. 1107, 2.)

#### **1. Petitioner Had Strong Settled Expectations of Non-Enforcement**

Petitioner introduced SYNC in 2007 and began sourcing infotainment technology from Flextronics in 2010. (Exs. 1061, 3, 86; 1117; 1118.) Since 2014, Petitioner has manufactured vehicles incorporating Flextronics-supplied SYNC modules. (Exs. 1110; 1121, ¶4.) Although Flextronics assigned the ’100 Patent to Patent Owner on May 20, 2015 (Ex. 1120, 2), Petitioner remained unaware of the transfer until Patent Owner asserted the patent in December 2023. (Ex. 1005, ¶34.) Regardless of that assignment, Petitioner holds a license under Section 19 of its

Global Terms and Conditions to any Flextronics (or former Flex) patents covering technology supplied to Petitioner, including the SYNC system. (Ex. 1128, § 19.)

The Director has already decided Petitioner “had settled expectations that the challenged patents would not be asserted against it based upon ... its business relationship with the original owner of the challenged patents, Flextronics AP, LLC (‘Flextronics’).” IPR2025-01342, Paper 10 at 2. The Director further explained that it was, “eminently reasonable for [Petitioner] to expect its supplier, ... [would] have all necessary licenses” for the products it continued to sell to Petitioner. *Id.*, 3. Therefore, Petitioner’s “decade-long and continuous customer-supplier relationship, ... developed a well-settled expectation that it would not be accused of infringing the challenged patents.” *Id.*

## **2. Patent Owner’s Failures to Pay Maintenance Fees Favors Institution**

Patent Owner argues that “the ’100 patent issued *over a decade ago*, an age that weighs strongly in favor of discretionary denial.” (Paper 6, 4, emphasis in original.) Although the ’100 Patent issued in 2015, it issued to Petitioner’s supplier of the accused system, and after transfer, Patent Owner failed to pay the first maintenance fee by the October 27, 2019 deadline, resulting in the ’100 Patent lapsing. (Ex. 1107.) Patent Owner did not revive the ’100 Patent until April 5, 2023, i.e., over three years after it lapsed. (Ex. 1107, 2; Ex. 1002, 1175–1178.)

Patent Owner has a history of allowing its patents to lapse. Patent Owner allowed five asserted patents to lapse in 2019, including the '100 Patent, for failure to pay the first maintenance fee: U.S. 9,123,186 (Ex. 1103); U.S. 9,140,560 (Ex. 1104); U.S. 9,147,296 (Ex. 1105); U.S. 9,147,297 (Ex. 1106); and U.S. 9,173,100 (Ex. 1107). Patent Owner also allowed U.S. 9,020,697 to lapse in 2023 for failure to pay the second maintenance fee. (Ex. 1102). As confirmed by the Director, Patent Owner's failure to timely pay maintenance fees and maintain its patents in-force "cut[s] against any settled expectations that Patent Owner had developed ... ." IPR2025-01342, Paper 10 at 3. The combination of the above facts gave Petitioner the expectation that it would not be sued.

### III. CONCLUSION

Director Review is particularly appropriate under these circumstances to provide guidance on the Director's holistic approach to discretionary denial analysis, especially in view of a change in circumstances, *i.e.*, a stay of the Related Litigation. Reconsideration will promote consistency, fairness, and confidence in the Interim Director Discretionary Process. Accordingly, Petitioner respectfully requests the Director review and vacate the Decision denying institution of IPR2026-00173, and grant institution.

Dated: May 1, 2026

Respectfully submitted,

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**Certificate of Service**

The undersigned hereby certifies that on **May 1, 2026**, a complete and entire copy of **Petitioner's Request for Director Review**, was served via electronic mail to the attorneys listed below:

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**Certificate of Compliance**

This paper complies with the type-volume limitation of 37 C.F.R. § 42.6(a) and the length limitations of 37 C.F.R. § 42.24(a)(1)(v). The paper contains **15 pages**, excluding the parts of the paper exempted by § 42.24(a).

This paper also complies with the typeface requirements of 37 C.F.R. § 42.6(a)(ii) and the type style requirements of § 42.6(a)(iii)&(iv).

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