

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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Case No. IPR2026-00173  
Patent No. 9,173,100

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**PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL**

***Mail Stop "PATENT BOARD"***  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

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## PATENT OWNER’S EXHIBIT LIST

| Exhibit | Description   |
|---------|---|
| 2001    | Letter from William Woodford, Counsel for AutoConnect Holdings LLC to Steven Croley, General Counsel for Ford Motor Company, dated December 28, 2023.                                     |
| 2002    | Email from Tom Yerbernetsky, Counsel for Ford Global Technologies to William Woodford, Counsel for AutoConnect Holdings LLC, dated March 4, 2024.   |
| 2003    | Letter from Charles J. Monterio, Jr., Counsel for Ford Motor Company to William Woodford, Counsel for AutoConnect Holdings LLC, dated May 16, 2024.                                       |
| 2004    | Letter from Charles J. Monterio, Jr. Counsel for Ford Motor Company to William Woodford, Counsel for AutoConnect Holdings LLC, dated July 22, 2024.                                       |
| 2005    | Second Amended Docket Control Order, <i>AutoConnect Holdings, LLC v. Toyota Motor Corp. et al.</i> , No. 2:24-CV-00802-JRG-RSP, ECF No. 161 (E.D. Tex. February 10, 2026) (Payne, Roy S.) |
| 2006    | ORDER Denying Motion to Dismiss, <i>AutoConnect Holdings, LLC v. Ford Motor Company</i> , No. 1:24-CV-01327-JCG, ECF No. 24 (Dist. of Del. September 24, 2025) (Choe-Groves, J.)          |
| 2007    | <i>Intentionally left blank</i>   |
| 2008    | March 24, 2025 Guidance on USPTO’s recission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation”                       |

|      |  |
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| 2009 | October 3, 2025 Update to USPTO Interim Director Discretionary Process   |
| 2010 | USPTO FAQs for Interim Processes for PTAB Workload Management (Archived)   |
| 2011 | Scheduling Order, <i>AutoConnect Holdings, LLC v. Ford Motor Company</i> , No. 1:24-CV-01327-JCG, ECF No. 27 (Dist. Of Del. October 27, 2025) (Choe-Groves, J.)  |
| 2012 | USPTO Fee history for U.S. Patent No. 9,173,100  |
| 2013 | USPTO Decision on Petition to Accept Unintentionally Delayed Payment of a Maintenance Fee for U.S. Patent No. 9,173,100, March 7, 2023   |
| 2014 | USPTO Decision on Petition to Accept Unintentionally Delayed Payment of a Maintenance Fee for U.S. Patent No. 9,173,100, April 5, 2023   |
| 2015 | USPTO EPAS Assignment Cover Sheet and Assignment for U.S. Patent No. 9,173,100, Reel 36503, Frame 62, Executed: May 20, 2015, Recorded: August 28, 2015  |
| 2016 | <i>Intentionally left blank</i>  |
| 2017 | <i>Intentionally left blank</i>  |
| 2018 | Panasonic Article Regarding Development of Ford's SYNC 3, <a href="https://na.panasonic.ca/blog/inside-development-fords-syncr-3">https://na.panasonic.ca/blog/inside-development-fords-syncr-3</a> (retrieved December 7, 2025)   |
| 2019 | October 7, 2015 Business Insider Article Regarding Panasonic and Ford's Creation of SYNC 3, <a href="https://www.businessinsider.com/sc/panasonic-automotive-and-ford-partnership-2015-10">https://www.businessinsider.com/sc/panasonic-automotive-and-ford-partnership-2015-10</a> (retrieved December 7, 2025) |

|      |  |
|------|--|
| 2020 | <i>Excerpts of GM Invalidation Contentions served August 19, 2025, AutoConnect Holdings, LLC v. General Motors LLC, No. 2:24-cv-00877-JRG-RSP (E.D. Tex.)</i>  |
| 2021 | <i>GM’s Motion For Leave To Amend Invalidation Contentions, AutoConnect Holdings, LLC v. General Motors LLC, No. 2:24-cv-00877-JRG-RSP, ECF No. 102 (E.D. Tex. Nov. 12, 2025)</i>  |
| 2022 | <i>Declaration of Aidan Skoyles in support of GM’s Motion For Leave To Amend Invalidation Contentions, AutoConnect Holdings, LLC v. General Motors LLC, No. 2:24-cv-00877-JRG-RSP, ECF No. 102-1 (E.D. Tex. Nov. 12, 2025)</i> |
| 2023 | <i>Intentionally left blank</i>  |
| 2024 | <i>Intentionally left blank</i>  |
| 2025 | <i>Excerpts of Ford Invalidation Contentions served February 6, 2026, AutoConnect Holdings, LLC v. Ford Motor Company, No. 1:24-cv-01327 (Dist. of Del.)</i>   |
| 2026 | <i>Exhibit K-112 to Ford’s Invalidation Contentions served February 6, 2026, AutoConnect Holdings, LLC v. Ford Motor Company, No. 1:24-CV-01327 (Dist. of Del.)</i>  |
| 2027 | <i>Exhibit J2 to Complaint, AutoConnect Holdings, LLC v. Ford Motor Company, No. 1:24-CV-01327, ECF No. 1-29 (Dist. of Del. December 6, 2024)</i>  |

## I. INTRODUCTION

The Director should deny institution because the Petition comes far too late and would upset settled expectations without providing any of the efficiencies for which IPRs were created. Ford filed this Petition at the statutory deadline, over a decade into the '100 patent's term, and *two years* after it received detailed notice of its infringement. Multiple tribunals are already addressing the same validity analysis Ford seeks to pursue here. Instituting review would add a third forum addressing the same invalidity questions, with no realistic prospect of simplifying the existing actions and a significant risk of inconsistent outcomes.

Compounding the problem, Ford contends in the parallel litigation that the claims are so unclear as to be indefinite, yet here it asks the Board to adopt “plain and ordinary meaning” constructions here to sustain its obviousness theories. That inconsistency alone warrants denial of the petition. It also underscores that this Petition is not a focused or efficient vehicle for resolving validity, but rather an attempt to litigate issues in multiple fora based on contradictory positions.

Unable to justify its two-year delay and disturb AutoConnect's settled expectations in a decade-old patent, Ford pivots to a supplier-based narrative that it never actually believed and finds no support in the record. Although Ford asserts that Flextronics, the original applicant, “supplies the accused product” and that eliminated any reasonable possibility of infringement, the '100 patent itself

identifies AutoConnect—not Flextronics—as the patent owner, as confirmed by *the face of the patent* and the assignment recorded in 2015. Nor does Ford identify any evidence that Flextronics supplied the accused products, much less that it did so in an exclusive manner that could plausibly support reliance on exhaustion or first-sale principles. And when Ford was charged with infringement in 2023, it did not invoke any supplier-based immunity; that argument emerged two years later, once Ford sought to escape the consequences of its delay. This after-the-fact reframing cannot unsettle expectations or justify discretionary review.

Taken together, Ford’s delay, the advanced and overlapping parallel proceedings, the absence of any meaningful simplification, and the weakness and inconsistency of the Petition itself strongly favor discretionary denial. Institution would merely duplicate the efforts of multiple tribunals, complicate the resolution of ongoing litigation, and risk inconsistent outcomes—precisely the circumstances in which discretionary denial is warranted.

## **II. THE DIRECTOR SHOULD EXERCISE ITS DISCRETION UNDER 314(a) TO DENY INSTITUTION.**

Section 314(a) gives the Director broad discretion to decide whether an inter partes review should proceed. The USPTO “is permitted, but never compelled, to institute” an IPR, even when a petition meets the statutory thresholds. *Nautilus Hyosung Inc. v. Diebold, Inc.*, IPR2017-00426, Paper 17 at 11 (PTAB June 22,

2017). That principle has warranted denials where parallel litigation will address the same issues.

The Office has identified six factors to guide whether an IPR would advance or hinder efficient resolution: (1) whether the court has or will grant a stay in the parallel proceeding; (2) the proximity of the trial date to the Board’s projected final written decision deadline; (3) investment in the parallel proceeding; (4) overlap between issues raised in the Petition and the parallel proceeding; (5) whether the parallel proceeding involves the same parties; and (6) other circumstances that may bear on institution, including the merits. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020).

The Director’s guidance also calls for separate consideration of the parties’ settled expectations, including “the length of time the claims have been in force” and “any other considerations bearing on the Director’s discretion.” Dirs.’ Mar. 26, 2025 Mem., *Interim Processes for PTAB Workload Management*, at 2-3. Decisions applying that guidance show that long-standing notice and late-filed petitions weigh strongly against institution, even where some *Fintiv* factors might point the other way. *Dabico Airport Solutions Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 at 3 (June 18, 2025); *iRhythm Techs., Inc. v. CardioNet, LLC*, IPR2025-00363, Paper 10 at 3 (June 6, 2025); *Toyota Motor Corp. v. AutoConnect Holdings LLC*, IPR2025-00890, Paper 9 at 3 (Sept. 19, 2025). Those considerations favor denial here.

**A. The Parties’ Settled Expectations Favor Discretionary Denial.**

**1. Ford’s longstanding notice and delay reinforce strong settled expectations.**

A decade-old patent, longstanding notice, and petitioner delay all create circumstances in which settled expectations weigh strongly against institution. *Dabico*, at 3; *iRhythm*, at 3; *Toyota*, at 3; *Kingston Tech. Co., Inc. v. Vervain, LLC*, IPR2025-00614, Paper 12 at 2 (Acting Director Stewart July 16, 2025). Strong settled expectations support discretionary denial even when a final written decision will be issued before trial in a parallel proceeding. *See OnePlus Tech. Co., Ltd. v. Pantech Corp.*, IPR2025-00637, Paper 17 at 2 (August 14, 2025); *Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12 at 2 (July 31, 2025) (denying institution despite the case being stayed). Here, the ’100 patent issued *over a decade ago*, an age that weighs strongly in favor of discretionary denial.

Ford’s two-year delay in filing its petition despite being notified of its infringement also supports discretionary denial. *iRhythm*, at 3. Ford was notified of infringement in 2023 and responded that it was “diligently reviewing the patents and [infringement] claim charts.” Exs. 2001, 2002. Yet in Ford’s ensuing responses, it never addressed validity. Exs. 2003, 2004. It was only 23 months later, and 12 months after AutoConnect filed suit—the statutory deadline—that Ford filed this Petition. Ford’s “failure to seek early review of the patents favors denial.” *iRhythm*, at 3.

Ford asserts that Patent Owner “made no use of the ’100 patent” before December 2023 and that this cuts against discretionary denial. Pet. at 3. Even if that were accurate, the Board has expressly rejected this argument. *Google LLC v. SoundClear Techs. LLC*, IPR2025-00344, Paper 15 at 2 (August 4, 2025) (explaining that lack of prior assertion does not undermine settled expectations); *Kahoot!*, Paper 12 at 2. Ford’s two-year delay in challenging the ten-year-old ’100 patent and Patent Owner’s settled expectations support discretionary denial.

**2. Ford’s unrelated dealings with Flextronics does not disrupt the parties’ settled expectations.**

Ford attempts to excuse its delay by suggesting that it believed it would not be sued because “the original PO [Flextronics] supplies the accused product.” Pet. at 3. That assertion is unsupported and contradicted by the record. Ford offers no evidence that it actually held such a belief, no evidence that Flextronics supplies the accused systems, and no explanation why the involvement of a former patent owner—who divested the portfolio in 2015—would reasonably insulate Ford from infringement. Ford’s supplier narrative was not a contemporaneous expectation; it is a litigation construct offered to avoid the consequences of Ford’s delay.

*First*, Flextronics *does not and never has* supplied Ford with any products or systems accused of infringement. For the ’100 patent, Patent Owner accuses Ford systems “including non-transitory computer readable media that store computer-executable instructions and hardware and software that enable security measures” in

model year vehicles 2017 to present infringe the '100 patent. Ex. 1005 at ¶ 240; Ex. 2027. Unless Ford can tie Flextronics to those specific security functionalities in 2017 and later vehicles, its argument that Flextronics supplies “the accused product” fails. Pet. at 3. Ford makes no such showing.

Ford instead points to outdated and irrelevant materials, such as articles concerning legacy infotainment systems that are not accused and were replaced before the accused 2017 model year vehicles entered the market. *Id.* For example, Exhibit 1110 discusses a generic quality certification unrelated to any particular product. Exhibits 1117-1118 reference Flextronics’ involvement with a second generation SYNC system in 2010, which Ford replaced with SYNC 3 that Panasonic began developing in 2013. Ex. 2018 at 2 (noting that “Panasonic took on the SYNC 3 project in 2013” and led its design and implementation); Ex. 2019 at 4. Exhibit 1119 confirms that Ford had *moved to SYNC 3 by 2016*—the same timeframe it launched Apple CarPlay—but says nothing about Flextronics. None of these materials ties Flextronics to the accused security functionalities in 2017 and later vehicles. They show, at most, historical participation in unrelated systems—not supply of the accused products.

After similar deficiencies were exposed in other proceedings, Ford submitted a carefully worded declaration stating only that Flextronics supplies unspecified “SYNC modules.” *See* IPR2026-00002, Paper 8 at 3-6 (citing Ex. 1121). That

vague formulation does not cure the problem. “SYNC” is not a single, static system; it has been repeatedly overhauled, with the later generation systems in the accused vehicles supplied by other vendors. Moreover, *Patent Owner does not generically accuse “SYNC” as a brand name*—it accuses specific security-related functionalities. Ford’s intentionally vague reference to “SYNC modules,” untethered to identified structure or accused functionality—fails to show that Flextronics supplies the accused systems at issue here. Ex. 1005 at ¶ 240; Ex. 2027.

*Second*, even if Ford could show that Flextronics supplied some portion of the accused systems—which it has not—its theory would still fail absent exclusivity. Only if Flextronics were the *sole* supplier of the accused components could Ford plausibly claim that a retained license or exhaustion theory insulated it from infringement. Otherwise, the presence of other suppliers would independently expose Ford to liability—it would not be reasonable for Ford to assume a supplier would allow Ford to infringe by sourcing systems from a competing supplier. Ford has never alleged, much less proven, that Flextronics was the exclusive supplier of the accused security functionality in the 2017 and later vehicles. To the contrary, the record reflects that Ford relies on other suppliers for its infotainment and vehicle control systems. *Ford Motor Company v. AutoConnect Holdings, LLC*, IPR2026-00002, Paper 8 at 6 (Jan. 7, 2026). Without exclusivity, any supposed reliance on a supplier-based immunity collapses as a matter of logic.

*Third*, because Ford cannot show that Flextronics supplies the accused systems, it has no basis to presume that Flextronics retained license rights after divesting the patents. Companies routinely sell patents without keeping rights—especially when they do not practice the invention or when the technology no longer aligns with their business strategy, both of which were true when Flextronics sold the '100 patent to AutoConnect in 2015. Ex. 2015. It would be unreasonable for Ford to *assume* a supplier retained patent rights in a divestiture; that would allow a former owner to undermine the rights of the new owner simply by continuing to appear anywhere in the supply chain. Here, there is no evidence Flextronics ever practiced the claimed inventions. In any event, a sophisticated company like Ford would not rely on such a sweeping assumption when a single, straightforward inquiry to Flextronics would have resolved the issue outright.

*Fourth*, Ford has never offered evidence that it actually believed Flextronics retained license rights in the '100 patent family after assigning the portfolio to AutoConnect in 2015. The assignment was publicly recorded in 2015, and the face of the '100 patent identifies AutoConnect as the owner. Ex. 2015. Yet when Ford received detailed notice of infringement in 2023, it did not assert that a supplier's retained rights barred the claim, request confirmation of any such license, or otherwise indicate that it viewed itself as insulated from suit. That silence persisted for nearly two years. A sophisticated company that genuinely believed a supplier's

retained rights eliminated infringement exposure would have said so immediately, when it would have been most natural and advantageous to do so. Ford's belated invocation of this theory—only after discretionary denial became an issue—confirms that it is an after-the-fact construct rather than a settled expectation that guided Ford's actions.

**3. A brief and unknown maintenance-fee lapse cannot disturb settled expectations.**

Ford has also pointed to an unintentional and temporary maintenance fee lapse to undermine Patent Owner's strong settled expectations. Pet. at 2-3. Once again, Ford identifies no evidence that it was even aware of this lapse before litigation. Instead, Ford has confirmed it did not even know Flextronics assigned the patents to AutoConnect until December 2023. IPR2025-01342, Paper 8 at 19 (Nov. 7, 2025). If Ford did not know who owned the patent, it is implausible that it undertook the more detailed inquiry necessary to identify a maintenance fee lapse.

Ford has also asserted a vague intervening rights theory in another proceeding—seemingly suggesting it did not expect to be sued for infringement for vehicles it developed during the period of lapse, which is the 2019-2023 time frame

for the '100 patent.<sup>1</sup> IPR2025-01342, Paper 14 at 11-12 (Feb. 9, 2026). But Ford offers no factual support it ever undertook activities giving rise to intervening rights, and it also never raised this theory until over two years after it was sued, confirming it did not give rise to any settled expectations.

In any case, Patent Owner promptly corrected the error once it was discovered. It filed a petition for acceptance of delayed payment under 37 C.F.R. § 1.378(a), and after corresponding with the Office of Petitions, the USPTO granted the petition, accepted payment, and revived the patent in April 2023. Exs. 2012–2014. By regulation, once the Director accepts the delayed payment, “the patent shall be considered as not having expired.” 37 C.F.R. § 1.378(a). Ford therefore seeks to rely on a technical lapse that—by operation of law—is treated as though it never occurred. Patent Owner maintains a portfolio of nearly 100 patents, and a few, isolated administrative issues that Patent Owner promptly resolved fails to destroy

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<sup>1</sup> Any suggestion by Ford that it developed the accused systems during the 2019-2023 maintenance fee lapse (*see* IPR2025-01342, Paper 14 at 11-2) would contradict Ford’s assertion that Flextronics has been selling the accused systems since 2014 (*id.* at 5; *see also* Pet. at 3). Ford’s reliance on such inconsistent arguments only highlights its inability to support any of its claims that Flextronics actually supplies the accused systems.

Patent Owner's settled expectations. Nothing in the record suggests that Patent Owner treats its patents casually.

**B. *Fintiv* Factor 1 Favors Denial Because the Ford Action Has Not and Will Not Be Stayed.**

The *Fintiv* factors also favor discretionary denial. The Ford Action was filed over a year ago, involves thirteen asserted patents, and neither party has requested a stay. Consequently, this factor supports discretionary denial. Even if Ford were to request a stay based on this Petition, it would invariably be denied. *Siemens Indus., Inc. v. Westinghouse Air Brake Techs. Corp.*, No. CV 16-284-LPS, 2018 WL 3046511, at \*1 (D. Del. June 20, 2018) (denying stay where IPR proceedings were instituted for 8 of 12 patents because it “may slightly simplify some portion of the issues for trial, but would not simplify the majority of the case”); *Toshiba Samsung Storage Tech. Korea Corp. v. LG Elecs., Inc.*, 193 F. Supp. 3d 345, 349 (D. Del. 2016). Because no stay has been or will be entered due to incomplete IPR coverage, this factor favors denial of institution. *Id.*; see also *Mylan Labs. Ltd. v Janssen Pharm. NV*, IPR2020-00440, Paper 17 at 13-14 (PTAB Sep. 16, 2020).

**C. *Fintiv* Factor 2 Favors Denial Because Two Litigations Are Advancing, and One Will Reach Trial Well Before the IPR Deadline.**

Discretionary denial is also appropriate here due to the parallel Ford and GM Actions. It is an ineffective use of resources to have three separate proceedings

involving validity challenges of the '100 patent, which would needlessly duplicate effort and risk inconsistent claim constructions and validity determinations.

The Ford Action has been pending since December 6, 2024. Rather than file an Answer to Patent Owner's complaint, however, Ford filed a partial motion to dismiss that challenged only a subset of the patents based on a repeatedly rejected indefiniteness challenge. Although Ford's baseless motion has now been denied, it achieved its likely goal of delaying progression of the case for over seven months, resulting in trial date in October 2027. Exs. 2006 at 15, 2011 at 26. Due to Ford's baseless motion, the trial in the Ford Action will occur after a final written decision would be issued.

But the Ford Action is only one of two parallel litigations involving the '100 patent. The GM Action is currently set for trial on July 20, 2026, in the Eastern District of Texas. Ex. 2005 at 1; *see also* E.D. Tex. L.R. CV-83(a) (characterizing set trial dates as "firm trial dates"). Thus, trial in the GM Action will begin over eleven months before any final written decision in this *inter partes* review (June 2027). This timing favors discretionary denial. *See AT&T Services Inc. v. ASUS Tech. Licensing Inc.*, IPR2024-00992, Paper 14 at 10-11 (PTAB Dec. 16, 2024).

While the GM Action involves a different party, GM has already indicated it is coordinating validity challenges with Ford and the GM trial will focus validity challenges in the Ford Action. *See* Exs. 2021 at 2, 8; 2022, ¶ 7. And the timing of

the GM trial will result in a prior adjudication of validity prior to a FWD in this case.

Thus, *Fintiv* factor 2 favors discretionary denial

**D. *Fintiv* Factor 3 Favors Denial As the Parallel Cases Will Have Received Substantial Investment.**

By the June 11, 2026 institution decision deadline, both district-court actions involving the '100 patent will be far along. In the Ford Action, the parties will have exchanged infringement and invalidity contentions, and exchanged initial claim construction briefs. Ex. 2011. That weighs heavily in favor of discretionary denial. *BOE Tech. Grp. Co. v. Element Capital Commercial Co.*, IPR2023-00808, Paper 9 at 23–24 (PTAB Nov. 15, 2023). The only reason the Ford Action will not be even further developed is Ford's futile motion to dismiss.

The GM matter will be on the eve of trial with a pre-trial conference occurring shortly after the institution deadline in this case. Ex. 2005. Patent Owner and the E.D. Texas court will have dedicated substantial resources to resolving the same claims and validity issues Petitioner asks the PTAB to address. Proceeding with an IPR alongside these proceedings would yield the opposite of the efficiencies the IPR process was created to promote, and Factor 3 strongly favors denial.

**E. *Fintiv* Factor 4 Favors Denial Because the Invalidity Issues in the District Courts Substantially Overlap with Those Raised Here.**

The Director should also discretionarily deny institution because the grounds set forth therein overlap with the Ford and GM Actions. Specifically, GM, who is

coordinating invalidity efforts with Ford, challenges the validity of the '100 patent based on two of the four references relied upon in the Petition. Ex. 2020 at 62-63, 227.

The grounds in this Petition also overlap with Ford's invalidity arguments in the Ford Action. Ex. 2025 at 49-50, 213. Although Ford filed a *Sotera* stipulation, it is not dispositive. Paper 5; Ex. 2008 at 2-3. The USPTO has explained that reliance on system art and other invalidity theories renders a *Sotera* stipulation "not ... particularly meaningful because the efficiency gained by an AIA proceeding will be limited." Ex. 2009 at 3. Ford is doing just that by combining the IPR references with system art in its invalidity contentions to side-step any estoppel. Ex. 2025 at 213-215 ("It would further been obvious to combine any system identified in Section II.C.15 with any of the references charted in Exhibit K."). Similarly, the *Sotera* stipulation does not prevent Ford from relying on system art that embodies the teachings of the cited printed publications. Ford's contentions confirm this IPR is not a "true alternative" to district court. *See, e.g., SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01495, Paper 13, 8-9 (Apr. 7, 2025); *Motorola Sols. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (PTAB Mar. 28, 2025).

This factor favors discretionary denial.

**F. *Fintiv* Factor 5 Favors Denial Because This IPR Involves the Same Parties or Disputes as the Parallel Proceedings.**

The parties in this proceeding are the same as in the Ford Action. Thus, *Fintiv* Factor 5 favors denial.

While the GM Action involves a different party, it involves many of the same validity challenges to the '100 patent and GM is coordinating with Ford. Ex. 2020 at 62-63, 227. This duplication further supports discretionary denial. *Fintiv*, Paper 11 at 14.

**G. *Fintiv* Factor 6 Favors Denial Because the Petition Does Not Present Compelling Merits.**

A full merits analysis is not necessary for a discretionary denial analysis. Here, there is a single issue that confirms the merits do not support institution. Ford takes claim construction positions in its petition that contradict the positions it has taken in the parallel litigation. Specifically, Ford contends in the petition that it “applies the plain and ordinary meaning” of the challenged claims. Pet. at 7-8. But Ford has taken a very different position in the parallel litigation, asserting that every one of the challenged claims is invalid for indefiniteness. Ex. 2026 at 1-4. This is not a minor discrepancy—Ford maintains that *every independent claim contains seven terms that are indefinite*. These include, for example: (1) “a first security mechanism to enforce a security measure and form a perimeter network logically including the plurality of on board computational components;” (2) “on board

computational component not affected by or potentially affected by the instance of a breach of the security measure;” (3) “determine whether a computational component affected by the instance of a breach of the security measure can be isolated from at least one on board computational component not affected by or potentially affected by the instance of a breach of the security measure;” (4) “isolate” / “isolation;” (5) “one or more;” (6) and “and/or.”

Ford only addresses one of these discrepancies, stating that it adopts PO’s construction for “and/or” because “indefiniteness cannot be raised within an IPR petition.” Pet. at 8. But the Board and Director have confirmed this explanation is inadequate. *See Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 at 5 (Director Nov. 3, 2025) (precedential); *Tesla, Inc., v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 at 3 (Director Nov. 5, 2025) (informative). Ford’s inconsistent constructions of the claims, standing alone, warrants denial of institution. *Generac Power Sys., Inc. v. Champion Power Equipment, Inc.*, IPR2025-00805, Paper 40 at 4-5 (Feb. 3, 2026). Thus, the petition lacks compelling merits and factor 6 further supports discretionary denial

### **III. CONCLUSION**

The ’100 patent issued over a decade ago, giving Patent Owner strong settled expectations. Those expectations were reinforced by Ford’s failure to challenge the validity of the ’100 patent until two years after AutoConnect provided a claim chart

explaining Ford's infringement. In addition, Ford adopts claim constructions here that are inconsistent with its positions in the parallel litigation. On top of this, the GM Action involves many of the same validity arguments as presented in the Petition and that case will be tried long before a final written decision would be issued. As for the Ford Action, the '100 patent is but one of thirteen asserted patents, such that this proceeding would not meaningfully focus the case for trial. Institution here would wholly defeat the goals of discretionary denials—efficiency and integrity of the system. Patent Owner requests discretionary denial of the Petition.

Date: February 11, 2026

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the foregoing **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** and associated exhibits (Exhibits 2001-2006, 2008-2015, 2018-2022, 2025-2027) were served electronically via e-mail on February 11, 2026, in their entireties on the following counsel of record for Petitioner:

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