

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORP.,
Petitioner,

v.

EMERGING AUTOMOTIVE LLC,
Patent Owner.

Case IPR2024-00786
U.S. Patent No. 9,171,268

**PATENT OWNER'S
PRELIMINARY RESPONSE
UNDER 37 C.F.R. §42.107**

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EX2001	Declaration of Professor Sam Malek, Ph.D. under 37 C.F.R. § 1.68 in support of Patent Owner's Preliminary Response
EX2002	<i>Curriculum Vitae</i> of Dr. Malek
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EX2004	Cover pleading to Defendants' Preliminary Invalidity Contentions, <i>Emerging Automotive LLC v. Kia Corporation, et. al., and Toyota Motor Corp. et al.</i> , No. 2:23-cv-0437-JRG (lead case), No. 2:23-cv-0434-JRG (member case), served March 28, 2024
EX2005	Exhibit D-1 to Defendants' Preliminary Invalidity Contentions, <i>Emerging Automotive LLC v. Kia Corporation, et. al., and Toyota Motor Corp. et al.</i> , No. 2:23-cv-0437-JRG (lead case), No. 2:23-cv-0434-JRG (member case), served March 28, 2024
EX2006	Judicial Caseload Profile (March 31, 2024): Table C-5, <i>U.S. District Courts—Civil Federal Judicial Caseload Statistics</i> ; Table T-3, <i>U.S. District Courts—Median Time from Filings to Trial for Civil Cases in which Trials were Completed</i>
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EX2009	Google Patents search, U.S. Patent No. 9,171,268, available at https://patents.google.com/patent/US9171268B1/en?q=9%2c171%2c268#citedBy (identifying assignees of patents and patent applications which cited to U.S. Patent No. 9,171,268)
EX2010	Toyota's U.S. Patent No. 10,449,918, titled, "User Profile Synchronization for a Vehicle."

I. Introduction

The Board should exercise its discretion under 35 U.S.C. § 314(a) and *Fintiv* to deny institution. But should the Board analyze the merits of the Petition, it should deny institution because there is no reasonable expectation of success. Regarding discretionary denial, the district court litigation involves the same issues, the same parties, the same challenged claims, and the same asserted art, including the same primary reference for all Grounds here—*Xiao*. There is extensive overlap, and institution would needlessly waste party and Board resources through duplicate, parallel proceedings that create the potential for inconsistent results. The district court trial is set to occur months before the projected statutory deadline for a final written decision, and both parties and the district court have and will have expended substantial time and resources in the parallel litigation. Currently, fact discovery is well underway, motion practice regarding infringement and invalidity are already pending, multiple motions to compel discovery are on file, as well as upcoming depositions and the commencement of the claim construction process. And this is all months before the Board's institution decision in October 2024. Toyota has not sought a stay in the district court proceeding, and, given the recent decisions of Judge Gilstrap denying stay requests, any future motion, if sought, is unlikely to be granted.

Given the amount of work already undertaken by the district court and the parties, and the likelihood of inconsistent results on invalidity arguments and

asserted art for the same asserted patent claims on a trial due to precede any final written decision—efficiency and integrity of the system are best served by denying institution.

Moreover, the Petition fails to present a compelling patentability challenge to overcome the factors favoring discretionary denial. Indeed, the Petition includes several facial deficiencies. As an example, Grounds 1, 3a, and 4a all rely on the inaccurate assertion that “[c]laim 10 does not actively recite determining that applicable settings are compatible with settings that are settable on the selected vehicle” (EX1009, ¶ 119; Petition (“Pet.”) 25, citing EX1009, ¶¶ 117-126)—a claimed functionality identified and argued during prosecution to overcome art—and further seeks to eliminate the operation of the claimed “server” from claim 10 altogether (e.g. Pet. 27 (claiming that a command that works is “compatible with the selected vehicle because it is usable on the vehicle”)). But the claim *does* by its plain language recite that the “determining” is performed “by the server,” and that the server must ***determine***¹ “applicable settings ... that are preferred to be set as identified from the user profile ***and are compatible*** with settings that are settable on the selected vehicle.” EX1001, 33:1-26. In addition to attempts to avoid the express language of the claims, the Petition also ignores the meaning of the “determining

¹ All ***bold italic*** emphasis herein added unless otherwise noted.

compatible settings” requirement, as confirmed in the prosecution history, wherein the Applicant amended claims 10 and 20 to add “clarifying language that defines the exchanges between the server and the vehicle and the transfer of user profiles to a vehicle, such that settings that are compatible with a vehicle can be transferred for programming on the vehicle.” See EX1002, 196 (amendments to claim 10[c]), 200 (amendments to claim 20[a]), 202 (interview regarding the compatible settings), 203 (remarks in amendment), 213 (reasons for allowance include the independent claims’ limitation that “available vehicle settings that are determined compatible with settings identified in ... the user profile”). The Petition cannot simply disregard claim language that doesn’t fit its anticipation and obviousness challenges, and certainly cannot argue that the very language added to overcome prior art rejections, and cited as a reason for allowance, is now somehow superfluous.

As another example of its facial deficiency, the Petition ignores the claim language requiring the two elements that must be ***determined to be compatible*** with one another—(1) user profile settings that are preferred to be set must be determined to be compatible with (2) the settable settings in the selected vehicle. This is because the Petition’s alleged “determining compatibility” of ***Hayashi discloses neither user profile settings nor settable settings in a vehicle***. Grounds 2, 3b, 4b and 5 of the Petition must fail on this point alone, but also fail because *Hayashi* is not analogous

art, is not properly combined with *Xiao*, and contains absolutely no mention or disclosure of “compatibility” or *any* “compatible settings.”

The Petition is also fatally deficient concerning at least claim elements 10[c] and 20[a]—“determining, by the server, applicable settings ... that are ... compatible with settings that are settable on the selected vehicle” / “wherein certain of the user settings are determined to be compatible for use with the vehicle.”² The Petition fails to establish that any reference, alone or in combination, discloses or renders obvious these independent claim elements, which are recited in or incorporated by all of the challenged claims of Grounds 1-5. The entire Petition fails on this point alone.

These failures are discernable from the Petition itself and cannot be cured by expert testimony. Even if they could be cured (they cannot), Dr. Almeroth’s Declaration—made up principally of verbatim copying of attorney argument from the Petition—fails to add anything to the proceedings. Not one of Toyota’s grounds has any reasonable likelihood of success, failing to meet Petitioner’s evidentiary burden at the outset. Toyota’s Petition must contain evidence to show “that there is a reasonable likelihood that the petitioner would prevail.” 35 U.S.C. § 314(a). It does

² Claim 20’s preamble recites that the claimed method for managing a user profile of a vehicle is performed “via a cloud processing system;” additionally, claim 20[d] recites that the “method is executable by a processor.” EX1001, 34:43-47, 65-35:5.

not. And the Board must not institute to fill gaps in the Petition, to answer questions for which Toyota offers no evidence, or to construe claim terms for which Toyota asserts no construction is required. *See* Pet. 12. The Board routinely and properly dismisses defective Petitions like Toyota's at the outset. Institution should be denied.

II. The Board Should Deny Institution Under *Fintiv*

The Board should exercise its discretion to deny institution under § 314(a). To do so, the Board balances six factors:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the Petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11, 5-6 (P.T.A.B. Mar. 20, 2020).

"These factors relate to whether efficiency, fairness, and the merits support the

exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* In evaluating these factors, the Board takes “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.*

In addition, the USPTO Director issued an “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” (“Interim *Fintiv* Procedure”) dated June 21, 2022, which is addressed below with respect to *Fintiv* factors 2, 4, and 6.

As set forth in more detail below, a balance of the *Fintiv* factors—in view of the Interim *Fintiv* Procedure—warrants denial of institution.

A. The Board need not address the merits of the Petition because each factor favors denial, and Toyota has failed to present a compelling patentability challenge

1. Factor 1 Favors Denial (Likelihood of Stay)

Factor 1—which considers whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted—favors denial of institution.

Emerging Auto filed an infringement action on September 20, 2023, in the Eastern District of Texas, captioned *Emerging Automotive LLC v. Toyota Motor Corp.*, Case No. 2:23-cv-434, assigned to Judge Rodney Gilstrap. EX2008. Judge Gilstrap has since consolidated that lawsuit against Toyota with Emerging Auto’s infringement action against Kia Corporation, captioned *Emerging Automotive LLC*

v. Kia Corp., Case No. 2:23-cv-437, also assigned to Judge Rodney Gilstrap. EX2007. Toyota has not filed any motion to stay in the district court case. *Id.* Even if Toyota were to request a stay pending the outcome of this IPR proceeding, Toyota's request would likely be denied.

Courts in the Eastern District of Texas, and Judge Gilstrap in particular, disfavor, and as a general rule, deny motions to stay pending IPRs. *See Scorpcast v. Boutique Media*, No. 2:20-cv-00193-JRG-RSP, 2021 WL 3514751, at *1 (E.D. Tex. Jun. 7, 2021) (Judge Gilstrap reciting bases for denial of earlier motion to stay: "On October 27, 2020, the Defendants filed [their] original motion to stay pending resolution of the IPR. At the time the Defendants filed their original stay motion, the parties had served infringement and invalidity contentions, started the discovery process, and begun preparing for the claim construction hearing. The Court denied that motion.") (internal citations omitted); *and see, e.g., Force Mos Tech., Co., Ltd. v. ASUSTek Computer, Inc.*, No. 2:22-CV-00469-JRG, 2024 WL 1586266 (E.D. Tex. Apr. 11, 2024) (Judge Gilstrap); *Koninklijke v. Telefonaktiebolaget LM Ericsson*, No. 2:21-CV-00113-JRG, 2022 WL 17484264 (E.D. Tex. July 7, 2022) (Judge Gilstrap); *St. Lawrence Comms. LLC v. ZTE Corp.*, No. 2:15-CV-349-JRG, 2017 WL 3396399 (E.D. Tex. Oct. 29, 2021) (Judge Gilstrap).

The stay is even less likely here, given the significant case progression (discussed in factor 3) and scheduled jury trial preceding any final written decision

(discussed in factor 2). The first *Fintiv* factor supports denying institution. *See, e.g., Mylan Labs. Ltd. v. Janssen Pharmaceutica NV*, IPR2020-00440, Paper 17 at 13-14 (P.T.A.B. Sept. 16, 2020) (“We consequently conclude that the balance of facts in the two litigations indicate that no stay is likely to be entered in either, and therefore *Fintiv* factor 1 leans towards denial of institution.”).

2. Factor 2 Favors Denial (Timing of Trial)

Fintiv factor 2 weighs in favor of denying institution because the district court is set to complete trial before any final decision from the Board would be due. The jury trial in the Eastern District of Texas litigation is set to commence on July 21, 2025 (EX1014), whereas the Board’s final written decision would be due months later on approximately October 24, 2025. “If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under NHK.” *Fintiv*, Paper 11 at 9.

This timeline favors denial, as the Board has previously found that even a one-to two-month period between the trial date and the projected date of a final written decision favors denial. *See, e.g., NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 18 at 8-9 (P.T.A.B. May 2, 2022) (finding two-month period between trial date and deadline for final decision weighed in favor of discretionary denial); *E-One, Inc. v. Oshkosh Corp.*, IPR2019-00161, Paper 16 at 6-9 (P.T.A.B. May 15, 2019) (finding one-month period between trial date and deadline for final written

decision weighed in favor of discretionary denial); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12-13 (P.T.A.B. May 13, 2020) (factor disfavors institution when “the currently scheduled District Court trial is scheduled to begin two months before our deadline to reach a final decision”); *eClinicalWorks, LLC et al. v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (P.T.A.B. Apr. 13, 2022) (determining denial favored where beginning of jury trial was “roughly one to two months” before final decision was due); *Netflix, Inc. et al. v. Uniloc 2017 LLC*, IPR2020-00008, Paper 13 at 9 (P.T.A.B. Apr. 13, 2020) (finding two-month period between scheduled trial date and deadline for final written decision favored denial).

Additionally, the USPTO’s Interim *Fintiv* Procedure provides that the “[p]arties may present evidence regarding the most recent statistics on median time-to-trial for civil actions in the district court in which the parallel litigation resides for the PTAB’s consideration ... the PTAB will also consider additional supporting factors, such as the speed and availability of other case dispositions. *See Interim Fintiv Procedure*, 8-9.

Here, the median time from filing to case disposition in the Eastern District of Texas is 7.8 months, and the median time-to-trial is 21.1 months. EX2006, Judicial Caseload Profile, Table C-5 at 2, Table T-3 at 2 (Mar. 2024). Considering the 7.8-month median time for disposition in the Eastern District of Texas, the parallel litigation will likely be disposed of in 2024, over a year before the October 2025

statutory deadline for the final decision. *Id.*, Table C-5 at 2; *see* EX2007 (showing September 2023 complaint filing); EX2008 (same). Moreover, applying the 21.1-month median time to trial period, a trial in district court would be concluded nearly three months before the projected deadline for a final decision. *Id.*; EX2006, Table T-3 at 2.

Judge Gilstrap has already set the jury trial, and that jury trial will conclude well before the Board's projected statutory deadline. EX1014. Additionally, because of the stage of the underlying case and the speed with which the Eastern District of Texas reaches case dispositions, there are likely to be district court determinations relating to the validity of the '268 Patent in advance of the Board's projected statutory deadline. EX2006. Thus, *Fintiv* factor 2 favors discretionary denial.

3. Factor 3 Strongly Favors Denial (Investment in Parallel Proceedings)

Factor 3 strongly weighs in favor of denial because both Emerging Auto and Toyota will have expended considerable resources in the parallel litigation, including on the merits of Toyota's invalidity positions, by the time the Board issues an institution decision. *See Sand Revolution II, LLC v. Continental Intermodal Grp.*, IPR2019-01393, Paper 24 at 10 (P.T.A.B. June 16, 2020) (noting that investment in invalidity contentions is relevant to this factor).

For factor 3, the Board considers “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, Paper 11 at 9. “This investment factor is related to the trial date factor, in that more work completed by the parties and court in the parallel proceeding tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs.” *Id.* at 10.

Here, the Board is projected to issue an institution decision on October 24, 2024. Emerging Automotive served its infringement contentions on January 18, 2024, and on March 28, 2024, Toyota served its invalidity contentions, nearly seven months before the projected institution decision. EX2004. Toyota’s invalidity contentions include claim charts addressing the same primary reference (*Xiao*) asserted by Toyota in every ground of its Petition for every claim challenged in the co-pending litigation. EX2005. By the time of the Board’s institution decision, Judge Gilstrap will have issued a decision on at least four now-pending motions pertaining to technical aspects of the asserted patents – a motion to compel documents and discovery responses from Toyota, Toyota’s motion to compel documents from Emerging Auto, Toyota’s motion to amend its invalidity contentions, and Toyota’s motion to strike Emerging Automotive’s Infringement Contentions—a motion that argues both claim construction and the merits of infringement allegations. *See*

EX2007, ECF Nos. 54 (motion to compel Toyota's production of technical documents and discovery responses), 61 (addressing and incorporating Patent Owner's asserted claims and infringement contentions against Toyota), 63 (Toyota's motion to compel discovery responses), 65 (Toyota's motion to amend its invalidity contentions). Additionally, the parties have already exchanged interrogatory responses, exchanged document productions, and scheduled depositions. *Id.* Before the projected institution deadline, therefore, the parties will have completed multiple witness depositions, and the Court will have issued rulings on at least four substantive motions. *Id.* The parties further will have exchanged proposed claim terms and proposed constructions and will have prepared drafts of the Joint Claim Construction Statement, due on October 24, 2024. EX1014. While claim construction may not be completed before the institution decision, it will be well underway and since neither party has contended that claim construction is necessary to resolve the merits of the Petition (Pet. 12), an order coming shortly after institution does not overcome the substantial resources expended by the court and parties. *See, e.g., Mylan Laboratories*, Paper 17 at 18 (finding court's issuance of orders favored denial despite no claim construction order because "neither party has acknowledged any potential issues of claim construction that need to be resolved") (citing *Fintiv*, Paper 11 at 9)).

By the time the Board issues an institution decision, the district court has, and will have, spent considerable time and resources dealing with substantive motions. This factor favors denial. *Mylan Laboratories*, Paper 17 at 15, 18 (“Specifically, if, at the time of the institution decision, the district court has issued substantive orders related to the patent at issue in the petition, this fact favors denial.”) (citing *Fintiv*, Paper 11 at 9 and citing *E-One*, Paper 16 at 8, 13, 20).

Moreover, both Emerging Auto and Toyota will have expended substantial resources in the parallel litigation, including on the merits of Toyota’s invalidity positions, where—as detailed below—there is significant overlap of issues.

Discretionary denial is therefore favored here, since the parties and the court will have invested substantial time and resources, including substantial motion practice and ongoing fact discovery, by the October 24, 2024 institution deadline.

4. Factor 4 Strongly Favors Denial (Overlap of Issues)

Factor 4 weighs strongly in favor of discretionary denial because there is substantial overlap between the claims, arguments, and evidence raised in the Petition and in Toyota’s invalidity contentions in the parallel district court proceeding. Toyota’s proposed stipulation fails to obviate the concerns of duplicative efforts and conflicting outcomes raised by *Fintiv* and the USPTO’s Interim *Fintiv* Procedure.

The Petition challenges each asserted claim in the district court litigation (i.e., claims 10-20). Pet. 3. In the district court litigation, Toyota challenges the same claims using the same asserted references—*Xiao, Hayashi, Patenaude, and Singh*. EX2004, 10, 15-16; Pet. 3.

Toyota’s invalidity contentions served in district court therefore include the same asserted claims, as well as at least the same references applied against the same claims. *E.g.*, EX2004, 15-16 (identifying prior art references, including the four references cited in the Petition); *see* EX2005. And Toyota’s district court assertion of *additional* prior art and *additional* combinations of art than those asserted here does nothing to alter the degree of overlap between the Petition and its invalidity contentions. *See, e.g.*, *Fintiv*, Paper 15 at 15 (finding Petitioner’s assertion of additional invalidity contentions “not relevant to the question of the degree of overlap for this factor”).

Therefore, with this substantial overlap between the Petition and the parallel proceedings, there are particularly strong “concerns of inefficiency and the possibility of conflicting decisions” if the IPR is instituted. *See, e.g.*, *Fintiv*, Paper 11 at 12 (finding “concerns of inefficiency and the possibility of conflicting decisions [are] particularly strong” where there is substantial overlap).

Accordingly, factor 4 weighs strongly in favor of denial of institution. *See Teso LT UAB v. Luminati Networks Ltd.*, IPR2021-00122, Paper 12 at 10 (P.T.A.B.

Apr. 20, 2021) (finding “the overlap in issues between the two proceedings is substantial” where common art and common challenges to the independent claim were presented in both proceedings); *see also eClinical Works, LLC, et al. v. Decapolis LLC*, IPR2022-00229, Paper 10 at 12 (P.T.A.B. Apr. 13, 2022) (finding factor 4 weighed in favor of denial where Preliminary Invalidity Contentions showed overlap of asserted claims, art and arguments asserted in the Petition); *U.S. Venture, Inc. v. Sunoco Partners Marketing & Terminals L.P.*, IPR2020-00728, Paper 10 at 12-14 (P.T.A.B. Oct. 1, 2020) (finding overlap between primary references asserted in Petition and litigation weighed in favor of denial).

Toyota’s narrow stipulation fails to obviate the concerns of inefficiency and the possibility of conflicting decisions. The stipulation offers only to forego the specific “*grounds* raised in this Petition,” which fails to mitigate the duplicative efforts and the likelihood of inconsistent decisions on many of the same issues involving the same prior art. Pet. 74. The stipulation is inconsistent with *Sotera* and the Interim *Fintiv* Procedure, both of which demonstrate the need for a broad stipulation under this factor—breadth wholly lacking in Toyota’s stipulation:

Consistent with *Sotera Wireless, Inc.*, the PTAB will not discretionarily deny institution ... where a petitioner presents a stipulation not to pursue ... the same grounds as in the petition or any grounds that reasonably could have been raised in the petition.

Interim *Fintiv* Procedure at 3, 7-9. Toyota's stipulation is far narrower than the *Sotera* stipulation described by the Interim *Fintiv* Procedure, since there is no agreement not to pursue in district court "any grounds that could have reasonably been raised in the petition." *Id.*; Pet. 74. Toyota's failure to forego "grounds that reasonably could have been raised in [Toyota's] petition" only highlights the *Fintiv* concerns of duplication of work and the potential for conflicting decisions described. *See Samsung Elecs. Co., Ltd. v. Ancora Techs., Inc.*, IPR2020-01184, Paper 11 at 19-21 (P.T.A.B. Jan. 5, 2021) (finding stipulation to forego in litigation only the petition's asserted art does not "mitigate the 'concerns of inefficiency and the possibility of conflicting decisions,' nor does it ensure that an *inter partes* review is a 'true alternative' to the parallel District Court proceeding") (quoting *Fintiv*, IPR2019-00019, Paper 11 at 12); *International Business Machines Corp. v. Digital Doors Inc.*, IPR2023-00971, Paper 7 at 12 (P.T.A.B. Dec. 5, 2023) (denying institution when stipulation was narrow).

Finally, because Toyota does not stipulate even that the same prior art would not be relied upon in both proceedings, "both the Board and the district court would be analyzing and interpreting the same pieces of art, duplicating effort and potentially reaching inconsistent results;" indeed, the Board has already found that stipulations such as Toyota's are insufficient under this factor. *Samsung Elecs. Co., Ltd. v. Clear Imaging Research, LLC*, IPR2020-01401, Paper 12 at 21 (P.T.A.B.

Feb. 17, 2021) (finding overlapping claims challenged on the same prior art favored discretionary denial because duplication of work and potential for inconsistent decisions remained despite petitioner’s stipulation to forego grounds asserted in Petition).

For each of these reasons, factor 4 strongly favors discretionary denial.

5. Factor 5 Favors Denial (Overlapping Parties)

Patent Owner is the plaintiff and Petitioner is a defendant in the parallel litigation (EX2007), and “because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.” *Samsung v. Clear Imaging*, Paper 12 at 21-22 (quoting *Fintiv*, Paper 15 at 15) (finding factor 5 weighs in favor of discretionary denial given petitioner’s status as co-defendant in parallel litigation). When “a petitioner in *inter partes* review and a defendant in a parallel district court proceeding are the same, or where a district court is scheduled to go to trial before the Board’s final decision would be due in a related *inter partes* review, this factor weighs in favor of discretionary denial.” *Id.* (quoting *Sand Revolution*, Paper 24 at 12-13). Here, Toyota is both the petitioner and a defendant in the district court litigation, and that district court proceeding “is scheduled to go to trial before the Board’s final decision would be due” here. *Id.*; see also section II.A.2., above.

This factor therefore weighs in favor of exercising discretion to deny institution.

6. The Petition fails to show that any claim of the '268 patent is unpatentable, and accordingly, Factor 6 favors denial

The Interim *Fintiv* Procedure explains that “where the information presented at the institution stage is merely sufficient to meet the statutory institution threshold, the PTAB has the authority, where warranted, to exercise discretion to deny institution in view of the other *Fintiv* factors.” Interim *Fintiv* Procedure at 4. That is, given the factors favoring discretionary denial, as shown above, institution should be denied unless the Petition “plainly” “presents a compelling patentability challenge.” *Id.* at 3-4. As described above, the Petition not only fails to meet the statutory institution threshold, but also on its face, each Ground of the Petition suffers fatal flaws of proof: Grounds 1, 3a and 4a ignore the challenged claims’ required *server* operation to determine compatible settings—**because *Xiao* doesn’t disclose this operation**—and Grounds 2, 3b, 4b and 5 all disregard either element of *what must be determined to be compatible*—**because *Hayashi* doesn’t disclose or suggest either user settings or settable settings**. On this omission alone, Toyota cannot show *any* challenged claim to be unpatentable, let alone come close to presenting a “compelling” patentability challenge.

III. Institution should be denied because Petitioner has failed to show a reasonable likelihood of success on any challenged claim

Should the Board consider the merits, it should deny institution because the Petitioner failed to establish any reasonable likelihood of demonstrating that even a single challenged claim is unpatentable. Toyota fails to establish that *Xiao*, alone or in any of the alleged combinations, anticipated or would have rendered obvious any of the challenged claims.

All Grounds rely on *Xiao*, either alone or in combination with *Hayashi*, to disclose or render obvious the elements requiring “determining, by the server, applicable settings ... that are preferred to be set as identified from the user profile and are compatible with settings that are settable in the selected vehicle” (claim 10[c]) / “wherein certain of the user settings are determined to be compatible for use with the vehicle” (claim 20[a])—as in each of the challenged claims of the ’268 Patent. EX1001, 33:1-26, 34:43-35:21. The Petition identifies *Xiao*’s server looking up and retrieving command codes but identifies nothing in *Xiao* that ever mentions or discloses compatibility, let alone the required “determining, by the server, applicable settings ... that are preferred to be set ... and are compatible with settings that are settable on the selected vehicle[.]” Pet. 25-27. *Hayashi* cannot fill *Xiao*’s evidentiary void, as it merely provides guidance to a driver on how to *manually* operate vehicle functions, such how to operate a shift lever or a parking brake;

Hayashi never mentions or relates to user profile settings, settable settings, or checking for any compatibility between the two.

In addition, Grounds 2, 3b, 4b and 5 fail because the Petition never offers a rationale for a POSITA to combine *Hayashi* with *Xiao*, relying instead on claim terms of the '268 Patent to serve as a substitute. *E.g.*, Pet. 17 (“compatible guidance”), 46 (“these functions may include user settings”). *Hayashi* cannot be analogous art, as the Petition wrongly claims, as *Hayashi* concerns an entirely different technology problem, i.e., providing audio and video instructions to a driver who is unfamiliar with the operations of their rental car. And in any event, *Hayashi* is a manual, driver-implemented solution which a POSITA would dismiss as irrelevant to supplement the programmable vehicle commands of *Xiao*. EX2001, ¶¶ 94-96, 85-89.

Because Petitioner’s unsupported arguments fail to establish a reasonable likelihood of proving any challenged claim unpatentable, trial should not be instituted here.

A. The '268 Patent

U.S. Patent No. 9,171,268 (“the '268 Patent”) is entitled “methods and systems for setting and transferring user profiles to vehicles and temporary sharing of user profiles to shared-user vehicles.” The '268 Patent is part of a family of patents that teach and claim inventions for improving the efficiency, security, consistency

and overall user experience of personal, rental and shared-use vehicle systems. The inventions of the '268 Patent were invented by Albert and Angel Penilla (“Penilla brothers”) and issued to their company, Emerging Automotive LLC, a family-owned car innovation company.

The '268 Patent discloses the Penilla brothers' inventive systems and methods allowing for, e.g., the automatic transfer of user profile settings to vehicles and the employment of a cloud processing system to manage, update, learn from, improve upon, and automatically implement a personalized vehicle-user experience in vehicles. EX1001, 1:56-5:12. The inventions of the '268 Patent offer a specific, personalized user experience, defined by preferences the user sets in a user profile, while simultaneously achieving the scalability of applying those personalized settings to various shared vehicles and shared vehicle services—supporting a wide range of user preferences and vehicle types by, e.g., providing for a compatibility check between settings in the user profile and available settings on the vehicle before transferring the profile settings for programming on the vehicle. *Id.*; *see also id.*, 33:1-26, 34:43-35:21. As stated in the title, the '268 Patent involves transferring of user profile settings, making those settings available to a user from vehicle to vehicle. As part of this process, the systems and methods perform a compatibility check to ensure that a selected vehicle has particular settings available. EX1001, 31:65-32:3, 33:11-15, 34:42-51, 1:66-2:5, 10:42-55. Indeed, this “compatibility

check” was featured prominently in prosecution and used as a basis to overcome art. EX1002, 202-203, 213.

The innovations of the ’268 Patent have broad application to various shared vehicle services, supporting a wide range of users and vehicles, and are particularly beneficial for improving ‘mobility as a service’ industries, such as car-sharing, ride-hailing and other on-demand transportation solutions. *Id.* In fact, the innovations disclosed by the ’268 Patent have provided a foundation that persists in many of the shared vehicle and vehicle personalization technologies of today. Companies like Uber Technologies, Waymo, IBM, Google, Cisco, LG Electronics, Apple, Ford, Nissan, Honda, Audi, Daimler, and even Toyota have all cited to the ’268 Patent in their own patent applications. EX2009, 24-26 (Google Patents Search, U.S. Patent No. 9,171,268, identifying assignees of patents and patent application publications which cited to the ’268 Patent). Indeed, Toyota itself has recognized the novelty and importance of the functionality disclosed and claimed in the ’268 Patent. Years after the priority date of the ’268 Patent, Toyota filed a family of patent applications titled, “User Profile Synchronization for a Vehicle.” EX2010. The disclosure and claims of the patents in this family are remarkably similar to that of the ’268 Patent. *Id.* Toyota’s argument *now*—that transferring and synchronizing user profiles in vehicles was “well-known” at the time of the invention of the ’268 Patent—is belied by Toyota’s disclosure and investment in the technology years later and stands in

direct contradiction to the representations made to the Patent Office during prosecution of its later-filed patents. *Id.*

The innovations of the '268 Patent not only provide users with a more personalized, comfortable and secure experience, they also allow the owner of a vehicle (or a fleet of vehicles) more control and security in the management of their car and how the vehicle can be used by other drivers. EX1001, Abstract, 1:56-5:12, 6:13-29; 10:7-24, 42-55. For example, the inventions of the '268 Patent allow for an enhanced user experience, ensuring consistent comfort, convenience and security for the user across different vehicles—rented, shared or owned. *Id.* The inventions also support increased security and privacy, for instance, by allowing temporary profile management that ensures user data is protected by deactivating profiles after use. EX1001, 20:6-13, 33:61-34:3.

Additionally, the systems of the '268 Patent let the owner of a vehicle specify what settings will be available to another driver, like a child, a valet, a guest driver, a dealership “test-drive” customer, or a rental car customer, and because the invention includes a compatibility check between settings in the user profile and available settings on the vehicle, the system sends the owner automatic alerts when there is a violation of those settings. EX1001, 1:66-2:5, 10:15-24; 13:37-14:39.

B. The '268 Patent Prosecution History and Specification

The prosecution history provides relevant details on the claims' requirement that a server perform a compatibility check before transferring user profiles to selected vehicles—a requirement which the Petitioner and its expert explicitly seek to *read out of* the claims by mischaracterizing the file history, ignoring express examples in the specification, and, importantly, disregarding express claim limitations altogether because the asserted references do not disclose them. *See, e.g.*, Pet. 6-12, 25-26; EX1009, ¶¶ 60-78, 119.

During prosecution, the pending claims 1-20 were initially rejected as anticipated by the *Hendrix* reference (U.S. Publication No. 2012/0330494), and ultimately, Applicant made clarifying amendments to independent claims 1, 10, and 20, including adding language on “the check for compatibility of settings” to each of these claims. EX1002, 128, 192-201; *id.* at 203. An Examiner Interview was conducted, in which the Examiner and Applicant discussed “the clarifying language that defines the exchanges between the server and the vehicle and the transfer of user profiles to a vehicle, such that settings that are compatible with a vehicle can be transferred for programming on the vehicle.” *Id.*, 202. In this interview, the Examiner and Applicant reached an “[a]greement [] that the cited art to *Hendrix* does not teach these features, considered as a whole with the claims as amended.” *Id.*

Applicant then made those “agreed-upon” clarifying amendments to independent claims 1, 10, and 20, as well as amendments to claims 2-5, 7-9, 11-15, and 18. *Id.*, 192-201. For example, Applicant amended claim 10 to specifically include the terms “by the server” and “are compatible with settings that” in element 10[c]:

determining, by the server, applicable settings for the selected vehicle, the applicable settings being settings that are preferred to be set as identified from the user profile and are compatible with settings that are settable in the selected vehicle; and

Id., 196.

Applicant argued that amendments to each of the independent claims 1, 10 and 20 clarified “the way in which the user profile is used to enable transfer of certain vehicle settings to the vehicle.” *Id.*, 203. For example, Applicant made clarifications to independent claims 1 and 10, “such as the determination of vehicle settings that are determined compatible” (claim 10[c]) amendments); Applicant further clarified the vehicle settings that “are identified in the user preferences of the user profile” (claim 10[b] amendments). *Id.*, 196, 203; *see also id.*, 203 (“claim 10 was also amended to clarify the determining, by the server, of applicable settings for the selected vehicle...”). Likewise, independent “[c]laim 20[a] was also amended to recite that certain of the user settings are determined to be compatible for use with the vehicle.” *Id.*, 203; *see also id.*, 200. Applicant also made numerous amendments

to claim 20 “for clarity,” including amendments to the preamble, elements 20[b]-20[c] and 20[e]. *Id.*, 203; *see also id.*, 200. Applicant cited to paragraph 018 in support of additional claim 20 amendments. *Id.*, 203; *see also id.*, 39, ¶ [0018].

Importantly, “as examples of the check for compatibility of settings,” Applicant specifically cited to paragraphs “007, 0075” of the specification. *Id.* For example, the specification had described that a compatibility check can detect a violation of a setting or an incompatible setting, allowing for an automatic notification to be sent to the profile administrator:

In one example, the profile is associated with a plurality of vehicle types and the method includes detecting a violation of a setting or an incompatible setting in the profile that is user defined via the user account. The method can then automatically send a notification to a predefined administrator of the profile.

Id., 37, ¶ [0007]. As another example, the specification described a transfer of profile settings, in which a user’s vehicle screen displays only those third-party applications that are compatible with the vehicle selected, or is allowed to display to the user all applications, regardless of compatibility:

The screen displays can have various configurations, placements ... and the user can provide controls for some or all of the interfaces and controls in certain locations. The selection can be enabled for third-party applications. ... The third-party applications can be pre-identified by the site and displayed to the user if they are compatible

with the particular vehicle selected. In another embodiment, the third-party applications can all be shown to the user whether or not they are compatible with the vehicle. ...

Id., 55-56, ¶ [0075].

Applicant then relied upon this claimed functionality to overcome the rejection, arguing that “*Hendrix* does not teach to perform any compatibility between settings in the user profile against settings available on the specific vehicle” and therefore, “does not teach the transfer of user profiles to vehicles.” *Id.*, 203. With these amendments made to independent claims 1, 10 and 20, including the server’s check for compatibility of settings in the allowed claims, all pending claims were allowed. *Id.* The Examiner recognized that neither *Hendrix* nor “any art of record” discloses or suggests “...transferring the user profile, and configured the vehicle to automatically set on the vehicle one or more of the available **vehicle settings that are determined compatible** with settings identified in one or more of the user preferences of the user profile[.]” *Id.* (emphasis added).

Accordingly, each of the independent claims recites, and has written description for³, the server performing a compatibility check between settings in the

³ Despite Applicant’s express “examples of the check for compatibility of settings” (EX1002, 203) in Application No. 13/842,158, Petitioner inexplicably contends that

user profile against settings available on the specific vehicle. *Id.*, *see id.*, 203 (“See ¶¶ 007, 0075, as examples of the check for compatibility of settings...”); *and see id.*, 190-201 (amendments to claims 1-5, 7-15, 18, 20).

C. The ’268 Patent Challenged Claims

Toyota challenges eleven claims of the ’268 Patent, including independent claims 10 and 20. Claim 10 requires determining, by a server, applicable settings that are preferred to be set as identified from the user profile and are compatible with settings that are settable on the selected vehicle, and claim 20 requires a cloud processing system to determine that certain of the user settings for the vehicle are compatible for use with the vehicle. EX1001, 33:1-26 (claim 10), 34:43-35:21 (claim 20).

For example, challenged method claim 10 recites:

paragraph 0018, added in a October 2013 application, is the only written description “possibly supporting setting ‘compatibility[.]’” Pet. 8-12. The ’268 Patent properly claims priority to Applications 61,478,436, 13/452,882, 61/745,729, and 13/824,158, with the earliest-filed priority application dated April 22, 2011, and is properly supported under Section 112, as the Examiner found. Nonetheless, the Petition’s entire analysis on effective filing date and priority is completely irrelevant because the Petition fails regardless. Pet. 8-12.

10. A method, comprising,

...

determining, by the server, applicable settings for the selected vehicle, the applicable settings being settings that are preferred to be set as identified from the user profile and are compatible with settings that are settable in the selected vehicle,

Id., 33:1-26.

Similarly, challenged method claim 20 recites:

20. A method for managing a user profile of a vehicle ***via a cloud processing system*** being accessible over the Internet and wherein the vehicle is provided with wireless communication logic for connecting to the Internet for accessing the cloud processing system, comprising,

accessing the cloud processing system by the vehicle, ***the user profile having user settings for the vehicle, wherein certain of the user settings are determined to be compatible for use with the vehicle;***

...

the method being executable by a processor;

Id., 34:43-35:21.

As discussed below, *Xiao*—alone or in combination with *Hayashi*—fails to disclose or suggest these emphasized elements, which are included directly or by dependency in every challenged claim. Toyota instead seeks to read out the

limitations and rely on disclosure of *Xiao*'s preset command codes, codes that can only be "looked up" or "retrieved" by a server, and *Xiao*'s subsequent "generate command" step. Pet. 25-27 (Ground 1) (relying on *Xiao* for this element), 50-57 (Ground 3a) (relying on *Xiao* as to dependent claim 12), 57-62 (Ground 4a) (relying on *Xiao* as to dependent claim 14). But none of these disclosures of *Xiao* teach or suggest a server determining compatibility between settings in the user profile against settings available on the specific vehicle. And *Hayashi*—which offers only "guidance" to a driver on, e.g., how to manually operate a car's shift lever, how to manually operate a car's parking brake, etc.—does not even refer to settings, user settings or settable settings, let alone teach or suggest a server performing a compatibility check between user profile settings against settable settings on the specific vehicle. See Pet. 45-50 (relying on *Xiao-Hayashi* combination for element 10[c]), 50-57 (Ground 3b) (same as to dependent claim 12), 57-62 (Ground 4b) (same as to dependent claim 14), 64-67 (Ground 5) (same as to claim 20[a]). The Petition fails to show a reasonable likelihood of success and must be denied pursuant to 35 U.S.C. § 314.

Challenged claims 12 and 14 depend from claim 10, and no reasonable likelihood of success is shown for the grounds challenging these claims either, for the same reasons as discussed herein for claim 10. EX1001, 33:33-39 (claim 12); see also Pet. 3, 50-57 (Grounds 3a, 3b), 3, 57-62 (Grounds 4a, 4b). While Toyota adds

two new references, *Patenaude* and *Singh*, these references do not cure the deficiencies discussed above regarding the independent claims, and Toyota offers no argument or analysis to the contrary. *See id.*

Toyota's Petition fails completely on key elements of both independent challenged claims and should be denied institution on its (lack of) merits.

D. Claim Construction

The Petition does not offer any claim constructions or analysis of whether any claim language requires construction—instead offering the unsupported assertion that “the claims read on the prior art ... under any construction consistent with *Phillips*.” Pet. 12. But the Petition abuses and distorts the plain language of the claims to arrive at its conclusory “read on the prior art.”

Toyota's efforts to rewrite language out of the claims—rendering superfluous express claim language that was cited by the Examiner as a reason for allowance—cannot be correct. *Apple Inc. v. ContentGuard Holdings, Inc.*, IPR2015-00353, Paper 9 at 9 (P.T.A.B. June 25, 2015) (denying institution and rejecting Petitioner's proposed construction, finding that “[i]f we were to adopt this language proposed by Petitioner, it would render the claim phrase [] explicitly recited in independent claims [] superfluous”) (citing *Stumbo v. Eastman Outdoors, Inc.*, 508 F.3d 1358, 1362 (Fed. Cir. 2007) (disfavoring any claim interpretation that renders a claim term or phrase superfluous)); *see also Medacta USA, Inc. et al. v. RSB Spine, LLC*,

IPR2020-00264, Paper 46 at 13 (P.T.A.B. Apr. 15, 2021) (rejecting petitioner’s interpretation of claim limitation that “renders the term ‘primarily’ superfluous”) (*Bicon Inc. v. Straumann Co.*, 441 F.3d 945, 950 (Fed. Cir. 2006) (“[C]laims are interpreted with an eye toward giving effect to all terms in the claim.”); *see also Wasica Finance GmbH, et al. v. Continental Automotive Syst.*, 853 F.3d 1272, 1288-89, fn.10 (Fed. Cir. 2017) (Board erred by failing to give effect to claim terms expressly covered by the claim, as doing so would render other limitations meaningless); *Elekta Instrument S.A. v. O.U.R. Sci. Int’l, Inc.*, 214 F.3d 1302, 1307 (Fed. Cir. 2000) (construing claim to avoid rendering the 30 degree claim limitation superfluous).

The challenged independent claims here have specific elements requiring a server to determine that settings from the user profile are compatible with settings available on the specific vehicle. *See* Section III.C above. It is at least those elements that Toyota has failed to show are disclosed or suggested in the prior art asserted here. Because of these failures of proof, Toyota and its expert ignore claim 10[c]’s requirement that **a server** perform this operation of determining ... applicable settings ... that are preferred to be set as identified from the user profile and are compatible with settings that are settable on the selected vehicle.” Pet. 25 (citing EX1009, ¶ 119) (“[c]laim 10 does not recite actively determining that the applicable settings are compatible with settings that are settable in the selected vehicle”). But,

by its express language, claim 10 *does* recite the server performing the operation of determining that the applicable settings are preferred to be set as identified from the user profile and are compatible with settings that are settable in the selected vehicle. EX1001, 33:11-15. Claim 20, by its plain language, likewise requires that “a cloud processing system” carries out the recited method, including, “wherein certain of the user settings are determined to be compatible for use with the vehicle[.]” *Id.*, 34:42-51, 35:4-5. A person of ordinary skill in the art wouldn’t disregard express language from the claims. EX2001, ¶¶ 41-50. And a person of ordinary skill wouldn’t disregard this required server determining ... applicable settings ... that are compatible ...,” when the specification offers specific “examples of the check for compatibility of settings[.]” *Id.*; EX1002, 203; EX1001, 1:66-2:5, 10:42-55. Other than adopting the plain meaning, and rejecting Toyota’s efforts to read this express language out of the claims, construction by the Board is not needed to see why these elements are not present or suggested in the cited art.

Patent Owner reserves the right to propose or challenge constructions of terms other than those discussed herein in its § 42.120 Response if any trial is instituted.

E. All Grounds fail to establish a reasonable likelihood of proving any challenged claim unpatentable because neither *Xiao*, nor *Xiao* in combination, discloses or suggests at least the “determining ... compatible ... settings” claim elements 10[c] and 20[a]

Xiao, the primary reference for each ground, fails to disclose or suggest the “determining, by the server, applicable settings ... that are preferred to be set as identified in the user profile and are compatible with settings that are settable in the selected vehicle,” as required by element 10[c]. Similarly, *Xiao* fails to disclose or suggest “the user profile having user settings for the vehicle, wherein certain of the user settings are determined to be compatible for use with the vehicle,” as required by element 20[a]. While Petitioner proposes to add the *Hayashi* reference for Grounds 2, 3b, 4b and 5, *Hayashi* does not cure *Xiao*’s deficiencies.

Accordingly, Toyota’s failure to demonstrate any disclosure or suggestion of the elements applies to all Grounds. And all Grounds fail.

Further, Petitioner fails to show that *Xiao* is properly combined with the proposed secondary references. For example, *Xiao* and *Hayashi*—a combination relied upon for challenges to the independent claims (Grounds 2 and 5) and dependent claims 12 and 14 (Grounds 3b and 4b) are not even analogous art—*Hayashi* never mentions settings, let alone teaches anything about “applying settings to automobiles,” as the Petition incorrectly contends. Moreover, no POSITA would look to the manually implemented vehicle operations of *Hayashi* in an attempt to

supplement *Xiao*'s server relay of command codes and vehicle module implementation of vehicle commands. EX2001, ¶¶ 83-89. The fatal flaws concerning each *independent claim* (Grounds 1, 2, and 5) discussed herein are sufficient to warrant denial of institution.

F. There is no reasonable likelihood that Petitioner will prevail in its contention that the Ground 1, 3a or 4a challenged claims are anticipated or rendered obvious by *Xiao*

Xiao fails to disclose or suggest “determining, by the server, applicable settings ... that are preferred to be set as identified in the user profile and are compatible with settings that are settable on the selected vehicle,” as claimed by independent claim 10 and, by dependency, all claims challenged in Grounds 1, 3a and 4a. Further, *Xiao* also fails to disclose “receiving, at a server, information for a user profile of a user,” as required by all Ground 1, 3a and 4a challenged claims.

1. Petitioner has not shown that *Xiao* discloses “determining, by the server, applicable settings ... that are preferred to be set ... and are compatible with settings that are settable in the selected vehicle” of independent claim 10

Toyota failed to show that *Xiao* discloses a server “determining ... applicable settings ... that are preferred to be set as identified from the user profile and are compatible with settings that are settable in the selected vehicle,” as required by independent claim 10. The “determining ... applicable settings ... that are ... compatible” element is also recited in the body or included by dependency in all

challenged claims of Grounds 1, 3a, and 4a. *Id.*, 33:27-32 (claim 11), 33:33-39 (claim 12), 33:40-60 (claim 13), 33:61-34:3 (claim 14), 34: 34:4-42 (claims 15-19).

As discussed above, the '268 Patent teaches and claims setting and transferring user profile settings to vehicles, with a solution that uses a server to receive information for a user profile, identify a selected vehicle with settable settings on which to apply user profile settings, and perform a compatibility check between settings in the user profile against settings available on the specific vehicle—all *before* sending the applicable settings for programming on the selected vehicle. EX1001, 33:1-26. With this compatibility check performed by the server, the '268 Patent teaches user profile transfer methods that can, for example, allow the owner to specify what settings will be available to another driver, like a valet or a rental car customer, “detect[] a violation of a setting or an incompatible setting in the profile that is user defined via the user account,” and “automatically send a notification to a predefined administrator of the profile.” EX1001, 1:66-2:5, 10:15-24; 13:37-14:39. Toyota fails to identify any operation in *Xiao* that can detect such an incompatible setting. Pet. 25-27. Indeed, this claimed functionality was discussed extensively during prosecution and used to overcome the Examiner’s rejection in prosecution. *See supra* Sections III.B., III.D.

- a. *Xiao*'s "look up" and "retrieval" of command codes do not disclose or suggest "determining ... applicable settings ... that are preferred to be set ... and are compatible with settings that are settable on the selected vehicle," as claimed

Xiao never mentions or suggests determining compatible settings as claimed.

Ground 1 of the Petition relies on *Xiao*'s "command codes" (Pet. 25-27), but the server in *Xiao* never **determines** applicable settings, performing a compatibility check. EX2001, ¶¶ 61-70. Instead, *Xiao*'s server merely "looks up" and "retrieves" these command codes from a table. *Id.*; EX1010.

Xiao explains that command codes are preset codes or instructions that are stored in "automobile command information 606"—shown in Figure 6 below—which is a table that stores the automobile ID 628, command ID 630, and command code 632 "associated with each command that may be issued to the automobile 112" (*id.*, ¶ [0088]). *Id.*, Figure 6:

AUTOMOBILE COMMAND INFORMATION			606	
628	AUTOMOBILE ID	COMMAND ID	COMMAND CODE	632
	—	—	—	630
	—	—	—	
	—	—	—	

When *Xiao*'s server receives a command request from an operator, the server simply "look[s] up" and "retrieve[s]" the command codes "associated with each command."

Id., ¶ [0088] (“server may **look up** a particular command code 632 based on the automobile ID 628 and command ID 630 contained in a command request received from a mobile device 110...”), ¶ [0103] (“server may **look up** appropriate command codes 632 based on the automobile ID 627 and on the command IDs 630...”), ¶ [0103] (“server 118 may **retrieve** appropriate command codes 632 for these systems from automobile command information 606”). None of these “look up” or “retrieval” operations identified by the Petition discloses the required compatibility check recited by claim elements 10[c] or 20[a]. Pet. 25-27, 63-67; EX2001, ¶¶ 52-58, 61-70.

Xiao fails to even mention the word “compatible,” “compatibility” or “incompatible,” let alone disclose a server operation performing the claims’ required compatibility determination. EX1010; EX2001, ¶¶ 61-70. And because *Xiao* discloses no such compatibility check—not before and not after *Xiao*’s server looks up or retrieves command codes, these command codes cannot be the claimed “applicable settings,” which—as claim 10 requires—must be determined by the server to be “compatible with settings that are settable on the selected vehicle.” EX1001, 33:1-26; EX2001, ¶¶ 52-58, 61-70. Nor can the command codes of *Xiao* be the required “certain of the user settings” of claim 20[a] because this claim similarly requires that a cloud processing system must “determine[]” that “certain of

the user settings” are “compatible for use with the vehicle.” *Id.*, 34:43-34:21; EX2001, ¶¶ 52-58, 61-70.

Xiao’s “generate command” step 1108 of Figure 11 does nothing to fill the Petition’s disclosure gap for claim 10[c] or claim 20[a]. Pet., 25-27, 63-67; EX1010, ¶ [0088]); *see id.*, ¶ [0103]); EX2001, ¶ 71. The Petition identifies no disclosure on what “generat[ing]” a command entails, identifies no disclosure that this step performs a compatibility check between user settings against settings available on the specific vehicle, and never bothers to explain how this “generate command” step allegedly discloses the server performing the required compatibility determination between settings in the user profile against settings available on the specific vehicle. Pet. 25-27, 63-67 (citing EX1010, ¶¶ [0103], [0126], Figure 11); EX2001, ¶¶ 52-58. Accordingly, the Petition fails to show that *Xiao* discloses, explicitly or inherently, “determining, by the server, applicable settings ... that are preferred to be set as identified from the user profile and are compatible with settings that are settable on the selected vehicle” / “wherein certain of the user settings are determined to be compatible for use with the vehicle.” EX2001, ¶¶ 61-72.

b. Neither Toyota’s expert declaration nor citations to the prosecution history remedy the Petition’s shortcomings

Petitioner concedes that *Xiao* fails to disclose or suggest “determining, by the server, applicable settings ... that are preferred to be set ... and are compatible with

settings that are settable in the selected vehicle,” and instead seeks to read out the requirement from the claims. Petitioner cites to Dr. Almeroth’s declaration, which primarily just repeats verbatim the arguments of the Petition. Pet., 25-27 (citing EX1009, ¶¶ 117-126). As an initial matter, repetition and bare endorsement of attorney argument by Toyota’s expert is not helpful to the Board and should be disregarded. *Kinetic Techs., Inc. v. Skyworks Sols., Inc.*, IPR2014-00529, Paper 8 at 15 (P.T.A.B. Sept. 23, 2014) (“merely repeating an argument from the Petition in the declaration of a proposed expert does not give that argument enhanced probative value”). But ultimately, Dr. Almeroth’s characterizations of *Xiao*’s “command codes” and *Xiao*’s unexplained “generate command” function, like those of the Petition, are of no consequence since none of the identified disclosures teaches a server performing the claims’ required compatibility check. EX2001, ¶¶ 52-58, 61-72.

Aware of this shortcoming in proof, the Petition relies on Dr. Almeroth’s unsupported assertion that claim 10 somehow *does not require* that the server perform any function with respect to determining compatibility. Pet. 25-26 (citing EX1009, ¶¶ 117-126); EX1009, ¶ 119 (“Thus, *Xiao* discloses the single ‘determining’ step recited in claim 10. Claim 10 does not recite actively determining that the applicable settings are compatible with settings that are settable in the selected vehicle.”). Here, the Petition and Dr. Almeroth attempt to substitute an

adjective like “usable” with a *server operation* like “determining, by the server...,” by mischaracterizing the prosecution history. Pet. 27 (“This setting is compatible with the selected vehicle because it is usable on the vehicle”); EX1009, ¶ 124 (same). Tellingly, to try to “define” claim 10[c]’s compatibility requirement, the Petition and declaration rely on one of the lone sentences on EX1002, page 203 that does not mention the word “compatible,” “incompatible” or “compatibility,” along with that sentence’s citation to a paragraph (¶ [0018]), which itself does not mention the word “compatible,” “incompatible,” or “compatibility” (EX1002, 39, ¶ [0018]). Pet. 27; EX1009, ¶¶ 124-25 (same); *see* EX1002, 203.

Where the required ‘server determining compatible settings’ of claim 10 is *mentioned*, however, is in the express language of claim 10, the ’268 Patent specification’s examples of the check for compatibility of settings, and the patent prosecution’s claim amendments, traversed rejections and Reasons for Allowance—all of which make clear that claim 10 requires the server to perform a compatibility determination between settings in the user profile against settings available on the specific vehicle. EX1001, 33:1-26; *Id.*, 1:66-2:5, 10:42-55; EX1002, 196, 202-203, 213; *see also* Sections III.B. and III.D, above.

Petitioner’s efforts to read *out of* claim 10 the required **server** determining user profile settings that are compatible with settable settings in the vehicle only highlights the complete lack of relevant disclosure in *Xiao*, and regardless, is wrong

as a matter of law. *Apple*, IPR2015-00353, Paper 9 at 9 (rejecting proposed construction that would render claim language superfluous); *Stumbo*, 508 F.3d at 1362 (same); *Medacta*, IPR2020-00264, Paper 46 at 13 (same); *Bicon*, 441 F.3d at 950 (“[C]laims are interpreted with an eye toward giving effect to all terms in the claim.”); *Wasica Finance*, 853 F.3d at 1288-89, fn.10 (error to ignore claim terms expressly covered by the claim). The Petition’s Grounds 1, 3a and 4a, each of which depend on this erroneous construction of claim 10, fail for this reason as well.

Ground 5’s reliance on *Xiao* fares no better. Petitioner and Dr. Almeroth rely on the same deficient disclosures from *Xiao* for claim 20[a]’s required functionality that, “via a cloud processing system,” “certain of the user settings are determined to be compatible for use with the vehicle.” Pet. 64-66 (citing, e.g., EX1010, ¶¶ [0088], [0103]-[0104] and EX1009, ¶¶ 241-254). But as shown above, *Xiao* discloses no such functionality, and Petitioner cannot meet its burden by simply ignoring recited elements of the claims. *In re Smith*, 871 F.3d at 1381 (all claim elements must be shown).

As shown above, Petitioner’s arguments for disclosure of “determining, by the server, applicable settings ... that are ... compatible with settings that are settable in the selected vehicle” by *Xiao* are facially deficient, and do not show a reasonable likelihood that *Xiao* could anticipate any challenged claim. There is simply no disclosure in *Xiao* of the claimed compatibility check by the server. This

‘determining compatible settings’ element is recited in the body or included by dependency in all challenged claims of Grounds 1, 3a and 4a. EX1001, 33:1-26 (claim 10); *see also id.*, 33:26-34:43 (claims 11-19). Accordingly, Toyota’s failure to demonstrate any disclosure or suggestion of this element applies to and refutes all claims challenged in Grounds 1, 3a and 4a.

2. Petitioner has not shown that *Xiao* discloses “receiving, at a server, information for a user profile of a user” as recited in independent claim 10

As a separate and independent basis for showing that *Xiao* fails to anticipate any of the challenged claims of Grounds 1, 3a, and 4a, Petitioner has also failed to show that *Xiao* discloses the claim element of “receiving, at a server, information for a user profile of a user,” as claimed in the ’268 Patent. EX1001, 33:1-26 (claim 10). The “receiving ... information for a user profile” element is recited in, or included by dependency in, all Ground 1 challenged claims. *Id.*; *see also id.*, 33:27-32 (claim 11), 33:33-39 (claim 12), 33:40-60 (claim 13), 33:61-34:3 (claim 14) 34:4-42 (claims 15-19). Though the Petition adds references *Patenaude* and *Singh* to Grounds 3a and 4a, these references do not cure *Xiao*’s lack of disclosure on this element, and Toyota offers no argument or analysis to the contrary. The absence of this element is fatal to Grounds 1, 3a and 4a of the Petition.

a. The command request of *Xiao* is not “information for a user profile of a user”

Xiao does not anticipate any challenged claim because the Petitioner-identified “command request” of *Xiao* is inconsistent with, and fails to disclose, the required “information for a user profile of a user.” Pet. 19-23; EX2001, ¶¶ 52-58, 73-80. Petitioner starts with the premise that *Xiao*’s “profile information 614” is the “user profile of a user” recited in independent claim 10. Pet. 19-22; EX1010, Figure 6. *Xiao* describes “**operator profile information 614**” as being stored in a table of “**operator information 602**.” EX1010, ¶ [0066], Figure 6. Indeed, *Xiao* discloses that the information for an operator’s profile is stored in the table’s column titled, “profile information 614,” as shown in Figure 6 below:

608	610	612	614	616	602
OPERATOR INFORMATION					
OPERATOR ID	MOBILE ID	AUTHENTICATION INFORMATION	PROFILE INFORMATION	AUTOMOBILE PERMISSIONS	DEFAULT AUTOMOBILE ID
—	—	—	—	—	—
—	—	—	—	—	—
—	—	—	—	—	—

Id., Figure 6 (annotated).

But the relied-upon “command request” is not included within or otherwise information for *Xiao*’s “profile information 614,” and in fact, *Xiao* teaches that a “command request” contains information that is stored in an entirely distinct table. *Id.*, ¶ [0088], Figure 6. Specifically, *Xiao* discloses a server can “receive” a “command request” issued from a mobile device or computer, and that command

request is comprised of information from “**automobile command information 606**” – i.e., the command request contains **automobile ID 628** and **command ID 630**. *Id.*, ¶ [0088] (“the automobile ID 628 and command ID 630 contained in a command request received from a mobile device 110 and/or from a terminal device”), Figure 6.

AUTOMOBILE COMMAND INFORMATION		
AUTOMOBILE ID	COMMAND ID	COMMAND CODE
—	—	—
—	—	—
—	—	—

Id., Figure 6 (annotated). Therefore, whether *Xiao*’s server receives a command request to “start the engine of an automobile 112, and/or to customize the settings of one more systems of an automobile 112 based on an operator profile” (Pet. 21-22, citing EX1010, ¶ [0124]), that command request contains nothing more than the “**automobile ID 628**” and “**command ID 630**” as taught by *Xiao* (*id.*, ¶ [0088]), and as depicted in *Xiao*’s “**automobile command information 606**” table (*id.*, Figure 6). The **automobile ID** of *Xiao* identifies the vehicle to which the operator wants to issue the command (*id.*, ¶¶ [0086], [0088]), and the **command ID** of *Xiao* identifies a “particular automobile command” (*id.*, ¶ [0087]). Neither *Xiao*’s **automobile ID** nor its **command ID** is included in the Petition-identified “operator profile information

614,” and neither **automobile ID** nor its **command ID** is stored in the “profile information 614” column of “operator information 602” table, shown below:

608		610	612	614	616	602
OPERATOR ID		MOBILE ID	AUTHENTICATION INFORMATION	PROFILE INFORMATION	AUTOMOBILE PERMISSIONS	DEFAULT AUTOMOBILE ID
—		—	—	—	—	—
—		—	—	—	—	—
—		—	—	—	—	—

Id., Figure 6 (annotated). Accordingly, the command request—whose information is stored in *Xiao*’s automobile command information 606—cannot be said to disclose the required “information for a user profile of a user.” EX2001, ¶¶ 73-80.

Indeed, the Petition’s failure to identify any “receiving” disclosure in *Xiao* further highlights *Xiao*’s deficiencies on the “determining” element required by claim 10[c]—for the server in *Xiao* isn’t even “receiving” the “information for a user profile” against which a server can perform a compatibility check for the settings that are settable in the selected vehicle. *See* Section III.G.1., above. Rather, *Xiao*’s server merely receives a command request—containing an **automobile ID** and **command ID**—and fetches the corresponding command code 632 from the “**automobile information 606**” table to relay that command onto the vehicle. *Id.*, ¶ [0088].

In sum, Petitioner’s *Xiao* arguments are facially deficient, and do not show a reasonable likelihood that *Xiao* could anticipate or render obvious any challenged

claim. There is simply no teaching or suggestion in *Xiao* of the claimed “determining, by the server, applicable settings ... that are preferred to be set as identified from the user profile and are compatible with settings that are settable on the selected vehicle.” Indeed, *Xiao* never uses the word “compatible,” “compatibility” or “incompatible,” and certainly never discloses a server performing a check for compatibility between settings in the user profile against settings available on the specific vehicle. EX1010. Instead, *Xiao* discloses a limited, perfunctory pathway for the server to follow from the moment the server receives a command request associated with an account. Moreover, *Xiao*’s receipt of that “command request” is not the claims’ required “receiving, at the server, information for a user profile” since neither the “automobile ID” nor the “command ID”—comprising *Xiao*’s “command request”—is included in or information for *Xiao*’s “profile information 614.” Therefore, the Petition’s Grounds 1, 3a and 4a, which cite to and rely only on *Xiao* for both of these elements, must fail. *In re Smith*, 871 F.3d at 1381 (all claim elements must be shown).

While Petitioner adds *Patenaude* (Ground 3a) and *Singh* (Ground 4a), they do not cure deficiencies of *Xiao*, and Petitioner makes no argument to the contrary. Pet. 50-62; EX2001, ¶ 80.

G. Grounds 2, 3b, 4b and 5 fail because there is no reasonable likelihood that Petitioner will prevail in its contention that the challenged independent claims are obvious over *Xiao* in combination with *Hayashi*

For Grounds 2, 3b, 4b, and 5, Petitioner adds *Hayashi* in an attempt to cure *Xiao*'s deficiencies regarding the server determining compatibility requirements of each challenged claim. As discussed in Sections III.E. and III.F, above, both independent claims 10[c] and 20[a] require this "check for compatibility of settings": "determining, by the server, applicable settings for the selected vehicle ... that are preferred to be set as identified from the user profile and are compatible with settings that are settable in the selected vehicle" / "wherein certain of the user settings are determined to be compatible for use with the vehicle[.]" EX1001, 33:11-15, 34:42-51; EX1002, 203; EX2001, ¶¶ 41-50. The Petition failed to show that *Xiao* discloses or suggests this required check for compatibility of settings (Section III.F., *supra*), and *Hayashi* fails to fill the void of *Xiao*. And while Grounds 3b, 4b, and 5 include references additional to *Hayashi*, they also do not cure *Xiao*'s failures with respect to these elements, and Petitioner makes no assertion to the contrary. Moreover, the references are not analogous art, and Toyota fails to identify any teaching or problem disclosed in one reference that would point to another.

The Petition attempts to rely on the combination of *Xiao* with *Hayashi* to render obvious the compatibility check required of all challenged claims. Pet. 3

(Grounds 2, 3b, 4b, and 5 challenge claims which either include or incorporate the recited compatibility check of 10[c] and 20[a]). The Petition cites to and relies on only *Xiao* and *Hayashi* for alleged disclosure of these claim elements. *See, e.g.*, Pet. 25-27 (Ground 1, claim 10[c]), 45-50 (Ground 2, claim 10), 50-57 (Ground 3b, claim 12), 57-64 (Ground 4b, claim 14), 64-67 (Ground 5, claim 20[a]). As detailed further below, Grounds 2, 3b, 4b, and 5 each fail because *Hayashi* cannot cure the deficiencies of Petitioner’s *Xiao*-based anticipation theory to teach, suggest or render obvious the recited “determining, by the server, applicable settings ... that are preferred to be set as identified from the user profile and are compatible with settings that are settable in the selected vehicle” / “wherein certain of the user settings are determined to be compatible for use with the vehicle[.]” *Id.*; EX1001, 33:10-15 (claim 10[c]), 34:43-51 (claim 20[a]). Accordingly, this failure of proof is fatal to all remaining Grounds of the Petition.

As a separate and independent basis for denial of Grounds 2, 3b, 4b, and 5, Toyota has failed to explain how incorporation of all of the components from *Hayashi*—teaching guidance for **manual** driver operations within a vehicle—would be seen to benefit a person of ordinary skill with knowledge of the *automatic* implementation of commands in *Xiao*. The only thing motivating Toyota’s desire to point to the manually implemented solution in *Hayashi* is *Xiao*’s complete lack of any teaching or suggestion of the “determining, by the server, applicable settings ...

that are ... compatible ...” / “certain of the user settings are determined to be compatible for use with the vehicle” elements of the claims. Toyota’s attempt to reconstruct the claimed invention using hindsight and elements from a non-analogous source—*Hayashi*—is “insufficient to present a prima facie case of obviousness.” *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992); *see also Opticon Medical AB v. Cochlear Limited*, IPR2019-00975, Paper 154 at 29-30 (P.T.A.B. Oct. 14, 2020) (finding that the Petition’s proposed combination was based on improper hindsight and had not persuasively proven its stated rationale for the proposed modification). Toyota’s desire for invalidation is no substitute for a motivation to combine. This deficiency infects each of Grounds 2, 3b, 4b, and 5, because the Petition relies on the proposed *Xiao-Hayashi* combination to challenge independent claims 10 and 20.

1. Petitioner fails to show that *Xiao* could be combined with *Hayashi*

Toyota’s circular “motivation to combine” argument fails to provide the required motivation for a person of ordinary skill to combine *Xiao* and *Hayashi*, but instead relies on the disclosures of the ’268 patent to mischaracterize and cobble together unrelated references to call them “analogous art.” Pet. 45-50 (Ground 2), 50-62 (Grounds 3b and 4b), and 62-67 (Ground 5). Indeed, without the ’268 patent’s disclosures, Petitioner is left with no argument that a POSITA would have found a

reason in *Xiao* to point to *Hayashi* as a reference, no reason to make the proposed modification, and no combined solution that renders obvious any challenged claim. EX2001, ¶¶ 83-89; *see id.*, ¶¶ 90-96.

Xiao combined with *Hayashi* neither suggests nor renders obvious the compatibility check required of all claims—as shown below—but because Toyota has failed to show any proper motivation for combining the references, this failure of proof provides an additional reason that Toyota cannot meet its burden to establish a reasonable likelihood of success for any challenged claim of Grounds 2, 3b, 4b, and 5.

a. *Hayashi’s guidance to a driver on how to operate an unfamiliar car is not analogous art to the ’268 patent or Xiao*

The *Hayashi* reference is not analogous art and not in the same field of endeavor as either the ’268 Patent or *Xiao*, as Petitioner and its expert wrongly claim. Pet. 45-50, 64-67; EX1009, ¶¶ 189-192, 241-254; EX2001, ¶¶ 59, 83-89. Instead, *Hayashi* identifies a problem where a driver “mis-operates a vehicle he/she does not normally use,” such as a rental car, but it is “usually not possible for the driver to check the manual while driving.” EX1013, ¶¶ [0002], [0004]. *Hayashi* seeks to solve that problem by guiding the driver with “operating instructions” for unfamiliar functions in the car. *Id.*, ¶¶ [0002], [0004], [0123], [0120], Abstract. To do so, *Hayashi* identifies operating methods on a rental car that are familiar or unfamiliar

to the driver based on how frequently the driver has used that vehicle model. *Id.*, ¶ [0122] (“the extracted operating method means there is a difference in operating methods between vehicle 20 and a vehicle frequently used by the user”). And, if the driver is unfamiliar with how to operate the vehicle’s functions, *Hayashi*’s “driving support apparatus” provides the driver visual and audio instructions for the driver to manually follow. *Id.*, ¶ [0123] (“For example, scene determination portion 212 graphically depicts the positions of a shift lever, a parking brake, or the like on display portion 250 and guides the operating method thereof by voice.”). Those vehicle functions, *Hayashi* teaches, are the car’s shift lever, parking brake, etc. (*id.*, ¶ [0120] (“a function to be guided in the current vehicle state ... for example ... a shift lever, parking brake ...”)), and the operating methods are instructions for how to use vehicle functions, such as where to find that shift lever or parking brake in the car. *Id.*, ¶ [0122] (“The operating method may include information such as the positions of levers, switches and the like ...”).

Toyota’s assertion that *Hayashi* is “applying settings to automobiles based on user preferences” is wholly imagined, unsupported, and indeed belied by the reference itself. Pet. 45-50, 66 (citing “*Supra*, VII.B”); EX1009, ¶¶ 188-192; EX1013; EX2001, ¶¶ 59, 83-89. *Hayashi* never even mentions or suggests “profiles,” “settings,” or “user preferences,” and certainly has no teaching to “apply” its nonexistent user settings to vehicles. EX1013; EX2001, ¶¶ 59, 85-86. Toyota

does not claim that *Hayashi* involves a user profile wherein the user defines settings that a user prefers to be set in a vehicle. It does not. Therefore, *Hayashi* cannot be said to be “applying settings to automobiles based on user preferences.” Pet. 45-50, 66; EX2001, ¶¶ 85-86.

Rather, as described above, *Hayashi*’s “driving support apparatus” provides visual displays and voice guidance to a human driver on how that driver can ***manually*** operate an unfamiliar car—like engaging a parking brake. EX1013, ¶¶ [0002], [0004], [0123] (invention demonstrates to driver graphically displayed and audio operating methods for “a shift lever, a parking brake and the like”). *Hayashi*’s provision of guidance to a driver—e.g. how to engage the parking brake of an unfamiliar car—is simply not related to the transfer of user profile settings, or settings at all, to vehicles, nor is it “applying settings to automobiles based on user preferences,” as Toyota contends. *See id.*; *see also* EX2001, ¶¶ 84-86.

Likewise baseless is the Petition’s claim that *Hayashi* is “pertinent to the problem” of “improving convenience in applying settings to automobiles.” Pet. 45; EX1009, ¶ 192 (same); EX2001, ¶¶ 59, 87-88. Again, *Hayashi* never mentions or relates to settings, or *applying* settings, let alone offers any disclosure about the transfer of *settings that are preferred to be set in vehicles*. EX1013; EX2001, ¶¶ 84-88. By guiding a driver through the *manual* execution of tasks like locating and engaging a parking brake, *Hayashi* cannot be said to be “improving convenience in

applying settings to automobiles.” *Id.*; Pet. 45; EX1009, ¶ 192 (same); EX1013, ¶¶ [0122]-[0123]; EX2001, ¶¶ 59, 84, 87-88.

The Petition fails to show, therefore, that a POSITA would ever combine *Hayashi* with *Xiao*, as they are not analogous art or in the same field of endeavor. EX2001, ¶¶ 83-89.

b. The Petition’s repetition of the claim terms “compatible” or “user settings” does not cure its failure to offer a teaching, suggestion or motivation to combine *Hayashi* with *Xiao*

Toyota relies only on the benefits and novelty of the ’268 Patent itself to justify its proposed obviousness combination. The Petition cites to no problem or suggestion known in the prior art or disclosed in either *Xiao* or *Hayashi* that would motivate a POSITA to seek out the other reference. The supposed motivation to combine proffered by Petitioner and its expert is entirely conclusory and includes justifications based on their own unsupported conclusions—for instance stating, incorrectly, that *Hayashi* “demonstrates the concept of compatibility determination,” and then arguing that “[o]ne would have looked to *Hayashi* as an example of how a server may determine compatibility.” Pet. 46-48, 66-67; EX1009, ¶¶ 190, 195-196, 246-254. Ultimately, Toyota’s hindsight reasoning, even if parroted by an expert, cannot support a motivation to combine. *Kinetic Techs.*, Paper 8 at 15 (“merely

repeating an argument from the Petition in the declaration of a proposed expert does not give that argument enhanced probative value”).

For instance, the Petition repeatedly relies on mischaracterizations of *Hayashi* and *Xiao*, where Petitioner and its expert just insert ’268 Patent terms, not contemplated by the references, in an attempt to defend *Xiao* and *Hayashi*’s irrational and unworkable combination. *See, e.g.*, Pet. 46 (“these functions may include **user settings** for the vehicle, such as ‘shift lever, parking brake ...’”). As described above, *Hayashi* never mentions “user settings” or any settings, and *Hayashi*’s vehicle functions—like engaging a parking brake or a shift lever—are not defined by the user, based on user-defined preferences or any user setting at all. EX1013, ¶¶ [0122]-[0123]; EX2001, ¶¶ 83-89. Here, Toyota’s mischaracterization of *Hayashi*’s “functions” as “user settings” only highlights the lack of relevant teaching in the reference.

Toyota offers the same mischaracterization of *Hayashi* on compatibility. *See, e.g.*, Pet. 18 (“providing **compatible** guidance to the driver for the vehicle he/she is driving”). But *Hayashi*—like *Xiao*—never even mentions the word “compatible,” “compatibility,” or “incompatible,” nor does it relate to the “determining ... applicable settings ... that are preferred to be set as identified from the user profile and are compatible with settings that are settable” / “wherein certain of the user settings are determined to be compatible for use in the vehicle” elements required

by the claims. EX1013; EX1010. Toyota’s suggestion that a POSITA would be motivated to look to *Hayashi* for the “concept of determining compatibility” is completely void of supporting evidence and based entirely on hindsight. *See, e.g.*, Pet. 48, 67 (“it would have been obvious to indicate certain commands are **compatible/incompatible** with certain automobiles”).

Toyota never identifies any disclosure in either *Xiao* or *Hayashi* that would suggest looking to the other to solve the problem of automatically transferring settings that are compatible with settable settings on the vehicle. EX2001, ¶¶ 87-89. Toyota merely offers attorney argument, parroted verbatim by its expert, that *Xiao*’s server should “not attempt to command vehicles to do things they cannot do, potentially resulting in unexpected and/or undesired vehicle configurations or errors.” Pet. 46; EX1009, ¶190 (same). Nor does the Petition identify any suggestion from *Xiao* to alter its database of command codes, or any suggestion from either *Xiao* or *Hayashi* that would lead to the tables Toyota has created. Pet. 48, 66; EX1009, ¶¶ 195-196, 247-254 (same); EX2001, ¶ 88. Beyond inserting claim terms from the ’268 Patent and restating them as attorney argument, Toyota completely fails to identify any teaching or problem disclosed in one reference that would point to the other.

Indeed, without the hindsight knowledge derived from the ’268 Patent, no POSITA would ever look to *Hayashi*—an apparatus which guides a driver on how

to *manually* execute operating instructions in a vehicle—to modify *Xiao*—a process for relaying command codes over the Internet to control automobile systems executable by on-vehicle modules. EX1010; EX1013. In other words, a POSITA looking at *Xiao*’s programmable modules would immediately view the manually implemented instructions of *Hayashi* as completely irrelevant. *Id.*; *see also* EX2001, ¶¶ 92-96. The fact that *Xiao* and *Hayashi* both relate to cars, and both use well-known server and database components, is insufficient to show that one of ordinary skill in the art would have been led to combine *Xiao* and *Hayashi*. EX2001, ¶¶ 83-89.

2. Even if *Xiao* and *Hayashi* were analogous art, for which there was an actual motivation to combine, Petitioner failed to show that the combination discloses or renders obvious the compatibility check required of claim elements 10[c] and 20[a]

Assuming the references could be properly combined, the Petition nevertheless fails to demonstrate that the combination disclosed or suggested the server compatibility check of claims 10[c] and 20[a]. As shown above, the claims require a server to determine compatibility *between* two settings: settings in the user profile against settings that are settable on the specific vehicle. *See, e.g.*, Claim 10[c] (“the applicable **settings** being settings that are preferred to be set as **identified from the user profile** and are **compatible with settings that are settable in the selected vehicle**”); Claim 20[a] (“wherein **certain of the user settings** are determined to be

compatible for use with the vehicle....”). For example, as taught by the ’268 Patent, this check for compatibility can “detect[] a violation of a setting or an incompatible setting in the profile,” enabling the administrator of the profile to receive an automatic notification of this incompatibility. EX1001, 1:66-2:5. Because *Hayashi* never mentions or suggests user profile settings or settings that are settable in a vehicle, *Hayashi* cannot possibly teach or suggest a server checking for compatibility between user profile settings against settings available on the specific vehicle. EX1013; Pet. 44-50 (Ground 2), 50-67 (Grounds 3b, 4b, and 5).

In fact, the Petition’s use of the term “compatibility determination” is completely removed from the actual compatibility determination required of the claims. Toyota’s identified “concept of compatibility determination” involves no user settings or settable settings whatsoever. *See, e.g.*, Pet. 47. For example, in Toyota’s view, *Hayashi*’s “database of operating methods according to vehicle model 134,” illustrated in Figure 6, “demonstrates the concept of compatibility determination.” Pet. 47 (citing EX1013, ¶ [0029], Fig. 6); EX1009, ¶ 195 (same). But *Hayashi*’s database 134 is entirely devoid of any user settings—showing, instead, how a driver can engage a parking brake according to vehicle model α , β or γ , or where on the car a driver can find the shift lever in vehicle model α , β or γ . EX1013, Fig. 6; *see id.*, ¶¶ [0029], [0122]-[0123]; EX2001, ¶¶ 90-96. Neither the operating methods nor the functions of *Hayashi* database 134 teach or suggest

settings of a user profile—wherein *the user* defines settings to be set on a vehicle. *Id.*; EX1001, 33:1-26 (claim 10), 34:48-51-35:21 (claim 20). Therefore, the reference cannot teach or suggest any compatibility check *between* those nonexistent settings against settings available on the specific vehicle. *Id.*; EX2001, ¶¶ 90-96.

Hayashi also fails to teach or suggest any “settable settings” or settings that can be used or programmed on vehicles, and therefore cannot disclose the required “compatibility determination” of the claims for this reason as well. Pet. 48-50, 66-67; EX1001, 33:1-9 (claim 10[c]: “settings that are settable”), 34:43-51 (claim 20[a], “settings ... for use with the vehicle”). Instead, *Hayashi* merely differentiates between vehicle models that may, for example, have a shift lever in the same position or in a different position—and then tells the driver where to find or how to operate that lever. EX1013, ¶¶ [0122]-[0123]; EX2001, ¶¶ 90-96. *Hayashi* leaves it to the driver to implement vehicle functions; there is no determination—by a server or otherwise—of what settings are “settable” in a given vehicle. *Id.*

The Petition’s chimera of tables from *Xiao* and *Hayashi* only highlights this evidentiary void. Pet. 48, 67; EX1013. For instance, the Petition modifies *Xiao*’s table, “automobile command information 606,” which contains commands that are relayed to, and executed by, on-board vehicle systems. Pet. 48, 67; EX1010, ¶ [0088] (describing command codes as “CAN bus codes or other codes provided by the manufacturer of automobile 112 ... for controlling the systems to perform various

functions”). But the Petition modifies *Xiao*’s command information table with *Hayashi*’s operating methods to instruct a *human driver* how to *manually* operate the vehicle. Pet. 48, 67; EX1013, ¶¶ [0004], [0029], [0122], [0123]. Adding the *manual*, driver-implemented operation from *Hayashi* to *Xiao* does not somehow transform *Xiao* into a method capable of automatically transferring user profile settings to vehicles that are confirmed to be compatible with settings that are settable on the vehicle.

In sum, Petitioner’s obviousness arguments are facially deficient, and do not show a reasonable likelihood that *Xiao*—alone or with any other reference—could render obvious any challenged claim. There is simply no teaching or suggestion in *Xiao* or *Hayashi*—alone or in combination—of the claimed “determining, by the server, applicable settings ... that are preferred to be set as identified from the user profile and are compatible with settings that are settable in the selected vehicle” / “wherein certain of the user settings are determined to be compatible for use with the vehicle.” Petitioner’s Grounds 2, 3b, 4b, and 5, each of which rely only on *Xiao* and *Hayashi* for these elements, must fail. The Board need go no further to find a complete lack of any reasonable likelihood of success and needn’t consider the other references or the merits of the claimed combinations for dependent claims—which add nothing to *Xiao* and *Hayashi*’s missing disclosure here. The Petition should be

dismissed under § 314(a) for these reasons as well as those detailed in Sections III.F.1 and III.F.2 above.

IV. Conclusion

As shown above, the *Fintiv* factors and Interim *Fintiv* Procedure warrant the Board's exercise of discretionary denial.

Alternatively, for all the reasons stated above, the Petition fails to establish a reasonable likelihood of success as to any challenged claim, and therefore institution should be denied.

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Respectfully submitted,

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37 C.F.R. §42.24(d) CERTIFICATION

The undersigned hereby certifies that this submission, excluding the tables of contents, certificate of word count, exhibit list, and certificate of service, contains 13,784 words, as determined using the standard word counting feature of the Microsoft Word program.

Dated: July 24, 2024

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CERTIFICATE OF SERVICE

Petitioner has consented to e-mail service in this proceeding. Pursuant to 37 C.F.R. §42.6, the undersigned certifies that on July 24, 2024, a copy of the foregoing document was served by email upon the following counsel at the below email addresses:

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