

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORP.,
Petitioner,

v.

EMERGING AUTOMOTIVE LLC,
Patent Owner.

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

PETITIONER'S PRE-INSTITUTION REPLY

Petitioner's diligence filing the present IPR, its expanded stipulation, and the petition's strong merits outweigh other applicable factors and favor institution.

Factor 1 – Neutral: Patent Owner EA asserts this factor supports denial because Judge Gilstrap views motions to stay pending IPR with “disfavor.” POPR, 7. But *Fintiv* cautions against speculating whether the district court would grant a stay if requested; the absence of a district court stay is, at most, *neutral* and does not favor denial. *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019-15 at 12 (PTAB May 13, 2020).

Factor 2 – Does Not Warrant Denial: Trial is set in the district court for July 21, 2025, about three months before the Board's anticipated October 24, 2025, FWD deadline. EA provides median time-to-trial statistics, but, district-wide statistics are less useful for the Eastern District of Texas, where >70% of cases are assigned to Judge Gilstrap, delays are common, and case filings continue to rise. Ex. 1016 at 6; Ex. 1017 at 2. Judge Gilstrap has twenty trials scheduled for July 21, 2025, and it is impossible for all to proceed then. Further, EA's shorter median times for *disposition* (POPR, 9) are irrelevant, as neither *Fintiv* nor the June 21, 2022 Guidance Memo support weighing statistics for disposition *other than by trial*.

In any case, the district court trial date alone is not determinative. Guidance Memo at 8; *see also Google LLC v. Proxense, LLC*, IPR2024-00232-10 at 28–29 (PTAB Jul. 24, 2024) (instituting review when scheduled trial preceded FWD date by five months; same stipulation as this case); *Cisco Sys., Inc. v. Portsmouth*

Network Corp., IPR2024-00505-7 at 11–12 (PTAB Aug. 6, 2024) (same by two months; *Sand II*-type stipulation). EA cites decisions in which the Board denied institution (POPR, 7), but they are distinguishable because they do not involve *any* stipulation—much less a *Sand II*-type or greater stipulation, like here.

Factor 3 – Favors Institution: EA argues that the parties and court have invested “substantial time and resources” in the parallel district court litigation. POPR, 10–13. Yet, EA itself described the case as “in the initial stages” during early submissions to the Federal Circuit related to the mandamus petition of consolidated defendant Kia. Ex. 1018. By time of institution, the district court case will still not have advanced beyond fact discovery and claim construction will be ongoing (*Markman* hearing scheduled for January 16, 2025). Ex. 1014, 4. The district court’s substantive investment regarding invalidity will only be nominal.

Factor 4 – Favors Institution: EA argues that Petitioner’s stipulation fails to obviate concerns of inefficiency and duplication. POPR, 13–17. Toyota addresses this concern with the following additional stipulation: If the Board institutes this IPR, Toyota will not pursue any invalidity ground that includes *Xiao*, *Hayashi*, *Patenaude*, or *Singh* against the ’268 patent in the related litigation.

Factor 5 – Neutral: EA does not dispute the applicability of *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820-15 at 16 (PTAB Oct. 21, 2020), cited in the petition for the proposition that this factor is neutral. Petition, 74–75. Additionally, EA

has not shown that trial would precede the FWD by a *significant* period of time.

Factor 6 – Strongly Favors Institution: The PTAB will not “discretionarily deny institution in view of parallel district court litigation where a petition presents compelling evidence of unpatentability.” Guidance Memo at 2. The petition’s grounds are compelling and speak for themselves. EA makes only weak challenges to the merits, which do not withstand scrutiny.

Regarding ground 1, in arguing that *Xiao* does not disclose the claimed “determining” step, EA implicitly construes claim 10 to require that a server determines compatibility between (1) settings that are preferred to be set as identified from the user profile; and (2) settings that are settable on the vehicle. POPR, 3, 21, 39. EA also apparently seeks to read in nonexistent requirements to further narrow the word “determine,” such as requiring a server to generatively create settings that it judges to be compatible with already-existing settings that it also determines the vehicle can set. Petitioner maintains that claim construction is not necessary because *Xiao* discloses claim 10 under any construction consistent with *Philips*. And even under EA’s apparent constructions, *Xiao*’s disclosure of server 118 generating, looking up, or retrieving commands meets the claims, as set forth in the petition. For example, *Xiao* discloses a server determining “compatible” command codes based on (1) command IDs that are associated with an operator’s preferences; and (2) a particular automobile (e.g., automobile ID).

Petition, 25–26 (citing *Xiao* at ¶[0103], Fig. 11, and corresponding descriptions).

EA asserts that “look up” or “retrieval” cannot meet the claim, POPR at 37–39, however, the claim merely recites “determine.” EA cites nothing in the ’268 patent or prosecution history to limit this term to performing some narrower type of determination that would exclude look up or retrieval. *Id.*, 36. In any event, EA’s assertions are an irrelevant distraction because *Xiao* explicitly discloses that server 118 “may *determine* whether the operator ID, mobile ID, and/or automobile ID associated with the request is found in operator information 602 and/or in automobile information 604” (i.e., perform a “compatibility check”) and then generates commands to be sent to the automobile. *Xiao* at ¶¶[0125]–[0126].

EA is incorrect that *Xiao* must use the word “compatible” to meet the claim because anticipation does not require identity of language. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990). EA itself explained what the claims meant during prosecution when arguing the “compatibility” feature distinguished from the cited art: “the user profile may have many preferences for settings, and some of such settings are *usable* on certain vehicles.” Ex. 1002, 203. EA cannot retreat from this characterization to a narrower construction to save its claims. The petition demonstrates how *Xiao*’s “applicable” settings are “compatible with settings that are settable in the selected vehicle,” as claimed. Petition, 26–27.

In another attempt to distinguish *Xiao*, EA argues *Xiao*’s operator profile

information 614 (or “information for” it) must include the contents of a command request to meet the claimed “information for a user profile of a vehicle.” POPR, 47. EA appears to suggest that *Xiao*’s disclosures of information being stored in association with an operator or automobile ID means that information is somehow cabined to the particular sub-tables illustrated and (incorrectly) isolated from one another. *Id.*, 43–46. Even under EA’s apparent view, the petition shows that *Xiao* discloses this element, as evidenced at least by ¶¶[0102]–[0103] (explaining the server uses command IDs that are “associated with *the operator*’s desired system settings 614” and which correspond to an operator ID), and ¶[0079] (explaining the server “may update the stored operator profile information 614 *for the operator*.”).

Regarding ground 2, EA asserts that *Hayashi* “never even mentions or suggests ‘profiles,’ ‘settings,’ or ‘user preferences....’” POPR, 52. But the ’268 patent describes user settings as including “settings of the seats, the mirrors....” Ex. 1001, 21:11–15. And *Hayashi* discloses “seat adjustment function, or mirror adjustment function.” Petition at 18, 46 (citing Ex. 1010 at ¶¶[0120], [0122]).

EA also argues that *Hayashi* is irrelevant to *Xiao* because it provides guidance to a driver to “manually execute operating instructions in a vehicle,” making it inapplicable to *Xiao*’s process for relaying command codes to control automobile systems. POPR, 57. But physical combinability is not required. *MCM Portfolio LLC v. Hewlett-Packard Co.*, 812 F.3d 1284, 1294 (Fed. Cir. 2015).

Respectfully submitted,

Dated: August 23, 2024

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Petitioner's Pre-Institution Reply** was served on August 23, 2024 via email directed to counsel of record for Patent Owner at the following.

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