

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 9,171,268

PATENT OWNER'S SUR-REPLY

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PATENT OWNER'S UPDATED APPENDIX OF EXHIBITS

Exhibit	Description
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
EX2003	[Reserved]
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>
EX2007	Civil Docket Report for <i>Emerging Automotive LLC v. Kia Corporation, et al., and Toyota Motor Corp. et al.</i> , No. 2:23-cv-0437-JRG (lead case)
EX2008	Civil Docket Report for <i>Emerging Automotive LLC v. Toyota Motor Corp. et al.</i> , No. 2:23-cv-0434-JRG (member case)
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)

Exhibit	Description
EX2010	Toyota’s U.S. Patent No. 10,449,918, titled, “User Profile Synchronization for a Vehicle.”
EX2011	[reserved]
EX2012	Email Correspondence from counsel for Petitioner, to Counsel for Patent Owner, dated August 7, 2024, explaining “good cause” for additional briefing
EX2013	Judge Gilstrap Trial Schedule for July 21, 2025
EX2014	Civil Docket Report for <i>Stingray IP v. Vivint, Inc.</i> , No. 2:23-cv-00503-JRG-RSP
EX2015	Civil Docket Report for <i>Emerging Automotive LLC v. Kia Corporation, et. al., and Toyota Motor Corp. et al.</i> , No. 2:23-cv-0437-JRG (lead case) (updated September 6, 2024)
EX2016	Docket Navigator Median Time-to-Trial Statistics for Judge Rodney Gilstrap (excluding transfers), August 26, 2019 through August 26, 2024

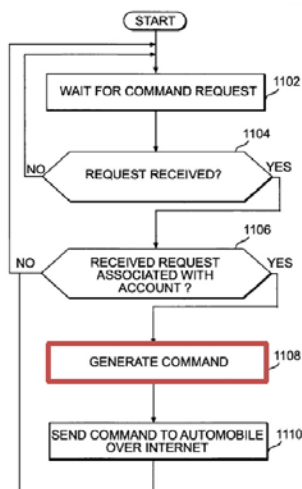
I. PETITIONER’S REPLY CONFIRMS THAT THE PETITION SHOULD BE REJECTED BECAUSE THE “COMPATIBILITY CHECK” IS NOT DISCLOSED OR SUGGESTED

While Petitioner requested additional briefing to address “developments in the parallel district court proceeding,” the Reply omits each of the litigation developments since the filing of the POPR, and instead seeks to cure the clear substantive defects in the Petition. EX2015; EX2012. Petitioner’s subterfuge¹ only highlights that the Petition fails on the merits. Even if a post-petition reply could cure deficiencies, nothing remedies the Petition: neither *Xiao*, nor *Xiao/Hayashi* discloses or suggests the claims’ required compatibility check, and in any event, no POSITA would combine *Hayashi* with *Xiao*, as Toyota incorrectly contends.

Toyota’s bait-and-switch highlights Xiao’s deficiencies: The Petition pointed to “**step 1108**” as the “**determining**” function and “**command codes 632**” as the “**applicable settings**,” but the POPR showed that neither is a server performing the recited compatibility check. POPR, 35-43; Pet. 24 (“Xiao discloses **determining** (e.g., **step 1108**), by the server (e.g., server 118), **applicable settings** (e.g., **command codes 632**)”); EX1009, ¶ 117 (verbatim). Confronted with its failures of proof,

¹ Patent Owner did not move to strike the Reply because “the Board is capable of ... disregarding any new issues or belatedly presented evidence that exceeds the proper scope of reply.” PTAB Consol. Tr. Pract. Guide (Nov. 2019), 80.

Toyota makes a 180-degree turn, conceding that Toyota and its expert were wrong to point to *Xiao*'s "**step 1108**" of Figure 11 as the required "determining" step of claims 10[c] and 20[a]. Reply, 4; Pet. 24-25. Toyota now makes the brand-new and



unsupported assertion that the alleged compatibility check happens **before** "**step 1108**"—that is, before the step Dr. Almeroth opined was the claims' recited "**determining**" function. EX1009, ¶ 117; Reply, 4 "... (i.e., perform a 'compatibility check') and then generates commands") (citing *Xiao*, ¶ 125 for the first time) (¶ 125 describing "step 1106" of figure 11). But this belated and improper attempt to change theories cannot save the defective Petition, as it presents another problem for Petitioner: *Xiao*'s step 1106—determining whether a command request is associated with an account—has absolutely no mention of the "**command codes 632**" that Toyota points to as alleged "applicable settings," nor any discussion about *settings* whatsoever. EX1010, ¶ 125; Pet. 24-25. Even with this new-found alleged disclosure about associating a request with an account, Toyota still cannot explain how this or *any* function of *Xiao* can "detect[] a violation of a setting or an incompatible setting in the profile that is user defined via the user account," a feature enabled by the claims' server compatibility check. EX1002, 37, 203 (citing as examples, ¶¶ [0007], [0085]). Apart from these apparent failings of *Xiao*'s step 1106, Dr. Malek made clear why "*Xiao*'s command

codes are not the recited ‘applicable settings.’” *E.g.*, EX2001, ¶ 64. *Xiao* ¶ 125, like each *Xiao* disclosure actually cited in the Petition, fails to disclose the required compatibility check, not only for want of the server’s “determining” function, but also for lack of “applicable settings.” *Id.*, ¶¶ 62-72; POPR, 34-43.

Toyota misstates the Petition and misunderstands its burden: The Petition never asserted that *Xiao*’s “look up” or “retrieval” function met the “determining” limitation of claims 10[c] / 20[a], as the Reply wrongly asserts. Reply 3; Pet. 25-27. And Toyota cannot switch horses after realizing its theories fail. Having failed to present evidence for this new argument, Toyota cannot now shift its burden to Patent Owner.² Reply, 4; *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (“[P]etitioner has the burden from the onset.”). Toyota and its expert boxed themselves into an erroneous construction, arguing that the recited server need not “determine” *any* settings to be compatible, rather the alleged “settings” of *Xiao* necessarily have some “compatible” characteristic. Pet. 27; EX1009, ¶¶ 98, 119, 124. The POPR demonstrated that Petitioner cannot disregard the claim language requiring a compatibility check “by a server,” as confirmed by specification examples and the prosecution history showing the amendments and reasons for

² In any event, the POPR demonstrated that these disclosures do not meet the limitations of claim 10[c] or 20[a]. *Id.*, ¶¶ 62-72; POPR, 34-43.

allowance. POPR, 24-28, 31-33, 39-43. Ground 2's obviousness combination was based on the 'alternative theory' that the server performs a compatibility check, but there, Petitioner and Dr. Almeroth pointed to *Hayashi* for this limitation. Pet. 45 ("To the extent, however, element 10[c] is interpreted to require ..."). The POPR demonstrated numerous failures of proof as to each of the independent claims 10[c] / 20[a], and 10[a], and as to Toyota's alternative theory set forth in Ground 2. POPR, 34-61. Toyota's efforts to improperly shift the burden and backtrack on the Petition's arguments, without any supporting evidence and in contradiction to its own expert's opinion, should be disregarded.

Hayashi's "manual adjustments" remain inapplicable: Toyota leaves unaddressed the wealth of evidence refuting *Hayashi*'s combination with *Xiao*. POPR 50-57 (citing EX1013, ¶¶ 002, 004, 120, 122-123; EX2001, ¶¶ 59, 83-89). But even if the two references were properly combined (they are not), the identified functions of *Hayashi* (Reply, 5) cannot be the required "settings that are preferred to be set as identified from the user profile" (claim 10[c]) at least because *Hayashi* teaches no such user profile and because the bizarre mashup of *Xiao*'s automated relay of commands and *Hayashi*'s manual operations does not result in, or render obvious, the required compatibility check. *Id.*; POPR, 57-61.

II. THE REPLY MISREPRESENTS AND OMITTS KEY *FINTIV* FACTS

The Reply affirms the bases for discretionary denial. For ***Fintiv* Factor 2**,

Toyota incorrectly states that “Judge Gilstrap has twenty trials for July 21, 2025,” but Judge Gilstrap has only five trials set for that date, and Patent Owner’s trial against Petitioner will proceed first. EX2013 (showing *Emerging Auto* matter set first with lowest case number); EX2014 (showing one listed case settled). Trial is thus likely on July 21, 2025. Moreover, Toyota misrepresents case disposition statistics as “irrelevant.” 2022 Guid. Memo, 8-9. All indications—the scheduled trial date, and median times to disposition and trial—demonstrate that the district case will be resolved before the FWD, thus this factor favors denial. EX2006; EX2016; *IBM Corp. v. Digital Doors*, IPR2023-00971, Paper 7 at 11 (PTAB Dec. 5, 2023).

Concerning **investment in the parallel proceeding**, recent developments—including a completed hearing on five motions, completed depositions, and a validity challenge to the ’268 Patent—confirm that the investment of resources is undisputedly substantial. EX2015. Toyota used these “developments” as a pretext for a reply but focused instead on rehashing the Petition’s (lack of) merits. EX2012. Patent Owner’s statement as to Kia’s settlement posture is irrelevant. EX1018, 2.

Fintiv Factor 5 favors denial because the trial date precedes the FWD. *IBM Corp.*, Paper 7 at 13. Moreover, *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15 (PTAB Oct. 21, 2020) is irrelevant because there is no stay and by contrast to *Snap*, there is substantial overlap between invalidity contentions and the Petition. POPR, 6-8, 13-15.

Dated: September 6, 2024

/s/ Jerry Tice
Jerry Tice (Reg. No. 73,582)

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 September 6, 2024, a copy of the foregoing document was served by email upon the following counsel at the below email addresses:

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