

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 REPLY TO PATENT OWNER'S RESPONSE

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I. INTRODUCTION

As the Petition details, the Grounds render the challenged claims unpatentable. Patent Owner's ("PO") arguments rely on flawed claim constructions that deviate from the terms' plain meanings and mischaracterizations of the prior art when applying those constructions.

PO's constructions are wrong. PO already declined its opportunity to amend, and it would be improper to allow PO to limit the unamended claim scope for purposes of this IPR solely to try to dodge Petitioner's art. PO cannot treat the claims as a "nose of wax" to be "twisted and turned in any direction" to suit its needs. *White v. Dunbar*, 119 U.S. 47, 51 (1886).

Without PO's improper claim constructions, PO has no argument for why the grounds fail. Moreover, PO does not dispute it would have been obvious to combine Xiao and the secondary references aside from a perfunctory statement that only two references, Xiao and Hayashi, are not "properly combined," an argument the Board already properly rejected.

II. CLAIM CONSTRUCTION

A. The plain language of 10[c] does not require a "compatibility check" performed by a server.

Claim 10 does not require a server-performed compatibility check, as PO argues. Paper 13 ("POR"), 1, 8, 33–36. In its Institution Decision, the Board agreed with Petitioner that the claim "does not appear to require performance of a

compatibility check.” Paper 11, 28. PO seeks to undo this finding by disclaiming the full scope of the original claim examined and allowed by the Office. But PO’s disclaimer does not bind the PTAB in the very proceeding where made. *CUPP Computing AS v. Trend Micro Inc.*, 53 F.4th 1376, 1383 (Fed. Cir. 2022). The claim recites, in passive voice, “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.”¹ The plain and ordinary meaning of this phrase does not require *the server* to perform a compatibility check.

PO does not argue the specification provides a lexicographic definition of “compatible” settings. Nor does PO argue it disavowed the full scope of the claims in the specification or during prosecution. Instead, PO bases its construction on disclaimers it made in its Preliminary Response. Paper 6 (“POPR”), 2–3, 30. At institution, the Board properly rejected PO’s position and should do the same here. Paper 11, 27–29. The fact that Petitioner Toyota cited PO’s disclaimer in the district court does not change the plain language of the claims. Tellingly, PO’s position here differs from district court (“no construction necessary”). Ex.1019, 50; Ex.1020, 18. PO should not be allowed to benefit from taking inconsistent positions in different fora.

¹ All emphasis added unless otherwise indicated.

PO argues Petitioner's position is inconsistent with the parallel district court litigation. POR, 9. But Petitioner is not the one being inconsistent. Petitioner's proposed construction in district court was expressly and solely based on PO's disclaimer in this IPR. The chronology is instructive.

In its July 24, 2024 POPR, PO advocated a narrow construction of claim 10, asserting that it requires "the server" perform a "compatibility check" in which two things are compared: "(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." Paper 6, 3.

On October 24, 2024, Toyota filed its claim construction statement in district court, expressly stating its "proposed construction is based on the statements EA made in its Patent Owner Preliminary Response in the corresponding IPR, so the construction is only applicable here and not in the IPR." Ex.1021, 21 (citing *CUPP*, 53 F.4th at 1383, and PO's constructions at POPR, 2–3, 30).

The POR omits the rest of Petitioner's remarks accompanying the "agreed" construction proposed in district court: "To be clear, claim 10 does not recite *the server* actively determining that the applicable settings are 'compatible.' Toyota does not agree that the plain and ordinary language of claim 10 requires *the server* to perform a compatibility check, but for simplicity in this litigation only, Toyota

believes the parties should be able to agree on constructions for [this term].”

Ex.2017, 35–36 (emphasis original).

In this IPR, the Board should continue to apply the plain and ordinary meaning to claim 10, which does not require the server actively determine compatibility. Ex.1009 (Almeroth Decl.), ¶119. The situation here is analogous to *Samsung Elecs. Co. v. Staton Techiya, LLC*, IPR2022-00253, Paper No. 33 at 23–25 (PTAB Jul. 14, 2023) (“[T]he district court relied on disclaimer based on Patent Owner’s arguments in this IPR proceeding..., but the Federal Circuit has made clear that such a disclaimer does not apply to us in this proceeding.”) (citing *CUPP*, 53 F.4th at 1383 (“a disclaimer is not binding on the PTO in the very IPR proceeding in which it is made...”)). Like *Samsung*, Petitioner’s position in district court “was expressly and solely based on [Patent Owner’s] disclaimer in this IPR[.]” IPR2022-00253, Paper No. 33 at 23.

PO’s shifting of positions is precisely the kind of chicanery the Federal Circuit prohibits. *CUPP*, 53 F.4th at 1383 (Patentees cannot argue “one way in order to maintain [the claims’] patentability and in a different way against accused infringers.”).

B. Claim 10 cannot be reasonably construed to require a server performing a “compatibility check”

The prosecution history does not support PO’s reading in additional limitations. In prosecution, applicant amended claim 10 “to clarify the determining,

by the server, *of applicable settings* for the selected vehicle.” Ex.1002, 203.

Applicant was careful to argue “applicable settings... *are compatible* with settings that are settable in the selected vehicle.” *Id.* That is, applicant never made the particular disclaimer PO makes here—that claim 10 requires *the server determine compatibility*. In contrast, in that same amendment, applicant argued amended claim 20 required that “certain of the user settings *are determined* to be compatible...,” *id.*, demonstrating applicant knew how to claim an actual determination of compatibility, but chose not to for claim 10.

PO argues dependent claim 14 supports its construction for claim 10. POR, 11. Actually, it undermines it. Adding limitations in dependent claims gives rise to a presumption that the limitation in question is not present in the independent claim. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314–15 (Fed. Cir. 2005). Thus, claim 10’s recitation that settings are “compatible” must mean something broader than claim 14’s recitation of “performing a mapping between settings associated with the user profile and settings obtained from an automobile...” *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 910 (Fed. Cir. 2004) (“[W]here the limitation that is sought to be ‘read into’ an independent claim already appears in a dependent claim, the doctrine of claim differentiation is at its strongest.”).

Additionally, the specification does not support PO’s narrower construction. The portions relied upon when applicant introduced the “compatibility” feature do

not describe a compatibility check performed by a server. Ex.1002, 203 (citing original specification paragraphs 7, 18, and 75, corresponding to Ex.1001 ('268 Patent), 1:56–2:5, 2:59–3:5, 10:42–55). Moreover, these portions certainly do not mandate PO's construction. These paragraphs merely state the bare result of determining "an incompatible setting," Ex.1001, 1:56–2:5, that applicable settings are "settable in the selected vehicle," *id.*, 2:59–3:5, or that third-party applications can be displayed "if they are compatible..." *Id.*, 10:42–55. Nowhere does the specification describe *how* to check "compatibility."

PO's narrower construction would exclude embodiments described in the specification. This is "rarely, if ever, correct." *On-Line Techs., Inc. v. Bodenseewerk Perkin-Elmer GmbH*, 386 F.3d 1133, 1138 (Fed. Cir. 2004). The specification describes processing (e.g., determining compatibility) not just on a server, but on "vehicle electronics" or "the user's portable electronics (e.g., smartphone or the like)." Ex.1001, 7:65–8:18 (vehicle electronics executing programming to provide services, and synchronization with the user's portable electronics), 10:42–55 (determining "compliance" upon binding/pairing), 20:65–21:5 (vehicle applying "custom settings of the user's portable device" by syncing the vehicle and user's device, without the involvement of a server), 30:1–13 (operations performed on vehicle electronics or jointly between vehicle electronics and other devices).

C. The claims do not require, as a matter of logic or grammar, steps 10[a], 10[b], and 10[c] be performed in a particular order.

PO argues 10[a], 10[b], and 10[c] must be performed in sequence. POR, 16–19. But method steps are not ordinarily construed to require a specific order of performance unless the specification or claims expressly or implicitly require that specific order. *Altiris v. Symantec Corp.*, 318 F.3d 1363, 1369 (Fed. Cir. 2003) (citing *Interactive Gift Express Inc. v. Compuserve Inc.*, 256 F.3d 1323 (Fed. Cir. 2001)). PO did not advocate this construction in district court, or its POPR, but now asserts the claims require an ordered sequence.

To import this limitation, a two-part test must be satisfied: (1) the claim language itself must, as a matter of logic or grammar, dictate that the method steps be performed in the order written; and if not, (2) we look to the specification to determine whether it directly or implicitly requires such a narrow construction. *Altiris*, 256 F.3d at 1369–1370. In *Altiris*, the only limitations the court found required an order were those using “conditional language.” 315 F.3d at 1370. Simply invoking an antecedent is not enough to import an ordered sequence of steps. *Cybersettle, Inc. v. Nat’l Arbitration Forum, Inc.*, 243 Fed. App’x 603, 609 (Fed. Cir. 2007); *Kaneka Corp. v. Xiamen Kingdomway Grp.*, 790 F.3d 1298, 1306–07 (Fed. Cir. 2015) (requiring a defined order only “if the language of a claimed step refers to the *complete results* of the prior step”). Furthermore, statements of intended use are non-limiting. *In re Anderson*, 662 Fed. App’x 958,

963 (Fed. Cir. 2016) (finding the claimed “for use” language did not add structural limitation to the claimed system or method).

Here, nothing in 10[b] or 10[c] references anything logically indicating that 10[a] had already been performed. There are no “conditional” limitations. Step 10[a] recites “receiving, at a server, information for a user profile of a user,” but the claim never refers back to this “information.” Step 10[a] does not recite receiving, at the server, *the user profile*, nor does it recite receiving “*settings* for a user profile,” as PO attempts to show in its illustration (which appears nowhere in the ’268 patent or prosecution history). POR, 11. The “receiving” of “information” in 10[a] does not define any temporal aspect as to the “user profile.” The “user profile” is merely described in passive voice throughout.

Like in *Compuserve*, “there is no reason why step one’s ‘[receiving]’ of information... must occur before” the later-recited “identifying” and “determining” steps, neither of which require the recited “information.” 256 F.3d at 1343. Indeed, steps 10[a] and 10[b] could occur concurrently. *See Kaneka*, 790 F.3d at 1307 (claims did not exclude steps “occurring simultaneously”). PO cites no examples demonstrating how this would be inconsistent with the ’268 patent. Step 10[b] recites “identifying a selected vehicle for applying the user profile,” but this does not require using the “information” received by the server in step 10[a]. PO’s assertion that “step 10[b] does not allow the operation of ‘identifying a selected

vehicle for applying the user profile’ until after the user profile information is received by the server...,” POR, 18, is belied by its conduct in district court.

In district court claim construction, PO disputed that step 10[b] was performed by the server, and argued it could be performed by other devices. Ex.1022, 79:17–80:15 (“[W]e disagree that the server is required to identify this selected vehicle.” Instead arguing the specification describes an example where “*Bob’s device* identifies the selected vehicle...”). PO represented to the court that an embodiment in the specification where the user’s mobile device identifies the selected vehicle is an example of the claimed “identifying a selected vehicle for applying the user profile...” limitation. This embodiment explains that only *after* the identification of the selected vehicle does the server retrieve Bob’s user profile and determine settings for the vehicle based thereon. Ex.1001, 16:57–2 (identifying the vehicle via pairing request that “can include sending the model of the vehicle 200” to cloud services 120; and thereafter “pairing module 170 can *then* communicate with a mapping engine 118 that determines information associated with car 200”); *see also id.*, 17:3–11 (describing “integration of Bob’s user profile *from* the user profiles database 160 so that Bob’s profile can be sent to car 200”). If the claims are construed to cover this embodiment, as PO insisted in district court, they cannot require the server first receive the “information for a user profile”

before identifying “a selected vehicle...” Thus, the specification contradicts PO’s assertion that 10[a] must occur before 10[b].

Step 10[c] recites “determining, by the server, applicable settings for the selected vehicle...,” but this also does not require using the “information” received by the server in 10[a]. At best, it references the “selected vehicle” that was selected in 10[b]. But whether 10[b] occurs before 10[c] is not at issue in this IPR.

Additionally, PO does not cite anything in the specification or prosecution history indicating the order of steps is important. Indeed, the intrinsic record indicates the opposite. The specification *only* describes Fig. 14 in terms of a “stepped flow of events...” Ex.1001, 25:1–17. And the specification instructs that the claims are to be interpreted broadly, where “various computer-implemented operations” could be employed, without regard to their order. *Id.*, 30:1–31:48 (noting, e.g., that “method operations” can be “executed jointly,” that “changes and modifications can be practiced within the scope of the appended claims,” and that the embodiments “are to be considered as illustrative and not restrictive...”). Here, like *Altiris*, the ’268 patent and its prosecution history contain no statements that the alleged specific order of steps is important, or disclaiming any particular order. Neither PO nor its expert even allege so.

PO’s cited cases are distinguishable. PO relies on a non-precedential decision, *Tuna Processors, Inc. v. Hawaii Int’l Seafood, Inc.*, 327 Fed. App’x 204

(Fed. Cir. 2009), but this reliance is misplaced. In *Tuna Processors*, the language of the claim made clear that certain action(s) had occurred prior to others (creating smoke, cooling it, and then exposing tuna meat to the cooled smoke). As discussed above, the claims here contain no such language requiring the step of “receiving... information” to have occurred prior to other steps (none of which reference the “information”).

PO also relies on a PTAB decision denying IPR institution in which the Board interpreted a claim to require a condition precedent where it recited actions occurring “when both the first and second thresholds are exceeded.” *Askeladden LLC v. Hardison Holding Co.*, IPR 2021-00278, Paper 7 at 22 (PTAB Apr. 15, 2021). Here, 10[b] and 10[c] do not include conditions precedent like those in *Askeladden* (i.e., the exceeding of thresholds being a trigger for subsequent actions).

The claim also does not preclude steps occurring multiple times. The claims are open ended (reciting a “method, comprising...”). Thus, a method performing any number of steps could satisfy the claim so long as 10[a], 10[b], and 10[c] are performed at some point.

III. XIAO INVALIDATES THE CHALLENGED CLAIMS

A. Xiao discloses determining “applicable settings” that are

“compatible,” under 10[c]

Xiao discloses a server determining “appropriate command codes 632” for achieving the user’s “desired automobile system settings indicated by the operator profile information 614...” Ex.1010, ¶[0103]; Pet., 25–27. Those command codes are “compatible with settings that are settable in the selected vehicle,” as claimed. As the Board found at institution, the reference need not satisfy an *ipsissimis verbis* test. Paper 11, 27.

PO misinterprets Xiao, asserting that “every setting in Xiao is vehicle-specific from the outset.” POR, 34. The disclosures of Xiao, cited in the Petition, refute this. For example, Xiao teaches the user “may apply the preferences indicated in the operator profile information 614 to the systems of *the new automobile...*” Ex.1010, ¶[0111]; Pet., 24–25. This demonstrates that preferences contained in the user profile (e.g., 614) are specific to the user, and those preferences can be applied to other vehicles, not just the currently selected or default one. Ex.1010, ¶[0110]. Xiao explains that “appropriate command codes 632” are “based on the automobile ID 62[8] *and* on the command IDs 630 *associated with the operator’s desired system settings 614.*” *Id.*, ¶[0103]; Pet., 25–27. That is, Xiao determines applicable settings for the selected vehicle that are desired by the user (as indicated in 614), and are compatible with settings that are settable in the selected vehicle (e.g., because they can be set on the vehicle). Xiao

discloses determining applicable settings in at least as much detail as the claim specifies (“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”).

B. Xiao discloses 10[a], 10[b], and 10[c] reciting the “user profile”

PO attempts to link its arguments regarding 10[b] and 10[c] to the “user profile” recited in 10[a]. POR, 31–32. But as a preliminary matter, the Board already found Xiao teaches 10[a]. Specifically, the Board rejected PO’s argument that Xiao’s command request is not “information for a user profile of a user” and found the server receiving a command request (which includes “mobile ID 610 corresponding to mobile device 110”) “is information for a user profile as this information is used to retrieve the profile information.” Paper 11, 21–25. That is, the Board did not find the claimed “information for a user profile” to read in any special meaning that the “information” includes extensive requirements as to the “user profile.” The claim recites “receiving, at a server, *information for* a user profile of a user,…” Then, in passive voice, the claim states “the user profile defining one or more settings that are preferred to be set in vehicles if the vehicles support the settings.” PO cannot dispute that these recitations of 10[a] are met by Xiao.

However, PO now seeks another bite at the apple, this time arguing that elements 10[b] and 10[c] require additional limitations. But like 10[a], the passive-voice invocations of “the user profile” in 10[b] and 10[c] do not carry with them the extra requirements PO suggests.

The Petition explains how Xiao discloses 10[b] (“identifying a selected vehicle for applying the user profile”). Pet., 23–25. Without formally proposing a construction, PO argues “[f]or ‘the user profile’ settings of elements 10[b] and 10[c], *each* setting is preferred to be set in vehicles (*at least two*).” POR, 32. The claims do not require this. The earlier recitation of “user profile” in 10[a] states “the user profile defining one or more settings that are preferred to be set in vehicles if the vehicles support the settings.” Nowhere is there a requirement that *each* profile setting be set in multiple vehicles. PO also attempts to import the ’268 patent’s alleged “purpose” into the claims. *Id.*, 4, 7, 32, 39. PO cites no authority for why aspirational statements in the specification should be imported into the claims.

Indeed, this interpretation (that settings be applied to “any” of multiple vehicles) contradicts PO’s own characterization of the ’268 patent, that “[n]ot all the user’s settings may be compatible in each vehicle.” *Id.*, 6–7. Additionally, claim 10 does not prohibit settings from being vehicle specific. POR, 19–31. Properly construed, Xiao discloses the limitations in as much detail as claimed.

See, e.g., Ex.1010, ¶[0031] (describing a user’s account and associated profile being “for one or more... automobiles 112,” similar to 10[a]’s recitation of “the user profile defining one or more settings that are preferred to be set in vehicles if the vehicles support the settings”). Xiao discloses the operator’s profile has settings for multiple vehicles, as explained in the Petition. Pet., 24–25; *see also* Ex.1009, ¶94 (citing Xiao’s desired settings “for the automobile(s) 112.”).

Regarding 10[c], PO asserts that “Xiao does not disclose any settings that can be set in multiple vehicles, as the settings are specific to only one vehicle.” POR, 42. PO is incorrect. Xiao discloses settings that can be set in multiple vehicles. Ex.1010, ¶[0111]; Pet., 25. PO takes too narrow an interpretation, alleging Xiao’s settings are “always fixed to a specific vehicle.” POR, 43. PO overlooks that Xiao’s “[o]perator profile information 614 may contain information regarding the preferences of the operator *for the disclosed wireless automobile key service*,” not just for an individual automobile. Ex.1010, ¶[0069]. PO attempts to impute limiting effect on particular examples provided by Xiao (e.g., Xiao’s application of “the operator’s desired [radio] station presets”) against Xiao’s explicit instruction not to be interpreted narrowly. *Id.*, ¶¶[0102], [0129]–[0130]. Additionally, Xiao explicitly discloses the operator may, at any time, apply preferences indicated in operator profile information 614 to a “new automobile,” which may be “any” automobile “the operator is permitted to operate.” *Id.*,

¶¶[0110]–[0111]. Xiao does not constrain the application of settings to the “new automobile” to only automobiles for which the operator has already set settings.

But even if it were so constrained, Xiao would meet the claims under any reasonable construction.

C. Xiao discloses any temporal aspect of 10[a] and 10[b]

PO’s argument relies on an incorrect claim construction, and thus, PO’s challenge to the Petition fails. But even under PO’s proposed construction, Xiao discloses 10[a] and 10[b]. PO argues that Xiao’s command request is received after the selected automobile’s name is displayed to the user. POR, 47–51. Even so, Xiao anticipates claim 10. Nothing precludes Xiao from “identifying a selected vehicle” again after a first command request is received. Indeed, Xiao’s methods are shown to repeat on loop. Ex.1010, Figs. 10–11. The Petition cited an identification of the currently selected automobile for 10[b]. Pet., 23–25; Ex.1009, ¶¶112–116. After selecting an automobile, a user’s settings can be applied by transmitting an “apply operator profile command request” to server 118. Pet., 21, 24; Ex.1010, ¶[0102]. The Petition explains how this command is used “to apply the settings of the operator’s profile to the systems of *the automobile 112*.” *Id.* Indeed, under PO’s own characterization of Xiao, which it argues is “vehicle-specific at every stage” (POR, 30), Xiao’s command request would necessarily include an identification of the automobile to which settings are applied. *Id.*, 38–39

(PO asserting the command request is “constrained to one, single vehicle”). Thus, Xiao’s commands associated with the displayed automobile would also include identification of the vehicle (i.e., that “one, single vehicle”).

PO acknowledged Xiao’s command request contains an automobile ID, and a command ID for the desired commands (e.g., settings) to be sent to the vehicle. POR, 25–29 (“Each command request, Xiao teaches, contains a particular ‘automobile ID 628 and command ID 630’...”). And as the Board already found, “Xiao’s server appears to receive *more* than just the automobile ID or command ID.” Paper 11, 25 (citing Ex.1010, ¶[0102] and Ex.1009, ¶104, explaining the server also receives “operator ID 608” or other identifiers for the user’s profile). It is clear from Xiao that commands and requests include information identifying a vehicle to which they are sought to apply.

Moreover, nothing precludes elements 10[a] and 10[b] from occurring concurrently. Xiao’s server at least receives “information for a user profile” along with the “identifying a selected vehicle,” as recited in 10[a] and 10[b]. PO does not argue Xiao’s step of determining applicable settings (10[c]) fails to meet the claims because it occurs *before* its step of identifying a selected vehicle (10[b]) or receiving a command request (10[a]). Thus, there is no dispute that the order of Xiao’s determining step (10[c]) satisfies the claim.

D. Xiao discloses claims 17, 18, 19

PO argues Xiao's "family account" and associated descriptions are insufficient to meet the claimed "sub-user accounts" of claims 17 and 19. POR, 51–53. PO makes a pedantic argument that "child accounts" are a "fiction" in Xiao. But PO cannot deny that "a child may only have permission to operate" certain automobiles and that a child would necessarily have an operator ID and defined permissions, as explained in Xiao. Ex.1010, ¶¶[0076], [0110]. Claim 17 only requires a single account ("*one or more* sub-user accounts"). It does not require, for example, a family account and a child account, as PO appears to suggest. POR, 52. The Petition and Dr. Almeroth explain how Xiao's child's account has predefined privileges. Pet., 40–41.

Regarding claim 18, PO similarly argues that accounts associated with family members are deficient. However, Dr. Almeroth explained how one would understand the various disclosures of Xiao to meet this claim. Pet., 41–42. Also, PO alleges that permissions for use of the vehicle must refer to the enabling or disabling of individual settings, but PO's own claims define "settings" as things as broad as "remote access" or "operational settings." Ex.1001, 33:40–60 (Cl. 13). Like Xiao's example of family members, the '268 specification describes an administrator giving a family member only "access to a certain vehicle," and thus prohibiting access to other vehicles. *Id.*, 15:15–18. PO cannot dispute that

privileges to *access* or *operate* a vehicle are “privileges” as claimed. Thus, a child may have a configuration of settings specific to him/her, consistent with the understanding of PO’s expert. Ex.1024, 33:1–44:10. And, PO’s expert acknowledged that Xiao discloses multiple accounts. Ex.1024, 45:22–46:2.

IV. THE CLAIMS ARE OBVIOUS

A. Ground 2 (adding Hayashi) renders claims 10, 11, 13, 15–19 obvious

PO repeats its argument that Xiao and Hayashi are “not even properly combined,” which the Board properly rejected. POR, 55. Obviousness does not require bodily incorporation. *MCM Portfolio LLC v. Hewlett-Packard Co.*, 812 F.3d 1284, 1294 (Fed. Cir. 2015). The Petition demonstrated how a POSA would rely on Hayashi for a specific teaching, namely, how the management server compares the functionality of different vehicles used by a user with certain preferences. Pet., 18–19, 94–96. The Petition demonstrated how the prior art combinations in Grounds 2–5 meet the claims.

PO again glosses over the fact that Hayashi discloses “seat adjustment function, or mirror adjustment function,” which are the same type of vehicle systems to which PO describes its “settings” apply. Ex.1001, 21:11–15 (“settings of the seats, the mirrors...”). PO’s expert acknowledged that he did not cite these “seat” and “mirror” disclosures. Ex.1024, 14:3–10.

PO acknowledges the combination of Xiao and Hayashi would result in determining certain settings are incompatible in an automobile. PO states the “result achieved by the combination would be that Xiao’s server, at best, in response to the command request issued by the operator, could ‘look up’ a command code to apply a vehicle-specific setting to that automobile 112, only to find that there is ‘none.’” POR, 56. This example of determining a setting is incompatible demonstrates the server *does* determine some settings are compatible (e.g., by virtue of including an applicable operating method/command code) as opposed to incompatible (e.g., by indicating “none”). This is enough to meet the claims, which simply recite that applicable/certain settings are “compatible.”

PO again relies on inappropriate claim constructions to argue the combination would not result in determining settings that are applicable “to multiple vehicles, as claimed in the ’268 Patent,” POR, 56, but such is not claimed. And even under PO’s improper constructions, the combination meets the claims. PO interprets Hayashi too narrowly, failing to account for its determination of particular functions that are compatible with vehicles and are based on the user’s preferences. POR, 58–63.

PO argues “the addition of Hayashi, at best, would only apply in a scenario when there are no applicable settings because ‘none’ may be stored in Xiao’s table 606...” POR, 59; *id.*, 62 (“The *only* additional operation achieved by Petitioner’s

proposed combination is that the server will sometimes retrieve ‘none’ when there is no such command code.”). This is incorrect. PO fails to address that Hayashi show various operating methods (e.g., X, Y, Z) in different vehicle models *for achieving the same function*. Pet., 48 (citing Ex.1009, ¶195). The Petition demonstrated it would have been obvious to apply these teachings of Hayashi to Xiao. *Id.*

B. Grounds 3a and 3b (adding Patenaude) render claim 12 obvious

PO argues Patenaude’s teachings of “retrieving” user-specific entertainment selection profiles fail to disclose “sending the learned settings...” of 12[c] because retrieving allegedly means data is being pulled, not sent. POR, 54–55. Not only is PO wrong to suggest that “retrieving” means data is being pulled, *id.*, 55 (“data being pulled (i.e., retrieving)”), but this is also irrelevant because the claims do not distinguish between pushing and pulling. Ex.1026, ¶¶12–14, 19–20. “Retrieving” means that data *moves* from one place to another. Ex.1025, 4 (defining retrieve as “To move data out of a storage device or data medium”). That means Patenaude’s retrieval of “learned settings” necessarily includes sending those settings. Ex.1026, ¶¶15–23. The claimed “sending” requires nothing more.

Patenaude discloses “sending the learned settings” at least by stating that “[d]uring stage S610, processor 122 in the telematics unit 120 retrieves the user-specific entertainment selection profile stored in the in-vehicle memory 128.”

Ex.1026, ¶17 (citing Ex. 1011, ¶[0073]). Consistent with PO’s expert’s acknowledgment that “retrieval” may involve transmission, Ex.1024, 18:6–7, this means that the user-specific entertainment selection profile is sent from memory 128 to processor 122. *Id.* In addition, because Patenaude teaches the profile being retrieved from memory, it follows that the profile must have been previously sent to the memory. Ex.1026, ¶18. There is no practical difference between the “retrieval” disclosed by Patenaude and the “sending” recited in claim 12. *Id.*, ¶21.

C. Grounds 4a and 4b (adding Singh) render claim 14 obvious

Regarding claim 14, PO asserts the claim imputes a requirement that the server must be “*capable of* determining ‘applicable settings’ by ‘performing a mapping...’” POR, 37 (emphasis original). Even if this were to be accurate, it would have been obvious to have a server perform a mapping, as explained in the Petition. Pet., 35, 57–62,

D. Ground 5 (adding Hayashi and Patenaude) renders claim 20 obvious

Aside from incorporating other deficient arguments, as above, PO’s only challenge to Ground 5 is based on an alleged deficiency solely of primary reference Xiao, but Ground 5 is based on obviousness. The Petition explains how one would have combined Xiao, Hayashi, and Patenaude and reached 20[b]. Pet., 68–70. Patenaude’s system operates using user-preference data that is transmitted to/from cloud components, including a server. *Id.*, 70 (citing Ex. 1011, ¶[0027])

(“User-preference data from client-side software is transmitted to server-side software of web-hosting portal 160.”)). PO’s criticism of *Xiao* misses the point.

PO asserts “the Petition fails to identify any disclosure from *Xiao* to meet the recited limitation of ‘communicating... *by the vehicle*, changes to user settings[.]” POR, 64 (emphasis original). PO alleges *Xiao* is deficient because it states in paragraph [0105] that the operator can change settings via the user interface page 900 as shown in Fig. 9. *Id.*, 66. PO alleges this is *only* available on mobile device 110 or terminal device 122. *Id.* Again, PO’s view is too narrow.

As Dr. Almeroth explained, it would have been obvious to a POSA to have combined the well-known features of *Xiao*, Hayashi, and Patenaude. Ex.1009, ¶¶235–274. For example, one would have looked to Patenaude’s teachings of predicting a user’s selections made using a vehicle telematics unit (i.e., setting changes) to extend and improve the user experience of *Xiao*. Pet., 53–57. In making this modification, it follows that Patenaude’s changes, which are communicated to a cloud processing system (Ex.1011, Fig. 1, ¶¶[0021], [0027]), would be communicated from vehicle (e.g., from the telematics unit) to cloud. Patenaude describes its telematics unit receiving user input through, e.g., a touch-screen. *Id.*, ¶[0002]. The Petition also explained how Patenaude monitors “entertainment selections at a telematics unit...” Pet., 15–16.

In making the obvious combination of Xiao, Hayashi, and Patenaude, one would have applied the teachings of the references to extend the usability and convenience of the subject systems (e.g., the touch-screen input devices of Xiao and touch-screen telematics unit of Patenaude), as explained by Dr. Almeroth. Ex.1009, ¶¶199–206, 272 (referencing the same). As Patenaude demonstrates, communication occurs by and between the various components in its cloud system. Ex. 1011, Fig. 1 (depicting communication arrows connecting components); Ex.1024, 27:17–28:1 (PO’s expert acknowledging that elements within Patenaude’s cloud system “would be communicating with each other”).

Furthermore, PO fails to appreciate that Xiao explicitly teaches the operator making changes to settings in the vehicle, and the “[a]utomobile 112 may communicate the settings... to server 118, which may *update* the stored operator profile information 614 for the operator.” Ex.1010, ¶[0079]; Pet., 65 (discussing the “user settings of element 20[a], to which the “changes” of element 20[b] are made). Also, as Dr. Almeroth explained, Xiao discusses providing recommendations to the user automatically based on his use of the vehicle. Ex.1009, ¶256. Tellingly, PO does not dispute that Patenaude renders obvious limitation 20[b], despite the Board’s explicit invitation to develop the record in this regard. Paper 11, 42. The deficiency of PO’s challenge is highlighted by PO’s

failure to challenge any other limitations of claim 20. POR, 63–66 (failing to dispute Petitioner’s combination renders 20[c]–[e] obvious).

V. CONCLUSION

For these reasons, Petitioner respectfully requests the Board find the challenged claims unpatentable.

Respectfully submitted,

Dated: April 18, 2025

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(c)(1), the undersigned hereby certifies that the foregoing PETITIONER'S REPLY contains 5,590 words, excluding the parts exempted under 37 C.F.R. § 42.24(c), as measured by the word-processing system used to prepare this paper.

Dated: April 18, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Petitioner's Reply** was served on April 18, 2025 via email directed to counsel of record for Patent Owner at the following.

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