

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

**EMERGING AUTOMOTIVE LLC'S
PATENT OWNER SUR-REPLY**

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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
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)
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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."
EX2011	Declaration of Professor Sam Malek, Ph.D. under 37 C.F.R. § 1.68 in support of Patent Owner's Response
EX2012	Email Correspondence from counsel for Petitioner, to Counsel for Patent Owner, dated August 7, 2024, explaining "good cause" for additional briefing

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EX2016	Docket Navigator Median Time-to-Trial Statistics for Judge Rodney Gilstrap (excluding transfers), August 26, 2019 through August 26, 2024
EX2017	Defendants' Responsive Claim Construction Brief, <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)
EX2018	Claim Construction order for <i>Emerging Automotive LLC v. Kia Corporation, et. al., and Toyota Motor Corp. et al.</i> , No. 2:23-cv-0437-JRG
EX2019	Preliminary Constructions for <i>Emerging Automotive LLC v. Kia Corporation, et. al., and Toyota Motor Corp. et al.</i> , No. 2:23-cv-0437-JRG
EX2020	Infringement contentions for <i>Emerging Automotive LLC v. Kia Corporation, et. al., and Toyota Motor Corp. et al.</i> , No. 2:23-cv-0437-JRG

I. Introduction

All claims must be upheld, as Petitioner’s Reply (“Reply”) affirms that *Xiao* cannot anticipate any claim of the ’268 Patent, the proposed *Xiao/Hayashi* combination cannot cure vehicle-specific constraints of *Xiao*, and no other ground or basis fills the numerous evidentiary voids identified in Patent Owner’s Response (“Response”).

Nothing offered in Reply rebuts Patent Owner’s showing that (1) neither *Xiao*, nor the *Xiao/Hayashi* combination, discloses or suggests the compatibility check required of independent claims 10 and 20; (2) *Xiao* fails to disclose the “user profile” required in the operations of elements 10[b] and 10[c]; (3) *Xiao* cannot disclose elements 10[a] and 10[b] as arranged in claim 10, since the server receiving a “command request,” relied on for element 10[a], cannot occur until after the server has identified “the name of the automobile currently selected,” which is relied on for element 10[b]; and even by identifying the “command request” for both steps 10[a] and 10[b], as now argued in Reply, *Xiao* still fails because the “command request” cannot meet the limitations of element 10[b]; and (4) as already “questioned” in the Board’s Institution Decision, the Petition fails to meet its burden as to element 20[b].

The Reply not only fails to rebut the arguments in Response, but affirms the Petition’s failures to sustain its burden of proof. All grounds fail, and all claims must be upheld.

II. The Reply affirms the claim constructions requiring (1) a compatibility check and (2) a sequential order of steps.

A. The claims require a “compatibility check.”

The Reply does not dispute that neither *Xiao* nor *Xiao* in combination discloses the compatibility check required by the plain and ordinary meaning of the independent claims in limitations 10[c] and 20[a]. In Reply, Toyota does not dispute that claim 20 requires a “compatibility check.” Therefore, if the Board agrees with the district court’s construction (EX2018, 29-30) that the claims require a compatibility check, both parties’ agreement on this construction, and/or both parties’ cited intrinsic evidence supporting this construction, there is no dispute that the Petition fails. Response, 33-37.

1. The parties and the district court all agree that the plain and ordinary meaning of claim limitations 10[c] and 20[a] require a “compatibility check.”

As shown in Patent Owner’s Response, “Toyota agrees that the server / cloud based system performs the compatibility check.” *Id.*, 33. Toyota now tries to minimize its agreed-upon construction as “expressly and solely based on” alleged disclaimer (Reply, 4), but the record demonstrates the opposite. EX1019, 20. The district court did not and could not rely on any alleged IPR disclaimer—there was none. Instead, the district court agreed with *both* parties’ citations to the specification and prosecution history to find that the *plain and ordinary meaning* of claims 10[c]

and 20[a], in light of the intrinsic record, require a “compatibility check,” as set forth below.

M	“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” (’268 Patent, Claim 10) / “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” (’268 patent, claim 20)	Plain and ordinary meaning [NOTE: these limitations require a “compatibility check” where the server / cloud based system determines whether settings are compatible with the vehicle”)
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EX2019, 4.

The district court has now adopted this plain and ordinary meaning, which requires a compatibility check. EX2018, 29-30. The court’s order makes clear that this construction was based on the plain and ordinary meaning of the term, not any alleged disclaimer. *Id.* Petitioner’s unfounded *argument* regarding disclaimer is not “evidence.” To the contrary, not only did Toyota expressly propose the compatibility check construction, it further represented to the district court specific evidence from the specification and prosecution history to “support that position”—much of which overlaps with Patent’s Owner’s cited evidence. *See* EX1019, 20:

Emerging Automotive LLC v. Kia Corporation, et al., C.A. No. 2:23-cv-0437-JRG (lead case)
Joint Claim Construction Statement: Defendants' Proposed Constructions

User Profile Patent ³				
No.	Terms/Phrases	Proposed Construction	Intrinsic Evidence	Extrinsic Evidence
3.	"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" ('268 claim 10) "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" ('268 claim 20)	the server / cloud based system determines applicable settings by performing a compatibility check to determine which settings that are preferred to be set as identified from the user profile are able to be set in the selected vehicle	Proceedings in IPR2024-00786 ('268 patent), including Patent Owner's Preliminary Reply. Prosecution history of U.S. App. No. 14/050,314, including applicant's 8/19/2015 remarks made in amendment (citing original specification paragraph [0018], among others). '268 patent at 2:55–3:25. Original specification paragraphs [0007], [0075]. '268 patent at 1:56–2:5, 10:42–55, 16:57–18:46, Figs. 7, 8, 9A.	EA's First and Second Amended Complaints and materials cited therein. [This 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. IPR2024-00786, POPR at 2–3, 30; see, e.g., <i>CUPP Computing AS v. Trend Micro Inc.</i>, 53 F.4th 1376, 1383 (Fed. Cir. 2022).] EA_TOY-019460 - EA_TOY-020252, EA_TOY-020371

Id.

Accordingly, not only does the claim language itself require this compatibility check (Response, 5-9), but also *both parties* agree that the same specification passages support this construction. Response, 12-16; EX1019, 20 (citing '268 patent, 1:56-2:5, 10:42-55, 16:57-18:46, Fig. 7); Response, 12-13. Likewise, both parties relied on the same prosecution history events as support for the agreed-upon construction. EX1019, 20 (citing prosecution history [EX1002], 196, 200 (amendments), 202-203 (remarks in amendment), 37, 54-55 (applicant-cited examples of compatibility check); Response, 14-16 (same).

The district court agreed that the plain and ordinary meaning requires a compatibility check. EX2018, 29-30. By contrast, there is no evidence that the district court *relied* on any alleged disclaimer to find that the independent claims

require a compatibility check. *Id.* In fact, the district court specifically noted that there was no disclaimer with respect to the term of claim 20 to support Toyota’s additional proposals. *Id.*

The record refutes Petitioner’s position as “expressly and solely based on” alleged disclaimer, and for at least this reason, this case stands in stark contrast to *Samsung Elecs v. Staton Techiya*, IPR2022-00253, Paper 33 at 23 (P.T.A.B. Jul. 14, 2023) (neither party could “offer any reasoning in support of the construction that we might impute to the district court” “other than disclaimer”); Reply, 4. But here, both parties had not only proposed the “compatibility check” construction at issue, but had also represented to the district court that the same specification passages and prosecution history events “support that position.” E.D. Tex. L.R. 4-3(a)(2); EX1019, 20. In any event, the district court was presented with no *evidence* of any disclaimer and the court’s order never even mentions this alleged disclaimer. EX2018, 29-30. The plain and ordinary meaning of claim 10[c] and 20[a] requires a compatibility check. *Id.*

2. There could be no disclaimer from this ongoing IPR as a matter of law.

Indeed, it would have been error for the district court to have concluded that Patent Owner’s IPR statements constitute “disclaimer.” Because this Board has not yet issued a final written decision adopting a particular construction of the claims

“in order to maintain their patentability,” there can be no disclaimer from any statements made in this not-yet concluded IPR proceeding. *Olympus v. Optimum Imaging Techs.*, IPR2024-01220, Paper 13 at 12-13 (P.T.A.B. Feb. 24, 2025) (quoting *Aylus Networks v. Apple*, 856 F.3d 1353, 1360 (Fed. Cir. 2017) (“extending the prosecution history disclaimer doctrine to statements made in *concluded* IPR proceedings to ‘ensure that claims are not argued one way in order to maintain their patentability and in a different way against accused infringers’”) (emphasis by Board)).

Relying on long-standing precedent, the Board in *Olympus* held that only “statements made in *concluded* IPR proceedings” can constitute disclaimer. Paper 13 at 12-13; *see also Illumina v. Ravgen*, IPR2021-01272, Paper 50 at 21 (P.T.A.B. Jan. 25, 2023) (“[w]e do not treat Patent Owner’s argument *in the present IPR* about the claims not covering ACD or its components as a ‘disclaimer’”) (emphasis in original).

As this Board (1) has not denied inter partes review, (2) has not yet adopted any proposed construction, and (3) has not yet upheld the validity of the claims based on such a construction, Patent Owner’s statements made in this *ongoing* IPR cannot constitute disclaimer, nor could the district court have relied on any non-existent disclaimer.

Instead, the court confirmed both parties' proposed construction and both parties' supporting evidence that the plain and ordinary meaning of claim limitations 10[c] and 20[a] require a compatibility check.

3. The intrinsic record supports the proposed construction.

The claim language, specification and prosecution history support the claimed compatibility check—"determin[ing] ... settings ... [that] are compatible with settings that are settable in the selected vehicle," as recited in Claim 10[c]. Response, 10. In Reply, Petitioner argues (incorrectly) that this requirement would exclude specific embodiments, but never identifies a single embodiment in which there is no compatibility check. Reply, 6. Instead, Petitioner merely misstates that the *server* does not perform a compatibility check. Whether "vehicle electronics" or a "smartphone" may perform processing or whether settings are provided by a portable device does not mean that a compatibility check is not required. Contrary to Petitioner's arguments, the specification explains that "portable electronics" and "vehicle electronics" are in fact connected to cloud services. EX1001, 7:65-8:18.

Moreover, a POSITA would have understood from the prosecution history that the plain language requires a compatibility check. Response, 13-16. In Reply, Petitioner apparently concedes that claim 20 requires a compatibility check by reciting "settings are determined to be compatible." Reply, 5. Claim 10 requires this as well, "determining ... settings that ... are compatible." Claim 10[c]. The

applicant amended both claims 10 and 20 to include the compatibility check, submitted the same argument for both amendments to overcome the prior art, and explained these amendments as “the check for compatibility of settings.” Response, 13-16; EX1019, 20. Petitioner cannot credibly maintain that language of claim 20 requires a compatibility check but somehow maintain that the substantially similar amendments and exact same arguments for claim 10 do not.

4. Dependent claim 14 provides one example of *how* the compatibility check required of claim 10 may be performed.

The patent specification further supports the agreed-upon compatibility check. Response, 8-16. For example, the server of claim 14 “performing a mapping” may be one way of performing a compatibility check. *Id.*, 5.

The claim differentiation doctrine is inapposite (Reply, 5), as neither party is contends that “dependent claim [14] should be read into the independent claim [10],” and, in any event, claim 14’s “performing a mapping” limitation is but one of several “meaningful differences” between claims 10 and 14. *Sunrace Roots Enterprise v. SRAM Corp.*, 336 F.3d 1298, 1302-03 (Fed. Cir. 2003); claims 10, 14.

B. The logic, grammar and antecedent basis of the claim language demands an order of steps for 10[a]-10[c].

If the Board agrees that method step 10[a] must precede step 10[b], the Petition fails. *Xiao* cannot disclose the order of steps required by claim 10 because *Xiao*’s system cannot receive any command request (relied on for step 10[a]) until

after *Xiao*'s display of the name of the selected automobile (relied on for step 10[b]). Response, 47-49.

In Reply, Petitioner now contends that the “command request” itself may satisfy both steps 10[a] and 10[b], but as Petitioner concedes, *Xiao*'s command request is always constrained to be vehicle-specific for the lone, already-identified vehicle, and cannot therefore meet step 10[b]'s requirement that the identified vehicle is “one of a *plurality of vehicles* identified as available by the server.” Under either argument, therefore, *Xiao* fails to disclose the required order of steps.

Accordingly, should the Board find that the plain and ordinary meaning of claim 10 requires that step 10[a] precedes step 10[b], the Petition fails.

1. The claim language itself shows that step 10[a] is a condition precedent to steps 10[b] and 10[c], and 10[b] is a condition precedent to step 10[c].

Here, “[t]he sequential nature of the claim steps is apparent from the plain meaning of the claim language.” *Mantech Env't Corp. v. Hudson Env't Servs., Inc.*, 152 F.3d 1368, 1375-76 (Fed. Cir. 1998) (method claim steps require their written order because “in order to accomplish step (b), the wells of step (a) must already have been provided”). The Response showed that steps 10[b] and 10[c] *do* include conditions precedent like those in *Askeladden v. Hardison Holding Co.*, IPR2021-00278, Paper 7 at 11 (P.T.A.B. Apr. 15, 2021). That is, by “receiving information for a user profile of a user ... the user profile defining one or more settings ...” (step

10[a]),” the user profile” “for applying” (step 10[b]) is therefore already known. And because that specific user profile is known, the “one or more settings” defined by “the user profile” of step 10[a] can be “identified from the user profile” in step 10[c]. Additionally, before 10[c]’s “determining” step, the selected vehicle of step 10[b] must already be identified and “the settings that are settable in the selected vehicle” must be known. *See id.*; *E-Pass Tech., Inc. v. 3COM Corp.*, 473 F.3d 1213, 1222 (Fed. Cir. 2007) (the step of “transferring a data set” must come before the later recited step of “storing said transferred data set”). The language, logic and grammar of claim 10 make apparent the sequential nature of claim steps 10[a], 10[b] and 10[c]. Response, 16-19.

The Reply fails to rebut the fact that to accomplish steps 10[b] and 10[c], “information for a user profile of a user” of step 10[a] must already be known. Response, 6-7 (citing EX1001, 12:36-39 (“embodiments ... allow each user to apply his or her settings to any vehicle based on their login information”)). Accordingly, logic and grammar require that the recited “receiving” step of 10[a] must occur prior to the “identifying” (10[b]) and “determining” (10[c]) steps, as the latter steps recite operations that require “*the* user profile” that is already known, and that the one or more settings of that user profile have already been “defin[ed].” EX1001, 33:1-15.

Contrary to Petitioner’s cited caselaw,¹ claim 10’s use of antecedent language itself evinces logic and grammar requiring a specific order of steps, and not concurrent steps. Reply, 7, 17. “[W]hen the current step of a method claim refers to a previous step using the definite article ‘the,’ the claim language indicates that the previous step occurs sequentially before the current step.” *Medtronic, Inc. v. Teleflex Life Scis. Ltd.*, No. 2022-1605, 2024 WL 1208642, at *3-4 (Fed. Cir. 2024); *see also Wi-Lan, Inc. v. Apple, Inc.*, 811 F.3d 455, 462-63 (Fed. Cir. 2016) (claim element producing modulated data symbols must occur before combining “*the* modulated data symbols” because “subsequent use of the definite articles ‘the’ or ‘said’ in a claim refers back to the same term recited earlier in the claim”).

The antecedent relationship of the terms used in steps 10[a], 10[b] and 10[c] reinforces a sequence as a matter of grammar. *Hytera Comms. Co. Ltd. v. Motorola*

¹ Neither cited case stands for the proposition that “invoking antecedent is not enough to import an ordered sequence of steps.” Reply, 7. Use of antecedent language was not even addressed by the court in *Cybersettle Inc. v. National Arbitration Forum Inc.*, 243 Fed.App’x 603, 609 (Fed. Cir. 2007). And in *Kaneka v. Xiamen Kingdomway Group Co.*, the court held that the claims *did require* an order of steps because language of a claimed step referred to the result of the prior step. 790 F.3d 1298, 1306-07 (Fed. Cir. 2015).

Sols., Inc., 841 Fed. App'x 210, 218 (Fed. Cir. 2021) (“the fact that the ‘determining’ step says ‘the’ when it could have said ‘a’ reinforces our conclusion that it is meant to come after the ‘preparing’ step”). In *Zillow Grp., Inc. v. IBM*, the Board required a sequential order of steps where step 1[c] recited “receiving” “a search query,” while steps 1[d] and 1[e] recited “searching” and “returning” operations according to “the search query.” IPR2020-01656, Paper 33 at 10, 5-6 (P.T.A.B. Mar. 3, 2022). In *Zillow*, the Board determined that “the sequential nature of the steps is apparent from the plain meaning of the claim language and appl[ied] the plain and ordinary meaning of the steps in claim 1 *considering the recited antecedent basis* for steps 1[c] to 1[h].” *Id.* at 10 (emphasis added). Accordingly, the fact that the “identifying” step of claim 10[b] and “determining” step of 10[c] each say “the user profile” when they could have said “a user profile” reinforces the conclusion that each is meant to come after the “receiving” step 10[a].

Here, no “two-part test must be satisfied” (Reply, 7), instead, *only if* the logic or grammar of the claim language *does not* support the sequential order of steps, should the court look to the specification. *E.g. Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1369-70 (Fed. Cir. 2003). Nonetheless, not only is the sequential nature of the claim steps apparent from the plain meaning of the claim language, but also, as detailed below, nothing in the written description suggests otherwise.

2. The specification and district court infringement and validity theories further support claim 10’s sequential order of steps 10[a]-10[c].

Petitioner attempts to create inconsistencies where there are none. First, Patent Owner has repeatedly maintained that the plain meaning of claim 10 shows this specific order of steps. For example, Patent Owner’s infringement theory in district court has repeatedly recognized this express order of steps. *See, e.g.*, EX2020, 27-68; Response, 16-19.

Second, Petitioner points to an embodiment of the specification as purportedly inconsistent with the required order of steps, but tellingly, Petitioner omits the first two paragraphs of that embodiment’s description. Reply, 9 (citing EX1001, 16:57-[17:]2, 17:3-11). *Before* Petitioner’s “starting point” (the “pairing request” at EX1001, 16:57), the specification discloses that “[u]sers wishing to find a vehicle to use can *access an application*[.]” EX1001, 16:42-45 (emphases added). This embodiment includes receiving information from the user’s login to the *accessed application*—before the user receives an option of vehicles within a range of the location of the user. *Id.* And “[*o*]nce the user has located a proximate vehicle,” and approaches the vehicle—allowing a geo-location of the user’s mobile device to be detected—does the relied-upon “pairing request” occur. *Id.*, 16:46-56 (emphases added).

Accordingly, if the “pairing request” is an example of the “identifying” step of 10[b], information for a user profile of a user has already been received, since the user has already accessed the application and the geo-location of the user’s mobile device has already been detected before that pairing request can be made. *Id.*, 16:34-65.

Petitioner also mischaracterizes Patent Owner’s district court argument regarding this embodiment. Patent Owner represented that a server, as well as a user’s device, can perform the “identifying” operation. EX1022, 80. As shown above, whether the “identifying” in this embodiment is performed by a user’s device or by a server, the user must already have accessed an application, and the user has already come into proximity to the located proximate vehicle—all *before* the pairing request. EX1001, 16:34-65.

Accordingly, “the sequential nature of the claim steps is apparent from the plain meaning of the claim language and nothing in the written description suggests otherwise.” *See Mantech*, 152 F.3d at 1376.

III. Because *Xiao* is vehicle-specific, it cannot disclose the limitations of 10[b] or 10[c].

A. The Reply highlights the vehicle-specific deficiencies of *Xiao*.

Nothing in Reply rebuts the Response’s detailed demonstration that *Xiao*’s operator profile settings are always vehicle-specific, requiring at registration, every setting to be preset individually “for each automobile 112 on the account,” and by

its user interface, *Xiao*'s system is constrained to be vehicle-specific when the user issues any command request to apply settings. Response, 19-31. *Xiao* refutes Petitioner's contention that preferences "are specific to the user"—instead, they are always specific to the already-selected vehicle. *Id.* Because the server automatically selects the "default automobile" on the account, the user interface ("UI") will only identify those preset system preferences and commands that are available for that already-identified automobile (e.g., "Mazda 6"). Response, 22-23.

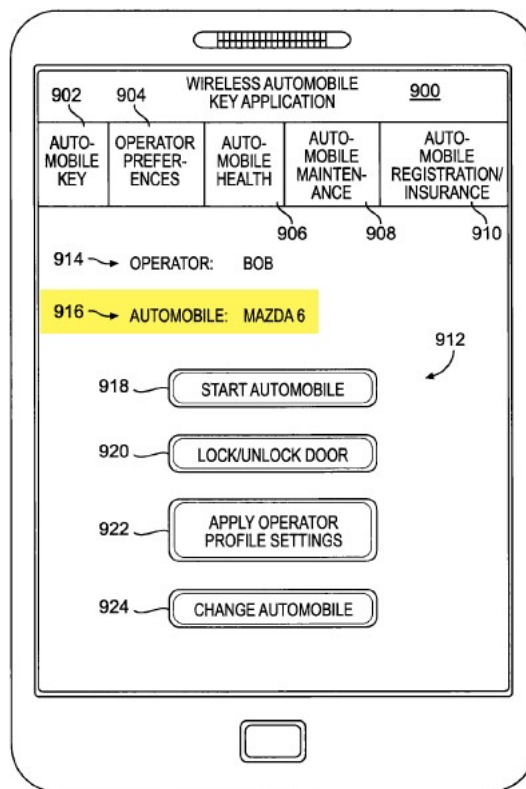


FIG. 9

EX1010, Fig. 9 (annot.). When a user issues a command request from the UI (e.g., 922 apply operator profile settings), *Xiao*'s system can only retrieve and relay a

command code corresponding to a setting that is fixed for that already-identified vehicle displayed on the UI. Response, 19-31.

Xiao is clear that in order for any setting to be applied to a different, “new automobile,” the user must manually select the “change automobile UI element 924.” EX1010, ¶ 110.

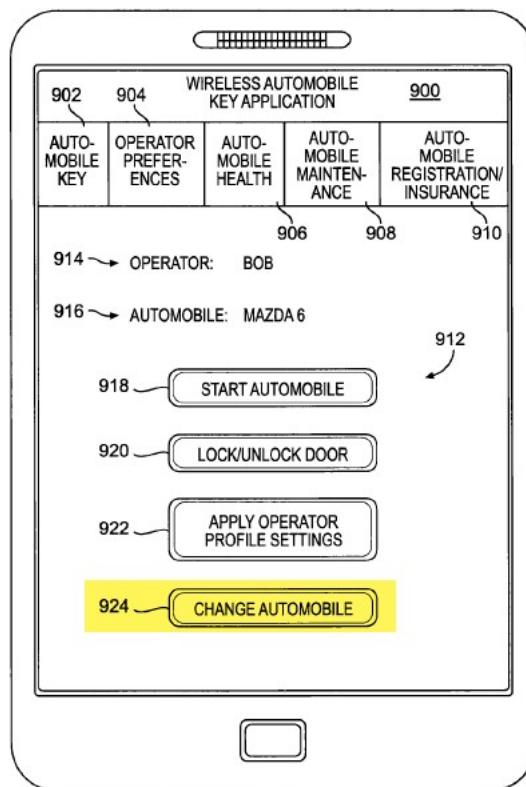


FIG. 9

Id., Fig. 9 (annot.). *Xiao* teaches that the user may select “a new automobile” from the “automobile selection menu” and only “subsequently, the operator may be able to perform the various automobile key service with respect to *the* selected new automobile 112.” *Id.*, ¶ 111 (emphasis added). Therefore, once that “new

automobile” is identified, and the user’s preset system preferences for that automobile are relayed to the user’s mobile device, the user interface will only display available commands according to the preset system preferences for that second, already-identified automobile. *Id.* And only then, the user “may apply the preferences indicated in the operator profile information 614 to the systems of the new automobile 112 using UI element 922.” *Id.* (emphasis added).

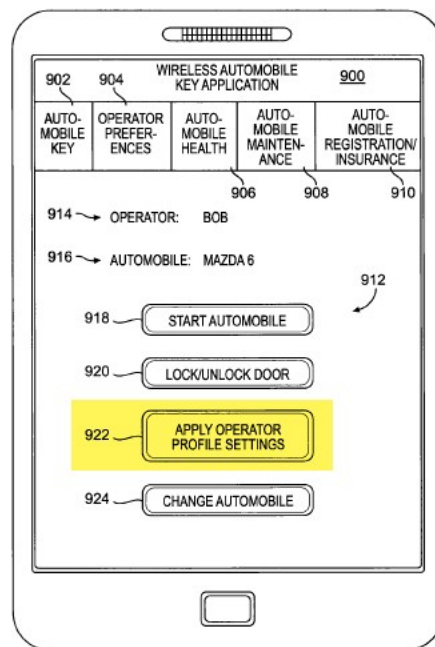


FIG. 9

Id., Fig. 9 (annot.). *Xiao*’s system requires that the user *first* select a “new automobile,” *before* the user interface’s display of preset system preferences for that automobile. *Id.*, ¶¶ 110-111, Fig. 9. Accordingly, the system preferences available to the user are always vehicle-specific.

B. The Reply misrepresents the “applicable settings” required of claim 10[c], to no avail.

Because any setting in *Xiao* is always vehicle-specific, *Xiao*’s purported retrieval of “settings for the selected vehicle” cannot meet the “applicable settings” expressly defined by claim 10[c], regardless of whether a “compatibility check” is required. Response, 38-47. Claim 10[c] requires that the “applicable settings” determined are “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.” EX1001, 33:11-15. Therefore, the ’268 patent allows a user profile having a set of one or more settings that can be set *in vehicles*, while *Xiao* is limited to applying any setting to only one vehicle. Claim 10[a]; Response, 38-47. *Xiao* lacks “the user profile” from which to identify “settings that are preferred to be set,” and therefore *Xiao* cannot determine the “applicable settings” defined by claim 10[c].

Additionally, *Xiao*’s server never determines compatibility between one set of settings—“identified from the user profile”—and another set of settings—those “that are settable in the selected vehicle.” Claim 10[c]. Instead, upon registering, the user in *Xiao* inputs the system preferences “for each automobile 112 on the account,” the server automatically selects the default automobile on the account, and the system’s UI automatically displays to the user only those preferences and commands preset for that already-identified automobile. Response, 19-25. Via the

UI, the user may only issue command requests that are likewise constrained to be vehicle-specific, as each request will already contain the automobile ID and command ID specific to the already-identified vehicle. *Id.*, 22-31, 46.

C. The Reply confirms *Xiao*’s failure to disclose “the user profile” defined in 10[a] and required by the operations in steps 10[b] and 10[c].

None of Petitioner’s arguments rebut *Xiao*’s failure to disclose the operations of steps 10[b] and 10[c] requiring “the user profile” expressly defined by step 10[a]. Naturally, Patent Owner need not have proposed any construction for “the user profile,” since limitation 10[a] itself already describes “the user profile.” EX1001, 33:3-5. Whether this description allegedly uses “the passive voice” (Reply, 13) is of no consequence to *Xiao*’s failures, as the Response demonstrated that *Xiao*’s vehicle-specific system cannot perform claim 10’s recited operations *acting on* the “the user profile.” EX1001, 33:3-15; Response, 42-46. Moreover, that detailed showing made in the Response—*Xiao*’s failure to disclose “the user profile” defined by 10[a] and required by antecedent basis in the operations recited in limitations 10[b] and 10[c]—is distinct from the Preliminary Response, which had addressed *Xiao*’s failure to meet the “information” limitation of claim 10[a] and the claims’ required compatibility check. *Id.*; POPR, 43-47.

The Reply ignores *the operations* recited by claim 10 which expressly require “the user profile,” for example, irrelevantly arguing that there is no “requirement

that each profile setting be set in multiple vehicles.” Reply, 14. This statement ignores the import of the invention’s compatibility check, which ensures that only “applicable settings” that are “determine[ed]” in step 10[c] will be sent to the vehicle in step 10[d]. EX1001, 33:1-21. That is, of those one or more settings that are preferred to be set in vehicles, as defined by the user profile, the server determines settings are compatible with the settings that are settable in the selected vehicle. *Id.* *Xiao* cannot perform the “identifying” or “determining” operations requiring “the user profile,” at least because *Xiao* does not disclose “the user profile defining one or more settings that are preferred to be set *in vehicles*.” *Id.*, 33:3-15; Response, 42-46.

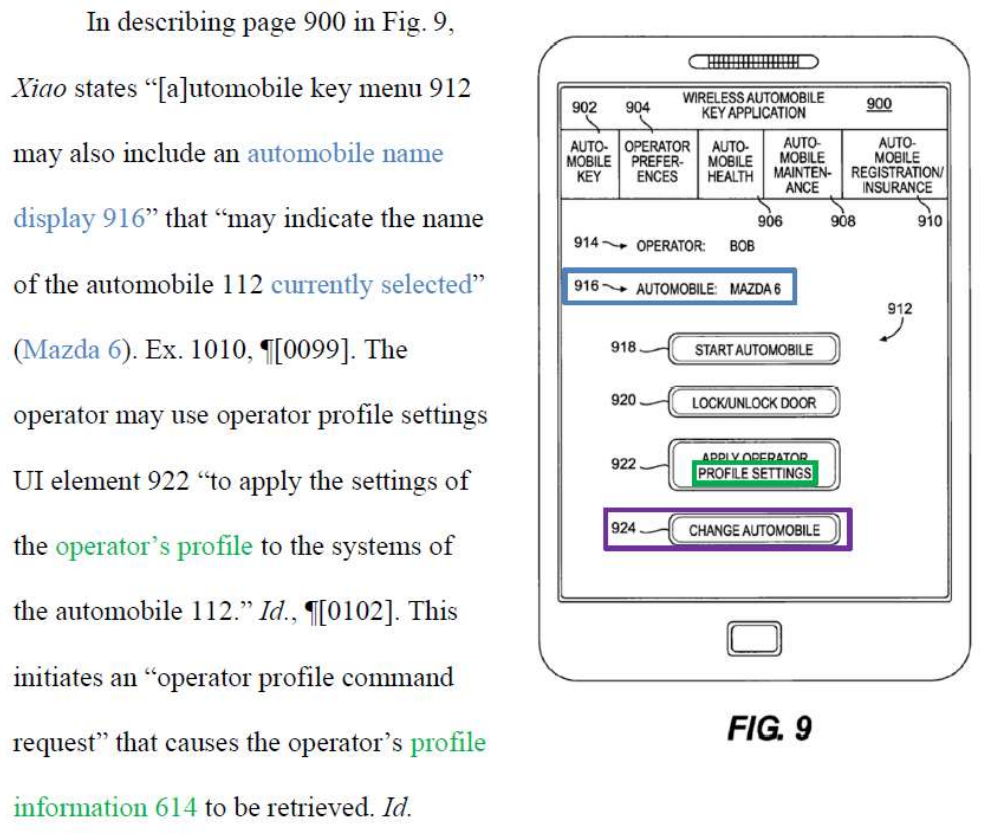
It is not incumbent upon Patent Owner to show what claim 10 allegedly “prohibits.” Reply, 14. Instead Petitioner bears the burden of proof, and the Petition relies on *Xiao* alone for alleged disclosure of “the user profile” as recited in 10[a]-[c]. The Response details why *Xiao* can neither identify “a selected vehicle *for applying the user profile*” (step 10[b]), nor determine “applicable ... settings that are preferred to be set as *identified from the user profile*” (step 10[c]). Response, 38-46.

The Reply’s rehashing of the word “automobile(s)” is of no import. Reply, 15-16. Upon registering and creating an account, each system preference of *Xiao* is configured by the operator “for each automobile 112 on the account,” the “operator

preferences menu UI element 904” can only be modified vehicle-by-vehicle, and each command request that is available to the operator is specific to the already-identified automobile displayed on the UI. EX1010, ¶¶ 99-102, 105, 110-111, Fig. 9; Response, 19-31. When “a new automobile” is selected from the “automobile(s)” that are registered to the account, the UI will likewise display the available information specific to *that* automobile. Response, 22-24.

IV. Petitioner’s rewriting of its anticipation argument on Reply does nothing to rebut *Xiao*’s failure to disclose claim 10’s elements or the required order of steps.

Xiao’s command request, relied upon for step 10[a], is unavailable until *after* the already-identified automobile is displayed on the UI—relied upon for the “identifying a selected vehicle” limitation of step 10[b]. Response, 47-50. Petitioner now attempts to change its theory to instead rely on *Xiao*’s “operator profile command request” for both steps 10[a] and 10[b], but this belated argument also fails to disclose the steps as ordered, or meet the limitations of claim 10. As shown below, Petitioner concedes that any command request is constrained to be vehicle-specific, and therefore cannot be “one of a plurality of vehicles identified as available by the server,” as recited by step 10[b]. Claim 10[b].



Pet. 24.

In Reply, Petitioner invents a non-existent “loop” to try to correct *Xiao*’s failure to disclose the required order of steps, but *Xiao*’s disclosures and Petitioner’s own admissions show this “loop” is a fiction. Reply, 16-17.

First, *Xiao*’s “apply operator profile command request” cannot disclose step 10[b] because that command request is always constrained to be vehicle-specific and cannot therefore meet step 10[b]’s requirement that the identified vehicle is “one of a *plurality of vehicles* identified as available by the server.” EX1001, 33:6-10; Response, 25-31, 43-44. As shown by *Xiao*, and as Petitioner now concedes,

this command request is the opposite: “constrained to one, single vehicle,” containing an automobile ID for *the* automobile 112 for which to provide the requested service. Reply, 16-17.

¶¶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”).

Id.

According to the Petition, the “change automobile UI element 924”—allegedly meeting 10[b]’s limitation reciting a “plurality of vehicles identified as available by the server”—is only displayed and available ***before*** the “apply operator profile command request” is issued. Pet. 21-23. Upon issuance of the “apply operator profile settings 922” command request, however, that command request “would necessarily include an identification of *the* automobile to which settings are applied” (Reply, 16-17)—constraining any alleged identification to only one single vehicle available for applying profile settings. *Id.*; Response, 25-31, 38-39.

Accordingly, this “command request,” fixed to an already-identified vehicle, cannot meet the limitations of step 10[b]. *Id.*

Second, *Xiao* itself contradicts the “loop” invented by Petitioner. Because *Xiao* automatically identifies the default automobile 112 on the account and displays the available preferences for that automobile as depicted in Figure 9 (e.g., “Mazda 6”), *Xiao* does not permit another identification of an automobile *unless* and *until* the user clicks the “change automobile” UI element *and* manually selects “a new automobile.” Response, 19-25, 47-51; EX1010, ¶¶ 110-111. Indeed, Figures 10 and 11, cited in Reply, recite steps that are already constrained to one and only one already-identified automobile, i.e. “*the* automobile 112.” *Id.*, ¶¶ 112, 117, 123-125, Figs. 10-11.

Finally, as shown above, the plain language of claim 10 makes clear that step 10[a] is a condition precedent to steps 10[b], as opposed to “concurrent” steps. *See* section II.B., *supra*. Nevertheless, *Xiao* still fails to disclose the required order because the automobile identification by *Xiao*’s server and displayed on the UI must occur before, not “occurring concurrently” with, the later-available “apply profile information” command request. Response, 47-51.

Accordingly, the Reply’s changed theory still fails to show *Xiao*’s disclosure of claim 10’s required order of steps or the limitations therein.

V. Petitioner rehashes the same failed arguments for claims 17-19.

Xiao's disclosure of multiple operators on a single family account does not disclose "one or more sub-user accounts." Response, 51-54. Claim 17 requires "associating one or more sub-user accounts to the user profile" *in addition to* the already-recited "user profile of a user" of independent claim 10, and those one or more sub-user accounts must further have "predefined privileges for the selected vehicle." EX1001, 33:1-5, 34:16-20. Similarly, claims 18 and 19 require claim 10's "user profile of a user," *plus* "an administrator account that can define one or more sub-user accounts." *Id.*, 34:21-42. *Xiao*'s table 600 is *one account* that includes column 614—the Petition's relied upon "a user profile." Pet. 22. By Petitioner's own representations, *Xiao*'s single account merely *includes* profile information for the operators on the lone account, not any "one or more sub-user accounts" associated with "the user profile" (claim 17) or "a user profile of a user" plus "an administrator account that can define one or more sub-user accounts" (claims 18 and 19). EX1010, Fig. 6, ¶ 65; claims 17-19.

608		610	612	614		616	602
OPERATOR ID		MOBILE ID	AUTHENTICATION INFORMATION	PROFILE INFORMATION	AUTOMOBILE PERMISSIONS	DEFAULT AUTOMOBILE ID	617
—		—	—	—	—	—	
—		—	—	—	—	—	
—		—	—	—	—	—	

Pet. 22. Accordingly, *Xiao*'s mere disclosure of a lone account, which *includes* the "profile information" for operators on the lone account, cannot anticipate claims 17, 18, or 19. EX1010, ¶¶ 22, 66, 76, Fig. 6.

In Reply, Petitioner misrepresents Dr. Malek's testimony about multiple accounts, but the cited testimony refers to *Xiao*'s "*storage device 506*, which may contain automobile key service information for a plurality [sic] accounts." EX1024, 45:16-21 (quoting EX1010, ¶ 65) (emphases added). That many different accounts can be registered, each with its own table "600 for one account" (*id.*) is of no aid to Petitioner. *Xiao*'s table 600 discloses neither "a user profile of a user" plus "one or more sub-user accounts" associated with that user profile (claim 17), nor "a user profile of a user" plus "an administrator account that can define one or more sub-user accounts ..." (claims 18 and 19).

VI. The *Xiao*/*Hayashi* combination leads to a non-sensical result that nonetheless fails to meet limitation 10[c].

The Petition's reliance on *Hayashi* is limited to 10[c] and therefore does nothing to remedy the remaining deficiencies of *Xiao*. Response, 31-51, 55-56. The two references are not properly combined. *Id.*, 55-56. Indeed, the non-sensical result of this proposed combination—allowing only that a server find "none" for applicable settings of step 10[c]—both highlights the impropriety of combining these references *and* their inherent deficiency. *Id.*, 55-60. *Hayashi*'s disclosure of

“none” necessarily negates any disclosure or suggestion of step 10[c], which requires determining applicable settings, not their absence. Claim 10 requires the server to determine “applicable settings” and send those “applicable settings” to the selected vehicle. EX1001, 33:11-21. Were the server to determine no applicable settings, neither step 10[c] nor 10[d] could possibly be disclosed. *Id.*; Response, 58-60.

Moreover, *Hayashi* is not related to “settings that are preferred to be set as identified from the user profile,” but instead instructions for how to operate an unfamiliar vehicle, such as to engage the parking brake or operate the shift lever. *Id.*, 56-59. By pointing to “seat adjustment function, or mirror adjustment function,” Petitioner does not change the fact that *Hayashi* only provides instructions on *how to operate* these functions. *Id.* Just like instructions on how to operate vehicle functions, *Hayashi* is unrelated to determining, storing, sending any “user profile” settings, as recited. *Id.*

VII. Petitioner’s belated construction of “sending” is erroneous, and regardless, *Patenaude* fails to send the learned settings to the user profile, as recited in claim 12.

“Sending” is not “retrieving.” Response, 54-55 (citing EX2011, ¶¶ 121-122). Such a construction is not only improper and belated in Reply, the assertion of Petitioner and Dr. Almeroth belies credulity. Moreover, claim 12 plainly requires an additive operation – “sending the learned settings *to the user profile*.” EX1001,

33:38-39. By contrast, *Patenaude*'s retrieval operation merely takes data *from the vehicle*'s stored, in-memory profile. EX1011, ¶¶ 72-73. Regardless of Petitioner's new and incorrect construction, *Patenaude* cannot accomplish the additive result achieved of "sending the learned settings *to* the user profile," and fails to disclose or suggest claim 12[c].

VIII. The Petition relied solely on *Xiao* for alleged disclosure of limitation 20[b]—a deficiency so apparent the Board "questioned" its veracity without any argument by Patent Owner.

The Petition misidentifies "terminal device," attempting to capitalize on *Xiao*'s obvious typographical error. Response, 64. This failure of proof was so evident that the Board "questioned" whether the Petition could satisfy limitation 20[b], despite no such argument from Patent Owner's Preliminary Response. ID at 43. The Board was nonetheless required to institute under *SAS* in light of the other claims, despite the Petition's misrepresentation of *Xiao*. *Id.*

Petitioner's newfound reliance on *Patenaude* and *Hayashi* is of no avail, as the Petition relied solely on *Xiao* for the "communicating ... by the vehicle" limitation. Pet. 68 (e.g., citing *Xiao*'s "automobile 112").

Accordingly, the Petition fails to render disclose or suggest both the compatibility check required of claim 20[a], and limitation 20[b]. Response, 63-66.

IX. Conclusion

For all of the reasons given above, the Board should uphold each of the challenged claims.

Dated: May 30, 2025

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 5,593 words, as determined using the standard word counting feature of the Microsoft Word program.

Dated: May 30, 2025

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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 May 30, 2025, a copy of the foregoing document was served by email upon the following counsel at the below email addresses:

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