

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORP.,
Petitioner,

v.

EMERGING AUTOMOTIVE LLC,
Patent Owner

IPR2024-00786
Patent 9,171,268 B1

Record of Oral Hearing
Held Virtually: August 8, 2025

Before GEORGIANNA W. BRADEN, FRANCES L. IPPOLITO, and
JASON M. REPKO, *Administrative Patent Judges*.

IPR2024-00786
Patent 9,171,268 B1

APPEARANCES:

ON BEHALF OF THE PETITIONER:

JOSHUA GOLDBERG, ESQUIRE
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
901 New York Avenue, NW
Washington, DC 20001
joshua.goldberg@finnegan.com
(202) 408-6092

ON BEHALF OF THE PATENT OWNER:

BRENDA ENTZMINGER, ESQUIRE
JERRY TICE II, ESQUIRE
Bunsow De Mory LLP
701 El Camino Real
Redwood City, CA 94063
bentzminger@bdiplaw.com
(650) 351-7242
jtice@bdiplaw.com
(650) 318-6774

The above-entitled matter came on for hearing on August 8, 2025,
commencing at 1:00 p.m., via video teleconference.

P R O C E E D I N G S

- - - - -

JUDGE IPPOLITO: Good afternoon. This is the oral hearing for IPR2024-00786. I'm Judge Ippolito, and I have with us today Judges Braden and Repko. We did a little introduction before, but since our record has now started, could I have you introduce yourselves again, beginning with Petitioner?

MR. GOLDBERG: Good afternoon, Your Honor. This is Joshua Goldberg for Petitioner, Toyota.

JUDGE IPPOLITO: Patent Owner?

MS. ENTZMINGER: Good afternoon, Your Honors. This is Brenda Entzminger for Patent Owner, Emerging Automotive, LLC.

JUDGE IPPOLITO: Welcome. The hearing order sets out the procedures we're going to follow today. And per our order, each side will have 60 minutes of total presentation time. Petitioner, you can reserve time for rebuttal, and Patent Owner, you can reserve time for sur-rebuttal.

I will be keeping time on my own device, and will provide some reminders. But as you can see, we don't have a clock that shows in a virtual hearing so you will have to keep your own time as well. I do like to offer parties a break or two, if you need one. During transitions, if you need a break in addition to that, don't hesitate to ask for one.

If you're going through slides, those could be shared, but we still want to tell us the slide number so we can follow along and have that in the transcript as well. As a reminder, the hearing is public so we do have an active public line.

1 And with that, I think we can begin. Petitioner, do you have any
2 time you'd like to reserve for rebuttal?

3 MR. GOLDBERG: Yes, Your Honor, I'd like to reserve 15
4 minutes.

5 JUDGE IPPOLITO: Okay. I have that down, and you can start
6 when you're ready.

7 MR. GOLDBERG: All right. I will go ahead and share the slides.
8 And, Your Honors, I will start with Slide 49.

9 So, Your Honors, there's several disputes between the parties at
10 this point in the proceeding. I'd like to start by speaking about the user
11 profile that shows up in Claim Elements 10[a], [b], and [c]. And I'll first
12 start on Slide 50, talking about Claim Element 10[b]. The reason being that
13 Patent Owner's arguments about this issue, in particular, their arguments
14 repeatedly that vehicle-specific is an issue, that somehow the information in
15 Xiao is vehicle-specific, and that makes it so it can't meet the claims. That's
16 really been focused on Elements 10[b] and 10[c]. But the reality is, that
17 there is nothing in the claims that precludes vehicle-specific settings. And if
18 we focus on the language in the claims themselves, and we can see that for
19 10[b] at the top of Slide 50 here, we can walk through it, and we can see that
20 every aspect of the claims themselves is actually disclosed by the Xiao
21 reference.

22 So, identifying a selected vehicle, we can see in Figure 9 on the
23 left side of the slide here, at the top in a blue box an automobile, it's a Mazda
24 6, so that is a vehicle that is identified. It also provides, toward the bottom
25 there, that you can change the automobile, so you can identify a new
26 automobile. And that indicates, toward the end of the claim, that there's a

1 plurality of vehicles that are available.

2 There's also a button here that says, apply the operator profile
3 settings in Figure 9, that's 922, and that would be a place where you can
4 apply the user profile. So, we're identifying the selected vehicle, we're
5 applying the user profile. Now, we get to the selected vehicle, has a
6 plurality of settable settings. And if we look at the right side of the slide,
7 paragraph 102 over there, the operator profile information 614, they identify
8 certain desired settings. For example, this includes the operator's desired
9 climate system settings, desired audio system settings, desired operator
10 comfort settings, such as seat positions and temperatures, desired operator
11 awareness settings, things like the rearview mirror position. So, the vehicle
12 has a plurality of settings. And, again, the vehicle can be one of a plurality.
13 Because we have a Mazda shown in Figure 9, and we also have the ability to
14 change the automobile. And if we look at that middle figure with the series
15 of tables, we can see several places for different automobile IDs, which Xiao
16 recognizes can be things like the vehicle identification numbers. So we are
17 going to be having, again, a plurality of vehicles that are available.

18 If we go to Slide 51, we can see that, for Element 10[c], similarly,
19 the actual language of the claims is all disclosed by the Xiao reference. So,
20 we're going to determine by the server applicable settings for the selected
21 vehicle, and those are going to be identified from the user profile. If we look
22 at paragraph 103, the top left of Slide 51, it says that, based on the desired
23 automobile system settings indicated by the operator profile information
24 614, automobile service server 118 may retrieve appropriate command codes
25 632, so those are going to be the applicable settings for the vehicle that's
26 selected.

1 The applicable settings, again, they're identified from the user
2 profile. And I'll get to this in a little bit more detail in a few minutes, but
3 they're compatible with settings that are settable in the selected vehicle
4 because they end up actually being set in the vehicle. We can see that, if we
5 go to the bottom of paragraph 103, it says, then, automobile service server
6 118 may generate one or more commands based on the retrieved command
7 codes 632 to control the automobile systems to achieve the operator's
8 desired settings.

9 JUDGE IPPOLITO: Counsel, can I stop you there?

10 MR. GOLDBERG: Yes.

11 JUDGE IPPOLITO: I think that one of the disputes is whether or
12 not this look up appropriate command codes is sufficient to be a
13 compatibility check based on a claim construction dispute. Can you speak
14 on that issue?

15 MR. GOLDBERG: Yes, Your Honor. Let me go to Claim 23
16 -- I'm sorry, Slide 23. So, I want to -- first, Your Honors, just note that we're
17 dealing with two claims here, Claims 10 and 20. Thus far, I was focusing on
18 a couple of elements in Claim 10. There's some similar but different
19 elements in Claim 20. And as you can see on this slide here, there is a
20 meaningful difference on these compatibility issues. On the left-hand side
21 on Claim Element 10[c], the word determine does not show up there. All it
22 says is that the settings are compatible, the settings that are settable in the
23 selected vehicle. Whereas, in Claim 20, it says that these settings are
24 determined to be compatible for use with the vehicle. So, just as an initial
25 matter, in Claim 10, there actually isn't any requirement to determine that
26 settings are compatible. But even if they were, as Claim 20 actually does

1 end up requiring that you do this determination, that is something that is
2 disclosed by the Xiao reference.

3 If we go to Slide 28 --

4 JUDGE IPPOLITO: Let me stop you right there just to make sure
5 I understand. Are you conceding that for Claim 20[a] the server is doing a
6 compatibility check, but disputing whether or not that is the case for 10?

7 MR. GOLDBERG: So, in Claim 20, I would say, we accept that
8 there is a compatibility check done. The claim does not specify that it has to
9 be done by the server, but there is a check. In Claim 10, we do dispute that a
10 compatibility check is required at all. To the contrary, all that the claim
11 actually requires is that the settings happen to be compatible.

12 JUDGE IPPOLITO: So, if the server is determining the applicable
13 settings, and those settings are compatible, isn't that part of what the server
14 is doing in determining the applicable settings, is making that compatibility
15 check?

16 MR. GOLDBERG: I don't think the claims require that, Your
17 Honor. The claims could have been written in the active voice to
18 specifically articulate that the server has to do some compatibility
19 determination, but for whatever reason, that is not the way that the applicant,
20 now Patent Owner, chose to write the claims. Instead, they wrote them in
21 the passive voice to merely indicate that there was compatibility.

22 JUDGE IPPOLITO: So, how would that compatibility --

23 JUDGE BRADEN: (INDISCERNIBLE) --

24 JUDGE IPPOLITO: Oh, go ahead, Judge Braden.

25 JUDGE BRADEN: Well, the claim specifically says, determining
26 by the server the applicable settings. And then, it goes on to define that the

1 settings are settings that are preferred to be set as identified from the user
2 profile and are compatible with settings that are settable in the selected
3 vehicle. It appears, based on the structure of the sentence, that applicable
4 settings has two defining requirements. Do you read that differently,
5 Counsel?

6 MR. GOLDBERG: So, I read it as the server can determine
7 applicable settings, and that then they just happen to be compatible. The
8 server does not have to check whether they are compatible before deciding
9 that those are the applicable settings. And had the Patent Owner wanted it to
10 actually require that the server do that, then the claim should have been
11 written to say, determine by the server whether settings are compatible, and
12 if they are, determine that those are applicable settings, but that's not how
13 the claim was written.

14 JUDGE REPKO: This is Judge Repko. Do you have any support
15 in the written description of the patent any embodiments that may support
16 this reading of the claim they just happen to be compatible?

17 MR. GOLDBERG: I don't have any portions of the specification
18 to point to and say, this requires that the claim be construed the way that I'm
19 articulating. Instead, it's merely that the plain and ordinary meaning of the
20 claim language itself, does not require that narrow reading, and that there's
21 nothing in the specification or the file history that's been pointed to, that
22 would require such a narrow reading. Particularly, given that Claim 20,
23 specifically, is written in a different way to show that settings are actually
24 determined to be compatible.

25 And one thing that I think might be helpful here, Your Honors, is if
26 we look at the Patent Owner response at page 12 -- and I'll just give Your

1 Honors a minute to get there. At the top of page 12, Patent Owner specifies
2 that for Claim 14, the functionality required by the server in determining
3 applicable settings must be at least capable of performing a mapping
4 between settings associated with the user profile, and settings obtained from
5 an automobile database. And then, Patent Owner says, this example of a
6 compatibility check. So, that language in Claim 14, according to them, is a
7 compatibility check.

8 And if we look now at the petition at pages 57 and 58, we can see
9 here where that very limitation is being addressed in the petition, and what
10 we point to is Xiao at paragraphs 88 and 103, and Xiao's explanation that --

11 JUDGE REPKO: So, I guess apart from Xiao's explanation, I have
12 a question about page 12 here. I want to make sure I understand what your
13 point is. The sentence reads, "This example of the compatibility check is
14 supported by the specifications." So, they're talking about a specific
15 example?

16 MR. GOLDBERG: Yes.

17 JUDGE REPKO: Is that how you read that? So, there are
18 examples of compatibility checks, and one of them is this mapping engine.
19 Does every single example have some sort of compatibility check, just
20 maybe variations on it, every embodiment in the spec?

21 MR. GOLDBERG: I don't believe that the specification
22 specifically calls out compatibility checks in every instance where settings
23 are being applied.

24 JUDGE REPKO: So, it's your view that are certain embodiments
25 that don't have a compatibility check?

26 MR. GOLDBERG: I think that it is one example where it is

1 specifically called out, and that other areas of the specification do not call it
2 out in this way.

3 JUDGE REPKO: Right. But I guess my -- and on that point, I
4 guess my reading of that sentence seems to be, like, an example of a
5 compatibility check is a mapping, not that a compatibility check is an
6 example of the claimed invention. Is that an accurate reading?

7 MR. GOLDBERG: Yes, Your Honor, on that point it is. And
8 what I was trying to get to, is that this issue of whether the compatibility
9 check is required or not, I don't think it ultimately matters to the outcome of
10 this case. And one of the reasons that I don't think it matters is that Patent
11 Owner has conceded that the compatibility check, to the extent that it exists
12 in Claim 1, and as it does exist in Claim 20, that one example of that is what
13 is shown in Claim 14, and Claim 14 is this mapping situation.

14 And if we look at Slide 29 of our demonstratives, we can see what
15 Xiao is doing, and we can see that Xiao is actually doing this same type of
16 mapping, and this is actually our expert, Dr. Almeroth, talking about what
17 Xiao is actually doing. In paragraph 96 of his declaration, he explains that
18 Xiao demonstrates the concept of compatibility of certain settings by
19 disclosing appropriate command codes being sent to appropriate automobile
20 modules. Xiao explains its server generates or retrieves appropriate
21 commands code 632, corresponding to an operator's desired settings in a
22 particular vehicle. So, this is that mapping happening in Xiao.

23 And he goes on to explain that these command codes 632 are
24 associated with each command that may be issued to the automobile 112.
25 That's citing to paragraph 88. And by listing them in the table of automobile
26 command code information 606, Xiao shows that there are particular settings

1 compatible with particular automobiles and particular desired settings. And
2 thus, Xiao demonstrates the necessarily present characteristic that certain
3 settings, for example, commands, are compatible with certain automobiles.

4 And the reason that I found paragraph 88 and 103 particularly
5 interesting and called them out, is those are the exact same paragraphs that
6 we cite in our petition at pages 57 and 58. When we are mapping -- sorry to
7 use the word mapping. When we are comparing the Claim 14, the Patent
8 Owner says, as an example of a compatibility check to Xiao, that Patent
9 Owner has not contested that these teachings for Claim 14, specifically
10 paragraphs 103 and 88, teach the mapping in Claim 14, which were
11 necessarily, according to Patent Owner's admission, mean that they would
12 also teach a compatibility check in Claim 1 and Claim 10.

13 JUDGE REPKO: I just want to stop there for a moment to make
14 sure I understand your point here. The slides titled compatibility; you didn't
15 necessarily put check in there. But you're saying that -- let's assume for a
16 moment, that the claim requires a compatibility check. You're saying that on
17 this slide that there's a check there? That the appropriate command codes
18 are checked to be appropriate? Is that your argument?

19 MR. GOLDBERG: What I'm saying is, that according to Patent
20 Owner, that merely doing this mapping, merely taking the codes, and merely
21 looking at what's in the profile, and then mapping it to the command code
22 632, the fact that it's doing that mapping, according to Patent Owner, that's
23 an example of a compatibility check. Doing mapping is an example of
24 doing a compatibility check. That's what Patent Owner says in its Patent
25 Owner response.

26 JUDGE REPKO: So, what do you -- what's your take on it

1 though? I want to understand your position on Xiao. Does Xiao make a
2 determination here with the codes to make sure they're appropriate? Is that
3 the mapping you're referring to?

4 MR. GOLDBERG: Yes. I think that Xiao does, because Xiao -- if
5 we go back to Slide 28 and look at the actual language of the reference itself
6 in paragraph 103, it says that, for example, automobile server 118, then look
7 up appropriate command codes 632, based on automobile ID 627 and the
8 command ID 630. That use of the word appropriate is what is indicating that
9 it is checking to see whether it's compatible or not. It's not going to find an
10 inappropriate command code, it's going to use appropriate command codes.
11 And I think that's the entire point in Xiao of having the table that links up the
12 command codes 632 to the information that is coming out of the operator
13 profile information 614.

14 If it was not necessary to see how does it actually map, how does it
15 actually get from the profile information to the vehicle itself, there would be
16 no need to have the command codes at all. The user settings would instead
17 just directly define what it is that you tell the vehicle to do. You wouldn't
18 have to have another layer of looking up what the appropriate command
19 codes are.

20 JUDGE REPKO: So, I guess, looking at 103 again, you're saying
21 that there are these command codes. Some are appropriate, some are not,
22 and the servers may determine which ones are appropriate based on the
23 setting; is that correct?

24 MR. GOLDBERG: The server's going to get in the setting, and it's
25 going to look and try to find what is the appropriate command code for that.
26 And it's either going to find it or it's not going to find it. If it finds it, it's

1 going to be an appropriate command code. If it doesn't find it, then who
2 knows what happens? And that's actually what brings us to the combination
3 with Hayashi, that we articulated in the petition, to account for the situation
4 of what happens when it doesn't find it? In Xiao it doesn't request --

5 JUDGE REPKO: (CROSSTALK) --

6 MR. GOLDBERG: Yes, Your Honor.

7 JUDGE REPKO: So, Xiao doesn't explain explicitly what happens
8 if it doesn't find an appropriate code?

9 MR. GOLDBERG: Exactly, and that's what we brought in the
10 Hayashi reference to deal with.

11 JUDGE REPKO: Wouldn't that suggest that there's only
12 appropriate codes? They just happen to be appropriate. The only codes that
13 are available are the ones that are appropriate?

14 MR. GOLDBERG: I don't --

15 JUDGE REPKO: There's no explanation of the error condition?

16 MR. GOLDBERG: I don't think so, Your Honor, because I don't
17 think that it would have specified the word appropriate, and I don't think the
18 command codes would have existed at all if it needed to -- sorry, if it was
19 just the case that always all of them were appropriate.

20 JUDGE REPKO: Thank you.

21 MR. GOLDBERG: Instead, I was saying before, I think they
22 would just be specified directly by the user, and you wouldn't have this extra
23 table.

24 JUDGE REPKO: Okay, thank you.

25 MR. GOLDBERG: So, turning to the combination, a person of
26 ordinary skill in the art, they would have been motivated to avoid

1 determining settings that are incompatible to avoid unexpected and/or
2 undesired results. They would not want to have vehicle configurations that
3 result in errors. And this is something that Dr. Almeroth explains at
4 paragraph 190. That in order to deal with the incompatibility -- the
5 possibility of incompatibility, that you're going to seek to avoid that. And
6 one way of avoiding that is by keeping track of what works and what doesn't
7 work more expressly.

8 And if we go to Slide 33, we can see how the Hayashi reference
9 does that. In the Hayashi reference it stores operating methods for various
10 functions according to vehicle models. And I know Patent Owner had some
11 arguments about whether these functions were relevant or not to what's
12 happening in the Xiao reference. I think they are. If you look at paragraph
13 120 at the bottom of the slide, we can see it talk about the seat adjustment
14 functions and mirror adjustment functions. The same type of settings we
15 saw earlier in Xiao, and that also exist in the '268 Patent. And as she
16 specifically recognizes, that if a certain vehicle model does not have a
17 certain function, none may be stored in the database of operating methods.
18 And that word, none, is in quotes. So, it's not just saying that there's nothing
19 there, it actually has the word, none, that's stored in the database of operating
20 methods, according to vehicle model 134, as the operating method for the
21 function for the vehicle model.

22 If we go to Slide 34, we can see here Dr. Almeroth, he created a
23 figure to show exactly what Hayashi just said, that you could have situations
24 where a particular function, here, looking at the table on the left side,
25 Function 2 has none for that last model in the last column because there isn't
26 compatibility there. And a person of ordinary skill in the art, according to

1 Dr. Almeroth, would have considered it useful to have a database, indicating
2 which vehicles are compatible, or incompatible, with respective
3 functions/operating methods, as in Hayashi.

4 If we go to Slide 35, he further articulates what this would look
5 like and how this would actually be implemented in the Xiao reference.
6 Looking at the left-hand side, the table from Xiao modified to show, just like
7 in Hayashi, an example of a particular command that just does not exist. So,
8 the command idea is something that's coming from the profile settings, and
9 there is no corresponding command code for it.

10 For example, this is according to Dr. Almeroth at paragraph 196,
11 there may be an automobile having an automobile ID 628 for which a certain
12 command ID 630 has no corresponding command code 632. It would have
13 been an obvious and straight-forward modification of Xiao to use indicators
14 such as none; for example, for commands having no corresponding
15 command code on a vehicle based on Hayashi. That's one -- one would have
16 looked at Hayashi and found an example of how a server may determine
17 compatibility, the only accommodation that would meet Claim 10.

18 And if there's no further questions on that, I will go to Slide 10.
19 So, Your Honors, I want to now turn to the sequential order of steps that
20 Patent Owner argues Claim 10 requires. And just so that we're all on the
21 same page, because I haven't talked about 10[a] before in detail, I just want
22 to remind Your Honors what the mapping was in the petition. We said that
23 we would receive out-of-server information for -- sorry, was there a
24 question? Okay, I guess not.

25 So, we can see on Figure 11 on Slide 10 that there is a request
26 received, that's the request from mobile device 110 or a terminal device 122.

1 For example, that request could be to customize the settings of one or more
2 systems of the automobile 112 based on operator profile, so that would be
3 receiving at a server information or a user profile of the user.

4 And as we discussed before, the user profile defines one or more
5 settings that are preferred to be set in vehicles if the vehicles support such
6 settings. We went through this before, like the radio settings, and the HVAC
7 settings, and things like that.

8 And then very quickly, on Slide 11, just as a reminder again for
9 10[b], what we're pointing to is the identification that happens when you
10 change the automobile, what's shown in Figure 9 there on the left-hand side.

11 So, now if we go to Slide 38, we can see here steps 10[a] through
12 10[c], that Patent Owner takes the view where it'd have to be in this very
13 specific order here. They can't be in a different order. And it's really 10[a]
14 and 10[b] that matter. I don't think there's a dispute between the parties
15 about 10[b] and 10[c] in their relative positioning.

16 What Patent Owner points to here is, they say, well, it has to be
17 that 10[a] has to come first because the user profile comes up in 10[a] and
18 that means because of the antecedent basis 10[b] necessarily has to be what's
19 coming first. But that's not how the law works, if we're looking at whether
20 steps need to be performed in order or not.

21 If we go to Slide 39, we can see the claim that was at issue in the
22 *Interactive Gift* case from the Federal Circuit, a precedential case. And what
23 the Court said there was that, unless the steps of a method actually recite an
24 order, the steps are not ordinarily construed to require one. And with respect
25 to the steps being considered, the Court said, that looking at the claim
26 language, there is no reason why step one's providing -- we can see that as

1 first step on the slide, of information to the IMM must occur before step
2 four's receiving the request reproduction code. Step 4 is shown at the
3 bottom of the slide. Logically, information could be sent after a request is
4 made.

5 And the Federal Circuit found this despite the fact, that you can see
6 'a' catalog code in the first step and 'the' catalog in the fourth step. So, it's
7 got that same antecedent basis, like the profile in 10[a] and 10[b], but that
8 did not mean that the fourth step had to come after the first step. Instead,
9 according to the Court, there's no reason that the fourth step had to come
10 after the first step; instead, the order could be different.

11 And if we go to Slide 40, we can see the claims of *Interactive Gift*
12 on the right compared to the claims that we're dealing with in the '268 Patent
13 on the left showing, that 'a' catalog code, 'the' catalog code, it didn't matter in
14 *Interactive Gift*, and similarly, it doesn't matter in the '268 Patent. The word
15 'information' on the left-hand side, receiving at a server information, I just
16 want to note, that actually doesn't show up in 10[b]. So, the step that's
17 actually being done in 10[a], it is irrelevant to what's happening in 10[b].

18 If we go to Slide 41, *Altiris*, another Federal Circuit case
19 recognizing the same situation, we have a first step that requires testing,
20 we've got a fifth step that requires setting said selection flag, and then we've
21 got a final step that boots normally, if said testing does certain things. And
22 the Court said, that in the case before us, nothing in the intrinsic evidence
23 indicates that the setting step must be performed before the booting normally
24 step. Meaning what the claim language, it neither grammatically nor
25 logically indicates that the settings that must occur in a particular order
26 compared to the other steps. The only order mandated by the claim

1 language is the conditional language in several of the steps, indicating that
2 they must be performed after the testing step. So, if you're going to be
3 dealing with the testing, you have to be after the testing happens. But if
4 you're doing something, like setting boot selection flag that's not tied to the
5 testing, there's no reason that that has to be happening in any particular
6 order.

7 If we go to Slide 43, I want to talk about an embodiment from the
8 specification that the Patent Owner actually brought up when discussing
9 these very limitations with the District Court at the claim construction
10 hearing.

11 The Patent Owner told the District Court that we disagree that the
12 server is required to identify the selected vehicle. There's multiple things
13 that identify the selected vehicle. So, this is talking about that identification,
14 not just that it doesn't need to be in a particular order, but it doesn't even
15 have to be done by the server, the same thing that's doing step 10[a] and step
16 10[c].

17 Patent Owner goes on to recite the specific example from the
18 specification. So, Bob's device is identifying the selected vehicle, in
19 addition to Bob himself, who is identifying the selected vehicle. And, of
20 course, the server identifies the selected vehicle as well.

21 If we go to the next slide, Slide 44. If you go to the Bob example
22 from the '268 Patent, you'll see on the right side, this is the portion of the
23 example that corresponds to what the Patent Owner was talking about when
24 they were talking to the District Court. You can see at the top, in green, the
25 identification happening. The pairing request can include sending the model
26 of the vehicle 200, that may have been obtained by the user's mobile device

1 from the vehicle 200 directly. So, you've got identification, and then, lower
2 down, then you communicate with a mapping engine 118 that determines the
3 information associated with car 200.

4 And then, going further down, the mapping engine ultimately
5 allows integration of Bob's user profile, from the user profile's database 160,
6 so that Bob's profile can be sent to car 200. So, this example, from the
7 specification, actually shows doing the identifying before doing the
8 receiving.

9 Now, what Patent Owner has said is that the left side of the slide
10 here, these are the specific column and line numbers that they pointed to.
11 They said, well, there's actually a receiving that happens in the left side of
12 this slide. And the receiving that they pointed to is they said, supposedly,
13 that the user, they log in, and the user login is discussed right here, column
14 16, line 34 to 66, the user login happens before that identification, and that
15 solves their problem.

16 So, first of all, I'll invite, Your Honors, read this very carefully, go
17 back and look at it after the hearing, nothing in this column at lines 34 to 66
18 is talking about a user login. But even if it was, if you look at Slide 46, this
19 is Xiao's disclosure. And what does Xiao actually disclose? It discloses the
20 operator may log in to page 900, and then mobile device 110 can transmit
21 the authentication information, it can go down the path of doing all the
22 settings, types of things that we talked about before.

23 So, even if Patent Owner was right, that there is an example in
24 their specification where the receiving is just the user logging in, and that
25 happens before the identification, Xiao discloses that exact thing. So, the
26 claims they don't require the Patent Owner says they do, but even Patent

1 Owner's own example of the way that they say the claim works, is disclosed
2 by Xiao.

3 If we go to Slide 54, I want to talk briefly about the sub-user
4 accounts in Xiao for Claims 17 to 19. We can see here in 17 and 19, the
5 sub-user accounts, they come in various different ways, several times
6 throughout these different claims.

7 If we go to Slide 56, one of the arguments that Patent Owner
8 makes is that there is no administrator account in Xiao. We disagree with
9 that. We can see here on Slide 56, that an operator of automobile of 112
10 may register for the disclosed wireless automobile key service with
11 automobile service system 104 and create an account for one or more mobile
12 devices 110 or automobile operators. That, right there, is acting as an
13 administrator. So, I don't think that holds up.

14 If we go to Slide 58, there's also a dispute between the parties
15 about whether Xiao discloses that the different sub-user accounts can have
16 the same or varying privileges. If we look on the left-hand side, paragraph
17 76 of Xiao, in a family account, the father and mother may have permission
18 to operate every automobile 112 on the account. Whereas a child may only
19 have permission to operate the child's automobile 112 or the family
20 automobile. So, the child has different privileges than the mother and father,
21 and the mother and father have the same privileges as each other.

22 Dr. Almeroth, in paragraph 171 on the right, thus, some sub-users,
23 for example, a father and mother, have the same privileges, and some sub-
24 users, for example, children, have varying privileges where settings may be
25 disabled.

26 JUDGE BRADEN: Counsel?

1 MR. GOLDBERG: Yes.

2 JUDGE BRADEN: I hate to stop you right there, but can we just
3 put a pin in that for one moment? I believe Judge Ippolito needs to be put
4 back in the hearing. I think she froze. Just give us one moment.

5 MR. GOLDBERG: Thank you for pointing it out. I definitely
6 don't want to be talking with her not on.

7 JUDGE BRADEN: Absolutely. Counsel, we apologize for this
8 disruption. IT is working to get Judge Ippolito back, so just give us one
9 more moment.

10 MR. GOLDBERG: Thank you.

11 (Whereupon, the above-entitled matter went off the record at 1:39
12 p.m. and resumed at 1:42 p.m.)

13 JUDGE IPPOLITO: I apologize for that. I was kicked out of the
14 WebEx and I could not get back in. But I am back now. So, I would say
15 that we -- we had the discussion in the transcript, and we have about 10
16 minutes, or 11 minutes left, I think, of the Petitioner's time so we can
17 continue on, and I will let Petitioner continue on. Sorry about that. I'm not
18 sure what happened.

19 MR. GOLDBERG: Okay. No problem, Your Honor. Thank you
20 to the others for letting us know so that we could make sure that you hear
21 whatever I say.

22 So, I'd like to -- I guess I'll turn to Slide 59. And I want to just
23 look at the disclosures between the '268 Patent and Xiao. They're actually
24 very similar. We just went through the different family members having the
25 different types of access. And in the '268 Patent on the left side, Slide 59,
26 we have here, allowing a family member to have access to the family

1 vehicle, for instance in this case, family User 2 is shown. And the
2 administrator has given this family member a login named User 2 and has
3 granted two roles to User 2. User 1 may not want User 2 to have access to
4 certain vehicle -- sorry, and they only want User 2 to have access to certain
5 vehicle and certain roles only. So, it's the same situation in Xiao in
6 paragraph 76, where they're specifying that the child only gets access to a
7 certain vehicle as opposed to all of the family's vehicles.

8 If we go to Slide 60. Again, Xiao is disclosing the same
9 privileges/user accounts. And one of the things that Xiao is also disclosing
10 is that certain operators, they have access to view health information
11 associated with the vehicle as required in the claims. And it's only certain,
12 let's say, of the operators, because some of the operators, like the children,
13 they are not operators for all the vehicles, so therefore they would not have
14 access to this health information. But, at least one, the mother and father as
15 an example, would have access.

16 And as we can see in Slide 61, testimony from Dr. Almeroth. He's
17 clear, that in such embodiments only some users, i.e., particular sub-user
18 accounts have access to view health information associated with the selected
19 profile.

20 If we go down to Slide 62, I'll address the combination of Xiao and
21 Patenaude for Claim Element 12[c].

22 If we go to Slide 65, it's relevant limitations sending the learned
23 settings to the user profile for use of transfer to the selected vehicle. And we
24 can see that claim element mapped out on the left side. You've got the
25 learned setting, going to user profile, and going to the vehicle. On the right-
26 hand side, we can see the Patenaude -- the figure there that we pointed to in

1 the petition and throughout. The same learned setting, it's determined a
2 user-specific pattern for the specific user in red, generates a user-specific
3 entertainment selection profile based on the determined user-specific pattern.
4 So, the pattern, the learned setting, is being sent to the user profile. And
5 then, finally, it is making its way to the vehicle to be used there. We see at
6 the bottom, retrieve the user-specific entertainment selection profile from a
7 memory in the telematics unit responsive to the determined power-up input.

8 So, again, this is just another proof at the end here, that it's
9 retrieving the profile that has that particular pattern in it. That means it must
10 have been -- the learned setting, the pattern, must have been put into the
11 profile. So, I think it's pretty clear, based on this, that this claim element is
12 met.

13 If we go to Slide 70, and finally, the combination of Xiao and
14 Patenaude for Claim Element 20[b]. If we go to Slide 74, here's the Patent
15 Owner's arguments against this particular claim element. They say that the
16 petition fails to identify any disclosure from Xiao to meet the recited
17 limitation of communication by the vehicle, changes to user settings as
18 required by Element 20[b]. They talk a lot about a typo. I'm not sure why
19 or how that matters, and I'll show you why in a second. They also point to,
20 supposedly a newfound reliance on Patenaude, but that doesn't exist.

21 If we go to their next slide, Slide 75, this is a screenshot of the
22 petition, we can see at the bottom there, pointing to Patenaude, so there's no
23 new reliance that's showing up for that. At the top, specifically saying, that
24 Xiao discloses communicating the cloud processing system, for example,
25 wireless automobile key system 100 by the vehicle, for example, automobile
26 112 changes to user settings, for example, profile information 614.

1 And if we go to the very next slide, Slide 76, the relevant
2 paragraph from Xiao, in some embodiments, the operator may set operator
3 profile information 614 from automobile 112. Automobile 112 may
4 communicate the settings over cellular network 114 to server 118, which
5 may update the stored operator profile information 614 for the operator. So,
6 a clear disclosure of the movement from the vehicle right here.

7 And unless Your Honors have any questions, I'll reserve the
8 remainder of my time.

9 JUDGE IPPOLITO: No questions for me. It doesn't seem like my
10 panel members-- so, since I had technical difficulties, I want to say that I
11 think you have about five, six minutes left. I don't know what you have on
12 your side, but.

13 MR. GOLDBERG: Five to six in the 45, meaning --

14 JUDGE IPPOLITO: Yes.

15 MR. GOLDBERG: Yeah.

16 JUDGE IPPOLITO: I'll give you six to add to your rebuttal time
17 so you'll have a total of 21.

18 MR. GOLDBERG: Thank you.

19 JUDGE IPPOLITO: All right. And Patent Owner, when you're
20 ready, you can begin, and let me know if you'd like to reserve time for sur-
21 rebuttal.

22 MS. ENTZMINGER: Yes, Your Honor, we'd like to reserve 15
23 minutes for sur-rebuttal, please.

24 JUDGE IPPOLITO: All right, thank you.

25 MS. ENTZMINGER: I'd like to share Patent Owner's
26 demonstratives Exhibit 2021. And also, Your Honors, when I introduced

1 myself earlier, I neglected to introduce my co-counsel, Jerry Tice. Lead
2 Counsel for Patent Owner is also on counsel line. And on the public line is
3 the inventor and client representative for Emerging Automotive.

4 So, Your Honors, I'd like to get started and just jump ahead to
5 Slide 7 of Patent Owner's demonstratives. Because I think with the
6 questions from Your Honors, we focused in on the key failures of the
7 petition for all grounds.

8 Now, while Petitioner relies on Xiao's primary reference, it's only
9 seeking to cure 10[c] and 20[a] by way of Hayashi, this compatibility check.
10 But what has become clear is -- sorry, turning to Slide 5, what has become
11 clear is that -- and this is showing Claims 10[c] and 20[a].

12 What is clear from the questions by Your Honors, is specifically
13 that the claim language itself shows this compatibility check is required.
14 And while, of course, there's no dispute now that the District Court adopted
15 that claim construction for these particular independent claims, what is
16 important, and I think what was hit upon by Your Honors' questioning is,
17 that regardless of that claim construction, the plain language of the claims
18 requires a compatibility determination, and it's a specific kind of
19 compatibility determination. So, if we look here at the top of Slide 5, Claim
20 10[c], the server must determine applicable settings for the selected vehicle.
21 But this isn't a generic term, applicable settings.

22 As was hit upon by Judge Braden's question, the applicable
23 settings must be expressly defined as settings that are preferred to be set, as
24 identified from the user profile, and are compatible with settings that are
25 settable in the selected vehicle. And, likewise, as Petitioner concedes, 20[a]
26 requires that very compatibility determination. They concede that that is, in

1 fact, done actively in 20[a]. But whether it active or passive, that's
2 irrelevant. The server must determine these applicable settings because it's
3 looking at two groups of settings to determine compatibility. And while
4 Petitioner focused on what, at most, from Xiao is one set of settings, what is
5 settable on the vehicle, and then they just happen to be compatible? Well,
6 that's not what the claims require by the express language.

7 Looking at Slide 6, what the claims require by the express
8 language, is that the server is determining applicable settings, and those must
9 be determined from two express groups of settings. And I've color-coded
10 them here in this slide to show, that one group of settings is coming from
11 Element 10[a], the settings identified from the user profile, and another
12 group of settings come from Element 10[b], the settable settings of the
13 selected vehicle. The server is going to determine which, among those two
14 groups of settings, are compatible with one another, and it is that
15 determination that will provide the, quote, "applicable settings." And those
16 applicable settings are what are going to be transferred to the vehicle for
17 programming.

18 And this is why -- so, just turning back to -- talking about the
19 actual innovation of the patent itself, this is what is critical as to why the
20 '268 Patent invention is an advance over prior art, like Xiao. In the prior art,
21 like Xiao, I had to add every setting separately car by car. And those preset
22 settings for that car can in turn be applied only to that car.

23 But with the inventions of the '268 Patent, I no longer have to do
24 that. I no longer have to set system preferences car by car and ultimately
25 have them set according to that car. I can set my user profile once for
26 vehicles, and whatever car I use, assuming it's compatible, it'll be set in that

1 car. And that's the transformative aspect of the '268 Patent. It allows user
2 profile transferability among vehicles, across vehicle, and that is what Xiao
3 --

4 JUDGE BRADEN: But, Counsel, how do you address Petitioner's
5 arguments regarding paragraphs 102 and 103 of Xiao, where you have a
6 discussion about Figure 9, where you can, A, change the automobile, where
7 you've got multiple roles in Figures 6 with different, you know, automobile
8 ID 618, where you can put in automobile information, and where it talks
9 about the fact where you could generate one or more commands based on
10 these command codes to control automobile settings to achieve the
11 operator's desired settings. How do you address that?

12 MS. ENTZMINGER: Thank you, Your Honor, that gives me the
13 opportunity to get to the foundational differences between Xiao and patent.
14 So, looking at Patent Owner Slide 22, we had highlighted and provided in
15 great detail the Patent Owner response, each of the disclosures of Xiao,
16 making clear that every setting, every operation is vehicle specific at the
17 outset in Xiao. So looking, for example, at the left side of the slide, these
18 are paragraphs 69 through 72, examples of system preferences from Xiao.

19 And what Xiao is making clear is, that the operator profile
20 information 614, so, for example, climate control system preferences, those
21 have to be set for the operator for each automobile 112 on the account.
22 That's the same for audio system preferences, they need to be set for the
23 operator for each automobile on the account. Same goes for operator
24 comfort preference, they need to be for each automobile on the account.
25 Same for operator awareness system preferences.

26 And what is clear here, is that Xiao's system is static and vehicle

1 specific from the get-go, which referring back to the app that Your Honor
2 brought up, so this is Slide 23. So, if you look to, first the left of this slide,
3 Xiao is making clear at paragraph 77, and others we cited in the response,
4 that every operator is going to have a default automobile ID associated with
5 them on the account, and that's going to identify a default automobile for
6 which to provide the disclosed service. And how that service is provided is
7 on the right, in this app, depicted in Figure 9 of Xiao.

8 But what is important first to look at is -- as we saw earlier in Slide
9 22, the operator profile information has system preferences stored for every
10 operator for each automobile on the account. So, if we look at this part of
11 -- on the left-hand side of 23 of Figure 6, you have the table from Xiao
12 indicating the operator ID, the corresponding profile information, and the
13 corresponding default automobile ID to which those system preferences
14 correspond in the profile information column.

15 And if we look to the right, back to Your Honor's question about
16 this particular app utilized by Xiao. Xiao makes clear that it's already
17 selecting, before you can even utilize any feature on this app, including the
18 command requests brought up by your question, it's first selecting a default
19 automobile to which to apply the service, that's paragraph 77. And here,
20 depicted in Figure 9, this is the Mazda 6 of this particular operator. All of
21 these command requests listed on the app are going to be login to change
22 automobile (INDISCERNIBLE), but all of the command requests are
23 specific to this automobile that's already been selected for the operator, and
24 that goes for the applied operator profile settings that Petitioner relies on for
25 the alleged disclosure in the claims.

26 And what's important to note is that every command request issued

1 already has the automobile ID and the command ID for that particular
2 command that can be issued. So, any command request is already going to
3 be specific to the vehicle that is already identified on the app before any
4 command request can be issued. And what -- because Petitioner brought up
5 in reply, this point that Your Honor brings up about the change of
6 automobile, we made clear in the sur-reply, that when Xiao shows explicitly
7 -- when the operator chooses the change automobile user interface elements,
8 924, then this entire screen changes, they have a selection of whatever other
9 automobile may be on the account, registered to the account, so, Nissan 2,
10 they can select the Nissan 2, and then this page is going to repopulate
11 command requests specific to that Nissan 2. To every command request
12 available on the app is going to be specific to the automobile registered on
13 the account, even when -- and this is expressed in Xiao, when the change
14 automobile element is selected, the operator actually has to manually select
15 which automobile they want, then wait for the app to pull up those
16 respective command requests, and then issue a vehicle-specific command
17 request for that automobile.

18 JUDGE IPPOLITO: Counsel, can I stop you there for another
19 question?

20 MS. ENTZMINGER: Sure.

21 JUDGE IPPOLITO: But first let me make sure that I don't jump in
22 front of Judge Braden's question and make sure she doesn't have a follow-up
23 for her question that you're answering.

24 JUDGE BRADEN: I may later, but I suspect you may be going in
25 the same direction, so please proceed.

26 JUDGE IPPOLITO: Okay, thank you. So, you talked a lot about

1 the distinctions between vehicle specific operations, I think you're saying
2 Xiao does, versus what you say the claims cover that's different. Help me
3 understand, what in your claim is making that distinction in the claim
4 language itself? Because when I read this 10[c] limitation, I don't see a
5 distinction between a compatibility setting for something that might be a
6 vehicle-specific scenario versus something that's not. For example, in 10[b],
7 you identify a vehicle, okay, so we have a default automobile, that one is
8 going to have some sort of settings, and we've got a user profile of some sort
9 here, and then we're going to determine the applicable settings. In that
10 scenario, it seems that even if you have a vehicle-specific system, you're
11 going to have compatibility that's determined at some point for that vehicle
12 that's been selected. So, can you explain to me what the distinction is?

13 MS. ENTZMINGER: Yes, Your Honor. Actually, I think, turning
14 to Petitioner's demonstratives at 21, this might be helpful, because it actually
15 has the claim language of Claim 10 in its entirety, and I can address Your
16 Honor's question better with the slide.

17 So, first, 10[a] is requiring receiving at a server information for a
18 user profile of a user. But what is important, is that the user profile is
19 expressly defined in 10[a]. And what is different is that it is expressly
20 defining one or more settings that are preferred to be set in vehicles if the
21 vehicles support the settings, that's vehicles plural.

22 That means, I need only create the profile once, any settings, and at
23 some point in time, whether it my friend's vehicle, a shared vehicle that is
24 going to be identified from a plurality of vehicles, for applying the user
25 profile, I can make sure that my user profile settings are going to be applied
26 to that selected vehicle because the server will have determined applicable

1 settings for that vehicle. It will have determined that those applicable
2 settings are compatible, they are, as between 10[a], my user profile settings
3 preferred to be set in vehicles, compatible with settable settings that are
4 settable in the selected vehicles. But only those applicable settings
5 determined in 10[c] will be sent by the server for programming in the
6 selected vehicle.

7 There is, necessarily, if I could turn back to Patent Owner's Slide 6,
8 there is necessarily a compatibility determination between two groups of
9 settings from the user profile, settings preferred to be set in vehicles, plural,
10 and the selected vehicle for which I want my user profile applied, and that
11 vehicle must have settable settings. So, those two groups of settings, there
12 must be an intersection between them in which the settings are compatible
13 for programming, and --

14 JUDGE IPPOLITO: Counsel, let me ask you. I think you
15 mentioned earlier that in Xiao, we were talking about the change the
16 automobile option, I think it was Figure 9, or I don't know what slide it was
17 on. But my understanding is then, that a user can use more than one
18 automobile. And so, there's a choice between which vehicle is being
19 selected. Now, that selection might come -- you were saying, I think, at a
20 different point in time than what you might think isn't claimed, but let's put
21 that aside. I think Xiao teaches that you can have multiple vehicles -- that a
22 user can use more than one; would you agree with that?

23 MS. ENTZMINGER: Absolutely, Your Honor. And if we look
24 back for a moment at Patent Owner's Slide 22, the key distinction is, yes, the
25 operator can register multiple vehicles on an account. Those have to be
26 known and registered. But for what Xiao makes clear is that the profile

1 information -- so this is what Petitioner's point to as the user profile, the
2 profile information contains every single kind of system preference. So,
3 paragraph 69, climate-controlled preference, 70, audio system preference,
4 71, comfort system preferences, every single one of my operator system
5 preferences are specific for each automobile on the account, that means
6 they're always vehicle specific from the get-go.

7 As by contrast, my user profile for the '268 Patent, generically, I
8 can change one or more settings preferred to be set in vehicles. I don't have
9 to know what they are in advance. I don't have to register them. At some
10 later point in time, I can have my user profile applied to any vehicle that is
11 going to ask the compatibility check of 10[c].

12 JUDGE IPPOLITO: Understood. Let me go back to the vehicle-
13 specific argument that you were making. So, would you agree then, that for
14 a specific vehicle, the user profile, or the user account, or the user operator
15 profile information in Xiao then has information that is going to be
16 compatible with that vehicle?

17 MS. ENTZMINGER: Well, actually, Your Honor brings up an
18 important point. I think that in Patent Owner's Slide 25, when we have the
19 automobile ID and the command ID already in every single command
20 request that is issued in Xiao, the server -- and this was brought up in
21 Petitioner's argument, the server is pulling an appropriate command code,
22 but that command code is always going to correspond -- this is Xiao, Figure
23 6, it's always going to correspond to that automobile, that automobile ID that
24 is already in the command request. And therefore, Xiao actually has no need
25 for any compatibility check, because every single command that Xiao's
26 server issues, when it does a look up function and the generate command

1 function of Figure 11, those are going to always be specific to/constrained to
2 the already preset vehicle-specific preferences for that car.

3 So, at most, we're -- so, if we go back to Patent Owner's Slide 6, at
4 most, Xiao is showing that it has settable settings of the selected vehicle.
5 They're always going to be settable in Xiao. There is no disclosure of any
6 operation where a server tries to come up with a command code and doesn't
7 find one. I heard that during Petitioner's argument, but there is no such
8 disclosure in that regard.

9 But I think that that bring -- Your Honor's question bring up a key
10 flaw here. Not only is Xiao always specific to a vehicle, the system
11 references are preset and specific to that vehicle, but also every operation is
12 going to be vehicle specific and can only apply the preferences that were
13 preset for that vehicle.

14 And we know that because as I went over the default automobile
15 ID 617, that's going to tell page 900 what automobile it can provide service
16 to. So, when you issue a command request, it already has a default
17 automobile selected, that Mazda 6. And as Your Honor indicated, you can
18 select the UI element to change the automobile to Nissan 2, or whatever that
19 may be on the account, but then it's going to pull up specific command
20 requests for that automobile. And we know that Xiao stores the operator ID
21 along with a default automobile ID, and that the profile information includes
22 system preferences according to each automobile on the account, so that
23 when the server looks up a particular command code, it does show based on
24 the automobile ID and the command ID already contained in the command
25 request.

26 So, as was brought up during Petitioner's argument, they just

1 happened to be appropriate -- they happened to be corresponding because
2 there is no other option. There is no option for the server to look up a
3 command code for any other vehicle. And indeed, you've --

4 JUDGE BRADEN: So, Counsel?

5 MS. ENTZMINGER: Yes.

6 JUDGE BRADEN: Explain something to me. I feel like I'm
7 maybe a bit confused here. Because I'm trying -- I'm looking at the
8 application that's shown in Figure 9. You've got 922, which is apply
9 operator profile settings, and you've got 924, which is change automobile. Yet,
10 when you first pulled it up, you've got 916, which is identifying automobile
11 Mazda 6. What I'd like to know is, why 924, change automobile, isn't the
12 same as 10[b], where you're identifying a selected vehicle, and then you've
13 got applying the operator profile settings, which is applying the user profile
14 in 10[b]. I'm not sure I understand why, when you say in 10[a], you've got
15 these preferred to be set in vehicles, these user profiles, doesn't that just
16 mean that you could apply those in multiple vehicles? It's not only set in
17 one specific vehicle, and that's why your claims allow you to select
18 vehicles?

19 MS. ENTZMINGER: Well, I appreciate the question, Your
20 Honor. I think, if I can go back a step, when the operator has this app in
21 front of him -- so, I'm at Patent Owner's Slide 23, depicting Figure 9 of Xiao,
22 so the automobile for which to provide the wireless key service, this is
23 paragraph 77 at the left, that's already depicted on the app, and we see that
24 here in Xiao, in Figure 9, here, it's the Mazda 6.

25 When I apply start automobile, or apply -- apply operator profile
26 settings/commands, those commands are going to be specific to that

1 automobile, the Mazda 6 because, as I highlighted here in the middle, every
2 command request Xiao teaches, already has in it the automobile ID and the
3 command ID for the command that can be issued to that automobile. If I
4 were to select change automobile 924, Xiao teaches that, although it's not
5 pictured, then you have a selection menu, and you can select among the
6 options for a different vehicle. You select your new vehicle and that new
7 automobile, Xiao teaches, will be pulled up here in exactly the same fashion
8 as we see in Figure 9. So, instead of saying, automobile Mazda 6, if you had
9 selected Nissan 2, it would say Nissan 2, then you could hit start automobile,
10 you could hit apply operator profile settings on the app, and those command
11 requests, Xiao teaches, are going to be specific to that new automobile
12 because they too will contain the automobile ID and command ID for the
13 command that can be issued to that automobile.

14 And this was -- also, there are different -- there's more detail to the
15 disclosures of Xiao of what happens when you select a new automobile. But
16 what is clear -- and we made that clear in the sur-reply. But what is not in
17 dispute is every single command request issued by this app, by the disclosed
18 service of Xiao is necessarily vehicle specific. So, you could never have the
19 -- what is enabled by the '268 Patent, which is, I have a user profile of one or
20 more settings to be set in vehicles, and to have that user profile applied to
21 any vehicle after it passes this compatibility check. Or, in another way, after
22 --

23 JUDGE BRADEN: So, does your argument hinge on us finding
24 that there is a requirement in the timing of the steps that 10[a] must come
25 before 10[b]?

26 MS. ENTZMINGER: No, Your Honor. If I may, for -- so, for the

1 -- sorry, if you turn to Slide 31. So, one argument as to why all grounds fail,
2 is that Xiao fails to -- well, all grounds on which Claim 10 is challenged, is
3 that Xiao fails to disclose the requisite order of Elements 10[a], 10[b], and
4 10[c]. And critically, for the petition, it's the order of 10[a] and 10[b] that
5 matter for that particular argument. Those are the two that are not arranged,
6 as claimed, in the petition. The disclosures relied upon are not arranged as
7 claims. But that is just one argument one. That is just one basis for the
8 failure of Grounds 1, 2, 3[a], 3[b], 4[a], and 4[b].

9 But in addition, as we made clear in the response, for example, and
10 with some of the background provided today, the user profile of Claim
11 Element 10[a] is required in the operations of 10[b] and 10[c]. It's not near
12 antecedent basis. Knowing that user profile is a requirement for those
13 operations, and Xiao's failure to disclose the user profile as defined by the
14 claim -- expressly defined by 10[a], and required by 10[b] and 10[c], means
15 that all of those grounds fail, 1 through 4[b], all fail by that failure to
16 disclose the required the user profile, so.

17 JUDGE IPPOLITO: Counsel, let me stop you there for a second
18 and ask. So, for 10[a], the user profile, defining one or more settings that are
19 preferred to be set in vehicles if the vehicles support the settings. Okay, we
20 just talked about how Xiao -- even if we say it's vehicle specific, Xiao
21 teaches multiple vehicles associated with the operator profile information,
22 and so there are multiple vehicles, if we're going to say vehicles, and the
23 user profile there has settings that are preferred for multiple vehicles.
24 Explain to me if I'm reading that incorrectly?

25 MS. ENTZMINGER: Well, respectfully, yes, Your Honor. What
26 Xiao is disclosing -- so, back to Slide 22, every single setting is by vehicle.

1 So, whereas the '268 Patent, so, looking at 10[a] requires the user profile
2 defining one or more settings preferred to be set in vehicles, that means one
3 to many, or two to many, et cetera, Xiao is only ever going to be one to one
4 or many to one.

5 And that's what's critical. That distinction is not just ancillary but
6 critical to the subsequent steps, the subsequent operations of the method
7 claim, what is allowing and what is the advance over this prior art, like Xiao.
8 I can set -- with the '268 Patent, I can set a user profile with any settings, and
9 then I can show up at a friend's house. I can try to use a shared vehicle.
10 And once that vehicle, for applying my user profile is selected, with the
11 compatibility check of 10[c], with the determining of applicable settings, it's
12 performing this compatibility determination between my group of settings
13 for vehicles, plural, and any vehicle that I choose to have the user profile
14 applied to.

15 So, I think that your question brings up a critical distinction
16 between the '268 Patent 10[a], one to many vehicles -- one setting to many
17 vehicles versus Xiao being, every single setting has to be vehicle specific.
18 There is no setting that can be set in vehicles, plural. If I want climate-
19 control settings at 65 degrees, I have to go through every single vehicle on
20 my account, my Mazda 6, my Nissan 2, and set that setting per vehicle. And
21 then, when I want those particular settings set in those vehicles, in Xiao, it's
22 merely going to look up the corresponding command code for my specific
23 setting of 65 degrees for that Mazda 6 or for that Nissan 2.

24 And I think, actually, this issue gets us to why Hayashi relied upon
25 for an alleged compatibility determination still fails, because Xiao is already
26 constrained to be vehicle specific from the get-go, so.

1 JUDGE REPKO: Before you move on, I just have a quick
2 question about the term compatibility. Just generally, they're saying that
3 compatibility, according to your papers can say, it can be this mapping. The
4 mapping is an example of a compatibility check, generally. But I think what
5 you're arguing is, it doesn't turn on the word compatibility, it's broader, it's
6 about a specific type of compatibility check that's recited in the claim. Is
7 that correct? Does this not turn on the term compatibility?

8 MS. ENTZMINGER: I think that's exactly right, Your Honor. If I
9 can turn back to Petitioner's Slide 21, I'm looking at 10[c]. We obviously
10 disagree with Petitioner. 10[c] does require this compatibility check, and
11 I'm happy to go through the prosecution history, the specification, the
12 District Court's adoption of that construction as to why that construction
13 should be adopted. But more to the point of Your Honor's question, whether
14 or not that construction is adopted by the Board, 10[c] is requiring a
15 compatibility determination that is very specific and requires a determination
16 of applicable settings that is a specifically defined term. Not something
17 incidental that happens to be applicable. Applicable settings have to be this
18 equation. It has to be both, preferred to be set, as identified from the user
19 profile, that's 10[a], and compatible with settings that are settable in the
20 selected vehicle, that's 10[b]. Only the server conducting this compatibility
21 determination, that is determining applicable settings, is going to get the
22 required applicable settings of 10[d] programmed to the selected vehicle.

23 So, absolutely, the compatibility determination of 10[c] is
24 expressed in the language itself. And Patent Owner -- the Applicant was
25 clear, in the prosecution history, that the compatibility check was not only a
26 requirement of the claims, but that's actually what was used to traverse a 102

1 rejection, the Hendrix rejection in -- if I could turn to --

2 JUDGE REPKO: Great. And then so, just quickly, Claim 14
3 though, focusing on that, is that a type of compatibility determination?
4 Because it says in Claim 14, determining the applicable settings, and then,
5 there's been a mapping. Is that, like, another type of determination, or is that
6 specifically a determination of compatibility?

7 MS. ENTZMINGER: So, specifically Claim 14, Your Honor, is a
8 determining of applicable settings that is specific. That specific claim
9 requires a mapping engine, and the mapping engine to perform a certain kind
10 of mapping. But to Your Honor's question, that is just an example of one
11 way the compatibility determination can be performed. Also, the
12 specification makes clear that the server identifying components that can
13 allow integration; for example, identifying APIs, identifying apps that allow
14 integration, that can be determining applicable settings. That can be
15 determining compatibility. And, effectively, it's going to be determining
16 -- if I could turn to --

17 JUDGE REPKO: So, I mean, I think that in one way, you can read
18 this as saying, determining applicable settings in Claim 10, and then you
19 have these definitions about what the applicable settings are -- they're
20 identified from user profile, compatible, and you have maybe another
21 condition on them, and that's the mapping. That's another characteristic of
22 the applicable settings, performing some sort of mapping and making sure
23 the mapping.

24 But I guess what you're saying is, that it actually narrows what a
25 compatibility check is, in a way. You're not saying, is it something else
26 separate from the compatibility check, you're saying, this just sort of defines

1 the compatibility check; is that correct, 14 further narrows the compatibility?

2 MS. ENTZMINGER: That's right, Your Honor. Claim 14 is a
3 narrower type -- that is one specific type of compatibility determination
4 required by that claim, that's exactly right.

5 JUDGE REPKO: Okay. And so then, in Figure 8, for example,
6 they have sort of vehicle-specific mappings, right? This is like a car
7 database and car IDs and stuff? Is that the mapping we're talking about here
8 in 14?

9 MS. ENTZMINGER: Let me pull up Figure 8. So, I think, Your
10 Honor, the example that 14 is referring to is Figure 7.

11 JUDGE REPKO: But can't -- there's no mapping engine in Figure
12 8 depicted exclusively, but I do wonder, is this proximity logic -- it looks
13 like there's some -- it looks -- whether it's closer, or whatever, but there is
14 some -- there are IDs associated with specific vehicles here, right? There's a
15 car ID. Is there some mapping going on here, or you don't think Figure 8,
16 for example, falls within the scope of Claim 14 or Claim 1?

17 MS. ENTZMINGER: Your Honor, specifically, we had pointed to
18 Figure 7, and the specification description of Figure 7 for Claim 14 because
19 that claim does require a mapping engine. There not being a description of a
20 mapping engine in Figure 8, I wouldn't be able to say, yes, it includes this.

21 JUDGE REPKO: Is there compatibility checking in Figure 8? Is
22 that sort of excluded from the scope because there's no compatibility check
23 with Figure 8?

24 MS. ENTZMINGER: So, we have -- again, we had pointed to
25 Figure 7. I'm happy to review Figure 8 and address Your Honor's specific
26 question on sur-rebuttal. I have -- looking at Figure 7, we had talked about,

1 basically what is in this cloud as an example of a compatibility check. And
2 more specifically --

3 JUDGE REPKO: Understood. The reason I'm asking about
4 Figure 8, I guess -- not to interrupt you, I know you only have a few minutes
5 left here, but it does have these vehicle-specific settings, right? It seems to
6 be one of the points of distinction you're trying to make against the prior art
7 cited. So, I guess -- I mean, if there's a way, can you distinguish this from
8 what's in the claims? If this falls in the scope of the claims, it seems like
9 there's some vehicle-specific stuff going on here, and perhaps a
10 compatibility check?

11 MS. ENTZMINGER: Well, no, Your Honor. The vehicle-specific
12 embodiments that I think Your Honor is pointing to, the vehicle-specific
13 profile embodiments have to do with learned settings, wherein you have a
14 user profile for a vehicle, you have the user making changes to settings,
15 those changes to settings going to a cloud processing system, the processor
16 processing those new changes, learning from them, and then, if they are
17 compatible, those learned behavior settings can be applied to a vehicle.

18 So, if I'm not mistaken, I think what Your Honor might be
19 referring to are embodiments referring to learned behavior, and those
20 settings being applied to vehicles.

21 JUDGE REPKO: Well, I mean, you're trying to distinguish the
22 Xiao system because it has its IDs, and it's looking things up, right? You
23 have a vehicle-specific ID, right?

24 MS. ENTZMINGER: Right.

25 JUDGE REPKO: And he's trying to say, that's not -- we're talking
26 about compatibility checks, correct?

1 MS. ENTZMINGER: Well, Your Honor --

2 JUDGE REPKO: And, so. Right, this vehicle specificity,
3 fundamental flaw, isn't Figure 8, this is the vehicle-specific settings, like,
4 there's a profile for a specific car?

5 MS. ENTZMINGER: Your Honor, I don't believe we had pointed
6 to Figure 8 as being a requirement of, or an example of the compatibility
7 check for Claim 10. And rather, what is being discussed for the fundamental
8 differences between Xiao and the challenged claims are the vehicle
9 specificity of Xiao as contrasted to what is required of the challenged claim
10 in the '268 Patent, which is the user profile requiring one or more settings to
11 be identified, or one or more settings preferred to be set in vehicles, plural.
12 And that's the whole point of why our compatibility check is needed
13 between my one or more settings to be applied in vehicles, plural, and the
14 settable settings in the selected vehicle.

15 So, the challenged Claim 10 and the dependence on which is relies
16 is not speaking to any vehicle specificity, but rather from the outset is
17 making clear that the user profile requires one or more settings preferred to
18 be set in vehicles.

19 JUDGE IPPOLITO: Counsel, I just want to let you know you're at
20 your 45 minutes, and you can go into your sur-rebuttal time if you want. I
21 don't want to stop you from doing that, but just letting you know.

22 MS. ENTZMINGER: Thank you, Your Honor, just briefly, I
23 would like to take a few minutes just to go over quickly, Hayashi, and the
24 critical distinction here. Because Xiao is vehicle specific and constrained to
25 only pull vehicle-specific commands corresponding to those vehicle-specific
26 preferences, Hayashi doesn't make sense, both in terms of any motivation to

1 combine, but also, when modified, doesn't achieve the compatibility check
2 or the determination of compatibility required of 10[c] or 20[a].

3 And, specifically, Hayashi is a reference that is simply comparing
4 functions in a vehicle. So, for example, I've rented a car, and I'm not
5 familiar with where the parking brake might be, and my car at home has a
6 parking brake in a different location, if those locations are different, Hayashi
7 is going to provide me with operating instructions about where to find the
8 parking brake.

9 So, at the outset, combining Hayashi with Xiao doesn't make any
10 sense. Xiao has disclosing ability to set system preferences by vehicle, and
11 when you issue a command on the app for that vehicle, it's going to apply
12 those specific preferences for that Mazda 6. But bringing Hayashi in to tell
13 that user where the parking brake is, is not going to add any value, that every
14 single vehicle in Xiao needs to be registered at the outset and every vehicle
15 is already known. Trying to get operating instructions as to where to
16 manually find the parking brake is of no value.

17 And second, Hayashi is, likewise, irrelevant, because it achieves a
18 nonsensical result. So, I'm referring here to Slide 40. But if we look at Slide
19 41, and specifically the annotated table that Dr. Almeroth prepared, and
20 what Petitioner went over in argument, is by adding none to Xiao's Table 6,
21 this does not achieve the claims required determining applicable settings
22 because it's still going to be specific -- that command code is going to be
23 retrieved according to that particular automobile.

24 So, I if I have Mazda 6 already, I've asked it to apply a specific
25 command request, adding Xiao telling me none for that Mazda 6, now
26 there's no climate preference for the Mazda 6, doesn't get me to the required

1 compatibility check of 10[c]. And I think that what's important is, that's
2 regardless of whether or not a compatibility check construction is adopted by
3 this Board. Because Xiao, and Xiao in combination with Hayashi, still fails
4 to determine applicable settings as shown to the left here. Those applicable
5 settings must be determined to be compatible between two distinct groups of
6 settings, one of which is wholly lacking from Xiao from the get-go.

7 And with that, Your Honors, I'll reserve the remainder of my time
8 for sur-rebuttal. Thank you.

9 JUDGE IPPOLITO: Okay. You've used up about four minutes so
10 you'll have 11 minutes left for sur-rebuttal.

11 MS. ENTZMINGER: Thank you.

12 JUDGE IPPOLITO: Thank you. And if we'd like to keep going,
13 Petitioner, if you're ready, we can do your rebuttal of 21 minutes, or we
14 could take a break, either way.

15 MR. GOLDBERG: Your Honor, I think we can just keep going.

16 JUDGE IPPOLITO: Okay.

17 MR. GOLDBERG: I'll be brief.

18 JUDGE IPPOLITO: All right.

19 MR. GOLDBERG: So, I want to just look for one minute at our
20 Slide 51. And, Your Honors, just very quickly, I want to note that on the
21 right-hand side here, in paragraph 111, it's talking, repeatedly, about what
22 happens when you have a new vehicle that is selected. And this is actually
23 the only paragraph that talks about what happens with new vehicles. So, this
24 is a vehicle that there are no settings yet, and it says that -- may display an
25 automobile selection menu allowing the operator to select a new automobile
26 112, and the operator may be able to perform the various automobile key

1 service with respect to the selected new automobile that's including applying
2 the preferences indicated in the operator profile information 614, the systems
3 of the new automobile 112.

4 So, this is settings that exist, but they're not particular for this
5 vehicle yet, because it's a new vehicle, and they're somehow being set. So,
6 it's not vehicle specific in the way that Patent Owner's counsel keeps saying
7 that it is. Patent Owner's counsel thought that it was really important to
8 them, it seemed like, that both the automobile ID 627, and the command ID
9 630, we can see this in paragraph 103 on the left, that both of those were
10 included in the request. That's the point, those both need to be included in
11 the request, so that then the server can look up the appropriate command
12 code 632 that are doing the very mapping that shows up in Claim 14, and
13 that Patent Owner's counsel again has confirmed, is itself an example of the
14 compatibility check that they say is in Claim 1, and that they say is in Claim
15 20. There would be no reason to be doing this look-up -- this finding of 632
16 if 632 was, itself, stored in the profile. It's not, that's why you have to look it
17 up because the profile itself is not vehicle specific in the way that Patent
18 Owner's Counsel says.

19 And with that, unless there's any questions, I will rest.

20 JUDGE IPPOLITO: Seeing no questions from my panel and
21 having none myself, I will turn it over to Patent Owner. Eleven minutes.

22 MS. ENTZMINGER: Thank you, Your Honor. So, to speak first
23 to that issue, it's not accurate to state that once the -- sorry -- so, Slide 22 of
24 Patent Owner's demonstratives. It's not accurate to state that once the new
25 vehicle is selected, there aren't yet preferences set for that vehicle. Xiao
26 makes very clear, and I encourage the Board to carefully consider Xiao's

1 teachings regarding the profile information 614 storing system preferences
2 for the operator for each automobile on the account. Each automobile on the
3 account must be pre-registered. And paragraph 69 through 72 that we went
4 over, provides that specific teaching, and that in the table they are stored in
5 that manner, so that when a command request is issued to the vehicle, it's
6 necessarily vehicle specific.

7 I'd also just like to point out for Claim 20, so Petitioner had
8 identified 20[b] as just merely a typo issue and, in fact, the Petitioner had
9 relied on other disclosures for --

10 MR. GOLDBERG: I'd like to object to this. I did not discuss
11 anything about this during my rebuttal right now so she should not be
12 allowed to be getting into it either.

13 MS. ENTZMINGER: Well, Your Honor, I merely wanted to raise
14 that this was a brand new argument raised for the first time in Petitioner's
15 argument and therefore should be noted as such and violative of 104(b)(4)
16 (CROSSTALK) --

17 JUDGE IPPOLITO: Patent Owner, you do have to respond to the
18 rebuttal. And to the extent that your arguments have been presented, they're
19 all in the record.

20 MS. ENTZMINGER: Okay. Thank you, Your Honor. Well, with
21 respect to the user specificity -- I'm referring to Slide 34 of Patent Owner's
22 demonstratives, Xiao failing to disclose Claim 10 is regardless of -- as I
23 indicated, regardless of whether or not the Board agrees that a compatibility
24 check is required of the claims. And what Petitioner wishes to imply now,
25 or argue, is that somehow Xiao has a teaching that settings can be applied
26 across vehicles; they cannot. And that's the key distinction between the

1 inventions of the '268 Patent and Xiao, and Xiao in combination with
2 Hayashi. Because, regardless, there is no determination of applicable
3 settings. And circling here, more particularly of Figure 7, Bob's user profile
4 and Auto Maker C M7 of Figure 7. Those two groups of settings, the
5 settings from the automobile selected, and the settings from Bob's user
6 profile, those are what need to be determined to be compatible with one
7 another to be applicable settings.

8 And with that, unless the Board has any further questions, I'll rest.

9 JUDGE IPPOLITO: I do not have any additional questions, and
10 I'll check with panel. It does not seem that we have any additional questions
11 from my panel members either. Let me just confirm.

12 Well, at this time, we will take these cases under advisement.
13 Thank you, both for your presentations and for answering our many
14 questions today.

15 Before you leave, after we adjourn, I would like you to stay after,
16 and check with the court reporter to make sure if there are any questions that
17 need to be answered. And with that, we are adjourned. Thank you.

18 MS. ENTZMINGER: Thank you.

19 MR. GOLDBERG: Thank you, Your Honor.

20 (Whereupon, the above-entitled matter went off the record at 2:46
21 p.m.)

IPR2024-00786
Patent 9,171,268 B1

PETITIONER:

Joshua Goldberg
James Barney
Aidan Skoyles
Nicholas Eitsert
Ryan Davies
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
joshua.goldberg@finnegan.com
james.barney@finnegan.com
aidan.skoyles@finnegan.com
nicholas.eitsert@finnegan.com
ryan.davies@finnegan.com

PATENT OWNER:

Jerry Tice II
Aaron Hand
Brenda Entzminger
BUNSOW DE MORY LLP
jtice@bdiplaw.com
ahand@bdiplaw.com
bentzminger@bdiplaw.com