

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORP.,
Petitioner,

v.

EMERGING AUTOMOTIVE LLC,
Patent Owner.

Case IPR2024-00814
U.S. Patent No. 11,396,244

**PATENT OWNER'S
PRELIMINARY RESPONSE
UNDER 37 C.F.R. §42.107**

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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	Exhibits E-3, E-6 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
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EX2009	Google Patents search, U.S. Patent No. 11,396,244, available at https://patents.google.com/patent/US11396244B2/en?q=11396244#citedBy (identifying assignees of patents and patent applications which cited to U.S. Patent No. 11,396,244)
EX2010	Toyota's Appeal Brief, seeking review of Toyota's USPTO-rejected U.S. Patent Application Publication No. 2022/0144292, titled "Systems and Methods for Selecting a User Profile Among Multiple Users Carrying Personal Devices"
EX2011	U.S. Patent No. 10,449,918

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EX2012	Global Dossier for Toyota's family of patents and applications titled, "User Profile Synchronization for a Vehicle"
EX2013	Judge Gilstrap Trial Schedule for July 21, 2025
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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

I. Introduction

The Board should exercise its discretion under 35 U.S.C. § 314(a) and *Fintiv* to deny institution. But should the Board analyze the merits, it should nevertheless deny institution because the Petition fails to present any reasonable expectation of success.

Regarding discretionary denial, the district court litigation involves the same issues, the same parties, the same challenged claims, and the same asserted art, including the same primary reference for all Grounds here—*Rector*. There is extensive overlap, and institution would needlessly waste party and Board resources through duplicate, parallel proceedings that create the potential for inconsistent results. The district court trial is set to occur months before the projected statutory deadline for a final written decision, and both parties and the district court have and will have expended substantial time and resources in the parallel litigation. Currently, fact discovery is well underway, with hearings set on no fewer than five motions, including motion practice regarding infringement and invalidity, as well as multiple motions to compel discovery. Toyota has filed another motion challenging the validity of the '244 Patent on Section 101 grounds, which will be ripe for decision well before the institution deadline. Multiple depositions have been conducted, with more upcoming, as well as the commencement of the claim construction process. And this has and will all occur months before the Board's

institution decision in November 2024. Toyota has not sought a stay in the district court proceeding, and, given the recent decisions of the district court denying stay requests, any future motion, if sought, is unlikely to be granted.

Given the amount of work already undertaken by the district court and the parties, and the likelihood of inconsistent results on invalidity arguments and asserted art for the same asserted patent claims on a trial due to precede any final written decision—efficiency and integrity of the system are best served by denying institution.

Moreover, the Petition fails to present a compelling patentability challenge to overcome the factors favoring discretionary denial. As an example, Grounds 1-5 all attempt to rely on *Rector* alone for alleged disclosure of elements 1[b] / 17[b] / 21[b], but *Rector* does not disclose the server operation recited by these claim elements. Despite the plain language of the claim reciting “processing, ***by the server***¹ ... user information to verify the user ...,” Petitioner argues that these elements do *not* require a “server” to perform this operation. Pet. 23-24; EX1005 ¶¶ 118-120. But the claim *does* by its plain language recite that the “processing” of user information “to verify” the user is performed by a “server.” EX1001, 33:9-32, 34:66-35:24; EX1002, 632-34 (claims 17 and 21).

¹ All ***bold italic*** emphasis herein added unless otherwise noted.

Trying to fill the evidentiary void of *Rector*, the Petition alternatively cites to the “server verification” of *Kleve*. This attempt likewise fails, first because the motivation to combine is based on a non-existent problem of *Rector*, and further because it relies on purported teachings of *Kleve* that are not supported by the disclosures themselves.

And, even if the combination were proper, Toyota’s addition of *Kleve* does nothing to meet the recited limitation, as it wholly disregards the claims’ requirement that a server verifies the user “for accessing the profile.” A server must process user information “to verify the user *for accessing the profile* associated with the user account, the profile having a plurality of settings of the user for the vehicle.” *Id.* This requirement is confirmed in the prosecution history, wherein the Applicant amended the independent claims to add “for accessing the profile” in order “to clarify the process for verifying the user for accessing a profile that has settings stored in storage of a cloud services system.” *See* EX1002, 198-205 (amendments to claims), 206 (remarks in amendment), 213 (reasons for allowance include the independent claims’ limitation “processing, by the server, at least part of the user information to verify the user for accessing the profile associated with the user account, the profile having a plurality of settings of the user for the vehicle ...”).

As another example of its facial deficiency, an IPR can only be instituted “on the basis of prior art consisting of patents or printed publications.” 35 U.S.C.

§ 311(b). Each ground of the Petition relies on *Kleve*, which is neither a patent nor a prior art printed publication, as required by Section 311(b), and thus the Board cannot institute on any ground of Toyota’s IPR.

These failures are discernable from the Petition itself and cannot be cured by expert testimony. Even if they could be cured (they cannot), Dr. Almeroth’s declaration—made up principally of verbatim copying of attorney argument from the Petition—fails to add anything to the proceedings. Not one of Toyota’s grounds has any reasonable likelihood of success, failing to meet Petitioner’s evidentiary burden at the outset.

Toyota’s Petition must contain evidence to show “that there is a reasonable likelihood that the petitioner would prevail.” 35 U.S.C. § 314(a). It does not. And the Board must not institute to fill gaps in the Petition, to answer questions for which Toyota offers no evidence, or to construe claim terms for which Toyota asserts no construction is required. *See* Pet. 12. The Board routinely and properly dismisses defective Petitions like Toyota’s at the outset. Institution should be denied.

II. The Board Should Deny Institution Under *Fintiv*

The Board should exercise its discretion to deny institution under § 314(a). To do so, the Board balances six factors:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;

2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the Petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5-6 (P.T.A.B. Mar. 20, 2020).

“These factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* In evaluating these factors, the Board takes “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.*

In addition, the USPTO Director issued an “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” (“Interim *Fintiv* Procedure”) dated June 21, 2022, which is addressed below with respect to *Fintiv* factors 2 and 4.

A balance of the *Fintiv* factors –in view of the Interim *Fintiv* Procedure – warrants denial of institution.

A. The Board need not address the merits of the Petition because the *Fintiv* factors favor denial

1. Factor 1 Favors Denial (Likelihood of Stay)

Factor 1—which considers whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted—favors denial of institution.

Emerging Auto filed an infringement action on September 20, 2023, in the Eastern District of Texas, captioned *Emerging Automotive LLC v. Toyota Motor Corp.*, Case No. 2:23-cv-434, assigned to Judge Rodney Gilstrap. EX2008. Judge Gilstrap has since consolidated that lawsuit against Toyota with Emerging Auto’s infringement action against Kia Corporation, captioned *Emerging Automotive LLC v. Kia Corp.*, Case No. 2:23-cv-437, also assigned to Judge Rodney Gilstrap. EX2007. Toyota has not filed any motion to stay in the district court case. *Id.* Even if Toyota were to request a stay pending the outcome of this IPR proceeding, Toyota’s request would likely be denied.

Courts in the Eastern District of Texas, and Judge Gilstrap in particular, disfavor, and as a general rule, deny motions to stay pending IPRs. *See Scorpcast, LLC v. Boutique Media*, No. 2:20-cv-00193-JRG-RSP, 2021 WL 3514751, at *1 (E.D. Tex. June 7, 2021) (Judge Gilstrap reciting bases for denial of earlier motion to stay: “On October 27, 2020, the Defendants filed [their] original motion to stay

pending resolution of the IPR. At the time the Defendants filed their original stay motion, the parties had served infringement and invalidity contentions, started the discovery process, and begun preparing for the claim construction hearing. The Court denied that motion.”) (internal citations omitted); *and see, e.g., Force Mos Tech., Co. v. ASUSTek Comp., Inc.*, No. 2:22-CV-00469-JRG, 2024 WL 1586266 (E.D. Tex. Apr. 11, 2024) (Judge Gilstrap); *Koninklijke KPN N.V. v. Telefonaktiebolaget LM Ericsson*, No. 2:21-CV-00113-JRG, 2022 WL 17484264 (E.D. Tex. July 7, 2022) (Judge Gilstrap); *St. Lawrence Commc’ns LLC v. ZTE Corp.*, No. 2:15-CV-349-JRG, 2017 WL 3396399 (E.D. Tex. Jan. 17, 2017) (Judge Gilstrap).

The stay is even less likely here, given the significant case progression (discussed in factor 3) and scheduled jury trial preceding any final written decision (discussed in factor 2). The first *Fintiv* factor supports denying institution. *See, e.g., Mylan Labs. Ltd. v. Janssen Pharmaceutica NV*, IPR2020-00440, Paper 17 at 13-14 (P.T.A.B. Sept. 16, 2020) (“We consequently conclude that the balance of facts in the two litigations indicate that no stay is likely to be entered in either, and therefore *Fintiv* factor 1 leans towards denial of institution.”).

2. Factor 2 Favors Denial (Timing of Trial)

Fintiv factor 2 weighs in favor of denying institution because the district court is set to complete trial over four months before any final decision from the Board

would be due. The jury trial in the Eastern District of Texas litigation is set to commence on July 21, 2025 (EX1011), whereas the Board’s final written decision would be due over four months later, on approximately November 30, 2025. “If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*.” *Fintiv*, IPR2020-00019, Paper 11 at 9.

This timeline favors denial, as the Board has previously found that when “a jury trial is scheduled to occur in the related district court litigation approximately four months prior to when a final written decision would be statutorily due,” “these facts weigh in favor of exercising discretion to deny institution.” *Immersion Sys. LLC v. Midas Green Techs., LLC*, PGR2021-00104, Paper 15 at 11 (P.T.A.B. Jan. 31, 2022). Indeed, the Board has repeatedly found that even a one-to two-month period between the trial date and the projected date of a final written decision favors denial. *See, e.g., NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 17 at 8-9 (P.T.A.B. May 2, 2022) (finding two-month period between trial date and deadline for final decision weighed in favor of discretionary denial); *E-One, Inc. v. Oshkosh Corp.*, IPR2019-00161, Paper 16 at 6-9 (P.T.A.B. May 15, 2019) (finding one-month period between trial date and deadline for final written decision weighed in favor of discretionary denial); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12-13 (P.T.A.B. May 13, 2020) (factor disfavors institution when “the currently

scheduled District Court trial is scheduled to begin two months before our deadline to reach a final decision”); *eClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (P.T.A.B. Apr. 13, 2022) (determining denial favored where beginning of jury trial was “roughly one to two months” before final decision was due); *Netflix, Inc. v. Uniloc 2017 LLC*, IPR2020-00008, Paper 13 at 9 (P.T.A.B. Apr. 13, 2020) (finding two-month period between scheduled trial date and deadline for final written decision favored denial).

Additionally, the USPTO’s Interim *Fintiv* Procedure provides that the “[p]arties may present evidence regarding the most recent statistics on median time-to-trial for civil actions in the district court in which the parallel litigation resides for the PTAB’s consideration ... the PTAB will also consider additional supporting factors, such as the speed and availability of other case dispositions. *See Interim Fintiv Procedure*, 8-9. Here, the median time-to-trial is 21.1 months and the median time from filing to case disposition in the Eastern District of Texas is 7.8 months. EX2006, Judicial Caseload Profile, Table T-3 at 2, Table C-5 at 2 (Mar. 2024). Considering the 7.8-month median time for disposition in the Eastern District of Texas, the parallel litigation will likely be disposed of in 2024, over a year before the November 2025 statutory deadline for the final decision. *Id.*, Table C-5 at 2; *see also* EX2007 (showing September 2023 complaint filing); EX2008 (same). Moreover, the median time-to-trial statistics for the district predict a trial date of

June 2025 (EX2006), and for Judge Gilstrap in particular, the trial would be between eight to ten months prior to the institution date, in February or April 2025 (EX2016) (showing 20-month average time-to-trial, excluding transfers, and median time-to-trial of 18 months).

Judge Gilstrap has already set the jury trial for July 21, 2025, and that jury trial will conclude well before the Board's projected statutory deadline. EX2013 (showing Patent Owner's trial is set to proceed first on Judge Gilstrap's July 21, 2025 calendar). Additionally, because Toyota has already challenged the validity of the '244 Patent with a motion for judgment on the pleadings and given the speed with which the Eastern District of Texas reaches case dispositions, there may be a validity determination in advance of the Board's institution deadline and there will certainly be a district court determination relating to the validity of the '244 Patent in advance of the Board's projected statutory deadline. EX2006. Thus, *Fintiv* factor 2 favors discretionary denial.

3. Factor 3 Strongly Favors Denial (Investment in Parallel Proceedings)

Factor 3 strongly weighs in favor of denial because both Emerging Auto and Toyota will have expended considerable resources in the parallel litigation, including on the merits of Toyota's invalidity positions, by the time the Board issues an institution decision. *See Sand Revolution II, LLC v. Cont'l Intermodal Grp.*,

IPR2019-01393, Paper 24 at 10 (P.T.A.B. June 16, 2020) (noting that investment in invalidity contentions is relevant to this factor).

For factor 3, the Board considers “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, IPR2020-00019, Paper 11 at 9. “This investment factor is related to the trial date factor, in that more work completed by the parties and the court in the parallel proceeding tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs.” *Id.* at 10.

Here, the Board is projected to issue an institution decision on November 30, 2024. Emerging Automotive served its infringement contentions on January 18, 2024, and on March 28, 2024, Toyota served its invalidity contentions, nearly seven months before the projected institution decision. EX2004. Toyota’s invalidity contentions include claim charts addressing the same references asserted by Toyota in every ground of its Petition for every claim challenged in the co-pending litigation. *E.g.*, EX2005. By the time of the Board’s institution decision, Judge Gilstrap will have conducted hearings and issued decisions on at least five now-pending motions pertaining to technical aspects of the asserted patents – a motion to compel documents from Toyota, a motion to compel discovery responses from Toyota, Toyota’s motion to compel documents from Emerging Auto, Toyota’s

motion to amend its invalidity contentions, Toyota's motion to strike Emerging Automotive's Infringement Contentions—a motion that argues both claim construction and the merits of infringement allegations, and Toyota's §101 motion. *See* EX2007, ECF Nos. 54 (motion to compel Toyota's production of technical documents), 61 (addressing and incorporating Patent Owner's asserted claims and infringement contentions against Toyota), 63 (Toyota's motion to compel discovery responses), 65 (Toyota's motion to amend its invalidity contentions), 71 (motion to compel Toyota to respond to discovery). Judge Gilstrap has scheduled hearings on five pending motions for September 4, 2024, nearly three months before the Board's institution deadline. *Id.*, 13.

Moreover, as noted above, Toyota has filed a Rule 12(c) motion to dismiss Patent Owner's infringement count asserting the '244 Patent at issue in this Petition. *Id.*, ECF No. 83. Thus, by the time of the Board's institution decision, the parties' briefing will be complete on Toyota's Section 101 motion challenging the validity of the '244 Patent. *Id.* Additionally, the parties have already exchanged interrogatory responses, exchanged document productions, and completed certain depositions. *Id.* Moreover, Emerging Auto has spent hours reviewing materials on a “source code” computer, and Toyota recently noticed the depositions of the two inventors, Angel and Albert Penilla, for September. Before the projected institution deadline, therefore, the parties will have completed numerous witness depositions, and the

Court will have completed hearings and issued rulings on at least five substantive motions, with another pending substantive motion pertaining to the validity of the '244 Patent. *Id.* The parties further will have exchanged proposed claim terms and proposed constructions, will have submitted the Joint Claim Construction Statement, and will have completed claim construction discovery. EX1011. While claim construction may not be completed before the institution decision, it will be well underway and since neither party has contended that claim construction is necessary to resolve the merits of the Petition (Pet. 12), an order coming shortly after institution does not overcome the substantial resources expended by the court and the parties. *See, e.g., Mylan Labs.*, IPR2020-00440, Paper 17 at 18 (finding court's issuance of orders favored denial despite no claim construction order because "neither party has acknowledged any potential issues of claim construction that need to be resolved") (citing *Fintiv*, IPR2020-00019, Paper 11 at 9)).

By the time the Board issues an institution decision, the district court has, and will have, spent considerable time and resources dealing with substantive motions. This factor favors denial. *Mylan Labs.*, IPR2020-00440, Paper 17 at 15, 18 ("Specifically, if, at the time of the institution decision, the district court has issued substantive orders related to the patent at issue in the petition, this fact favors denial.") (citing *Fintiv*, IPR2020-00019, Paper 11 at 9 and citing *E-One*, IPR2019-00161, Paper 16 at 8, 13, 20).

Moreover, both Emerging Auto and Toyota will have expended substantial resources in the parallel litigation, including on the merits of Toyota's invalidity positions, where—as detailed below—there is significant overlap of issues.

Discretionary denial is therefore favored here, since the parties and the court will have invested substantial time and resources, including court hearings, substantial motion practice and ongoing fact discovery, by the November 30, 2024 institution deadline.

4. Factor 4 Strongly Favors Denial (Overlap of Issues)

Factor 4 weighs strongly in favor of discretionary denial because there is substantial overlap between the claims, arguments, and evidence raised in the Petition and in Toyota's invalidity contentions in the parallel district court proceeding. Toyota's failure to offer any stipulation or other action to reduce the overlap between the proceedings only highlights the concerns of duplicative efforts and conflicting outcomes raised by *Fintiv* and the USPTO's Interim *Fintiv* Procedure.

The Petition challenges each asserted claim in the district court litigation (i.e., claims 1-2, 4-11, 14-22). Pet. 3. In the district court litigation, Toyota's invalidity contentions challenge the same claims using at least the same asserted references of its Petition—*Rector*, *Kleve*, *Yassin*, *Patenaude*, and *Faenger*. Pet. 3; EX2004, 10, 17-19; Pet. 3 (invalidity contentions identifying prior art references, including the

five references cited in the Petition); *see* EX2005. Therefore, Toyota’s common prior art and common challenges to the claims renders the “overlap in issues between the two proceedings [] substantial.” *Code200, UAB v. Luminate Networks, Ltd.*, IPR2020-01506, Paper 10 at 11-12 (P.T.A.B. Feb. 16, 2021).

And Toyota’s district court assertion of *additional* prior art and *additional* combinations of art than those asserted here does nothing to alter the degree of overlap between the Petition and its invalidity contentions. *See, e.g., Fintiv*, IPR2020-00019, Paper 15 at 15 (finding Petitioner’s assertion of additional invalidity contentions “not relevant to the question of the degree of overlap for this factor”). Likewise, Petitioner incorrectly argues that the Petition’s challenge of two *additional* dependent claims of the ’244 Patent somehow weighs against discretionary denial, but the Board has repeatedly ruled that such a fact does nothing to mitigate “substantial” overlap in issues between the two proceedings where common prior art is presented and common independent claims are challenged. *Code200, UAB*, IPR2020-01506, Paper 10 at 11-12 (“In light of the common prior art asserted here and in the [] district court case, as well as the common challenge to the sole independent claim *and all but two of the dependent claims* of the [’244] patent, we agree with the Patent Owner that the overlap in issues between the two proceedings is substantial.”); *see also Teso LT UAB v. Luminati Networks Ltd.*, IPR2021-00122, Paper 12 at 10 (P.T.A.B. Apr. 20, 2021) (denial of institution

avored where Petition’s prior art references were all identified in the district court invalidity contentions, the same independent claims were challenged in both proceedings, and “the *additional* claims challenged in the Petition are all dependent claims”).

Therefore, with this substantial overlap between the Petition and the parallel proceedings, there are particularly strong “concerns of inefficiency and the possibility of conflicting decisions” if the IPR is instituted. *See, e.g., Fintiv*, IPR2020-00019, Paper 11 at 12 (finding “concerns of inefficiency and the possibility of conflicting decisions [are] particularly strong” where there is substantial overlap).

Accordingly, factor 4 weighs strongly in favor of denial of institution. *See Teso LT UAB*, IPR2021-00122, Paper 12 at 10 (finding “the overlap in issues between the two proceedings is substantial” where common art and common challenges to the independent claim were presented in both proceedings); *see also eClinical Works*, IPR2022-00229, Paper 10 at 12 (finding factor 4 weighed in favor of denial where Preliminary Invalidity Contentions showed overlap of asserted claims, art and arguments asserted in the Petition); *U.S. Venture, Inc. v. Sunoco Partners Mktg. & Terminals L.P.*, IPR2020-00728, Paper 10 at 12-14 (P.T.A.B. Oct. 1, 2020) (finding overlap between primary references asserted in Petition and litigation weighed in favor of denial).

Finally, because Toyota does not offer any stipulation or any action whatsoever to mitigate “the concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions,” this failure further “favors exercising [] discretion to deny institution of *inter partes* review.” *Code200, UAB*, IPR2020-01506, Paper 10 at 11-12.

For each of these reasons, factor 4 strongly favors discretionary denial.

5. Factor 5 Favors Denial (Overlapping Parties)

Patent Owner is the plaintiff and Petitioner is a defendant in the parallel litigation (EX2007), and “because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.” *Samsung Elecs. Co. v. Clear Imaging Research, LLC*, IPR2020-01401, Paper 12 at 21-22 (P.T.A.B. Feb. 17, 2021) (quoting *Fintiv*, IPR2020-00019, Paper 15 at 15) (finding factor 5 weighs in favor of discretionary denial given petitioner’s status as co-defendant in parallel litigation). When “a petitioner in *inter partes* review and a defendant in a parallel district court proceeding are the same, or where a district court is scheduled to go to trial before the Board’s final decision would be due in a related *inter partes* review, this factor weighs in favor of discretionary denial.” *Id.* (quoting *Sand Revolution*, IPR2019-01393, Paper 24 at 12-13); *see also IBM Corp. v. Digital Doors, Inc.*, IPR2023-00971, Paper 7 at 13 (PTAB Dec. 5, 2023) (“this factor favors denial if trial precedes the Board’s Final Written Decision”). Here,

Toyota is both the petitioner and a defendant in the district court litigation, and that district court proceeding “is scheduled to go to trial before the Board’s final decision would be due” here. *Samsung Elecs. v. Clear Imaging*, IPR2020-01401, Paper 12 at 21-22; *see also* section II.A.2., *supra*.

This factor therefore weighs in favor of exercising discretion to deny institution.

6. Factor 6 Favors Denial (Other Circumstances)

There are no “other circumstances” that support institution.

III. Institution should be denied because Petitioner has failed to show a reasonable likelihood of success on any challenged claim

Should the Board consider the merits, it should deny institution because the Petitioner failed to establish any reasonable likelihood of demonstrating that even a single challenged claim is unpatentable. Toyota fails to establish that *Rector*, alone or in any proposed combination (even if proper), would have rendered obvious any of the challenged claims.

All Grounds fail because *Rector*, either alone or in combination with *Kleve*, fails to disclose or suggest the independent claim elements requiring “processing, by the server, at least part of the user information to verify the user for accessing the profile associated with the user account, the profile having a plurality of settings of the user for the vehicle” (claim 1[b]) / “processing, by one of the servers, at least

part of the user information to verify the access² for the user, the profile having a plurality of settings of the user for the vehicle” (claim 17[b]) / “processing, by one of the servers, at least part of the user information to verify the access for the user, the profile having a plurality of setting of the user for the vehicle” (claim 21[b])—as in each of the challenged claims. The Petition points to *Rector*’s alleged server as performing this verification for profile access—but it does not. Instead, the relied upon disclosures show, at best, *Rector*’s *smart vehicle*, and not any alleged server, determining the identity of the driver, and that the alleged server, at most, “determines the permitted settings for the user.” Pet. 23-25 (citing claim 1, ¶¶ [0009], [0031], [0043], [0047], [0049]). Even if Petitioner’s summary of *Rector* were accurate, neither identified operation of *Rector* discloses or suggests any server performing user verification processing, let alone any server processing user information to verify the user’s *access to the profile of settings*.

Acknowledging *Rector*’s shortcoming, the Petition argues that “it would have been obvious to modify *Rector* such that verification is performed by the server, as

² Claim 17[a] and claim 21[a] provide the antecedent basis for “the access,” as recited in claim 17[b] and claim 21[b], requiring, for example, “a request from a vehicle to access a profile for a user account associated with a user[.]” EX1001, 35:7-10; EX1002, 632-34 (corrected claims 17 and 21).

in *Kleve*.” Pet. 23. But Toyota has failed to show a motivation to modify *Rector*’s method of controlling driver settings to include *server-side verification*. In fact, as explained more fully below, a POSITA would not have been motivated to modify *Rector*’s method to include server-side verification, as *Rector* already uses the more secure *client-side* verification. EX2001, ¶¶ 65-66.

But even if the references were properly combined (they are not), *Kleve* cannot fill *Rector*’s evidentiary void, as it merely describes a server verifying credentials *for access to a vehicle*—not access to a user profile, as claimed. Pet. 23-25 (citing EX1007, ¶¶ [0037], [0049], [0069], [0072], Fig. 6). Indeed, *Zellner*—the prior art rejection successfully traversed by Applicant—reflects deficiencies strikingly similar to *Kleve*, as *Zellner* too was concerned with detecting a device of a user when the user approaches a vehicle, and it was the vehicle that determined the user’s identity to allow the user to gain *access to the vehicle*. EX1002, 206 (citing *Zellner*, ¶¶ 66, 54, 55).

The Petition fails to establish any reasonable likelihood that any challenged claim is unpatentable. Thus, the Board should deny institution.

A. The ’244 Patent

U.S. Patent No. 11,396,244 (“the ’244 Patent”) is titled “methods for transferring user profiles between vehicles using cloud services.” The ’244 Patent is part of a family of patents that teach and claim inventions for improving the

efficiency, security, consistency and overall user experience of personal, rental and shared-use vehicle systems. The inventions of the '244 Patent were invented by Albert and Angel Penilla (the “Penilla brothers”) and issued to their company, Emerging Automotive LLC, a family-owned automotive innovation company.

The '244 Patent discloses the Penilla brothers' inventive systems and methods allowing for, e.g., the automatic and seamless transfer of user profile settings between vehicles and the employment of a cloud processing system to manage, update, learn from, improve upon, and automatically implement a personalized vehicle-user experience in vehicles. EX1001, Abstract, 1:59-6:11. The inventions of the '244 Patent offer a specific, personalized user experience, defined by preferences the user sets in a user profile, while simultaneously achieving the scalability of applying those personalized settings to various shared vehicles and shared vehicle services—leveraging cloud services to store and manage user profile data which allows for secure and efficient synchronization of settings across a wide range of vehicle types by, e.g., server-side verification of the user's access to the user profile. *Id.*; *see also id.*, 33:9-35:30, 36:1-29; EX1002, 632-34 (certificate of correction showing corrected claims to reflect Examiner-allowed claims). As stated in the title, the '244 Patent involves transferring of user profiles between vehicles using cloud services, making secure and efficient synchronization of user profile settings across different vehicles. EX1001, Title. As part of this process, the systems and methods

include mechanisms for authenticating devices and verifying users that interact with the user profile data, ensuring that only verified users can access or modify the stored profiles, and only specified users can access or modify restricted settings. EX1001, 1:59-3:63, 16:13-17:7, 10:15-24; 13:37-14:39. Indeed, this security feature of a server verifying the user for “accessing the profile” was featured in prosecution and used as a basis to overcome art. EX1002, 213-214 (Reasons for allowance), 198-205 (Amendments), 206 (Applicant remarks in amendment).

The innovations of the '244 Patent have broad application to various shared vehicle services, supporting a wide range of users and vehicles, and are particularly beneficial for improving ‘mobility as a service’ industries, such as car-sharing, ride-hailing and other on-demand transportation solutions. *E.g.*, EX1001, 17:8-32. In fact, the innovations disclosed by the '244 Patent have provided a foundation that persists in many of the shared vehicle and vehicle personalization technologies of today. Companies like Uber Technologies, Meta, Facebook, Apple, Ford, Google, Honda, Audi, Qualcomm, Nokia, Volvo, Jaguar, Paypal, IBM, Microsoft, and even Toyota have all cited to the '244 Patent in their own patent applications. EX2009, 25-30 (Google Patents Search, U.S. Patent No. 11,396,244, identifying assignees of patents and patent application publications which cited to the '244 Patent).

Indeed, Toyota itself has recognized the novelty and importance of the functionality disclosed and claimed in the '244 Patent. Years after the priority date

of the '244 Patent, Toyota filed a patent application titled, “Systems and Methods for Selecting a User Profile Among Multiple Users Carrying Personal Devices.” EX2010. The disclosure and claims of Toyota’s patent application publication are remarkably similar to that of the '244 Patent—so similar in fact that Toyota’s application has been rejected by the Patent Office as unpatentable under 35 U.S.C. § 103 over the '244 Patent in view of Patent Application Publication No. 2017/0369071 to Gould et al. *Id.* Toyota has since appealed that final rejection of its patent application, claiming that the cited combination fails to teach or suggest a proposed feature for accessing a profile log and loading a user profile based on the profile log. *See id.*; *see also id.*, 9. Moreover, long after the priority date of the '244 Patent, Toyota filed a family of patent applications titled, “User Profile Synchronization for a Vehicle.” EX2011; 2012. The disclosure and claims of the patents in this family recite identical and/or similar functionality disclosed in the '244 Patent. *Id.* Toyota’s argument *now*—that transferring and synchronizing user profile settings between vehicles utilizing cloud services was “well-known” at the time of the invention of the '244 Patent—is belied by Toyota’s disclosure and investment in the technology years later and stands in direct contradiction to the representations made to the Patent Office during prosecution and subsequent appeal of its rejected patent application. *Id.*; EX2010.

The innovations of the '244 Patent not only provide users with a more personalized, comfortable and secure experience, they also allow the owner of a vehicle (or a fleet of vehicles) more control and security in the management of their car and how the vehicle can be used by other drivers. EX1001, Abstract, 1:59-6:11, 16:13-17:7, 10:15-24; 13:37-14:39. For example, the inventions of the '244 Patent allow for an enhanced user experience, ensuring consistent comfort, convenience and security for the user across different vehicles—rented, shared or owned. *Id.* The inventions also support increased security and privacy, for instance, by allowing temporary profile management that ensures user data is protected by deactivating profiles after use. EX1001, 2:29-30; 20:6-13, 33:36-40.

Additionally, the systems of the '244 Patent let the owner of a vehicle specify what settings will be available to another driver, like a teenaged-child, a valet, a guest driver, a dealership “test-drive” customer, or a rental car customer, and because the invention includes a server verification for accessing the profile data before transferring settings to a vehicle, the system ensures that only users with specific permissions, like an owner, a parent, or an administrator, can edit, restrict or permit settings for additional users, such as employee drivers or teenager family members. EX1001, 1:66-2:5, 10:15-24; 13:37-14:39. In developing the innovations described in the '244 Patent, the Penilla brothers recognized drawbacks in the prior art. For example, vehicle settings were vehicle specific, with each vehicle typically

only having the ability to store 1-3 sets of settings. The Penilla brothers orchestrated a key shift in the art, abstracting vehicle operators from the vehicle itself, such that vehicle settings are *user specific*, allowing each user to apply his or her settings to any vehicle based on their login, and defined permissions/restrictions. EX1001, 13:35-43. For instance, their innovative methods of access management for user profiles and user profile transfer between vehicles enable companies to create and manage different logins to company vehicles for their employee delivery drivers, car washers, and mechanics. EX1001, 14:42-46. “That is, each login can be configured to provide or restrict access based on the user logged into the vehicle.” *Id.*, 14:44-46.

Families, too, find important applications of the inventions of the '244 Patent, which ensures that only select users of vehicles, like a co-owner parent, can create and make changes to user profile roles and restrict specific settings for the vehicle. For example, in Figure 2, shown below, user 1 is an administrator and can add more logins and/or roles to the system to allow a family member to have access to the family vehicles, but user 1 (e.g., parent) may only want user 2 (e.g., teenaged child driver) to have access to the vehicle for purposes of traveling between school and home. The invention restricts the teenager's ability to edit his or her login, role, or vehicle settings since they do not have administrator access. EX1001, 16:18-36, Fig. 2.

 User 1		
User 1 Logins	User 1 Roles	User 1 Vehicles
Administrator(edit) Add New	- Owner(edit) - Weekend driving(edit) - Commute driving(edit) Add New	- Ford SUV(edit) - Honda Hybrid(edit) Add New

 User 2		
User 2 Logins	User 2 Roles	User 2 Vehicles
Child(edit)	- School commute(edit) - Errands(edit)	Honda Hybrid

 User 1		
User 2 Logins	User 2 Roles	User 2 Vehicles
Child(edit) Add New	- School commute(edit) - Errands(edit) Add New	Honda Hybrid Add New

FIG. 2

EX1001, Fig. 2.

The methods of the '244 Patent allow the administrator parent and teenager child to have user profiles with specific settings for the same family car, and by having a server verifying user access to the profile of settings, not merely verifying accessing the vehicle, the parent can alter and restrict settings to be applied to the vehicle—in real time—even when other users are logged in, like the teenager user,

but the teenager user does not have the same editing permission given his or her login role. *Id.*, 11:30-46, 13:50-14:41, 15:25-17:7, Figs. 2-4.

For example, with the inventions of the '244 Patent, the parent administrator of the vehicle, who has a master account with administrator credentials, is able to set and remotely administer login settings for their teenaged-driver child, and can even update restrictions of settings at night or upon receipt of a notification that the teenager's rate of speed has exceeded a specified threshold. EX1001, 11:30-46, 13:50-14:41, 15:25-17:7, 23:7-14, Figs. 2-5.

B. The '244 Patent Prosecution History and Specification

The prosecution history provides relevant details on the claims' requirement that a *server* verify a user for *accessing a user profile* that has stored settings before transferring user profiles to a vehicle—requirements which the Petitioner and its expert disregard altogether because the asserted references do not disclose them. Pet. 24; EX1005, ¶ 120.

During prosecution, the pending independent claims 1 and 17 were initially rejected as anticipated by the *Zellner* reference (U.S. Publication No. 2007/0207789), and ultimately, Applicant made clarifying amendments to independent claims 1 and 17 and added independent claim 21, including adding language to each of “the independent claims to clarify the process for verifying the user for accessing a profile that has settings stored in storage of a cloud services

system.” EX1002, 206; *id.* at 198, 202, 204-05. For example, Applicant amended claim 1 to specifically include the terms “for accessing the profile” and “and at least one of said plurality of settings being restricted for use on the vehicle, wherein” in element 1[b]:

processing, by the server, at least part of the user information to verify the user for accessing the profile associated with the user account, the profile having a plurality of settings of the user for the vehicle and at least one of said plurality of settings being restricted for use on the vehicle, wherein at least part of the plurality of settings for the profile being stored on storage accessible to the cloud services system;

Id., 198.

Applicant argued that amendments (i.e., the underlined text above) to each of the pending independent claims 1 and 17 clarified “the process for verifying the user for accessing a profile that has settings stored in storage of a cloud services system.”

Id., 206.

Likewise, independent claim 21 was also added, and like independent claims 1 and 17, claim 21 recited that one of the servers processes user information to verify the access for the user, the profile having a plurality of settings of the user for the vehicle, with at least one of the settings being restricted for use on the vehicle. *Id.*, 204-05; *see also id.*, 207. Applicant also made amendments to dependent claims 2-3, 6, and 11-12, and added dependent claim 22. *Id.*, 198-200, 205; *see also id.*, 200.

Applicant relied on this claimed server functionality—verifying the user for accessing a profile that has settings stored in storage of a cloud services system, wherein at least one of the settings are restricted for use on the vehicle—to overcome the *Zellner* anticipation rejection. EX1002, 206. Applicant argued that the *Zellner* reference teaches determining the identity of a user in order to grant access to a vehicle. *Id.*

With these amendments made to the independent claims, including a server’s verifying the user for accessing a profile with settings, including at least one of those settings being restricted for use on the vehicle, all pending claims were allowed, subject to filing a terminal disclaimer. *Id.*, 213. The Examiner recognized that “all of the prior art of record fails to teach or suggest the limitation of claim, a method executed by a server of a cloud services system ... comprising: ... *processing, by the server, at least part of the user information to verify the user for accessing the profile* associated with the user account, *the profile having a plurality of settings of the user for the vehicle and at least one of said plurality of settings being restricted for use on the vehicle* ... [.]” *Id.* (emphases added).

C. The ’244 Patent Challenged Claims

Toyota challenges 21 claims of the ’244 Patent, including independent claims 1, 17 and 21. Claims 1, 17, and 21 each require *processing, by a server*, at least part of the user information *to verify the user for accessing the profile* associated with

the user account, the profile having a plurality of settings of the user for the vehicle.
EX1001, 33:9-32 (claim 1), 34:66-35:24 (claim 17); EX1002, 633-34 (corrected
claims 17 and 21).

For example, challenged method claim 1 recites:

1. A method executed by a server of a cloud services
system that is configured to interface with vehicles, comprising,

...

*processing, by the server, at least part of the user information to verify
the user for accessing the profile associated with the user account,
the profile having a plurality of settings of the user for the vehicle and
at least one of said plurality of settings being restricted for use on the
vehicle*, wherein at least part of the plurality of settings for the profile
being stored on storage accessible to the cloud services system; and

Id., 33:9-32; EX1002, 632-633.

Similarly, challenged method claims 17 and 21 recite:

17 / 21. A cloud-based system including one or more data centers, and
each data center of the cloud-based system includes one or more servers
. . . comprising:

receiving, by one of the servers, *a request from a vehicle to
access a profile for a user account associated with a user*, the request
identifies user information related to a user;

*processing, by one of the servers, at least part of the user
information to verify the access for the user, the profile having a*

plurality of settings of the user for the vehicle and at least one of said plurality of settings being restricted for use on the vehicle, wherein at least part of the plurality of settings of the profile being stored on storage accessible to said one or more servers; and

...

Id., 34:66-35:16; EX1002, 632-34.

As discussed below, *Rector*—alone or in combination with *Kleve*—fails to disclose or suggest any server verifying user access to the profile of settings for the vehicle, a feature which is included directly or by dependency in every challenged claim. Toyota instead relies on disclosure of *Rector*’s *smart vehicle* determining the identity of the driver, along with the fact that *Rector*’s alleged server determines permitted settings for the user. Pet. 23-24 (Ground 1) (relying on *Rector* for this element), 50-58 (Ground 2) (relying on *Rector* for alleged disclosure of elements 1[b] and 17[b], as to dependent claims 2, 4, 10, 18), 58-67 (Ground 3) (same as to dependent claims 5-7), 68-78 (Ground 4) (same as to dependent claim 8 and element 21[b]), and 78-79 (Ground 5) (relying on *Rector* for alleged disclosure of element 21[b], as to dependent claim 22). But none of these disclosures of *Rector* teach or suggest any server processing user information to verify the user, let alone a server verifying a user’s access to the user profile having settings for the vehicle. And *Kleve*—which is not properly combined with *Rector*—cannot make up for the evidentiary shortcomings of *Rector* because *Kleve* verifies only the user’s access to

a vehicle. *See* Pet. 24-25, 44-45 (Ground 1) (relying on *Rector-Kleve* combination for elements 1[b] and 17[b]), 50-58 (Ground 2) (relying on *Rector-Kleve* combination for alleged disclosure of elements 1[b] and 17[b], as to dependent claims 2, 4, 10, 18), 58-67 (Ground 3) (same as to dependent claims 5-7), 68-78 (Ground 4) (same as to dependent claim 8 and element 21[b]), and 78-79 (Ground 5) (relying on *Rector-Kleve* combination for alleged disclosure of element 21[b], as to dependent claim 22). The Petition fails to show a reasonable likelihood of success and must be denied pursuant to 35 U.S.C. § 314.

Toyota’s Petition thus fails and should be denied on its lack of merit.

D. Claim Construction

The Petition does not offer any claim constructions or analysis of whether any claim language requires construction—instead offering the unsupported assertion that “the claims read on the prior art ... under any construction consistent with *Phillips*.” Pet. 12. But the Petition abuses and distorts the plain language of the claims to arrive at its conclusory “read on the prior art” argument.

Toyota seeks to rewrite the claim to exclude the “by the server” / “by one of the servers” limitations. However, Toyota’s efforts to rewrite language out of the claims—rendering superfluous express claim language—cannot be correct. *Apple Inc. v. ContentGuard Holdings, Inc.*, IPR2015-00353, Paper 9 at 9 (P.T.A.B. June 25, 2015) (denying institution and rejecting Petitioner’s proposed construction,

finding that “[i]f we were to adopt this language proposed by Petitioner, it would render the claim phrase [] explicitly recited in independent claims [] superfluous”) (citing *Stumbo v. Eastman Outdoors, Inc.*, 508 F.3d 1358, 1362 (Fed. Cir. 2007) (disfavoring any claim interpretation that renders a claim term or phrase superfluous)); *see also Medacta USA, Inc. v. RSB Spine, LLC*, IPR2020-00264, Paper 46 at 13 (P.T.A.B. Apr. 15, 2021) (rejecting petitioner’s interpretation of claim limitation that “renders the term ‘primarily’ superfluous”) (citing *Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 950 (Fed. Cir. 2006) (“[C]laims are interpreted with an eye toward giving effect to all terms in the claim.”); *see also Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1288-89, fn.10 (Fed. Cir. 2017) (Board erred by failing to give effect to claim terms expressly covered by the claim, as doing so would render other limitations meaningless); *Elektro Instrument S.A. v. O.U.R. Sci. Int’l, Inc.*, 214 F.3d 1302, 1307 (Fed. Cir. 2000) (construing claim to avoid rendering the 30 degree claim limitation superfluous).

The challenged independent claims here have specific elements requiring a server to process user information to verify a user’s access to the user profile. *See* Section III.C above. It is at least those elements that Toyota has failed to show are disclosed or suggested in the prior art asserted here. Because of these failures of proof, Toyota and its expert ignore claim 1[b] / 17[b] / 21[b]’s requirement that *a server* process user information to verify the user *for accessing the profile*. Pet. 23-

24 (“To the extent that element 1[b] is interpreted to require *the server* ‘to verify the user for accessing the profile associated with the user account’”) (emphasis in original) (citing EX1005, ¶ 120) (same). But, by its express language, claim 1 *does* recite a server performing the operation of verifying the user for accessing the profile associated with the user account. EX1001, 33:11-15. Claims 17 and 21, by their plain language, likewise require that “one of the servers” carries out the recited processing of the user information to verify the access for the user, wherein “the access” is understood with reference to elements 17[a] / 21[a]’s recited “request from a vehicle to access a profile for a user account associated with a user.” *Id.*, 35:7-10; EX1002, 633-34. A person of ordinary skill in the art would not disregard express language from the claims. EX2001, ¶¶ 33, 41. And a person of ordinary skill would not disregard the requirement of a server processing user information to verify the user for accessing the profile, especially in view of the examples disclosed in the specification detailing that “systems for communicating with a server of a cloud system *used for managing access to a user account having a profile* that includes settings for a vehicle,” wherein, for example, “*credentials for the user account are transferred* by the computing system *to the server to enable the server to access the profile of the user account* and enable the computing system of the vehicle to use the profile.” EX2001 ¶¶ 38-51; EX1001, 5:50-60; *see id.*, 10:42-62, 11:30-46, 13:50-14:41, 15:25-17:7, 23:7-14, Figs. 2-5. Other than adopting the plain meaning, and

rejecting Toyota's efforts to read this express language out of the claims, construction by the Board is not needed to see why these elements are not present or suggested in the cited art.

Patent Owner reserves the right to propose or challenge constructions of terms other than those discussed herein in its § 42.120 Response if any trial is instituted.

E. All Grounds fail to establish a reasonable likelihood of proving any challenged claim unpatentable because neither *Rector*, nor *Rector* in combination, renders obvious any of the challenged independent claims

Rector, the primary reference for each ground, fails to disclose or suggest the “processing, by the server, at least part of the user information to verify the user for accessing the profile associated with the user account, the profile having a plurality of settings of the user for the vehicle,” as required by element 1[b]. Similarly, *Rector* fails to disclose or suggest “processing, by one of the servers, at least part of the user information to verify the access [i.e., “a request from a vehicle to access a profile for a user account”] for the user, the profile having a plurality of settings of the user for the vehicle,” as required by elements 17[b] and 21[b].

While Petitioner proposes to add the *Kleve* reference “[t]o the extent that element 1[b] is interpreted to require *the server* ‘to verify the user for accessing the profile associated with the user account,’ . . .”, *Kleve* does not cure *Rector*'s deficiencies. The identified disclosures of *Kleve* merely describe a remote credential

verification *for access to a vehicle*. EX1007, ¶ [0049]. Moreover, the ‘profile’ pointed to in *Kleve* has no “settings of the user for the vehicle,” as required by elements 1[b], 17[b], and 21[b]. *Id.*, ¶ [0037]; EX2001, ¶¶ 55-56. Instead, *Kleve*’s ‘user profile’ is a feature available to an owner and renter of a vehicle, in which the owner lists information about the terms of the rental agreement and the make and model of the vehicle, and the renting customer uploads photographs of identification cards, photographs of credit cards, and/or “other types of unique Temporary User identification to validate and pay for the rental service[.]” *Id.*

Accordingly, Toyota’s failure to demonstrate any disclosure or suggestion of these elements applies to all Grounds. And all Grounds fail.

The fatal flaws concerning each *independent claim* (Grounds 1 and 4) discussed herein are sufficient to warrant denial of institution.

F. There is no reasonable likelihood that Petitioner will prevail in its contention that the Ground 1-5 challenged claims are rendered obvious by *Rector* or by *Rector* in combination with *Kleve*

Neither *Rector* nor *Rector* in combination with *Kleve* discloses or suggests “processing, by the server, ... user information to verify the user for accessing the profile associated with the user account,” as claimed by independent claims 1, 17, and 21 and, by dependency, all claims challenged in Grounds 1-5.

1. Petitioner has not shown that *Rector* discloses or suggests “processing, by the server, ... user information to verify the user for accessing the profile associated with the user account” of independent claims 1, 17, and 21

Toyota failed to show that *Rector* discloses or suggests any server “processing ... user information to verify the user for accessing the profile associated with the user account,” as required by independent claims 1, 17 and 21. The “processing ... user information to verify the user for accessing the profile...” element is also recited in the body or included by dependency in all challenged claims of Grounds 1-5. EX1001, 33:33-35 (claim 2), 33:41-34:65 (claims 4-16), 35:25-36:29 (claims 18-20); EX1002, 633-34 (claim 22).

As discussed above, the '244 Patent teaches and claims transferring user profiles between vehicles, with a solution that uses a server to receive a request from electronics of a vehicle to access a profile for a user account, and a server to process user information to verify the user for accessing the profile associated with the user account—all *before* transferring settings to the vehicle. *E.g.*, EX1001, 33:9-32. With this server verifying user information for accessing the profile, the '244 Patent teaches user profile transfer methods that can, for example, allow the owner of the vehicle or administrator of the profile to specify what user profile settings can be accessed by another driver, and accordingly, what settings will be transferred to the vehicle. EX1001, 14:42-56. For example, as described above, a company owning a

fleet of vehicles “can create and manage logins to company vehicles for delivery drivers, car washers, and mechanics,” configuring each login “to provide or restrict access based on the user logged into the vehicle,” such as a maximum speed, or restricted territory of travel. *Id.* Likewise, an administrator of a profile, such as a parent-owner of a vehicle, can set and remotely administer login settings for another user, e.g. a teenaged-driver, depending on the time of day (day or night) or when a condition or event is detected (e.g., the teenager’s driving characteristics such as rate of speed, fuel consumption, etc.). EX1001, 13:50-14:41, 15:25-17:7. The owner-parent can even toggle the settings available to the teenaged-driver login in real-time, for example, in response to the parent-owner’s receipt of automatic notifications of the teenaged driver exceeding or failing to follow specific vehicle restrictions. EX1001, 11:30-46, 13:50-14:41, 15:25-17:7. Toyota fails to identify any server operation in *Rector* that can verify a user’s access to a profile such that a user 1 (e.g., administrator) can login and update profile settings available to user 2 (e.g., delivery driver, teenaged-driver) in real-time, thereby allowing a change and automatic update of the profile settings transferred to a vehicle while user 2 is logged into that vehicle. Pet. 21-24. Indeed, this claimed functionality was addressed during prosecution and used to overcome the Examiner’s anticipation rejection. *See supra* Sections III.B., III.D.

a. ***Rector* fails to teach or suggest any server processing user information to verify the user for accessing the profile, as claimed**

Rector never mentions or suggests a server performing any user verification operation, let alone the claimed server verification for accessing the user profile. EX1006. The Petition identifies *Rector*'s "comparing the unique identifier with a set of unique identifiers on a server on a network" (Pet. 23), but no alleged server in *Rector* performs this "comparing," ***verifies a user, or otherwise processes user information to verify a user***. EX2001, ¶¶ 59-60, 53-54. Instead, *Rector* discloses that a "smart vehicle," not any alleged server, performs this "comparing" function. *Id.*; EX1006, ¶ [0043].

Rector explains that its "smart vehicle determines the identity of the driver" wherein "a client logic and processor on the smart vehicle compares the unique identifier with a set of unique identifiers on a server on a network." EX1006, ¶ [0043]; EX2001, ¶ 61. And then, "[w]ith the identity of the driver determined," *Rector* instructs, "the smart vehicle looks up settings for the driver." *Id.* *Rector* teaches that the "comparing" operation to determine the identity of the driver can be performed in one of two ways: either by comparing information from the wireless communication device of the user to the information stored on the vehicle, or by taking a unique identifier from the wireless communication device and comparing it to the unique identifier from the settings server. *Id.* ¶ [0043]; *see also id.*, ¶ [0030]

(“[c]lient logic 105 on smart vehicle 100, via an antenna and transceiver, receives the unique identifier ... and determines the identity of the driver.”). Neither of *Rector*’s described “comparing” operations discloses or suggests any server processing user information to verify a user for accessing a profile. EX2001, ¶ 61.

Indeed, in *Rector*, the relied-upon “comparing” function cannot be the alleged server verifying a user for accessing a profile having settings, as the Petition incorrectly states. *Rector* is explicit that “***the determination of a driver’s identification*** and the subsequent initiation of the corresponding settings for the driver ***are performed by smart vehicle 200.***” EX1006, ¶ [0040]; EX2001, ¶ 62. It is “with the unique identifier” that “***the smart vehicle determines the identity of the driver*** S351”:

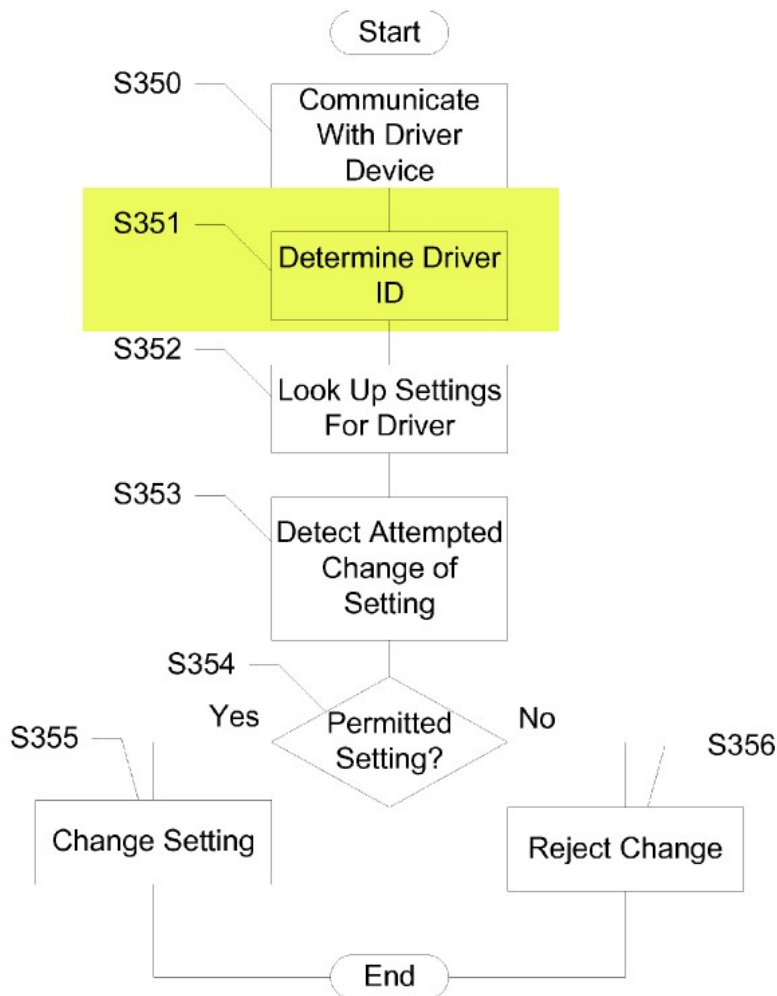


Figure 3

EX1006, Fig. 3 (highlighted); EX2001, ¶ 62.

- b. The Petition offers no evidence that *Rector*’s “associate” function discloses or suggests a server verifying the user for accessing the profile, as claimed**

Rector’s “associat[ing] the unique identifier with the user account” does nothing to fill the Petition’s disclosure gap for claim 1[b], claim 17[b] or claim 21[b]. Pet. 23; EX1006, ¶ [0009]; EX2001, ¶ 63. The Petition identifies no disclosure on what “associat[ing] the unique identifier with the user account” entails, identifies no

disclosure that this operation performs or otherwise processes user information to verify the user at all, and never offers any explanation how this “associating” function allegedly discloses the server performing verification of user information for accessing the user profile. Pet. 21-24, 44-45 (“*see supra*, IV.A.3.”), 76 (“*see supra*, VI.A.10 (discussing nearly identical element 17[b])”); *see id.*, 23 (citing EX1006, ¶¶ [0009], [0043], [0031], Figure 3); EX2001, ¶ 63. In fact, because *Rector* utilizes the term “verifying a driver’s identity” to describe the various means by which *the smart vehicle* of the settings control system can “verify that the correct party is determined to be the driver,” *Rector* itself belies the Petition’s argument that *Rector*’s use of the term “associate” somehow suggests the required verification function. EX1006, ¶¶ [0047]-[0048]; EX2001, ¶ 63.

Indeed, the disclosures of *Rector* only identify one component of the “settings control system”—the “smart vehicle”—“to verify that the correct party is determined to be the driver.” *See, e.g.*, EX1006, ¶¶ [0009], [0030], [0040], [0043], [0047]-[0048]; EX2001, ¶ 64. Accordingly, the Petition fails to show that *Rector* teaches or suggests, “processing, by the server, at least part of the user information to verify the user for accessing the profile associated with the user account, the profile having a plurality of settings of the user for the vehicle” / “processing, by one of the servers, at least part of the user information to verify the access for the user,

the profile having a plurality of settings of the user for the vehicle.” EX2001, ¶¶ 58-64.

2. All Grounds fail because Petition has not shown that a POSITA would have been motivated to modify *Rector*’s *more secure* client-side verification with a *less secure* server-side verification

The premise of Petitioner’s motivation to combine—that “it would have been obvious to modify *Rector*’s method of controlling driver setting to include server-side verification, as in *Kleve*, *for additional security*”—is just plain wrong. Pet. 24-25; EX1005, ¶ 122. First, a POSITA would have understood that the client-side verification of *Rector*, a *local* software system, is *more secure* than a system in which authentication is performed *remotely by a server*. EX2001, ¶¶ 65-66. Unlike authentication performed by local systems (i.e., client-side authentication), server-side authentication requires computer networks to transmit messages for verifying credentials, and those distributed systems’ reliance on computer networks means that they are vulnerable to a variety of security attacks. *Id.* Accordingly, modifying a local, client-side verification system with a less-secure server-side system does not provide the “additional security” that the Petition claims. *Id.*; Pet. 24-25; EX1005, ¶ 122. A POSITA motivated to provide “additional security” to the client-side authentication of *Rector* would not have sought to modify *Rector*’s *more*

secure system to render it *less secure* with “server-side authentication, as in *Kleve*.” Pet. 25; EX2001, ¶¶ 65-66.

Therefore, the proposed motivation to combine fails because Toyota’s relied-upon problem—providing “additional security” to the *more secure Rector*, allegedly solved by including a *less secure* “server-side verification”—is simply nonexistent. “A motivation to combine the teachings of references cannot be based on the alleged existence of a problem that does not exist in the specific asserted combination.” *Aruba Networks, Inc., XR Commc’ns LLC*, IPR2018-00701, Paper 10 at 10 (P.T.A.B. Aug. 27, 2018) (denying institution, finding “the purported gap in the teachings of [the reference] that Petitioner relies on as the basis for providing the motivation to combine [the two references] does not exist”) (citing *In re Schweickert*, 676 F.App’x 988, 995-96 (Fed. Cir. 2017)).

The Petition’s alleged motivation to combine is further flawed because *Kleve* does not even stand for the proposition claimed by Toyota and its expert. Pet. 24-25; EX1005, ¶ 122; EX2001, ¶ 66. Rather, *Kleve* teaches that “additional security” to the virtual key can be achieved “by requiring **remote credential verification at the vehicle**.” EX1007, ¶ [0049]. Toyota and its expert mischaracterize *Kleve*’s teachings about “additional security” via remote credential verification as *limited to* server-side verification. Pet. 24-25; EX1005, ¶ 122; EX2001, ¶ 66. Instead, *Kleve* explains that “the remote credential verification **at the vehicle** may be done with

additional hardware assembled on the exterior of the vehicle or in the vehicle cabin.” EX1007, ¶ [0049]. *Kleve* goes on to instruct that this remote verification **at the vehicle** can be performed by any of three entities: “the remote credential verification may be done by [1] the VCS, [2] using a server, or [3] allowing the Owner to verify the Temporary User’s request.” *Id.* Here, among *Kleve*’s three options to provide “additional security” to the virtual key is the *most secure*, local option: client-side verification at the vehicle, using the VCS. *Id.*; EX2001, ¶ 66. Therefore, a POSITA seeking to provide “additional security” would not have modified *Rector*’s *more secure* method of controlling driver settings to include the *less-secure* server-side option of *Kleve*. EX2001, ¶¶ 65-66. The Petition’s mischaracterizations of *Kleve* provide yet another reason Toyota and its expert fail to establish a motivation to modify *Rector* with *Kleve*, as proposed. *See, e.g., Aruba Networks*, IPR2018-00701, Paper 10, at 11-14 (denying institution, finding “reasons given for combining the relevant teachings ... to teach or suggest all the elements of this limitation are not supported by the relied upon passages”).

These deficiencies infect each of Grounds 1-5 because the Petition relies on the proposed *Rector-Kleve* combination to challenge independent claims 1, 17 and 21.

3. **All Grounds fail because Petitioner has not shown that *Rector* in combination with *Kleve* renders obvious “processing, by the server, ... user information to verify the user for accessing the profile associated with the user account ...” as recited in independent claims 1, 17 and 21**

Acknowledging that the relied-upon disclosures of *Rector* never teach or suggest a *server* performing any verification function (Pet. 23 (“to the extent element 1[b] is interpreted to require the *server* to ‘verify the user for accessing the profile associated with the user account’...”)), Toyota argues that “it would have been obvious to modify *Rector* such that verification is performed by the server, as in *Kleve*.” Pet. 24 (citing EX1007, ¶ [0049]). But the Petition’s reliance on *Kleve* is misplaced, for its alleged server only verifies credentials ***for accessing a vehicle***, not verifying the user for accessing a user profile having settings, as required by all challenged claims. EX1007, ¶¶ [0048]-[0049]; EX2001, ¶¶ 67-68. The Petition identifies disclosures of *Kleve* which describe a security feature available to a vehicle owner before a user is granted access to enter and/or drive away a vehicle. EX1007, ¶¶ [0048]-[0049]; EX2001, ¶¶ 67-68. That is, even after a “virtual key” is issued to a user to “unlock” and drive a vehicle, the user also undergoes remote credential verification **at the vehicle** itself, before the user is allowed to enter and/or drive the vehicle. *Id.* *Kleve* makes clear that it verifies only this vehicle access:

[t]he virtual key may allow a Temporary User temporary granted access to the Owner’s vehicle. ***The granted access allowed by the***

virtual key may permit entry of the vehicle; grant a keyless drive-away of a vehicle, and/or both. The Temporary User may enter a virtual key outside or inside the vehicle, while credential authorization may be processed by the VCS, a server and/or by the vehicle Owner. The system may be further extended to facilitate the virtual key with additional security by requiring remote credential verification at the vehicle. ... For example, but not limited to, the Temporary User entering a credential verification password at the vehicle's touchscreen visual display while having the VCS, server, or owner compare and verify authorization.

Id. The Petition-identified disclosures of *Kleve* never mention or suggest verification by any server for accessing a user profile, let alone accessing a user profile having settings of a user for a vehicle. *Id.*; EX2001, ¶¶ 67-68. Therefore, *Kleve*'s teaching about verifying to ***grant access to a vehicle*** cannot be the required server verification for accessing a profile with a plurality of settings.

And while Toyota attempts to conflate *Kleve*'s "user profile" with the claims' recited "profile having a plurality of settings of the user for the vehicle," *Kleve*'s "user profile" has no such settings. Pet. 25 (citing EX1007, ¶ [0037]); EX2001, ¶¶ 70-71. Rather, the "user profile" described in *Kleve* is merely a feature on a website which allows the owner to approve of, and receive payment for, a vehicle rental transaction. EX1007, ¶ [0037]; EX2001, ¶¶ 70-71. For example, *Kleve* teaches that a "user profile" is where the owner lists the make, model and year of the vehicle, the

temporary user submits photographs of their credit cards and photographs of their IDs, and ultimately, it is the “user profile” that serves as a means for the owner to obtain payment from and validate a user to rent the vehicle. *Id.*

More fundamentally, because *Kleve*’s “user profile” has no disclosure or suggestion of any settings of the user for the vehicle (*id.*), let alone any disclosure of transferring settings from a profile to a vehicle (*id.*), the disclosures of *Kleve* cannot achieve the vehicle customization enabled by the user profile transfer solutions of the ’244 Patent. EX1001, 11:30-46, 13:50-14:41, 15:25-17:7, Fig. 4, Fig. 5; EX2001, ¶¶ 69, 55-56. Regardless, and in any event, *Kleve*’s server verification is limited to *the vehicle access*, and has nothing to do with what *Kleve* refers to as a “user profile.” EX1007, ¶¶ [0048]-[0049]; EX2001, ¶¶ 55-56, 67-68.

Toyota’s reliance on *Kleve*’s disclosure of “step 624” fares no better. Pet. 25 (citing EX1007, Fig. 6). Indeed, *Kleve* never mentions or suggests any server involved at all in “step 624.” EX1007, ¶ [0072], Fig. 6; EX2001, ¶ 72. On the contrary, *Kleve* instructs that once a user uses a virtual key to enter/start a vehicle, the user may *use a phone* (or a “nomadic device”)—and not any alleged server—to pair with the vehicle computer system and, according to *Kleve*’s system, it is the phone that “may send personal settings to the vehicle.” EX1007, Fig. 6, ¶ [0072]; EX2001, ¶¶ 55-56, 72-73.

Accordingly, Petitioner’s *Kleve* arguments are facially deficient, and do not show a reasonable likelihood that *Kleve*’s server verification, even in combination with *Rector*, could suggest or render obvious a server performing a verification of a user for accessing the profile having settings of the user for the vehicle. There is simply no teaching or suggestion in *Kleve* of the claimed “processing, by the server, ... user information to verify the user for accessing the profile associated with the user account the profile having a plurality of settings of the user for the vehicle.” Indeed, *Kleve*’s alleged server verification, at best, grants access to a vehicle only. EX1007, ¶¶ [0048]-[0049]; EX2001, ¶¶ 55-56, 67-68. And *Kleve*’s disclosure of a “user profile” is of no consequence since there is no server verifying user access to this “user profile” and regardless, *Kleve*’s “user profile” has no settings. EX1007, ¶ [0037]; EX2001, ¶ 71. Likewise irrelevant are the “personal settings” identified by Toyota’s Petition, which are sent solely from a nomadic device to a vehicle. EX1007, ¶ [0072]; EX2001, ¶ 73. Therefore, *Kleve* fails to cure the deficiencies of *Rector* discussed above.

While Petitioner adds *Yassin* (Grounds 2, 3, and 5), *Patenaude* (Ground 3) and *Faenger* (Grounds 4 and 5), they do not cure deficiencies of *Rector*, or *Rector* in combination with *Kleve*, for independent claim elements 1[b], 17[b], and 21[b], and Petitioner makes no argument to the contrary. Pet. 47-58 (Ground 2), 58-68 (Ground 3), 68-78 (Ground 4), 78-79 (Ground 5); EX2001, ¶ 74.

The Board should thus deny institution.

IV. Section 311(B) of the AIA Prevents Institution

The Petition must be denied under 35 U.S.C. § 311(b). Regardless of whether *Kleve* is prior art under 35 U.S.C. § 102, it cannot be used for IPR. While Section 102 identifies numerous disclosures that qualify as “prior art,” an IPR may only be instituted on a subset of that art. Specifically, §311(b) allows *inter partes* review “only on the basis of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b). Petitions thus may not be instituted on prior art consisting of “public use” or “sales,” as recited in §102(a)(1) or a patent application that was filed before the effective date, but published after, as contemplated in §102(a)(2).

Petitioner concedes that the priority date of the ’244 Patent is—at the latest—March 15, 2013³. Pet. 10. Therefore, *Kleve* is not “prior art consisting of patents or printed publications” as required by § 311(b). First, *Kleve* is a patent publication, and thus not prior art consisting of a patent. EX1006, 1. Moreover, *Kleve* was not published until May 8, 2014 (*id.*), well after the priority date of the ’244 patent, whether it be March 15, 2013 or earlier. Petitioner makes no argument that *Kleve*

³ While Petitioner argues that the ’244 patent is not entitled to its April 22, 2011 priority date, the Board need not resolve that question to deny institution under any of the arguments presented herein, as the Petition fails regardless.

was publicly available before its publication. As such, *Kleve* is not prior art consisting of a printed publication because “[f]or a reference to qualify as a printed publication, ‘before the critical date the reference must have been sufficiently accessible to the public interested in the art.’” *See, e.g., Valve Corp. v. Ironburg Inventions Ltd.*, 8 F.4th 1364, 1373 (Fed. Cir. 2021) (quoting *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1568 (Fed. Cir. 1988)). As such, the Petition cannot be instituted because each ground of the Petition relies on *Kleve*.⁴

V. Conclusion

As shown above, the *Fintiv* factors and Interim *Fintiv* Procedure warrant the Board’s exercise of discretionary denial.

Alternatively, for all the reasons stated above, the Petition fails to establish a reasonable likelihood of success as to any challenged claim, and therefore institution should be denied.

As a separate basis for denial, the Petition cannot be instituted because all grounds rely on *Kleve*, which is not “prior art consisting of patents or printed publications” as required by Section 311(b).

⁴ Patent Owner recognizes and notes that this issue is currently on appeal before the Federal Circuit in *Lynk Labs, Inc. v. Samsung Electronics Co.*, No. 2023-2346 (Fed. Cir.).

Dated: August 30, 2024

Respectfully submitted,

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37 C.F.R. §42.24(d) CERTIFICATION

The undersigned hereby certifies that this submission, excluding the table of contents, table of authorities, exhibit list, certificate of word count, and certificate of service, contains 11,639 words, as determined using the standard word counting feature of the Microsoft Word program.

Dated: August 30, 2024

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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 August 30, 2024, a copy of the foregoing document was served by email upon the following counsel at the below email addresses:

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