

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

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

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I. Introduction

Toyota offered neither excuse nor explanation for its failure to show a motivation to combine teachings from *Rector*'s distinct embodiments. The embodiment on which Petitioner primarily relied does not disclose any server transferring operation and instead teaches that a smart vehicle determines the identity of the driver, the smart vehicle looks up settings for the driver and the smart vehicle determines whether any attempted change in setting is permitted or prohibited. The Petition failed to inform the Board, let alone justify, that Petitioner had thus modified this first embodiment in view of a distinct, second embodiment which teaches the alleged server operations. *See, e.g.*, Patent Owner's Response ("Response"), 20-28, 30-38. Because the Petition relies on *Rector* alone for alleged disclosure of the server transferring operations of independent claim limitations 1[c] and 17[c]—and failed to justify its combination of embodiments or show any reasonable expectation of success in doing so—all grounds fail and all challenged claims must be upheld. Unlike the wealth of authority cited in the Response, the Board need not assess Petitioner's *insufficiency* of proof—here, the Petition offered none whatsoever. In Reply, Petitioner does not and cannot rehabilitate the Petition's *prima facie* failures of proof. Instead, the Reply offers various red herring arguments, none of which change the legal deficiencies of the Petition, as shown below.

As a separate basis for upholding all challenged claims, the Reply affirms that the plain and ordinary meaning of “transferring is configured to instruct” is narrower than mere capability, and therefore the Petition’s reliance on *Rector*’s *capability* is of no avail to Petitioner’s obviousness challenge. The Petition relies on *Rector* alone for alleged disclosure of the independent claims’ recited limitation, “transferring, by the server ... the transferring is configured to instruct” EX1001, claims 1[c], 17[c]. Therefore, Petitioner’s failure to demonstrate this narrowed operation of server transferring is fatal to all grounds of the Petition. While the Reply repeatedly deflects the issue by pointing to alleged “causation,” neither *Rector* discloses any such “causation,” nor does Petitioner’s expert opine that it does so. Accordingly, if the Board agrees with controlling authority that the plain and ordinary meaning of “configured to” is narrower than “capable of” or “capability,” *Rector* still fails to teach or suggest at least independent claim elements 1[c] and 17[c], and therefore all challenged claims must be upheld.

II. The Reply fails to address the Petition’s failures of proof in improperly combining and modifying distinct embodiments of *Rector*, without explanation, let alone any motivation for combining and modifying these embodiments.

Like the Petition, the Reply ignores its burden of proof, misapprehending that Petitioner, alone, must meet the burden to demonstrate some suggestion or motivation to combine and modify *Rector*’s distinct embodiments. Indeed, the

Reply fails to even address any of the controlling authority discussed in the Response that demonstrated the Petition's fatal failure to show a teaching or motivation to combine and modify the embodiments of *Rector*. Response, 20-28, 30-38. For example, the Response cited to the Board's decision in *Abiomed v. Maquet Cardiovascular*, IPR2017-01204, Paper 9 at 9-11 (P.T.A.B. Oct. 23, 2017), which demonstrates the very evidentiary deficiencies at issue here. The Board in *Abiomed* found that (1) Petitioner failed to establish sufficiently that the features of different embodiments are interchangeable (Paper 9 at 9); (2) Petitioner failed to provide sufficient rationale to combine the teachings of those different embodiments (Paper 9 at 9, 11); (3) Petitioner's expert's opinion as to what one embodiment "could include or would accommodate [] is not the same as what the reference teaches" (Paper 9 at 11); and (4) Petitioner failed to "explain sufficiently why one skilled in the art would have found it obvious to combine those teachings" (*id.*). Worse than the failures of *Abiomed*, Petitioner never offered *any* explanation whatsoever for combining *Rector*'s distinct embodiments. Response, 17-37.

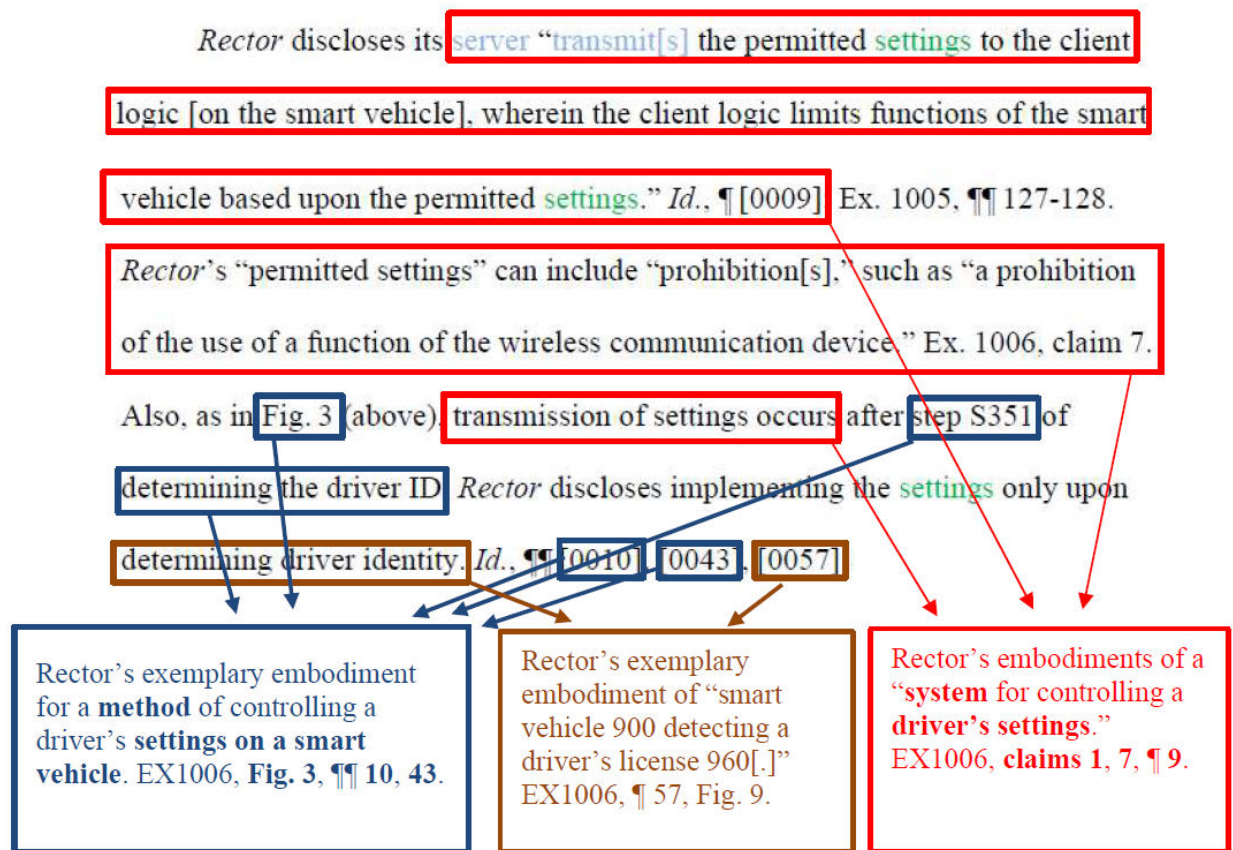
Because the Petition failed to ever advise the Board that it had combined and modified *Rector*'s embodiments, let alone offered any rationale why a POSITA would be motivated to do so, the Petition fails to meet its prima facie burden of obviousness. *Id.*, 17-37, 38-40; *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000) ("Even when obviousness is based on a single prior art reference, there must be a

showing of a suggestion or motivation to modify the teachings of that reference.”). As demonstrated in the Response, regardless of whether the relied-upon disclosures are taken from a single reference, it remains the Petitioner’s burden to make “a showing of a suggestion or motivation to modify the teachings of that reference.” *In re Kotzab*, 217 F.3d at 1370.

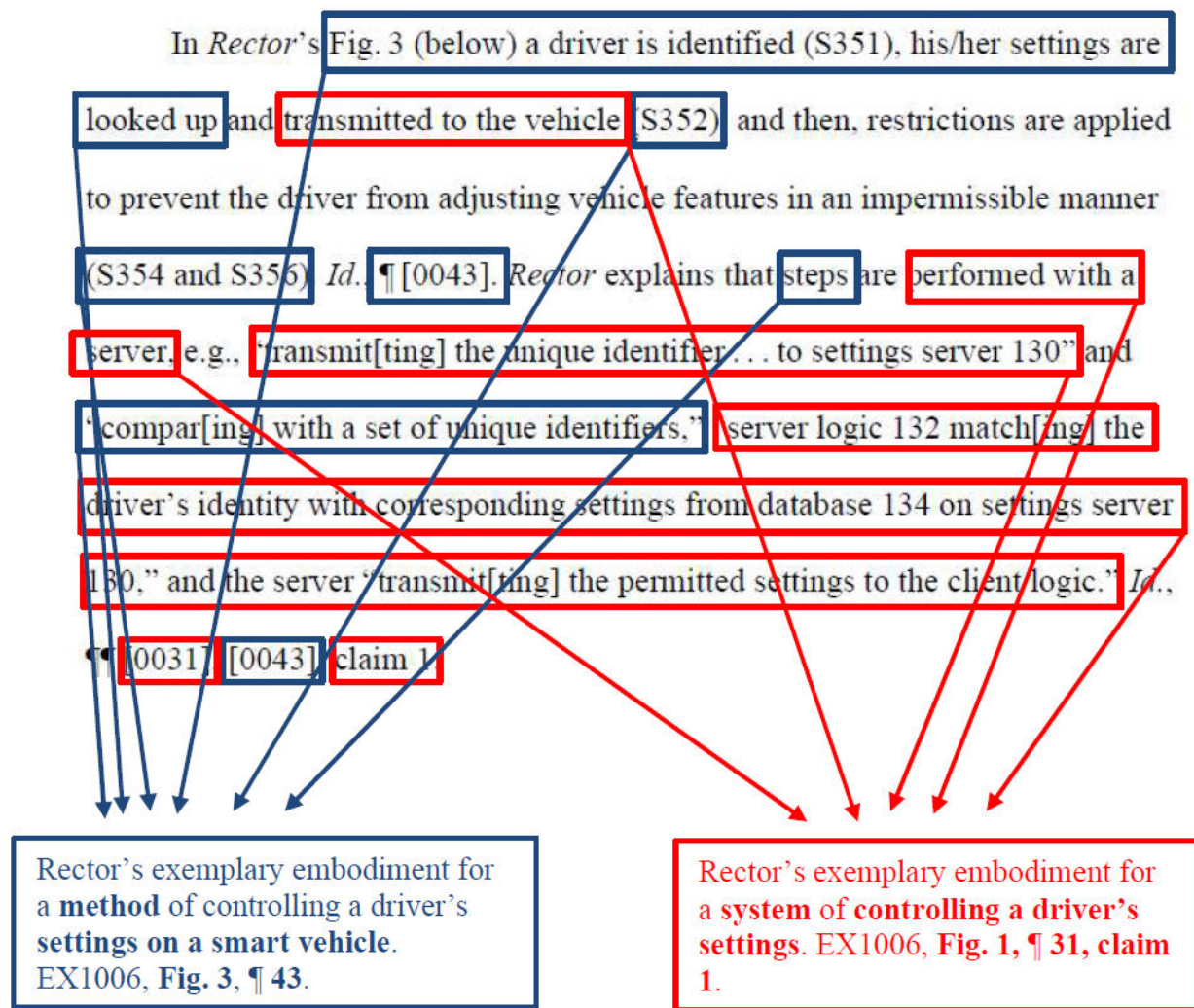
The Petition’s reliance on distinct method and system embodiments is unambiguous, and detailed at length in the Response. Response, 17-37; *see, e.g.*, EX1006, ¶ 43 (describing method embodiment, without any server transmission operation), Fig. 3; *but see id.*, ¶¶ 9, 31 (describing system embodiment with a server transmission). That Petitioner would even dispute, as in Reply, that its relied-upon disclosures are not from distinct embodiments, defies credulity. *See, e.g.*, Response, 32; *but see* Reply, 10 (misstating “Patent Owner’s only basis for contending that Rector’s teachings are distinct”).

Rector’s method embodiment requires that a smart vehicle execute each of its method steps, including a smart vehicle determining a driver’s identity (S350), a smart vehicle consulting a database to look up and determine a driver’s settings (S351), and a smart vehicle re-consulting that database to determine whether a detected attempted change in setting is permitted or prohibited (S353, S354). EX1006, ¶ 43; Response, 17-28. Not one of *Rector*’s method steps is executed by a server. EX1006, ¶ 43; Response, 28-30. By contrast, *Rector*’s system embodiment

requires that a server determine the permitted settings for the user, and transmit the permitted settings to the client logic of the smart vehicle. EX1006, ¶ 9; Response, 17-28, 28-30. *Rector's* method and system embodiments are not only distinct, but each embodiment requires different elements to perform different functions. *Id.*



Response, 32; and see, e.g.: *id.*, 31:



Accordingly, all grounds fail because there is no dispute that the Petition combined and modified *Rector's* embodiments for alleged disclosure of independent claim limitations 1[c] and 17[c], and as confirmed by Petitioner's silence in Reply, the Petition never made any "showing of a suggestion or motivation to modify the teachings of" *Rector*. See *id.*; see also *Pers. Web. Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 991 (Fed. Cir. 2017) (obviousness finding requires the Board to find that a POSITA would have been motivated to combine

the prior art in the way claimed by the patented claims at issue and had a reasonable expectation of success in doing so); *Cisco Sys., Inc. v. Bockstar Techs. LLC*, IPR2014-01192, Paper 10 at 13 (P.T.A.B. Feb. 2, 2015) (“Petitioner has not explained how or why a person having ordinary skill in the art would modify the Multigigabit Router” to use features of that reference’s Netstar GigaRouter).

In Reply, Petitioner remains completely silent as to its failure to show any suggestion or motivation to combine and modify the embodiments of *Rector*. Petitioner does not even attempt to excuse its legal failures, but presents red herring arguments that are irrelevant, as discussed below.

A. *Rector*’s smart vehicle executes each step of the method embodiment—by contrast, the server’s only involvement is to store a set of identifiers for the smart vehicle to look-up; thus *Rector* fails as to elements 1[c] and 17[c].

Petitioner’s first red herring argument is the undisputed and unhelpful point that *Rector*’s method embodiment, disclosed in paragraph 43, involves a server. Reply, 10. But not the server as claimed: As detailed in the Response, *Rector*’s method embodiment requires its “smart vehicle” to execute each step of the method, whereas the server’s *involvement* in that method is limited to storing “a set of unique identifiers.” Response, 20-28; EX1006, ¶ 43 (“... the smart vehicle compares the unique identifier with a set of unique identifiers stored on a memory on the smart vehicle. Alternatively, the unique identifier may be compared with *a set of unique*

identifiers on a server on a network”). As shown by the Response, *Rector*’s method teaches that the “smart vehicle compares the unique identifier with a set of unique identifiers,” which are stored either “on a memory of the smart vehicle,” or “alternatively,” are stored “on a server on a network.” Response, 23-24; EX1006, ¶ 43. Either way, *Rector* makes clear that it is the smart vehicle that is performing this “comparing” operation, which is how the “smart vehicle determines the identity of the driver S351.” *Id.*

In Reply, however, Petitioner attempts to sidestep its failures by now imagining that paragraph 43’s use of the word “alternatively” somehow discloses a server operation that is not there. Reply, 14-16. *Rector* explicitly teaches ***the smart vehicle*** as executing each step of the method embodiment, and further describes *how* the smart vehicle executes each step. The method starts with the smart vehicle executing step S350:

FIG. 3 shows a method of controlling a driver's settings on a smart vehicle, according to an exemplary embodiment of the present invention. In this embodiment, the method begins with ***the smart vehicle communicating*** with a driver's device ***S350***. ...

EX1006, ¶ 43.

Rector's method goes on to describe step S350, i.e., how and why the smart vehicle communicates with the wireless communication device:

The smart vehicle communicates with the wireless communication device ... to request a unique identifier for the driver's wireless communication device. ... The unique identifier is associated with a user of the smart vehicle.

Id.

Rector next discloses that the smart vehicle executes step S351, i.e., the smart vehicle determines the identity of the driver:

With the unique identifier, *the smart vehicle determines the identity of the driver S351.*

Id.

Rector's method goes on to describe *how* the smart vehicle executes step S351, i.e., the two different ways in which *the smart vehicle* compares the unique identifier against a set of unique identifiers to “determine[] the identity of the driver.” *Id.*

A client logic and processor *on the smart vehicle compares the unique identifier with a set of unique identifiers stored on a memory of the smart vehicle.*

Alternatively, *the unique identifier may be compared with a set of unique identifiers on a server* on a network.

Id. While Petitioner now contends, without evidence, that this “alternative” way that the smart vehicle determines the identity of the driver somehow implicates a server transferring operation, *Rector* itself discloses the opposite. As explained in the Response, it is the client logic and processor *on the smart vehicle* that compares the unique identifier with a set of unique identifiers, in one of two ways—(1) comparing the unique ID with the set of unique IDs that are either stored on a memory of the smart vehicle, or (2) alternatively, comparing the unique ID with a set of unique IDs stored on a server on a network. *Id.* *Rector*’s method, described at paragraph 43, couldn’t be clearer in stating that “the smart vehicle determines the identity of the driver.” *Id.* Therefore, the underlying comparison function is executed by the client logic and processor *on the smart vehicle*. The smart vehicle’s client logic can perform the comparison function in two ways, but regardless of which, it is *the smart vehicle* executing each operation of *Rector*’s method, not a server. *Id.* And if, somehow, *Rector*’s description at paragraph 43 were not sufficiently clear (it is), *Rector* further affirms that in *all of its described embodiments*, it is the client logic of the smart vehicle that performs this operation to determine a driver’s identity. *E.g., id.*, ¶ 57 (“As described in the embodiments above, client logic 905 determines that the unique identifier corresponds to a driver’s identity”). Accordingly, the

Reply's effort to invent server operations in paragraph 43, though there are none, is proved by *Rector* itself to be a fiction.

Ultimately, that a server is involved in *Rector*'s method embodiment—i.e., to store a set of unique identifiers—is of no consequence, since *Rector*'s method never discloses or suggests the claims' recited transferring operation “by the server” (claims 1[c], 17[c]) and the Petition failed to provide any rationale to combine the teachings of *Rector*'s method embodiment (paragraph 43) with the relied-upon server operations of *Rector*'s system embodiment (paragraph 9). Response, 17-37; EX1006, ¶ 43, *but see id.*, ¶ 9. What *Rector*'s disparate disclosures could include or would be capable of fails to show “why one skilled in the art would have found it obvious to combine those teachings.” *See, e.g., Abiomed*, Paper 9 at 9, 11; Response, 28-41.

Indeed, *Rector*'s method embodiment never teaches or suggests *any* server transferring operation, and in fact the method relies *exclusively* on the smart vehicle to look up and determine settings, thereby discouraging any combination in which a server would somehow also transfer the already-looked-up settings. Response, 28-30. As shown by Patent Owner, *Rector* requires the smart vehicle to consult a database to look up and determine settings for a driver, and subsequently—when an attempted change in setting is detected by the vehicle—the smart vehicle again re-consults that database to “determine[] whether the attempted change of the

setting is permitted S354.” *Id.* (quoting EX1006, ¶ 43). As shown in the Response, it would be nonsensical to combine this method embodiment (*id.*, ¶ 43) with *Rector*’s system embodiment (*id.*, 9), wherein *Rector* dictates that a server will “determine settings for a user,” then transmit those settings to the smart vehicle. EX1006, ¶ 9; Response, 28-40. Apart from impermissibly using the patented claims as a roadmap, therefore, neither the Petition nor Reply offers any reason why a POSITA would combine the two embodiments of *Rector*, especially where doing so would irrationally duplicate the very operations already achieved by the smart vehicle in *Rector*’s method embodiment. *Id.*

B. In Reply, Petitioner relies on various red herring arguments to detract from its failure to show any motivation to combine *Rector*’s embodiments nor any reasonable expectation of success—failures which are fatal to all grounds of the Petition.

Petitioner argues in Reply, for example, that “nothing in *Rector* requires its teachings to be viewed separately” and the relied-upon embodiments are “not mutually exclusive.” Reply, 1, 11. These arguments improperly impute Petitioner’s failures of proof onto Patent Owner, and more fundamentally, are incorrect under the law. The Response detailed how the Petition relied on disparate disclosures from distinct embodiments for alleged disclosure of at least claims 1[c] and 17[c], and *it is the Petition’s burden* to show “a suggestion or motivation to modify the teachings of that reference” and that a POSITA would have had a reasonable

expectation of success in doing so. *See, e.g., Abiomed*, Paper 9, at 9, 11; *In re Kotzab*, 217 F.3d at 1370; *Pers. Web. Techs.*, 848 F.3d at 991; *Cisco Systems*, Paper 10 at 13; *Aptiv Servs. US, LLC v. Microchip Tech. Inc.*, IPR2024-00803, Paper 10, at 26-27 (P.T.A.B. Nov. 7, 2024); *Olympia Tools Int’l, Inc. v. JPW Indus., Inc.*, IPR2018-00388, Paper 8, at 22 (P.T.A.B. June 20, 2018). The law does not, as Petitioner misstates, put the onus on patent owners to show that a reference “requires its teachings to be viewed separately” nor that relied-upon embodiments are “mutually exclusive.” Reply, 1, 11.

However, notwithstanding Petitioner’s failure, Patent Owner *did show* that the Petition’s proposed modification and combination of *Rector*’s embodiments are incompatible and nonsensically duplicative. Response, 28-40. For example, the Response showed that (1) *Rector*’s method actually discourages any server transferring of settings (EX2003, ¶ 66; *see also* Response, 28-30), (2) *Rector* offers no indication that its method remains operable if its steps are swapped or supplemented with the system embodiment components selectively plucked by the Petition (*id.*, 34), (3) combining the two embodiments as proposed would result in nonsensical redundancies—e.g., both a server and a smart vehicle determining settings—that would render relied upon steps of *Rector*’s method completely meaningless (*id.*, 35-37), and (4) there is no reason to conclude that a POSITA would have had a reasonable expectation of success in combining the relied-upon

embodiments (*id.*, 38-40). Therefore, while it is not the burden of Patent Owner to show reasons why a POSITA *would not* be motivated to combine or modify the embodiments as the Petition proposes, Patent Owner actually did make that showing.

Likewise, the Reply's reliance on *Rector*, paragraph 29, is of no avail. Reply, 13. Far from promising equivalence throughout the reference for every structure or function, as Petitioner suggests, *Rector* acknowledges that the functions of various elements may work for one embodiment but result in a conflicting description for another embodiment. EX1006, ¶ 29. This disclosure not only highlights the deficiencies of the Petition, but also highlights that Petitioner failed to disclose its reliance on features from different embodiments, let alone make the required showing of a suggestion or motivation to combine distinct embodiments. *Id.*

Equally unavailing is Petitioner's citation to *Oatey v. IPS Corp.*, 514 F.3d 1271, 1276 (Fed. Cir. 2008), as no party is seeking to construe claim terms of *Rector*, a patent application, nor apply any alleged "disclaimer" to this patent application. Reply, 12-13. As shown in the Response, each of *Rector*'s method embodiment steps is executed by a smart vehicle, not a server. Response, 22-28; EX1006, ¶ 43. The Petition misstates that steps of *Rector*'s method are performed by a server—they are not. *E.g.*, Pet., 13. The Petition's relied-upon server operations are taken from *Rector*'s system embodiment (e.g., *id.*, ¶ 9). *Rector* is

unambiguous in distinguishing between these embodiments, and therefore no such construction is required, as Petition suggests. Reply, 11-12; *but see* Response, 20-28, 30-38.

Likewise inapposite are the actions of an Examiner in reviewing the *Rector* application. Reply, 13. The prosecution history of *Rector* cannot and does not excuse Petitioner’s failure to support even a prima facie case of obviousness: the Petition failed to offer any motivation to combine *Rector*’s embodiments, any motivation to modify either of those embodiments, or show why a POSITA would have a reasonable expectation of success in doing so. The Petition relied solely on *Rector* for alleged disclosure of the server operations of independent claim limitations 1[c] and 17[c]. Pet. 27-28. Because the Petition failed to justify its modification of *Rector*’s method embodiment—to inexplicably add on server operations from *Rector*’s system embodiment—or demonstrate any reasonable expectation of success, all grounds fail.

III. The plain and ordinary meaning of “configured to,” as used in claim limitations 1[c] and 17[c], is narrower than mere capability, and therefore all grounds fail.

If the Board agrees that “the transferring is configured to instruct” recited in independent claims 1[c] and 17[c] means “configured to” rather than the mere hypothetical “capability” relied upon by the Petition, all grounds fail and all challenged claims must be upheld. In Reply, Petitioner did not and cannot change

the fatal deficiencies of its relied-upon evidence: Dr. Almeroth’s testimony is limited to the mere “capability” of *Rector*’s disclosures, rather than the required operation of a server transferring one or more settings, “the transferring *configured to instruct*.” Indeed, the Petition is further deficient in relying on purported functionalities of how a *smart vehicle* “implements” settings, as opposed to any *server transferring* operation that is “designed, adapted or programmed” to instruct as claimed.

A. The Reply affirms that the plain and ordinary meaning of “... the transferring is configured to instruct” requires a server transferring operation that is “designed, adapted or programmed to accomplish the specified objective of the limitation.”

The Reply cannot rebut the fact that the plain and ordinary meaning of the term “the transferring is configured to instruct,” as recited in claims 1[c] and 17[c], requires that the server’s transferring operation is “configured to instruct” i.e., designed, adapted or programmed to accomplish the specified objective of the limitation: “to instruct software and/or hardware associated with said electronics of said vehicle to apply one or more settings to the vehicle for customizing said vehicle to use said one or more settings associated with the profile” (claim 1[c]) / “to instruct software and hardware associated [with] the vehicle to enable said one or more settings for use on the vehicle to customize said vehicle for the user” (claim 17[c]). EX1001, 33:23-29, 35:17-24. In Reply, Petitioner showed neither lexicography nor

disavowal, and therefore there is no reason the limitations' use of "configured to" should not be given their plain and ordinary meaning.

The claim language itself requires a narrower construction than the broad "capable of" meaning advocated by Petitioner, and the Reply offers no evidence to the contrary. Response, 5, 12-14. Moreover, as shown in the Response, "controlling case law strongly supports this result[.]" *Acclarent, Inc. v. Albritton*, IPR2017-00498, Paper 40, at 14 (P.T.A.B. July 9, 2018) (citing, e.g., *Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335, 1349 (Fed. Cir. 2012)); *ParkerVision, Inc. v. Qualcomm Inc.*, 903 F.3d 1354, 1361 (Fed. Cir. 2018); *Typhoon Touch Techs., Inc. v. Dell, Inc.*, 659 F.3d 1376, 1380 (Fed. Cir. 2011); *In re Man Mach. Interface Techs. LLC*, 822 F.3d 1282, 1285 (Fed. Cir. 2016). Accordingly, Patent Owner would have had no need to propose any construction in the parallel district court proceeding (Reply, 8-9), as the plain and ordinary meaning of "configured to," by controlling precedent, requires a narrower construction than that which Petitioner seeks to apply in this *inter partes* review. E.g., EX1005, ¶ 136 (Dr. Almeroth testifying, "Rector is thus capable of satisfying, and does satisfy, this element of claim 1."). Moreover, Patent Owner's infringement contentions are entirely consistent with this narrower construction (EX1012), and not, as the Petition argues, entirely dependent on the capabilities of *Rector*'s "smart vehicle." EX1005, ¶ 136

(citing EX1006, ¶¶ 23, 31-34, 38, 43, 57, 59) (relied-upon citations of *Rector* reciting various *smart vehicle* functionalities, but no server transferring operation).

Petitioner confoundingly contends that this narrower construction is not germane to the server's operation of "transferring" (Reply, 5-6), as recited in claim limitations 1[c] and 17[c], but the express language of the claims proves Petitioner wrong: it is precisely "*the transferring*" *by the server* that must be "configured to instruct." EX1001, 33:23-29, 35:17-24.

First, independent claim 1[c] recites:

transferring, by the server, ... the transferring is configured to instruct software and/or hardware associated with said electronics of the vehicle to apply said one or more settings to the vehicle for customizing said vehicle to use said one or more settings associated with the profile;

Likewise, independent claim 17[c] recites:

transferring, by one of the servers ... the transferring is configured to instruct software and hardware associated the vehicle to enable said one or more settings for use on the vehicle to customize said vehicle for the user ...

EX1001, claim 1[c], claim 17[c].

Indeed, each of the specification examples cited in Reply only highlights the narrower construction required by the claims' express language and Federal Circuit precedent. Reply, 6-7. Petitioner fails to explain how any one of the cited specification examples could be performed without the server transferring operation being *configured* "to instruct software and/or hardware associated with said electronics of said vehicle to apply one or more settings to the vehicle for customizing said vehicle to use said one or more settings associated with the profile." *Id.*; EX1001, claim 1[c], claim 17[c]. In *Rector*, the alleged transferring does not do the instructing : The smart vehicle does it on its own.

Indeed, the specification underscores the distinctions between the recited claims and *Rector*, whose method depends on a "smart vehicle" to execute relied-upon operations. Response, 17-28. Whereas, by the claims of the '244 patent, it is the *server* itself which "seamlessly transfer[s]" the user's custom configuration of settings, *regardless of vehicle type*, e.g., utilizing a mapping engine to achieve that custom configuration. Response, 7-8, 10, 15-16, 42-43. As demonstrated in the Response, and confirmed by the specification examples cited in Reply, the inventions of the '244 patent can achieve this customization, "regardless of the vehicle that the user chooses to drive," because the server's transfer operation "is configured to instruct software and/or hardware ... of the vehicle to apply one or

more settings to the vehicle for customizing said vehicle to use said one or more settings associated with the profile.” *Id.*; EX1001, claim 1[c].

B. All grounds fail because Petitioner failed to show that *Rector*, relied-upon alone for alleged disclosure of limitations 1[c] and 17[c], renders obvious the recited “configured to” limitations.

Nothing in Reply rebuts the Response’s detailed demonstration that *Rector* fails to teach or suggest any server transferring one or more settings to the vehicle where “*the* transferring is configured to instruct software and/or hardware ... of the vehicle to apply said one or more settings to the vehicle for customizing said vehicle to use said one or more settings associated with the profile.” Response, 41-47. The Petition relied on *Rector*’s various functionalities of its “smart vehicle” to conclude that the hardware/software of the smart vehicle “implements” settings, and somehow from this premise, Petitioner made the non sequitur leap that these smart vehicle functionalities are “capable of satisfying” the recited “configured to” limitations. EX1005, ¶ 136. However, what the *smart vehicle* is “capable of” is wholly irrelevant to the patentability of the challenged claims because: (1) the claims’ operation that is “configured to instruct” is the “*transferring, by the server*” (claim 1[c] / claim 17[c]), not any smart vehicle operation, i.e., the relied-upon smart vehicle’s “implementation” of settings, as in *Rector*; and (2) the independent claims’ limitation’s recitation of “configured to” is, by its express language and controlling precedent, undeniably narrower than mere *capability*. EX1005, ¶ 136.

As shown in the Response, not one of the Petition's relied upon citations discloses, teaches or even suggests any *server operation* of transferring settings, wherein "*the transferring*" is *designed, adapted or programmed* "to instruct the hardware/software associated with the electronics of the vehicle to apply said one or more settings to the vehicle for customizing said vehicle to use said one or more settings associated with the profile." EX1005, ¶ 136 (citing EX1006, ¶¶ 23, 31-34, 38, 43, 57, 59); *but see* EX1001, claim 1[c], claim 17[c]. Repeatedly, Petitioner's expert cites *Rector's* disclosures regarding its *smart vehicle's client logic* and then inexplicably concludes that the reference is "capable of" satisfying, and does satisfy, the required "configured to" limitations specific to the claims' recited *server transferring operation*. EX1005, ¶ 136. For example, Dr. Almeroth testifies that *Rector*, at paragraph 23, discloses the "claimed transferring step," and yet paragraph 23 neither mentions nor suggests any server involvement whatsoever. *Id.*; EX1006, ¶ 23. Likewise, paragraphs 31-34, 43, 57, and 59 of *Rector* never even suggest *any* server transferring operation, nor does *Rector's* passing mention of an "upload" in paragraph 38 disclose or suggest the required server "transferring is configured to instruct software and/or hardware associated with said electronics of the vehicle to apply said one or more settings to the vehicle for customizing said vehicle to use said one or more settings associated with the profile." EX1005, ¶ 136 (citing EX1006, ¶¶ 23, 31-34, 38, 43, 57, 59); EX1001, claim 1[c].

In Reply, Petitioner does nothing to rehabilitate the deficiencies of *Rector*'s relied-upon disclosures. Instead, Petitioner fixates on “causation”—an irrelevant argument since not one of the cited *Rector* disclosures suggest that any server “transferring” operation *causes* “software and/or hardware associated with said electronics of the vehicle to apply said one or more settings to the vehicle for customizing said vehicle to use said one or more settings associated with the profile.” *Id.* Nor does Dr. Almeroth ever mention “causation,” or otherwise offer any opinion that *Rector* somehow discloses any such “causation.” EX1005, ¶ 136. It does not.

Accordingly, all grounds fail since Petitioner failed to offer any evidence showing that *Rector* discloses or suggests a server transferring operation where “the transferring is configured to instruct”—that is, the transferring is *designed, adapted or programmed to instruct*—“software and/or hardware associated with said electronics of the vehicle to apply said one or more settings to the vehicle for customizing said vehicle to use said one or more settings associated with the profile” (claim 1[c]) / “the transferring is configured to instruct software and hardware associated with the vehicle to enable said one or more settings for use on the vehicle to customize said vehicle for the user” (claim 17[c]).

IV. All grounds fail because *Rector* is not properly combined with *Kleve*, and Petitioner fails to rebut Dr. Malek’s showing that there is no motivation to combine the references as proposed.

Petitioner leaves un rebutted Patent Owner’s showing that the smart vehicle-verification disclosed by *Rector* would be rendered *less secure* by modifying *Rector*’s smart-vehicle-executed method to include *Kleve*’s server-side verification, as Petitioners propose. EX2003, ¶¶ 78-79. In Reply, Petitioner failed to rebut evidence showing that no POSITA would be motivated to introduce the less secure, server-side system of *Kleve* as “additional security” to *Rector*’s more secure, fully-localized system, since doing so would render *Rector*’s system more vulnerable to security attacks. EX2003, ¶¶ 78-79; Response, 51-53. Instead, Petitioner misstates the teachings of *Kleve* to suggest that the Response and Dr. Malek’s testimony are both “directly contrary to the express teachings of *Kleve*[.]” Reply, 22 (citing ID at 33).

Dr. Malek’s testimony—that a local, client-side verification is rendered more vulnerable to security attacks by introducing a remote, server-side verification—is in no way undermined by *Kleve*. EX2003, ¶¶ 78-79. Indeed, *Kleve* itself teaches that a server conducts *both* the initial credential authorization, and for “additional security,” a server may perform remote credential verification. EX1006, ¶¶ 48-49. Contrary to the argument in Reply, *Kleve* is not *introducing* server-side verification for “additional security,” as Petitioner would have the Board believe is “contrary”

to Dr. Malek’s opinion. Reply, 22 (citing ID at 33). Instead, *Kleve* already teaches the use of a server-side credential authorization as a step (EX1006, ¶ 48) **before** a server performs remote credential verification for “additional security” (*id.*, ¶ 49). By contrast to *Kleve*—which re-teaches the use of a server for two steps of verification—Dr. Almeroth improperly *introduces* server-side verification from *Kleve* to *Rector*’s wholly localized, client-side method embodiment, which relies solely on a smart vehicle to check a driver’s identity. EX2003, ¶¶ 78-79.

Kleve’s system in no way contradicts the impropriety of this combination, as shown by Dr. Malek, since *Kleve* is not introducing server-side verification as “additional security” to a local, client-side verification system as Petitioner argues, but is instead merely repeating the teaching that a server can be used for **both** the initial “credential authorization,” and, for “additional security” a server may likewise perform a second credential verification. EX1007, ¶¶ 48-49.

Kleve itself is explicit that a server may perform ***the initial virtual key credential authorization***.

The 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.

Id., ¶ 48. By adding another level of server-side verification as “additional security,” *Kleve* repeats the very elements that perform the initial credential authorization. *Id.*, ¶ 49.

The system may be further extended to facilitate the virtual key *with additional security by requiring remote credential verification at the vehicle.* ... The remote credential verification may be done by the VCS, *using a server*, or allowing the Owner to verify the Temporary User’s request. For example ... 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. It is only after, and *in addition to*, teaching that a server may already perform the initial credential authorization that *Kleve* further teaches a server may perform a second credential verification as “*additional security.*” *Id.*, ¶ 49.

Therefore, *Kleve* does not contradict, but in fact bolsters, the distinctions between *Rector* and *Kleve*, as highlighted by Dr. Malek. EX2003, ¶¶ 78-79. Unlike

Kleve's two layers of credential verification, each explicitly teaching the use of a server for both the initial and "additional security" verification layer (*id.*, ¶¶ 48-49), *Rector*'s method teaches a smart vehicle, alone, to determine driver identity, and is therefore fully local, client-side verification only (EX1006, ¶ 43). Petitioner does not dispute that such a localized, client-side verification would be rendered more vulnerable to security attacks, and therefore less secure, by the *introduction* of a server-side verification, as proposed by Dr. Almeroth.

A POSITA would not have been motivated to modify *Rector*'s method to include server-side verification, for "additional security," as *Rector* already uses the more secure client-side verification. EX2003, ¶ 79. The Petition relies on this improper combination of *Rector* and *Kleve* for independent claim elements 1[b] and 17[b]. Accordingly, all grounds fail and all claims must be upheld.

V. Conclusion

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

Dated: June 20, 2025

Respectfully submitted,

/Jerry D. Tice II/

Jerry D. Tice II

Reg. No. 73,582 (Lead counsel)

Aaron R. Hand

Reg. No. 80,694 (Back-up counsel)

Brenda Entzminger

Reg. No. 76,896 (Back-up counsel)

BUNSOW DE MORY LLP

701 El Camino Real

Redwood City, CA 94063

Telephone: 650-318-6774

Facsimile: 415-426-4744

jtice@bdiplaw.com

bentzminger@bdiplaw.com

Counsel for Patent Owner

37 C.F.R. §42.24(d) CERTIFICATION

The undersigned hereby certifies that this submission, excluding the tables of contents, certificate of word count, exhibit list, and certificate of service, contains 5,597 words, as determined using the standard word counting feature of the Microsoft Word program.

Dated: June 20, 2025

/Jerry D. Tice II/

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Reg. No. 73,582 (Lead counsel)

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Reg. No. 80,694 (Back-up counsel)

Brenda Entzminger

Reg. No. 76,896 (Back-up counsel)

BUNSOW DE MORY LLP

701 El Camino Real

Redwood City, CA 94063

Telephone: 650-318-6774

Facsimile: 415-426-4744

jtice@bdiplaw.com

bentzminger@bdiplaw.com

Counsel for Patent Owner

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 June 20, 2025, a copy of the foregoing document was served by email upon the following counsel at the below email addresses:

Finnegan, Henderson, Farabow, Garrett & Dunner LLP
Joshua L. Goldberg – joshua.goldberg@finnegan.com
James R. Barney - james.barney@finnegan.com
Aidan Skoyles - aidan.skoyles@finnegan.com
Nicholas Eitsert - nicholas.eitsert@finnegan.com
Ryan Davies - ryan.davies@finnegan.com

Dated: June 20, 2025

/Jerry D. Tice II/

Jerry D. Tice II
Reg. No. 73,582 (Lead counsel)
Brenda Entzminger
Reg. No. 76,896 (Back-up counsel)
BUNSOW DE MORY LLP
701 El Camino Real
Redwood City, CA 94063
Telephone: 650-318-6774
Facsimile: 415-426-4744
jtice@bdiplaw.com
bentzminger@bdiplaw.com

Counsel for Patent Owner