

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLKSWAGEN GROUP OF AMERICA, INC.,

Petitioner,

v.

LONGHORN AUTOMOTIVE GROUP LLC,

Patent Owner.

Patent No. 8,085,192

Filing Date: April 5, 2010

Issue Date: December 27, 2011

Inventor: Leigh M. Rothschild

Title: DEVICE, SYSTEM AND METHOD FOR CONTROLLING
AND STORING SENSITIVE INFORMATION ON A GPS DEVICE

PATENT OWNER'S PRELIMINARY RESPONSE

Case No. IPR2025-00925

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2001	Fourth Amended Docket Control Order, Dkt. 58, <i>Longhorn Automotive Group LLC v. Volkswagen AG</i> , Case No. 2:24-cv-00933-JRG (E.D. Tex. May 15, 2025)
2002	Longhorn Automotive Group LLC's Infringement Contentions and P.R. 3-1 and 3-2 Disclosures in <i>Longhorn Automotive Group LLC v. Volkswagen AG</i> , Case No. 2:24-cv-00933-JRG (E.D. Tex.), dated April 4, 2025

I. INTRODUCTION

On April 24, 2025, Volkswagen Group of America, Inc. (“Petitioner” or “VW”) submitted a Petition (Paper 1, “Petition” or “Pet.”) to institute *inter partes* review (“IPR”) of U.S. Patent No. 8,085,192 (Ex. 1001, the “’192 Patent”), challenging Claims 1-22 (the “Challenged Claims”). The Petition asserts that Claims 1, 11-14, and 19-22 are rendered obvious over U.S. Patent No. 6,490,513 to Fish et al. (Ex. 1004 or “Fish”); Claims 2-4 and 15-17 are rendered obvious over Fish in view of U.S. Patent Application Publication No. US 2004/0103288 to Ziv et al. (Ex. 1005 or “Ziv”); Claims 5-8 and 18 are rendered obvious over Fish in view of Ziv and U.S. Patent No. 6,310,542 to Gehlot (Ex. 1006 or “Gehlot”); and Claims 9 and 10 are rendered obvious over Fish in view of Ziv, Gehlot, and European Patent Application No. EP 0 962 894 A2 to Stevenson (Ex. 1007 or “Stevenson”) (Pet. 2). The Board should deny the Petition for at least the reasons described briefly below.

First, regarding Claim 1, Petitioner fails to demonstrate in each of the four Grounds to sufficiently show that any of the references or combinations disclose or render obvious the limitation “at least one route traveled by the device.” The Fish reference does not disclose “at least one route traveled by the device,” and the disclosures Petitioner relies upon does not support its arguments. Further, the Petition is deficient because there is no likelihood of demonstrating a reasonable

expectation of success for the Fish reference or combinations depending on the Fish reference. Petitioner presents no real expert testimony on expectation of success, and Petitioner's purported reliance on its expert to address deficiencies in the references is improper under the July 31, 2025 Memorandum from the Acting Director of the United States Patent and Trademark Office. Petitioner's expert submits a copy-cat Declaration restating the same paragraphs of conclusory, unsupportable attorney argument and this "general knowledge" cannot be used to fill in missing limitations in the claims.

Second, the Board should exercise its discretion to deny the Petition under 35 U.S.C. § 314(a). The Petition identifies co-pending district court litigation *Longhorn Auto. Grp. LLC v. Volkswagen AG*, Case No. 2:24-cv-00933-JRG (E.D. Tex.) ("District Court Litigation") with a trial date set for August 17, 2026. With Patent Owner's Preliminary Response due August 25, 2025, institution of any grounds will result in the issuance of a Final Written Decision ("FWD") by November 25, 2026. The Board should exercise discretion to deny the Petition under 35 U.S.C. § 314(a) for at least the following reasons: (i) the parallel District Court Litigation exists between the same parties or real-parties-in-interest; (ii) the District Court Litigation involves the same subject patent (the '192 Patent) with substantially the same claims; (iii) the District Court's trial will be *over three months* before the projected statutory

deadline for FWD; (iv) the parties have invested in the District Court Litigation with the a trial date set for August 16, 2026; and (v) there is no stay of the parallel District Court Litigation, and Petitioner has not sought a stay. Accordingly, the Board should exercise discretion to deny the Petition.

II. CLAIM CONSTRUCTION

For purposes of this Preliminary Response, Patent Owner does not adopt any meanings other than the plain and ordinary meaning of terms not identified by Petitioner.

III. LEVEL OF SKILL IN THE ART

For the purposes of this Preliminary Response only, Patent Owner utilizes Petitioner's proposed level of skill in the art: "at least a four-year degree in electrical engineering or a closely related field, and at least two years of experience with navigation systems, or an equivalent advanced education in the field of navigation systems. Additional education could substitute for professional experience and vice versa." Pet. at 19-20.

IV. PETITIONER HAS NOT DEMONSTRATED A REASONABLE LIKELIHOOD OF SUCCESS FOR THE GROUNDS ADVANCED IN THE PETITION, AND THE PETITION SHOULD BE DENIED

The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art, (2) any

differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) so-called secondary considerations where in evidence. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537 (Fed. Cir. 1983).

The Board has held that a failure to identify the differences between the claimed subject matter and the prior art is fatal to an obviousness challenge. *See Apple, Inc. v. Contentguard Holdings, Inc.*, IPR2015-00355, Decision Denying Institution of *Inter Partes Review*, Paper 9 at 9-10 (P.T.A.B. June 26, 2015) (denying institution for failure to identify the differences between the claimed subject matter and the prior art).

In arriving at an obviousness determination, the Board must sufficiently explain and support the conclusions that the prior art references disclose all the elements recited in the Challenged Claims and a relevant, skilled artisan not only could have made, but would have been motivated to combine all the prior art references in the way the patent claims and reasonably expected success. *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017). That is, even if

all the claim elements are found across a number of references, an obviousness determination must consider whether a person of ordinary skill in the art would have the motivation to combine those references. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1368 (Fed. Cir. 2016); *Los Angeles Biomedical Rsch. Inst. at Harbor-UCLA Med. Ctr. v. Eli Lilly & Co.*, 849 F.3d 1049, 1067 (Fed. Cir. 2017) (vacating and remanding an obviousness determination, in part, because the Board did not make factual finding as to whether there was an apparent reason to combine all three prior art references to achieve the claimed invention and whether a person of skill in the art would have had a reasonable expectation of success from such a combination). This combinability determination, as supported by an articulated motivation to combine, requires a plausible rationale as to why those prior art references would have worked together. *Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1335 (Fed. Cir. 2013). Absent some articulated rationale, a “common sense” finding is no different than the conclusory statement “would have been obvious.” *In re Van Os*, 844 F.3d 1359, 1361 (Fed. Cir. 2017). Of additional importance, “knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references” *Innogenetics, N.V. v. Abbott Lab’ys.*, 512 F.3d 1363, 1373 (Fed. Cir. 2008).

To demonstrate inherent obviousness, an inherent limitation must necessarily

be present in the combination of references. *See Pers. Web Techs., LLC v. Apple, Inc.*, 917 F.3d 1376 (Fed. Cir. 2019); *LBT IP I LLC v. Apple Inc.*, No. 2022-1613, 2023 WL 3914920, at *3 (Fed. Cir. June 9, 2023). It is not enough to merely show that it is likely to be present. *Id.*

A. Claims 1, 11-14, and 19-22 Are Not Rendered Obvious By Fish Because the Petition Fails to Disclose or Suggest “at least one route traveled by the device”

Petitioner fails to show how Fish alone or in combination teaches or suggests the claimed features of Claims 1, 11-14, and 19-22, and specifically, does not teach or suggest “at least one route traveled by the device.”

The '192 Patent describes a “system and method of saving information on a global positioning system (GPS) device in a secure fashion which will only allow designated users access to the information.” '192 Patent, 1:59-61. For example, Claim 1 recites “a locational information module for determining location information of the device, the determined location information being **at least one route traveled by the device.**” (emphasis added.) Independent Claims 13, 19, and 22 recite the same limitation.

Fish describes a “data archive system for securely archiving signals and, more particularly, to a mobile data archive system which authenticates and records operational and situational data concerning a[] vehicle.” Ex. 1004, 1:6-9. The

“vehicle data archive system (VDAS)” is described as including “ a satellite signal source 20, a trusted third party (TTP) 15, a service provider 13 which may also serve as a proxy for the TTP 15, **a data archive 10 located in a vehicle 5**, and vehicle data sensors, generally designated 12.” *Id.*, 2:45-52 (emphasis added).

Petitioner submits that a “POSITA would have understood that by storing location data collected at predetermined time intervals, the resulting data provides the route traveled by the device.” Pet. at 33. However, Fish discloses the GPS receiver which “provides both locational and temporal signals” receives “a GPS signal for identifying the latitudinal and longitudinal coordinates of the data archive.” Ex. 1004, 7:42-47. However, this information requires that the secure memory is “preloaded with cartographic content” which can then translate to a geographical location and only when the secure memory is preloaded with cartographic content can “the position of the vehicle be indicated textually, with reference to particular roadways.” *Id.*, 7:48-49; 56-58. Fish therefore discloses vehicle signals, such as “speed data and operational details such as the pressure on the accelerator pedal and brake pedal and the direction of the steering wheel.” *Id.*, 11:8-11. However, the “time, location, and direction data ***can be derived from the data provided by GPS receiver.***” *Id.*, 11:12-14 (emphasis added).

Fish does not disclose, nor does Petitioner claim, “at least one route traveled

by the device,” but rather, “locational and temporal signals” that must be coordinated with cartographic content to determine a location. Pet. at 42. Fish further discloses “latitude and longitude values derived from the GPS signal,” but such signals are not a “route traveled by the device.” While Petitioner points to Fish’s disclosure of “time, location, and direction data,” these “sensory data” is not a route. Rather, Fish discloses that it is necessary to preload cartographic content to “identify cartographic locations,” as conceded by Petitioner. Pet. at 34. This is unnecessary to the purpose of the invention described: “securely and reliably record and authenticate the signals of a plurality of motor vehicle sensory devices so that the *conditions* leading up to a motor vehicle accident can be more readily identified.” The route would be unnecessary to such a purpose.

Petitioner’s expert provides no evidence or explanation to support Petitioner’s conclusions. Substantively, Dr. Michalson’s testimony is a near complete copy of the Petition. *Compare* Pet. at 35-37 with Ex. 1002, ¶¶ [164]-[167]. Dr. Michalson’s Declaration provides nothing more than mirror attorney argument, as submitted in the Petition, and should be given no weight. Further, Petitioner should not be permitted to supplement missing limitations with conclusory expert opinions.

Pursuant to 35 U.S.C. § 312(a)(3), an IPR Petition must identify “in writing and with particularity, each claim challenged, the grounds on which the challenge to

each claim is based, and the evidence that supports the grounds for the challenge to each claim.” Further, Rule 104(b)(4), an IPR Petition “must specify where each element of the claim is found in the prior art patents or printed publications relied upon.” Under the July 31, 2025 Memorandum, “expert testimony, common sense, and other evidence that is not ‘prior art consistent of patents or printed publications’ (collectively, ‘general knowledge’) *may not be used to supply a missing claim limitation.*”

https://www.uspto.gov/sites/default/files/documents/aapa_memo_final__signed.pdf?utm_campaign=subscriptioncenter&utm_content=&utm_medium=email&utm_name=&utm_source=govdelivery&utm_term=. Here, Petitioner does just that. For example, Petitioner submits that “[a] POSITA would have understood that by storing location data collected at predetermined time intervals, the resulting data provides the route traveled by the device.” Pet at 33. Petitioner relies on general knowledge to supply the missing claim limitation, “at least one route traveled by the device.” The Board should reject Petitioner’s conclusory statements under the July 31, 2025 Memorandum.

Accordingly, because the “at least one route traveled by the device” is required by each and every independent claim, Petitioner has failed to show a reasonable likelihood of success as to Claims 1, 11-14, and 19-22, and the Petition

should be denied.

B. Claims 2-4 and 15-17 Are Not Rendered Obvious By Ground 2

Petitioner fails to show how Fish in combination with Ziv teaches or suggests the claimed features of Claims 2-4 and 15-17.

Like Ground 1, Petitioner relies on general knowledge to supplant limitations that are not explicitly met by the Fish and Ziv references. For example, Petitioner submits that a “POSITA would have found it obvious to use *Fish*’s password for other data security purposes,” despite Fish’s disclosure of a password for *deleting* data stored on the VDAS. Petitioner does not point to any disclosure in Fish or Ziv to support its conclusion. Petitioner’s reliance on general knowledge is improper. Petitioner has failed to show a reasonable likelihood of success as to Claims 1, 11-14, and 19-22, and the Petition should be denied.

C. Claims 5-8 and 18 Are Not Rendered Obvious By Ground 3

Petitioner fails to show that Fish in view of Ziv and Gehlot teaches or suggests the claimed features of Claims 5-8 and 18.

Like Grounds 1 and 2, Petitioner improperly relies on general knowledge to address missing limitations in the references. For example, Petitioner submits that “[i]mplementing *Gehlot*’s biometric user identification components and/or methods in the combination of *Fish* and *Ziv* would have been advantageous and obvious,”

and would merely require substituting the disclosures of Gehlot with those of Fish and Ziv. Pet. at 78. Petitioner does not point to any disclosure in Fish or Ziv to support its conclusion. Petitioner's reliance on general knowledge is improper. Petitioner has failed to show a reasonable likelihood of success as to Claims 5 through 8 and 18 and the Petition should be denied.

D. Claims 9 and 10 Are Not Rendered Obvious By Ground 4

Petitioner fails to show that Fish in view of Ziv, Gehlot, and Stevenson teaches or suggests the claimed features of Claims 9 and 10.

Like Grounds 1 through 3, Petitioner improperly relies on general knowledge to address missing limitations in the references. For example, Petitioner submits that it would have been "beneficial and obvious" to combine the disclosures of these references because they disclose "user authentication or authorization." Pet. at 83-84. Petitioner and Dr. Michaelson conclude that using Stevenson's techniques 'could be used instead of, or in addition to, *Gehlot's*, which would enhance flexibility." *Id.* at 84. However, the invention of Gehlot relates to an "improved vehicle entry/exit control system," for "controlling entry/exit of vehicles to a restricted area." Ex. 1007, ¶¶ [0004]-[0005]. The claimed "identity capture device" functions to verify the identity of the user of the device, wherein the "identity capture device" is used to "decrypt information on the storage module" or access information securely stored

in the storage module. '192 Patent, 5:66-6:7.

Petitioner does not point to any disclosure in Stevenson to support its conclusion and Petitioner's reliance on general knowledge is improper. Petitioner has failed to show a reasonable likelihood of success as to Claims 9 and 10 and the Petition should be denied.

V. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE DIRECTOR UNDER 35 U.S.C. § 314(A)

Based on Petitioner's reasons regarding § 314(a), the Board should exercise its discretion to deny this Petition.

The parallel District Court Litigation warrants denial of the Petition under the Board's precedent. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (P.T.A.B. Mar. 20, 2020) (precedential) (considering (a) "whether the petitioner and the defendant in the parallel proceeding are the same party"; (b) "overlap between issues raised in the petition and in the parallel proceeding" (c) "proximity of the court's trial date to the Board's projected statutory deadline for a final written decision"; (d) "investment in the parallel proceeding by the court and the parties"; (e) "whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted"; and (f) "other circumstances that impact the Board's exercise of discretion, including the merits.").

As set forth below, these factors collectively demonstrate that efficiency and integrity of the AIA are best served by denying review. First, the Petitioner is the Defendant in the parallel proceeding. *See infra* Section VII.A. Second, the District Court Litigation involves the same claims at issue in the Petition. *See infra* Section VII.B. Third, trial in the District Court Litigation is set for August 17, 2026, more than three months prior to the projected statutory deadline for a Final Written Decision of this Petition on November 25, 2026. *See infra* Section VII.C. Fourth, the parties (and Patent Owner in particular) have invested significant resources on developing legal and factual issues of validity and infringement in the District Court Litigation and will have invested substantially more resources before any decision on this Petition. *See infra* Section VII.D. Fifth, Defendant has not moved for a stay of the District Court Litigation, and regardless, it is likely that the Court will deny the request for a stay where there are four other asserted patents. *See infra* Section VII.E. Finally, no other factors favor institution. *See infra* Section VII.F.

Accordingly, the Board should exercise its discretion under § 314(a) and deny the Petition because institution of this proceeding would not be consistent with the objective of the AIA to “provide an effective and efficient alternative to district court litigation.” *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018) (quoting *Gen. Plastic Indus. Co. v. Canon Kabushiki*

Kaisha, IPR2016-01357, Paper 19, at 16–17 (P.T.A.B. Sept. 6, 2017) (precedential)).

A. The Parallel District Court Litigation and the Petition Involve the Same Parties

As Petitioner notes, there exists a parallel District Court Litigation between the same parties regarding the same subject patent (the '192 Patent) with substantially the same claims. Pet. at 89. Petitioner is a party to the District Court Litigation captioned as *Longhorn Auto. Grp., LLC v. Volkswagen AG*, Case No. 2:24-cv-00933-JRG (E.D. Tex.). Accordingly, this factor weighs in favor of discretionary denial.

B. The District Court Litigation Involves Substantially the Same Claims

There is substantial overlap between the claims at issue in this Petition and the District Court Litigation because the Petition challenges all but three of the claims asserted in the District Court Litigation. “In at least these ways, the parallel proceedings would duplicate effort. This is an inefficient use of Board, party, and judicial resources and raises the possibility of conflicting decisions.” *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 at 10 (P.T.A.B. May 15, 2020).

Petitioner has not submitted a *Sotera* stipulation in this case. Instead, Petitioner submits a singular statement in its Petition that: “Petitioner stipulates that, if this Petition is instituted, it will not pursue in district court the grounds identified in this Petition or grounds that could reasonably have been raised in this IPR.” Pet. at 88. Petitioner’s statement is not a formal *Sotera* stipulation.

Accordingly, this factor weighs in favor of discretionary denial.

C. Proximity of the District Court’s Trial Date

The proximity of the District Court Litigation’s trial date to the Board’s projected statutory deadline for a Final Written Decision weighs in favor of discretionary denial.

The parties’ trial is scheduled for August 17, 2026. Ex. 2001 (Fourth Amended Docket Control Order, Dkt. 58, *Longhorn Auto. Grp., LLC v. Volkswagen AG*, Case No. 2:24-cv-00933-JRG (E.D. Tex. May 15, 2025)). Pursuant to 35 U.S.C. §§ 314(b)(1) and 316(a)(11), the projected statutory deadline for a Final Written Decision of this Petition is November 25, 2026. As the District Court’s trial date will be *nearly three months before* the projected statutory deadline, this factor weighs in favor of denying institution. *See Supercell Oy v. Gree, Inc.*, IPR2020-00513, Paper 11 at 10-12 (P.T.A.B. June 24, 2020) (denying institution where the jury trial was scheduled to conclude approximately ten months before the statutory deadline);

Edward LifeSciences Corp. v. Evalve, Inc., IPR2019-01479, Paper 7 at 6-13 (P.T.A.B. Feb. 26, 2020) (denying institution where trial was scheduled to conclude “several months” before a final decision would be due); *Cisco Sys., Inc.*, IPR2020-00122, Paper 15 at 8 (“Because the trial date is substantially earlier than the projected statutory deadline for the Board’s final decision, this factor weighs in favor of discretionary denial.”); *Cisco Sys., Inc. v. Estech Sys., Inc.*, IPR2021-00329, Paper 13 at 7-15 (P.T.A.B. Jul. 6, 2021) (denied when two related trials predate FWD by eleven months and seven months, respectively); *F5 Networks, Inc. v. WSOU Invs., LLC*, IPR2022-00239, Paper 12 at 7-8 (P.T.A.B. May 19, 2022) (denied when trial predates FWD by six months); *Google LLC v. EcoFactor, Inc.*, IPR2021-00488, Paper 12 at 11-12 (P.T.A.B. Aug. 11, 2021) (denied when trial predates FWD by six months); *Cisco Sys., Inc. v. Oyster Optics, LLC*, IPR2021-00238, Paper 10 at 11-13 (P.T.A.B. June 1, 2021) (denied when trial predates FWD by seven months); *Samsung Elecs. Co. v. Truesight Commc’ns LLC*, IPR2025-00123, Paper 12 at 6-7 (P.T.A.B. Apr. 22, 2025) (denied when trial predates FWD by six months). The nearly three-month differential between the August 2026 trial date and the November 2026 FWD justifies discretionary denial.

Accordingly, this factor weighs in favor of discretionary denial.

D. Significant Investment in the Parallel Litigation Supports Discretionary Denial

The parties' investment in the parallel proceeding weighs in favor of discretionary denial. In the District Court Litigation, Plaintiff has submitted preliminary infringement contentions and Petitioner's preliminary invalidity contentions are due nearly a month after submission of this Preliminary Response.

Before the November 25, 2025 statutory deadline for an institution decision, the parties will have exchanged claim construction terms and proposed constructions. Ex. 2001. A trial date is set for August 17, 2026. Accordingly, the parties' and the Court's investment in this proceeding weighs in favor of denial of institution.

E. No Stay of the Parallel District Court Litigation

There is no stay of the parallel District Court Litigation. Petitioner has not sought a stay in the District Court Litigation. Even if Petitioner files a motion to stay, the Eastern District of Texas routinely denies requests to stay pending IPRs before institution on all asserted claims of all asserted patents. *See Force Mos Tech., Co. v. ASUSTek Comput., Inc.*, No. 2:22-cv-00460-JRG, 2024 WL 1586266, at *4 (E.D. Tex. Apr. 11, 2024) (citation omitted). There are four other asserted patents in the District Court Litigation. *See Longhorn Auto. Grp., LLC v. Volkswagen AG*, Case No. 2:24-cv-00933-JRG, Dkt. 1 at 2-3 (E.D. Tex. Nov. 15, 2024). There is one patent

for which no IPR petition has been filed. *See id.* at 2 (U.S. Patent No. 7,987,002).

Accordingly, the lack of a stay and the future unlikelihood of a stay before an institution decision weighs strongly in favor of denial of institution.

F. Other Factors Favor Discretionary Denial

Petitioner claims that the merits of the Petition weigh against a discretionary denial. Pet. at 87. Petitioner supplants the missing limitations in Petitioner's arguments with general knowledge, and specifically, conclusory opinions from Dr. Michalson that are merely reproductions of the attorney argument submitted in the Petition. Thus, the Petition should weigh in favor of denial.

When viewing the factors together, the Petition should be denied in the Board's discretion under 35 U.S.C. § 314(a).

VI. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Director exercise discretion to deny institution of the Petition in its entirety.

Respectfully submitted,

August 25, 2025

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CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S PRELIMINARY RESPONSE specified in 37 C.F.R. § 42.24 has 3,909 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word for Office 365.

Respectfully submitted,

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