

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

AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST

Case No. IPR2025-00925

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Pursuant to 37 C.F.R. § 42.75(c) and the Director’s authorization (Ex. 3100, Oct. 16, 2025), Patent Owner Longhorn Automotive Group LLC (“Patent Owner”) respectfully submits this opposition to Petitioner’s Request for Director Review of Institution Decision (Paper 10, “Request”), requesting affirmance of the Decision Denying Institution of *Inter Partes* Review (Paper 9, Sept. 12, 2025) (“Decision”) of U.S. Patent No. 8,085,192 (“the ’192 Patent”).

The Request should be denied for numerous reasons. First, the entirety of the Request rises and falls on the issue of whether “the Decision made a material error of fact when relying on an examiner interview . . . when assessing whether a material error by the examiner was made in allowing all claims.” Request at 1. Each alleged “reason” or “error” depends on this issue of what type of papers in the prosecution history are appropriately considered when assessing an alleged examiner error. As explained below, an allowance results when the claimed invention *as a whole* is allowable and the examiner’s reasons for allowability are not contained solely within the four corners of the notice of allowance. Rather, the MPEP guidance and the USPTO rules expressly provide that a statement of reasons for allowance “is not intended to necessarily state all the reasons for allowance or all the details why claims are allowed and should not be written to specifically or impliedly state that all the reasons for allowance are set forth,” and the MPEP makes clear that “**no**

statement should be necessary” when a prior office action indicates a reason for allowance. MPEP 1302.04 *citing* 37 C.F.R. 1.104(e) (emphasis added). The notion that the Acting Director impermissibly looked to another paper in the file history in an attempt to understand the reasons for allowance is legally and factually incorrect. Second, the request fails to address all remaining stated reasons for denial – *i.e.*, strong settled expectations, failure to provide persuasive reasoning why an IPR is an appropriate use of Board resources, and holistic assessment of all the evidence and arguments presented. Petitioner’s focus on the “interview summary” and failure to address these considerations renders this Request insufficient and the requested relief unwarranted.

I. PETITIONER MISCHARACTERIZES THE DECISION: THE ACTING DIRECTOR REJECTED PETITIONER’S INCORRECT ANALYSIS AND CONCLUSION THAT “NO OTHER REASON FOR ALLOWANCE WAS IDENTIFIED” IN THE PROSECUTION HISTORY

The Request identifies no abuse of discretion or any factual or legal error to warrant Review. The Decision reasonably and correctly found that “Petitioner’s argument that the Examiner erred is unconvincing as it does not accurately characterize the prosecution history.” Decision at 2. Petitioner appears to take issue with the Director’s reliance on an “interview summary,” contending that such a paper does not contain reasons for allowance. This contention is factually and legally

incorrect. The Decision reasonably and correctly relies on a paper exchange in the prosecution history indicating another non-exclusive reason for allowance.

The Request is based on a misunderstanding of the USPTO's guidance and practice on reasons for allowability. Contrary to Petitioner's arguments, a full and complete record of the reasons for allowability need not be contained solely within the notice of allowance. *See generally* MPEP 1302.04 *citing* 37 C.F.R. 1.104. Preliminarily, claims are issued when the claimed invention *as a whole* is allowable. Typically, the prosecution record (which includes the public disclosure of the claimed invention) as a whole informs the public as to the reasons for allowability. Only when the record as a whole does not make clear one or more reasons for allowability that an examiner "may set forth such reasoning." MPEP 1302.04 *citing* 37 C.F.R. 1.104(e). In fact, the MPEP provides that a statement of reasons for allowance "is not intended to necessarily state all the reasons for allowance or all the details why claims are allowed and should not be written to specifically or impliedly state that all the reasons for allowance are set forth." *Id.* Instead, the MPEP makes clear that "**no** statement should be necessary" when a prior office action indicates a reason for allowance. Thus, the reasons for allowability should account for the claimed invention as a whole and should be gleaned from the entire prosecution

record, including any interview summary. There is no wrong place to find such reasoning.

In Petitioner's Opposition to PO's Discretionary Denial Request, Petitioner incorrectly argued as follows:

II. The '192 Patent Was Allowed in Error

The '192 patent was allowed with an incorrect understanding of what its claims recite. Paper 1, at 1, 5. The Examiner allowed all of claims 1-22 based on the following conclusion:

<i>Allowable Subject Matter</i> 1. The following is an examiner's statement of reasons for allowance: The closest prior arts does not teach or make obvious: - "A removable storage module for storing the encrypted location ..."

Ex-1003, at 143 (emphasis added). No other reason for allowance was identified.

Paper 7 at 2-3 (Aug. 8, 2025). The Acting Director rejected this argument because it is factually and legally incorrect. In doing so, the Acting Director identified an example of another non-exclusive reason for allowance, showing that Petitioner incorrectly argued that "[n]o other reason for allowance was identified," and showing that Petitioner's argument was based on an incomplete record, i.e., solely the notice of allowance. Up to this point, Petitioner has failed to address the prosecution history as a whole for all reasons for allowance, and any attempt on

Request to address other parts of the prosecution history should be rejected as outside the scope of a proper Request. For example, prior to this Request, Petitioner failed to address any reasons for allowance to be gleaned from the Examiner's non-response to Applicant's Remarks filed on December 8, 2010, and May 9, 2011, and Examiner's Interview Summary filed on May 5, 2011. Ex. 1003 at 76-84, 121-124, 134. Petitioner also failed to address the fact examiners are not required to state reasons for allowance. *See generally* MPEP 1302.04 *citing* 37 C.F.R. 1.104. Here, where there is no apparent error and the record contains multiple locations for reasons for allowance which were not addressed by Petitioner prior to the Request, the Acting Director appropriately rejected Petitioner's incorrect analysis that the sole reason for allowance was stated in the notice of allowance and that "[n]o other reason for allowance was identified." Paper 7 at 2-3. Petitioner's attempt to manufacture new issues based on the Acting Director's rejection of this incorrect analysis and to introduce new arguments on Request should be rejected.

As the Decision notes, the summary of the telephonic interview conducted on May 5, 2011, in connection with the Notice of Allowability, fully explains the examiner's reason for allowance of the '192 Patent. The interview summary cited in the Decision provides as follows: "Applicant argues that *Adcox* ***does not teach the information in the memory being encrypted.*** He pointed *Adcox* teaches that the

device retrieved information from the memory, then encoded in order to transfer to the transmitter. *Therefore the information in the memory is not encoded yet.*” Ex. 1003, at 134 (emphasis added and internal citations omitted). The Notice of Allowability additionally provides that the prior art did not teach removable storage for “storing the encrypted location” *Id.*, at 143. As recognized by the Acting Director, Petitioner failed to address the interview summary in its Opposition to Patent Owner’s Discretionary Denial Request. *See* Paper 7, at 2-7. Petitioner, therefore, failed to address the entirety of the ’192 Patent’s prosecution history when attempting to allege material error, and it was appropriate for the Acting Director to reject those arguments.

II. THE DECISION PROPERLY CONSIDERED EACH ARGUMENT MADE BY THE PARTIES AND CORRECTLY EXERCISED DISCRETION IN DENYING THE PETITION

The Decision properly considered all evidence presented and all arguments made by the parties in exercising discretion to deny the Petition. As noted by Patent Owner in its Request for Discretionary Denial (Paper 6, at 9-10) and in the Decision, the ’192 Patent has been in force for thirteen (13) years, which created “strong settled expectations for Patent Owner[.]” Decision, at 2. The Decision explicitly noted that Petitioner failed to provide “persuasive reasoning why an *inter partes* review is an appropriate use of Board resources.” *Id.* (citing *Dabico Airport Sols. Inc. v. AXA*

Power ApS, IPR2025-00408, Paper 21 at 2–3 (Director June 18, 2025)). Patent Owner’s settled expectations alone were a reason to deny the Petition.

In the request, Petitioner mischaracterizes the Decision by arguing that it failed to address several of the Petitioner’s arguments in alleged violation of the Administrative Procedure Act and Due Process. Paper 10, at 6-8. This is incorrect. The Decision explicitly states that it was rendered “[a]fter considering the parties’ arguments and the record, ***and in view of all relevant considerations***, discretionary denial of institution is appropriate in this proceeding. This determination is based on ***the totality of the evidence and arguments the parties have presented.***” Decision, at 2 (emphasis added). Moreover, the Decision specifically addressed Petitioner’s specious argument that the Director failed to consider several of Petitioner’s arguments. *See id.* at 3 (emphasis added) (“Although certain arguments are highlighted above, ***the determination to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented.***”). Petitioner is, therefore, incorrect that the Director failed to consider every argument presented by Petitioner. The Director’s reasoning is consistent with other recent decisions denying institution based, at least in part, on settled expectations. *See, e.g., iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, -00374, -00376,

-00377, -00378, Paper 10, at 3 (Director June 6, 2025); *Ultrahuman Healthcare Pvt. Ltd. v. Ouraring, Inc.*, IPR2025-00411, Paper 12, at 3 (Director June 25, 2025).

Ignoring the Director's express statement that the entire record was considered, Petitioner merely restates its positions in opposition to Patent Owner's Discretionary Denial Request. *See, generally*, Paper 7. Petitioner further argues, baselessly, that the Decisions violated the Administrative Procedure Act and Due Process. *See* Paper 10, at 7-8. However, Petitioner's argument necessarily fails because it only relates to the Decision with respect to Petitioner's mischaracterization of examiner's reasons for allowance. *See id.* Petitioner does not argue that the Decision's reliance on Patent Owner's strong settled expectations – a separate reason for denying institution – violated the APA or Due Process. Accordingly, the Decision sufficiently explains its reasoning for denying the Petition, and the request for Director Review should be denied.

III. CONCLUSION

For the foregoing reasons, Petitioner's request for Director Review should be denied.

Respectfully submitted,

October 23, 2025

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CERTIFICATE OF SERVICE

A copy of the foregoing PATENT OWNER'S RESPONSE TO DIRECTOR
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