

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORD MOTOR COMPANY,
Petitioner

v.

AUTOCONNECT HOLDINGS LLC,
Patent Owner

Case No. IPR2025-01342
Patent No. 9,020,697

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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PATENT OWNER’S EXHIBIT LIST

Exhibit	Description
2001	Letter from William Woodford, Counsel for AutoConnect Holdings LLC to Steven Croley, General Counsel for Ford Motor Company, dated December 28, 2023.
2002	Email from Tom Yerbernetsky, Counsel for Ford Global Technologies to William Woodford, Counsel for AutoConnect Holdings LLC, dated March 4, 2024.
2003	Letter from Charles J. Monterio, Jr., Counsel for Ford Motor Company to William Woodford, Counsel for AutoConnect Holdings LLC, dated May 16, 2024.
2004	Letter from Charles J. Monterio, Jr. Counsel for Ford Motor Company to William Woodford, Counsel for AutoConnect Holdings LLC, dated July 22, 2024.
2005	First Amended Docket Control Order, <i>AutoConnect Holdings, LLC v. Toyota Motor Corp.</i> , No. 2:24-CV-00802-JRG-RSP, ECF No. 53 (E.D. Tex. February 13, 2025) (Gilstrap, J.)
2006	ORDER Denying Motion to Dismiss, <i>AutoConnect Holdings, LLC v. Ford Motor Company</i> , No. 1:24-CV-01327-JCG, ECF No. 24 (Dist. of Del. September 24, 2025) (Choe-Groves, J.)
2007	Annotated Excerpts of Toyota’s Invalidity Contentions <i>served</i> April 1, 2025, <i>AutoConnect Holdings, LLC v. Toyota Motor Corp.</i> , No. 2:24-cv-00802-JRG-RSP (E.D. Tex.)

2008	March 24, 2025 Guidance on USPTO’s recission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation”
2009	October 3, 2025 Update to USPTO Interim Director Discretionary Process
2010	USPTO FAQs for Interim Processes for PTAB Workload Management (Archived)

I. INTRODUCTION

The Board should deny institution because the challenged '697 patent issued over ten years ago, creating strong settled expectations for Patent Owner. Those settled expectations were reinforced when Patent Owner raised infringement allegations with Petitioner by letter in December 2023 and Petitioner waited 19 months to file a petition challenging the '697 patent. Further, the '697 patent is involved in two federal court litigations, including the action filed against Petitioner over ten months ago in the District of Delaware (the “Ford Action”) and another against Toyota filed two months earlier in the Eastern District of Texas (the “Toyota Action”). Institution would result in a significant duplication of effort with these ongoing litigations.

Patent Owner owns a large portfolio of patents directed to inventions conceived by one of its owners, including the '697 patent. The '697 patent issued on April 28, 2015. On December 28, 2023, Patent Owner sent a letter to Petitioner in which it accused Petitioner of infringing the '697 patent, among others. Ex. 2001. Petitioner initially responded by stating it was “diligently reviewing the patents and claim charts” addressed in Patent Owner’s December 2023 letter. Ex. 2002. Thereafter, Petitioner offered blanket assertions of non-infringement of the '697 patent, but never challenged the validity of the '697 patent. *See, e.g.*, Exs. 2003, 2004. Based on the lack of progress through informal means, and with settled

expectations as to the validity of the '697 patent, Patent Owner filed a complaint in the Ford Action alleging infringement of the '697 patent (and 12 other patents) on December 6, 2024.

At the time of the complaint against Petitioner, Patent Owner had already filed infringement complaints against other automakers, including the Toyota Action, which also involved the '697 patent. The Toyota Action is pending before Judge Rodney Gilstrap in the U.S. District Court for the Eastern District of Texas and scheduled for trial in July 2026. Ex. 2005. Thus, Petitioner had every reason to challenge the '697 patent but never did, further settling Patent Owner's expectations.

In addition to Patent Owner's settled expectations, the traditional *Fintiv* factors favor discretionary denial. There are two parallel proceedings involving the same patent, one with a trial scheduled to occur long before any final written decision would be rendered, such that institution would cause needless duplication of efforts. Further minimizing any potential value of these proceedings, Petitioner has filed petitions with respect to only four of the thirteen patents asserted in the Ford Action (with this being the earliest-filed). Consequently, institution of the instant petition could not possibly avoid, or even meaningfully focus, the inevitable trial in the Ford Action.

Holistically, denying institution is the most efficient and fair result as it respects Patent Owner's strong settled expectations and will avoid duplicative efforts

by different tribunals, risking inconsistent claim construction and validity rulings.

II. THE BOARD SHOULD EXERCISE ITS DISCRETION UNDER 314(a) TO DENY INSTITUTION.

The decision whether to institute an *inter partes* review lies with the Board's discretion. *Nautilus Hyosung Inc. v. Diebold, Inc.*, IPR2017-00426, Paper 17 (PTAB June 22, 2017) (confirming that under § 314(a), “the PTO is permitted, but never compelled, to institute an IPR proceeding”); *see also NHK Spring Co. v. Intriplex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019) (confirming the Board has discretion to deny institution of under 35 U.S.C. § 314(a) due to the advanced state of parallel district court litigation regarding the same issues).

The Board has identified a number of factors to consider when analyzing whether to discretionarily deny institution, which include:

1. Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. The 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 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 (PTAB 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.* The Board should use these factors to develop “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.*

Consistent with *Fintiv*’s holistic analysis, the Board should also consider the “[s]ettled expectations of the parties, such as the length of time the claims have been in force” and “any other considerations bearing on the Director’s discretion.” Director’s March 26, 2025 Memorandum titled, “Interim Processes for PTAB Workload Management” at 2-3.

The balance of these factors strongly favor discretionary denial of the Petition.

A. *Fintiv* Factor 1 Favors Denial Because the Ford Action Has Not and Will Not Be Stayed.

The Ford Action is long underway. Neither party has requested a stay, and Petitioner has not expressed any plans to seek one. Consequently, this factor supports discretionary denial. *See Mylan Labs. Ltd. v Janssen Pharm. NV*, IPR2020-00440, Paper 17 at 13-14 (PTAB Sep. 16, 2020) (“[N]o stay is likely to be entered [], and therefore *Fintiv* factor 1 leans towards denial of institution.”).

Even if Petitioner were to request a stay based on this Petition, it would invariably be denied. The challenged '697 patent is merely *one of thirteen* asserted patents. It is highly unlikely that any district court judge would stay a litigation based on an IPR challenges that do not address the vast majority of asserted patents. The District of Delaware routinely denies motions to stay under such circumstances. *Toshiba Samsung Storage Tech. Korea Corp. v. LG Elecs., Inc.*, 193 F. Supp. 3d 345, 349 (D. Del. 2016) (denying stay where “a PTAB decision that is totally favorable to [defendant] will leave behind a lot to (at least potentially) be litigated”); *Siemens Indus., Inc. v. Westinghouse Air Brake Techs. Corp.*, No. CV 16-284-LPS, 2018 WL 3046511, at *1 (D. Del. June 20, 2018) (denying stay where IPR proceedings “may slightly simplify some portion of the issues for trial, but would not simplify the majority of the case”); *see also N. Atl. Imports, LLC v. LoCo-Crazy Good Cookers, Inc.*, No. CV 23-999-GBW-SRF, 2024 WL 4827250, at *2 (D. Del. Nov. 19, 2024) (explaining that simplification of issues for trial “is the most important factor bearing on whether to grant a stay”).

Because no stay has been or will be entered, this factor favors denial of institution. *Mylan*, IPR2020-00440, Paper 17 at 13-14.

B. *Fintiv* Factor 2 Favors Denial Because There Are Multiple Parallel Proceedings and One of Them is Scheduled for Trial Months Before a Final Written Decision Is Expected Here.

Discretionary denial is also appropriate here due to the parallel Ford Action as well as the Toyota Action. It would not be an effective use of resources to have three separate proceedings involving challenges to the validity of the '697 patent, which would not only result in needless duplication of effort but would risk inconsistent claim constructions and validity determinations.

The Ford Action has been pending since December 2024. Rather than file an Answer to Patent Owner's complaint, however, Petitioner filed a partial motion to dismiss that challenged only a subset of the patents. Specifically, the motion argued that the claims in six of the thirteen asserted patents, including the '697, were indefinite due to the use of "and/or" in both the subjunctive and conjunctive.¹ But numerous courts have already ruled that the subjunctive and conjunctive combination of "and/or" is not indefinite. *Pavilion Techs., Inc. v. Emerson Elec. Co.*, No. A-05-CA-898-SS, 2006 WL 6210180 (W.D. Tex. Sept. 5, 2006); *Cipher Pharms. Inc. v. Actavis Lab'ys FL, Inc.*, 99 F. Supp. 3d 508, 518 (D.N.J. 2015); *Chiesi USA Inc. v. MSN Pharms. Inc.*, No. CV-19-18564, 2021 WL 4843806, at *9 (D.N.J. Oct. 18, 2021); *In re Qualcomm Litig.*, No. 17-CV-00108-GPC-MDD, 2018

¹ Petitioner notably did not argue the same in the instant petition.

WL 2229344, at *19 (S.D. Cal. May 16, 2018).

Although Petitioner’s baseless motion has now been denied,² it achieved its likely goal of delaying the progression of the case. As things stand, the parties will be submitting a case schedule later this month, and the trial date is currently unknown. Petitioner, consistent with its past efforts, will invariably suggest a later trial date. The deadline for a final written decision if the Board were to institute the instant petition would be February 7, 2027. The trial in the Ford Action is likely to occur after a final written decision would be issued.

While that could cut against discretionary denial, the Ford Action is only one of two parallel actions involving the ’697 patent. The Toyota action is currently set for July 20, 2026, in the Eastern District of Texas. Ex. 2005 at 1. This date “cannot be changed without an acceptable showing of good cause.” *Id.* at 6; *see also* E.D. Tex. L.R. CV-83(a) (characterizing set trial dates as “firm trial dates”). Thus, trial in Toyota Action will begin about *seven months* before any final written decision in this *inter partes* review. This timing favors discretionary denial. *See AT&T Services Inc. v. ASUS Tech. Licensing Inc.*, IPR2024-00992, Paper 14 at 10-11 (PTAB Dec.

² Ford challenged the sufficiency of Patent Owner’s factual allegations of infringement with respect to two of the asserted patents, but the Court also denied this procedural challenge. Ex. 2006 at 12-15.

16, 2024) (denying institution because *Fintiv* factor 2 substantially favored discretionary denial when there was a parallel trial scheduled “four to five months prior” to the final written decision deadline). While the Toyota Action involves a different party, it would still serve to focus the validity challenges Petitioner makes in the Ford Action.

The final written decision in this case would likely be issued before the trial in the Ford Action, but well after the Toyota Action in which Toyota is challenging the validity of the '697 patent. Thus, under the circumstances of this proceeding, *Fintiv* factor 2 favors discretionary denial.

C. *Fintiv* Factor 3 is Neutral Because Petitioner Delayed Progress in the Ford Action.

The Ford Action is still in its early stages, with the parties required to submit a case schedule later this month. Petitioner delayed its Petition until nine months after Patent Owner filed its infringement complaint (and about 19 months from being informed of its infringement of the '697 patent). The only reason the Ford Action is not further developed at this stage, despite having been filed over 10 months ago, is that Petitioner filed a motion to dismiss that served no purpose other than to delay progress of the Ford Action. Petitioner should not benefit from its pursuit of a motion with little or no expectation of success, and this factor should be neutral.

D. *Fintiv* Factor 4 Favors Denial Because the Issues in the Parallel Proceeding Overlap with the Issues Raised in the Petition.

The Board should also discretionarily deny institution because the grounds set forth therein will likely overlap with Petitioner’s invalidity arguments contentions in the Ford Action. Acknowledging this likely overlap, Petitioner filed a “*Sotera*” stipulation. Paper 5 at 2. This type of stipulation, however, is not dispositive. Ex. 2008 at 2-3. Indeed, the USPTO has indicated that reliance on system art and other invalidity theories renders a *Sotera* stipulation “not ... particularly meaningful because the efficiency gained by an AIA proceeding will be limited.” Ex. 2009 at 3. For example, this stipulation does not prevent Petitioner from relying on the same prior art in district court in support of combinations involving non-printed publication art, e.g., prior art based on public use or an on sale-bar. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1365–66 (Fed. Cir. 2025) (“IPR estoppel does not preclude a petitioner from relying on the same patents and printed publications as evidence in asserting a ground that could not be raised during the IPR, such as that the claimed invention was known or used by others, on sale, or in public use.”). Similarly, the *Sotera* stipulation does not prevent Petitioner from relying on system art that embodies the teachings of the printed publications it relies upon in its Petition. Additionally, the *Sotera* stipulation may not simplify the issues in the Ford Action because Petitioner may assert the same prior art against other asserted patents. *See, e.g., Motorola Sols. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3–4

(PTAB Mar. 28, 2025) (denying institution despite Petitioner’s *Sotera* stipulation, in part, because “Petitioner’s invalidity arguments in the district court are more expansive” and “Petitioner’s stipulation does not ensure that the[] IPR proceedings would be a ‘true alternative’ to the district court proceeding”); *SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01495, Paper 13, 8-9 (Apr. 7, 2025).

In addition, Toyota relies on Ghabra to challenge the ’697 patent, which is one of the three prior art references that Petitioner relies upon here. Ex. 2007. Toyota relies upon this same reference to challenge the validity of two other patents as well, U.S. Patent Nos. 9,123,186 and 9,290,153, and both of these patents are also asserted against Petitioner. *Id.* Thus, the Toyota Action also overlaps with the issues that would be addressed in this proceeding.

Because of the likely overlap in issues between the petition and the parallel proceedings, as well as the limited impact of Petitioner’s stipulation, the objectives of efficiency and fairness behind *Fintiv* would be defeated if the Board were to institute *inter partes* review. This factor favors discretionary denial.

E. *Fintiv* Factor 5 Favors Denial Because the Parties in the Parallel Proceeding are Identical.

The parties in this proceeding are the same as in the Ford Action. Thus, *Fintiv* Factor 5 favors denial. *Fintiv*, Paper 11 at 13-14; *see also Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020)

In addition, the Toyota Action involves different parties but it will also

involve challenges to the validity of the '697 patent as discussed in section D. Indeed, one of the same prior art references is being asserted against the '697 patent (and other asserted patents) despite the differences in the parties. This further supports discretionary denial.

F. *Fintiv* Factor 6 Favors Denial Because the Merits of the Petition are Not Compelling and the Petition Relies Extensively on an Expert Declaration to Try to Fill the Gaps.

“A full merits analysis is not necessary as part of deciding whether to exercise discretion not to institute, but rather the parties may point out, as part of the factor-based analysis, particular ‘strengths or weaknesses’ to aid the Board in deciding whether the merits tip the balance one way or another.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 15 (PTAB May 13, 2020). Institution may not be appropriate even when the merits of the petition are strong. *E.g., Samsung Elecs. Co., Ltd. v. Sionyx, LLC.*, IPR2025-00065, Paper 16 at 19-20 (PTAB June 6, 2025) (denying institution despite “Petitioner’s strong case on the merits”); Ex. 2008 at 3.

Here, the strength of the merits are inadequate to warrant institution. The Petition does not contend that a single claim is anticipated, instead advancing four different grounds of obviousness. To fill in the gaps between the prior art and the claims, the Petition extensively relies on an expert declaration from Dr. Todor Cooklev, EX1003, which it cites 147 times. The Todor Declaration extends 313 pages, comprising 557 paragraphs, while the Petition is only 94 pages long. Such

extensive reliance on an expert is telling as to the lack of disclosure in the prior art and further indicates that the validity determination will turn on competing expert testimony, which is best assessed through live expert testimony in district court. Ex. 2010 at Q.22 (explaining that “extensive reliance on expert testimony . . . may suggest that the questions are better resolved in an Article III court,” and that “the failure to provide focused expert testimony may weigh against institution”); Ex 2009 (retiring PTAB’s April 25, 2025 FAQs (Ex. 2010) as part of the formalization of the new interim Director discretionary process but confirming that “the extent of the petition’s reliance on expert testimony” remains a relevant consideration).

In addition, there are numerous flaws in Petitioner’s arguments that ensure that claims will survive any institution of these proceeding and will need to be litigated. To be clear, Patent Owner is not cataloging every omission or weakness in the Petition; rather, the examples discussed below highlight the most glaring deficiencies. These deficiencies are so significant that they cannot reasonably support Petitioner’s invalidity position and ensure a trial will be required in the Ford Action.

For example, Petitioner advances two grounds for challenging claims 3, 10, and 17. The first ground, Clement (Ex. 1010) in view of Ghabra (Ex. 1011), fails because the references are directed to fundamentally different systems. Clement is directed to the use of “portable computing devices such as a tablet or smart phone,”

to issue vehicle control commands. Ex. 1010 at Abstract. After a user enters a command on the portable computing device, the vehicle determines the specific location within the vehicle where the device is located to determine whether the device should be allowed to issue the command. See Ex. 1010 at 5:10-17; 7:40-50; Fig. 8. Thus, Clement is directed to an *active* command procedure. Conversely, Gharba is directed to a key fob that provides for *passive* entry functions, eliminating the need to manually press an unlock or start button on the key fob. Ex. 1011 (entitled “Integrated Passive Entry and Remote Keyless System); 1:40-42 (describing “one disadvantage” of prior art key fobs as requiring the user to “manually actuate the key fob to achieve the desired result”); 2:17-21; 5:20-38. Thus, a POSA building an active command system—like that in Clement—would have no reason to consider the teachings of a passive vehicle system—like that described by Ghabra. Indeed, Ghabra describes an entirely different process for actively issuing commands by pushing key fob buttons that does not involve the “trigger signal” process for issuing passive commands that Petitioner relies upon. Compare Ex. 2011 at 3:30-42 (describing the process for issuing commands using key fob buttons) with Petition at 61 (citing passages in Ghabra describing “passive entry function” involving a “trigger event” and low frequency “trigger signal” that is not used for active entry of commands). In addition, the purpose of the trigger event and trigger signal in Gharba is to preserve the battery of the key fob (Petition

at 56-57), which presents different concerns than “portable computing devices” such as “a cell phone, a tablet, a laptop, or a portable gaming device” that are routinely recharged (Ex. 1010 at 4:42-46). For these reasons, a POSA would not be motivated to modify Clement based on Gharba.

The other obviousness ground relied upon by Petitioner for claims 3, 10, and 17 (as well as claims 5, 12, and 19), Lickfelt (Ex. 1012) in view of Ghabra (Ex. 1011), is also fundamentally flawed. Lickfelt’s entire architecture depends on continuous LF polling by the vehicle to detect fob movement trends away from or toward a vehicle as opposed to event-driven activation. Ex. 1012 at ¶ 0013; ¶ 0018-0021. Lickfelt—which is based on an application filed nearly two years after the Ghabra patent published—explicitly criticizes prior art systems like Ghabra that rely on discrete event triggers because those systems fail to unlock vehicles fast enough:

Some vehicles apply an LF polling strategy . . . [that] send the LF field to authenticate the fob *after the door handle is grabbed*. If the operator is too fast, the authentication and unlock command may not take place in time for the door to be unlocked before the user pulls on the door handle. This requires the operator to pull a second time on the handle to open the door.

Ex. 2012 at ¶ 0002 (emphasis added). That is exactly the process that Petitioner suggests a POSA would be motivated to add to the Lickfelt process. Petition at 87 (“The modification to Lickfelt’s communication strategy would include the ECU

sending out a signal to poll for devices in response to a triggering event and determining if a response signal was received, indicating that a new device is attempting to connect to the vehicle); 90-91. Accordingly, a POSA would not be motivated to modify Lickfelt based on Ghabra as suggested by Petitioner.

These are merely examples why the petition lacks compelling merits and why factor 6 supports discretionary denial.

G. The Parties Settled Expectations Warrant Discretionary Denial.

In determining whether to deny a Petition, the Board should consider the “[s]ettled expectations of the parties, such as the length of time the claims have been in force” and “any other considerations bearing on the Director’s discretion.” Director’s March 26, 2025 Memorandum titled, “Interim Processes for PTAB Workload Management” at 2-3. “Although there is no brightline rule on when expectations become settled, in general, the longer the patent has been in force, the more settled expectations should be.” *Dabico Airport Solutions Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 at 3 (Acting Director Stewart June 18, 2025).

The ’697 Patent has been in force for more than 10 years, which in and of itself creates settled expectations. *Id.* at 2 (finding “the challenged patent has been in force almost eight years, creating settled expectations.”); *see also Samsung Electronics Co., Ltd. v. Sinotechnix LLC*, IPR2025-00331, Paper 13 at 2 (PTAB July 2, 2025) (“[T]he challenged patents have been in force for more than 10 years,

creating strong settled expectations....”); *Kingston Tech. Co., Inc. v. Vervain, LLC*, IPR2025-00614, Paper 12 at 2 (Acting Director Stewart July 16, 2025) (“[T]he challenged patent ... has been in force for more than 10 years, creating strong settled expectations. Accordingly, the circumstances in this case favor discretionary denial.”). This is because issued patents on their own “provide notice to the public, other inventors, competitors, and commercial interests” such that actual notice is not required to create settled expectations. *Dabico Airport*, Paper 21 at 3. Strong settled expectations support discretionary denial even when a final written decision will be issued before trial in a parallel proceeding. *OnePlus Tech. Co., Ltd. v. Pantech Corp.*, IPR2025-00637, Paper 17 at 2 (August 14, 2025) (denying institution despite case being stayed); *Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12 at 2 (July 31, 2025) (denying institution despite case being stayed because of settled expectations over a 6-year-old patent).

Even further, however, Petitioner has been on actual notice of its infringement of the '697 patent since Patent Owner's December 2023 letter and chose not to pursue post-grant challenges despite “diligently reviewing the patents and claim charts” addressed by Patent Owner. Ex. 2002. When Petitioner finally provided a substantive response for some of the patents raised by Patent Owner, it never even addressed the validity (or infringement) of the '697 patent. Ex. 2003. Nor did Petitioner ever question the validity of the '697 in subsequent correspondence. Ex.

2004. It was not until 19 months after receiving notice of its infringement and a lawsuit by AutoConnect that Petitioner filed the instant petition. Petitioner's inaction reflects a conscious decision to accept the validity of the '697 Patent claims, reinforcing Patent Owner's settled expectations. *See iRhythm Techs., Inc. v. CardioNet, LLC*, IPR2025-00363, Paper 10 at 3 (Acting Director Stewart June 6, 2025) ("failure to seek early review of the patents favors denial."). The parties' settled expectations alone support discretionary denial.

Petitioner asserts that Patent Owner's settled expectations should be disregarded because it "had not commercialized, asserted, marked, licensed, or otherwise applied the '697 Patent in the automotive technology space if at all, before contacting Petitioner in December 2023." Petition at 3. Even if that was accurate, and it is not because Patent Owner had already charged other parties with infringement, it does not overcome Patent Owner's strong settled expectations.³

³ Nor does Petitioner's unsupported declaration of non-infringement in pre-suit correspondence (Ex. 2003 at 2-3) overcome Patent Owner's settled expectations. *DataDome S.A. v. Arkose Labs Holdings, Inc.*, IPR2025-00693, Paper 13 at 2-3 (August 14, 2025) (explaining that "a petitioner's reliance on its own assessment of patents" does not overcome a patent owner's settled expectations for a 10-year-old patent).

Google LLC v. SoundClear Techs. LLC, IPR2025-00344, Paper 15 at 2 (August 4, 2025) (holding that “Petitioner's argument that Patent Owner does not have strong settled expectations because the patent was not ‘commercialized, asserted, marked, licensed, or otherwise applied in a petitioner's particular technology space,’ without more, does not defeat Patent Owner's strong settled expectations”); *Kahoot!*, Paper 12 at 2 (holding that Patent Owner “not previously assert[ing] the challenged patent against Petitioner does not defeat Patent Owner’s settled expectations.”). And it also ignores Patent Owner’s strong settled expectations for a patent that is more than ten years old, as well as Petitioner’s delay in filing a petition for over 19 months after being notified of its infringement. Ex. 2001.

III. CONCLUSION

The ’697 Patent has been in force for over a decade, giving Patent Owner strong settled expectations. Those expectations were reinforced by Petitioner’s failure to challenge the validity of the ’697 patent until 19 months after AutoConnect provided a claim chart explaining Petitioner’s infringement. In addition, the ’697 patent is but one of thirteen patents asserted in the parallel Ford Action, such that this proceeding would not meaningfully focus the case for trial. Institution here would wholly defeat the goals of discretionary denials—efficiency and integrity of the system. Patent Owner requests discretionary denial of the Petition.

Date: October 7, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** and associated exhibits (Exhibits 2001-2010) were served electronically via e-mail on October 7, 2025, in their entireties on the following counsel of record for Petitioner:

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