

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORD MOTOR COMPANY
Petitioner,

v.

AUTOCONNECT HOLDINGS, LLC
Patent Owner.

U.S. Patent No. 9,290,153

Case No.: IPR2025-01383

PETITIONER'S REQUEST FOR REHEARING

Table of Contents

List of Exhibits.....	iv
I. INTRODUCTION	1
II. ARGUMENT.....	2
A. <i>Magnolia</i> Factors A and B: Petitioner Sought IPR as a True Alternative to Litigation and Not as a Tool for Duplicative Challenges, as the Related Litigation Is Stayed and Indefiniteness Is Not Asserted.....	3
1. The <i>Fintiv</i> Factors Confirm That This IPR Functions as an Alternative to Litigation.....	4
B. <i>Magnolia</i> Factor C: Petitioner Is a U.S.-Based Manufacturer and therefore This IPR would Protect American Manufacturing Interests.....	14
C. <i>Magnolia</i> Factor D: The Settled Expectations of the Parties Favor Institution and Advance Public Interest.....	14
III. REQUEST FOR RELIEF	15
Certificate of Service	17
Certificate of Compliance	18

Table of Authorities

Cases

<i>Amazon.com, Inc. v. NL Giken Inc.</i> , IPR2025-00050 (PTAB May 23, 2025)	7
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019 (PTAB March 20, 2020)	3, 4, 5, 7
<i>AutoConnect Holdings LLC v. Ford Motor Comp.</i> , 1:24-cv-01327-JCG (D. Del. April 16, 2026)	4, 6, 9, 13
<i>Caption Health, Inc. v. Univ. of B. C.</i> , IPR2025-01422 (Director December 18, 2025)	11
<i>Home Depot U.S.A., Inc. v. H2 Intellect LLC</i> , IPR2025-00480 (Director September 4, 2025)	14
<i>Home Depot U.S.A., Inc. v. Lynk Labs, Inc.</i> , PGR2022-00009 (PTAB May 25, 2022)	5, 6, 7
<i>Infineon Techs. Ams. Corp. v. MOSAID Techs. Inc.</i> , IPR2025-01171 (Director February 19, 2026)	11
<i>Infineon Techs. Ams. Corp. v. MOSAID Techs. Inc.</i> , IPR2025-01456 (Director March 17, 2026)	11, 12
<i>Kea Cloud, Inc. v. Valyant AI, Inc.</i> , IPR2023-00450 (PTAB July 19, 2023)	5
<i>Magnolia Med. Techs., Inc. v. Kurin, Inc.</i> , IPR2026-00097 (PTAB May 14, 2026)	1, 2, 3, 4, 9, 14
<i>Precision Planting, LLC v. Deere & Co.</i> , IPR2019-01052 (PTAB January 7, 2020)	5
<i>Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.</i> , IPR2025-00632 (Director November 3, 2025)	7

<i>Samsung Elecs. Co. Ltd. v. CardWare Inc.,</i> PGR2023-00013 (PTAB August 11, 2023).....	10
<i>Shenzhen Root Tech. Co., Ltd. v. Chiaro Tech. Ltd.,</i> IPR2024-01296 (PTAB February 25, 2025)	7
<i>Terumo BCT, Inc. v. Haemonetics Corp.,</i> IPR2025-01374 (Director May 12, 2026)	2, 7, 12
<i>Tesla, Inc. v. Intellectual Ventures II LLC,</i> IPR2025-00340 (Director November 5, 2025).....	8
<i>TikTok, Inc. v. Shopsee, Inc.,</i> IPR2025-01485 (Director January 16, 2026)	12

Other Authorities

H.R. Rep. No. 112-98 (2011).....	4
----------------------------------	---

List of Exhibits

Exhibit No.	Description
1001	U.S. Patent No. 9,290,153 (“the ’153 Patent”)
1002	U.S. Patent No. 9,290,153 Certified File History (“the ’153 Patent File History”)
1003	Expert Declaration of Todor Cooklev
1004	Todor Cooklev Curriculum Vitae
1005	<i>AutoConnect Holdings LLC v. Ford Motor Company</i> , Complaint, Case No. 1:24-cv-01327-JCG (D. Del.) Filed December 6, 2024 (“Complaint”)
1006	Plaintiff’s Opposition to Defendant’s Motion to Dismiss, <i>AutoConnect Holdings LLC v. Ford Motor Company</i> , Case No. 1:24-cv-01327-CFC (D Del.) Filed February 28, 2025 (“Opposition”)
1007-1009	<i>Intentionally left blank</i>
1010	U.S. Patent No. 8,768,539 B1 to Clement (“Clement”)
1011	U.S. Patent No. 7,388,466 B2 to Ghabra (“Ghabra”)
1012	U.S. Patent Application Pub. No. 2012/0092129 A1 to Lickfelt (“Lickfelt”)
1013	U.S. Patent Application Pub. No. 2011/0093153 to Moinzadeh (“Moinzadeh”)
1014	U.S. Patent Application Pub. No. 2012/0042005 A1 to Papakosta (“Papakosta”)
1015	U.S. Patent No. 7,783,699 B2 to Rasin (“Rasin”)
1016-1049	<i>Intentionally left blank</i>
1050	Bosch Handbook, (Automotive Handbook October 2004 6 th Edition) (“Bosch”)
1051	IEEE Dictionary, (IEEE 100 The Authoritative Dictionary of IEEE Standards Terms 2000 7 th Edition) (“IEEE Dictionary”) (Excerpts)
1052	“Specification of The Bluetooth System” (June 30, 2010). Version 4.0 (Volumes 0-6) Available at https://www.bluetooth.com/specifications/specs/core-specification-4-0/ (Accessed June 27, 2025) (“Bluetooth Specification”)
1053	Hossain et al., “A Comprehensive Study of Bluetooth Signal Parameters for Localization,” 2007 IEEE 18 th International Symposium on Person, Indoor and Mobile Radio Communications Available at https://www.ieeexplore.ieee.org/document/4394215 (“Hossain”)

Exhibit No.	Description
1054	McCartt, et al. “Driver Cellphone and Texting Bans in the United States: Evidence of Effectiveness,” Engaged Driving Symposium Annals of Advances in Automotive Medicine, March 31, 2014 (“McCartt”) Available at https://pmc.ncbi.nlm.nih.gov/articles/PMC4001674/ (Accessed July 1, 2025.)
1055	NHTSA Traffic Safety Facts Research Note “Distracted Driving 2010” published September 2012. Available at https://www.nrd.nhtsa.dot.gov/CATS/index.aspx (Accessed June 24, 2025) (“NHTSA”)
1056	Peterson, Andrew, “Do not disturb, Ford Fights Distracted Driving with Limited In-Motion Sync Access,” July 12, 2010. Available at https://www.motortrend.com/news/163-news100712-ford-sync-do-not-disturb (Accessed June 24, 2025) (“Motor Trend”)
1057	Allen, Leslie “Ford launches parental control technologies,” October 7, 2008. Available at https://www.autonews.com/article/20081007/ZZZ_SPECIAL/310079921/ford-launches-parental-control-technologies/ (Accessed June 24, 2025) (“Auto News”)
1058	Ghangurde, Mujund “Ford SYNC and Microsoft Windows Embedded Automotive Make Digital Lifestyle a Reality on the Road,” <i>SAE International</i> , Volume 3, Issue 2, October 19, 2010 SAE2010-01-02319 (Accessed April 25, 2025) (“Ghangurde”)
1059	Austin, Michael “Ford introduces Next-Gen Connectivity Suite Called MyFord; Should be Awesome,” January 6, 2010. Available at https://www.caranddriver.com/news/a15128939/ford-introduces-next-gen-connectivity-suite-called-myford-should-be-awesome-car-news/ (“Car and Driver”)
1060	TCP/IP Tutorial and Technical Overview 6 th Ed. (International Business Machines Corporation – October 1998) (“IBM TCP/IP Tutorial”)
1061	Ford SYNC Supplemental Guide, November 2007 (“SYNC Guide 2007”)
1062	Ford SYNC Supplemental Guide, January 2010 (“SYNC 1 Guide 2010”)
1063	Saltzstein, William E. “Bluetooth: The Future of Wireless Medical Technology?” February 1, 2002. Available at https://www.mddionline.com/new-technologies/bluetooth-the-

Exhibit No.	Description
	future-of-wireless-medical-technology- (Accessed June 30, 2025) (“MDDI”)
1064	MyFord Touch Ford User Guide Ford Motor Company, February 2012 (“MyFord Touch Guide”)
1065	SUSE LINUX – Administration Guide. Published by SUSE LINUX AG, 2004. (“Linux”)
1066	“Universal Serial Bus 3.0 Specification” (November 12, 2008). Revision 1.0, Available at https://manuais.iessanclemente.net/images/4/4b/USB30-Specification-2008.pdf (Accessed August 12, 2025) (“USB 3 Spec”)
1067	“Specification of the Bluetooth System” (December 1, 1999). Version 1.0 B Available at https://engweb.eng.wayne.edu/ad/ad57/ad5781/public_html/BluetoothWeb/BTooth_Spec1.0B_Vol1.pdf (Accessed August 12, 2025) (“Bluetooth Spec. V1.0 B”)
1068-1099	<i>Intentionally left blank</i>
1100	United States District Courts – National Judicial Caseload Profile, March 2025
1101	<i>Intentionally left blank</i>
1102	U.S. Patent and Trademark Office - U.S. 9,020,697 Maintenance Fee Payment Records
1103	U.S. Patent and Trademark Office - U.S. 9,123,186 Maintenance Fee Payment Records
1104	U.S. Patent and Trademark Office - U.S. 9,140,560 Maintenance Fee Payment Records
1105	U.S. Patent and Trademark Office - U.S. 9,147,153 Maintenance Fee Payment Records
1106	U.S. Patent and Trademark Office - U.S. 9,147,297 Maintenance Fee Payment Records
1107	U.S. Patent and Trademark Office - U.S. 9,173,100 Maintenance Fee Payment Records
1108	U.S. Patent and Trademark Office - U.S. 9,290,153 Maintenance Fee Payment Records
1109	U.S. Patent No. 9,147,296 Certified File History (“the ’296 File History”)
1110	Flextronics “Flex celebrates 10 years of maintaining Ford’s prestigious Q1 quality certification in Guadalajara, Mexico” (Posted

Exhibit No.	Description
	April 2, 2024) Available at https://flex.com/resources/10-years-of-maintaining-fords-q1-quality-certification
1111	<i>Intentionally left blank.</i>
1112	Scheduling Order, <i>AutoConnect Holdings LLC v. Ford Motor Company</i> , Case No. 1:24-cv-01327-JCG (D. Del) (“Scheduling Order”)
1113	U.S. Provisional Application No. 61/811,981 File History (“the ’981 File History”)
1114	<i>Intentionally left blank.</i>
1115	Defendant’s Motion to Dismiss, <i>AutoConnect Holdings LLC v. Ford Motor Company</i> , Case No. 1:24-cv-01327-CFC (D Del.) Filed February 14, 2025 (“Motion to Dismiss”)
1116	US 9,020,153 Patent Assignment Abstract (“the ’153 Patent Assignment Abstract”)
1117	Zetter, Mark “Ford and Flextronics automotive EMS, Venture Outsource” February 2010 (Available at https://ventureoutsource.com/contract-manufacturing/industry-pulse/ford-and-flextronics-automotive-ems , accessed November 18, 2025) (“Ford Flextronics EMS”)
1118	Schröter, Anke “Ford partners with Flextronics, evertiq.com”, February 12, 2010, (Available at https://evertiq.com/news/16197? , accessed November 18, 2025) (“Ford Flextronics 2010”)
1119	“Which Ford vehicles are compatible with Apple CarPlay?” (Available at https://www.ford.com/support/how-tos/sync/getting-started-with-sync/which-vehicles-are-compatible-with-apple-carplay/ Accessed November 18, 2025) (“Ford AppleCarPlay”)
1120-1198	<i>Intentionally left blank</i>
1199	Declaration of Yasmeen Moradshahi

I. INTRODUCTION

This Request for Rehearing of the Decision denying institution (Paper 29, “Decision”) presents important issues of law and policy concerning the Director’s holistic approach to discretionary denial analysis under 35 U.S.C. § 314(a). The Decision rests on the incorrect premise that Petitioner maintained inconsistent positions across forums. Before the Director issued the Decision on May 12, 2026, Petitioner *withdrew* its indefiniteness positions on April 2, 2026 and secured a *stay* of the related litigation on April 16, 2026. Petitioner sought authorization to introduce these developments into the record, but the Office denied those requests, leaving the Decision to assess alleged inconsistency without considering dispositive facts that had already eliminated the alleged inconsistency. The Decision therefore rests on a factual premise that was no longer accurate at the time it issued. On the full record, there is no inconsistency and this IPR is a true alternative to litigation. *See Magnolia Med. Techs., Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17 at 2 (PTAB May 14, 2026) (Precedential).

Magnolia makes clear that discretionary denial is driven by holistic analysis of discretionary considerations to determine whether the IPR functions as an alternative to litigation—not by rigid policing of litigation conduct in isolation. Where, as here, litigation is stayed and validity will be resolved exclusively by the USPTO, there is no inconsistency. The Decision did not account for the stay or

withdrawal of indefiniteness. Those developments independently eliminate any concern about parallel proceedings or inefficiency and do not support discretionary denial under the Director’s current framework.

Rehearing is warranted under 37 C.F.R. § 42.71(d) because the Decision: 1) overlooks material developments (withdrawal and stay); and 2) is inconsistent with the Director’s controlling guidance in *Magnolia*.

II. ARGUMENT

The Director denied institution concluding that Petitioner’s conduct suggested the dispute was “less about a litigation alternative and more about inconsistent positions to gain an upper hand in the overall litigation.” (Paper 29, at 3 citing *Terumo BCT, Inc. v. Haemonetics Corp.*, IPR2025-01374, Paper 20 (Director May 12, 2026) (informative).

The Decision’s reliance on *Terumo* is misplaced. In *Terumo*, the petitioner maintained inconsistent positions across active parallel proceedings. *Terumo*, IPR2025-01374, Paper 20 at 3–5. Here, by contrast, the Petitioner is not pursuing indefiniteness of the ’153 Patent in the related litigation and that litigation is stayed pending the outcome of USPTO proceedings. Accordingly, the concern identified in *Terumo*—using multiple forums to advance inconsistent positions—does not exist here.

In *Magnolia*, the Director explained that AIA reviews are intended “to provide

a quick and cost-effective *alternative* to district court patent litigation,” and should not be used “for harassment or a means to prevent market entry through repeated litigation and administrative attacks.” *Magnolia*, Paper 17 at 2 (emphasis in original). The Director further emphasized that discretionary denial is guided by “the public interest rather than the private interests of the parties,” including considerations such as “the economy, efficient administration of the Office, the ability of the Office to timely complete its AIA reviews, and the integrity of the patent system.” *Id.*, at 6.

The Decision issued prior to *Magnolia* and focused on *Fintiv* factor analysis related to Petitioner’s indefiniteness positions at the PTAB and in District Court. As explained below, Petitioner (A) sought IPR as a true alternative to litigation and (B) not as a tool for duplicative challenges, e.g., by withdrawing indefiniteness and securing a stay of the related litigation; Petitioner is a well-known American manufacturer and therefore (C) this IPR would protect American manufacturing interests; and (D) the settled expectations of the parties favor institution and advance the public interest.

A. *Magnolia* Factors A and B: Petitioner Sought IPR as a True Alternative to Litigation and Not as a Tool for Duplicative Challenges, as the Related Litigation Is Stayed and Indefiniteness Is Not Asserted

The Director clarified in *Magnolia* that “[t]he purpose of AIA reviews ... is,

to provide a quick and cost-effective *alternative* to district court patent litigation for resolving disputes over patent validity.” *Magnolia*, Paper 17 at 2 (emphasis in original) citing H.R. Rep. No. 112-98 at 48 (2011).

1. The *Fintiv* Factors Confirm That This IPR Functions as an Alternative to Litigation

The *Fintiv* factors strongly favor institution in view of the litigation being stayed and other relevant facts detailed below. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020) (Precedential). Under *Magnolia*, a stay reinforces that the IPR is functioning as a true alternative to litigation. *Magnolia*, Paper 17 at 4 (“Additionally, some district courts are unlikely to stay co-pending litigation so an AIA review is in *addition* to, not an *alternative* to, the litigation.” (Emphasis in original.)) Where litigation is stayed, as is the case here, the concern that AIA review is proceeding “in parallel with litigation to gain litigation leverage” is eliminated, and the proceeding necessarily functions as an alternative rather than an addition to district court litigation.

Factor 1 strongly favors institution because the District Court stayed the Related Litigation pending resolution of the USPTO proceedings. *AutoConnect Holdings LLC v. Ford Motor Comp.*, 1:24-cv-01327-JCG, ECF 72 (D. Del. Apr. 16, 2026). In granting the stay, the District Court found that “[g]iven the volume of patents at issue in this litigation and the reviews already instituted against ten of the

thirteen asserted patents ... there is a strong likelihood that the USPTO proceedings will simplify the issues before the Court and conserve the resources of the Parties and this Court.” *Id.*, 3. The District Court therefore “ORDERED that the case is stayed pending the issuance of a final written decision in **each** of the respective *inter-partes* and *ex-parte* review proceedings.” *Id.*, 5 (emphasis added).

Under *Fintiv*, “[a] district court stay of the litigation pending resolution of the PTAB trial allays concerns about inefficiency and duplication of efforts” and “[t]his fact has **strongly** weighed against exercising the authority to deny institution” *Fintiv*, IPR2020-00019, Paper 11 at 6, citing *Precision Planting, LLC v. Deere & Co.*, IPR2019-01052, Paper 19 at 10 (PTAB Jan. 7, 2020) (emphasis added). Indeed, where a stay is in place, the Board has repeatedly held that discretionary denial concerns are effectively “rendered moot.” *Id.*

Consistent with this principle, the Board has explained that “[i]n light of [a stay], it is not necessary to analyze the *Fintiv* factors in detail because the Underlying Litigations are not currently proceeding in parallel with this case.” *Kea Cloud, Inc. v. Valyant AI, Inc.*, IPR2023-00450, Paper 12 at 17 (PTAB July 19, 2023). Likewise, in *Home Depot U.S.A., Inc. v. Lynk Labs, Inc.*, the Board emphasized that *Fintiv* factors “do not sufficiently weigh towards denial because the stay of litigation is **dispositive**.” PGR2022-00009, Paper 10 at 27–28, (PTAB May 25, 2022) (emphasis added).

Factor 2 strongly favors institution because the originally scheduled trial date of October 25, 2027 (Ex. 1112, 29) is now moot in view of the stay. The stay extends until “issuance of a final written decision in each of the respective *inter-partes* and *ex-parte* review proceedings.” *AutoConnect Holdings LLC*, 1:24-cv-01327-JCG, ECF 72, 5.

Factor 3 strongly favors institution as neither the parties nor the District Court invested significant resources prior to the stay. Discovery had just started and there had yet to be any depositions or expert reports, and the parties had just recently exchanged preliminary claim construction positions before any briefing occurred. (Ex. 1112, 28.)

Factor 4, the overlap between the proceedings strongly favors institution, particularly in view of the stay of the Related Litigation. As the Board explained in *Home Depot*, when litigation is stayed, concerns regarding overlap “do not sufficiently weigh towards denial because the stay of litigation is dispositive.” *Home Depot U.S.A., Inc.*, PGR2022-00009, Paper 10 at 27–28.

Petitioner challenged all claims of the ’153 Patent in the IPR. (Paper 7, 3.) Petitioner filed a *Sotera* stipulation on September 10, 2025, mitigating concerns regarding duplicating efforts and inconsistent conclusions. (Paper 6.) *See Sotera Wireless, Inc v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020). The District Court has since stayed the litigation. Additionally, Petitioner withdrew its

indefiniteness arguments for the '153 Patent in the District Court. (Ex. 3104, 1–2.) As the Board held in *Amazon.com, Inc. v. NL Giken Inc.*, a petitioner's *Sotera* stipulation, combined with withdrawal of district-court indefiniteness positions, weighs against exercising discretion to deny institution under Factor 4. IPR2025-00050, Paper 12 at 11–12 (PTAB May 23, 2025).

Factor 5 is neutral because the parties before the Board and in the Related Litigation are the same. *See Shenzhen Root Tech. Co., Ltd. v. Chiaro Tech. Ltd.*, IPR2024-01296, Paper 9 at 19–20 (PTAB Feb. 25, 2025).

Factor 6 other considerations strongly favor institution, especially in view of the stay. *Home Depot U.S.A., Inc.*, PGR2022-00009, Paper 10 at 27–28 (*Fintiv* factors 4 and 6 “do not sufficiently weigh towards denial because the stay of litigation is dispositive.”)

Under *Revvo*, a petitioner must explain why it takes different claim construction positions in the petition and in district court. *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 (Director Nov. 3, 2025) (Precedential). Patent Owner argued that Petitioner had taken inconsistent claim construction positions without sufficient explanation. (Paper 16, 1–2.) The Director concluded that Petitioner's conduct suggested the dispute was “less about a litigation alternative and more about inconsistent positions to gain an upper hand in the overall litigation.” (Paper 29, 3 citing *Terumo*, IPR2025-01374, Paper 20.)

Petitioner’s conduct demonstrates that it pursued IPR as a litigation alternative. Specifically Petitioner: **(a)** Raised indefiniteness with respect to the *scope* of the claim language; **(b)** Filed a *Sotera*-like indefiniteness stipulation, then withdrew indefiniteness from the litigation, in-line with evolving PTAB guidance; and **(c)** Filed a motion to stay the related litigation once all asserted patents were challenged, and the District Court recently granted that motion.

**a. Petitioner Originally Pursued Indefiniteness
Consistent with *Tesla* due to Unclear Claim
Scope Boundaries**

In *Tesla*, the Director expressly rejected the notion that all indefiniteness challenges give rise to claim-construction gamesmanship. *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 (Director Nov. 5, 2025) (informative). Instead, the Director drew a clear distinction between challenges premised on an inability to understand claim meaning and those based on uncertain claim scope boundaries, explaining that discretionary denial would not be warranted where, “notwithstanding the alleged indefiniteness of the claim term, an ordinarily skilled artisan would understand that the asserted art satisfies the claim limitation (such as if the limitation prescribed a range and only the outer bounds of the range were unclear).” *Id.*, 3–4. The challenged claims of the ’153 Patent fall squarely in this category.

The ’153 Patent does not use the terms “one or more,” and “and/or” in their

conventional sense. Instead, the '153 Patent expressly defines those terms as “open-ended expressions that are *both conjunctive and disjunctive* in operation.” (Ex. 1001, 15:63-65, emphasis added.) Petitioner argued in district court that this definition renders all independent claims (i.e., claims 1, 11, and 12) indefinite because a list of claim elements cannot be “both conjunctive and disjunctive.” Ex. 1115, at 3, 9–10, 13. While the District Court denied Petitioner’s motion to dismiss as premature at the pleading stage, explaining that “a determination on indefiniteness under 35 U.S.C. § 112 is not appropriate at the motion to dismiss stage,” and that indefiniteness is “intertwined with claim construction”, it agreed that Patent Owner’s definition for the terms provided in the patent specification was “nonsensical.” (Ex. 2006, 10, 8.) Overlooking the definition, Patent Owner argued that the “claims cover both ‘the presence of more than one of the listed items’ and ‘the presence of a single listed item[,]’” but it does not have to “choose between the conjunctive and disjunctive meanings.” *Id.* at 7.

The Decision concludes that Petitioner’s indefiniteness positions are “broader” than the limitations addressed under *Tesla*. (Decision, 3.) That conclusion is moot because those positions have been withdrawn. The operative question under *Magnolia* is not whether those positions once existed, but whether the IPR functions as a litigation alternative. Here it does.

b. Petitioner Aligned its Positions with Evolving PTAB Guidance

Although the District Court found “Plaintiff’s use of ‘and/or’ as both conjunctive and disjunctive” to be “nonsensical because a limitation cannot have simultaneously A and B and C *and* A or B or C[;]” it denied Petitioner’s motion to dismiss the claims as being indefinite as procedurally premature. (Ex. 2006, 8, emphasis in original). To avoid waiver of its statutory defense, Petitioner served initial invalidity contentions on February 6, 2026 with indefiniteness grounds.

Before those contentions, Petitioner filed a *Sotera* stipulation on September 10, 2025 stating that: “If the PTAB institutes IPR2025-01383, Petitioner will not pursue against the ’153 Patent in [the Related Litigation] ‘the specific grounds [asserted in IPR2025-01383], or ... any other ground ... that was raised or could have been reasonably raised in an IPR’” (Paper 6, 1–2.) A petitioner cannot raise challenges under 35 U.S.C. § 112 in an IPR.

However, post-grant review (PGR) does provide for challenges under § 112, therefore a PGR *Sotera* or *Sand Revolution* stipulation includes indefiniteness. *See Samsung Elecs. Co. Ltd. v. CardWare Inc.*, PGR2023-00013, Paper 14 at 22–23 (PTAB Aug. 11, 2023) (granting institution of a PGR challenging patent claims under multiple grounds, including indefiniteness grounds, based on a finding that “Petitioner’s stipulation” to “not pursue section 101 or 112 invalidity grounds in the

related district court litigation *if we institute*” “will reduce the potential overlap that may occur with the district court litigation[.]” (emphasis in original).) Because a petitioner cannot challenge patent claims as indefinite in an IPR, and to eliminate any perceived discrepancy between forums, Petitioner made a *Sotera*-like stipulation, similar to a PGR *Sotera* stipulation, to withdraw all indefiniteness arguments against the ’153 Patent from the Related Litigation if the PTAB maintained institution of this IPR. (Paper 18, 2.) Petitioner’s stipulation would therefore “resolve[.] any potential inconsistency ... between forums[.]” *Caption Health, Inc. v. Univ. of B. C.*, IPR2025-01422, Paper 15 at 3 (Director Dec. 18, 2025).

In *Infineon*, the Director rejected a Petitioner’s stipulation that included a condition precedent that was not controlled by the PTAB, i.e., “if the district court later determines that any of the challenged claims are indefinite, Petitioner will move to withdraw those claims from this proceeding.” *Infineon Techs. Ams. Corp. v. MOSAID Techs. Inc.*, IPR2025-01171, Paper 27 at 4 (Dir. Feb. 19, 2026). Unlike *Infineon*, Petitioner’s stipulation did not ““wait and see”” how a district court would later rule on indefiniteness. *Id.* Instead, Petitioner’s stipulation stated that Petitioner would withdraw indefiniteness in the district court if the Director maintained institution of this IPR, avoiding any potential inconsistency. (Paper 18, 2.)

Subsequent PTAB guidance indicated that the PTAB disfavors *all* conditional

claim construction related stipulations in IPRs. *See e.g., Infineon Techs. Ams. Corp. v. MOSAID Techs. Inc.*, IPR2025-01456, Paper 27 at 4 (Director March 17, 2026). To eliminate any possible ambiguity, Petitioner withdrew its indefiniteness arguments concerning the '153 Patent from the Related Litigation at the beginning of the claim construction process on April 2, 2026, thereby removing any condition precedent and any perceived discrepancy between forums. (Ex. 3104.) Further, on May 13, 2026, the PTAB designated multiple decisions as informative, including the Decision, *Terumo*, and *TikTok*, clarifying its guidance rejecting *Sotera*-like claim construction related stipulations in IPRs. *Terumo*, IPR2025-01374, Paper 20; *TikTok, Inc. v. Shopsee, Inc.*, IPR2025-01485, Paper 13 (Director Jan. 16, 2026) (informative).

In the Decision, the Director denied institution based on the premise that Petitioner maintained materially inconsistent claim-construction and indefiniteness positions across forums and that subsequent efforts to cure were “insufficient.” (Paper 29, 3.) That premise rests on a misapprehension of the factual record. On April 2, 2026, Petitioner served supplements to its Invalidity Contentions that withdrew indefiniteness assertions for the identified patents, including the '153 Patent. The supplemented Exhibit for the '153 Patent correspondingly omits the prior indefiniteness section. Also on April 2, 2026, Petitioner contacted the PTAB seeking authorization to file these materials in the IPR record specifically to inform

the Director that “Petitioner ha[d] withdrawn its indefiniteness assertions in the related litigation with respect to the patents challenged in [this] IPR[]”, but the Office denied that request. (Ex. 3104, 1–2.) Petitioner also contacted the PTAB on April 17, 2026 seeking authorization to file the District Court’s Order of April 16, 2026 staying the related litigation based on USPTO proceedings challenging the asserted patents, including this IPR. Although the PTAB has not yet responded to the request, Petitioner cites the public record for this order herein. *The Decision thus evaluates the alleged “inconsistency” on a record that Petitioner was not permitted to supplement with evidence demonstrating that any potential inconsistency had been eliminated.*

Petitioner’s conduct reflects good-faith compliance with evolving PTAB guidance—and should not weigh against institution.

**c. Discretionary Denial Is Not Warranted Where
Petitioner Narrowed Parallel Issues and Sought
to Channel Patentability to the Office by
Successfully Staying the Related Litigation**

Petitioner filed a motion to stay the related litigation after challenges were filed against each asserted patent. *See* Paper 9, 6–7. The District Court granted the motion on April 16, 2026. *AutoConnect Holdings LLC*, 1:24-cv-01327-JCG, ECF 72. Petitioner promptly contacted the PTAB on April 17, 2026 to request authorization to file the Court Order in these IPRs.

B. *Magnolia* Factor C: Petitioner Is a U.S.-Based Manufacturer and therefore This IPR would Protect American Manufacturing Interests

Petitioner is a top U.S.-based automobile manufacturer who manufactures millions of vehicles in the U.S. each year. Because Patent Owner accuses those vehicles of infringing the '153 Patent (Ex. 1005, 77), Petitioner's U.S. manufacturing is directly affected. *See also* Paper 15, 5. This aligns with *Magnolia*'s recognition that “the availability of IPRs” are “important to protect American manufacturers.” *Magnolia*, Paper 17 at 4 (citations omitted).

C. *Magnolia* Factor D: The Settled Expectations of the Parties Favor Institution and Advance Public Interest

In *Magnolia*, the Director treats the settled expectations doctrine as part of the broader public-interest inquiry, recognizing that disrupting established expectations can weigh against institution because it undermines predictability, fairness, and the efficient administration of the patent system. *Magnolia*, Paper 17 at 6. However, the “[s]ettled expectations of either party may be a factor in determining whether to institute an AIA review.” *Id.*, 8. For example, “a petitioner may have its own settled expectations when a patent has not been commercialized, asserted, licensed, or otherwise applied in a petitioner’s technology space.” *Id.*, 9 citing *Home Depot U.S.A., Inc. v. H2 Intellect LLC*, IPR2025-00480, Paper 11 (Director Sept. 4, 2025) (informative).

Here, the Director has previously found that the settled expectations of both parties' favor institution. (Paper 11, 2–3.) The Director decided Petitioner “had settled expectations that the challenged patents would not be asserted against it based upon ... its business relationship with the original owner of the challenged patents, Flextronics AP, LLC (“Flextronics”).” *Id.*, 2. The Director further explained that it was, “eminently reasonable for [Petitioner] to expect its supplier, ... [would] have all necessary licenses” for the products it continued to sell to Petitioner. *Id.*, 3. Therefore, Petitioner’s “decade-long and continuous customer-supplier relationship, ... developed a well-settled expectation that it would not be accused of infringing the challenged patents.” *Id.*

Further, Patent Owner’s history of allowing its patents to lapse (Exs. 1102-1108) “cut[s] against any settled expectations that Patent Owner had developed ...” (Paper 11, 3) and undermines the integrity of the Patent System.

III. REQUEST FOR RELIEF

For the foregoing reasons, Petitioner respectfully requests rehearing and that the decision denying institution be vacated as to the ’153 Patent, and institution granted.

Dated: May 27, 2026

Respectfully submitted,

/ Andrew B. Turner /
Andrew B. Turner (Reg. No. 63,121)
John S. LeRoy (Reg. No. 48,158)

Christopher C. Smith (Reg. No. 59,669)
Yasmeen Moradshahi (*Pro Hac Vice*
admission requested)

BROOKS KUSHMAN P.C.
150 W. Second St., Suite 400N
Royal Oak, MI 48067-3846
(248) 358-4400

Attorneys for Petitioner Ford

Certificate of Service

The undersigned hereby certifies that on **May 27, 2026**, a complete and entire copy of **Petitioner's Request for Rehearing**, was served via electronic mail to the attorneys listed below:

LEAD COUNSEL	BACK-UP COUNSEL
Eric A. Zelepugas (Reg. No. 73,302) zelepugas@avantechlaw.com AVANTECH LAW, LLP 80 S 8th St, Suite 900 Minneapolis, MN 55402 Tel: 312-487-2185	Robert A. Conley (Reg. No. 55,846) conley@avantechlaw.com AVANTECH LAW, LLP 80 S 8th St, Suite 900 Minneapolis, MN 55402 Tel: 312-625-7378
USPTO@avantechlaw.com	

Respectfully submitted,

/ Andrew B. Turner /
Andrew B. Turner (Reg. No. 63,121)
John S. LeRoy (Reg. No. 48,158)
Christopher C. Smith (Reg. No. 59,669)
Yasmeen Moradshahi (*Pro Hac Vice*
admission requested)
BROOKS KUSHMAN P.C.
150 W. Second St., Suite 400N
Royal Oak, MI 48067-3846
(248) 358-4400

Attorneys for Petitioner Ford

Certificate of Compliance

This paper complies with the type-volume limitation of 37 C.F.R. § 42.6(a) and the length limitations of 37 C.F.R. § 42.24(a)(1)(v). The paper contains 15 pages, excluding the parts of the paper exempted by § 42.24(a).

This paper also complies with the typeface requirements of 37 C.F.R. § 42.6(a)(ii) and the type style requirements of § 42.6(a)(iii)&(iv).

Respectfully submitted,

Dated: May 27, 2026

/ Andrew B. Turner /
Andrew B. Turner (Reg. No. 63,121)
John S. LeRoy (Reg. No. 48,158)
Christopher C. Smith (Reg. No. 59,669)
Yasmeen Moradshahi (*Pro Hac Vice*
admission requested)
BROOKS KUSHMAN P.C.
150 W. Second St., Suite 400N
Royal Oak, MI 48067-3846
(248) 358-4400

Attorneys for Petitioner Ford