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. 9,123,186 to Ricci

Case No.: IPR2025-01524

PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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List of Exhibits

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1001	U.S. Patent No. 9,123,186 ("the '186 Patent")
1002	U.S. Patent No. 9,123,186 Certified File History ("the '186 File History")
1003	Expert Declaration of Scott Andrews
1004	Scott Andrews Curriculum Vitae
1005	*AutoConnect Holdings LLC v. Ford Motor Company*, 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, *AutoConnect Holdings LLC v. Ford Motor Company*, Case No. 1:24-cv-01327-CFC (D Del.) Filed February 28, 2025 ("Opposition")
1007	*AutoConnect Holdings LLC v. Ford Motor Company*, Ford's Reply In Support of Motion to Dismiss, Case No. 1:24-cv-01327-JCG (D. Del.) Filed March 7, 2025
1008-1009	*Intentionally left blank*
1010	U.S. Patent No. 8,768,539 B1 to Clement ("Clement")
1011-1012	*Intentionally left blank*
1013	U.S. Patent Application Pub. No. 2011/0093153 A1 to Moinzadeh ("Moinzadeh")
1014-1015	*Intentionally left blank*
1016	U.S. Patent No. 9,002,536 B2 to Hatton ("Hatton")
1017	U.S Patent Application Pub. No. 2011/0137520 A1 to Rector ("Rector")
1018	U.S. Patent Application Pub. No. 2008/0245598 A1 to Gratz ("Gratz")
1019-1027	*Intentionally left blank*
1028	2010 Ford F-150 Owner's Manual (Ford Motor Company 2009) ("F-150 Manual")
1029-1049	*Intentionally left blank*
1050	Bosch Handbook, (Automotive Handbook October 2004 6th Edition) ("Bosch")
1051	IEEE Dictionary, (IEEE 100 The Authoritative Dictionary of IEEE Standards Terms 2000 7th Edition) ("IEEE Dictionary")

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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 18th International Symposium on Person, Indoor and Mobile Radio Communications Available at https://www.ieeexplore.ieee.org/document/4394215 ("Hossain")
1054-1055	*Intentionally left blank*
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," *SAE International,* 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	*Intentionally left blank*
1061	Ford SYNC Supplemental Guide, November 2007 ("Sync Guide 2007")
1062	Ford SYNC Supplemental Guide, January 2010 ("Sync Guide 2010")

Exhibit No.	Description
1064	MyFord Touch Ford User Guide Ford Motor Company, February 2012 ("MyFord Touch Guide")
1065-1067	*Intentionally left blank*
1068	Vahid, Frank et al., "Timing is Everything – Why Embedded Systems Demand Early Teaching of Structured Time-Oriented Programming," Proceedings of the 2008 Workshop on Embedded Systems Education, WESE 2008 Atlanta, Georgia October 23, 2008. Available at ("Vahid")
1069	Woerner, Joerg, "Intel and TI: Microprocessors and Microcontrollers" (February 26, 2001). Available at http://www.datamath.org/Story/Intel.htm (Accessed Sept. 9, 2025) ("TI TMS1000")
1070	Pfaffenberger, Bryan (Websters New World Dictionary of Computer Terms 6th Edition (Simon & Schuster, Inc. 1997) ("Computer Terms")
1071	*Intentionally left blank*
1072	McCartney, Scott, "ENIAC The Triumphs and Tragedies of the World's First Computer," (Walker Publishing Co., Inc. 1999) ("ENIAC")
1073	Evans, Christopher "The Micro Millenium" (The Viking Press 1980) ("Micro Millenium")
1074	U.S. Patent No. 7,663,607 B2 to Hotelling et al. ("Hotelling")
1100	United States District Courts – National Judicial Caseload Profile, March 2025
1101	*Intentionally left blank*
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. 9,147,296 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

Exhibit No.	Description
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 April 2, 2024) Available at https://flex.com/resources/10-years-of-maintaining-fords-q1-quality-certification
1111	*Intentionally left blank*
1112	Scheduling Order, *AutoConnect Holdings LLC v. Ford Motor Company*, Case No. 1:24-cv-01327-JCG (D. Del)
1113	U.S. Provisional Application No. 61/811,981 File History ("the '981 File History")
1114	*Intentionally left blank*
1115	Defendant's Motion to Dismiss, *AutoConnect Holdings LLC v. Ford Motor Company*, Case No. 1:24-cv-01327-CFC (D. Del.) Filed February 14, 2025 ("Motion to Dismiss")
1116	*Intentionally left blank*
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	*Intentionally left blank*
1121	Declaration of Melissa Sheahan

Exhibit No.	Description
1122	US 9,123,186 Patent Assignment Abstract ("the '186 Patent Assignment Abstract")
1123	Plaintiff's Opening Claim Construction Brief, *AutoConnect Holdings LLC v. Toyota Motor Corp., et al.*, Case No. 2:24-cv-00802-JRG-RSP (E.D. Tex.) Filed December 9, 2025 ("AutoConnect's Claim Construction Brief")
1124	*AutoConnect Holdings LLC v. Ford Motor Company*, AutoConnect Infringement Contentions, Ex. F2, '186 Patent Excerpt, Case No. 1:24-cv-01327-JCG (D. Del.) Served December 19, 2025
1125	*AutoConnect Holdings LLC v. Ford Motor Company*, AutoConnect Infringement Contentions, Excerpt, Case No. 1:24-cv-01327-JCG (D. Del.) Served December 19, 2025

I. INTRODUCTION

The Board should deny Patent Owner AutoConnect's Request for Discretionary Denial (Paper 6, "Request") because (1) settled expectations favor Ford, not AutoConnect and (2) the *Fintiv* factors strongly favor institution. The facts here are substantially similar to those in Ford's prior IPRs, IPR2025-01342 and IPR2025-01383, where the Director denied similar requests. *Ford Motor Co. v. AutoConnect Holdings LLC*, IPR2025-01342, IPR2025-01383, Paper 10 (Director, Dec. 4, 2025.)

First, Ford's long-standing and continuous business relationship with Flextronics—the original owner of the '186 Patent and supplier of the accused SYNC infotainment system—created well-settled expectations that the '186 Patent would not be asserted against Ford. This expectation was reinforced by Flextronics's ongoing supply of the relevant technology and Ford's lack of notice regarding assignment of the patent. Further, AutoConnect's failure to timely pay maintenance fees, which resulted in the '186 Patent lapsing, cuts against AutoConnect's alleged settled expectations in the patent. These facts, already recognized by the Director in related IPRs, support Ford's reasonable reliance on non-enforcement and undermine any claim that AutoConnect held strong settled expectations in the '186 Patent.

Second, the *Fintiv* factors overwhelmingly favor institution in this proceeding. The related district court litigation is in its early stages, with trial scheduled well

after the projected final written decision in this IPR, and all asserted patents are now subject to post-grant review, increasing the likelihood of a stay. Ford has agreed to a comprehensive *Sotera* stipulation, eliminating concerns about duplicative efforts or inconsistent outcomes, and there is minimal investment in the parallel proceeding to date.

Additionally, the merits of the Petition are strong, and Ford's claim construction positions are consistent. Whereas AutoConnect's approach to claim construction is inconsistent and strategically shifts between proceedings, seeking broad interpretations to support infringement in district court while advocating narrower constructions to avoid unpatentability before the Board. Specifically, AutoConnect argues that "vehicle speed" is not an "*operating state of the vehicle*" in this IPR, despite relying on vehicle motion as an operating state in its infringement contentions in the parallel litigation. This claim construction gamesmanship undermines predictability and fairness. Taken together, these circumstances mirror those in prior related IPRs where the Board denied AutoConnect's requests for discretionary denial.

Accordingly, Ford respectfully requests institution under 35 U.S.C. § 314.

II. ARGUMENT

A. Settled Expectations of the Parties Do Not Weigh in Favor of Discretionary Denial

As in IPR2025-01342 and IPR2025-01383, Flextronics is the original owner of the challenged patent and supplies the accused SYNC infotainment system. Also, like IPR2025-01342, AutoConnect failed to pay the maintenance fee for the challenged patent causing it to lapse. That lapse persisted for more than three years—substantially longer than the nine-month lapse of the '697 Patent in IPR2025-01342.

1. Ford Had Strong Settled Expectations of Non-Enforcement

a. Ford has a long-term business relationship with the original owner of the '186 Patent

Ford released its first-generation SYNC infotainment system in 2007, followed by SYNC 2 in 2010. (Ex. 1061; Ex. 1062.) Ford started working with Flextronics in 2010 to source infotainment technology for use in Ford vehicles. (Exs. 1117, 1118.) Flextronics then filed many patent applications directed to infotainment related technology. For example, Flextronics filed U.S. 14/253,371 on April 15, 2014 that issued as the '186 Patent on September 1, 2015. (Ex. 1001, Cover; Ex. 1002, 6,7.) The '186 Patent claims priority to multiple provisional applications, including U.S. 61/811,981 filed April 15, 2013, which includes a "Functional Specification" that references Ford:

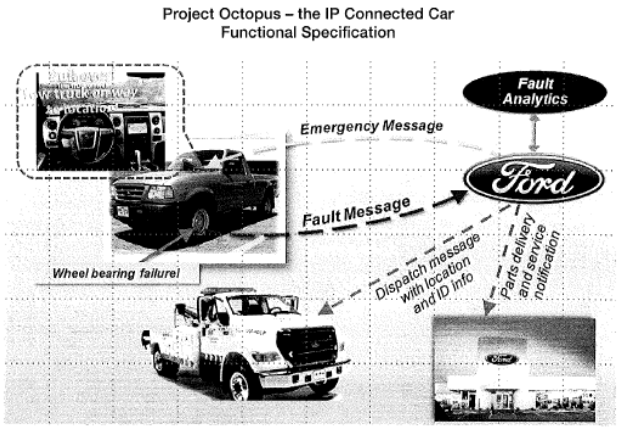


Figure 7 Vehicle Analytics & Customer Sat

Ex. 1113, 158

Flextronics has been supplying SYNC modules to Ford since at least 2014. (Ex. 1121.) Flextronics then assigned the '186 Patent to AutoConnect on May 20, 2015, without retaining a license. (Ex. 1122, 1–3.) Flextronics never informed Ford that it transferred the '186 Patent to a third party. Ford remained unaware of any such transfer until AutoConnect contacted Ford in December 2023. Yet Flextronics continued to supply Ford the accused SYNC system after assigning the '186 Patent. (*See* Ex. 1121, ¶ 4.) Flextronics has publicly touted this long-term relationship. (*See* Ex. 1110 ("Flex celebrates 10 years of maintaining Ford's prestigious Q1 quality certification in Guadalajara, Mexico.").) Ford expects its suppliers to protect their patent portfolios from being asserted against Ford, e.g., by retaining a license before selling an asset covering current products.

The Director has already decided that Ford "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')." IPR2025-01342, Paper 10, 2. The Director further explained that it was, "eminently reasonable for [Ford] to expect its supplier . . . [to] have all necessary licenses" for the products it continued to sell to Ford. *Id*. at 3. This is true for products supplied at the time of the filing date, as well as future products supplied during the life of the '186 Patent. Therefore, Ford'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*.

Moreover, the first sale doctrine and the doctrine of patent exhaustion prevent Flextronics from asserting its patents against products it sells to Ford. *See Impression Products v. Lexmark Intern.*, 581 U.S. 360, 137 S. Ct. 1523, 1533 (2017); *Quanta Computer, Inc. v. LG Electronics, Inc.*, 553 U.S. 617, 128 S. Ct. 2109, 2111 (2008) ("The patent exhaustion doctrine provides that a patented item's initial authorized sale terminates all patent rights to that item.").

AutoConnect argues that this evidence does not "demonstrate that the components alleged to infringe the '186 patent were supplied by Flextronics." (Request, 7.) AutoConnect accuses "All Ford vehicles . . ., vehicle systems (including in-vehicle **multimedia and infotainment systems**), mobile applications . . ., and hardware and software components thereof . . . that enable Ford's Phone As A Key feature" as allegedly infringing the '186 Patent claims. (Ex.

1125, 5.) Ford refers to its infotainment system as "SYNC", and Flextronics supplies the SYNC module to Ford. For example, as explained by Ford's buyer, Melissa Sheahan, Ford has "purchased SYNC modules from Flextronics since at least October 2014 and continuously through today for various versions of Ford's SYNC infotainment systems." (Ex. 1121, ¶ 4.)

b. AutoConnect is a non-practicing entity

The '186 Patent had not "been commercialized, asserted, marked, licensed, or otherwise applied in a petitioner's particular technology space, if at all" before AutoConnect contacted Ford in December 2023. *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12, 2-3 (PTAB June 26, 2025). As a non-practicing entity (NPE), AutoConnect has not commercialized or marketed products with the '186 Patent. Further, AutoConnect first publicly asserted the '186 Patent in October 2024 against Toyota, and there is no record of AutoConnect licensing the '186 Patent.

c. AutoConnect held the '186 Patent for more than eight years without alleging infringement

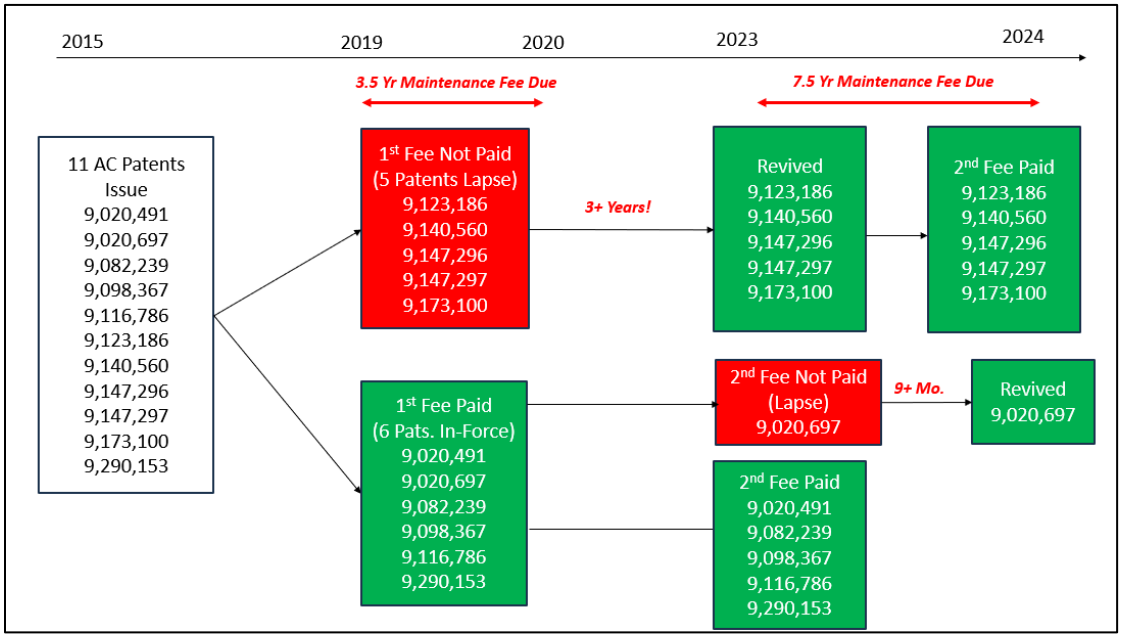
Ford commercialized the SYNC infotainment system in 2007 and partnered with Flextronics to manufacture the second-generation SYNC system in 2010. (Exs. 1117, 1118.) AutoConnect had actual knowledge of Ford's infotainment systems, e.g., by its reference to Ford in its earliest claimed provisional application 61/811,981 filed April 15, 2013 (Ex. 1113, 158), and the original owner of the '186

Patent (Flextronics) supplying the accused product. Nonetheless, AutoConnect did not assert the patent against Ford until December 2023, and did not assert the patent publicly against any party until suing Toyota in October 2024. This is an additional reason Ford did not expect to face the ’186 Patent in litigation.

2. AutoConnect’s Failures to Pay Maintenance Fees Cut Against Any Settled Expectations

AutoConnect argues that “[t]he ‘186 patent has been in force for over 10 years, which in and of itself creates settled expectations.” (Request, 4.) Although the ’186 Patent issued in 2015, AutoConnect failed to pay the 3.5-year maintenance fee resulting in the ’186 Patent lapsing for more than three years. (Ex. 1103.) Accordingly, the ’186 Patent has not been in force for over 10 years.

AutoConnect has a history of allowing its patents to lapse. AutoConnect allowed five asserted patents to lapse in 2019 for failure to pay the first maintenance fee: U.S. 9,123,186 (Ex. 1103; Ex. 1002, 729-730, 745); U.S. 9,140,560 (Ex. 1104); U.S. 9,147,296 (Ex. 1105; Ex. 1109, 1086-1087); U.S. 9,147,297 (Ex. 1106); and U.S. 9,173,100 (Ex. 1107). AutoConnect also allowed one asserted patent to lapse approximately four years later in 2023 for failure to pay the second maintenance fee: U.S. 9,020,697 (Ex. 1102).



Patent Lapse Timeline

As illustrated in the above Timeline, during these time periods when AutoConnect missed maintenance fee payment deadlines on certain patents e.g., the '186 Patent, (shown in red); it timely paid maintenance fees on other patents, such as the '153 Patent (shown in green). (*See* Exs. 1103, 1108.) AutoConnect's assertions that it had settled expectations in its patents are undermined by the fact that it allowed six of thirteen asserted patents to lapse.

The Director has found that a patent owner's failure to timely pay maintenance fees and maintain its patents in-force "cut[s] against any settled expectations that Patent Owner had developed . . . ." IPR2025-01342, Paper 10, 3. AutoConnect attempts to minimize the lapse by alleging it took "prompt corrective action." (Request, 9.) But, taking over three years to revive a lapsed patent is far from prompt.

AutoConnect also argues that its many lapses "all stem from a single, discrete administrative circumstance[.]" (Request, 10.) However, this argument ignores the fact that AutoConnect allowed the '697 Patent to lapse in 2023, four years after allowing five other patents, including the '186 Patent, to lapse.

B. The *Fintiv* Factors Favor Institution

The *Fintiv* factors strongly favor institution. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (Precedential); *see also* March 26, 2025 Memorandum: Interim Processes for PTAB Workload Management ("March 2025 Memo").

1. Factor 1: The Likelihood of a Stay Favors Institution or is Neutral

Factor 1 favors institution or is neutral. AutoConnect argues that a stay is unlikely because not all asserted patents are challenged by IPRs. (Request, 10.) However, now all 13 asserted patents have been challenged in either an IPR or EPR. Ford plans to move to stay the related litigation based on the IPRs and EPRs challenging all thirteen asserted patents.

The D. Delaware Court is likely to grant a stay. Courts favor a stay when USPTO reviews cover all asserted claims, since the "review could dispose of the entire litigation: the ultimate simplification of issues." *VirtualAgility Inc. v. Salesforce.com, Inc.*, 759 F.3d 1307, 1314 (Fed. Cir. 2014). Delaware courts extend this principle to all USPTO post-grant challenges including EPRs, noting that PTO

expertise streamlines prior art disputes. *Monitoring v. Get-Grin Inc*., No. 22-647-WCB, 2024 WL 1603403, *5-6 (D. Del. Apr. 9, 2024); *Ever Win Int'l Corp. v. RadioShack Corp*., 902 F. Supp. 2d 503, 505-07 (D. Del. 2012).

In Delaware, stays are often granted when all asserted claims are challenged by IPRs. *Consumeron, LLC v. MapleBear Inc*., No.1:21-1147-GBW-MPT, 2023 WL 3434002, at *2 (D. Del. May 12, 2023) (granting a stay where the IPR proceedings "encompass all of the currently asserted claims of all of the patents-in-suit"). Stays are also granted when asserted patents are challenged by EPR. *Rampart IC, LLC v. Egg Med., Inc*., 1:24-cv-00643, 2025 WL 1100626, *5 (D. Del. Apr. 14, 2025) (granting a stay where EPR requests were granted against all claims) (Jennifer Choe-Groves J. (presiding over the district court case against Ford)).

The Delaware Court will also grant a stay when less than all asserted patents are challenged, but there is overlap in the patents. *See e.g., NEC Corp. v. Peloton Interactive, Inc*., No. 22-987-CJB, 2024 WL 1533952, *1 (D. Del. Apr. 9, 2024) (granting a stay, where two of the three asserted patents were subject to pending IPRs given the "real overlap" between the patents); *Speyside Med., LLC v. Medtronic CoreValve, LLC*, No. 1:20-cv-00361-JLH-CJB, D.I. 155 (D. Del. Sept. 30, 2021) (granting a stay where three of the five patents were challenged given "common specification and similar claim language" between the patents). Here, there is substantial overlapping subject matter in the asserted patents. For example,

the ’153 Patent is a continuation of the ’697 Patent, and both claim priority to the same seven provisional applications as the ’186 Patent. (Pet. 5; IPR2025-01342, Paper 6, 6.) Accordingly, Factor 1 favors institution or is at the very least neutral.

2. Factor 2: The Parallel Trial Date Weighs Against Discretionary Denial

Factor 2 strongly favors institution. The parallel litigation in Delaware is in its early stages, and trial is scheduled for October 25, 2027—over seven months after the final written decision here. (Ex. 1112, 29.)

Referencing the timing of its litigation with Toyota in the Eastern District of Texas, AutoConnect argues that it would be inefficient “to have three separate proceedings involving validity challenges of the ’186 Patent[.]” (Request, 12.) However, Ford is not a party to that litigation, and the PTAB has “found that *Fintiv* factor 2 weighed strongly against exercise of discretion” when “Petitioner is not a party to the [other] Litigation.” *Bose Corp., v. Koss Corp*., IPR2021-00612, Paper 15, 24 (PTAB Sept. 15, 2021) *citing Owens Corning Roofing & Asphalt, LLC v. Kirsch Research & Dev., LLC*, IPR2020-01389, Paper 11, 11 (PTAB Feb. 18, 2021). *See also Multi-Color Corp. v. Brook & Whittle LTD*, PGR2025-00025, Paper 10, 2 (PTAB July 16, 2025) (“Other factors counsel against discretionary denial . . . [e.g.,] Petitioner is not a party to either proceeding[.]”)

Additionally, if there is any inefficiency—it is due to AutoConnect asserting

the ’186 Patent in two different venues: Delaware and Texas. Further, AutoConnect should have reasonably expected at least one USPTO challenge.

3. Factor 3: The Investment in Parallel Proceedings Weighs Against Discretionary Denial

Factor 3 strongly favors institution. By institution, neither the parties nor the D. Delaware court will have invested significant resources in the litigation. Discovery has just started, AutoConnect recently provided its initial infringement contentions (Ex. 1124), and the claim construction hearing is scheduled for September 3, 2026. (Ex. 1112, 28.)

4. Factor 4: The Overlap Between the Petition and the Parallel Proceeding Weighs Strongly Against Discretionary Denial Because Ford Agreed to Sotera Stipulations

Factor 4 strongly favors institution. Ford challenged all claims of the ’186 Patent in the IPR. (Pet., 4.) Further, Ford filed a *Sotera* stipulation on October 22, 2025, mitigating concerns regarding duplicating efforts and inconsistent conclusions. (Paper 5.) *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (Precedential).

5. Factor 5: Whether the Parties Are the Same Is Neutral

Factor 5 is neutral. The parties before the Board and in the related district court litigation are the same. *See Shenzhen Root Tech. Co., Ltd. v. Chiaro Tech. Ltd*., IPR2024-01296, Paper 9, 19-20 (PTAB Feb. 25, 2025) (finding this factor neutral

where parties are the same in both proceedings).

6. Factor 6: Other Considerations, Including the Strength of the Petition, Weigh Strongly Against Discretionary Denial

Factor 6 strongly favors institution because the Petition presents compelling merits and because the district court litigation is complex.

a. The Petition properly relies on expert testimony

AutoConnect argues that the declaration of Mr. Andrews (Ex. 1003) "fill[s] in the gaps between the prior art and the claims[.]" (Request, 16.) Without citing a specific example of gap-filling, AutoConnect faults the Petition for citing to the declaration 233 times, and that the declaration has more pages than the Petition. (*Id*.)

In the March 2025 Memo, the Acting Director indicated that she would consider the "extent of the petition's reliance on expert testimony[.]" (March 2025 Memo, 2.) In *iRhythm*, the Director held that this factor weighs towards institution when the expert "explain[s] the background knowledge" of a POSA, "provides citations to evidence in support of his statements," and does not "fill gaps in the prior art." *iRhythm Techs., Inc. v. Welch Allyn, Inc*., IPR2025-00377, Paper 10, 2-3 (PTAB Jun. 6, 2025).

Mr. Andrews did just that—he provided a detailed explanation of the state-of-the art, including Ford's prior commercialization of the Sync infotainment system in 2007—six years before the earliest claimed filing date of the '186 Patent. (Ex. 1003,

¶¶ 85–116.) Mr. Andrews also provided ample citations to evidence in support of his opinions. As in *iRhythm*, the Petition's degree of reliance on Mr. Andrews's expert opinion weighs towards institution. Ford relies on its expert to explain what a POSA would have understood at the relevant time in view of supporting evidence. *See Xerox Corp. v. Bytemark, Inc*., IPR2022-00624, Paper 9 (PTAB Aug. 24, 2022) (Precedential). At no point does the Petition rely solely on Mr. Andrews's opinion to fill a gap in the prior art.

b. Ford did not engage in inconsistent claim construction

AutoConnect alleges that the Petition should be denied because Ford purportedly took "inconsistent positions on claim construction" before the Board and the D. Delaware Court. (Request, 17–18 (citing *Tesla Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 (Director Nov. 5, 2025)).) That allegation fails. Although both Ford and Tesla raised indefiniteness in the district court, the similarity ends there. In *Tesla*, the petitioner argued that a POSA could not ascertain the meaning of the phrase "generating said target feature information from said data statistics." *Id*. at 2. Ford's indefiniteness challenge, by contrast, is directed to structural ambiguity in the claims themselves—specifically, the indeterminate outer boundaries created by stacked "at least one of" and "and/or" claim terms. (Ex. 1115, 16.)

In *Tesla*, the Director expressly rejected the notion that all indefiniteness challenges give rise to claim-construction gamesmanship. To the contrary, the Director drew a clear line between challenges premised on an inability to understand claim meaning and those based on uncertainty as to a claim's boundaries, explaining that discretionary denial would not be warranted where, "notwithstanding the alleged indefiniteness of the claim term, an ordinary 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)." *Tesla*, Paper 18, 3–4. Ford's indefiniteness challenge fits squarely within this expressly sanctioned category. It targets ambiguity concerning the boundary of the claims arising from the patent's express definition of "and/or" that includes *both* the disjunctive and the conjunctive – something the District Court stated was "nonsensical." (Ex. 2006, 8.) Ford's challenge was not based on an inability of a POSA to understand the claim terms themselves separate from the use of "and/or" as defined.

Moreover, Ford expressly applied the prior art under both the narrower conjunctive ("and") and the broader disjunctive ("or") interpretations of the claim term "and/or," eliminating any suggestion of claim-construction gamesmanship.

In Ground 1, the Petition applied AutoConnect's broader "or" construction and demonstrated that Gratz discloses the claimed "*operating state of the vehicle*" limitation. (Pet. 31–32.) In Ground 3, the Petition further explained that Moinzadeh

discloses both "*an operating state of the vehicle*" (Pet. 71–72) and an "*area and/or zone occupied by the vehicle occupant*." (Pet. 81–83.) Thus, under any construction of "and/or," a POSA "would understand that the asserted art satisfies the claim limitation," placing Ford's challenge squarely within the category the Director deemed appropriate in *Tesla*. *Tesla*, Paper 18, 3.

c. AutoConnect, not Ford, engaged in inconsistent claim construction

AutoConnect's argues "vehicle speed" is not an "*operating state of the vehicle*." (Request, 19.) AutoConnect does not provide any reasons in support; instead, it merely alleges the Petition relies on unsupported expert testimony. First, this is not true. As pointed out in both the Petition and the Andrews Declaration, the '186 Patent states, "[t]he vehicle control system 204 may also determine an operating state of the vehicle, e.g., **in motion**, parked, in gear, in neutral, and the like." (Ex. 1001, 114:39-41; Pet., 7; Ex. 1003, ¶60.) Determining "in motion" means determining the vehicle has a speed greater than zero. Therefore, "vehicle speed" is an "*operating state of the vehicle*." Second, this is a claim-construction dispute best considered after institution where the parties can fully brief the issue. Indeed, the Request did not include any *Phillips* analysis. *Phillips v. AWH Corp*., 415 F.3d 1303 (Fed. Cir. 2005) (en banc)

AutoConnect's argument that vehicle speed is not "*an operating state of the*

vehicle" implies a narrow claim construction of "*operating state*" that excludes vehicle speed, and conflicts with its specification and construction for litigation. AutoConnect did not construe "*operating state*" with respect to the '186 Patent in district court in the Toyota/GM Litigation, instead relying on plain and ordinary meaning. (Ex. 1123.) Further, AutoConnect relies on vehicle motion for its infringement contentions against Ford, *i.e*., "For example, the ability to unlock a door or start the engine using the Phone As A Key is available only when the vehicle is in a non-operating state (*e.g.,* **not in motion** or parked with the engine off, respectively) . . . ." (Ex. 1124, 6.)

Under *Phillips*, the plain and ordinary meaning of a term is interpreted in view of the patent specification. *Phillips v. AWH Corp.*, 415 F.3d at 1315–16 ("the best source for discerning the proper context of claim terms is the patent specification") (internal citations omitted). As discussed above, the '186 Patent explains that vehicle state includes "in motion," i.e., a vehicle speed greater than zero. (Ex. 1001, 114:39-41; Petition, 7.) Therefore, AutoConnect's argument here that Gratz's determining of vehicle speed is not determining . . . "*an operating state of the vehicle*" implies a narrow construction that is inconsistent with its broad proposed construction in district court. This is an example of impermissible gamesmanship where AutoConnect seeks broader claim construction for infringement and narrower claim constructions to attempt to avoid invalidity. *Revvo Techs., Inc. v. Cerebrum Sensor*

Techs., Inc., IPR2025-00632, Paper 20 (PTAB Nov. 3, 2025) (explaining that claim-construction gamesmanship "does not further the Office's goal of 'providing greater predictability and certainty in the patent system.'") (internal citations omitted).

d. Petitioner demonstrated a reasonable expectation of success in combining the references

AutoConnect argues that Ford's reasons for combination are deficient for failing to use the "magic words" "reasonable expectation of success." (Request, 18.) But no such requirement exists. Rather, the Petition need only demonstrate that a POSA would have had a reasonable expectation of success in combining the references. Here, both Ford and Mr. Andrews performed a complete *KSR* analysis in Grounds 1 and 2, explaining the similarities between the prior art, why the references would have been predictably combined, that the combinations involve "merely a software modification" well within the level of ordinary skill, and that the combinations reflect "the combination of prior-art elements (safety restrictions and driver-created settings) according to known methods." These analyses make clear that a POSA would have had a reasonable expectation of success in combining the references. (See, e.g., Pet. 17–18, 46–47, 49, 50–51.)

e. Complex litigation favors institution

AutoConnect argues that "the validity determination will turn on competing expert analysis, which is best assessed through live expert testimony in district

court." (Request, 16.) On the contrary, the Board is best suited to address the complex technical issues raised here because the PTAB Administrative Patent Judges (APJs) have technical backgrounds and are paneled based on the technology of the challenged patent. (PTAB Standard Operating Procedure 1, Revision 16, June 12, 2024, Section E, "Paneling by technology", 8.) The District of Delaware, where the related litigation is pending, recently expressed a similar view. *Monitoring*, 2024 WL 1603403, *5 (D. Del. Apr. 9, 2024) ("Put more simply, it makes sense to ask the agency that issued the patent in the first place to decide whether it made a mistake, rather than to ask a court and eight jurors–strangers to the original issuance decision—to take the lead in second-guessing the PTO's issuance decision.").

The PTAB has held that it is more efficient for the PTAB to resolve disputes between parties when there is a large number of parties and patents in a multitude of districts. *See Harbor Freight Tools USA, Inc. et al. v. Champion Power Equipment, Inc*., IPR2025-00805, Paper 20 (PTAB Sept. 19, 2025) (Decision Referring to the Board—where the district court litigations involved thirteen patents asserted in multiple district courts); *see also Berkshire Hathaway Energy Co. et al. v. Birchtech Corp*., IPR2025-00274, Paper 23 (PTAB July 2, 2025). Here there are fifteen different patents asserted against three different parties in two jurisdictions.

The Board has also held that "[t]he large number and vast scope of the patents asserted in the district court litigation . . . weighs against discretionary denial, as the

Board is better suited to review a large number of patents involving diverse subject matter." *Shenzen Touzhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-00438, Paper 10, 3 (PTAB July 17, 2025) (Decision Referring to the Board) *citing Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9, 2-3 (Director June 13, 2025). Here, the vast scope of the asserted patents is evidenced by the different prior art combinations asserted in each proceeding.

C. Institution of Ford's IPR Petition Is Appropriate

Denial under 35 U.S.C. §325(d) is not warranted because the applied art was not considered nor cited during the examination of the '186 Patent. (Pet., 8; Ex. 1001, 1–4.)

III. CONCLUSION

Petitioner Ford requests the Board grant institution of the Petition.

Respectfully submitted,

Dated: December 23, 2025

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Certificate of Service

The undersigned hereby certifies that on **December 23, 2025**, a complete and entire copy of **Petitioner's Opposition to Patent Owner's Request for Discretionary Denial**, including all new exhibits, was served via electronic mail to the attorneys listed below:

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Certificate of Compliance Pursuant to 37 C.F.R. § 42.24

This paper complies with the type-volume limitation of 37 C.F.R. § 42.24. The paper contains 20 pages, excluding the parts of the paper exempted by §42.24(a).

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