

IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF TEXAS  
MARSHALL DIVISION

AUTOCONNECT HOLDINGS LLC,

*Plaintiff,*

v.

TOYOTA MOTOR CORPORATION, ET

AL.,

*Defendants.*

Case No. 2:24-cv-00802-JRG-RSP  
(Lead Case)

AUTOCONNECT HOLDINGS LLC,

*Plaintiff,*

v.

GENERAL MOTORS LLC

*Defendants.*

Case No. 2:24-cv-00877-JRG-RSP  
(Member Case)

**DEFENDANTS' PRELIMINARY INVALIDITY CONTENTIONS**

Pursuant to Patent Local Rules ("P.R.") 3-3 and 3-4 and the Court's First Amended Docket Control Order (Dkt. No. 53), Defendants Toyota Motor Corporation ("TMC"), Toyota Motor North America, Inc. ("TMNA"), Toyota Motor Engineering & Manufacturing North America, Inc. ("TME"), and Toyota Motor Sales, U.S.A, Inc. ("TMS") (collectively, the "Toyota Defendants"); and General Motors LLC ("GM") (collectively with the Toyota Defendants, "Defendants") hereby make the following initial Invalidity Contentions and provide accompanying document production.

| Ex. | Country | Name/Patent/<br>Application No.                                                                          | Filing/Publication/<br>Issue Date | Inventor(s) | 35 U.S.C. Section<br>102 |
|-----|---------|----------------------------------------------------------------------------------------------------------|-----------------------------------|-------------|--------------------------|
|     | NPL     | Service and User Interface Transfer from Nomadic Devices to Car Infotainment Systems                     | Nov. 11-12, 2010                  | Sonnenberg  | Pre-AIA 102(a) and (b)   |
|     | NPL     | Morphing Smartphones into Automotive Application Platforms                                               | May 2011                          | Bose et al. | Pre-AIA 102(a)           |
|     | NPL     | Terminal Mode — Transforming Mobile Devices into Automotive Application Platforms                        | Nov. 11-12, 2010                  | Bose et al. | Pre-AIA 102(a) and (b)   |
|     | NPL     | RIDING IN A CLOUD:<br>Carmakers sync with Internet via smartphones to inform, entertain, protect drivers | July 3, 2011                      | Swift       | Pre-AIA 102(a) and (b)   |
|     | NPL     | <i>See also</i><br>documents related to system art listed <i>infra</i> II.C                              |                                   |             |                          |

**7. U.S. Patent No. 9,147,296**

| Ex. | Country | Name/Patent/<br>Application No. | Filing/Publication/<br>Issue Date            | Inventor(s)     | 35 U.S.C. Section<br>102 |
|-----|---------|---------------------------------|----------------------------------------------|-----------------|--------------------------|
| G-1 | US      | 7,653,467                       | Jan 24, 2004 / Aug. 26, 2004 / Jan. 26, 2010 | Bachmann et al. | AIA 102(a)(1) and (a)(2) |
| G-2 | JP      | 2003312391                      | April 17, 2002 / Nov. 6, 2003 / N/A          | Bando           | AIA 102(a)(1)            |
| G-3 | US      | 20080306656                     | April 22, 2006 / Dec. 11, 2008 / N/A         | Baumann et al.  | AIA 102(a)(1) and (a)(2) |
| G-4 | US      | 7768380                         | Oct. 29, 2007 / Nov. 27, 2008 / Aug. 3, 2010 | Breed et al.    | AIA 102(a)(1) and (a)(2) |
| G-5 | US      | 9008854                         | May 4, 2012 / Nov. 22, 2012                  | Breed           | AIA 102(a)(1)            |

| Ex.  | Country | Name/Patent/<br>Application No. | Filing/Publication/ Issue<br>Date                                                                              | Inventor(s)     | 35 U.S.C.<br>Section 102    |
|------|---------|---------------------------------|----------------------------------------------------------------------------------------------------------------|-----------------|-----------------------------|
|      |         |                                 | 2012 / April 14, 2015                                                                                          |                 | and (a)(2)                  |
| G-6  | US      | 9,532,207                       | April 30, 2012 / March 6,<br>2014 / Dec. 27, 2016<br>Provisional No.<br>61/480,354, filed on Apr.<br>28, 2011. | Cho et al.      | AIA 102(a)(2)               |
| G-7  | EP      | 2028062                         | July 30, 2008 / Feb. 25,<br>2009 / Jan. 12, 2011                                                               | Coon et al.     | AIA 102(a)(1)               |
| G-8  | US      | 9224289                         | March 15, 2013 / June<br>21, 2014 / Dec. 29, 2015                                                              | Demeniuk et al. | AIA 102(a)(2)               |
| G-9  | JP      | 2010163092                      | Jan. 16, 2009 / July 29,<br>2010 / July 24, 2013                                                               | Endo            | AIA 102(a)(1)               |
| G-10 | US      | 2007/0238491                    | Mar. 31, 2006 / Oct. 11,<br>2007 / N/A                                                                         | He              | AIA 102(a)(1)<br>and (a)(2) |
| G-11 | US      | 2008/0215209                    | Feb. 28, 2008 / Sep. 4,<br>2008 / Nov. 3 2015                                                                  | Ikeda et al.    | AIA 102(a)(1)<br>and (a)(2) |
| G-12 | JP      | 2008213634                      | March 2, 2007 / Sep. 18,<br>2008 / Aug. 15, 2008                                                               | Ikeda et al.    | AIA 102(a)(1)               |
| G-13 | JP      | 2010012823                      | July 1, 2008 / Jan. 21,<br>2010 / July 24, 2013                                                                | Ikeda           | AIA 102(a)(1)               |
| G-14 | US      | 7,602,947                       | Oct. 3, 2006 / Oct. 13,<br>2009 / Oct. 13, 2009                                                                | Lemelson et al. | AIA 102(a)(1)<br>and (a)(2) |
| G-15 | EP      | EP1211141                       | Oct. 31, 2001 / June 5,<br>2002 / N/A                                                                          | Morehouse       | AIA 102(a)(1)               |
| G-16 | US      | 6,584,389                       | Sept. 11, 2000 / June 24,<br>2003 / June 24, 2003                                                              | Reimann et al.  | AIA 102(a)(1)<br>and (a)(2) |
| G-17 | JP      | 2009262654                      | April 23, 2008 / Nov. 12,<br>2009 / N/A                                                                        | Suzuki et al.   | AIA 102(a)(1)               |
| G-18 | JP      | 2008017227                      | July 6, 2006 / Jan. 14,<br>2008 / Oct. 13, 2010                                                                | Yasui           | AIA 102(a)(1)               |
|      | DE      | 102006054738                    | Nov. 21, 2006 / May 29,<br>2008 / N/A                                                                          | Heinzelmann     | AIA 102(a)(1)<br>and (a)(2) |
|      | JP      | 2003130649                      | Oct. 22, 2001 / May 8,<br>2003 / N/A                                                                           | Yamada          | AIA 102(a)(1)               |
|      | JP      | 2006008098                      | Nov. 8, 2004 / Jan. 12,<br>2006 / N/A                                                                          | Harumoto et al. | AIA 102(a)(1)               |
|      | JP      | 2006131031                      | Nov. 4, 2004 / May 25,<br>2006 / N/A                                                                           | Endo            | AIA 102(a)(1)               |
|      | JP      | 2006190206                      | Jan. 7, 2005 / July 20,<br>2006 / N/A                                                                          | Nonaka et al.   | AIA 102(a)(1)               |
|      | JP      | 2007251383                      | March 14, 2006 / Sep. 27,<br>2007 / N/A                                                                        | Yuhara          | AIA 102(a)(1)               |
|      | JP      | 2010208416                      | March 9, 2009 / Sep. 24,<br>2010 / N/A                                                                         | Miyake et al.   | AIA 102(a)(1)               |

solutions available in relation to such missing express disclosure and/or because known work in one field or endeavor prompted variations based on predictable design incentives and/or market forces either in the same field or a different one. The combination of prior art references identified in these contentions would have been obvious because the combination represents the potential options for a combination of structure/functions/features that could be achieved with a reasonable expectation of success in view of the predictability in the computing (and/or automotive) arts in the relevant timeframes. One of ordinary skill in the art would have been motivated to create, and would have understood the ready availability, of the combinations identified in these contentions using: known methods to yield predictable results; known techniques performed in the same way; a simple substitution of one known, equivalent element for another to obtain predictable results; and/or teaching, suggestion, or motivation in the prior art generally. Also, market forces in the industry, and the desire to improve features and performance, would motivate the addition of features to systems as they become available, become less expensive, become more commonly used, provide better performance, reduce costs, size or weight, or predictably achieve other clearly desirable results.

**A. Regarding the '034, '296, and '243 Patents**

**Analogous Art.** Each of the references cited in the Exhibit A, G, and K charts are analogous prior art to the '034, '296, and '243 patents and to one another because they are directed to the same or similar fields and aim to solve the same or similar problems. For example, all of the prior art references cited in the Exhibit A, G, and K charts are directed to systems and methods for accessing and implementing user profiles that contain settings for adjustable components of the vehicle. *E.g.*, Ikeda '209 at Abstract, Figure 1, Figure 2, [0005], [0009], [0061], [0063], [0065], [0092], [0093]; Ikeda '823 MT at claim 1, [0001], [0058], [0061], [0073]-[0075], [0114]; Ikeda '634 MT at claim 1, [0001], [0007], [0028], [0050], [0068]; He '491 at

Figure 3, [0002], [0009], [0011], [0013], [0027], [0033], claim 11; Morehouse '141 at Abstract, [0001], [0002], [0007], [0021]; Yasui '227 MT at [0064]; Bachmann '467 at Abstract, 4:12–21, 6:3–12, 6:21–33, 6:50–65; Suzuki '654 MT at claim, [0004], [0010], [0012]–[0014]; Cho '207 at 4:15–26, 7:31–37, 12:3–14, 13:39–14:5; Baumann '656 at [0001], [0006], [0012]; Bando '391 MT at claims 1 and 3–6, [0001], [0047], [0048]; Lemelson '947 at Figure 3, 11:55–12:6; Coon '062 at Abstract, [0013], Figures 2A–2D; Breed '380 at 112:8–35; Endo '092 MT at [0001], [0007], [0008], [0021], [0062]; Breed '854 at 30:29–47, 86:63–87:7; Reimann '389 at Abstract, 2:27–42; Demeniuk '289 at 3:26–28, 19:50–56; Hendry at [0002], [0026], [0030], Figure 4a, Figure 4b; Penilla '900 16:31–53, 17:41–52, 19:9–17, 20:35–42, Figure 6, Figure 7, Figure 10.

**The recited features were well-known in the art.** The prior art references cited in the Exhibit A, G, and K charts disclose each of the purported claimed inventions recited in the '034, '296, and '243 patents. For example, claims 1, 9, and 14–16 of the '034 patent, claims 1, 7, 8, 9, 14, 15, and 20 of the '296 patent, and claims 1 and 11 of the '243 patent recite systems and methods for accessing and implementing user profiles that contain settings for adjustable components related to a location inside the vehicle, along with various techniques for implementing these systems and methods, including determining the presence of a user, identifying the user, and determining whether a request to access a profile is authorized. Prior to the alleged invention of the Asserted Patents, persons of ordinary skill in the art were well aware of systems, methods, and computer readable mediums for such configurations. *E.g.*, He '491 at [0002], [0026]; Rovik at 1:22–47; Hafner at [0061]; Ikeda '209 at [0013], [0079], [0093]; Ikeda '634 at [0050]; Ikeda '823 at claim 1, [0011]; Ikeda '634 at claim 10, [0060];

Morehouse '141 at [0002]; Yasui '227 at [0022], [0048]; Bachmann '467 at Abstract, 6:3-12; Suzuki '654 at claim 2, [0006]; Endo '092 at [0012]-[0013].

Claims 7 and 17 of the '034 patent further recite storing settings in cloud storage. Prior to the alleged invention of the Asserted Patents, persons of ordinary skill in the art were well aware of systems, methods, and computer readable mediums for such configurations. *E.g.*, Yasui '227 at [0103]; Ikeda '209 at [0072], [0092]; Ikeda '823 MT at [0101]; Ikeda '634 MT at [0067]; Cho '207 at 12:60-13:3; Baumann '656 at [0016]-[0017]; Breed '380 87:62-88:7; Breed '854 at 57:44-52; Cazanas at 1:44-54; *see also* Margis '908, Kitahara '717, Kawaguchi '415, Ohmura '732, Fujita '421; *see also* Lortz '960 at [0050] ("Access rights are directed to the cloud-based service providing control and services to the vehicle. Determining access rights may involve identifying who is providing the access rights....a determination can be made if an owner or a person with authority is providing the access rights."); Marchwicki '575 at 1:27-2:36 (cloud services includes a provision of data or execution of an application from a device); Kawaguchi '415 at [0007]-[0008], [0026]-[0027], [0107]-[0110], [0113], [0121]-[0122], [0128]-[0130], [0135]-[0136], [0144]-[0145], [0177]-[0179], [0189]-[0191], Figs. 1-3, 6-7, 9-10; Kitahara '717 at Figs. 1-3, 6, Claims 2-3, [0001], [0003]-[0004], [0008]-[0012], [0014]-[0015], [0017], [0019]-[0021], [0023]-[0025], [0029], [0031]-[0032], [0056]-[0057], [0064]; Zellner '861 at [0091] ("Still other configurations can provide priority settings between the user device 106 and the remote network 210 (universally for the environment, for each setting, for each type of setting, for particular users, etc.)").

Claim 8 of the '034 patent and claims 3, 4, 11, and 17 of the '296 patent recite specific hardware to which settings can apply, such as a seat's position, a mirror's position, or a radio's setting. Prior to the alleged invention of the Asserted Patents, persons of ordinary skill in the art

were well aware of systems, methods, and computer readable mediums for such configurations. *E.g.*, Ikeda '209 at Fig. 1., [0005], [0064]; Ikeda '823 MT at [0058]; Ikeda '634 MT at [0049]; He '491 at [0009]; Morehouse '141 at [0016]; Yasui '227 MT at [0059]; Bachmann '467 at 3:58-4:11; Suzuki '654 MT at [0004]; Cho '207 at 12:14-22; Bauman '656 at [0010]; Bando '391 MT at [0015]-[0017]; Lemelson '947 at 11:55-12:6; Coon '062 at [0013]; Breed '380 at 112:8-35; Endo '092 MT at [0002]; Breed '854 at 86:63-87:7; Singh at Abstract.

Claims 10 and 11 of the '034 patent, claims 5, 12, and 18 of the '296 patent, and claims 7 and 17 of the '243 patent recite various means of identifying or verifying a user, including using biometric data and image data. Prior to the alleged invention of the Asserted Patents, persons of ordinary skill in the art were well aware of systems, methods, and computer readable mediums for such configurations. *E.g.*, Ikeda '209 at Abstract, [0062]; Ikeda '823 MT at [0057]; Ikeda '634 MT at [0048]; Yasui 227 MT at [0006]; Suzuki '654 MT at [0006]; Singh at Abstract, [0034]; Hendry '178 at [0017], [0020], [0030]; Poulson '795 at [0037], [0045]; Rovik '231 at 10:35-57; Addepalli '256 at 3:54-60; Bell '491 at [0035]; Cazanas '408 at 6:50-62; Forstall '070 at [0047]; Hafner '903 at [0074]; Inada '968 at [0042]; Lortz '960 at [0050]; Penilla '900 at 15:25-30; Protopapas '931 at [0070]; Sands '526 at [0065]; Wilkens '655 at [0046]; Yester '603 at 4:44-50.

Claims 6, 13, and 19 of the '296 patent recite determining whether a user adjusted one of the adjustable components in the vehicle and then saving that change to a user profile. Prior to the alleged invention of the Asserted Patents, persons of ordinary skill in the art were well aware of systems, methods, and computer readable mediums for such configurations. *E.g.*, Ikeda '209 at [0144]; Ikeda '823 MT at [0045]; Ikeda '634 at [0056]; Morehouse '141 at [0002]; He '491 at [0021]; Bachman '467 at 6:50-65.

Claims 1-20 of the '243 patent recite receiving a request to access a user profile, determining whether the request is authorized, and various techniques for implementing and performing the claimed systems and methods, such as using user profiles based on templates, including templates common to more than one vehicle manufacturer. Prior to the alleged invention of the Asserted Patents, persons of ordinary skill in the art were well aware of systems, methods, and computer readable mediums for such configurations. *E.g.*, Hendry at [0033]; Rovik at 9:3-53.

Thus, the prior art references identified herein, individually and in combination, demonstrate that each purported feature of the '034, '296, and '243 patents was well known to those of ordinary skill in the art.

**The claimed systems and methods would have been obvious to a skilled artisan at the times of the alleged inventions.** A skilled artisan would have been motivated to modify or combine teachings from charts A, G, and K to develop the systems and methods recited in the '034, '296, and '243 patents, and a skilled artisan would have had a reasonable expectation of success in making these modifications and combinations without undue experimentation and using methodologies commonly understood in the art. A skilled artisan would have understood that these references, as well as the skilled artisan's knowledge, disclose interrelated teachings based on routine technologies and would have been amenable to various well-understood and predictable combinations.

Further non-limiting examples as to motivations to combine are discussed below.

In the context of accessing and implementing user profiles that contain settings for adjustable components of the vehicle a skilled artisan would have been motivated to automatically identify and apply a user's preferred settings. For example, automatically

notice of the art. Defendants reserves the right to supplement these contentions to rely on further content from certified translations of those same references.

Defendants' search for prior art references, additional documentation, and/or corroborating evidence concerning prior art systems is ongoing. Defendants reserve the right to continue to supplement their production as Defendants obtain additional prior art references, documentation, and/or corroborating evidence concerning invalidity during the course of discovery.

Dated: April 1, 2025

Respectfully submitted,

/s/ James R. Barney

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### **CERTIFICATE OF SERVICE**

The undersigned certifies that on April 1, 2025, a true and correct copy of the above document was served on all counsel of record via electronic mail.

/s/ James R. Barney  
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