

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. 9,147,296 to Ricci

Case No.: IPR2026-00002

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

Table of Contents

I.	INTRODUCTION	1
II.	ARGUMENT	2
A.	Settled Expectations of the Parties Weigh Against Discretionary Denial	2
1.	Ford Had Strong Settled Expectations of Non-Enforcement	3
a.	Ford has a long-term business relationship with the original owner of the '296 Patent	3
b.	AutoConnect is a non-practicing entity (NPE).....	6
c.	AutoConnect held the '296 Patent for many years without alleging infringement	6
2.	AutoConnect's failures to Pay Maintenance Fees Cuts Against Any Settled Expectations	7
B.	The <i>Fintiv</i> Factors Favor Institution	9
1.	Factor 1: The Likelihood of a Stay Favors Institution.....	10
2.	Factor 2: The Parallel Trial Date Weighs Against Discretionary Denial	11
3.	Factor 3: The Investment in Parallel Proceedings Weighs Against Discretionary Denial.....	12
4.	Factor 4: The Overlap Between Petition and Parallel Proceeding Weighs Strongly Against Discretionary Denial Because Ford Agreed to <i>Sotera</i> Stipulations	13
5.	Factor 5: Whether the Parties Are the Same Is Neutral.....	13
6.	Factor 6: Other Considerations Weigh Strongly Against Discretionary Denial	14
a.	The Petition properly relies on expert testimony	14
b.	The Petition presents compelling merits	14
c.	AutoConnect engages in inconsistent claim construction.....	15
d.	Complex litigation favors institution.....	18
e.	The Co-Pending EPR Provides No Basis for Discretionary Denial.....	19
C.	Other Considerations.....	20
III.	CONCLUSION.....	20
	Certificate of Service	22

Table of Authorities

Cases

<i>AutoConnect Holdings, LLC v. Toyota Motor Corp.</i> , No. 2:24-cv-00802-JRG-RSP (E.D. Tex., Dec. 5, 2025) ..	6, 7, 12, 13, 16, 18
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019 (PTAB Mar. 20, 2020)	1, 9-10, 12
<i>Berkshire Hathaway Energy Company et al., v. Birchtech Corp.</i> , IPR2025-00274 (PTAB July 2, 2025)	19
<i>Bose Corp., v. Koss Corp.</i> , IPR2021-00612 (PTAB Sept. 15, 2021)	12
<i>Consumeron, LLC v. MapleBear Inc.</i> , No.1:21-1147-GBW-MPT 2023 WL 3434002 (D. Del. May 12, 2023)	10
<i>Ever Win Int’l Corp. v. RadioShack Corp.</i> , 902 F. Supp. 2d 503 (D. Del. 2012)	10
<i>Harbor Freight Tools USA, Inc. Generac Power Systems, Inc. and MWE Investments, LLC v. Champion Power Equipment, Inc.</i> IPR2025-00805 (PTAB Sept. 19, 2025)	18
<i>Impression Products v. Lexmark Intern.</i> , 581 U.S. 360, 137 S. Ct. 1523 (2017)	5
<i>Intel Corp. v. Proxense LLC</i> , IPR2025-00327 (PTAB June 26, 2025)	6
<i>iRhythm Techs., Inc. v. Welch Allyn, Inc.</i> , IPR2025-00377 (PTAB Jun. 6, 2025)	14
<i>Monitoring v. Get-Grin Inc.</i> , No. 22-647-WCB, 2024 WL 1603403 (D. Del. Apr. 9, 2024)	10, 19

<i>Mueller Sys., LLC v. Rein Tech, Inc.,</i> IPR2020-00100 (PTAB May 12, 2020)	19
<i>Multi-Color Corp. v. Brook & Whittle LTD,</i> PGR2025-00025 (PTAB July 16, 2025)	12
<i>NEC Corp. v. Peloton Interactive, Inc.,</i> No. 22-987-CJB, 2024 WL 1533952 (D. Del. Apr. 9, 2024).....	11
<i>Owens Corning Roofing & Asphalt, LLC v. Kirsch Research & Dev., LLC,</i> IPR2020-01389 (PTAB Feb. 18, 2021).....	12
<i>Phillips v. AWH Corp.,</i> 415 F.3d 1303 (Fed. Cir. 2005)	17
<i>Quanta Computer, Inc. v. LG Electronics, Inc.,</i> 553 U.S. 617, 128 S. Ct. 2109 (2008)	5
<i>Rampart IC, LLC v. Egg Med., Inc.,</i> 1:24-cv-00643, 2025 WL 1100626 (D. Del. Apr. 14, 2025).....	11
<i>Revo Techs., Inc. v. Cerebrum Sensor Techs., Inc.,</i> IPR2025-00632 (PTAB Nov. 3, 2025).....	17
<i>Shenzen Touzhu Technology Co., LTD v. Stratasys, Inc,</i> IPR2025-00438 (PTAB July 17, 2025)	19
<i>Shenzhen Root Tech. Co., Ltd. v. Chiaro Tech. Ltd.,</i> IPR2024-01296 (PTAB Feb. 25, 2025).....	14
<i>Speyside Med., LLC v. Medtronic CoreValve, LLC,</i> No. 1:20-cv-00361-JLH-CJB, D.I. 155 (D. Del. Sept. 30, 2021)	11
<i>Tesla, Inc. v. Intellectual Ventures II LLC,</i> IPR2025-00217 (Director June 13, 2025)	19
<i>Thermaltake Tech. Co., Ltd. v. Chen,</i> IPR2024-01230 (PTAB Feb. 19, 2025).....	19

<i>VirtualAgility Inc. v. Salesforce.com, Inc.</i> , 759 F.3d 1307 (Fed. Cir. 2014)	10
--	----

<i>Xerox Corp. v. Bytemark, Inc.</i> , IPR2022-00624 (PTAB Aug. 24, 2022)	14
--	----

Statutes

35 U.S.C. § 314	2
35 U.S.C. § 41(c)(2)	8, 9
35 U.S.C. §325(d)	20

Agency Guidance

Memorandum: Interim Processes for PTAB Workload Management (March 26, 2025)	10
--	----

List of Exhibits

Exhibit No.	Description
1001	U.S. Patent No. 9,147,296 (“the ’296 Patent”)
1002	U.S. Patent No. 9,147,296 Certified File History (“the ’296 Patent File History”)
1003	Expert Declaration of Dr. Scott Andrews
1004	Scott Andrews 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”)
1006-1009	<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 A1 to Moinzadeh (“Moinzadeh”)
1014	<i>Intentionally left blank</i>
1015	U.S. Patent No. 7,783,699 B2 to Rasin (“Rasin”)
1016-1023	<i>Intentionally left blank</i>
1024	Certified Translation and Original Copy of Japanese Patent Application Pub. No. 2010-163092 A to Endo (“Endo”)
1025	U.S. Patent Application Pub. No. 2007/0238491 A1 to He (“He”)
1026	Certified Translation and Original Copy of Japanese Patent Application Pub. No. 2009/262654 A to Suzuki (“Suzuki”)
1027-1049	<i>Intentionally left blank</i>
1050	Bosch Automotive Handbook, 6 th Ed., (Robert Bosch GmbH – October 2004) (“Bosch”)
1051	IEEE Dictionary, (IEEE 100 The Authoritative Dictionary of IEEE Standards Terms 2000 7 th Edition) (“IEEE Dictionary”)
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

Exhibit No.	Description
	Available at https://www.ieeexplore.ieee.org/document/4394215 (“Hossain”)
1054-1056	<i>Intentionally left blank</i>
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	<i>Intentionally left blank</i>
1061	Ford SYNC Supplemental Guide, November 2007 (“SYNC Guide 2007”)
1062	Ford SYNC Supplemental Guide, January 2010 (“SYNC 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-future-of-wireless-medical-technology- (Accessed June 30, 2025) (“MDDI”)
1064	<i>Intentionally left blank</i>
1065	SUSE LINUX – Administration Guide. Published by SUSE LINUX AG, 2004. (“Linux”)
1066-1074	<i>Intentionally left blank</i>
1075	Turing, A. M. “On Computable Numbers with an Application to the Entscheidungsproblem” November 12, 1936. (“Turing”)
1076	Ganesan, Deepak “Chapter 4, The Von Neumann Model” April 25, 2012. Available at https://web.archive.org/web/20120425083227/http://none.cs.umass.edu/~dganesan/courses/fall09/handouts/Chapter4.pdf (Accessed September 15, 2025) (“Ganesan”)

Exhibit No.	Description
1077	Von Neumann, John “First Draft of a Report on the EDVAC” June 30, 1945. (“Von Neumann”)
1078	Intel “The Story of the Intel 4004.” Available at https://web.archive.org/web/20121003001757/https://www.intel.com/content/www/us/en/history/museum-story-of-intel-4004.html (Accessed September 22, 2025) (“Intel 4004”)
1079	Intel MCS-4 Micro Computer Set Data Sheet, November 1971. (“MCS-4”)
1080	Erickson, Kelvin T. “Programmable logic controllers,” <i>IEEE Potentials</i> , Institute of Electrical and Electronics Engineers (IEEE), February/March 1996. (“Erickson”)
1081-1100	<i>Intentionally left blank</i>
1101	United States District Courts – National Judicial Caseload Profile, June 2025
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
1108	U.S. Patent and Trademark Office - U.S. 9,290,153 Maintenance Fee Payment Records
1109	<i>Intentionally left blank</i>
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	<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)
1113	U.S. Provisional Application No. 61/811,981 File History (“the ’981

Exhibit No.	Description
	File History”)
1114-1116	<i>Intentionally left blank</i>
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”)
1119-1120	<i>Intentionally left blank</i>
1121	Declaration of Melissa Sheahan
1122	<i>Intentionally left blank</i>
1123	Plaintiff’s Opening Claim Construction Brief, <i>AutoConnect Holdings LLC v. Toyota Motor Corp., et al.</i> , Case No. 2:24-cv-00802-JRG-RSP (E.D. Tex.) Filed December 9, 2025 (“AutoConnect’s Claim Construction Brief”)
1124	<i>Intentionally left blank</i>
1125	<i>AutoConnect Holdings LLC v. Ford Motor Company</i> , AutoConnect Infringement Contentions, Case No. 1:24-cv-01327-JCG (D. Del.) Served December 19, 2025 (“Infringement Contentions”)
1126	<i>AutoConnect Holdings LLC v. Ford Motor Company</i> , AutoConnect Infringement Contentions, Ex. H2, ’296 Patent, Case No. 1:24-cv-01327-JCG (D. Del.) Served December 19, 2025 (“Infringement Contentions Excerpt”)
1127	U.S. 9,147,296 Patent Assignment Abstract (“the ’296 Patent Assignment Abstract”)
1128	Ford Motor Company, “Production Purchasing Global Terms and Conditions”) (Jan. 1, 2004) (Available at https://fsp.portal.covisint.com/documents/106025/25131282/Global_Production_Terms.pdf/fd1ed09d-7519-4ebb-928e-a7b302dc1331?version=1.0) (“Ford production global terms and conditions 2004”)

I. INTRODUCTION

The Director 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, December 4, 2025).

First, Ford's long-standing business relationship with Flextronics—the original owner of the '296 Patent and supplier of the accused SYNC system—created well-settled expectations that the '296 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 '296 Patent lapsing and the rise of intervening rights under 35 U.S.C. § 42(c), cuts against AutoConnect's alleged settled expectations in the patent. These facts, some of which were 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 lapsed patents.

Second, the *Fintiv* factors overwhelmingly favor institution in this

proceeding. The related district court litigation (“Related 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 Related Litigation to date. Additionally, the merits of the Petition are strong. 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.

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

II. ARGUMENT

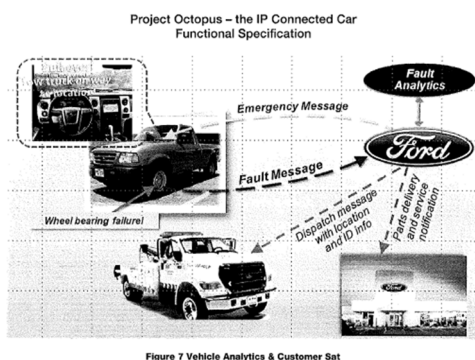
A. Settled Expectations of the Parties Weigh Against Discretionary Denial

As in IPR2025-01342 and IPR2025-01383, Flextronics is the original owner of the challenged patent and has continuously supplied the accused SYNC system to Ford for over ten years. Also, like IPR2025-01342, AutoConnect failed to pay the maintenance fee for the challenged patent causing the patent to lapse. This 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 '296 Patent

Ford released its first-generation SYNC infotainment system in 2007. (Ex. 1061.) SYNC 2 followed in 2010, which included the creation of user profiles linked to the user's cell phone. (Ex. 1062, 8; Ex. 1059.) 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, e.g., U.S. 14/253,204 on April 15, 2014 that issued as the '296 Patent. (Ex. 1001, Cover.) The '296 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:



Ex. 1113, 158

Ford started manufacturing vehicles with the Flextronics supplied SYNC modules in 2014. Flextronics then assigned the '296 Patent to AutoConnect on

May 20, 2015. (Ex. 1127, 2.) Flextronics never informed Ford that it transferred the '296 Patent to a third party, without retaining a license. 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 '296 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.”).) Due to Flextronics contractual defense and indemnification obligations to Ford arising from third-party claims of patent infringement, Ford expects its suppliers to protect their patent portfolios from being asserted against Ford, e.g., by retaining a license when selling a patent asset that may be asserted against a supplied product. (Ex. 1128, 16, § 21 Claims of Infringement.)

The Director has already decided 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, ... [would] have all necessary licenses” for the products it continued to sell to Ford. *Id.* at 3. 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.”).

Notwithstanding the Director’s prior findings, AutoConnect argues that this evidence “never links [the Flextronics] relationship to any products accused of infringing the patents” and “Flextronics did not supply the accused technology” (Request, 7.) However, AutoConnect broadly accuses: “All Ford vehicles ..., vehicle systems (including in-vehicle multimedia and **infotainment systems**), mobile applications ... and hardware and software that enable Personal Profiles with Phone as A Key in Ford vehicles,” as allegedly infringing the ’296 Patent claims. (Ex. 1125, 6.) Ford refers to its infotainment system as “SYNC”, and Flextronics supplies the “SYNC” module to Ford. Indeed, AutoConnect cites SYNC related evidence over 100 times throughout its infringement claim charts. (*See generally* Ex. 1126.) Further, 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.)

AutoConnect also argues that Ford’s relationship with Panasonic undermines Ford’s settled expectations of non-enforcement of Flextronics patents, “unless Flextronics were the *sole* supplier.” (Request, 7.) This argument misses the mark because AutoConnect sued Ford—not Ford’s other suppliers—on Flextronics patents. First, it is public knowledge that Ford has worked with multiple suppliers to develop and manufacture SYNC technology, including Microsoft, Panasonic, and Flextronics. (See Exs. 1058, 2018, 1117, 1118.) Of course, Ford would not and did not expect to be sued for infringement of its current supplier’s patents, regardless of the source of the accused goods.

b. AutoConnect is a non-practicing entity (NPE)

The ’296 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 an NPE, AutoConnect has not commercialized or marketed products with the ’296 Patent. Further, AutoConnect first publicly asserted the ’296 Patent in October 2024 against Toyota, and there is no record of AutoConnect licensing the ’296 Patent.

c. AutoConnect held the ’296 Patent for many years without alleging infringement

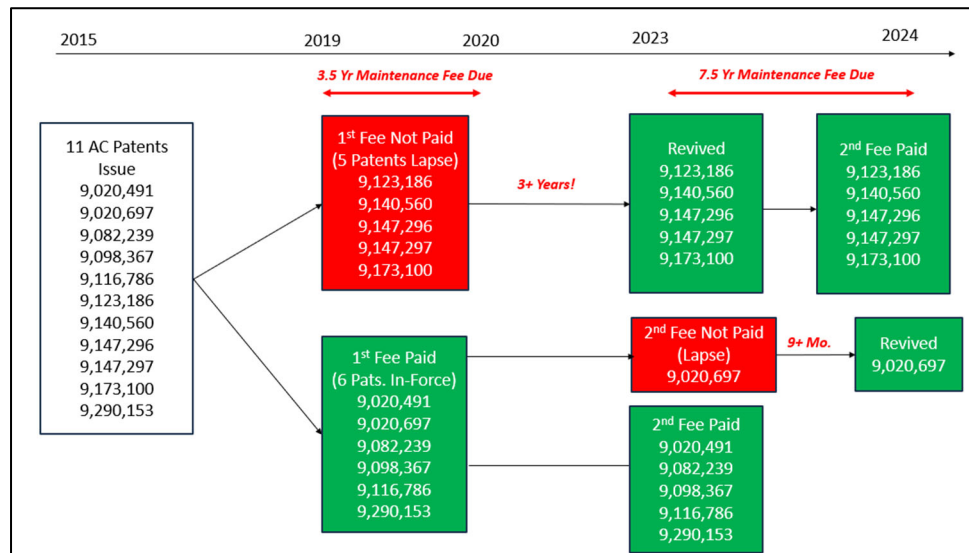
Ford commercialized the SYNC infotainment system in 2007 and partnered with Flextronics to manufacture the second-generation SYNC system in 2010. (Exs. 1117, 1118.) AutoConnect had actual knowledge of Ford's infotainment systems, e.g., by its reference to Ford in its earliest claimed provisional application 61/811,981 filed April 15, 2013 (Ex. 1113, 158), and the original owner of the '296 Patent (Flextronics) continuously 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.

2. AutoConnect's failures to Pay Maintenance Fees Cuts Against Any Settled Expectations

AutoConnect argues that "the '296 patent issued over a decade ago, an age that weighs strongly in favor of discretionary denial." (Request, 5.) Although the '296 Patent issued in 2015, AutoConnect failed to pay the first maintenance fee by the deadline of September 30, 2019 resulting in the '296 Patent lapsing. (Ex. 1105.) AutoConnect did not revive the '296 Patent until April 13, 2023, i.e., over three years after it lapsed. (Ex. 1105; Ex. 1002, 1085-1086.)

AutoConnect has a history of allowing its patents to lapse. Patent Owner allowed five asserted patents to lapse, including the '296 Patent, in 2019 for failure to pay the first maintenance fee: U.S. 9,123,186 (Ex. 1103); U.S. 9,140,560 (Ex. 1104); U.S. 9,147,296 (Ex. 1105); U.S. 9,147,297 (Ex. 1106); and U.S. 9,173,100

(Ex. 1107). AutoConnect also allowed one asserted patent to lapse 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 '296 Patent, (shown in red); it timely paid maintenance fees on other patents, such as the '153 Patent (shown in green). (See Exs. 1105, 1108.) AutoConnect's assertions of settled expectations in its patents are undermined by the fact that it allowed six of thirteen asserted patents to lapse.

In its infringement contentions, AutoConnect asserts Ford introduced the "Phone as a Key" feature accused of infringing the '296 Patent in the "2020 model year"—i.e., during the lapse. (Ex. 1125, 6.) Under 35 U.S.C. §41(c)(2), Ford was entitled to "the continued manufacture, use, offer for sale, or sale of the [accused

technology] ... of which substantial preparation was made” during the three-year lapse, *i.e.*, even after the '296 Patent was revived.

AutoConnect argues that “Ford identifies no evidence that it was even aware of this lapse before litigation.” (Request, 9.) But 35 U.S.C. § 41(c)(2) does not condition intervening rights on the third party’s awareness of the patent or its lapse. Further, as confirmed by the Director, AutoConnect’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 “promptly corrected the error[.]” (Request, 10.) However, the '296 Patent lapsed on September 30, 2019 and AutoConnect did not revive it until April 13, 2023, which is far from prompt. (Ex. 1105; Ex. 1002, 1046-1050.) AutoConnect also argues its many lapses over four years “all stem from a single, isolated administrative issue[.]” (Request, 10.) But AutoConnect’s purported *excuse* for the lapse is not relevant to AutoConnect’s expectations arising as a *consequence* of it, e.g., intervening rights under 35 U.S.C. § 41(c)(2). In addition, AutoConnect does not explain how the '697 Patent lapse in 2023 stems from the other patent lapses in 2019.

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

Factor 1 favors institution or is neutral. AutoConnect argues that a stay is unlikely because not all asserted patents are challenged by IPRs. (Request, 11-12.) However, all 13 asserted patents have been challenged in either an IPR or *ex parte* reexam (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. *Consummeron, 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 Related Litigation)).

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 ’697 Patent, the ’153 Patent, and the ’186 Patent, all claim priority to the same seven provisional applications as the ’296 Patent. (Pet., 4; IPR2025-01342, Paper 6, 5-6; IPR2025-01524, Paper 2, 5.) 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 Related 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 and GM in the Eastern District of Texas, AutoConnect argues that it would be inefficient “to have three separate proceedings involving validity challenges of the ’296 patent[.]” (Request, 12.) Ford is not a party to the Toyota/GM litigation, and Toyota and GM recently filed a motion to stay that litigation. *AutoConnect Holdings, LLC v. Toyota Motor Corp.*, No. 2:24-cv-00802-JRG-RSP, ECF No. 124 (E.D. Tex., Dec. 5, 2025). 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 ’296 Patent in multiple venues against multiple parties.

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 Related Litigation. Discovery has just started, AutoConnect recently provided its initial infringement contentions (Ex. 1126), and the claim construction hearing is scheduled for September 3, 2026. (Ex. 1112, 28.)

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

Factor 4 strongly favors institution. Ford challenged all claims of the '296 Patent in the IPR. (Ex. 1005, 57-58; Pet., 3.) Further, Ford filed a *Sotera* stipulation on November 6, 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). AutoConnect argues that the Petition overlaps with the Toyota/GM litigation because Toyota included the asserted art in its initial invalidity contentions. (Request, 15; Ex. 2020.) However, the asserted art is only three of the at least 25 references listed in Ex. 2020, which is an excerpt and does not include the full list, undermining AutoConnect's assertion of overlap.

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

Factor 5 is neutral. 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, 19-20 (PTAB Feb. 25, 2025) (finding this factor neutral where parties are the same in both proceedings).

6. Factor 6: Other Considerations Weigh Strongly Against Discretionary Denial

Factor 6 strongly favors institution.

a. The Petition properly relies on expert testimony

AutoConnect argues that the Andrews Declaration (Ex. 1003) “fill[s] in the gaps between the prior art and the claims[.]” (Request, 18.) Without citing any specific example of gap-filling, AutoConnect faults the Petition for citing to the declaration 130 times and for having fewer pages than the declaration. (*Id.*) Ford properly relies on its expert to explain what a POSA would have understood at the relevant time in view of supporting evidence and technical reasoning to support his opinions. *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, 15 (PTAB Aug. 24, 2022) (Precedential). At no point does the Petition rely solely on Mr. Andrews’s opinion to supply a missing claim limitation or fill a gap in the prior art. *See iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00377, Paper 10, 2-3 (PTAB Jun. 6, 2025).

b. The Petition presents compelling merits

AutoConnect asserts “numerous flaws ... ensure that claims would survive institution” by advancing implicit claim construction arguments related to Grounds

1 and 3. (Request, 18.) These arguments fail for several reasons. For example, with respect to Ground 1 and as explained in detail in the subsequent section, AutoConnect asserts the Endo reference fails to teach a claim limitation when construed in a manner contrary to the specification of the '296 Patent. (Request, 18-19.) For Ground 3, AutoConnect argues the He reference does not “determin[e] a presence of the user *inside* the vehicle” because He describes that determination as detecting a phone “within range” and, according to AutoConnect, that range might extend outside the vehicle. (Request, 19.) First, as explained below, nothing in the claims require the determination to affirmatively reject a presence detected outside the vehicle. Second, AutoConnect ignores that He discloses determining presence “within range” **after** “one or more users ... enter the vehicle[.]” (Ex. 1025, [0026]; Pet., 63-64; Ex. 1003, ¶¶389-391.)

c. AutoConnect engages in inconsistent claim construction

AutoConnect argues Endo’s “memory 27” stored in an electronic key is not “a user profile memory associated with a user.” (Request, 18-19.) Because the electronic key “can still be shared by different users,” AutoConnect asserts that any settings stored in the memory 27 are not part of “a user profile that is **directed to a specific person.**” (*Id.*, emphasis added.) Notably, AutoConnect does not provide any support for such narrowed claim scope. Further, AutoConnect mischaracterizes

Endo by implying Endo teaches sharing the electronic key between users. Not so. As discussed in both the Petition and Andrews Declaration, Endo teaches each occupant carrying their own key. (Pet., 47-50; Ex. 1003, ¶¶317-331.) Additionally, AutoConnect's argument is a claim construction dispute best considered after institution where the parties can fully brief the issue. Indeed, the Request did not include any express claim construction analysis.

AutoConnect's argument that Endo's memory 27 is not "*a user profile associated with the user*" implies a narrow claim construction of "*user profile*" that conflicts with the '296 Patent's specification and AutoConnect's proposed construction in the Toyota/GM litigation.

AutoConnect did not construe any terms of the '296 Patent before the district court in the Toyota/GM Litigation, instead relying on plain and ordinary meaning. (Ex. 1123.) And the '296 Patent specification discloses that "[i]n some of the many embodiments described herein the user profile **may be** specific to only one user 216[,]" indicating the "*user profile*" is not always specific to one user. (Ex. 1001, 80:16-18.) Indeed, following the detailed description of the last embodiment, the '296 Patent states: "It should be appreciated that the user profiles as described herein **can be** associated with a single user 216" and that "one or more user profiles **associated with one or more users** 216 may be stored..." (*Id.*, 90:47-52.) Thus, AutoConnect's implied narrowed construction in the Related

Litigation is contradicted by its proposed plain and ordinary claim construction position in the Toyota/GM Litigation in view of the '296 Patent specification.

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 1303, 1315–16 (Fed. Cir. 2005) (en banc) (“the best source for discerning the proper context of claim terms is the patent specification”) (internal citations omitted). As discussed above, the '296 Patent explains that the “*user profile*” can be directed to a specific user or multiple users. (Ex. 1001, 90:47-52.) Therefore, AutoConnect’s argument that Endo’s memory 27 is not “*a user profile memory associated with a user*” implies a narrow construction that is inconsistent with the '296 Patent’s description. This is an example of impermissible gamesmanship where AutoConnect seeks broader claim construction for infringement and narrower constructions to attempt to avoid invalidity. *Revo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20, 4 (PTAB Nov. 3, 2025) (Precedential) (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).

AutoConnect’s argument that the He reference fails to disclose “*determining a presence of the user inside the vehicle*” similarly lacks merit. As mentioned above, He does disclose this limitation. To the extent AutoConnect is construing

the limitation to require a determination and subsequent rejection of a presence **outside** the vehicle, nothing in the claim requires as much. Indeed, AutoConnect alleges vehicles meet this limitation because they “can detect a user’s mobile device via Bluetooth ... in an area of the vehicle, such as the vehicle interior” (Ex. 1126, 2, 21)—virtually identical to the functionality disclosed by He. If AutoConnect had wanted a narrower scope, it would have drafted the claims similar to how it drafted the claims in U.S. 9,020,491, which is also asserted in the Related Litigation and expressly claims “*if the signal does not originate from inside the vehicle, rejecting the signal*”. See U.S. 9,020,491, Claim 1. Further, AutoConnect’s proffered narrow implied construction conflicts with its position in the Toyota/GM Litigation where it simply relied on plain and ordinary meaning. (Ex. 1123.)

d. 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, 18.) On the contrary, 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); see also *Berkshire Hathaway Energy Co. et al. v. Birchtech Corp.*,

IPR2025-00274, Paper 23 (PTAB July 2, 2025). 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). The District of Delaware recently expressed a similar view, i.e., “it makes sense to ask the agency that issued the patent in the first place to decide whether it made a mistake.” *Monitoring*, 2024 WL 1603403, *5 (D. Del. Apr. 9, 2024).

e. The Co-Pending EPR Provides No Basis for Discretionary Denial

In a last-ditch effort, AutoConnect argues that the Toyota EPR filed after the Petition, supports exercising discretion to deny this IPR. (Request, 19-20.) The Board regularly declines discretionary denial of IPRs based on co-pending EPRs even where the EPR request was granted before the IPR petition was filed. *See e.g., Mueller Sys., LLC v. Rein Tech, Inc.*, IPR2020-00100, Paper 9, 12-14 (PTAB May 12, 2020); *Thermaltake Tech. Co., Ltd. v. Chen*, IPR2024-01230, Paper 12, 11-13 (PTAB Feb. 19, 2025). In fact, in *Thermaltake*, the Board instituted IPR over an argument that the EPR would “outpace and resolve the issues” of the

IPR, *id.* at 9, similar to AutoConnect’s “average duration” argument here. (Request, 20.)

AutoConnect also argues both proceedings “challenge[] the same claims” and that institution of this IPR would “invite unnecessary duplication of effort” and “increase the risk of conflicting outcomes.” (Request, 19-20.) Although both proceedings challenge all claims, the EPR applies different prior art than the IPR. (Pet., 3; Ex. 2017, 13.) Since the EPR was filed after this IPR, and EPRs are not subject to statutory time constraints, this IPR is the most efficient procedure for challenging the ’296 Patent.

C. Other Considerations

Although Toyota previously filed IPR2025-00891 challenging the ’296 Patent, Ford is a different Petitioner, and the Board discretionarily denied Toyota’s petition without addressing the merits or primary discretionary issues here, i.e., Ford’s settled expectations, and the ’296 Patent lapse. Further, denial under 35 U.S.C. §325(d) is not warranted because the applied art was not considered nor cited during prosecution. (Pet., 8; Ex. 1001, 1-6.)

III. CONCLUSION

Ford requests the Director deny the Request and grant institution.

Dated: January 7, 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)
Cameron M. Anstess (Reg. No. 82,069)
BROOKS KUSHMAN P.C.
150 W. Second St., Suite 400N
Royal Oak, MI 48067-3846
(248) 358-4400

Attorneys for Petitioner

Certificate of Service

The undersigned hereby certifies that on **January 7, 2026**, 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:

LEAD COUNSEL	BACK-UP COUNSEL
Eric A. Zelepugas (Reg. No. 73,302) zelepugas@avantechlawn.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@avantechlawn.com AVANTECH LAW, LLP 80 S 8th St, Suite 900 Minneapolis, MN 55402 Tel: 312-625-7378
autoconnect_post-grant@avantechlawn.com	

Respectfully submitted,

Dated: January 7, 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)
Cameron M. Anstess (Reg. No. 82,069)
BROOKS KUSHMAN P.C.
150 W. Second St., Suite 400N
Royal Oak, MI 48067-3846
(248) 358-4400

Attorneys for Petitioner

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).

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: January 7, 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)
Cameron M. Anstess (Reg. No. 82,069)
BROOKS KUSHMAN P.C.
150 W. Second St., Suite 400N
Royal Oak, MI 48067-3846
(248) 358-4400

Attorneys for Petitioner