

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TOYOTA MOTOR CORPORATION

Petitioner

v.

Patent of American VEHICULAR SCIENCES

Patent Owner

Patent No. 6,738,697

Issue Date: May 18, 2004

Title: TELEMATICS SYSTEM FOR VEHICLE DIAGNOSTICS

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**PATENT OWNER'S PRELIMINARY RESPONSE  
TO PETITION FOR *INTER PARTES* REVIEW OF  
U.S. PATENT NO. 6,738,697 PURSUANT TO 35 U.S.C. §§ 42.107**

Case No. IPR2013-00412

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## I. INTRODUCTION

Patent Owner American Vehicular Sciences (“American”) submits the following preliminary response to the Petition filed by Toyota Motor Corporation (“Toyota”) requesting *inter partes* review of claims 1, 2, 5, 10, 17-21, 26, 27, 32, 40, and 61 of U.S. Pat. No. 6,738,697 (“the ‘697 patent”). This filing is timely under 35 U.S.C. § 313 and 37 C.F.R. § 42.107 because it is filed within three months of the July 17, 2013 mailing date of the Notice granting the Petition a July 8, 2013 filing date. This petition was one of two filed by Toyota relating to the ‘697 patent, the other being Case Number IPR2013-00413.

“The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged . . . .” 35 U.S.C. § 314(a) (emphasis added). Here, the prior art cited by Toyota, either alone or in combination, fails to disclose each and every limitation of claims 1, 2, 5, 10, 17-21, 26, 27, 32, 40, and 61 of the ‘697 patent. As such, Toyota has failed to show a reasonable likelihood that it would prevail with respect to the grounds asserted in its Petition. This Patent Owner Preliminary Response establishes that no review

should be instituted with respect to at least the claims and grounds identified below.<sup>1</sup>

## **II. SUMMARY OF THE '697 PATENT AND DEFICIENCIES IN ASSERTED REFERENCES**

The '697 patent claims the benefit of an initial priority application filed June 7, 1995, which disclosed a revolutionary new vehicle diagnostic system positioned on the vehicle. (*See* '697 patent at cover, claiming priority to U.S. Pat. App. No. 08/476,077, now U.S. Pat. No. 5,809,437.) That application disclosed a system of sensors on a vehicle, a diagnostic computer positioned on the vehicle for processing the sensor output and outputting a diagnosis, a display in the vehicle for displaying the diagnosis received from the vehicle diagnostic computer, and a separate transmission means for transmitting the diagnosis information to a remote site. (*See, e.g.*, U.S. Pat. No. 5,809,437 at claims 1, 9.) A later application filed on June 19, 2002 (U.S. Pat. App. No. 10/174,709, now U.S. Pat. No. 6,736,506) disclosed including GPS location data with a diagnosis transmission. (*See, e.g.*, U.S. Pat. No. 6,736,506 at claims.) The application leading to the '697 patent is a

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<sup>1</sup> In its Preliminary Patent Owner's Response, American has set forth preliminary positions in response to grounds recited in Toyota's Petition. Should the Board decide to institute a trial, American reserves the right to set forth additional reasons, arguments and evidence in support of patentability.

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