

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

**PATENT OWNER'S AMENDED OBJECTIONS TO EVIDENCE
SUBMITTED BY TOYOTA MOTOR CORPORATION**

Case No. IPR2013-00413

Pursuant to 37 C.F.R. § 42.64 and the Board's comments during the February 3, 2014 Initial Conference Call, Patent Owner American Vehicular Sciences ("AVS") serves and submits the following amended objections to evidence served with the Petition of Toyota Motor Corporation ("Toyota") Petition for *Inter Partes* Review of U.S. Pat. No. 6,738,697 ("the '697 patent"). These amended objections supersede AVS's prior objections to evidence served and submitted on January 27, 2014. (Paper No. 18.)

1. EXHIBIT 1105 (AVS'S LITIGATION INFRINGEMENT CONTENTIONS)

AVS objects to the admissibility of Exhibit 1105, AVS's infringement contentions in the district court litigation between AVS and Toyota in the Eastern District of Texas pursuant to Fed. R. Evid. 402 and 403. These infringement contentions have no bearing on the present *inter partes* review proceedings. Toyota only attempted to rely on AVS's non-final, pre-discovery litigation positions as alleged admissions dispositive of the priority dates of the '697 patent claims. (*See, e.g.*, Petition at p. 5.) The Board, however, did not cite to or rely on Exhibit 1105 in its Decision Instituting Inter Partes Review. (*See* Paper 16, 1/13/14 Board Decision.) And for purposes of these proceedings, AVS does not dispute the priority dates asserted in Toyota's Petition.

Further, Exhibit 1105 is not arguably relevant to prove any other issues in the proceeding. Toyota has not pointed to Exhibit 1105 for any other purpose. It

is well established that litigation positions and even district court rulings are not binding before the USPTO because of the different standards for invalidity and claim construction. *See, e.g., Infinera Corp. v. Cheetah Omni, LLC*, Appeal 2011-007232 (BPAI March 30, 2012) (“In addition, we are not bound by positions taken by Respondent in infringement litigation, as our standard for claim interpretation is broadest reasonable interpretation commensurate with the Specification”). *See also, e.g., Garmin Intern., Inc. v. Patent of Cuozzo Speed Tech., LLC*, Case IPR2012-00001 (PTAB Jan. 9, 2013) (“Petitioner states that the term has to mean, in this proceeding, what the Patent Owner asserts it means in the infringement suits the Patent owner has filed against various parties including Petitioner. That argument is without merit. The meaning of claim terms is not governed by what the Patent Owner says they mean in filing an infringement suit based on the ‘074 Patent.”) (emphasis added). And AVS’s infringement contentions are not AVS’s final positions on claim construction in any event, and are subject to revision. *See, e.g., SSL Servs., LLC v. Citrix Sys.*, 2012 U.S. Dist. LEXIS 35788 (E.D. Tex. Mar. 16, 2012) (explaining that pursuant to Eastern District of Texas Local Patent Rule 3-6(a)(1), a party may amend its infringement contentions without leave of court after the court issues its claim construction ruling).

Accordingly, Exhibit 1105 is not relevant or necessary to prove any issue in the *inter partes* review. *See* Fed. R. Evid. 401. Any minimal probative value is

substantially outweighed by a danger of unfair prejudice, confusing the issues, waste, or needless presentation of cumulative evidence. *See* Fed. R. Evid. 403.

Accordingly, AVS objects to the admissibility of Exhibit 1105.

2. INADMISSIBLE ATTORNEY ARGUMENT IN PETITION

Finally, AVS also objects pursuant to Fed. R. Evid. 402, 702, and 802 to any arguments, statements, or references in the Petition or subsequent papers filed by Petitioner, to any of the above-discussed inadmissible evidence. For example, should the Board exclude AVS's litigation infringement contentions, AVS also objects to any attorney argument offering similar statements.

Respectfully submitted,

DATE: February 5, 2014

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CERTIFICATE OF SERVICE

I hereby certify that the Patent Owner's Amended Objections to Toyota's Evidence in connection with *Inter Partes* Review Case IPR2013-00413 was served on this 5th day of February by electronic mail to the following:

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