UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORPORATION

Petitioner,

v.

AMERICAN VEHICULAR SCIENCES LLC

Patent Owner.

Patent 8,036,788
Issue Date: October 11, 2011
Title: VEHICLE DIAGNOSTIC OR PROGNOSTIC MESSAGE TRANSMISSION SYSTEMS AND METHODS

PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO AMEND

Case No. IPR2013-00417

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES

Page

Cases

Statutes

Petitioner Toyota Motor Corporation ("TMC") respectfully submits this Opposition under 37 C.F.R. §§ 42.23 and 42.24 to AVS's Motion to Amend (Paper 29, hereinafter "MTA"). AVS proposes to substitute claims 22-31 for claims 1, 3, 4, 6-8, 11, 15, 16, and 18 of U.S. 8,036,788 (Ex. 1001, "the '788 Patent"), and requests the original claims be cancelled, conceding unpatentability over Scholl (Ex. 1002) and Ishihara (Ex. 1004). AVS adds two limitations: the vehicle must be "on a road," and the message transmitted remotely must identify the component or subsystem affected and whether it needs repair or replacement. The Board should deny the motion because: the claims are indefinite; the claims are not enabled; AVS fails to address patentability over the relevant art; and the substitute claims ***are*** unpatentable.

I. The Substitute Claims Are Indefinite

The substitute claims are unpatentable as indefinite under 35 U.S.C. § 112, ¶ 2, because AVS's proposed amendment is unclear if it requires prediction of when an identified component needs repair as opposed to replacement (and *vice versa*), or if it is sufficient to predict when the component needs to be either "repaired or replaced."

II. The Substitute Claims Are Not Enabled

While the claim language is unclear, AVS implies the substitute claims require identification of a component and an indication of whether it needs to be repaired, as opposed to replaced (and *vice versa*). (MTA at 11.) AVS's expert also takes this narrow view. (Ex. 1025, Kennedy Tr., p. 486, l. 7–p. 487, l. 13.) If the claims are definite, the broadest reasonable interpretation ("BRI") of the phrase "repaired or replaced" does

not require an on-board system to distinguish between the need to repair versus the need to replace. Instead, it is enough to determine that a component either needs repair or replacement. However, to the extent AVS's proposed amended claims actually require an on-board system that distinguishes between the need for repair and the need for replacement, the specification does not support such a claim or explain how to determine whether a component needs repair as opposed to replacement. There is nothing in the claims limiting the type of analysis or indicating which components to analyze; nor does AVS cite exemplary code, an algorithm, or anything enabling one of skill to determine which analysis to apply to which component, or how to determine whether that component needs repair as opposed to replacement (and *vice versa*). Indeed, AVS's expert admits that no cited portions of related U.S. Patent No. 7,650,210, whose specification largely overlaps with that of the '788 patent, discloses algorithms for processing sensor data into an indication that a component needed to be repaired or replaced. (See Ex. 1025, Kennedy Tr., p. 487, l. 15 – p. 501, l. 16.) And, in IPR2013-00416, AVS proffered expert testimony that the creation of an algorithm able to determine whether a component needs to be repaired or replaced would require *more than routine* efforts by one of skill. (*See* IPR2013-00416, Ex. 2007, Loudon Decl., at ¶ 61.) Thus, if construed as AVS implies, the claims are unpatentable under § 112, ¶ 1.

III. AVS Fails to Meet Its Burden of Proof

AVS fails its burden, *Idle Free Sys., Inc., v. Bergstrom, Inc.,* IPR2012-00027, Paper

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.