

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.

AMERICAN VEHICULAR SCIENCES LLC,  
Patent Owner

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Case IPR2013-00419  
Patent 6,772,057

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Before JAMESON LEE, MICHAEL W. KIM, and  
LYNNE E. PETTIGREW, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

Order  
Conduct of Proceedings  
*37 C.F.R. § 42.05*

## Introduction

On May 7, 2014, a conference call was held between Judges Lee, Kim, and Pettigrew, and respective counsel for the parties. Counsel for Patent Owner initiated the conference call to ask the Board to grant two types of relief: (1) limit the cross-examination of its expert witness Chris Koutsougeras, Ph.D., by prohibiting questions directed to whether the feature of trained pattern recognition would have been obvious to one with ordinary skill in the art based on U.S. Patent 6,553,130 (“Lemelson”); and (2) authorize Patent Owner to correct certain typographical mistakes in the expert’s declaration and certain other allegedly non-substantive omissions in the expert declaration and in the patent owner response.

The dispute relating to the scope of cross-examination arose, on May 5, 2014, during cross-examination of the expert. Counsel for Patent Owner instructed the witness not to answer and sought to reach the Board to request an order to limit the cross-examination. It was approximately 6:00 PM on May 5, 2014, and the parties were unable to reach an administrative patent judge at that time. Cross-examination continued on unrelated matters and then was completed but for the line of questions in dispute. On May 6, 2014, the parties requested a telephone conference with the Board, to be held on May 7, 2014. If the Board denies Patent Owner’s request to limit the cross-examination testimony of Dr. Koutsougeras, further cross-examination of the witness would follow.

We grant the request of Patent Owner to limit the questioning of Dr. Koutsougeras, on cross-examination, by barring questions inquiring about the witness’s opinion on the obviousness to one with ordinary skill in the art of the trained pattern recognition claim feature in light of Lemelson. We also authorize Patent Owner to file a Revised Declaration and Revised Patent Owner Response to make certain non-substantive, but helpful, corrections.

## Discussion

The parties do not dispute that in all of the alleged grounds of unpatentability instituted for trial, that involve Lemelson, Petitioner in its petition relies on Lemelson as disclosing the claim feature of trained pattern recognition, not as rendering obvious that feature. According to counsel for Petitioner, however, obviousness, inherent disclosure, and the understanding of one with ordinary skill in the art as to the disclosure of Lemelson, are inter-mingled as one integral discoverable topic. We disagree. Counsel for Petitioner knows the difference between the separate concepts of inherent disclosure, understanding of the teachings of a reference, and obviousness in view of a reference. Indeed, counsel for Petitioner acknowledged that he asked the question in three “different ways” to get an assortment of “different perspectives” on the subject. Counsel for Patent Owner raised an objection only for questions directed to the witness’s opinion on obviousness of the feature in light of Lemelson’s disclosure.

We are unpersuaded that inherent disclosure, understanding of what a references discloses, and obviousness are all one and the same topic. Based on the specific grounds instituted for trial and the arguments made in the petition, as well as the absence of specific testimony in the declaration of Dr. Koutsougeras (Ex. 2001) pertaining to nonobviousness of the trained pattern recognition feature to one with ordinary skill in the art, counsel for Petitioner had no sufficient reason to inquire, on cross-examination, the opinion of Dr. Koutsougeras as to whether the trained pattern recognition feature would have been obvious to one with ordinary skill.

Counsel for Patent Owner asked for permission to make certain corrections of typographical errors in the claim listing of within headings. We replied that minor typographical errors, which counsel for Patent Owner represents the

mistakes to be, need no correction because they should not hinder our understanding. In response, counsel for Patent Owner withdrew the request to make corrections of minor typographical mistakes.

Finally, counsel for Patent Owner requested either to submit an errata for the declaration of Dr. Koutsougeras and for the patent owner response, or to submit a revised declaration of Dr. Koutsougeras and a revised patent owner response, to correct certain non-substantive but potentially problematic omissions in the declaration and in the patent owner response. Specifically, the issue has to do with Patent Owner's and the declarant's discussing the disclosure of U.S. Patent No. 5,245,422 ("Borcherts") in the context of the alleged ground of obviousness based on Lemelson and Borcherts, but not identifying the same as also for Borcherts in the context of the alleged ground of obviousness based on Borcherts and Japanese Unexamined Patent Publication No. H06-124340 ("Yamamura").

Counsel for Petitioner initially disagreed that the proposed changes are non-substantive, but later reached agreement with counsel for Petitioner with regard to allowing Petitioner to make the following corrections:

Declaration (Exhibit 2001):

In paragraph 81, change "Lemelson and Borcherts" to "Lemelson and Borcherts (claims 30-34, 37-39, 62) or Yamamura and Borcherts (claims 30, 32-34, 37-39)"

In paragraph 85, change "Lemelson nor Borcherts" to "Lemelson, Yamamura, nor Borcherts"

Patent Owner Response (Paper 33):

On page 29, change "claims 30-34, 37-39, and 62 on only one ground—obviousness by Lemelson and Borcherts" to "claims 30-34, 37-39, and 62 for obviousness by Lemelson and Borcherts and claims 30, 32-34, and 37-39 for obviousness by Yamamura and Borcherts."

On page 31, change “neither Lemelson nor Borcherts” to “neither Lemelson, Borcherts, nor Yamamura.”

We approve of the above-noted corrections, because based on the record before us the proposed changes are non-substantive, but helpful to a smooth reading and fair understanding of the patent owner response and the declaration.

#### Order

It is

ORDERED that Patent Owner’s request that we limit the cross-examination of Dr. Koutsougeras by precluding questions directed to whether the claimed feature of trained pattern recognition would have been obvious to one with ordinary skill is *granted*;

FURTHER ORDERED that cross examination of Dr. Koutsougeras by counsel for Petitioner shall not include questions asking for the opinion of Dr. Koutsougeras on whether the claimed feature of trained pattern recognition would have been obvious to one with ordinary skill in the art;

FURTHER ORDERED that the corrections agreed to by the parties and identified above are approved and that Patent Owner shall make the corrections not by any “errata,” but by filing a Revised Declaration (re-executed) having the same exhibit number and by filing a Revised Patent Owner Response within three business days of the date of this Order; and

FURTHER ORDERED that it will be understood that references in the revised patent owner response to the declaration of Dr. Koutsougeras refers to Dr. Koutsougeras’s revised declaration and not his initial declaration.

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