

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Mercedes-Benz USA, LLC,

Petitioner

Patent No. 6,738,697

Issue Date: May 18, 2004

Title: TELEMATICS SYSTEM FOR VEHICLE DIAGNOSTICS

**PETITION FOR *INTER PARTES* REVIEW OF U.S.
PATENT NO. 6,738,697
PURSUANT TO 35 U.S.C. § 312 and 37 C.F.R. § 42.104**

Case No. IPR2014-00645

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EXHIBITS

- Exhibit 1001 U.S. Patent No. 6,738,697 to Breed
- Exhibit 1002 U.S. Patent No. 5,157,610 to Asano
- Exhibit 1003 Fry, “Diesel Locomotive Reliability Improvements by System Monitoring,” Proceedings of the Institution of Mechanical Engineers, Part F: Journal of Rail and Rapid Transit, Vol. 209, Jan. 1, 1995
- Exhibit 1004 U.S. Patent No. 4,897,642 to DiLullo et al.
- Exhibit 1005 U.S. Patent No. 5,311,197 to Sorden et al.
- Exhibit 1006 Expert Declaration of David A. McNamara
- Exhibit 1007 January 13, 2014 Decision in IPR2013-00412 instituting *inter partes* review of ’697 patent
- Exhibit 1008 January 13, 2014 Decision in IPR2013-00413 instituting *inter partes* review of ’697 patent
- Exhibit 1009 American Vehicular Sciences LLC’s PR 3-1 Disclosure of Asserted Claims and Infringement Contentions and PR 3-2 Identification of Document Production Accompanying Disclosure in 13-cv-00105 (E.D. Tex.) (July 22, 2013)

Pursuant to 35 U.S.C. §§ 311-319 and 37 C.F.R. Part 42, Mercedes-Benz USA LLC (“Petitioner”) respectfully requests *inter partes* review of claims 1, 2, 5, 6, 10, 18-22, 26, 27, 32, 40, and 61 of U.S. Patent No. 6,738,697 (“the ’697 patent”). According to U.S. Patent and Trademark Office records, the ’697 patent is currently assigned to American Vehicular Sciences LLC (“AVS” or the “Patent Owner”).

I. MANDATORY NOTICES (37 C.F.R. § 42.8)

A. Real Parties-in-Interest (37 C.F.R. § 42.8(b)(1))

The real parties-in-interest with respect to this Petition are Petitioner and Mercedes-Benz U.S. International, Inc. (“MBUSI”).

B. Related Matters (37 C.F.R. § 42.8(b)(2))

The ’697 patent has been asserted by AVS in the following litigations in the U.S. District Court for the Eastern District of Texas: *American Vehicular Sciences LLC v. Mercedes-Benz U.S. Intl., Inc.*, No. 6:13-cv-00310, filed April 3, 2013 (the “310 Litigation”); *American Vehicular Sciences LLC v. American Honda Motor Co., Inc. et al.*, No. 6:13-CV- 226, filed March 8, 2013; *American Vehicular Sciences LLC v. Kia Motors Corp.*, No. 6:13-CV-148, filed February 13, 2013; *American Vehicular Sciences LLC v. Hyundai Motor Co. et al.*, No. 6:12-CV-776, filed October 15, 2012; *American Vehicular Sciences LLC v. BMW Group. A/K/A*

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