

Comparison of Paragraphs from *Ex Parte Reexamination Page 27* and IPR

Petition Pages 11-12

A person of ordinary skill in the art, at the time the alleged inventions of claims 1, 2, 4, 5, 7, 8, 10, 12, 13, 15, and 28-30 of the '781 patent were made, would have found it obvious to combine the teachings of Jurgen, Smith, and Habu, and, in addition, would have been motivated to do so. Jurgen, for example, expressly describes one such motivation: "The motive for using an electronic engine control system is to provide the needed accuracy and adaptability in order to minimize exhaust emissions and fuel consumption, provide optimal driveability for all operating conditions, minimize evaporative emissions, and provide system diagnosis when malfunctions occur." (Ex. 1002, p. 12.1). A person of ordinary skill in the art would have been further motivated to combine the teachings of Jurgen, Smith, and Habu to "provide optimal driveability for all operating conditions" (Ex. 1002, p. 12.1), to "provide[] the fuel metering and ignition timing precision to minimize fuel consumption" (Ex. 1002, p. 12.4), to encourage "fuel efficient driving techniques" (Ex. 1003, 1:22-24), and to "obtain preferable shift positions relating to optimum fuel consumption rate in accordance with ... data detected" (Ex. 1004, Abstract). The '781 patent states that its object is to "provide a system which integrates the ability to issue audible warnings which advise the driver to correct operation of the vehicle in a manner which will **enhance the efficient operation** thereof with the ability to automatically take corrective action if the vehicle is being operated unsafely." Ex. 1001, 1:66-2:5 (emphasis added). Thus, like the '781 patent, Jurgen, Smith, and Habu are concerned with, for example, improving fuel efficiency.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Patent of : Harvey Slepian, et al.
Patent No. : 5,954,781
Issued : Sep. 21, 1999
Title : METHOD AND APPARATUS FOR OPTIMIZING
VEHICLE OPERATION
Application Serial No. : 08/813,270
Filed : Mar. 10, 1997
Requester : Volkswagen Group of America, Inc.

VIA EFS-WEB

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P.O. Box 1450
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I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office via the Office electronic filing system on **May 22, 2014**.
Signature: /Helen Tam/
Helen Tam

**REQUEST FOR *EX PARTE* REEXAMINATION
OF U.S. PATENT NO. 5,954,781 PURSUANT TO 37 C.F.R. § 1.510**

SIR:

Volkswagen Group of America, Inc. ("Requester" or "VWGoA"), through its undersigned counsel, hereby respectfully requests *ex parte* reexamination of U.S. Patent No. 5,954,781 pursuant to 35 U.S.C. § 302 and the provisions of 37 C.F.R. § 1.510.

Toyota '599 teaches that indicator lamps that tell the driver to shift up or shift down are lit by the microcomputer in order to tell the driver when to shift to improve fuel economy. “Namely, in this step, the speed change operation indicating signal is applied to the indicator or display 10 from the microcomputer 5 through the I/O port 6. As a result, a particular lamp in this case, a shift up indicating lamp in the indicator 10, is illuminated, thus indicating to the driver that the speed change from current shift position to the one step shifting up position SP_{+1} is preferable.” Col. 5, line 63 to col. 6, line 2. “However, only when either one of the assumed fuel consumption rates above is better than the current fuel consumption rate B_e , the corresponding shift-up lamp or shift-down lamp in the indicator 10 is illuminated, thus indicating the necessity of the speed change operation.” E.g. col. 7, lines 29 to 38. Therefore, Toyota '599 teaches “an upshift[/downshift] notification circuit coupled to said processor subsystem, said upshift[/downshift] notification circuit issuing a notification that said engine of said vehicle is being operated at an excessive[insufficient] speed” and “said processor subsystem determining, based upon data received from said plurality of sensors, . . . when to activate said upshift[/downshift] notification circuit.”

A person of ordinary skill in the art, at the time the alleged inventions of claims 1, 7, and 13 of the '781 patent were made, would have found it obvious to combine the teachings of Jurgen and Toyota '599, and, in addition, would have been motivated to do so. Indeed, Jurgen, for example, expressly describes one such motivation: “The motive for using an electronic engine control system is to provide the needed accuracy and adaptability in order to minimize exhaust emissions and fuel consumption, provide optimal driveability for all operating conditions, minimize evaporative emissions, and provide system diagnosis when malfunctions occur.” (Jurgen, Page 12.1). A person of ordinary skill in the art, at the time the alleged inventions of claims 1, 7, and 13 of the '781 patent were made would have been further motivated to combine the teachings of Jurgen and Toyota '599 to “provide optimal driveability for all operating conditions” (Jurgen, Page 12.1), to “provide[] the fuel metering and ignition timing precision to minimize fuel consumption (Jurgen, Page 12.4), and to “obtain preferable shift positions relating to optimum fuel consumption rate in accordance with . . . data detected” (Toyota '599, Abstract). The '781 patent states that its object is to “provide a system which integrates the ability to issue audible warnings which advise the driver to correct operation of the vehicle in a manner which will *enhance the efficient operation* thereof with the ability to automatically take corrective action if the vehicle is being operated unsafely.” Col. 1, line 66 to col. 2, line 5. Thus, like the '781 patent, Jurgen and Toyota '599 are concerned with, for example, improving fuel efficiency.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLKSWAGEN GROUP OF AMERICA, INC.

Petitioner

Patent No. 5,954,781

Issue Date: Sep. 21, 1999

Title: METHOD AND APPARATUS FOR OPTIMIZING VEHICLE
OPERATION

**PETITION FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 5,954,781
PURSUANT TO 35 U.S.C. § 312 and 37 C.F.R. § 42.104**

Case No. IPR2015-00276

informed when to shift up or shift down using an indicator containing two lights 10a and 10b as shown in Fig. 1.

A person of ordinary skill in the art, at the time the alleged inventions of claims 1, 2, 4, 5, 7, 8, 10, 12, 13, 15, and 28-30 of the '781 patent were made, would have found it obvious to combine the teachings of Jurgen, Smith, and Habu, and, in addition, would have been motivated to do so. Jurgen, for example, expressly describes one such motivation: "The motive for using an electronic engine control system is to provide the needed accuracy and adaptability in order to minimize exhaust emissions and fuel consumption, provide optimal driveability for all operating conditions, minimize evaporative emissions, and provide system diagnosis when malfunctions occur." (Ex. 1002, p. 12.1). A person of ordinary skill in the art would have been further motivated to combine the teachings of Jurgen, Smith, and Habu to "provide optimal driveability for all operating conditions" (Ex. 1002, p. 12.1), to "provide[] the fuel metering and ignition timing precision to minimize fuel consumption (Ex. 1002, p. 12.4), to encourage "fuel efficient driving techniques" (Ex. 1003, 1:22-24), and to "obtain preferable shift positions relating to optimum fuel consumption rate in accordance with . . . data detected" (Ex. 1004, Abstract). The '781 patent states that its object is to "provide a system which integrates the ability to issue audible warnings which advise the driver to correct operation of the vehicle in a manner which will **enhance the efficient operation** thereof with the ability to automatically take corrective action if the vehicle is being operated unsafely." Ex. 1001, 1:66-2:5

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