

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Fortune et al. Case No.: IPR2015-01004
U.S. Patent No.: 6,012,007 Docket No.: 15625-0020IP1
Issue Date: January 4, 2000
Appl. Serial No.: 08/868,338
Filing Date: June 3, 1997
Title: OCCUPANT DETECTION METHOD AND APPARATUS
FOR AIR BAG SYSTEMS

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BRIEF RESPONSIVE TO BOARD ORDER FILED SEPTEMBER 2, 2015
RE: PARTIAL JUDGMENT OF INVALIDITY IN DISTRICT COURT

American Honda Motor Co., Inc. (“Petitioner” or “Honda”) files the present Brief in response to Board’s Order filed September 2, 2015 (“the Order”) in the present *Inter Partes Review* (IPR) proceeding. Petitioner respectfully submits that the Board should not deny institution of the present IPR or terminate the proceeding under 37 CFR § 42.72 as to the claims identified by the District Court as being indefinite, because the Joint Stipulation by the Petitioner and Patent Owner (“the Joint Stipulation”) in the District Court case is to the entry of the judgment only, not to the indefiniteness of the claims. As a result, Patent Owner may still appeal the judgment at the conclusion of trial, which leaves open the possibility that these claims may yet be found valid. If the Board denies institution of or terminates the present IPR as to these claims, Petitioner will be unable to

pursue a later IPR due to the one-year bar imposed by 35 U.S.C. § 315(b). Accordingly, the Board should afford Petitioner the opportunity to challenge the claims on prior art grounds in the present IPR by allowing the proceeding to continue as to all challenged claims. In addition, regardless of whether the claims are definite, Applicant respectfully submits that the prior art of record in the present proceeding discloses all limitations of all challenged independent and dependent claims of the '007 Patent, and requests that the Board move forward with its analysis of all challenged claims based on the cited art.

I. Explanation of the Joint Stipulation

On April 17, 2015, the District Court issued a claim construction order holding that the term “relative weight parameter” in the claims of the '007 Patent is indefinite under 35 U.S.C. § 112 ¶ 2. Ex. 2002, p. 1. The Patent Owner and the defendants (including Honda) filed the Joint Stipulation to entry of a judgment of invalidity of claims 1, 8, 9, 17, 18, 19 and 20 of the '007 Patent by the District Court, which had the effect of removing the claims from consideration in the case. *Id.* Notably, the Joint Stipulation was to “entry” of the judgment by the District Court only. *Id.* Neither the Patent Owner nor the defendants stipulated to the indefiniteness of the claims of the '007 Patent, and all parties “reserve[d] all appellate rights, including, but not limited to, the right to appeal the Court’s April 17, 2015 claim construction order to the United States Court of Appeals for the

Federal Circuit.” *Id.* at pp. 1-2. Accordingly, the partial judgment of invalidity entered in response to the Joint Stipulation can still be appealed to the Federal Circuit, and thus has no preclusive effect on the Board in the present case. *See SAP v. Versata*, CBM2012-00001, Paper 36, p. 19 (Holding that a judgment on appeal to the Federal Circuit “is not sufficiently firm to be accorded” preclusive effect by the Board).

II. Independent claims 1 and 17 and challenged dependents 2, 9 and 18-20 of the '007 Patent are indefinite, but analysis is still possible

Independent claims 1 and 17 recite “determining measures represented by individual sensor outputs and calculating from the sensor outputs a relative weight parameter.” The District Court found that the term “relative weight parameter” is indefinite because it is not clear to what the weight parameter is “relative.” *See Ex. 2001* (Claim Construction Order), p. 63. In the words of the court:

Because the patent provides no boundaries for what parameters could be considered a “relative weight parameter,” and does not describe to what it is “relative,” a person of ordinary skill in the art would not be able to discern the bounds of the claim with reasonable certainty. For example, an alleged infringer could argue that its product does not infringe, because it simply uses a weight measurement, but not one that is “relative.” Whether such a measurement would infringe cannot be determined with reasonable certainty from the language of the patent.

Id. We agree with the District Court that the claims are indefinite, because the '007 Patent does not define what constitutes a “relative weight parameter,” and does not indicate what the parameter is “relative” to. In fact, the word “relative” does not appear anywhere in the specification of the '007 Patent. Accordingly, because the claims, the specification, and the prosecution history of the '007 Patent do not “provide objective boundaries for those of skill in the art” to identify the breadth of weight parameters that would, and would not, meet this limitation, the claims are indefinite. *See Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1370–71 (Fed. Cir. 2014) (citing *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2124 (2014)). If the Board likewise determines claims 1 and 17 are indefinite, we invite the Board to explain its reasoning on the record.

Challenged claims 2, 3, 5, 9, and 18-21 depend from the independent claims discussed above, and thus by definition include all limitations of their respective independent claims, including the indefinite claim term “relative weight parameter.” 35 U.S.C. § 112(d). However, the District Court found dependent claim 21, that recites “wherein the relative weight parameter is the total force detected by all the sensors,” definite because it “adequately describe[s] the relative weight parameter” and thus “cure[s] the indefiniteness issue” of its indefinite base claim 17. Ex. 2001, p. 63, note 15. By this logic, claims 3 and 5, both of which further describe the “relative weight parameter” in terms of a total weight, arguably

remedy their indefiniteness for the same reason as claim 21. Unlike the dependent claims 3, 5 and 21, challenged claims 2, 9 and 18-20 fail to provide additional description of the relative weight parameter, and thus suffer the indefiniteness of their respective independent claims. Accordingly, challenged dependent claims 2, 9 and 18-20 are indefinite for the same reasons described above relative to independent claims 1 and 17.

However, despite the indefiniteness, the claims do not defy interpretation. Because the prior art cited in the Petition discloses all limitations of the dependent claims 3 and 5 (which depend from claim 1) and claim 21 (which depends from claim 17), it follows that the cited prior art also discloses all limitations of the broader independent claims. *See In re Slayter*, 276 F.2d 408, 411, 125 USPQ 345, 347 (CCPA 1960) (“A generic claim cannot be allowed to an applicant if the prior art discloses a species falling within the claimed genus.”); *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989). For example, regarding claims 3 and 21, Schousek describes “summ[ing]” the forces from each of an array of sensors “to obtain a total force or weight parameter,” thereby disclosing that “the relative weight parameter is the total force detected by all the sensors” as recited in claims 3 and 21. Paper 3 (Petition), p. 25 (quoting Ex. 1004 (Schousek), 5:30-31). Thus, Schousek also discloses the generic “relative weight parameter” in independent claims 1 and 17, from which claims 3 and 21 depend. *See In re Slayter*, 276 F.2d

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