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IPR2015-01645, Paper No. 28

IPR2015-01508, Paper No. 30

IPR2015-01585, Paper No. 31

November 22, 2016

571-272-7822

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NISSAN NORTH AMERICA, INC.,
Petitioner,

v.

JOAO CONTROL & MONITORING SYSTEMS, LLC ,
Patent Owner.

IPR2015-01645 (Patent 7,396,363)

IPR2015-01508 (Patent 6,542,076)

IPR2015-01585 (Patent 5,917,405)

Held: October 20, 2016

BEFORE: STACEY G. WHITE, JASON J. CHUNG, and BETH
Z. SHAW, Administrative Patent Judges.

The above-entitled matter came on for hearing on Thursday,
October 20, 2016, commencing at 1:00 p.m., at the U.S. Patent
and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

IPR2015-01645 (Patent 7,396,363)
IPR2015-01508 (Patent 6,542,076)
IPR2015-01585 (Patent 5,917,405)

APPEARANCES:

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Joao Control & Monitoring Systems, LLC

IPR2015-01645 (Patent 7,396,363)
IPR2015-01508 (Patent 6,542,076)
IPR2015-01585 (Patent 5,917,405)

1 At this time, petitioner may present their argument.

2 MR. ABSHER: Your Honor, I have paper copies of our
3 slides, if you would like them.

4 JUDGE CHUNG: Thanks.

5 MR. ABSHER: May I approach?

6 JUDGE CHUNG: You may.

7 MR. ABSHER: This hearing concerns three U.S.
8 patents, patent number 6,542,076, patent number 5,917,405, and
9 patent number 7,397,363. These patents are all in the same
10 family, have the same named inventor and have a great deal of
11 overlap and subject matter. And because of the significant
12 overlap, we will endeavor to cover these patents in groups where
13 appropriate.

14 Slide 3, please. So first we'll discuss the '076 and '405
15 patents in connection with the grounds of rejection using the
16 Frossard primary reference. Slide 4, please. Then we will
17 discuss the '076 and '405 patents in the context of the Pagliaroli
18 grounds of rejection. Slide 5, please. Then we will address the
19 grounds of rejection for the '363 patent.

20 Also, because of the significant overlap, whenever
21 there's an issue or argument or an exhibit that's present in
22 multiple IPRs, I'll endeavor to refer to it only once and by default
23 we'll refer to it by the exhibit or paper number in the '076 IPR, the
24 first one that was filed, IPR2015-01508.

IPR2015-01645 (Patent 7,396,363)
IPR2015-01508 (Patent 6,542,076)
IPR2015-01585 (Patent 5,917,405)

1 Given that we are the petitioners and we carry the
2 burden to prove the challenged claims unpatentable by a
3 preponderance of the evidence, I would like to provide a brief
4 overview of the record and how we got here.

5 So for each of the three challenged patents, petitioner,
6 we brought forward a petition along with a supporting expert
7 declaration. Our declaration explained how a person of ordinary
8 skill in the art, what he or she would understand from the
9 disclosure and how he or she would compare it to the claims.
10 Subsequently, the patent owner filed a preliminary response but
11 did not introduce any evidence in either of the responses
12 regarding how one of ordinary skill would understand the claims
13 in the prior art.

14 Subsequently, the Board instituted trial on all three
15 patents and all challenged claims and all grounds finding a
16 reasonable likelihood that we would prevail in proving the
17 challenged claims unpatentable.

18 After that the patent owner deposed our expert, filed its
19 response but again did not provide any evidence of how a person
20 of ordinary skill would understand the claims in the prior art.
21 They did critique our expert but did not challenge the
22 admissibility of his testimony. Only the weight of his testimony.

23 And as we set forth in our reply papers, the baseless.
24 Patent owner provided no evidence of secondary considerations

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