

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.

Case IPR2015-01509
Patent 6,549,130 B1

Before HOWARD B. BLANKENSHIP, STACEY G. WHITE, and
JASON J. CHUNG, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Petitioner, Nissan North America, Inc., filed a Petition to institute an *inter partes* review of claims 26, 29, 30, 33, 42, 43, 48, 60, and 68 (“the challenged claims”) of U.S. Patent No. 6,549,130 B1 (“the ’130 patent”).

Paper 1 (“Pet.”). Patent Owner, Joao Control & Monitoring Systems, LLC, filed a Preliminary Response pursuant to 35 U.S.C. § 313. Paper 9 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314; 37 C.F.R. § 42.4(a). Upon consideration of the Petition and the Preliminary Response, and for the reasons explained below, we determine that the information presented shows a reasonable likelihood that Petitioner would prevail with respect to claims 26, 29, 30, 33, 42, 43, 48, 60, and 68. *See* 35 U.S.C. § 314(a). Accordingly, we institute an *inter partes* review of these claims.

A. *Related Matters*

Petitioner and Patent Owner indicate that the ’130 patent or related patents have been asserted in the following proceedings: (1) *Joao v. Nissan North America, Inc.*, No. 1-14-cv-00523 (D. Del.); (2) *Joao v. City of Yonkers*, No. 1-12-cv-07734 (S.D.N.Y.); (3) *Joao v. Chrysler Corp.*, No. 4-13-cv-13957 (E.D. Mich.); (4) *Joao v. Volkswagen Group of America, Inc.*, No. 1-14-cv-00517 (D. Del.); (5) *Joao v. Protect America, Inc.*, No. 1-14-cv-00134 (W.D. Tex.); (6) *Joao v. Cox Communications, Inc.*, No. 1-14-cv-00520 (D. Del.); (7) *Joao v. Time Warner Cable, Inc.*, No. 1-14-cv-00524 (D. Del.); (8) *Joao v. Verizon Communications, Inc.*, No. 1-14-cv-00525 (D. Del.); (9) *Joao v. Slomin’s Inc.*, No. 2-14-cv-02598 (E.D.N.Y.); (10) *Joao v. LifeShield, Inc.*, No. 2-15-cv-02772 (E.D. Pa.); (11) *Icontrol Networks, Inc. v. Joao*, No. 1-15-cv-00755 (W.D. Tex.); (12) *Joao v. Telular Corp.*, No. 14-cv-09852 (N.D. Ill.); (13) *Joao v. Comverge, Inc.*, No. 14-cv-03862; (14) *Joao of California, LLC v. ACTI Corp.*, No. 8-10-cv-01909 (C.D. Cal.);

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(15) *Joao of California, LLC v. Sling Media, Inc.*, No. 3-11-cv-06277 (C.D. Cal.); (16) *Joao v. Ford Motor Co.*, No. 4-12-cv-14004 (E.D. Mich.); (17) *Joao v. Chrysler Corp.*, No. 1-13-cv-00053 (S.D.N.Y.); (18) *Joao v. Ford Motor Co.*, No. 4-13-cv-13615 (E.D. Mich.); (19) *Joao v. Jaguar Land Rover North America LLC*, No. 1-13-cv-00507 (D. Del.); (20) *Joao v. Mitsubishi Motors North America Inc.*, No. 1-13-cv-00614 (D. Del.); (21) *Joao v. Mazda Motor of America Inc.*, No. 1-13-cv-00728 (D. Del.); (22) *Joao v. Vivint Inc.*, No. 1-13-cv-00508 (D. Del.); (23) *Joao v. Lowe's Cos., Inc.*, No. 5-13-cv-00056 (W.D.N.C.); (24) *Joao v. FrontPoint Security Solutions LLC*, No. 1-13-cv-01760 (D. Del.); (25) *Alarm.com Inc. v. Joao*, No. 1-14-cv-00284 (D. Del.); (26) *Joao v. Cenuco, Inc.*, No. 7-05-cv-01037 (S.D.N.Y.); (27) *Joao v. Xanboo, Inc.*, No. 2-12-cv-3698 (C.D. Cal.); (28) *Joao v. Ford Motor Co.*, No. 1-12-cv-01479 (D. Del.); (29) *Joao v. Ford Motor Co.*, No. 2-12-cv-00033 (C.D. Cal.); (30) *Joao v. Hyundai Motor America*, No. 8-12-cv-00007 (C.D. Cal.); (31) *Joao v. Consolidated Edison, Inc.*, No. 1-14-cv-00519 (D. Del.); (32) *Joao v. Honda Motor Co., Inc.*, No. 2-12-cv-04013 (C.D. Cal.); (33) *Xanboo Inc. v. Joao of California*, No. 8-11-cv-00604 (C.D. Cal.); (34) *Joao v. Cablevision Systems Corp.*, No. 1-14-cv-00518 (D. Del.); (35) *Joao v. DirecTV*, No. 1-14-cv-00521 (D. Del.); (36) *Joao v. DISH Network Corp.*, No. 1-14-cv-00522 (D. Del.); and (37) *Joao v. Mobile Integrated Solutions LLC*, No. 14-cv-2643 (D. Ariz.). Exs. 1016–1018; Paper 5.

According to Petitioner and Patent Owner, the '130 patent and several related patents are the subject of four *ex parte* reexaminations, Reexamination Control Nos.: (1) 90/013,303; (2) 90/013,301; (3) 90/013,302; and (4) 90/013,300. Exs. 1016–1018; Paper 5. Petitions have

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been filed in regards to the '130 patent and several related patents requesting *inter partes* review of U.S. Patent Nos.: (1) 6,542,076 (Case IPR2015-01478); (2) 7,397,363 (Case IPR2015-01482); (3) 7,397,363 (Case IPR2015-01485); (4) 6,549,130 (Case IPR2015-01486); (5) 6,542,076 (Case IPR2015-01508); (6) 6,549,130 (Case IPR2015-01509); (7) 5,917,405 (Case IPR2015-01585); (8) 6,542,076 (Case IPR2015-01610); (9) 6,549,130 (Case IPR2015-01611); (10) 7,397,363 (Case IPR2015-01612); (11) 5,917,405 (Case IPR2015-01613); (12) 7,397,363 (Case IPR2015-01645); (13) 6,549,130 (Case IPR2015-01760); (14) 7,397,363 (IPR2015-01762); (15) 6,542,077 (Case IPR2015-01466); (16) 6,587,046 (Case IPR2015-01477); and (17) 7,277,010 (Case IPR2015-01484). Exs. 1016–1018; Paper 5.

B. The Asserted Grounds

Petitioner identifies the following as asserted grounds of unpatentability:

Reference(s)	Basis	Challenged Claim(s)
Frossard (Ex. 1005) ¹	§ 102(a) ²	26, 29, 33, 42, 48, and 68
Frossard and Pagliaroli (Ex. 1006) ³	§ 103(a)	30 and 43
Frossard and Simms (Ex. 1007) ⁴	§ 103(a)	60
Pagliaroli	§ 102(e)	26, 29, 30, 42, 43, and 48
Pagliaroli and Frossard	§ 103(a)	33 and 68
Pagliaroli and Simms	§ 103(a)	60

C. The '130 Patent

The '130 patent is directed to controlling a vehicle or premises. Ex. 1001, Abs. The '130 patent describes three control devices; a first control device is located at a vehicle or premises, a second control device is located remote from the vehicle or premises, and a third control device is located remote from the vehicle or premises and remote from the second control device. *Id.* The first control device generates a first signal in response to a second signal from the second control device. *Id.* The first control device

¹ European Patent Application Publication No. 0 505 266 A1, published March 17, 1992.

² The relevant sections of the Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, took effect on March 16, 2013. Because the application from which the '130 patent issued was filed before that date, our citations to Title 35 are to its pre-AIA version.

³ U.S. Patent No. 5,276,728, filed Nov. 6, 1991.

⁴ U.S. Patent No. 5,334,974, filed Feb. 6, 1992.

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