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Paper No. 11
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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 IPR2015-01585
Patent 5,917,405

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

WHITE, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Nissan North America, Inc. ("Petitioner") filed a Corrected Petition (Paper 6, "Pet.") seeking to institute an *inter partes* review of claims 1, 2, 3, 11, 16, and 17 of U.S. Patent No. 5,917,405 (Ex. 1001, "the '405 patent") pursuant to 35 U.S.C. §§ 311–319. Joao Control & Monitoring Systems, LLC, ("Patent Owner") filed a Preliminary Response. (Paper 10, "Prelim. Resp."). We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition."

Petitioner contends the challenged claims are unpatentable under 35 U.S.C. §§ 102 and 103 on the following specific grounds (Pet. 16–60):

Reference(s)	Basis	Claim(s) Challenged
Frossard[1]	§ 102	1 and 16
Frossard and Pagliaroli[2]	§ 103	2 and 17
Frossard and Simms[3]	§ 103	3
Frossard and Shimizu[4]	§ 103	11
Pagliaroli	§ 102	1, 2, 16, and 17
Pagliaroli and Simms	§ 103	3
Pagliaroli and Shimizu	§ 103	11

[1] EP 0505266 A1 (Ex. 1004); English translation of EP 0505266 A1 (Ex. 1005) ("Frossard").

[2] U.S. Patent No. 5,276,728 (Ex. 1006) ("Pagliaroli").

[3] U.S. Patent No. 5,334,974 (Ex. 1007) ("Simms").

[4] U.S. Patent No. 4,373,116 (Ex. 1008) ("Shimizu").

Our factual findings and conclusions at this stage of the proceeding are based on the evidentiary record developed thus far (prior to Patent Owner's Response). This is not a final decision as to patentability of claims for which *inter partes* review is instituted. Our final decision will be based on the record as fully developed during trial. For reasons discussed below, we institute *inter partes* review of the '405 patent as to claims 1, 2, 3, 11, 16, and 17.

B. Related Proceedings

Petitioner informs us that the '405 patent is at issue in *Joao Control & Monitoring Systems LLC v. City of Yonkers*, No. 1:12-cv-7734 (S.D.N.Y.); *Joao Control & Monitoring Systems, LLC v. Chrysler Corp.*, No. 4:13-cv-13957 (E.D. Mich.). Pet. 1; Ex. 1020. In addition, *ex parte* reexamination No. 90/013,300 was filed with respect to the '405 patent and is pending. Pet. 1; Ex. 1020. The '405 patent also is the subject of a co-pending petition for *inter partes* review (IPR2015-01613).

C. The '405 Patent

The '405 patent describes a remote-controlled control, monitoring, and/or security apparatus and method for vehicles or premises. Ex. 1001, 1:18–22. The apparatus described in the '405 patent allows an owner, occupant, or other authorized individual to control or to perform various monitoring and security tasks in regards to a vehicle from a remote location and at any time. *Id.* at 2:64–3:3.

An embodiment of the apparatus of the '405 patent includes a transmitter system which is "a remote system, which may or may not be physically connected to the remainder of the apparatus. Further, the transmitter system is not located in the [vehicle] . . . , but rather, is located

external from, and/or separate and apart from, the vehicle." *Id.* at 3:29–35. The apparatus also includes a CPU that is connected electrically and/or linked to one or more vehicle equipment systems (e.g., vehicle ignition or anti-theft systems). *Id.* at 4:12–17; 4:41–62. The vehicle equipment systems may be activated, de-activated, reset, or controlled by the apparatus. *Id.* at 4:63–67. This activation or control may be achieved by a user entering a code on the transceiver of the transmitter system. *Id.* at 6:9–15. The code is transmitted to the CPU and then the CPU communicates with the appropriate vehicle equipment system. *Id.* at 6:64–7:2.

D. Illustrative Claim

As noted above, Petitioner challenges claims 1, 2, 3, 11, 16, and 17 of the '405 patent, of which claims 1 and 16 are independent. Claim 1 is illustrative of the challenged claims and is reproduced below:

> 1. A control apparatus for a vehicle, which comprises:
>
> a first control device, wherein said first control device one of generates and transmits a first signal for one of activating, deactivating, enabling, and disabling, one of a vehicle component, a vehicle device, a vehicle system, and a vehicle subsystem, wherein said first control device is located at the vehicle;
>
> wherein said first control device is responsive to a second signal, wherein the second signal is one of generated by and transmitted from a second control device, wherein the second control device is located at a location which is remote from the vehicle, and further wherein the second control device is responsive to a third signal, wherein the third signal is one of generated by and transmitted from a third control device, wherein the third control device is located at a location which is remote from the vehicle and remote from the second control device.

II. CLAIM CONSTRUCTION

As acknowledged by the parties, the '405 patent has expired. *See* Pet. 8; Prelim. Resp. 7. We construe expired patent claims according to the principles set forth in *Phillips v. AWH Corp*., 415 F.3d 1303 (Fed. Cir. 2005) (en banc). *See In re Rambus*, 694 F.3d 42, 46 (Fed. Cir. 2012). "In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence." *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc*., 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17). A patentee may act as a lexicographer by giving a term a particular meaning in the specification with "reasonable clarity, deliberateness, and precision." *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

A. Asserted Means Plus Function Terms

Petitioner seeks construction of "monitoring device," "positioning device," and "voice synthesizing device." Pet. 9–16. Patent Owner disagrees with Petitioner's proposed constructions for these terms, but declines to provide a construction or "substantive argument" at this time. Prelim. Resp. 36–37. Petitioner asserts that each of these terms is governed by 35 U.S.C. § 112 ¶ 6[5]. Based on the record currently before us, we are persuaded by Petitioner's arguments that the terms "monitoring device" and

[5] Section 4(c) of the Leahy-Smith America Invents Act ("AIA") re-designated 35 U.S.C. § 112 ¶ 6, as 35 U.S.C. § 112(f). Pub. L. No. 112-29, 125 Stat. 284, 296 (2011). Because the '405 patent has a filing date before September 16, 2012 (effective date of § 4(c)), we will refer to the pre-AIA version of § 112.

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