

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

PATENT OWNER'S RESPONSE TO PETITION
FOR *INTER PARTES* REVIEW UNDER 37 C.F.R. § 42.107

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION	1
II. BACKGROUND.....	2
A. Overview of the ‘405 Patent	2
B. Prosecution History of the ‘405 Patent	3
C. Representative Claims.....	4
III. CLAIM CONSTRUCTION.....	5
A. Legal Standards.....	5
B. “control device”.....	8
C. “first signal,” “second signal” and “third signal”	8
D. “positioning device”	10
E. “monitoring device”	12
F. “voice synthesizing device”	13
IV. DAVID McNAMARA’S DECLARATION IS FUNDAMENTALLY FLAWED	13
A. David McNamara did not Review the Materials Required to Properly Reach his Conclusions and Opinions.....	13

B. David McNamara has an Erroneous Understanding of the Standards to Use
In Construing Patent Claims 14

C. David McNamara’s Testimony Should Be Given Little or No Weight..... 16

V. RESPONSE TO PROPOSED GROUNDS OF INVALIDITY 17

A. Ground 1 is Deficient..... 17

 1. Frossard fails to disclose the “A to B to C” control system/method of
 claims 1 and 16 17

B. Ground 2 is Deficient..... 22

C. Ground 3 is Deficient..... 23

D. Ground 4 is Deficient..... 25

E. Ground 5 is Deficient 27

 1. Pagliaroli fails to disclose the “A to B to C” control system/method of
 claims 1 and 16 27

F. Ground 6 is Deficient..... 32

G. Ground 7 is Deficient..... 35

VI. CONCLUSION..... 37

LIST OF EXHIBITS

Exhibit	Description
EX2001	"Preliminary Remarks" filed by Applicant on November 26, 2006 during prosecution of the patent application that issued as related U.S. Patent No. 7,277,010
EX2002	"Supplement to the Remarks for the Amendment filed on October 24, 2007" filed on November 23, 2007 during prosecution of the patent application that issued as related U.S. Patent No. 7,397,363
EX2003	Excerpt from U.S. Patent No. 6,549,130
EX2004	August 26, 2015 Opinion and Order Construing Disputed Claim Terms in the matter of <i>JCMS v. Chrysler Group LLC</i> , Case No. 13-cv-13957 (E.D. Mich.)
EX2005	Transcript of March 15, 2006 Deposition of David McNamara
EX2006	Transcript of March 16, 2006 Deposition of David McNamara

I. INTRODUCTION

In response to the Corrected Petition for *Inter Partes* Review (“Petition”) filed by Petitioner, the Board has instituted *inter partes* review (Paper 11, the “Decision”) of claims 1, 2, 3, 11, 16 and 17 (“Challenged Claims”) of U.S. Patent No. 5,917,405 (“the ‘405 Patent”) based on the following grounds:

Ground	Claims	Proposed Rejections
1	1 and 16	anticipated by Frossard
2	2 and 17	obvious in view of Frossard and Pagliaroli
3	3	obvious in view of Frossard and Simms
4	11	obvious in view of Frossard and Shimizu
5	1, 2, 16 and 17	anticipated by Pagliaroli
6	3	obvious in view of Pagliaroli and Simms
7	11	obvious in view of Pagliaroli and Shimizu

The seven proposed grounds of rejection are substantively flawed, in that none of the cited references teach important properly construed claim limitations. For example, none of the cited references teach an “A to B to C” control system/method, as required by the challenged claims and as will be explained in more detail below.

Further, as will be discussed below, it became apparent during cross-examination that Petitioner’s expert, David McNamara: (1) did not review the materials required to properly reach his conclusions and opinions; and (2) has an

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.