

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLKSWAGEN GROUP OF AMERICA, INC.,
Petitioner,

v.

JOAO CONTROL & MONITORING SYSTEMS, LLC,
Patent Owner.

Case IPR2015-01610
Patent 6,542,076 B1

Before DAVID C. MCKONE, STACEY G. WHITE, JASON J. CHUNG,
Administrative Patent Judges.

Opinion for the Board filed by *Administrative Patent Judge*, WHITE.

Opinion Concurring filed by *Administrative Patent Judge*, CHUNG.

WHITE, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
Inter Partes Review
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Volkswagen Group of America, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 3, 18, 65, 67, 68, 70, 73, 91, 94, 96, 103, 110, 116, 119, 120, and 205 of U.S. patent No. 6,542,076 B1 (Ex. 1001, “the ’076 patent”) pursuant to 35 U.S.C. §§ 311–319. Joao Control & Monitoring Systems, LLC, (“Patent Owner”) filed a Preliminary Response. (Paper 6). Based on our review of these submissions, we instituted *inter partes* review of claims 3, 18, 65, 67, 68, 70, 73, 91, 94, 96, 103, 110, 116, 119, 120 and 205 of the ’076 patent on grounds of unpatentability asserted under 35 U.S.C. §§ 102, 103. Paper 11 (“Dec.”). Specifically, we authorized this *inter partes* review to proceed as to the following grounds:

Reference(s)	Basis	Claim(s) Challenged
Kniffin ¹	§ 102	3, 18, 65, 67, 68, 70, 73, 91, 103, 116, 119, 120, and 205
Kniffin and one of Spaur, ² Behr, ³ or Kubler ⁴	§ 103	94 and 110
Kniffin and Neely ⁵	§ 103	96
Ryoichi ⁶	§ 102	3, 18, 65, 67, 70, 73, 91, 103, 116, 119, and 205
Ryoichi and one of Spaur, Behr, or Kubler	§ 103	94 and 110
Ryoichi and Neely	§ 103	68, 96, and 120

Id. at 24–25.

¹ U.S. Patent No. 6,072,402 (Ex. 1010) (“Kniffin”).

² U.S. Patent No. 5,732,074, filed Jan. 16, 1996 (Ex. 1020) (“Spaur”).

³ U.S. Patent No. 5,808,566, filed June 23, 1995 (Ex. 1021) (“Behr”).

⁴ U.S. Patent No. 5,726,984, filed Oct. 5, 1995 (Ex. 1022) (“Kubler”).

⁵ U.S. Patent No. 4,602,127 (Ex. 1018) (“Neely”).

⁶ U.S. Patent No. 5,113,427 (Ex. 1011) (“Ryoichi”).

Patent Owner filed a Patent Owner's Response (Paper 22, "PO Resp."), and Petitioner filed a Reply (Paper 26, "Reply"). No oral hearing was conducted. Paper 20.

We have jurisdiction under 35 U.S.C. §318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, Petitioner has demonstrated by a preponderance of the evidence that claims 3, 18, 65, 67, 68, 70, 73, 91, 94, 96, 103, 110, 116, 119, 120, and 205 of the '076 patent are unpatentable.

A. Related Proceedings

The parties inform us that the '076 patent is at issue in approximately one dozen lawsuits pending in courts around the country. Paper 17, Pet. 1–2. In addition, *ex parte* reexamination No. 90/013,302 was filed with respect to the '076 patent and has been stayed in light of this proceeding. Paper 16. The '076 patent also is the subject of a co-pending petition for *inter partes* review (IPR2015-01508).

B. The '076 patent

The '076 patent describes a control, monitoring, and/or security apparatus and method for vehicles. Ex. 1001, 1:25–32. The apparatus described in the '076 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 3:5–11.

An embodiment of the apparatus of the '076 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 3:50–56.

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 4:35–37; 4:61–5:14. The vehicle equipment systems may be activated, de-activated, reset, or controlled by the apparatus. *Id.* at 5:15–18. This activation or control may be achieved by a user entering a code on the transceiver of the transmitter system. *Id.* at 6:30–36. The code is transmitted to the CPU and then the CPU communicates with the appropriate vehicle equipment system. *Id.* at 7:16–21.

C. Illustrative Claim

As noted above, Petitioner challenges claims 3, 18, 65, 67, 68, 70, 73, 91, 103, 116, 119, 120, and 205 of the '076 patent, of which claims 3, 73, and 205 are independent. Claim 3 is illustrative of the challenged claims and is reproduced below:

3. A control apparatus, comprising:

a first control device, wherein the first control device at least one of generates a first signal and transmits a first signal for at least one of activating, de-activating, disabling, and re-enabling, at least one of a vehicle system, a vehicle equipment system, a vehicle component, a vehicle device, a vehicle equipment, and a vehicle appliance, of a vehicle, wherein the first control device is located at the vehicle,

wherein the first control device at least one of generates the first signal and transmits the first signal in response to a second signal, wherein the second signal is at least one of generated by a second control device and transmitted from a second control device, wherein the second control device is located at a location which is remote from the vehicle, wherein the second signal is transmitted from the second control device to the first control device, wherein the second signal is automatically received by the first control device, and further wherein the second control device at least one of

generates the second signal and transmits the second signal in response to a third signal,

wherein the third signal is at least one of generated by a third control device 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, wherein the third signal is transmitted from the third control device to the second control device, and further wherein the third signal is automatically received by the second control device.

II. CLAIM CONSTRUCTION

As acknowledged by the parties, the '076 patent has expired. *See* Pet. 9; PO Resp. 8. 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. Term Preliminarily Construed in the Decision to Institute

For purposes of the Decision to Institute, we construed the term “control device.” Dec. 5–9. Neither party raised any concerns regarding this construction during trial. *See* PO Resp. 10–11; Reply 1. Based on our review of the full record, we discern no reason to modify or further discuss

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