

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 IPR2015-01611
Patent 6,549,130 B1

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

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

Opinion Dissenting-in-part 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

Petitioner, Volkswagen Group of America, Inc., filed a Petition to institute an *inter partes* review of claims 26, 31, 38, 42, 43, 48, 60, 63, 64, 73, 74, 85, 91, 92, 138, 139, and 143 of U.S. Patent No. 6,549,130 B1 (“the ’130 patent”). Paper 2 (“Pet.”). Patent Owner, Joao Control & Monitoring Systems, LLC, filed a Preliminary Response pursuant to 35 U.S.C. § 313. Paper 6 (“Prelim. Resp.”).

Upon consideration of the Petition and the Preliminary Response, on January 28, 2016, we instituted *inter partes* review of claims 26, 31, 38, 42, 43, 48, 60, 63, 64, 73, 74, 85, 91, 92, 138, 139, and 143 (“instituted claims”), pursuant to 35 U.S.C. § 314. Paper 7 (“Dec.”).

Subsequent to institution, Patent Owner filed a Patent Owner Response. Paper 13 (“PO Resp.”). Petitioner filed a Reply to Patent Owner’s Response. Paper 19 (“Reply”). An oral hearing was not held. Paper 20.

We issue this Final Written Decision pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed herein, Petitioner has shown by a preponderance of the evidence that claims 91 and 92 are unpatentable and has not shown by a preponderance of the evidence that claims 26, 31, 38, 42, 43, 48, 60, 63, 64, 73, 74, 85, 138, 139, and 143 of the ’130 patent are unpatentable. *See* 35 U.S.C. § 316(e).

A. *Related Matters*

Petitioner and Patent Owner indicate that the ’130 patent or related patents may be implicated in a number of lawsuits pending in courts around the country. Pet. 1–2; Paper 5, 2–7. In addition, *ex parte* reexamination No.

90/013,301 was filed with respect to the '130 patent and has been stayed in light of this proceeding. Paper 16. The '076 patent also is the subject of a co-pending petitions for *inter partes* review (IPR2015-01509 and IPR2015-01760).

B. The Instituted Grounds

We instituted *inter partes* review on the following grounds of unpatentability:

| Reference(s) | Basis | Instituted Claim(s) |
|--|--------------------|---|
| Kniffin ¹ | § 102 ² | 26, 38, 42, 43, 48, 63, 73, 74, 91, and 138 |
| Kniffin and one of Spaur ³ , Behr ⁴ , or Kubler ⁵ | § 103 | 64, 85, and 92 |
| Kniffin and Ryoichi ⁶ | § 103 | 31 |
| Kniffin and Drori ⁷ | § 102 | 60 and 139 |
| Kniffin and Neely ⁸ | § 103 | 143 |

¹ U.S. Patent No. 6,072,402, filed Jan. 9, 1992 (Ex. 1006) (“Kniffin”).

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, revised 35 U.S.C. §§ 102, 103 and the relevant sections 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. 5,732,074, filed Jan. 16, 1996 (Ex. 1016) (“Spaur”).

⁴ U.S. Patent No. 5,808,566, filed June 23, 1995 (Ex. 1017) (“Behr”).

⁵ U.S. Patent No. 5,726,984, filed Oct. 5, 1995 (Ex. 1018) (“Kubler”).

⁶ U.S. Patent No. 5,113,427, issued May 12, 1992 (Ex. 1007) (“Ryoichi”).

⁷ U.S. Patent No. 5,081,667, issued Jan. 14, 1992 (Ex. 1008) (“Drori”).

⁸ U.S. Patent No. 4,602,127, issued July 22, 1986 (Ex. 1015) (“Neely”).

C. *The '130 Patent*

The '130 patent is directed to controlling a vehicle or premises. Ex. 1001, Abstract 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 can activate, de-activate, disable, or re-enable, one or more of “a respective system, component, device, equipment, equipment system, and/or appliance, of a respective vehicle or premises with the first signal.” *Id.* The second control device generates the second signal in response to a third signal from the third control device. *Id.* The “second control device is at least one of a server computer, a computer, and a network computer.” *Id.* at 81:19–21. In addition,

the third control device is at least one of a stationary device, a portable device, a hand-held device, a mobile device, a telephone, a cordless telephone, a cellular telephone, a home computer, a personal computer, a personal digital assistant, a television, an interactive television, a digital television, a personal communications device, a personal communications services device, a display telephone, a video telephone, a watch, and a two-way pager.

Id. at 81:21–29.

D. The Instituted Claims

Of the instituted claims, claims 26, 42, 48, 91, and 138 are independent. Claims 26 and 91 are illustrative and reproduced below:

26. A control apparatus, comprising:

a first control device, wherein the first control device at least one of generates 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 component, a vehicle device, a vehicle equipment, a vehicle equipment system, and a vehicle appliance, of a vehicle, wherein the first control device is located at the vehicle, wherein the first control device is responsive to a second signal, wherein the second signal is at least 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, wherein the second signal is transmitted from the second control device to the first control device, and further wherein the second signal is automatically received by the first control device,

wherein the second control device is responsive to a third signal, wherein the third signal is at least 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, 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,

wherein the at least one of a vehicle system, a vehicle component, a vehicle device, a vehicle equipment, a vehicle equipment system, and a vehicle appliance, is at least one of a vehicle ignition system, a vehicle fuel pump system, a vehicle alarm system, a vehicle door locking device, a vehicle hood locking device, a vehicle trunk locking device, a wheel locking device, a brake

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