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Paper 20
Date: January 23, 2017

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 IPR2015-01612
Patent 7,397,363 B2

Before STACEY G. WHITE, JASON CHUNG, and
BETH Z. SHAW, *Administrative Patent Judges*.

SHAW, *Administrative Patent Judge*.

DECISION
Final Written Decision
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Petitioner, Volkswagen Group of America, Inc., filed a Petition requesting *inter partes* review of claims 21, 24, 27, 29, 30, 31, 33, 68, 69, 72, 74, 77, and 80 ("the challenged claims") of U.S. Patent No. 7,397,363 B2 ("the '363 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."). Based on our review of these submissions, we declined to institute review of claims 21, 24, 27, 29, 30, 31, and 33, and we instituted *inter partes* review of claims 68, 69, 72, 74, 77, and 80. Paper 7 ("Dec."). Specifically, we authorized this *inter partes* review to proceed as to the following grounds: (1) claims 68, 69, 74, 77, and 80 under 35 U.S.C. § 102(e) as anticipated by Spaur[1]; and (2) claim 72 under 35 U.S.C. § 103(a) as obvious over Spaur.

Patent Owner filed a Patent Owner's Response (Paper 13, "PO Resp."), and Petitioner filed a Reply (Paper 18, "Reply"). An oral hearing was not held for this case because neither party requested a hearing and we determined an oral hearing was not necessary. Paper 19.

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 68, 69, 72, 74, 77, and 80 of the '363 patent are unpatentable.

A. Related Matters

Petitioner and Patent Owner indicate that the '363 patent or related patents have been asserted in a significant number of related cases. *See* Pet. 1–2; Paper 5.

[1] U.S. Patent No. 5,732,074, filed Jan. 16, 1996.

B. The '363 Patent

The '363 patent is directed to controlling a vehicle or premises. Ex. 1001, Abs. The '363 patent describes a first control device which generates a first signal and is associated with a web site and located remote from a premises or vehicle. *Id.* The first control device generates the first signal in response to a second signal that is transmitted via the Internet from a second control device located remote from the first device and remote from the premises or vehicle. *Id.* The first device determines whether an action associated with the second signal is allowed, and if so, transmits the first signal to a third device located at the premises. *Id.* The third device generates a third signal for activating, de-activating, disabling, re-enabling, or controlling an operation of a system, device, or component of the premises or vehicle. *See id.*

C. Illustrative Claims

Claims 68 and 72 are illustrative of the challenged claims and are reproduced below:

> 68. An apparatus, comprising:
>
> a first processing device, wherein the first processing device at least one of monitors and detects an event regarding 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 processing device is located at the vehicle, and further wherein the event is a detection of a state of disrepair of the at least one of a vehicle system, a vehicle equipment system, a vehicle component, a vehicle device, a vehicle equipment, and a vehicle appliance, wherein the first processing device at least one of generates a first signal and transmits a first signal to a

> second processing device, wherein the first signal contains information regarding the event, and further wherein the second processing device is located at a location which is remote from the vehicle, wherein the second processing device automatically receives the first signal, and further wherein the second processing device at least one of generates a second signal and transmits a second signal to a communication device, wherein the second signal is transmitted to the communication device via, on, or over, at least on of the Internet and the World Wide Web, wherein the communication device is located remote from the second processing device, and wherein the communication device automatically receives the second signal, and further wherein the communication device provides information regarding the event.
>
> 72. The apparatus of claim 68, wherein the communication device is at least one of a wireless device, a cellular telephone, and a personal digital assistant.

II. ANALYSIS

A. Claim Construction

In the Decision to Institute, we noted that the '363 patent was due to expire no later than May 6, 2016. Dec. 7. The parties have not disputed the calculation of the '363 patent's expiration date. Based on our review of the record, we discern no reason to modify that calculation and thus, we find the '363 patent to be expired. For claims of an expired patent, the Board's claim interpretation is similar to that of a district court. *See In re Rambus, Inc.*, 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 v. AWH Corp.*, 415 F. 3d 1303, 1312–17 (Fed. Cir. 2005)).

We are mindful that "limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993). Nevertheless, claims are not interpreted in a vacuum but are part of and read in light of the specification. *United States v. Adams*, 383 U.S. 39, 49 (1966) ("[I]t is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention."). In that regard, the terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the Specification. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). The construction that stays true to the claim language and most naturally aligns with the inventor's description is likely the correct interpretation. *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998).

In the Institution Decision, we determined the terms "processing device," "remote," and "located at" did not require express construction, and we did not expressly construe any other claim terms. Dec. 8.

In its Response, Patent Owner proposes constructions for "processing device," "first signal," and "second signal." PO Resp. 8–9. We determine that it is not necessary to construe "first signal" and "second signal" to resolve the controversy here. We construe "processing device," as discussed in more detail below. To the extent it is necessary for us to construe any additional claim terms in this decision, we do so below in the context of analyzing whether the prior art renders the claims unpatentable.

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