Trials@uspto.gov
571-272-7822

Paper 22
Entered: January 27, 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 IPR2015-01613
Patent 5,917,405

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 (Paper 2) requesting *inter partes* review of claims 1–3, 7, 8, 11, 12, 14, 16, 17, 19, and 20 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 6). Based on our review of these submissions, we instituted *inter partes* review of claims 1–3, 7, 8, 11, 12, 14, 16, 17, 19, and 20 of the '405 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[2]	1, 2, 7, 8, 11, 12, 14, 16, 17, 19, and 20
Kniffin and DiLullo[3]	§ 103	3
Ryoichi[4]	§ 102	1, 2, 7, 8, 11, 12, 14, 16, 17, 19, and 20
Ryoichi and Mansell[5]	§ 103	3

Id. at 19–20.

[1] U.S. Patent No. 6,072,402 (Ex. 1002) ("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. 4,897,642 (Ex. 1004) ("DiLullo").

[4] U.S. Patent No. 5,113,427 (Ex. 1003) ("Ryoichi").

[5] U.S. Patent No. 5,223,844 (Ex. 1005) ("Mansell").

Patent Owner filed a Patent Owner's Response (Paper 13, "PO Resp."), and Petitioner filed a Reply (Paper 19, "Reply"). No oral hearing was conducted. Paper 21.

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 1–3, 7, 8, 11, 12, 14, 16, 17, 19, and 20 of the '405 patent are unpatentable.

A. Related Proceedings

The parties inform us that the '405 patent is at issue in numerous lawsuits pending in courts around the country. Paper 14, Pet. 1–2. In addition, *ex parte* reexamination No. 90/013,300 was filed with respect to the '405 patent and has been stayed in light of this proceeding. Paper 16. The '405 patent also is the subject of a co-pending petition for *inter partes* review (IPR2015-01585).

B. The '405 patent

The '405 patent describes a remote-controlled control, monitoring, and/or security apparatus and method for vehicles. 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.

C. Illustrative Claim

As noted above, we instituted *inter partes* review on claims 1–3, 7, 8, 11, 12, 14, 16, 17, 19, and 20 of the '405 patent, of which claims 1, 12, and 16 are independent. Claim 1 is illustrative of the instituted 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. 13; PO Resp. 6. 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. 5–8. Neither party raised any concerns regarding this constructions during trial. *See* PO Resp. 9; *see generally* Reply. Based on our review of the full record, we discern no reason to modify or further discuss in this Final Written Decision our construction for this claim term. For convenience, the claim construction is reproduced in the table below.

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