

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 HOWARD B. BLANKENSHIP, STACEY G. WHITE, and  
JASON J. CHUNG, *Administrative Patent Judges*.

WHITE, *Administrative Patent Judge*.

DECISION  
Institution of *Inter Partes* Review  
37 C.F.R. § 42.108

## I. INTRODUCTION

### A. Background

Volkswagen Group of America, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) seeking to institute an *inter partes* review of claims 1, 2, 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, “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

Petitioner contends the challenged claims are unpatentable under 35 U.S.C. §§ 102 and 103 on the following specific grounds (Pet. 14–59):

Reference(s)	Basis	Claim(s) Challenged
Kniffin <sup>1</sup>	§ 102	1, 2, 7, 8, 11, 12, 14, 16, 17, 19, and 20
Kniffin and DiLullo <sup>2</sup>	§ 103	3
Ryoichi <sup>3</sup>	§ 102	1, 2, 7, 8, 11, 12, 14, 16, 17, 19, and 20
Ryoichi and Mansell <sup>4</sup>	§ 103	3

Our factual findings and conclusions at this stage of the proceeding are based on the evidentiary record developed thus far (prior to Patent Owner’s Response). This is not a final decision as to patentability of claims for which *inter partes* review is instituted. Our final decision will be based

---

<sup>1</sup> U.S. Patent No. 6,072,402 (Ex. 1002) (“Kniffin”).

<sup>2</sup> U.S. Patent No. 4,897,642 (Ex. 1004) (“DiLullo”).

<sup>3</sup> U.S. Patent No. 5,113,427 (Ex. 1003) (“Ryoichi”).

<sup>4</sup> U.S. Patent No. 5,223,844 (Ex. 1005) (“Mansell”).

on the record as fully developed during trial. For reasons discussed below, we institute *inter partes* review of the '405 patent as to claims 1, 2, 3, 7, 8, 11, 12, 14, 16, 17, 19, and 20.

*B. Related Proceedings*

Petitioner informs us that the '405 patent may be implicated in numerous lawsuits pending in courts around the country. Pet. 1–2. In addition, *ex parte* reexamination No. 90/013,302 was filed with respect to the '405 patent and is pending. Pet. 2. The '405 patent also is the subject of a co-pending petition for *inter partes* review (IPR2015-01585).

*C. The '405 Patent*

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

*D. Illustrative Claim*

As noted above, Petitioner challenges claims 1, 2, 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 challenged 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, therein 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; Prelim. Resp. 7. 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).

Petitioner does not seek explicit construction of any term of the ’405 patent. Pet. 12–14. Patent Owner argues that the terms “control device,” “remote,” and “located at” are defined expressly in the prosecution history of at least two related applications. Prelim. Resp. 15–32. Petitioner does not provide explicit arguments regarding the terms “remote” or “located at.” We are not persuaded that express construction of “remote,” or “located at” is necessary in order to resolve the issues currently before us. Thus, we discern no need to provide express constructions for these terms at this time. *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”).

We, however, discern a need to provide an express construction for “control device.” Patent Owner asserts that “control device” is defined expressly in remarks filed November 23, 2007, during prosecution of the patent application that issued as U.S. Patent No. 7,397,363 (“the ‘363 patent”) (Ex. 2002). Prelim. Resp. 15. This statement was made several years after the issuance of the ’405 patent. *See* Ex. 1001, at [45] (June 29, 1999 issuance date). The ’405 patent and the ’363 patent each descend from

# 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.