

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

PRELIMINARY RESPONSE OF PATENT OWNER

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION.....	1
II. BACKGROUND	2
A. Overview of the ‘405 Patent	2
B. Prosecution History of the ‘405 Patent	3
C. Petition Overview	4
III. CLAIM CONSTRUCTION.....	7
A. Legal Standards.....	7
B. Petitioner has Failed to Submit Claim Constructions for Key Terms Supporting its Invalidity Arguments	10
C. “control device”	15
1. Each “control device” is separate and distinct from the claimed vehicle systems being controlled.....	16
2. Each “control device” is separate and distinct from the communication system or the communication network, or any component of same, on, over, via, or in conjunction with, which they operate	19
D. “remote”	31
E. “located at”	31

IV. THE PROPOSED GROUNDS FAIL TO MEET THE BURDEN OF SHOWING A REASONABLE LIKELIHOOD OF PREVAILING..... 32

A. Ground 1 33

 1. Kniffen fails to teach the “first control device” of claim 1 and the “third control device” of claims 12 and 16 33

B. Ground 2 42

C. Ground 3 42

 1. Ryoichi fails to teach the “second control device” of claims 1 and 16, and the “first control device” of claim 12 42

D. Ground 4 44

VII. CONCLUSION 44

LIST OF EXHIBITS

Exhibit	Description
EX2001	“Preliminary Remarks” filed by Applicant on November 26, 2006 during prosecution of the patent application that issued as related U.S. Patent No. 7,277,010
EX2002	“Supplement to the Remarks for the Amendment filed on October 24, 2007” filed on November 23, 2007 during prosecution of the patent application that issued as related U.S. Patent No. 7,397,363

I. INTRODUCTION

Patent Owner Joao Control & Monitoring Systems, LLC (“JCMS”) respectfully submits this Preliminary Response of Patent Owner (“Preliminary Response”) in accordance with 35 U.S.C. § 313 and 37 C.F.R. § 42.107. This Preliminary Response responds to the Petition for *Inter Partes* Review (“Petition”) filed by Petitioner regarding claims 1, 2, 3, 7, 8, 11, 12, 14, 16, 17, 19 and 20 (“Challenged Claims”) of U.S. Patent No. 5,917,405 (“the ‘405 Patent”).

This Preliminary Response is timely filed under 35 U.S.C. § 313 and 37 C.F.R. § 42.107, as it is filed within three months of the August 5, 2015 date of the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response (Paper No. 3).

JCMS requests that the Board not institute an *inter partes* review (“IPR”) because Petitioner has failed to demonstrate a reasonable likelihood of prevailing with respect to any of the Challenged Claims, thereby failing to meet the threshold for institution under 35 U.S.C. § 314(a).

The four proposed grounds of rejection are substantively flawed, in that none of the cited references teach important properly construed claim limitations.

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.