

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 filed by *Administrative Patent Judge*, CHUNG.

WHITE, *Administrative Patent Judge*.

DECISION
Denying Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Volkswagen Group of America, Inc., (“Petitioner”) requests rehearing of our Final Written Decision (Paper 21, “Final Dec.”), in which we held that Petitioner had shown by a preponderance of the evidence the unpatentability of claims 91¹ and 92 of U.S. Patent No. 6,549,130 B1 (“the ’130 patent”) and failed to show by a preponderance of the evidence the unpatentability of claims 26, 31, 38, 42, 43, 48, 60, 63, 64, 73, 74, 85, 138, 139, and 143 of the ’130 patent. Final Dec. 21. Specifically, Petitioner seeks rehearing as to the claims that had not been shown to be unpatentable by arguing that it had provided sufficient evidence and argument to show that Kniffin² disclosed the claimed first control device which is responsive to a second signal. Reh’g Req. 1.

II. STANDARD OF REVIEW

A party dissatisfied with a decision of the Board may file a request for rehearing. 37 C.F.R. § 42.71(d). The party requesting rehearing has the burden of showing the decision should be modified, and “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.*

¹ Petitioner states that we found that it “did not carry its burden to establish that . . . [Kniffin] anticipates independent claims 26, 42, 48, 91, and 138.” Paper 22 (“Reh’g Req.”), 2. In our Final Written Decision, however, we did find that claims 91 and 92 (claim 92 depends from claim 91) were unpatentable. See Final Dec. 21.

² U.S. Patent No. 6,072,402, filed Jan. 9, 1992 (Ex. 1006) (“Kniffin”).

III. ANALYSIS

Petitioner asserts that we overlooked and misapprehended its evidence and arguments. Reh’g Req. 4. Petitioner contends that it had shown sufficiently “that Kniffin describes an in-vehicle device (access control device 64) that is responsive to the signal from an intermediate device (clearinghouse 66), to activate a vehicle component.” *Id.* at 3 (citing Paper 2 (“Pet.”), 14–17). For the reasons stated below, we are not persuaded by Petitioner’s arguments.

Claim 26 recites “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.” Ex. 1001, 80:9–10; *see also id.* 83:25–26 (similar language in claim 42), 85:15–18 (claim 48), 99:13–14 (claim 138). Thus, in each of independent claims 26, 42, 48, and 138, the first control device³ must respond to a signal from the second control device. Petitioner asserts that Kniffin discloses this limitation through its discussion of access control device 64 and clearinghouse 18 or 66. Pet. 13–14. We refer to claim 26 in this discussion, but the issues addressed here also apply to claims 42, 48, and 138. In our Final Written Decision, we held that Petitioner had not met its burden to show that Kniffin discloses this limitation and therefore, Petitioner had not met its burden to establish the

³ As explained in the Final Written Decision, each of the independent claims recites three control devices and three signals. Final Dec. 11–12. The same three devices and related signals are recited in these claims, but the labels differ from claim to claim. *Id.* For example, the first control device of claim 26 is the same as the third control device of claim 91. *Id.* For ease of reference, unless otherwise stated we will use the nomenclature set out in claim 26 to refer to the three control devices and their respective signals.

unpatentability of independent claims 26, 42, 48, and 138 and their dependent claims 31, 38, 43, 60, 63, 64, 73, 74, 85, 139, and 143. Final Dec. 12–16.

First, Petitioner argues that we overlooked evidence sufficient to establish that Kniffin discloses “a causal link between the clearinghouse and the storing of data in the in-vehicle memory.” Reh’g Req. 4. Petitioner then directs us to evidence cited in the Petition that describes the clearinghouse sending a verified schedule of deliveries to the access control device. *Id.* at 5 (citing Pet. 15–17). Petitioner emphasizes that the schedule is received by the access control device and stored in memory. *Id.* at 6. Based on this, Petitioner asserts “that the truck . . . access control device is responsive to the clearinghouse transmission by virtue of the transmitted signal from the clearinghouse to the access control device, causing the reprogramming of the access control device or storing data into memory.” *Id.* at 7.

We do not agree. In the Final Written Decision, we explained that in Kniffin, decisions as to whether to allow access were made “[i]n response to identification of the authorized user at the lock within the prescribed time period.” Final Dec. 14 (quoting Ex. 1006, 3:64–66). Thus, we found that Kniffin discloses an access control device responsive to a signal from identification device 70. *Id.* We were not persuaded that the access control device also was “responsive to” the signal from the clearinghouse. We acknowledged that Kniffin discloses a communication between the clearinghouse and the vehicle that is used by the in-vehicle component, but we were not persuaded that the proffered evidence was sufficient to establish the required responsiveness to that signal. This is discussed in our analysis of Petitioner’s challenge to claim 91.

We find that the schedule is stored in Kniffin's access control device and later used in the processing to determine whether the lock should unlock. Thus, we are persuaded that Kniffin's description of the clearinghouse sending a sequence of deliveries to the access control device discloses the claimed first signal "for . . . activating, de-activating, disabling, and re-enabling . . . a vehicle component." In the previously discussed independent claims we were not persuaded that Petitioner has established that the in-vehicle device was "responsive" to the signal from the clearinghouse. We, however, are persuaded that Petitioner has established that the in-vehicle device uses the information from the clearinghouse in deciding whether to unlock the access control device and as such the schedule is transmitted *for* activating or de-activating the lock.

Final Dec. 17.

As noted in the Final Written Decision, claim 91 does not require that the first control device⁴ be "responsive to" the signal from the second control device. Final Dec. 11–12, 16. Claim 91 instead recites, in relevant part,

a [second] signal for at least one of activating, deactivating, disabling, and re-enabling . . . a vehicle component . . . wherein the [second] signal is transmitted from the [second] control device to a [first] control device . . . [and] wherein the [second] control signal is automatically received by the [first] control device, wherein the [first] control device at least one of generates and transmits a [first] signal for at least one of

⁴ As noted above, the claims recite the same three control devices in different orders. The third control device of claim 91 is the same as the second control device of claim 26. Final Dec. 11 (noting that claim 26's third control device is equivalent to claim 91's second control device; claim 26's second control device is equivalent to claim 91's first control device; and claim 26's first control device is equivalent to claim 91's third control device). For ease of reference, we maintain the nomenclature used in claim 26 when discussing the devices in claim 91.

activating, de-activating, disabling, and re-enabling . . . a vehicle component.

Ex. 1001, 90:27–30, 90:43–57. Thus, in claim 91, the second signal must be “automatically received” and it must be “for at least one of activating, deactivating, disabling, and re-enabling” a vehicle component, but there is no requirement that the first control device be responsive to the second signal. We found Petitioner’s evidence to be persuasive as to this limitation, but we found that it was not sufficient for the “responsive to” limitation found in the other independent claims.

Similar to claim 91, claim 26 also requires the second signal to be “automatically received” and to be generated and transmitted “for at least one of activating, de-activating, disabling, and re-enabling.” Claim 26, however, recites the additional limitation requiring the first control device to be “responsive to” the second signal. Thus, the language of claim 26 indicates that the “responsive to” limitation requires something in addition to the receipt and use of the signal that we found to be sufficient for claim 91. We reviewed and considered the evidence that Petitioner revisits in its Request for Rehearing at the time we rendered our Final Written Decision, but we were not persuaded that this evidence was sufficient to show this additional requirement.

Second, Petitioner asserts that we misapprehended the relevance of Kniffin’s description of storing and reprogramming memory. Reh’g Req. 9. Petitioner argues that the signal from Kniffin’s identification device 70 is “immaterial” because the schedule from Kniffin’s clearinghouse is stored or reprogrammed in memory before an interaction occurs between the truck and the identification device. *Id.* at 9–10. Further, Petitioner contends that it

“relies on Kniffin’s storing or reprogramming of data in memory to show that an in-vehicle component (memory) is activated (data is stored or reprogrammed) in response to signals from the intermediate device (the clearinghouse).” *Id.* at 11. Petitioner asserts that our “reliance on the specification of the ’130 patent was improper” and did not address the unpatentability analysis presented in the Petition. *Id.* at 10. Petitioner asserts that the act of storing/reprogramming the schedule in the memory of the access control device is sufficient evidence to show the recited control device “responsive to” a second signal. *Id.* at 9–10. In addition, Petitioner asserts that we misapprehended its argument because “the Petition does not argue that any control device is responsive to Kniffin’s stored data,” instead Petitioner’s argument is that by storing the data the memory is activated and that is sufficient. *Id.* at 11.

Here, we also disagree with Petitioner. As noted in the Final Written Decision, we found that Petitioner did not provide a sufficient explanation as to “why storing a schedule in memory or reprogramming a device discloses the recited device responsive to a second signal.” Final Dec. 14. We explained that the specification of the ’130 patent differentiated between information stored in the device and signals to which the device was “responsive.” *Id.* at 15. Petitioner contends that we improperly relied on the specification of the ’130 patent as part of our analysis of the asserted grounds. Reh’g Req. 10. We do not agree. The claims are to be analyzed in light of the disclosures in the specification. We are tasked with performing this analysis without importing limitations from the specification into the claim. Our review of the disclosures of the specification aided us in determining whether the cited art provided a disclosure that was sufficient to

meet the “responsive to” requirement at issue and we are not persuaded that this analysis was in error. We compared the stored data discussed in the specification with Kniffin’s stored schedule and contrasted those disclosures with the program code, which is described in the specification as the signal to which the control device is responsive. Final Dec. 15. Petitioner did not persuade us that storing a schedule in memory was sufficient to meet this “responsive to” limitation, in part, because we determined that the storage of the schedule was analogous to the storage described in the specification and as such, Kniffin’s storage of the schedule in the access control device was not sufficient to disclose the required “responsive to” limitation.

We also are not persuaded that Kniffin’s reprogramming would meet this limitation. Kniffin allows the clearinghouse to send an updated schedule to the access control device and, upon the receipt of this new schedule, the access control device stores the new schedule in memory. *See* Ex. 1006, 8:61–67. This storage of the updated schedule is the “reprogramming” on which Petitioner relies. Reh’g Req. 9–11. For reasons described above, we determined that storing/reprogramming of a schedule is not sufficient to disclose the recited first control device which is responsive to a second signal because storing data was contemplated in the specification and it was not the same as the recited limitation. Final Dec. 14.

IV. CONCLUSION

The Request for Rehearing does not demonstrate that we misapprehended or overlooked any arguments or evidence in finding that Petitioner did not carry its burden to establish the unpatentability of 26, 31, 38, 42, 43, 48, 60, 63, 64, 73, 74, 85, 138, 139, and 143 of the ’130 patent.

V. ORDER

In consideration of the foregoing, it is hereby:
ORDERED that the Request for Rehearing is *denied*.

IPR2015-01611
Patent 6,549,130 B1

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*.

CHUNG, *Administrative Patent Judge*, dissenting.

I respectfully dissent from my esteemed colleagues' decision for the same reasons I described in the Final Written Decision. Paper 21, 1–15 (Chung, J., dissenting-in-part).

IPR2015-01611
Patent 6,549,130 B1

PETITIONER:

Michael J. Lennon
Clifford A. Ulrich
KENYON & KENYON LLP
mlennon@kenyon.com
culrich@kenyon.com

PATENT OWNER:

Raymond A. Joao
rayjoao@optonline.net

René A. Vazquez
SINERGIA TECHNOLOGY LAW GROUP, PLLC
rvazquez@hgdllawfirm.com