

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NISSAN NORTH AMERICA, INC.,
Petitioner

v.

JOAO CONTROL & MONITORING SYSTEMS, LLC,
Patent Owner

Case IPR2015-01645
Patent 7,397,363

Before STACEY G. WHITE, JASON J. 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, Nissan North America, Inc., filed a Petition requesting *inter partes* review of claims 21, 22, 24, 25, 29, and 36 of U.S. Patent No. 7,397,363 (“the ’363 patent”). Paper 1 (“Pet.”). Patent Owner, Joao Control & Monitoring Systems, LLC, filed a Preliminary Response pursuant to

35 U.S.C. § 313. Paper 8 (“Prelim. Resp.”). Based on our review of these submissions, we instituted *inter partes* review of claims 21, 22, 24, 25, 29, and 36 (“the instituted claims”). Paper 11 (“Dec.”).

Patent Owner filed a Patent Owner’s Response (Paper 20, “PO Resp.”), and Petitioner filed a Reply (Paper 23, “Pet. Reply”). An oral hearing was held for this case on October 20, 2016. A transcript of the oral hearing is included in the record. Paper 28.

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 21, 22, 24, 25, 29, and 36 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. The ’363 patent also is the subject of another *inter partes* review (IPR2015-01612).

B. The Asserted Grounds

Petitioner identifies the following as asserted grounds of unpatentability:

Reference(s)	Basis	Instituted Claim(s)
Frossard (Ex. 1005) ¹ and Spaur (Ex. 1016) ²	§ 103(a)	21, 24, 25, and 36
Frossard, Spaur, and Pagliaroli (Ex. 1006) ³	§ 103(a)	22
Frossard, Spaur, and Simms (Ex. 1007) ⁴	§ 103(a)	29
Johnson (Ex. 1008) ⁵ and Rossmann (Ex. 1009) ⁶	§ 103(a)	21, 22, 24, 25, 29, and 36

C. The '363 Patent

The '363 patent is directed to controlling a vehicle or premises. Ex. 1001, Abst. 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

¹ European Patent Application Publication No. 0 505 266 A1, published March 17, 1992.

² U.S. Patent No. 5,732,074, filed Jan. 16, 1996.

³ U.S. Patent No. 5,276,728, filed Nov. 6, 1991.

⁴ U.S. Patent No. 5,334,974, filed Feb. 6, 1992.

⁵ U.S. Patent No. 5,557,254, filed Nov. 16, 1993.

⁶ U.S. Patent No. 5,809,415, filed Dec. 11, 1995.

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.*

D. Illustrative Claim

We instituted *inter partes* review of claims 21, 22, 24, 25, 29, and 36, of which claim 21 is the only independent claim. Claim 21 is illustrative and is reproduced below:

21. An apparatus, comprising:

a first processing device, wherein the first processing device at least one of generates a first signal and transmits a first signal for at least one of activating, de-activating, disabling, re-enabling, and controlling an operation of, 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 or located at a vehicle, wherein the first processing device is associated with a web site, and further wherein the first processing device is located at a location remote from the vehicle,

wherein the first processing device at least one of generates the first signal and transmits the first signal in response to a second signal, wherein the second signal is [] at least one of generated by a second processing device and transmitted from a second processing device, wherein the second processing device is located at a location which is remote from the first processing device and remote from the vehicle, wherein the first processing device determines whether an action or an operation associated with information contained in the second signal, to at least one of activate, de-activate, disable re-enable, and control an operation 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, is an authorized or

an allowed action or an authorized or an allowed operation, and further wherein the first processing device at least one of generates the first signal and transmits the first signal to a third processing device if the action or the operation is determined to be an authorized or an allowed action or an authorized or an allowed operation, wherein the third processing device is located at the vehicle,

wherein the second signal is transmitted to the first processing device via, on, or over, at least one of the Internet and the World Wide Web, and further wherein the second signal is automatically received by the first processing device, wherein the first signal is transmitted to and automatically received by the third processing device, wherein the third processing device at least one of generates a third signal and transmits a third signal for at least one of activating, de-activating, disabling, re-enabling, and controlling an operation 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, in response to the first signal.

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. 6. 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 that no terms required express construction. Dec. 7. In its Response, Patent Owner proposes constructions for “interface device,” “processing device,” “first signal,” “second signal,” and “third signal.” PO Resp. 9–11. We determine that it is not necessary to expressly construe these terms to resolve the controversy here. 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.

B. Mr. McNamara's Testimony

1. Prosecution History

Petitioner relies on testimony of Mr. David McNamara. Pet. 26–30 (citing Ex. 1003). Patent Owner asserts that we should accord little or no weight to the testimony of Mr. McNamara. PO Resp. 14–17. We note that Patent Owner did not move to exclude this testimony and thus, its arguments are limited to the weight that should be given to the testimony. *Id.*

First, Patent Owner argues that Mr. McNamara did not review the materials required to properly reach his conclusions and opinions, such as the prosecution history of the '363 patent. *Id.* at 14–15. Paragraph 13 of Mr. McNamara's declaration states in part that "I have read the '363 Patent and its prosecution history." Ex. 1003 at ¶ 13. Patent Owner argues Mr. McNamara's testimony is flawed, however, because during cross-examination, Mr. McNamara testified that he had not reviewed the prosecution history of the '363 patent. PO Resp. 14–15 (citing Ex. 2006, 153:11–22 (In response to Patent Owner's questions "you did not review the prosecution histories for the four JCMS patents at issue correct" and "you did not apply the, any definitions that may have been provided by Mr. Joao during prosecution of those patents, correct," Mr. McNamara answers "[t]hat's correct.")).

Petitioner argues Mr. McNamara signed his declaration nine months before the cross examination, and in the declaration, he stated that he read the '363 patent and its prosecution history. Reply 2–3 (citing Ex. 1003 ¶ 13). According to Petitioner, Patent Owner improperly tries to latch onto Mr. McNamara's testimony that he did not read the prosecution history

while ignoring other statements to the contrary. *Id.* (citing Ex. 2006, 153:11–15). In particular, Petitioner argues Patent Owner ignores Mr. McNamara’s other statements that demonstrate that he reviewed the prosecution history. *Id.* at 2–3 (citing Ex. 2006, 154:11–20). According to Petitioner, Mr. McNamara’s inconsistent testimony, at best, illustrates a lapse in memory during a lengthy deposition. *Id.* at 3.

Petitioner also argues that any alleged failure by McNamara to not review the prosecution history of the ’363 patent has no bearing on the claim construction in this proceeding. *Id.* at 4. Specifically, Petitioner argues that Mr. McNamara confirmed during cross-examination that he reviewed all the materials including Exhibit 1009 containing the preliminary amendment of the ’363 patent—the only document in the prosecution history that is potentially relevant because it includes proposed definitions of claim terms. *Id.* (citing Ex. 2006, 154:14–20).

We are not persuaded that Mr. McNamara’s statements on cross-examination are sufficient to accord his testimony little or no weight. The prosecution history is an important element in understanding the claims of a patent. Yet, we are persuaded that the statement “that’s correct” (in response to the question made during cross examination about his review of the prosecution history of four patents) appears to be a misstatement as to Mr. McNamara’s review of the ’363 patent and its underlying prosecution history. Mr. McNamara signed his declaration under penalty of perjury, and made other statements during cross-examination that are consistent with his declaration testimony that he reviewed the relevant prosecution history. *See* Ex. 1003 ¶ 13; Ex. 2006, 154:11–20. We agree with Petitioner that Mr. McNamara’s inconsistent testimony (i.e., “that’s correct”) appears to

illustrate a momentary lapse in memory. *Compare e.g.*, Ex. 2006 at 153:11–15, *with id.* at 154:11–20.

Moreover, Patent Owner has not explained why Mr. McNamara’s testimony displays a lack of understanding of any particular part of the prosecution history, or how such testimony is dispositive to any particular issue in this case. In light of the foregoing, we credit the declaration testimony of Mr. McNamara that he reviewed the prosecution history of the ’363 patent over his cross-examination statement to the contrary. *See Yorkey v. Diab*, 601 F.3d 1279, 1284 (Fed. Cir. 2010) (“It is within the discretion of the trier of fact to give each item of evidence such weight as it feels appropriate”) (quoting *Velandier v. Garner*, 348 F. 3d 1359, 1371 (Fed. Cir. 2003)).

2. *Mr. McNamara’s Analysis of the Claims*

Patent Owner also contends that Mr. McNamara has an erroneous understanding of the standards of claim construction and thus, we should give his testimony little or no weight. PO Resp. at 15–16. Patent Owner argues Mr. McNamara acknowledged during cross-examination that he used the wrong claim construction standard when construing the claims. *Id.* (citing Ex. 2006, 151:14–152:18 (Mr. McNamara acknowledged that he used “the broadest reasonable construction in light of the specification of the patent.” However, in response to Patent Owner’s questions “[a]re you aware that the PTAB has indicated or stated that this is, in fact, the wrong standard for the 363’ patent” and “[h]ow does the use of the wrong claim construction standard affect your opinions in this case,” Mr. McNamara answers “I don’t think I used the wrong standard because I used the same standard through all

of the four patents. I used the one of ordinary and customary understanding.”)). Patent Owner argues that Mr. McNamara acknowledged that he cannot discern the difference between claims in an expired patent and claims in an unexpired patent and uses the same claim construction standard (i.e., plain and ordinary meaning) for both expired and unexpired patents. PO Resp. 16–17 (citing Ex. 2006, 152:19–25).

Petitioner argues that Patent Owner’s reliance on Mr. McNamara being unable to differentiate between the “broadest reasonable construction” and the “ordinary and customary understanding” is misplaced because the difference between the two standards is a legal question that is not at issue in this case. Pet. Reply 4. Petitioner also argues Patent Owner fails to explain how Mr. McNamara’s claim construction is incorrect, why Mr. McNamara’s claim construction is different from the plain and ordinary meaning, or how it impacts the opinions expressed in his declaration. *Id.* at 4–5. According to Petitioner, at most, Patent Owner illustrates that Mr. McNamara did not explain the difference between the “broadest reasonable construction” and the “plain and ordinary meaning” legal standards. *Id.*

We agree with Petitioner that Patent Owner fails to explain what relevance this argument has to this case. Patent owner faults the expert for using an incorrect claim construction standard, but does not explain why the choice of standard is dispositive in this *inter partes* review. See PO Resp. 16–17. We are unconvinced that the expert’s choice of claim construction standards presents a meaningful distinction in this case, as Patent Owner has not explained why or how the different standards would lead to a different outcome in this case. In light of the foregoing, we credit the declaration testimony of Mr. McNamara.

C. *Obviousness Based on Frossard and Spaur*

1. *Frossard (Ex. 1005)*

Frossard describes a system for controlling shutdown of movable or mobile equipment and locating the movable or mobile equipment. Ex. 1005, 2:1–2. Figure 1 is reproduced below.

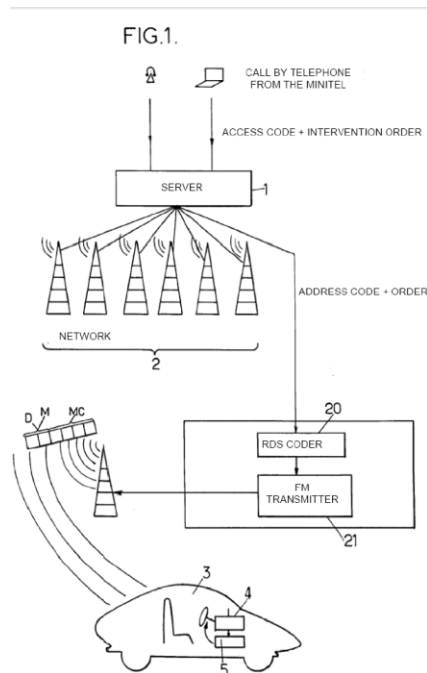


Figure 1 illustrates movable or mobile equipment 3 containing receiver-decoder circuits 4 for an order message to shut down movable or mobile equipment 3. *Id.* at 5:7–12. In addition, Figure 1 shows a scenario in which equipment 3 is stolen, the owner or authorized person calls server 1 to communicate a shutdown order of equipment 3. *Id.* at 9:14–17. After server 1 validates the shutdown order, the shutdown order is transmitted to equipment 3. *Id.* at 9:23–24. Figure 2, which is reproduced below, provides a more detailed explanation of how equipment 3 is shut down.

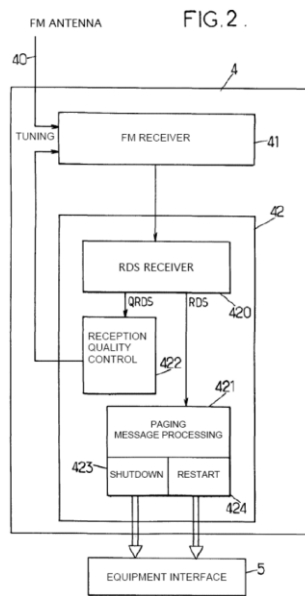


Figure 2 illustrates receiver-decoder circuits 4 and equipment interface 5 from Figure 1. *Id.* at 3:26–27, 7:21–23. Shutdown circuit 423 controls immediate or deferred shutdown of equipment 3. *Id.* at 9:28–10:3. When shutdown of equipment 3 occurs, an electrical contact that activates the starter is broken. *Id.* at 10:13–21.

2. *Spaur (Ex. 1016)*

Spaur describes an apparatus for communication of information “between a vehicle and one or more remote stations using an established network, such as the Internet.” (Ex. 1016, 1:7–8; 5:40–6:22; Fig. 1.) Figure 1 is reproduced below.

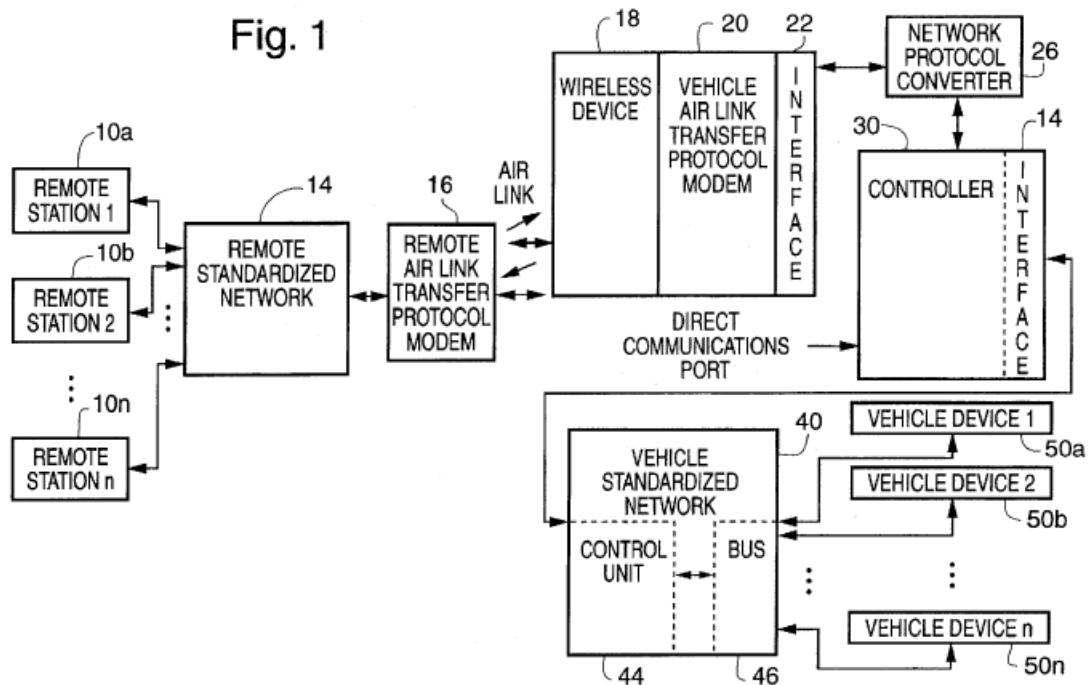


Figure 1 illustrates an apparatus for bi-directional communication between one or more remote stations 10a-n and a vehicle. Ex. 1016, 5:40–43. At the remote site, there is “[a]n internet or world wide web browser . . . available to the computer terminal” and “[t]he computer terminal supplies the browser with an IP (Internet protocol) address” which is “associated with a particular vehicle.” *Id.* at 2:25–34.

3. Analysis of Obviousness Challenge of Claims 21, 24, 25, and 36

Petitioner contends that the combination of Frossard and Spaur teaches all of the limitations of independent claim 21. Pet. 13–26. As support, Petitioner provides detailed explanations as to how the combination of prior art meets each claim limitation, and as to why the references would be combined. *Id.*

Petitioner points to Frossard's transmitting "an access code" and "corresponding intervention order" to a "server center... via a telephone connection or a Minitel, for example." Pet. 13–14 (citing Ex. 1005, p. 4 ¶ 3). The server center transmits "an order message M to shut down this equipment," such as "a motor vehicle." *Id.* (citing Ex. 1005, p. 4, ¶ 4; Ex. 1003 ¶ 43).

Petitioner directs our attention to Spaur as teaching a computer terminal, remote from the vehicle, which "is able to communicate with a first standard communications network link, such as the Internet, through its modem." Pet. 21 (citing Ex. 1016, 2:27–29; 7:23–47; Fig. 2.) "An internet or a world wide web browser, for example, that is available to the computer terminal is accessed. . . ." and the computer terminal supplies the browser with an IP (internet protocol) address that is "associated with a particular vehicle including communications related hardware contained in the vehicle." *Id.* (citing Ex. 1016, 2:29–34; Ex. 1003 ¶ 58.). Spaur discloses transmitting signals over the Internet to communicate information to a remote vehicle. *Id.*

Petitioner contends a person having ordinary skill would have combined the teachings of Frossard with those of Spaur for various reasons, including that both references describe systems for remotely communicating information to a vehicle, and receivers located on the vehicle that receive a signal from a remote device, and because one of ordinary skill in the art would recognize that it would be advantageous to use a device associated with a web site to send a shutdown signal to the vehicle. Pet. 16–17 (citing Ex. 1003 ¶ 49). Petitioner also contends that one of ordinary skill in the art would have combined Spaur and Frossard because it would achieve the

predictable result of using a processing device associated with a web site for the controlled shutdown of a vehicle. *Id.*

Patent Owner contends that Frossard fails to teach the “third processing device” of claim 21 because Frossard’s “receiver/decoder circuits 4” is actually an “interface” device, and not a “processing” device. PO. Resp. 18. Patent Owner argues that Frossard’s receiver-decoder circuits 4 only receives a signal and decodes that signal, therefore rendering it only an “interface” device and not a “processing” device. *Id.* We are not persuaded by this argument. Claim 21 requires that the third processing device generates or transmits a third signal. Ex. 1001 (a “third processing device” that “*at least one of generates a third signal and transmits a third signal . . .*”) (emphasis added). Petitioner points to the receiver-decoder circuits of Frossard, which send a third signal (i.e., a “controlled inhibition means . . . commanded by the receiver-decoder means . . . to ensure that the equipment is switched to shutdown . . .”) Pet. 22 (citing Ex. 1005, p. 3). Further, Frossard’s receiver-decoder circuit “addresses the corresponding commands to equipment 3 itself, causing immediate or deferred shutdown . . .” *Id.* (citing Ex. 1005, p. 9). Thus, we are not persuaded by Patent Owner’s argument that Frossard’s receiver-decoder circuits 4 merely receives and decodes a signal, without any transmission of a signal.

Patent Owner further argues that Spaur fails to teach the “first processing device” that is “located at a location remote from the vehicle” and that is “associated with a web site” as recited in claim 21. PO. Resp. 19–21. Patent Owner argues the only device in Spaur that could be associated with a web site is controller 30, which is located at the vehicle. *Id.* We disagree. Petitioner points to the computer terminal at the “remote

site” (not the vehicle) that has a “world wide web browser.” Pet. 14, 15 (citing Ex. 1016, 1:7–8, 5:40–6:22, Fig. 1, 2:25–34, Ex. 1003, 46). Thus, we agree with Petitioner’s assertions that Spaur teaches a computer terminal at a remote site (remote from the vehicle) that includes a web browser, thereby teaching the claim limitation. *Id.* at 15. We agree with Petitioner that one of ordinary skill in the art would understand that Spaur discloses using a web site at the remote site. *Id.* (citing Ex. 1003, 46).

Patent Owner’s argument turns on a reading of “associated with a web site” as requiring the first processing device to include a web server, located at the first processing device, which hosts the web site at that location. *See* PO Resp. 18–20. We decline to import these limitations into the language of claim 21, which does not recite anything about the location, or host, of “the web site.” Moreover, as Petitioners point out (Pet. Reply 14–16), the specification of the ’363 patent describes an embodiment where the association between the first processing device and the web site includes hosting the web site at another device and accessing the web site from that other device. *See* Ex. 1001, Figs. 11A, 11B, 57:20–67. Thus, Patent Owner’s argument is not supported by the language of claim 21 nor the specification of the ’363 patent.

As to dependent claims 24, 25, and 36, Patent Owner stands by its arguments with respect to claim 21. PO Resp. 27. We disagree with those arguments for the reasons described above. We have reviewed Petitioner’s arguments and supporting evidence with respect to each of claims 21, 24, 25, and 36 of the ’363 patent, as set forth in the Petition. Pet. 13–26. We agree with and adopt Petitioner’s contentions regarding the teachings in Frossard and Spaur of each of these limitations and Petitioner’s articulated reasoning

with rational underpinning for combining the references. *Id.* Based on these contentions, we conclude that Petitioner has shown by a preponderance of the evidence that the subject matter of claims 21, 24, 25, and 36 would have been obvious in view of the combination of Frossard and Spaur.

D. Asserted Ground Based on Frossard, Spaur, and Pagliaroli

1. Pagliaroli (Ex. 1006)

Pagliaroli teaches enabling or disabling remotely an automobile. Ex. 1006, Abs. When an automobile owner realizes their vehicle is stolen, the owner dials a telephone number to disable the automobile. *Id.* Figure 1 is reproduced below.

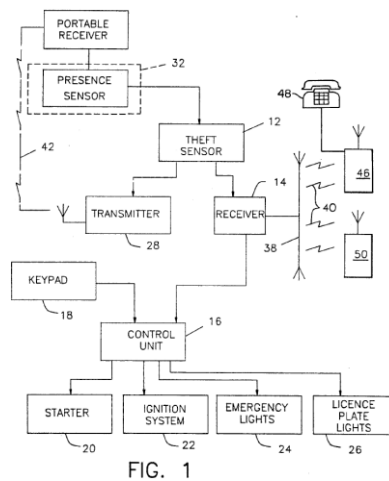


Figure 1 illustrates a user connecting to receiver 14 when dialing from telephone 48. *Id.* at 4:53–5:1. In addition, Figure 1 shows telephone 48 connects to receiver 14 via transmitter 46. *Id.* Receiver 14 receives signal code 40 and forwards code 40 to control unit 16. *Id.* at 5:30–33. When a disabling signal is sent, control unit 16 disables starter 20 and ignition system 22 stops the operation of the automobile and sends a signal activating emergency lights 24 of the automobile. *Id.* at 5:44–55. License plate lights

26 may change colors or flash to identify to police that the automobile is stolen. *Id.* at 5:55–58.

2. *Analysis of Obviousness Challenge of Claim 22*

Petitioner contends claim 22 is unpatentable under 35 U.S.C. § 103(a) as obvious in view of Frossard, Spaur, and Pagliaroli. Pet. 26–30. Relying on the testimony of Mr. McNamara, Petitioner explains how Frossard, Spaur, and Pagliaroli allegedly teach the claim limitations of claim 22, and argues a person of ordinary skill in the art would have combined Frossard, Spaur, and Pagliaroli. *Id.* (citing Ex. 1003). Specifically, Petitioner contends that Frossard and Spaur teach the elements recited in claim 21 and Pagliaroli teaches the additional limitation recited in claim 22 relating to the controlling, monitoring, and determining an operating status of a vehicle system. Pet. 26–30. In particular, Petitioner argues at least Pagliaroli’s disclosure of monitoring the condition of an automobile and if theft sensor 12 on the automobile is activated, transmitter 28 transmits signal 42 that can notify a person of the theft, meets the additional limitation recited in claim 22. *Id.* at 27 (citing Ex. 1006, 4:22–24; 4:42–45; 5:44–57).

As to claim 22, Patent Owner stands by its arguments with respect to claim 21. PO Resp. 27. Upon consideration of the full record, we are persuaded by Petitioner’s contentions. We agree with and adopt Petitioner’s contentions regarding the references teachings of the limitations of dependent claim 22. Petitioner has shown by a preponderance of the evidence that the combination of Frossard, Spaur, and Pagliaroli teaches the limitations recited in dependent claim 22, and Petitioner has articulated sufficient reasoning with rational underpinning for combining the references.

E. Asserted Ground Based on Frossard, Spaur, and Simms

1. Simms (Ex. 1007)

Simms teaches a security system utilizing Global Position Satellite (“GPS”). Ex. 1007, Abs. The security system comprises a mobile unit. *Id.* The mobile unit communicates emergency data including position coordinates to a central dispatch station that receives the emergency data and displays emergency information on a digitized map at a position corresponding to the location of the mobile unit. *Id.* Central dispatch station 40 is a database that processes the code to display the position of the mobile entity on the digitized map. *Id.* at 5:49–51, 5:62–68, 12:37–41, 12:51–13:9.

2. Analysis of Obviousness Challenge of Claim 29

Petitioner contends claim 29 is unpatentable under 35 U.S.C. § 103(a) as obvious in view of Frossard, Spaur, and Simms. Pet. 30–34. Relying on the testimony of Mr. McNamara, Petitioner explains how Frossard, Spaur, and Simms allegedly teach the claim limitations of claim 29, and argues a person of ordinary skill in the art would have combined Frossard, Spaur, and Simms. *Id.* (citing Ex. 1003). Specifically, Petitioner contends that Frossard and Spaur teach the elements recited in claim 21 and Simms teaches the additional limitation recited in claim 29 relating to the positioning device for determining the location of the vehicle that is located at the vehicle. *Id.*

In particular, Petitioner argues at least Simms’s disclosure of a positioning device for determining the location of the vehicle that is located at the vehicle meets the additional limitation in claim 29. *Id.* at 31. Petitioner concludes that one of ordinary skill in the art would have been motivated to combine Frossard’s system for protecting motor vehicles using

a shutdown mechanism and Simms's mobile unit using GPS communicating position coordinates to a database station that displays the position on a digitized map, because Simms's mobile unit would provide more accurate location information on a digital map. Pet. 30–32. Petitioner argues that such a combination is nothing more than the use of a known technique to improve similar devices and methods in the same way. *Id.* at 32–34.

Patent Owner does not dispute that the references teach the limitations of claim 29, but argues that a “complete redesign” of Frossard would be required to combine Frossard with Simms. PO Resp. 28–30. Patent Owner also generally argues that components of Spaur would also require redesign to combine with Simms. *Id.* at 30. According to Patent Owner, Mr. McNamara acknowledged this during his cross-examination. *Id.* (citing Ex. 2007, 324:7–22; 329:7–12).

Petitioner responds that Patent Owner's arguments are not supported by any evidence or by the language of claim 29. Pet. Reply 20–21. Petitioner argues Patent Owner's reliance on page 324, lines 7–22 and page 329, lines 7–12 of the cross-examination do not support Patent Owner's argument. *Id.* (citing Ex. 2007). Petitioner argues that instead, the statements from the cross-examination actually explain a simple implementation for combining Frossard's system and Simms's positioning device. *Id.* Petitioner argues Mr. McNamara further explains other implementations at page 335, line 13 through page 336, line 6 of the cross-examination. *Id.* (citing Ex. 2007).

We agree with Petitioner. Patent Owner does not explain why combining Frossard, Simms, and Spaur is improper other than general attorney argument that a “substantial” redesign would be required. PO Resp.

28–30. Patent Owner’s arguments are conclusory and unsupported by the record. Patent Owner’s reliance on page 324, lines 5–25 and page 329, lines 7–14 of the cross-examination do not support Patent Owner’s argument. Ex. 2007, 324:5–25, 329:7–14. We agree with Petitioner that the statements from the cross-examination explain a simple implementation for combining Frossard’s system and Simms’s positioning device. *Id.* Mr. McNamara further explains other implementations at page 335, line 13 through page 336, line 6 of the cross-examination. *Id.* at 335:13–336:6. Mr. McNamara articulates sufficient reasoning with rational underpinning for combining the references. Ex. 1003 ¶¶ 77–82. We find Mr. McNamara’s testimony to be reasonable and persuasive. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 401 (2007).

With respect to Spaur, Patent Owner does not explain why combining Frossard, Simms, and Spaur is improper other than one sentence of attorney argument that a “drastic” redesign would be required, without further explanation or evidence regarding to what the alleged redesign would involve or its significance. *See* PO Resp. at 30.

Upon review of the full record, we agree with Petitioner’s contention that Simms’s mobile unit 32 using GPS that communicates position coordinates to a central dispatch database station 40 that receives and displays the information on a digitized map at a position corresponding to the location of the mobile unit, teaches or suggest the limitations of dependent claim 29. Pet. 31–34 (citing Ex. 1007) (pinpoint citations omitted). We agree with and adopt Petitioner’s contentions with respect to dependent claim 29. *Id.* Based on Petitioner’s contentions, we conclude that Petitioner has shown by a preponderance of the evidence that the

combination of Frossard, Spaur, and Simms teaches the limitations recited in dependent claim 29, and we determine that Petitioner has articulated sufficient reasoning with rational underpinning for combining the references.

F. Asserted Ground Based on Johnson and Rossmann

We have reviewed the arguments and evidence presented in the Petition regarding how the instituted claims are unpatentable under 35 U.S.C. § 103(a) as obvious in view of Johnson and Rossmann. Pet. 34–60. Relying on the testimony of Mr. McNamara, Petitioner explains how Johnson and Rossmann allegedly teach the claim limitations of the instituted claims, and explains why a person of ordinary skill in the art would have combined Johnson and Rossmann. *Id.* at 34–37 (citing Ex. 1003).

Patent Owner argues that Johnson fails to teach the “first processing device” and “second processing device” of claim 21. PO Resp. 31. In particular, Patent Owner argues that Johnson does not teach a first processing device associated with a web site or a second signal to the first processing device via the Internet. *Id.* Patent Owner argues that Johnson “teaches away from a system which uses the Internet.” PO Resp. 34 (emphasis in original). Patent Owner argues the operator console and computer system of Johnson are located at the same location, i.e., the central monitoring station 103, and therefore, there is no need to connect them via the Internet or to combine Johnson’s system with Rossmann. PO Resp. 33–34.

We are not persuaded by these arguments. A reference teaches away from a claimed invention if it criticizes, discredits, or otherwise discourages modifying the reference to arrive at the claimed invention. *In re Fulton*, 391

F.3d 1195, 1201 (Fed. Cir. 2004). We will not, however, “read into a reference a teaching away from a process where no such language exists.” *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1364 (Fed. Cir. 2006).

Patent Owner’s teaching away argument is predicated on the notion that Johnson’s operator console and computer system being at central monitoring station 103 criticizes, discredits, or otherwise discourages modifying Johnson to utilize the Internet to send signals. See PO Resp. 32–35. We are not persuaded that Johnson teaches away from this solution and, as a result, teaches away from the claimed invention.

We agree with Petitioner that the server (computer system) in Johnson has a modem and that because of the modem, it would have been obvious to a person of ordinary skill in the art to set the server to (1) host a web site and provide access thereto to the client or (2) have remote access to a web site. Pet. 40–41. The Petition also explains that using the connection between the client and the server, the client sends a signal to the server, and Mr. McNamara testifies that it is well within the knowledge of a person of ordinary skill in the art at the time of the invention to use the Internet or the World Wide Web to transmit the signal in a client-server architecture. Pet. 50–51; Ex. 1003 ¶ 115.

The Petition relies on Rossmann to cure any deficiency of Johnson regarding the two features of (1) the association of the first processing device with a web site, and (2) the connection between the first processing device and the second processing device via the Internet or the World Wide Web. Pet. at 40–42, 50–52. Patent Owner does not dispute the disclosures of Rossmann, but Patent Owner argues that Petitioner’s analysis as to how

Rossmann remedies the deficiencies in Johnson lacks an articulated reasoning with some rational underpinning because Johnson is a “closed network” and Rossmann does not pertain to a security sensitive system. PO. Resp. 37. Patent Owner argues that Petitioner has not articulated why one of skill in the art would look to Rossmann to address an alleged problem that does not exist in Johnson, and that there is no need in Johnson to use the Internet to establish a network connection between the computer system 601 and the operator console 605. *Id.* at 38.

We are not persuaded by Patent Owner’s arguments. A person of ordinary skill is a person of ordinary creativity, not an automaton. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007). We disagree that a person of ordinary skill would disregard Johnson simply because it discloses using a computer system 601 and operator console 605 in a client-server architecture at a central location. *See* Ex. 1008, 11:18–32. Moreover, “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 550 U.S. at 416. “If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 417. The Petition, supported by Mr. McNamara’s testimony, articulates sufficient reasoning with rational underpinning for combining Johnson and Rossmann. Pet. 34–37, 41–42, 48–50. We find Mr. McNamara’s testimony to be reasonable and persuasive.

In particular, Petitioner contends that Johnson describes a system that uses a client-server architecture for a monitoring station, and the monitoring station issues signal commands to a vehicle to affect various functions to immobilize the vehicle. *Id.* at 35 (citing Ex. 1008, 11:18–32; Ex. 1003, 85).

Petitioner contends that Rossmann describes a cellular telephone as a client in a client-server architecture and an Internet-based server. *Id.* (citing Ex. 1009). Petitioner contends that one of ordinary skill in the art would have combined Rossmann (e.g., combining a computer module with a wireless communication module) with Johnson because it would achieve the predictable result of using the client-server architecture of Rossmann in the client-server architecture of Johnson. *Id.* at 35, 36 (citing Ex. 1003, 86).

Based on our review of the full record, we find persuasive Petitioner's arguments and evidence and we adopt them as the basis for our determination regarding the unpatentability of the instituted claims over the teachings of Johnson and Rossmann. Pet. 34–60. Based on these contentions, we determine that Petitioner has demonstrated by a preponderance of the evidence the unpatentability of the instituted claims over the teachings of Johnson and Rossmann.

III. CONCLUSION

Based on the evidence and arguments, Petitioner has demonstrated by a preponderance of the evidence that: (1) claims 21, 24, 25, and 36 are unpatentable under 35 U.S.C. § 103(a) as obvious over Frossard and Spaur; (2) claim 22 is unpatentable under 35 U.S.C. § 103(a) as obvious over Frossard, Spaur, and Pagliaroli; (3) claim 29 is unpatentable under 35 U.S.C. § 103(a) as obvious over Frossard, Spaur, and Simms; and (4) claims 21, 22, 24, 25, 29, and 36 are unpatentable under 35 U.S.C. § 103(a) as obvious over Rossmann and Johnson.

IV. ORDER

Accordingly, it is

ORDERED that claims 21, 22, 24, 25, 29, and 36 of the '363 patent have been shown to be unpatentable; and

FURTHER ORDERED that, because this is a final written decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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