

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DUNCAN PARKING TECHNOLOGIES, INC.,
Petitioner,

v.

IPS GROUP INC.,
Patent Owner,

Case IPR2016-00068
Patent 7,854,310 B2

Before JOSIAH C. COCKS, MICHAEL W. KIM, and RICHARD E. RICE,
Administrative Patent Judges.

COCKS, *Administrative Patent Judge.*

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

I. INTRODUCTION

A. Background

Duncan Parking Technologies, Inc. (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 1–11 of U.S. Patent No. 7,854,310 B2 (Ex. 1001, “the ’310 patent”). Paper 1 (“Pet.”). IPS Group Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6; “Prelim. Resp.”).

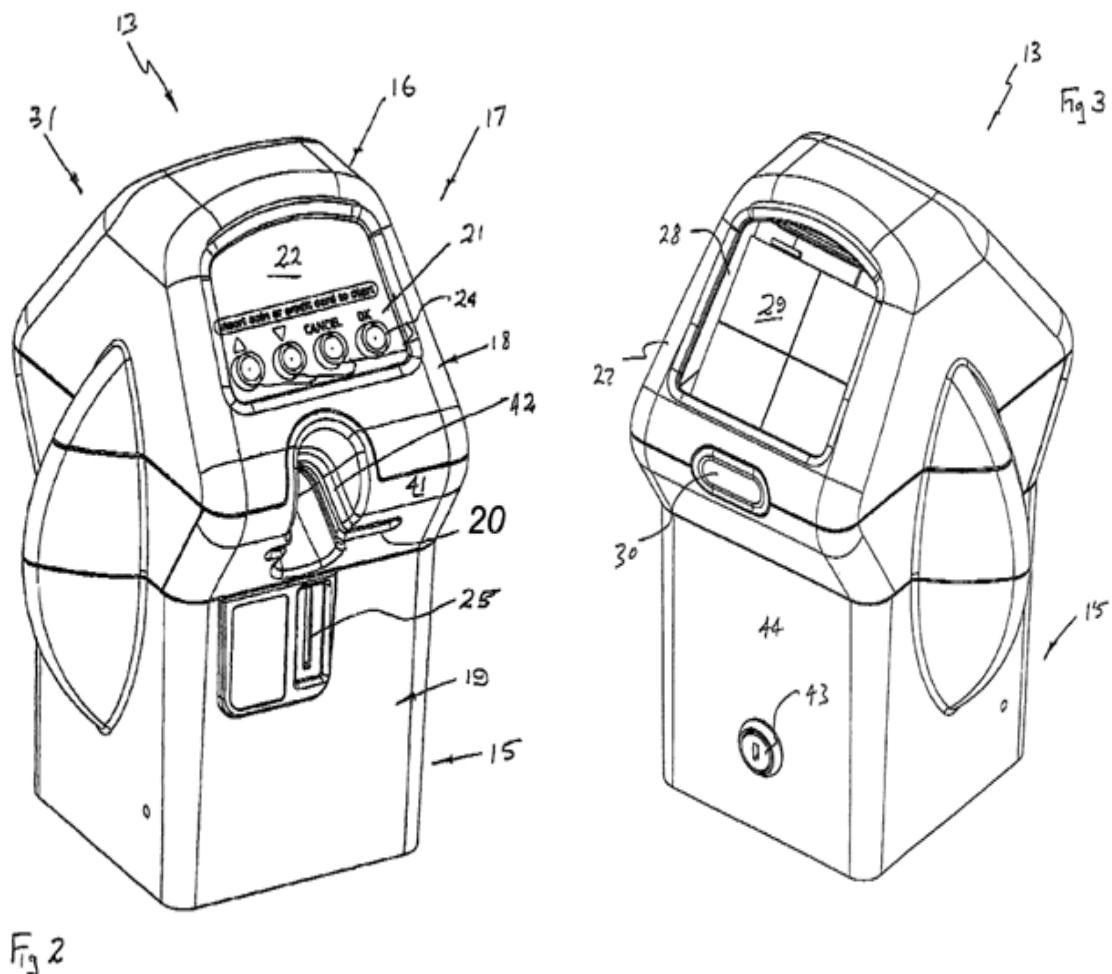
We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless the information presented in the Petition shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Upon consideration of the Petition and Preliminary Response, we are unpersuaded that Petitioner has met its burden of showing a reasonable likelihood that claims 1–11 are unpatentable.

B. Related Matters

Petitioner and Patent Owner identify the following district court proceedings concerning the ’310 patent: *IPS Group, Inc. v. Duncan Solutions, Inc.*, 3-15-cv-01526 BTM MDD (S.D. Cal.). Pet. 2; Paper 4, 2. The ’310 patent is also the subject of another *inter partes* review proceeding (IPR2016-00067) involving the same Petitioner.

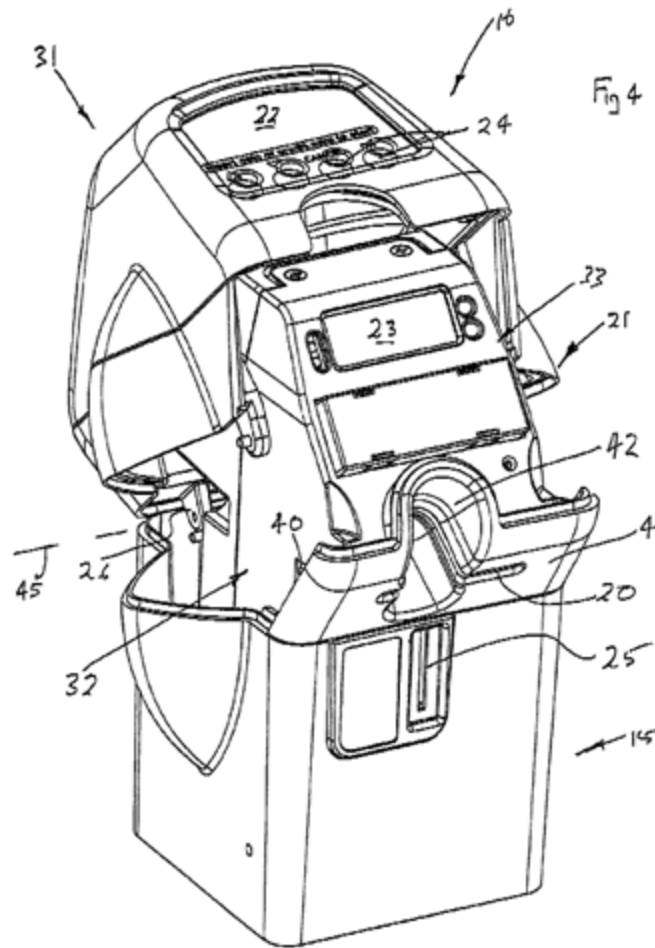
C. The ’310 Patent

The ’310 patent is titled “Parking Meter and a Device Therefor.” Ex. 1001, Title. Figures 2 and 3 of the ’310 patent are reproduced below:



Figures 2 and 3 above depict, respectively, a front view and a rear view of a parking meter assembly according to the '310 patent. *Id.* at 2:11–14. As shown in the figures, parking meter 13 includes cover panel 16 and panel set 15. *Id.* at 2:30–33. As shown, specifically, in Figure 2, the cover panel and panel set present front face 17 having control panel 21, window 22, buttons 24, coin slot 25, and card slot 20. *Id.* at 2:33–38. As shown in Figure 2, the rear of parking meter 13 includes rear face 27 with window aperture 22 allowing for transmission of light to solar panel 29. *Id.* at 2:51–54. At or adjacent rear face 27 is indicator 30 that relays whether a parking period has expired. *Id.* at 2:57–60.

Figure 4 of the '310 patent is reproduced below:



As shown in Figure 4 above, cover panel 16 is attached pivotally to panel set 15 (*id.* at 2:44–49), and together provide housing 31 in which module 32 is located (*id.* at 2:66–67). Module 32 includes electronic device 33, which incorporates screen 32, coin sensor 34 (not shown), and coin validator 35 (not shown). *Id.* at 2:67–3:3.

Claims 1 and 9 are independent. Claim 1 is illustrative of the subject matter at issue, and is reproduced below:

1. A parking meter including:
 - a coin sensor;
 - a card reader;

an electronic device electrically connected to the sensor and reader so as to receive information electronically therefrom, the electronic device having a screen to provide information visually, a telephone connection to provide receiving information in respect of a card used in respect of said card reader, and connections for at least one rechargeable battery to power the reader, sensor and device;

a solar cell operatively associated with said connections to charge said battery;

a housing in which the coin sensor, card reader, and electronic device are located, the housing comprising an intermediate panel set and a cover panel, wherein the cover panel is movably attached to the intermediate panel set, and a surface of the cover panel and a surface of the intermediate panel set comprise a front face, and the front face surface of the cover panel includes a control panel having a window and a plurality of buttons that operate the parking meter upon manipulation by a user;

a coin slot in the front face into which coins are inserted for delivery to the sensor and then to a coin receptacle;

a card slot in the front face into which a card is inserted to be read by said reader;

a rear face comprising a surface of the cover panel and a surface of the intermediate panel set providing a window aperture via which said solar cell is exposed to light;

wherein the coin sensor and the card reader are electrically linked to provide information to the electronic device to provide information of whether payment has been made;

wherein the screen of the electronic device is visible through the window of the control panel when the cover panel is attached to the intermediate panel.

D. Asserted Grounds of Unpatentability

Petitioner contends that claims 1–11 of the '310 patent are unpatentable under 35 U.S.C. on the following grounds:

Reference(s)	Basis	Challenged Claims
Jacobs ¹ in view of Williams ²	§ 103	1–11
Ward ³ in view of Williams	§ 103	1–11

II. ANALYSIS

A. Unpatentability based on Jacobs and Williams

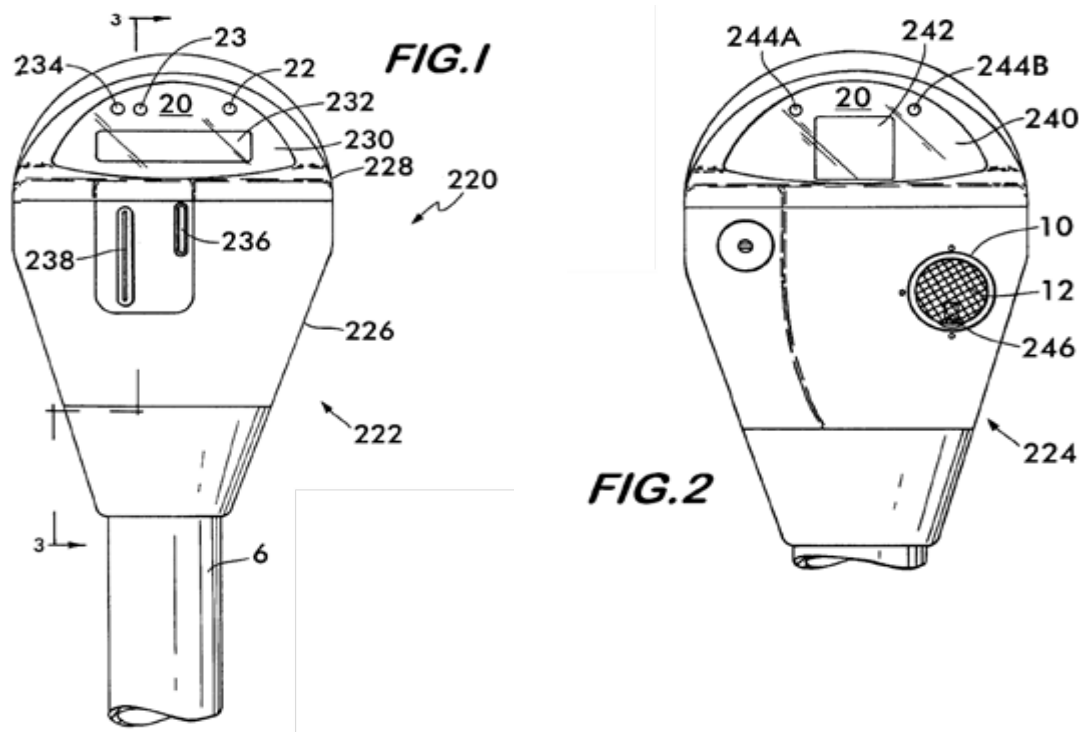
1. Overview of Jacobs

Jacobs is titled “Electronic Parking Meter.” Ex. 1006, Title. Jacobs’s Figures 1 and 2 are reproduced below:

¹ U.S. Patent No. 6,195,015 B1, issued February 27, 2001 (Ex. 1006).

² U.S. Patent No. 6,081,205, issued June 27, 2000 (Ex. 1008).

³ U.S. Patent No. 5,617,942, issued April 8, 1997 (Ex. 1007).



Figures 1 and 2 above show an embodiment of Jacobs’s electronic parking meter. Ex. 1006, 3:60–64. Figure 1 is characterized as a “sidewalk-side” view, and Figure 2 as a “street-side” view. *Id.* On the sidewalk-side view, electronic parking meter 220 includes first window 230 with display 232, payment card insertion hole 238, and coins insertion hole 236. On the street-side view, the parking meter includes second window 240 with electronic LCD display 242, “which flashes whenever the meter 220 is in an EXPIRED state.” *Id.* at 5:21–24.

2. Overview of Williams

Williams is titled “Electronic Parking Meter and Electric Automobile Recharging Station.” Ex. 1008, Title. Williams’s Figure 1 is reproduced below:

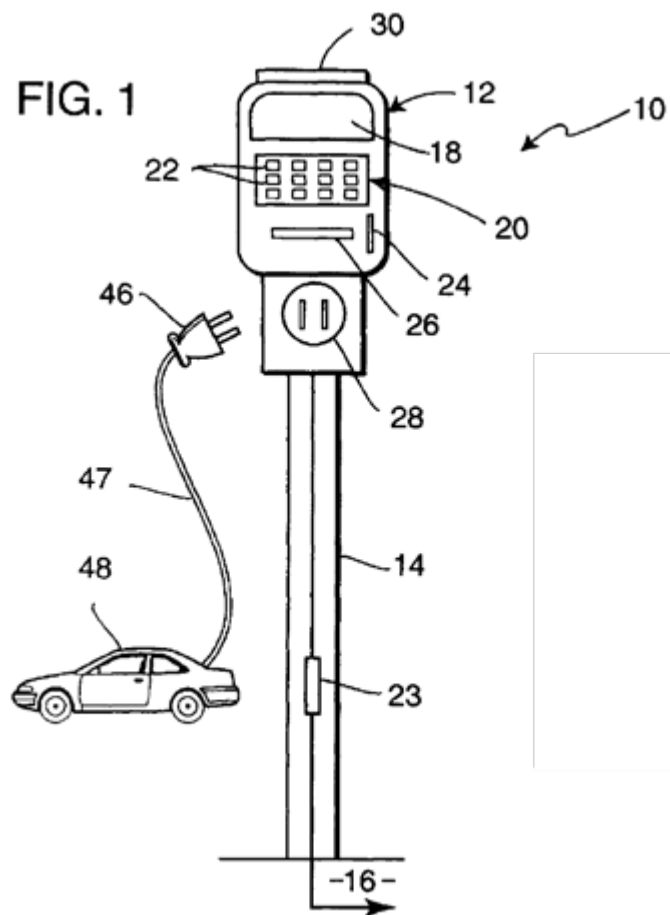


Figure 1 above depicts a parking meter according to Williams’s invention. Ex. 1008, 2:61–62. Parking meter 10 includes housing 12, display 18, keypad 20, money receptor slot 24, and credit card receptor slot 26. *Id.* at 2:16–36. Parking meter 10 also includes solar cell panel 30, shown mounted to the top of housing 12. *Id.* at 2:41–47.

3. Discussion — Jacobs and Williams

Petitioner proposes that the combination of Jacobs and Williams renders obvious each of claims 1–11 of the ’310 patent. Each of independent claims 1 and 9 requires a parking meter that includes a housing with a “cover panel” that is “movably attached” to an “intermediate panel set.” Each of claims 1 and 9 also requires a “solar cell.” With respect to the configuration of the solar cell, claim 1

requires the following: “a rear face comprising a surface of the cover panel and a surface of the intermediate panel set providing a window aperture via which said solar cell is exposed to light.” Claim 9 includes a similar requirement. The claims, thus, require that a solar cell be positioned on the rear surface of a cover panel so as to receive light through a second window on that rear surface.

Jacobs does not disclose a solar cell as a component of any embodiment of its parking meter. Indeed, we observe that although Jacobs generally recognizes that solar panels have been employed in the context of parking meters, Jacobs does not describe the use of solar cells in favorable terms. *See* Ex. 1006, 1:45–61. In that respect, Jacobs discounts the use of solar power source for parking meters as exhibiting “various problems” arising from the potential for inadequate power generation. *Id.* at 1:55–61. That Jacobs disparages solar power sources in connection with parking meters does not lend itself readily to the conclusion offered by Petitioner that there is “ample motivation” from Jacobs’s disclosure to incorporate a solar cell in a parking meter in the configuration required by the claims. *See* Pet. 18–19.

Petitioner also bases its theory of obviousness on the teachings of Williams. Yet, as is evident from Williams’s Figure 1, solar cell 30 is positioned on the top of its parking meter, rather than in a configuration in a second window aperture on the rear surface of a cover panel. We agree with Patent Owner (*see* Prelim. Resp. 22) that the logical inference from Williams’s teachings would be to locate a solar cell in a position different from that required by the claims of the ’310 patent.

Furthermore, we observe that although Petitioner postulates that configuring a solar cell in the required manner is “logical design choice,” that postulation rests simply on statements of Mr. Magness to that effect. *See* Ex. 1003 ¶ 95. In our view, neither the Petition nor Mr. Magness adequately explains why reconfiguring

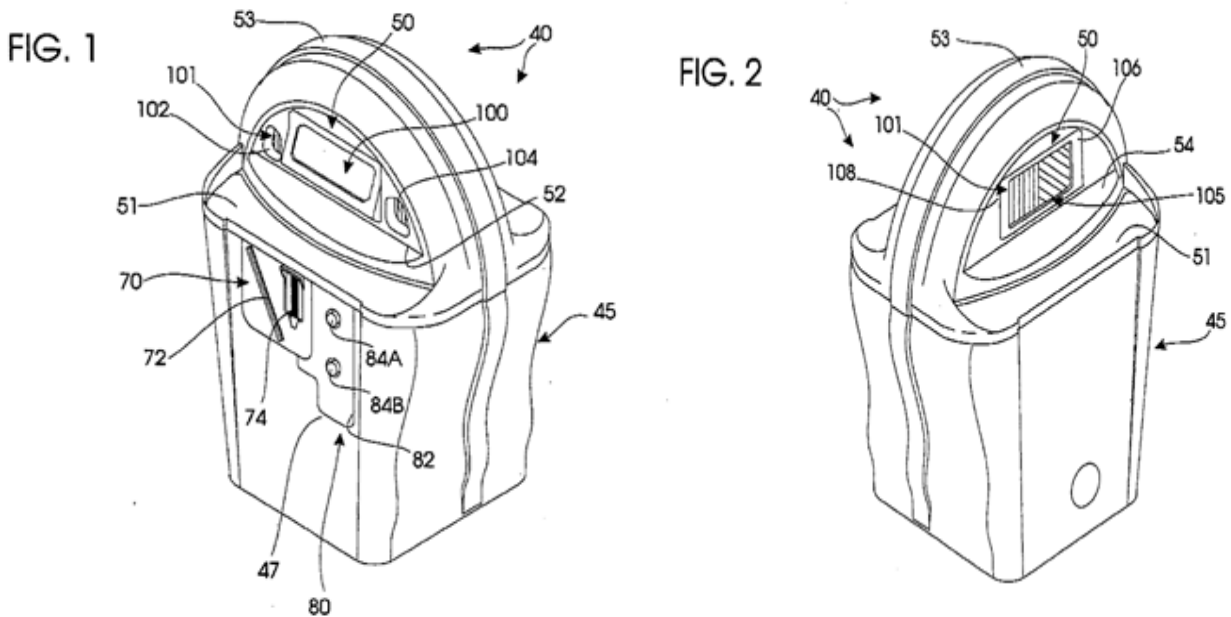
discrete disclosures of Jacobs and Williams in a manner not suggested by record evidence, beyond a general assertion of Mr. Magness, is characterized properly as merely a “logical design choice.” There is no requirement that we must credit the inadequately explained testimony of a declarant. *See Rohm and Haas Co. v. Brotech Corp.*, 127 F.3d 1089, 1092 (Fed. Cir. 1997). Specifically, as noted by Petitioner (Pet. 19), Jacobs does have a window aperture (Ex. 1006, element 240) on a rear portion of a parking meter. That window, however, serves a particular purpose in receiving electronic LCD display 242, which indicates if the parking meter is in an expired state. *Id.* at 5:21–24. Neither Petitioner nor Mr. Magness articulates, as a part of their obviousness theory, what becomes of display 242 were solar panels to be located where that display resides. That Petitioner leaves such inquiry up to the speculation of the panel, does not bode well for a conclusion that Petitioner will be successful in showing obviousness.

We have considered the Petition, but, on the record before us, we are not persuaded that Petitioner has shown a reasonable likelihood of success in showing that claims 1–11 would have been obvious in view of the teachings of Jacobs and Williams.

B. Unpatentability based on Ward and Williams

1. Overview of Ward

Ward is titled “Low-Power Multi-Bay Parking Meter.” Ex. 1007, Title. Ward’s Figures 1 and 2 are reproduced below:



Figures 1 and 2 above show an embodiment of a parking meter according to Ward's invention. Ex. 1007, 5:22–26. Figure 1 depicts a front view, and Figure 2 depicts a rear view. Parking meter 40 includes exterior metallic casing 45 with top 50 and base portion 51. *Id.* at 6:58–65. As seen in Figure 1, the front of the parking meter includes debit card slot 72, coin slot 74, and digital indicator 100 for displaying remaining time of the meter. *Id.* at 7:23–29, 8:13–15. As seen in Figure 2, the rear of the parking meter includes rear window 105 for displaying “a selected portion of multi-colored flag wheel 101” for indicating the status of the meter. *Id.* at 8:16–25.

2. Discussion — Ward and Williams

Ward's disclosure of parking meters is similar to that of Jacobs. Like Jacobs, Ward does not disclose the use of solar power. To account for that requirement, Petitioner relies on the same positions that were advocated in connection with the Jacob's ground. In particular, according to Petitioner, “Ward's cover could be pivotally attached and solar power included for the same reasons given” for the ground based on Jacobs. Pet. 40.

Petitioner fares no better in its case for the obviousness of claims 1–11 based on Ward and Williams than it did for its ground based on Jacobs and Williams. Indeed, Petitioner does not explain adequately why the required positioning of a solar cell would somehow emerge from the teachings of Ward and Williams. As before, Petitioner is content to rely on the statements of Mr. Magness without recourse to underlying teachings in the prior art that would justify a modification of Ward in the manner contemplated by Petitioner.

Specifically, like Jacobs, Ward does disclose a window aperture on a rear side of its parking meter. Also like Jacobs, however, Ward’s window aperture contains a functional component, namely, “multi-colored flag wheel 101” which displays the status of the parking meter (e.g., expired or malfunctioning). *See* Ex. 1007, 8:16–36. We share Patent Owner’s view that Petitioner “does not address how to modify Ward to both include a solar panel in Ward while retaining all functionality,” i.e., the functionality of the multicolored flag wheel. *See* Prelim. Resp. 31.

We have considered the Petition, but, on the record before us, we are not persuaded that Petitioner has shown a reasonable likelihood of success in showing that claims 1–11 would have been obvious in view of the teachings of Ward and Williams.

III. CONCLUSION

For the foregoing reasons, we are unpersuaded that Petitioner has met its burden of showing a reasonable likelihood that claims 1–11 are unpatentable.

IV. ORDER

It is ORDERED that the Petition is *denied*, and no trial is instituted.

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