

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 IPR2016-00070
Patent 8,595,054

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

KIM, *Administrative Patent Judge.*

DECISION
Decision Denying *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 1–16 of U.S. Patent No. 8,595,054 (Ex. 1001, “the ’054 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 it would prevail in proving that claims 1–16 are unpatentable.

B. *Related Proceedings*

Petitioner and Patent Owner identify the following district court proceedings concerning the ’054 patent: *IPS Group, Inc. v. Duncan Solutions, Inc.*, 3-15-cv-01526 BTM MDD (S.D. Cal.). Pet. 1; Paper 4, 2. Petitioner identifies further the following related patent applications that claim priority to the application that issued as the ’054 patent: 12/355,754; 14/297,525. Pet. 2. Petitioner identifies additionally the following *inter partes* review also directed to the ’054 patent: IPR2016-00069. Pet. 1.

C. *The ’054 Patent*

The ’054 patent discloses that it is directed to upgrading single-bay parking meters. Ex. 1001, 1:4–5. Figure 7 (below) depicts parking meter device 10, as well as housing 34 and cover 36. Ex. 1001, 4:13–14, 3:61–4:5.

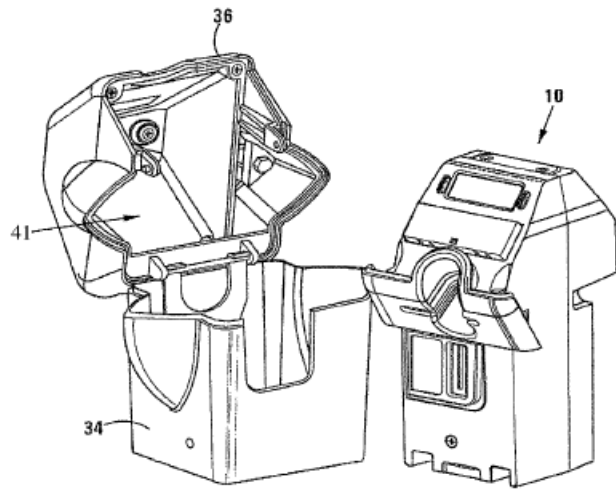


FIG 7

As shown in Figure 7 above, parking meter device 10 is configured to reside in housing 34 and be covered by cover 36. Ex. 1001, 4:13–14, 3:61–4:5.

Figures 1 and 2 (below) illustrate parking meter device 10 including lower portion 12 and upper portion 14. Ex. 1001, 3:28–33.

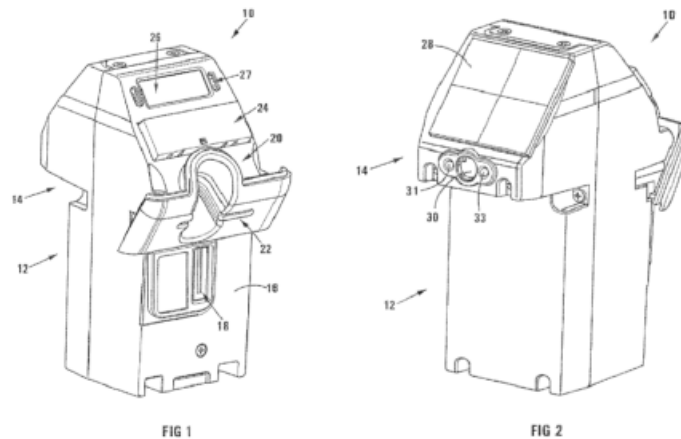


FIG 1

FIG 2

As shown in the figures above, lower portion 12 “has the same shape and dimensions as the housing base of conventional known single bay parking meter devices.” Ex. 1001, 3:33–35. Lower portion 12 includes a coin accepting and validating assembly 16 with coin slot 18. Ex. 1001,

3:44–45. Upper portion 14 includes card reading device 20 with access opening 22 into which a credit or debit card may be inserted and read by reading device 20. Ex. 1001, 3:46–49. Upper portion 14 also includes keypad sensor 24 and display 26. Ex. 1001, 3:49–50.

D. Illustrative Claim

Petitioner challenges claims 1–16 of the '054 patent. Independent claim 1 is the sole independent claim, and is reproduced below:

1. A parking meter device that is receivable within a housing base of a single space parking meter, the parking meter device including:

a timer;

a payment facilitating arrangement operable in cooperation with a non-cash payment medium for effecting payment of a monetary amount for a parking period;

a display configured to visually provide a balance remaining of the parking period;

a power management facility that supplies power to the timer, payment facilitating arrangement, and display;

a wireless communications subsystem configured to receive information relating to the non-cash payment medium in respect of the payment facilitating arrangement;

a keypad sensor that receives input comprising manipulation by the user;

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

a lower portion and an upper portion;

wherein the keypad sensor operates the parking meter and determines parking time amount for purchase in accordance with the received input from the user;

wherein the display provides the amount of time purchased in response to the received input from the user;

wherein the upper portion of the parking meter device includes a solar panel that charges the power management facility;

wherein the lower portion of the parking meter device is configured to have a shape and dimensions such that the lower portion is receivable within the housing base of the single space parking meter; and

wherein the upper portion of the parking meter device is covered by a cover that is configured to accommodate the upper portion and that is engageable with the housing base of the single space parking meter such that the payment facilitating arrangement is accessible by the user for user manipulation effecting the payment of the monetary amount for the parking period when the lower portion of the parking meter device is received within the housing base and the upper portion is covered by the cover.

E. Asserted Grounds of Unpatentability

Petitioner challenges claims 1–16 on the following grounds.

Reference(s)	Basis	Challenged Claims
Tung ¹	§ 102(b)	1–8 and 10–14
Fulcher ² and Jacobs ³	§ 103(a)	1–16

¹ Yaotsung Tung, “Design of an Advanced On-street Parking Meter,” Master’s Thesis (2001).

² U.S. Patent No. 6,505,774 B1, issued January 14, 2003 (Ex. 1033).

³ U.S. Patent No. 6,195,015 B1, issued February 27, 2001 (Ex. 1006).

II. ANALYSIS

A. Claims 1–16 as Unpatentable over Fulcher in view of Jacobs

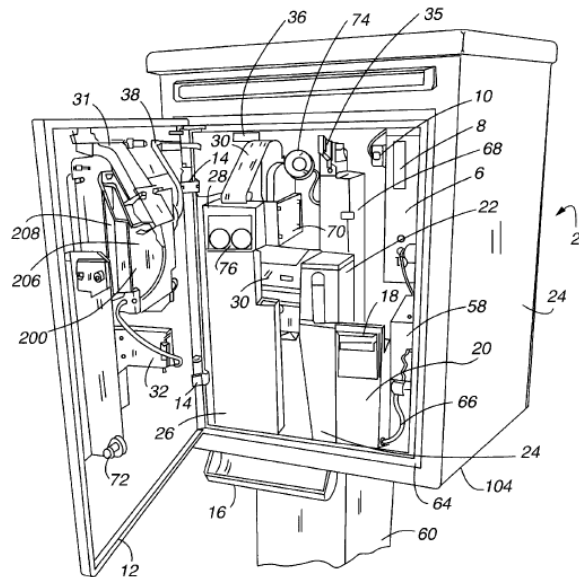
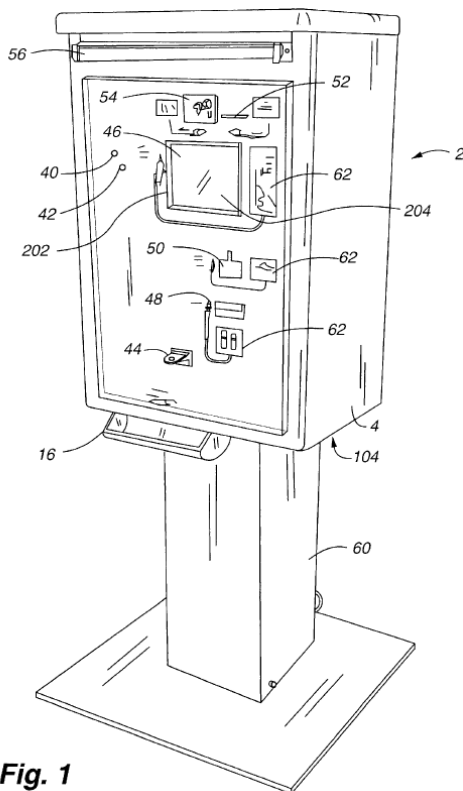
Petitioner asserts that a combination of Fulcher and Jacobs renders obvious claims 1–16. Pet. 27–45 (citing Exs. 1003, 1006, 1033). Patent Owner disagrees. Prelim. Resp. 19–32 (citing Exs. 1001–1003, 1006, 1033). In particular, Patent Owner asserts that Petitioner has not shown sufficiently that a combination of Fulcher and Jacobs discloses or suggests “a lower portion and an upper portion,” as recited in independent claim 1. Prelim. Resp. 20–23. We agree.

As an initial matter, we agree with Patent Owner that it is unclear what portions of Fulcher or Jacobs that Petitioner is relying on as corresponding to the recited “a lower portion and an upper portion.” We have read through Petitioner’s narrative concerning the proffered combination of Fulcher and Jacobs at pages 27–33 of the Petition, and are unable to locate either the word “lower” or “upper.” The portion of the claim chart concerning “a lower portion and an upper portion” reads as follows:

[1h] a lower portion and an upper portion;	<u>See, e.g., Fulcher</u> , Figs. 1 and 2 (depicting machine 2). <u>See, e.g., Jacobs</u> , 5:43-56: “As shown in FIG. 6, with the cover portion 228 removed, a modular assembly 248 can be removed from the housing 226. The modular assembly 248 comprises a PCB subassembly 250 and a coin handling subassembly 252. The coin handling subassembly 252 is releasably secured within the PCB subassembly 250. The PCB subassembly 250 comprises PCB 20, LCD support plates 254A and 254B, a coin/card plate 264, which contains the coin insertion hole 236 and payment card insertion hole 238. In addition, two lithium batteries 256A and 256B, for powering the meter 220, are secured to the PCB 20 via a battery bracket 258. Finally, a payment card connector 259 is coupled to the PCB subassembly 250 and is disposed to receives the payment card that is inserted into the payment card insertion hole 238”; Figs. 3 and 6.
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Section [1h] is a portion of the claim chart. Pet. 38.

We have considered the above portion of the claim chart, but are still unable to discern what Petitioner asserts corresponds in Fulcher and Jacobs to the recited “a lower portion and an upper portion.” For example, the citation to Fulcher consists entirely of only a mention of Figures 1 and 2, which are shown below.



Figures 1 and 2 are front perspective views of an automated fee collection and ticket dispensing unit.

There are many components depicted in ticket dispenser 2. Petitioner has not identified, and we are unable to ascertain, which components are meant to correspond to the recited “a lower portion and an upper portion.”

For Jacobs, Petitioner cites only a portion of Jacobs directed predominantly to components of PCB subassembly 250 and coin processor 252. Figure 6 of Jacobs is set forth below:

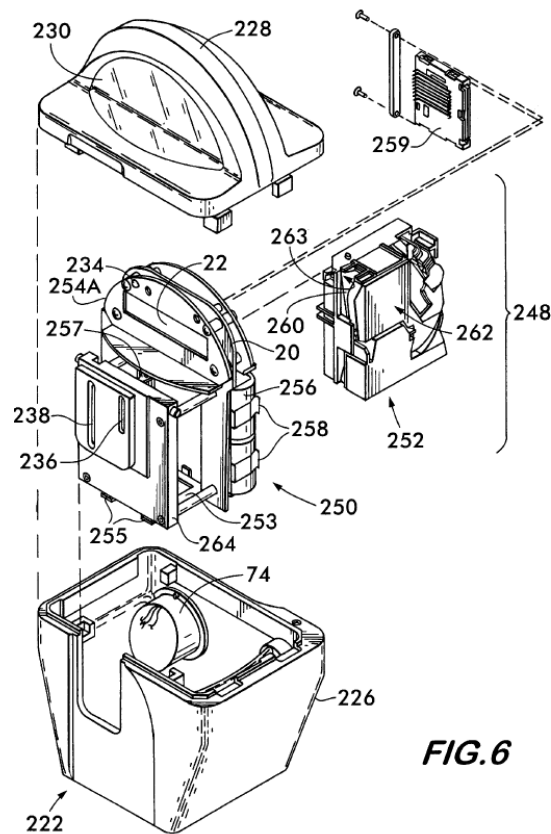


FIG. 6

Figure 6 is an exploded isometric view of an electronic parking meter. Similar to our analysis of Figures 1 and 2 of Fulcher, however, there are many components depicted in PCB subassembly 250 and coin processor 252, and Petitioner has not identified, and we are unable to ascertain, which components are meant to correspond to the recited “a lower portion and an upper portion.”

As we delve further into the claim chart, however, we are able to glean some indications as to what Petitioner may have considered “a lower portion and an upper portion” in Jacobs. For example, for the limitation “wherein the lower portion of the parking meter device is configured to have a shape and dimensions such that the lower portion is receivable within the housing base of the single space parking meter,” Petitioner appears to identify PCB assembly 250. Pet. 40. Accordingly, we infer that Petitioner

perhaps meant for PCB assembly 250 to correspond to the recited “lower portion.” For the recited “upper portion,” the only portion of the claim chart we can ascertain as providing us any meaningful guidance is claim 10, which recites “wherein the display is located at the parking meter device upper portion.” Pet. 42. For that, Petitioner identifies display 200 of Fulcher and display 232 of Jacobs.

Display 200 of Fulcher is roughly at the upper vertical half of ticket dispenser 2, but Petitioner has not identified, and we are unable to ascertain, which portion that display 200 is “at” constitutes the “upper portion.” Even giving Petitioner the benefit of the doubt, however, that the area of ticket dispenser 2 roughly surrounding display 200 is the “upper portion,” we are unclear as to how this “upper portion” is to be reconciled with the asserted “lower portion” identified in Jacobs, i.e., PCB subassembly 250 and coin processor 252.

Perhaps, then, the citation to both display 200 of Fulcher and display 232 of Jacobs is an indication that Petitioner intended one to be substituted for the other. Figure 1 of Jacobs showing display 232 is set forth below:

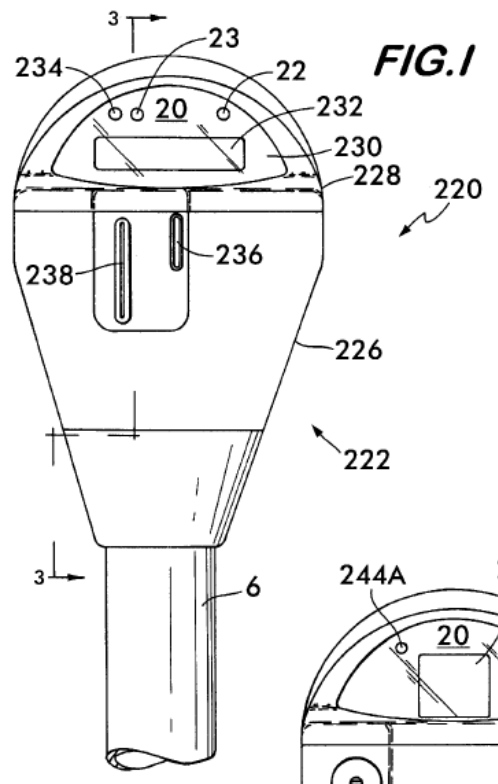


Figure 1 is a sidewalk-side elevation view of an electronic parking meter. Jacobs discloses that display 232 is viewable through window 230, and is mounted on printed circuit board 20. Ex. 1006, 5:1–10. Jacobs discloses further that PCB subassembly 250 comprises PCB 20. Ex. 1006, 5:48–49. Accordingly, it would appear that display 232 may be a component of PCB subassembly 250. Of course, this is problematic because if display 232 corresponds to the recited “upper portion,” and PCB subassembly 250 corresponds to the recited “lower portion,” Petitioner is actually asserting that the “lower portion” (PCB subassembly 250) includes the “upper portion” (display 232). Practicality dictates, however, that this is not logical, and additionally, even making all of the above assumptions, it is unclear how Petitioner intends for display 200 of Fulcher to fit into this analysis.

At this point, then, after having conducted this entire analysis with little to no guidance from Petitioner, we come to the conclusion that

Petitioner has not met its burden of showing how a combination of Fulcher and Jacobs discloses or suggests “a lower portion and an upper portion.” Specifically, Petitioner has not provided analysis, claim construction, or evidence that explains adequately how the above-identified items in Fulcher and Jacobs can be considered an “upper portion” and “lower portion,” in particular, when it appears that Petitioner is advocating that the “upper portion” is a component of the “lower portion.”⁴ For example, Petitioner has not provided any claim construction of “lower” and “upper,” which perhaps could have clarified Petitioner’s proffered mapping. Indeed, Petitioner has not provided any claim construction of any claim terms at all. In another example, Petitioner has not provided any analysis of any of PCB subassembly 250, coin processor 252, display 200, and display 232, other than to quote directly the portions of Fulcher and Jacobs that reference these items. Pet. 28–30, 38–40, 42. Without any such analysis, Petitioner is essentially asking the Board to speculate as to how Petitioner intended to reconcile the aforementioned discrepancy. We decline to do so.

Petitioner must identify, “in writing and with *particularity*, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3) (emphasis added); *see also* 37 C.F.R. §§ 42.22(a), 42.104(b)(4)–(5). For the reasons set forth above, we are unpersuaded that Petitioner has shown with sufficient particularity that a combination of

⁴ We have considered also the relevant portions of the Declaration of Mr. Magness that could plausibly be directed to this issue. Ex. 1003, ¶¶ 30, 31, 39, 64–68, 95–99, 116–121. We determine that they do not add materially to Petitioner’s analysis of the claim limitation at issue.

Fulcher and Jacobs discloses or suggests “a lower portion and an upper portion.” And without that particularity, we are unpersuaded that Petitioner has shown a reasonable likelihood that it would succeed in showing that independent claim 1 is unpatentable over a combination of Fulcher and Jacobs. Furthermore, as claim 1 is the only independent claim, for the same reasons, we are unpersuaded that Petitioner has shown a reasonable likelihood that it would succeed in showing that claims 2–16, each of which depend ultimately from independent claim 1, are unpatentable over a combination of Fulcher and Jacobs.

B. Claims 1–8 and 10–14 as Anticipated by Tung

Petitioner asserts that Tung anticipates claims 1–8 and 10–14. Pet. 15–27 (citing Exs. 1003, 1009, 1037). Patent Owner disagrees. Prelim. Resp. 8–19 (citing Exs. 1003, 1009, 1037, 2001, 2002). In particular, Patent Owner asserts that Petitioner has not met its burden of showing that Tung is prior art. Prelim. Resp. 9–12. We agree.

Tung is, on its face, a master’s thesis. While it does have repeated references to a 2001 date, because it is a master’s thesis, and no indication has been provided that it is a regular publication, the relevant question is not when Tung was completed, but when Tung was publicly accessible. *See SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008). Specifically, as the ’054 patent has a filing date of no later than December 4, 2006, and as Petitioner asserts that Tung is a reference under 35 U.S.C. § 102, the relevant question is whether Petitioner has shown that Tung was publicly accessible no later than December 4, 2006.

To that end, the entirety of Petitioner’s analysis concerning the public accessibility of Tung, as set forth in the Petition, is as follows: “Tung is a

master's thesis published in 2001 and publically available since that time. *See* Ex. 1037 (catalog entry for Tung showing publication and cataloging in 2001). As such, Tung is prior art under 35 U.S.C. § 102(b).” Pet. 15.⁵ We begin with Tung itself. As noted above, while Tung appears to be a master's thesis with multiple references to a 2001 date, Petitioner has not identified, and we are unable to ascertain independently, any indication in Tung itself as to how and when it was publicly accessible.

Petitioner then provides Exhibit 1037 as a “catalog entry for Tung showing publication and cataloging in 2001,” presumably from the RIT Scholar Works website. Pet. 15. Exhibit 1037 does mention a publication date of 2001, and notes the following: “Note: imported from RIT's Digital Media Library running on DSpace to RIT Scholar Works. Physical copy available through RIT's The Wallace Library at: HE336.P37 T864 2001.” Accordingly, if viewed in a light most favorable to Petitioner, it appears that a physical copy of Tung may have been publicly available at RIT's Wallace Library as of 2001 with the aforementioned catalog designation. The aforementioned items constitute the entirety of Petitioner's proffered evidence that Tung was publicly accessible in 2001.

Against the aforementioned evidence in favor of Petitioner, Patent Owner identifies several items that Petitioner has not accounted for and, thus, asserts that when all the evidence is considered in the aggregate, Petitioner has not shown adequately that Tung was publicly accessible as of

⁵ The Declaration of Mr. Magness also mentions a 2001 publication date for Tung; however, Mr. Magness only mentions Exhibit 1037 as the basis for that understanding. Accordingly, our analysis of Exhibit 1037 also accounts for Mr. Magness's statements concerning the publication date of Tung.

2001. We agree. Beginning with the aforementioned “Physical copy available through RIT’s The Wallace Library at: HE336.P37 T864 2001,” Petitioner has not explained at all the significance of this designation. Even if we were to infer that “HE336.P37 T864” is a card catalog designation and “2001” is the year of availability, those inferences do not inform us as to the indexing used by the RIT’s Wallace Library that would indicate adequately that a person interested and ordinarily skilled in the subject matter or art exercising reasonable diligence could locate Tung. *See SRI Int’l, Inc.*, 511 F.3d at 1194. Petitioner has not persuasively argued that we should draw supporting inferences from the designation itself.

Furthermore, Patent Owner identifies two dates in Exhibit 1037 that post-date 2001 and could potentially undercut Petitioner’s assertion, namely, an apparent print-date of Exhibit 1037 as “10/18/2015,” and the phrase “Since January 06, 2014.” While we discern that the first date is self-explanatory and does not weigh materially against Petitioner, we are unclear as to the implication of the second date. For example, “Since January 06, 2014” could indicate a date that the RIT Scholar Works website is available, which would undercut Petitioner’s assertion that Tung was available in 2001. Of course, there could be some other explanation that does not undercut Petitioner’s assertion; however, Petitioner has not provided any such analysis. In the absence of such analysis, and with the burden being on Petitioner to show adequately that Tung is prior art, we are persuaded that a lack of explanation concerning “Since January 06, 2014” must weigh against Petitioner.

Additionally, Patent Owner provides two additional exhibits that it asserts undercut further Petitioner’s assertion that Tung was publicly

accessible in 2001. Specifically, Exhibits 2001 and 2002 appear to be directed to “RIT Digital Media Library Repository,” which Exhibit 1037 appears to identify as the original source from which the RIT Scholar Works website acquired Tung. Ex. 1037, 1 (“Note: imported from RIT’s Digital Media Library running on DSpace to RIT Scholar Works.”). Going to the exhibits themselves, Exhibit 2002 indicates that the RIT Digital Media Library Repository was developed in 2003. While 2003 is admittedly before the “no later than” December 4, 2006, date of the ’054 patent, nonetheless, we agree with Patent Owner that it casts additional doubt on Petitioner’s assertion that Tung was publicly accessible as of 2001. In another example, Exhibit 2001, while having the same 2001 dates mentioned in Exhibit 1037 under “dc.date.issued” and “dc.subject.lcc,” also has the following under “dc.date.accessioned” and “dc.date.available”: “2012-02-13T15:17:27Z.” Patent Owner asserts that this designation could indicate that Tung was not available, at least at the RIT Digital Media Library Repository, until 2012.

To be sure, each and every one of the items set forth above may have an explanation as to why they ultimately do not weigh dispositively against Petitioner’s assertion that Tung was publicly accessible in 2001. For example, it could be argued that Exhibits 2001 and 2002 only go to the public accessibility of Tung at the RIT Digital Media Library Repository, and that a physical copy of Tung was still publicly accessible at RIT’s Wallace Library as of 2001. Additionally, Petitioner has not had a chance to challenge the contents of Exhibits 2001 and 2002. Against those considerations, however, we go back to the fact that the following constitutes the entirety of Petitioner’s analysis concerning the public accessibility of Tung in 2001: “Tung is a master’s thesis published in 2001

and publically available since that time. *See* Ex. 1037 (catalog entry for Tung showing publication and cataloging in 2001). As such, Tung is prior art under 35 U.S.C. § 102(b).” Accordingly, for the totality of reasons set forth above, and especially in light of Petitioner’s lack of analysis concerning “Physical copy available through RIT’s The Wallace Library at: HE336.P37 T864 2001,” we are unpersuaded that Petitioner has met its burden of showing that Tung was publicly accessible prior to the no later than December 4, 2006, date of the ’054 patent.

C. Conclusion

For the foregoing reasons, we are unpersuaded that Petitioner has met its burden of showing a reasonable likelihood that claims 1–16 are unpatentable.

III. ORDER

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

IPR2016-00070
Patent 8,595,054

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