

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORPORATION

Petitioner,

v.

AMERICAN VEHICULAR SCIENCES LLC

Patent Owner.

Patent 8,036,788

Issue Date: October 11, 2011

Title: VEHICLE DIAGNOSTIC OR PROGNOSTIC MESSAGE
TRANSMISSION SYSTEMS AND METHODS

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

Case No. IPR2013-00417

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I. INTRODUCTION

Pursuant to 37 C.F.R. §§ 42.23-24, Petitioner Toyota Motor Corporation (“TMC”) submits the following Reply in support of its petition for *inter partes* review (“IPR”), designated number IPR2013-00417, of certain of the claims of U.S. Patent No. 8,036,788 (“the ’788 patent”). This filing is in reply to the Response submitted by the Patent Owner (Paper 30, hereinafter “Response”) and is timely pursuant to the Board’s Scheduling Order (Paper 15) and the parties’ stipulation extending Due Date 2 to June 2, 2014. (*See* Paper 26, Joint Notice of Stipulation to Adjust Schedule.)

TMC’s petition identified claims 1, 3, 4, 6-9, 11, 15, 16, and 18 of the ’788 patent as the claims at issue. The Board instituted IPR in connection with all of these claims. Patent Owner AVS (“AVS”) presents no arguments rebutting, or purporting to rebut, the case for the unpatentability of claims 1, 3, 4, 6-8, 11, 15, 16, and 18. Instead, it filed a non-contingent motion to amend, requesting cancellation of those claims, and proposing substitute claims.

With respect to the remaining claim addressed in TMC’s petition—claim 9—AVS provides no substantive argument that attempts to explain how this claim is patentable over “Diesel Locomotive Reliability Improvement by Systems Monitoring” by Fry (Exhibit 1005, Fry). AVS’s sole argument for patentability is that Fry does not qualify as prior art under 35 U.S.C. § 102(a). (*See generally* Response at 6-13.)

AVS states that claim 9 is entitled to the priority date of a June 7, 1995, application. For purposes of its petition, TMC does not challenge this assertion.

AVS asserts no earlier date of invention. Accordingly, the only issue is whether TMC has proven by a preponderance of evidence that Fry was published prior to June 7, 1995, and therefore is prior art under 35 U.S.C. § 102(a).¹

II. THE BOARD SHOULD MAINTAIN ITS OPINION THAT CLAIM 9 IS UNPATENTABLE OVER FRY

The totality of the evidence establishes that it is more likely than not that Fry was published prior to June 7, 1995, and is thus prior art to the '788 patent under 35 U.S.C. § 102(a).

AVS does not dispute that Fry was actually published in the *Proceedings of the Institution of Mechanical Engineers*, Part F: Journal of Rail and Rapid Transit, Vol. 209, No. F1, or that it was available sometime in 1995. Instead, AVS only takes issue with TMC's evidence regarding the specific date within 1995 when this article was first made available to the public. The face of the Fry article includes a copyright date of "1995." (Ex. 1005, Fry, at 1-3.) It does not, however, specify the exact day on which the Fry article was published and available to the public in 1995. Therefore, for the

¹ AVS has indicated that it will file a motion contesting the admissibility of TMC's evidence regarding the Fry publication date, and that it will argue admissibility only at that time. *See* Response at 8-9. Therefore, TMC will respond to those arguments, if made, at that time.

purposes of establishing a publication date, TMC relies on various evidence² establishing—by a preponderance of the evidence—publication of the Fry article in January 1995, or at least prior to June 7, 1995.

First, TMC relies on records maintained on the website of Sage Publications, the current publisher of the Fry paper, that indicate publication in January 1995. (Ex. 1012, Sage Publications Inc.’s Website Listing, at 1-2, 4, 6.) AVS argues that Sage Publications “was not the original publisher of Fry in 1995,” and that TMC’s witnesses have not “corroborated the January 1, 1995 date.” But these objections are insufficient in view of TMC’s additional evidence.

TMC also relies on an affidavit by Sara Broadhurst, a Library and Archive Assistant for the *original* publisher of the Fry article, the Institution of Mechanical Engineers (“iMechE”). (See Ex. 1014, Broadhurst Aff., at ¶¶ 1-3; Ex. 1005, Fry, at 2.) AVS’s assertion that Ms. Broadhurst “does not work for the organization that actually published Fry in 1995 or the organization that currently publishes Fry,” (Response at 13), misses the point. According to Ms. Broadhurst’s affidavit, the iMechE is the entity ultimately responsible for the Fry article: the iMechE accepted the article for publication, arranged for the article’s publication in 1995, and continues to arrange for

² While TMC contends that the preponderance of the evidence shows that the Fry article was published before June 7, 1995, it has not been able to confirm that fact by locating physical copies with a recipient-stamped date prior to that date.

its publication today. (Ex. 1014, Broadhurst Aff., at ¶¶ 2-4.)³ Further, the declaration states that the records maintained on the Sage Publications website—relating to the date on which, for example, the Fry article was received, accepted for publication, and published—are business records generated and maintained in the ordinary course of business by the iMechE, and they show that the Fry article was made available to the public by January 1995. (*Id.* at ¶¶ 4-6.) And, consistent with the Fry article itself and Mr. Fry’s declaration (discussed below), Ms. Broadhurst explains that “Part F: Journal of Rail and Rapid Transit ... was published semi-annually, in two separate issues identified as ‘F1’ and ‘F2,’” with the “F1 issue published in January of each year.” (*Id.* at ¶ 7.) The Federal Circuit has held that a librarian’s affidavit regarding general library practices, such as the affidavit provided by Ms. Broadhurst, is sufficient to establish when a publication became publicly available. *In re Hall*, 781 F.2d 897, 898-899 (Fed. Cir. 1986) (finding that a reference was publicly available where the probative evidence was a librarian’s affidavit regarding the library’s business practices and the approximate date of publication based on these practices).

And, TMC further relies on a declaration by the author of the Fry article to corroborate publication in January 1995. (Ex. 1013, Fry Decl.) In his declaration, Mr. Fry states that he authored the Fry article. (*Id.* at ¶ 2.) He also states that it is his

³ Consistently, the Fry article indicates on its face that it was “Published for the Institution of Mechanical Engineers.” (Ex. 1005, Fry, at 2.)

recollection that the article was published in January 1995. (*Id.* at ¶ 5.) According to Mr. Fry, his recollection regarding the month of publication was refreshed by his review of (i) the paper itself, (ii) an award he received based on the paper, and (iii) printouts from the website of Sage Publications. (*Id.*) Mr. Fry's award, consistent with both Ms. Broadhurst's affidavit and the Fry article itself, expressly indicates that the article was part of the "F1" issue of "Part F" of the "Proceedings of the Institution of Mechanical Engineers." (Ex. 1011, Fry award, at 1.) Thus, the award does more than "merely indicate[] that Fry was published in '1995'" as AVS alleges, (Response at 12 n.3.); instead, the award corroborates that the Fry article was part of the first of two issues of "Part F" of the "Proceedings of the Institution of Mechanical Engineers" that were published in 1995.

Last, the Fry article itself includes various pertinent pieces of information, ignored by AVS, all of which support TMC's contention that the article was published and available to the public prior to the '788 patent's alleged June 7, 1995, priority date. For instance, the article's table of contents explains that "Part F" of the "Proceedings of the Institution of Mechanical Engineers," the journal that contains the Fry article, is "published twice a year. The two issues are numbered separately within the volume, i.e. F1, F2." (Ex. 1005, Fry, at 2.) As specified by the table of contents, the Fry article is part of the F1 issue, the first issue published in 1995. (*Id.*) Further, the first page of the Fry article explains that the article was "received 25 November 1993 and was accepted for publication on 22 December 1994." (*Id.* at 3.) AVS argues that Fry

could not have been published in January 1995 because it was “accepted for publication” only a few days earlier in December 1994. (Response at 11.) This ignores, however, the evidence that the article had been in the possession of the Institution of Mechanical Engineers since November 1993.

The declaration and the affidavit each prove—and certainly together with the Fry article and the materials from the Sage website, prove—by a preponderance of the evidence, that Fry was published and available to the public prior to June 7, 1995.

Indeed, AVS presents no evidence of its own regarding the date on which the Fry article was published. Instead, it simply argues that TMC’s evidence of public availability prior to June 7, 1995, is insufficient. In making this argument, however, AVS cites to no case law applying the “preponderance of the evidence” standard of proof applicable in an IPR under 35 U.S.C. § 316 (e), and to no case law in which the patent challenger offered the level of corroborating testimonial evidence presented here in support of invalidity.

For example, AVS cites to *Hilgraeve, Inc. v. Symantec Corp.* In that case, a single declaration by the prior art software publisher was insufficient to meet the clear and convincing proof standard. 271 F. Supp. 2d 964, 976 (E.D. Mich. 2003). Again, the clear and convincing evidentiary standard is inapplicable here. Instead, TMC only needs to establish the Fry article’s date of availability by a preponderance of the evidence. AVS’s citation to *Santec Indus. v. Micro-Waste Corp.* is also unavailing. In that case, the article itself had no date, and the court found that an undated publication—

without any additional evidence—is insufficient proof of prior art under the clear and convincing standard. No. 04-3066, 2006 WL 3455000, at *9 (S.D. Tex. Nov. 28, 2006). Here, not only does the lower, preponderance of the evidence standard apply, but the Fry article includes both a 1995 date and other dating information on its face. Further, TMC has submitted additional evidence regarding the month in which the article was available to the public.

AVS further cites to the *Carella* and *In re Omeprazole* cases, where there was no evidence at all, let alone clear and convincing evidence, of public availability. *Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135, 139 (Fed. Cir. 1986); *In re Omeprazole Patent Litig.*, 490 F. Supp. 2d 381, 520 (S.D.N.Y. 2007). For example, in *Carella*, it appears that the publication was dated just before the critical date, but there was no evidence that the transit time of the article through the mail was short enough such that it was received by the public in time. *Carella*, 804 F.2d at 139. Here, both the Fry declaration and Broadhurst affidavit explain that the Fry article was published in January 1995, six months before AVS’s alleged June 7, 1995, priority date.

The *Norian* case is also not on point. There, the Federal Circuit did not address the question of publishing by mail, through libraries, or over the Internet. Rather, the Court called into question the sufficiency of the physical dissemination of a conference article. *Norian Corp. v. Stryker Corp.*, 363 F.3d 1321, 1330 (Fed. Cir. 2004). The Fry article is not a conference article. Instead, it is part of a periodically published journal.

The other cases cited by AVS are also distinguishable. In the *Ajinomoto* case, the court found that the uncorroborated testimony from the author of the prior art article was insufficient under the clear and convincing standard. *Ajinomoto Co. v. Archer-Daniels-Midland Co.*, No. 95-218, 1998 WL 151411, at *38 (D. Del. Mar. 13, 1998). Here, Mr. Fry's declaration is corroborated by an award he received, along with the Fry article itself. Further, Mr. Fry's declaration is bolstered by and consistent with Ms. Broadhurst's affidavit. Last, in the *DH Tech.* case, the publication month and year printed on the reference itself was found insufficient, under the clear and convincing standard, to prove the publication **day** (within the month indicated on the reference). *DH Tech., Inc. v. Synergystex Int'l, Inc.*, No. 92-3307, 1994 U.S. Dist. LEXIS 5301, at *4 (N.D. Cal. Apr. 11, 1994). In this case, since AVS only alleges a June 7, 1995, priority date, the actual day in January 1995 on which the Fry article was published is unimportant.

In the absence of any argument on the merits, and in light of TMC's proof that Fry was published and available to the public prior to June 7, 1995, the Board's initial determination that claim 9 is unpatentable should be maintained.

III. CONCLUSION

For the reasons in TMC's Petition for *Inter Partes* Review of U.S. Patent No. 8,036,788 (Paper 2, Petition for IPR of 8,036,788), for the reasons in the Board's decision to institute an *inter partes* review (Paper 14, Institution Decision) , and for the

additional reasons set forth above, the Board should maintain its decision of unpatentability of claim 9.

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CERTIFICATE OF SERVICE

The undersigned hereby confirms that Petitioner's Reply to Patent Owner's Response and Exhibits 1019-1029 were served on June 2, 2014 via e-mail upon the following counsel of record for Patent Owner:

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