

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN HONDA MOTOR CO., INC., HONDA OF AMERICA MFG.,
INC., HONDA PATENTS & TECHNOLOGIES NORTH AMERICA, LLC,
and HONDA MOTOR CO., LTD,
Petitioner,

VOLKSWAGEN GROUP OF AMERICA, INC.,
Petitioner,

v.

SIGNAL IP, INC.,
Patent Owner.

IPR2015-01003 (Patent No. 5,732,375)
IPR2015-01004 (Patent No. 6,012,007)
IPR2015-01116 (Patent No. 6,012,007)

Before MEREDITH C. PETRAVICK, JEREMY M. PLENZLER, and
JAMES A. TARTAL, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

ORDER
37 C.F.R. § 42.5
Conduct of the Proceeding

IPR2015-01003 (Patent No. 5,732,375)
IPR2015-01004 (Patent No. 6,012,007)
IPR2015-01116 (Patent No. 6,012,007)

U.S. Patent No. 5,732,375 (“the ’375 patent”) and U.S. Patent No. 6,012,007 (“the ’007 patent”) are the subject of related case *Signal IP, Inc. v. American Honda Motor Co., Inc. et al.*, No. 2:14-cv-02454 in the U.S. District Court for the Central District of California. On May 22, 2015, the U.S. District Court entered a Partial Judgement of Invalidity. Ex. 3001. The Partial Judgement of Invalidity states that the Plaintiff, Signal IP, Inc., and defendants, which include all Petitioners in these proceedings, filed a Joint Stipulation For Entry of Partial Final Judgement of Invalidity. *Id.* at 1. The Partial Judgement of Invalidity states:

Based on the stipulation of the parties, and good cause appearing, the parties’ joint stipulation is APPROVED and SO ORDERED. Accordingly, IT IS HEREBY ORDERED, ADJUDGED AND DECREED THAT:

...

2. Claim 1 and 7 of U.S. Patent No. 5,732,375 (“the ’375 patent”) are invalid as indefinite under 35 U.S.C. § 112, paragraph 2.

3. Claims 1, 8, 9, 17, 18, 19, and 20 of U.S. Patent No. 6,012,007 (“the ’007 patent”) are invalid as indefinite under 35 U.S.C. § 112, paragraph 2.

Id. at 1-2.

Claims 1 and 7 of the ’375 patent are the only claims challenged in IPR2015-01003. Claims 1, 9, 17, 18, 19, and 20 of the ’007 are among the claims challenged in IPR2015-01004 and IPR2015-01116. Should an *inter partes* review be instituted, the ’375 patent and the ’007 patent appear to expire during the review. “[T]he Board’s review of the claims of an expired

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patent is similar to that of a district court's review.” *In re Rambus, Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012).

After discovering the Partial Judgement of Invalidity, which refers to the Joint Stipulation, the Board initiated a conference call to inquire about the parties' stipulation and to inquire as to what affect the parties believe the stipulation has on these proceedings. The conference call was held between counsel for the parties and Judges Petravick, Tartal, and Plenzler on September 1, 2015.

Based upon the information presented by the parties during the call, the Board determined that additional briefing is required. In each proceeding, Petitioner and Patent Owner should file a paper, no more than 10 pages, explaining the stipulation and what affect the stipulation has on that proceeding, or why it does not affect that proceeding. In addition, the parties should address the following questions:

- (1) Whether the party contends that the challenged claims that are the subject of the stipulation are indefinite under 35 U.S.C. § 112, second paragraph, with an explanation in support of the party's contention.
- (2) For IPR2015-01004 and IPR2015-01116, if the challenged independent claims are indefinite, whether the party contends such indefiniteness does, or does not, impact the challenged dependent claims that are not the subject of the stipulation, with an explanation in support of the party's contention and an explanation of the impact.
- (3) Whether the party contends that if the Board determines that the parties stipulated that the claims are invalid for being indefinite, the

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Board should exercise its discretion, pursuant to 35 U.S.C. § 314 to deny the Petition with respect to those claims or whether the Board should terminate the proceeding pursuant to 37 C.F.R. § 42.72.

(4) For IPR2015-01003, if the Board determines that the parties stipulated that claims 1 and 7 are invalid for being indefinite, whether Patent Owner's stipulation should be considered a request for adverse judgment because the stipulation is a "disclaimer of a claim such that the party has no remaining claim in the trial," pursuant to 37 C.F.R. § 42.73.

Each party also should file any information upon which it intends to rely with respect to the impact of the Joint Stipulation or to the issue of whether the claims are definite and should file any information that is inconsistent with its position advanced in the Joint Stipulation or inconsistent with its contentions regarding the issue of definiteness. Patent Owner should file a copy of the Joint Stipulation For Entry of Partial Final Judgement of Invalidity filed in the related U.S. District Court case.

The parties should file the papers and relevant information no later September 10, 2015.

It is so ORDERED.

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