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,

v.

SIGNAL IP, INC.,

Patent Owner.

Case IPR2015-01003

Patent 5,732,375

PATENT OWNER'S ADDITIONAL BRIEFING CONCERNING THE STIPULATION AND PARTIAL JUDGMENT OF INVALIDITY IN THE RELATED LITIGATION

Pursuant to the Board's Order of September 2, 2015, Patent Owner submits the following additional briefing to address the issues raised by the parties' stipulation and the Court's partial judgment of invalidity in the underlying litigations.

(1) The challenged claims of the '375 patent implicated by the stipulation are not indefinite.

Petitioner challenges the patentability of claims 1 and 7 of U.S. Patent 5,732,375 (the "'375 patent"). In the Court's order of partial summary judgment in the underlying litigation, claims 1 and 7 were found invalid as indefinite under 35 U.S.C. § 112, paragraph 2.[1] This determination was made pursuant to the parties' stipulation that,

> In light of the Court's claim construction order, Plaintiff and Defendants stipulate to entry of a partial final judgment that the following claims are invalid due to indefiniteness under 35 U.S.C. § 112, paragraph 2: . . . (ii) claims 1 and 7 of the '375 patent. . . .[2]

[1] *Ex. 3001* at 2.

[2] *Ex. 2002* at 2. Reexamination Certificate US 5,732,375 C1, issued July 30, 2015, confirms the patentability of claims 1 and 7, but directs attention to the Court's decision.

Notably, this stipulation related to a procedural action concerning the "entry of a partial final judgment," and ***not*** to the correctness of the Court's determination concerning validity of the subject claims. This is evidenced by further provisions of the stipulation that,

> Plaintiff and Defendants reserve all appellate rights, including, but not limited to, the right to appeal the Court's April 17, 2015 claim construction order to the United States Court of Appeals for the Federal Circuit. Plaintiff reserves all rights as to claims not addressed by the Court's claim construction order, or any new claims that may be issued by the United States Patent Office.[3]

With respect to claim 1, the Court deemed the term "concentrated" to be indefinite under 35 U.S.C. § 112, paragraph 2.[4] In context, this term is used in connection with calculations of forces in various seat areas: "determining the existence of a local pressure area when the calculated total force is concentrated in one of said seat areas," and "calculating a local force as a sum of forces sensed by each sensor located in the seat area in which the total force is concentrated."[5] The specification explains that,

---

[3] *Id*. at 2-3.

[4] *Ex. 2001* at 41-43.

[5] *Ex. 1001* at 5:52-57.

> a check is made for force concentration in a localized area <56>. Four overlapping localized areas are defined as shown in FIG. 7. The front four sensors 1, 6, 7 and 12 are in the front group, the rear eight sensors 2, 3, 4, 5, 8, 9, 10 and 11 are in the rear group, the left eight sensors 1, 2, 3, 4, 5, 6, 8, and 9 are in the left group, and the eight sensors 4, 5, 7, 8, 9, 10, 11, and 12 are in the right group. The algorithm determines if the pressure is all concentrated in one group by summing the load ratings of the sensors in each group and comparing to the total load rating. If the rating sum of any group is equal to the total rating, a flag is set for that group (all right, all front etc.).[6]

Thus, force "concentration" is used consistently with the plain and ordinary meaning of that term (a relative measure of the amount of force detected by sensors in a given seat area) and, in this example, the total force may be "concentrated" in a seat area when the sum in that area is equal to the total.

Based on the above, a person of ordinary skill in the art reading the '375 patent would readily discern that the term "concentrated," as used in claim 1, means that the check for force concentration described in the specification has determined that forces are such that "by summing the load ratings of the sensors in each group and comparing to the total load rating,"

[6] *Id*. at 4:18-29.

the sum of a group is equal to the total rating.

The Court mistakenly determined that the claim should have recited concentrations of 100% of forces and that because it did not the claim was invalid.[7] Such a determination, however, was inappropriate. Simply because only one example of force concentration was provided in the specification is not a basis for finding a claim indefinite. Indeed, a single embodiment may provide broad support for the understanding of a person of ordinary skill in the art in cases involving predictable factors, such as mechanical or electrical elements.[8] Here, the determination of relative displacements of forces over a defined sensor area involves predictable factors, hence the example provided in the specification was sufficient to inform persons of ordinary skill in the art of the boundaries of the claim.[9] Accordingly, the

---

[7] *Ex. 2001* at 43.

[8] *See, e.g.*, *In re Vickers*, 141 F.2d 522, 526-27 (CCPA 1944); *In re Cook*, 439 F.2d 730, 734 (CCPA 1971).

[9] *Cf. Nautilus, Inc. v. Biosig Instruments, Inc.* 134 S. Ct. 2120 (2014) (a claim, viewed in light of the specification and prosecution history, need only inform with reasonable certainty, those skilled in the art about the scope of the invention to satisfy § 112); *Halliburton Energy Services, Inc. v. M-I*

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.