

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Cashler Case No. IPR2015-01003
U.S. Patent No.: 5,732,375 Docket No.: 15625-0019IP1
Issue Date: March 24, 1998
Appl. Serial No.: 08/566,029
Filing Date: December 1, 1995
Title: METHOD OF INHIBITING OR ALLOWING AIRBAG
DEPLOYMENT

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BRIEF RESPONSIVE TO BOARD ORDER FILED SEPTEMBER 2, 2015
RE: PARTIAL JUDGMENT OF INVALIDITY IN DISTRICT COURT

American Honda Motor Co., Inc. (“Petitioner” or “Honda”) files the present Brief in response to Board’s Order filed September 2, 2015 (“the Order”) in the present *Inter Partes Review* (IPR) proceeding. Petitioner respectfully submits that the Board should not deny institution of the present IPR or terminate the proceeding under 37 CFR § 42.72, because the Joint Stipulation by the Petitioner and Patent Owner (“the Joint Stipulation”) in the District Court case is to the entry of the judgment only, not to the indefiniteness of the claims. As a result, Patent Owner may still appeal the judgment at the conclusion of trial, which leaves open the possibility that the claims may yet be found valid. If the Board denies institution of or terminates the present IPR, Petitioner will be unable to challenge the claims in a later IPR due to the one-year bar imposed by 35 U.S.C. § 315(b). Accordingly, the Board should afford Petitioner the opportunity to challenge the claims on prior art grounds in the present IPR by allowing the proceeding to continue.

The Order listed specific issues to be addressed in this Brief. Petitioner will address each of these issues in turn.

I. Explanation of the Joint Stipulation

On April 17, 2015, the District Court issued a claim construction order holding that the term “concentrated” in claim 1 of the ’375 Patent is indefinite

under 35 U.S.C. § 112 ¶ 2. Ex. 2002, p. 1. The Patent Owner and the defendants (including Honda) filed the Joint Stipulation to entry of a judgment of invalidity of claims 1 and 7 of the '375 Patent by the District Court, which had the effect of removing the claims from consideration in the case. *Id.* Notably, the Joint Stipulation was to “entry” of the judgment by the District Court only. *Id.* Neither the Patent Owner nor the defendants stipulated to the indefiniteness of the claims of the '375 Patent, and all parties “reserve[d] 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.” *Id.* at pp. 1-2. Accordingly, the partial judgment of invalidity entered in response to the Joint Stipulation can still be appealed to Federal Circuit, and thus has no preclusive effect on the Board in the present case. See *SAP v. Versata*, CBM2012-00001, Paper 36, p. 19 (Holding that a judgment on appeal to the Federal Circuit “is not sufficiently firm to be accorded” preclusive effect by the Board).

II. Claims 1 and 7 of the '375 Patent are indefinite, but analysis is still possible

Claims 1 and 7 recite “determining the existence of a local pressure area when the calculated total force is concentrated in one of the seat areas.” The District Court found that the term “concentrated” is indefinite because the claims

are ambiguous as to what amount of the total force must be applied to the seat area for it to be “concentrated” on that seat area. *See* Ex. 2001, p. 43. In the words of the court:

Nothing in the claims or specification allows a person of skill in the art to know the “objective boundaries” of the claim: whether 75%, 51%, or 33% of the force counts as “concentrated” in one group. “[A] patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” The “concentrated” term here fails that standard. Accordingly, Claim 1 of the ‘375 Patent is invalid as indefinite.

Ex. 2001, p. 33 (internal citations omitted). We agree with the District Court that the claims are indefinite, because the term “concentrated” is “a term of degree,” and none of the claims, the specification nor the prosecution history “provide[s] objective boundaries for those of skill in the art” to identify the levels of concentration that would, and would not, meet this limitation. *See Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1370–71 (Fed. Cir. 2014) (citing *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2124 (2014)). If the Board likewise determines the challenged claims are indefinite, we invite the Board to explain its reasoning on the record.

However, despite the indefiniteness, the claims do not defy interpretation. The ambiguity renders the claims open to multiple interpretations. However, regardless of how the ambiguity is reasonably resolved, the challenged claims are anticipated and rendered obvious by the prior art asserted in the Petition. For example, the Audi reference relied on in the petition “evaluates whether the front sensor force F1 is greater than the rear sensor force F2, i.e., ‘F1> F2,’ to determine the existence of a local pressure area.” *See* Paper 2 (Petition), p. 15. In other words, whether the ‘375 patent were read to require at least 33%, 51% or 75% of the force be concentrated in the seat area to determine a local pressure area, the Audi reference discloses an overlapping range, and the Audi-based grounds would thus meet this limitation. *See id.* The analysis of the Zeidler-based grounds is similar, because Zeidler, like Audi, evaluates weight in two seat areas (V and H). *See id.* at pp. 37-38. Accordingly, despite the indefiniteness of the claims, Petitioner submits that the claims are nonetheless invalid over the prior art cited in the Petitioner under any reasonable interpretation of the claims.

III. The Board should not deny the Petition or otherwise terminate the proceeding with respect to the indefinite claims because the Joint Stipulation does not represent a final judgment of invalidity

As previously discussed, the Joint Stipulation is to the "entry" of the judgment, and not to the indefiniteness of claims 1 and 7. *See* Ex. 2002, p. 1. The

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