

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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REACTIVE SURFACES LTD., LLP,  
Petitioner,

v.

TOYOTA MOTOR CORPORATION,  
Patent Owner.

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Case IPR2016-01914  
Patent 8,394,618 B2

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Before CHRISTOPHER M. KAISER, JEFFREY W. ABRAHAM, and  
MICHELLE N. ANKENBRAND, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceedings  
*37 C.F.R. § 42.5*

Following extensive briefing by Reactive Surfaces Ltd. LLP (“Petitioner”) and Toyota Motor Corporation (“Patent Owner”), we held an oral hearing on January 9, 2018. During our post-hearing consideration of the case, it became apparent that neither party had addressed a claim-construction issue that may be presented by the challenged claims.

All of the challenged claims are method claims that recite a limitation requiring “facilitating the removal of a fingerprint by vaporization from the lipase associated substrate or coating when contacted by a fingerprint.” Ex. 1001, 15:18–16:36. The language “when contacted by a fingerprint” may indicate that this limitation is conditional; that is, the action of “facilitating the removal of a fingerprint by vaporization from the lipase associated substrate or coating” may not occur at all unless there is contact by a fingerprint. *See Ex parte Kaundinya*, No. 2016-000917, 2017 WL 5510012, at \*6 (PTAB Nov. 14, 2017) (“when” may indicate a conditional method step); *Ex parte Zhou*, No. 2016-004913, 2017 WL 5171533, at \*2 (PTAB Nov. 1, 2017) (same); *Ex parte Lee*, No. 2014-009364, 2017 WL 1101681, at \*2 (PTAB Mar. 16, 2017) (same). Of course, “when contacted by a fingerprint” may not indicate that the limitation is conditional; instead, it might be a temporal limitation requiring that “facilitating the removal of a fingerprint” not occur until after there is contact by a fingerprint.

The question of whether the limitation “facilitating the removal of a fingerprint by vaporization from the lipase associated substrate or coating when contacted by a fingerprint” is a conditional method step is not purely academic. Our controlling precedent requires us to interpret claims reciting conditional method steps as encompassing at least two separate methods: one in which the conditional step occurs and one in which the conditional

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step does not occur. *Ex parte Schulhauser*, No. 2013-007847, 2016 WL 6277792, at \*4–5 (PTAB Apr. 28, 2016) (precedential). Accordingly, if the language “when contacted by a fingerprint” renders the limitation “facilitating the removal of a fingerprint by vaporization from the lipase associated substrate or coating when contacted by a fingerprint” a conditional method step, then we must interpret the challenged claims reciting this limitation as encompassing a method in which this step is not triggered and does not occur.

Because neither party has addressed the question of whether the limitation “facilitating the removal of a fingerprint by vaporization from the lipase associated substrate or coating when contacted by a fingerprint” is a conditional method step, we raise the question *sua sponte* and provide both parties with an opportunity to respond. Each party may file, no later than January 19, 2018, a single paper, not to exceed five pages, addressing the proper application, if any, of *Ex parte Schulhauser* to the challenged claims. We will not permit new evidence, but we encourage the parties to cite to the evidence already of record to the extent the parties find it helpful.

It is

ORDERED that each party may file a single paper not exceeding five pages, no later than January 19, 2018, addressing the proper application, if any, of *Ex parte Schulhauser* to the challenged claims; and

FURTHER ORDERED that no new evidence shall accompany either party’s submission.

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PETITIONER:

David O. Simmons  
IVC PATENT AGENCY  
dsimmons1@sbcglobal.net

Jonathan D. Hurt  
McDANIEL & ASSOCIATES, PC  
jhurt@technologylitigators.com

Mark A.J. Fassold  
Jorge Mares  
WATTS GUERRA LLP  
mfassold@wattsguerra.com  
jmares@wattsguerra.com  
ReactiveSurfaces@wattsguerra.com

Rico Reyes  
RICO REYES LAW  
rico@ricoreyeslaw.com

PATENT OWNER:

Joshua A. Lorentz  
Richard Schabowsky  
John D. Luken  
Oleg Khariton  
DINSMORE & SHOHL LLP  
joshua.lorentz@dinsmore.com  
richard.schabowsky@dinsmore.com  
john.luken@dinsmore.com  
oleg.khariton@dinsmore.com