

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BMW OF NORTH AMERICA, LLC AND MERCEDES-BENZ USA, LLC,
Petitioner,

v.

STRAGENT, LLC,
Patent Owner.

IPR2021-00419
Patent 9,705,765 B2

Before STACEY G. WHITE, DANIEL J. GALLIGAN, and JASON M.
REPKO, *Administrative Patent Judges*.

WHITE, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 325(d)

I. INTRODUCTION

BMW of North America and Mercedes-Benz USA, LLC (collectively “Petitioner”), request institution of an *inter partes* review of claims 1–31 of U.S. Patent No. 9,705,765 B2 (Ex. 1001, “the ’765 patent”). Paper 1 (“Pet.”). Patent Owner Stragent, LLC, filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). Patent Owner also filed a Disclaimer (Ex. 2004) disclaiming claims 1–11 and 13–23. Paper 13.

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless the information presented in the petition “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons explained below, we do not institute an *inter partes* review in this proceeding.

A. Related Matters

The Board previously determined that all claims of U.S. Patent Nos 8,209,705 B2 (“the ’705 patent”) and 8,566,843 B2 (“the ’843 patent”) were unpatentable. *See* Pet. 1–3, 11–12. The previous IPRs involving the ’705 patent are IPR2017-00458, IPR2017-00676, IPR2017-01502, IPR2017-01521, and IPR2017-01522. Paper 5, 2. The previous IPRs involving the ’843 patent are IPR2017-00457, IPR2017-00677, IPR2017-01503, IPR2017-01504, IPR2017-01519, and IPR2017-01520.¹ *Id.* Patent Owner did not appeal these decisions. *See* Pet. 3. The ’765 patent claims priority to the ’843 patent and the ’705 patent through a chain of continuations. Ex. 1001, code (63).

¹ For convenience, the other IPRs will be referenced using the last three or four digits of the case followed by “IPR.” For example, “the 458 IPR” refers to IPR2017-00458, and “the 1522 IPR” refers to IPR2017-01522.

The '765 patent also has been asserted in the following matters: *Stragent, LLC v. BMW of North America, LLC, and BMW Manufacturing Co., LLC*, (C.A. No. 20-510-LPS) (D. Del); *Stragent, LLC v. Mercedes-Benz USA, LLC Mercedes-Benz Vans, LLC, Daimler Trucks North America, LLC, and Daimler North America Corp.* (C.A. No. 20-511-LPS) (D. Del), and *Stragent, LLC v. Volvo Car North America, LLC* (C.A. No. 20-512-LPS) (D. Del). Pet. 4; Paper 5, 1–2.

B. Statutory Disclaimer

Patent Owner filed a “Statutory Disclaimer of Claims 1–11 and 13–23 of U.S. Patent No. 9,705,765.” Paper 11; Ex. 2004. A “patent owner may file a statutory disclaimer under 35 U.S.C. 253(a) in compliance with §1.321(a) of this chapter, disclaiming one or more claims in the patent. No *inter partes* review will be instituted based on disclaimed claims.”

37 C.F.R. § 42.107(e) (2019). A disclaimer under 35 U.S.C. § 253(a) is “considered as part of the original patent” as of the date on which it is “recorded” in the Office. 35 U.S.C. § 253(a). For a disclaimer to be “recorded” in the Office, the document filed by the patent owner must:

- (1) Be signed by the patentee, or an attorney or agent of record;
- (2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;
- (3) State the present extent of patentee’s ownership interest in the patent; and
- (4) Be accompanied by the fee set forth in [37 C.F.R.] § 1.20(d).

37 C.F.R. § 1.321(a); *see also Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1382 (Fed. Cir. 1998) (holding that a § 253 disclaimer is immediately “recorded” on the date that the Office receives a disclaimer meeting the

requirements of 37 C.F.R. § 1.321(a), and that no further action is required in the Office). Based on our review of Exhibit 2004 and Office public records, we conclude that claims 1–11 and 13–23 have been disclaimed under 35 U.S.C. § 253(a) in compliance with 37 C.F.R. § 1.321(a), and thus, no *inter partes* review shall be instituted as to those claims. 37 C.F.R. § 42.107(e).

C. The '765 Patent

The '765 patent is titled “System, Method and Computer Program Product for Sharing Information in a Distributed Framework.” Ex. 1001, code (54). The purported invention of the '765 patent “may optionally apply to electronic vehicle communication and control systems, real-time monitoring systems, industrial automation and control systems, as well as any other desired system.” *Id.* at 1:27–31. Figure 1 is reproduced below.

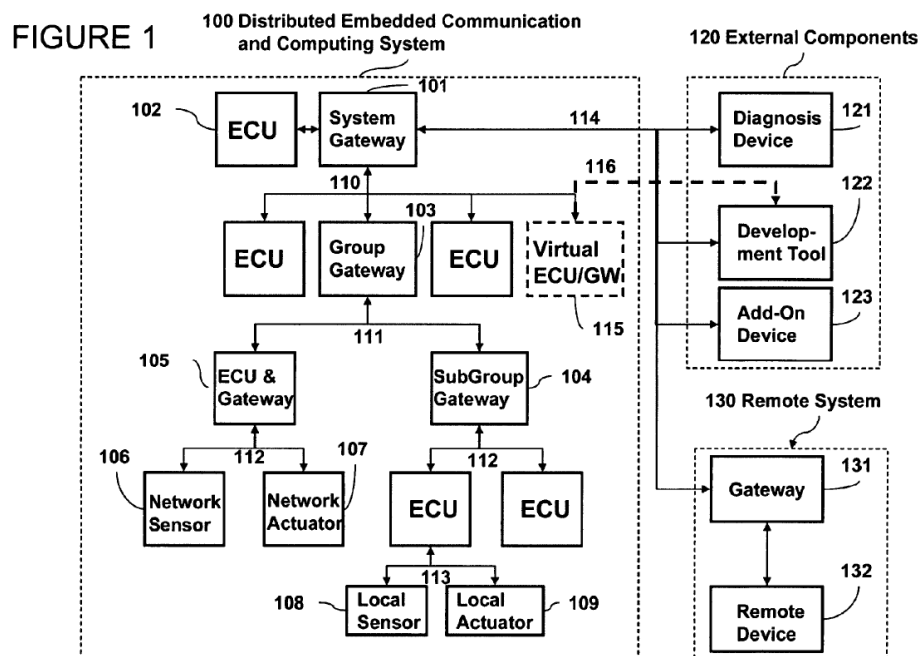


Figure 1 depicts elements of a distributed embedded communication and computing system. *Id.* at 3:19–20. In an automotive environment, electronic control units 102 (“ECUs”) control applications such as engine

control, brake control, or diagnostics through connections to various sensors and actuators organized into separate subnetworks. *Id.* at 3:22–27.

Applications are grouped into backbone system functions, such as “body control, power train, and chassis.” *Id.* at 3:29–31. Messages are relayed up and down through the system layers. *Id.* at 3:34–36. Each layer may contain multiple ECUs connected through wired serial multiplexing bus systems such as Controller Area Network (“CAN”), Local Interconnect Network (“LIN”), and Flexray. *Id.* at 3:37–42.

ECUs 102 “typically share information with devices that are connected on the same physical multiplexing system. This method of information sharing is called horizontal information sharing in a hierarchical system.” *Id.* at 3:61–66. In the alternative, a bulletin board may be used in a manner such that “information is shared, in real-time, among a plurality of heterogeneous processes.” *Id.* at 1:36–38. “[H]eterogeneous networks may refer to any different communication networks with at least one aspect that is different.” *Id.* at 7:43–45. Figure 7 is reproduced below.

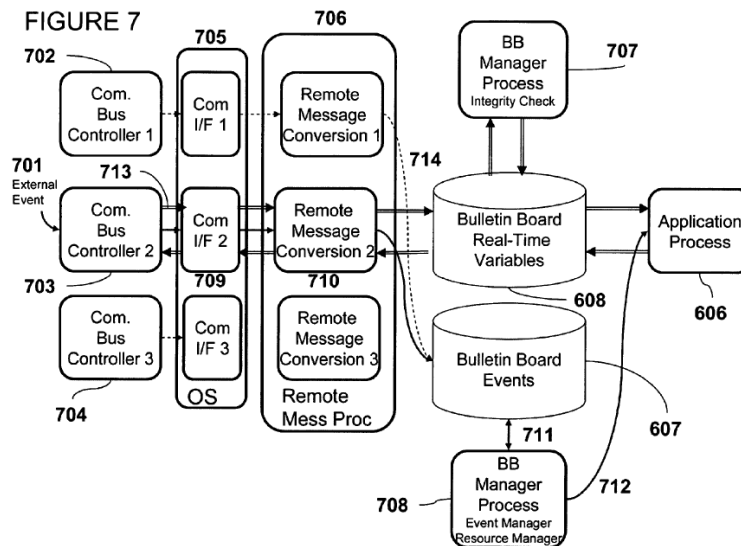


Figure 7 “illustrates the logical architecture of the interconnection between three heterogeneous network controllers (702, 703, 704), the

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