Trials@uspto.gov
571-272-7822

Paper No. 9
Entered: July 20, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMTECH MOBILE DATACOM CORPORATION,
Petitioner,

v.

VEHICLE IP, LLC,
Patent Owner.

Case IPR2018-00531
Patent 5,987,377

Before JAMES A. TARTAL, CARL M. DeFRANCO, and JAMES J. MAYBERRY, *Administrative Patent Judges*.

MAYBERRY, *Administrative Patent Judge*.

DECISION DENYING INSTITUTION
35 U.S.C. § 314(a)

I. INTRODUCTION

Petitioner, Comtech Mobile Datacom Corporation ("Comtech Mobile" or "Petitioner"), filed a Petition ("Pet.") requesting *inter partes* review of claims 1–34 (the "Challenged Claims") of U.S. Patent No. 5,987,337 (Ex. 1001, the "'377 patent"). Paper 2. Patent Owner, Vehicle IP, LLC ("Vehicle IP"), filed a Preliminary Response ("Prelim. Resp.") to the Petition. Paper 7.[1] We have jurisdiction under 35 U.S.C. § 314; *see also* 37 C.F.R. § 42.4(a) (permitting the Board to institute trial on behalf of the Director).

To institute an *inter partes* review, we must determine that the information presented in the Petition shows "a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a). Whether we institute trial, however, is discretionary. *See id.* For the reasons set forth below, upon considering the Petition, Preliminary Response, and evidence of record, we exercise our discretion not to institute trial in this proceeding.

A. Related Matters

The parties indicate that the '377 patent is the subject of an infringement suit in the U.S. District Court for the District of Delaware, in a case styled *Vehicle IP v. AT&T Mobility et al.*, No. 09-CV-1007-LPS (the "Delaware Action"). *See* Pet. 1; Paper 5, 2. The Delaware Action was the subject of a decision from the U.S. Court of Appeals for the Federal Circuit

[1] Our citations to the Preliminary Response are to the public version, which is Paper 7.

in Appeal 2013-1380, and is also the subject of a pending Federal Circuit appeal, Appeal 2017-2511. *See* Pet. 1–2; Paper 5, 2.

The Delaware Action was filed in 2009. Pet. 1. In 2011, the District Court construed certain claim terms. *See* Ex. 1011 (providing the court's claim construction order). The District Court granted the defendants' motions for summary judgment of non-infringement based on these constructions. *See Vehicle IP, LLC v. AT&T Mobility, LLC*, 594 F. App'x 636, 639 (Fed. Cir. 2014). The Federal Circuit reversed the District Court's construction of the terms "expected time of arrival" and "way point(s)," vacated the grant of summary judgment, and remanded the action to the District Court. *Id.* at 638.

After the action was remanded, the District Court further construed the term "dispatch" and, based on that construction, the parties stipulated that the defendants did not infringe the claims under that construction. Pet. 2; *see also* Ex. 1012 (providing the court's construction of "dispatch"). Patent Owner appealed the District Court's construction of the term "dispatch" to the Federal Circuit, where the appeal is still pending. Pet. 2.

B. The '377 Patent

The '377 patent, titled "Method and Apparatus for Determining Expected Time of Arrival," issued November 16, 1999, with claims 1–52. Ex. 1001, (54), (45), 14:62–22:30. The '377 patent is directed to a system that determines the expected time of arrival of a vehicle and employs a vehicle equipped with a mobile unit, a dispatch unit remote from the vehicle, and a communications link between the mobile unit and dispatch unit. *See id.* at 1:44–2:33.

Figure 2 of the ’377 patent is reproduced below.

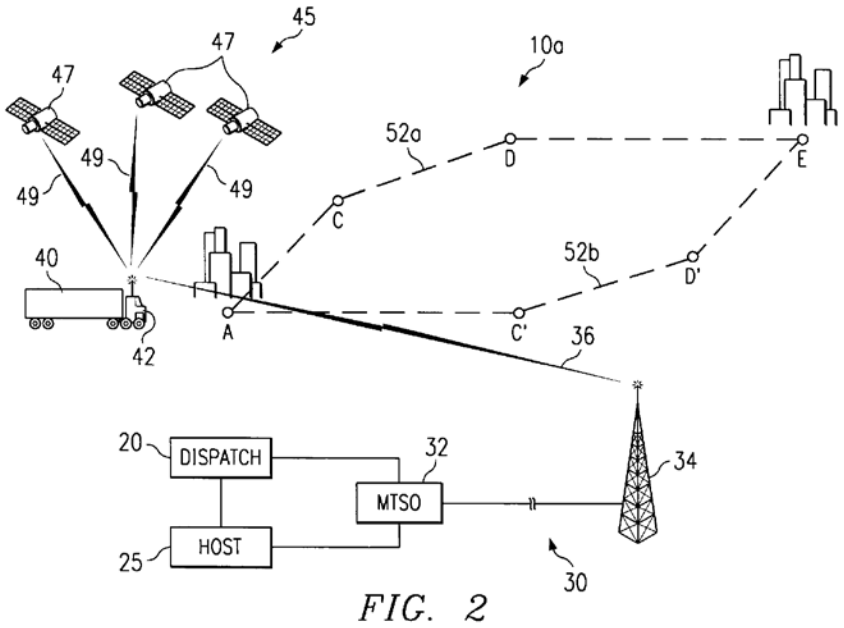

FIG. 2

Figure 2 depicts “a system for determining expected times of arrival at a plurality of destinations.” Ex. 1001, 2:43–44. System 10a of Figure 2 includes vehicle 40 travelling from point of origin A to multiple destinations (C, D, and E along route 52a or C′, D′, and E along route 52b). *See id.* at 2:59–61, 8:23–33. System 10a includes dispatch 20, host 25, communications link 30, and vehicle 40 with mobile unit 42. *See id.* at 2:61–63.

Dispatch 20 is remotely located from vehicle 40 and generates destination information for vehicle 40. Ex. 1001, 2:66–3:1. “[D]estination information may include one or more destinations, appointment information such as a corresponding appointment time for each destination specified, routing information, information regarding tasks to be performed at each destination specified, average travel time to each destination, rush hour and traffic information, [or] weather information.” *Id.* at 3:1–7. “Destination

information *may be any information generated by dispatch 20 that facilitates the control or monitoring of vehicle 40*." *Id.* at 3:7–9 (emphasis added).

Communications link 30 is coupled to dispatch 20 and mobile unit 42 and may be a cellular telephone network through transmitter 34. Ex, 1001, 3:34–41. As such, "[m]obile unit 42 receives the destination information generated by dispatch 20 for vehicle 40 over communications link 30." *Id.* at 4:58–60.

Mobile unit 42 determines its position using positioning system 45, such as a satellite-based radio navigation system. Ex. 1001, 5:17–19. "In response to the vehicle position, mobile unit 42 determines the expected time of arrival of vehicle 40 at the destination identified by the destination information received from dispatch 20 over communications link 30." *Id.* at 5:53–56. Dispatch 20 configures the time interval between mobile unit 42 calculating expected times of arrival. *Id.* at 6:8–9. The system supports remote sending of destination information to vehicle 40 from dispatch 20, such that destination information is sent directly to mobile unit 42, rather than input by the operator of vehicle 40. *See id.* at 6:40–63.

C. Challenged Claims

Of the Challenged Claims, claims 1, 12, and 23 are independent claims. Ex. 1001, 14:62–15:13, 15:48–63, 16:29–41. Significant to our decision here, all of the independent claims recite a "dispatch." *See id.* Claim 1 is reproduced below.

> 1. A system for determining an expected time of arrival of a vehicle equipped with a mobile unit, comprising:

> a dispatch remotely located from the vehicle, the dispatch operable to generate destination information for the vehicle, the destination information specifying a plurality of way points;
>
> a communications link coupled to the dispatch, the communications link operable to receive the destination information for the vehicle from the dispatch; and
>
> the mobile unit coupled to the communications link, the mobile unit operable to receive from the communications link the destination information for the vehicle generated by the dispatch, the mobile unit further operable to determine a vehicle position, the mobile unit further operable to determine in response to the vehicle position the expected time of arrival of the vehicle at a way point identified by the destination information and wherein the communications link comprises a cellular telephone network.

Ex. 1001, 14:62–15:13.

D. The Applied References

Comtech Mobile's asserted grounds of unpatentability for the Challenged Claims rely on the following references:

Behr	US 5,543,789	Aug. 6, 1996	Ex. 1002
Sprague	US 5,422,816	June 6, 1995	Ex. 1003
Gazis	US 5,610,821	Mar. 11, 1997	Ex. 1004
Schweiger	"Advanced Public Transportation Systems: The State of the Art, Update '94"	Jan. 1994	Ex. 1006
Dana	GPS World, "The Role of GPS in Precise Time and Frequency Dissemination"	July/Aug. 1990	Ex. 1033

Comtech Mobile also relies on the declaration testimony of Dr. James Olivier. *See* Ex. 1005.

E. Asserted Grounds of Unpatentability

Comtech Mobile asserts that (1) claims 1–3, 6–10, 12–14, 17–21, 23–26, and 29–32 are unpatentable under 35 U.S.C. § 103 over Behr, Sprague, and Dana; (2) claims 4, 5, 15, 16, 27, and 28 are unpatentable under 35 U.S.C. § 103 over Behr, Sprague, Dana, and Gazis; and (3) claims 11, 22, 33, and 34 are unpatentable under 35 U.S.C. § 103 over Behr, Sprague, Dana, and Schweiger. Pet. 15, 50, 60–61.

F. Overview of the Applied References

The Petition relies on five prior art references in its asserted grounds of unpatentability—Behr, Sprague, Gazis, Schweiger, and Dana. As will be evident from our analysis below, in Section II, we need discuss the Behr reference only.

Behr, titled "Computerized Navigation System," issued August 6, 1996, from an application filed June 24, 1994. Ex. 1002, (54), (45), (22). Behr is generally directed to a system that provides navigation route guidance information from a base unit to a mobile unit. *Id.* at 2:50–52.

Behr's system 10 includes base unit 12, preferably located at a central location, and multiple remote units 14, which "may include any number of mobile units." Ex. 1002, 6:67–6:7. "[S]ystem 10 provides geo-referenced information over wireless and wireline devices to mobile and remote users," including over a cellular telephone network. *Id.* at 7:36–38.

"[B]ase unit 12 includes an I/O interface 62, a query resolver 64, a route calculator 66, a distance and time travel estimator 68, a surroundings

explorer 70, a map database 72 and a third party data integrator 80." Ex. 1002, 7:55–58. I/O interface 62 couples base unit 12 to wireless and wireline communications systems. *Id.* at 7:58–61. I/O interface 62 receives queries from remote units 14 and transmits responses from base unit 12 to the remote units. *Id.* at 8:30–32. Base unit 12 includes query resolver 64, which interprets requests from remote units 14. *Id.* at 8:37–47. One such request may be a request for a route to a destination from a specific location or the remote unit's current location. *See id.* at 8:33–36.

Route calculator 66 determines the route from a specified origin to a specified destination using map database 72 at base unit 12. Ex. 1002, 8:48–52. "[R]oute calculator 66 thus forms a calculating means at the base unit for calculating a route between the origin and the destination." *Id.* at 9:1–3. Significant to our analysis here, the origin and route are specified by remote unit 14 and sent to base unit 12 in query message 120. *Id.* at 10:47–50; *see also* Fig. 3 (depicting query message structure). Specifically, query message 120 includes origin field 140 and destination field 144. *Id.* at 12:44–55. Origin field 140 may be empty and the current position of the mobile unit is used in calculating a route. *Id.* at 12:46–48. Destination field 144 specifies the destination address if routing information is requested by the mobile unit from base unit 12. *Id.* at 12:53–55.

In response to query message 120, system 10 provides response message 160. *See* Ex. 1002, 11:19–22, 13:51–52, Fig. 4 (showing the format of response message 160). If route guidance information was requested in the query, response message 160 includes a set of driving instructions including, if requested, maneuver arms. *Id.* at 15:25–34.

Maneuver arms provides detailed maneuvers at intersections along a determined route. *Id.* at 13:35–36, 13:64–14:11.

II. ANALYSIS

A. Our Discretion under U.S.C. § 314(a)

Our authority to institute an *inter partes* review is derived ultimately from 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition shows "there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." This authority to institute an *inter partes* review is discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) ("[T]he [Board] is permitted, but never compelled, to institute an IPR proceeding."); *see also Cuozzo Speed Techs., LLC v. Lee*, 136 S.Ct. 2131, 2140 (2016) ("[T]he agency's decision to deny a petition is a matter committed to the Patent Office's discretion. See [5 U.S.C.] § 701(a)(2); 35 U.S.C. § 314(a) (no mandate to institute review).") (additional citation omitted).

"The purpose of the 'America Invents Act,' as reported by the Committee on the Judiciary, is to . . . establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs." H.R. REP. 112-98, 40; *see also id.* at 39–40 ("The voices heard during the debate . . . have focused the Committee's attention on . . . improving patent quality and providing a more efficient system for challenging patents that should not have issued; and reducing unwarranted litigation costs and inconsistent damage awards.").

Mindful of these goals for *inter partes* reviews, as we explain in greater detail below, we exercise our discretion not to institute an *inter partes* review of the Challenged Claims.

1. Effect of pending Federal Circuit appeal on claim construction

The proper construction of the claim term "dispatch" is a central issue in this proceeding. Indeed, as explained above, the same issue was litigated before the District Court and is currently pending on appeal before the Federal Circuit. Further, both parties recognize that the '377 patent has expired, therefore, we would be required to apply a *district court-type* claim construction approach in this proceeding. Pet. 4; Prelim. Resp. 2; *see also In re Rambus, Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012) ("[T]he Board's review of the claims of an expired patent is similar to that of a district court's review."); *see also Black & Decker, Inc. v. Positec USA, Inc., 646* Fed. Appx. 1019, 1024 (Fed. Cir. 2016) (holding that in an *inter partes* review, "[c]laims of an expired patent are given their ordinary and customary meaning in accordance with our opinion in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc)").

In its Petition, Comtech Mobile provides explicit claim constructions for certain claim terms, including "dispatch." Pet. 9–13. Vehicle IP does not offer any explicit claim constructions.

The proper construction of "dispatch" was litigated in the Delaware Action and is central to the appeal now pending before the Federal Circuit. In particular, Vehicle IP first asserted that the term "dispatch" should be construed to mean "a computer-based communication and processing system remotely located from the vehicle." Ex. 1011, 11. The District Court

construed the term "dispatch" to mean "a computer-based communication and processing system remotely located from the vehicle that manages and monitors vehicles." Ex. 1011, 11; Pet. 9. On remand, Vehicle IP contended that the term "dispatch" should be construed to mean "computer-based communication and processing system remotely located from the vehicle that manages and monitors vehicles," and further contended that the phrase "manages vehicles" means "generates and provides information that facilitates or directs the vehicle's movement along the travel route" and the phrase "monitors vehicles" means "receives and processes information relating to the vehicle's status or position along the travel route." Ex. 1012, 5. The District Court modified its construction of "dispatch" to mean "a computer-based communication and processing system remotely located from the vehicle that supervises and controls vehicles to a destination *specified exclusively by the computer-based system*." Ex. 1012, 5 (emphasis added); Pet. 10.[2] Vehicle IP has appealed the District Court's construction of the term "dispatch." *See* Ex. 1013.

In its Petition, Comtech Mobile does not propose that we adopt the district court's construction of "dispatch." Instead, Comtech Mobile contends that we should construe the term "dispatch" as asserted by Vehicle IP during the Delaware Action— "a computer-based communication and

[2] This modification was not based on any determination at the Federal Circuit. *See Vehicle IP, LLC*, 594 F. App'x at 640–44 (addressing the terms "expected time of arrival" and "way point(s)" only). Instead, the modification was based on the court's recognition that further construction of the term may be warranted based on the parties' positions. *See* Ex. 1012, 1.

processing system remotely located from the vehicle that generates and provides information that facilitates or directs the vehicle's movement along the travel route and receives and processes information relating to the vehicle's status or position along the route." Pet. 10. Comtech Mobile argues that the term "dispatch" should be construed no more narrowly than Vehicle IP argued in its infringement suit, and, as such, asks us not to apply the District Court's construction. *Id.*

Petitioner's claim construction contentions strongly warrant against institution of *inter partes* review because the construction of "dispatch" is both pending on appeal before the Federal Circuit and potentially dispositive in this case. As we discussed above in connection with our overview of Behr, in Behr's system, the alleged mobile unit (remote unit 14), and not the alleged dispatch (base unit 12), specifies the destination. Such a system appears to be outside the scope of the claimed "dispatch" under the District Court's construction, which requires the destination to be specified exclusively by the dispatch. Were we to construe the term "dispatch," we would be deciding a disputed legal issue that is already currently before our reviewing court for resolution. As such, instituting trial in this proceeding would not be an efficient use of the Board's resources.

2. Other considerations

As we discussed above in connection with our description of the Delaware Action, the litigation involving the '377 patent has been ongoing since 2009 and is on its second trip to the Federal Circuit. As such, instituting an *inter partes* review would not afford a cost-effective alternative to litigation involving the '377 patent that would "limit

unnecessary and counterproductive litigation costs." *See* H.R. REP. 112-98, 40.

Also, Comtech Mobile has not been sued for infringement of the '377 patent. Accordingly, the time bar under 35 U.S.C. § 315(b) is not implicated presently. Comtech Mobile would likely have the opportunity to refile a petition after the Federal Circuit has resolved the claim construction of the term "dispatch" should it so desire. Also, Vehicle IP has offered Comtech Mobile and its customers a covenant not to sue for the '377 patent, which, if accepted, would appear to limit any liability that Comtech Mobile may have from infringing the '377 patent prior to the patent's expiration. *See* Prelim. Resp. 8; *see also id.* at 7 ("Because Petitioner's geoOps Enterprise Location Management System does not determine an ETA (and neither Petitioner nor Patent Owner alleges otherwise), it cannot possibly infringe the '377 [p]atent."). Although we recognize that Comtech Mobile may be denied its opportunity to challenge claims from the '377 patent at a time of its choosing, we determine that this disadvantage to Comtech Mobile is outweighed by those considerations weighing against institution.

Further, as the '377 patent has expired, the benefit of *inter partes* review to "challeng[e a] patent[] that should not have issued" is lessened in this particular case. *See* H.R. REP. 112-98, 39–40.

3. Conclusions

In light of the current status of the Delaware Action before the Federal Circuit with respect to the construction of the term "dispatch" and the long history of the Delaware Action, we determine that it is proper for us to exercise our discretion and not institute trial in this proceeding. We would

be inserting ourselves into a dispute that has played out in the courts since 2009 and we would be required to address issues that likely will be resolved by the Federal Circuit before our proceeding is complete, which we find to be an inefficient use of our resources. Also, since the time bar under 35 U.S.C. § 315(b) is not presently implicated in this case, we discern no significant prejudice to Comtech Mobile as a result of our decision not to institute trial in this proceeding.

III. CONCLUSION

After considering the evidence and arguments presented in the Petition, including its supporting testimonial evidence, and Preliminary Response, we exercise our discretion under 35 U.S.C. § 314(a) not to institute trial in this proceeding.

IV. ORDER

After due consideration of the record before us, it is:

ORDERED that the Petition is *denied* as to all challenges and no trial is instituted.

For PETITIONER:

Bing Ai
John P. Schnurer
Kevin Patariu
Evan S. Day
PERKINS COIE LLP
ai-ptab@perkinscoie.com
jschnurer@perkinscoie.com
kpatariu@perkinscoie.com
eday@perkinscoie.com

For PATENT OWNER:

Craig A. Deutsch
FISH & RICHARDSON P.C.
deutsch@fr.com