

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TOYOTA MOTOR CORPORATION,  
Petitioner

v.

AMERICAN VEHICULAR SCIENCES LLC,  
Patent Owner

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Case IPR2013-00424  
Patent 5,845,000

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Before JAMESON LEE, TREVOR M. JEFFERSON,  
and BARBARA A. PARVIS, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

Order  
Conduct of Proceedings  
*37 C.F.R. § 42.05*

## Introduction

On May 7, 2014, a conference call was held between Judges Lee, Kim, and Pettigrew, and respective counsel for the parties. Counsel for Patent Owner initiated the conference call to ask the Board to limit the cross-examination of its expert witness Chris Koutsougeras, Ph.D., by prohibiting questions directed to whether the feature of trained pattern recognition would have been obvious to one with ordinary skill in the art based on U.S. Patent 6,553,130 (“Lemelson”).

The dispute relating to the scope of cross-examination arose, on May 5, 2014, during cross-examination of the expert. Counsel for Patent Owner instructed the witness not to answer and sought to reach the Board to request an order to limit the cross-examination. It was approximately 6:00 PM on May 5, 2014, and the parties were unable to reach an administrative patent judge at that time. Cross-examination continued on unrelated matters and then was completed but for the line of questions in dispute. On May 6, 2014, the parties requested a telephone conference with the Board, to be held on May 7, 2014. If the Board denies Patent Owner’s request to limit the cross-examination testimony of Dr. Koutsougeras, further cross-examination of the witness would follow.

We grant the request of Patent Owner to limit the questioning of Dr. Koutsougeras, on cross-examination, by barring questions inquiring about the witness’s opinion on the obviousness to one with ordinary skill in the art of the trained pattern recognition claim feature in light of Lemelson.

## Discussion

The parties do not dispute that in all of the alleged grounds of unpatentability instituted for trial, that involve Lemelson, Petitioner in its petition relies on Lemelson as disclosing the claim feature of trained pattern recognition, not as rendering obvious that feature. According to counsel for Petitioner,

however, obviousness, inherent disclosure, and the understanding of one with ordinary skill in the art as to the disclosure of Lemelson, are inter-mingled as one integral discoverable topic. We disagree. Counsel for Petitioner knows the difference between the separate concepts of inherent disclosure, understanding of the teachings of a reference, and obviousness in view of a reference. Indeed, counsel for Petitioner acknowledged that he asked the question in three “different ways” to get an assortment of “different perspectives” on the subject. Counsel for Patent Owner raised an objection only for questions directed to the witness’s opinion on obviousness of the feature in light of Lemelson’s disclosure.

We are unpersuaded that inherent disclosure, understanding of what a reference discloses, and obviousness are all one and the same topic. Based on the specific grounds instituted for trial and the arguments made in the petition, as well as the absence of specific testimony in the declaration of Dr. Koutsougeras (Ex. 2002) pertaining to non-obviousness of the trained pattern recognition feature to one with ordinary skill in the art, counsel for Petitioner had no sufficient reason to inquire, on cross-examination, the opinion of Dr. Koutsougeras as to whether the trained pattern recognition feature would have been obvious to one with ordinary skill.

#### Order

It is

ORDERED that Patent Owner’s request that we limit the cross-examination of Dr. Koutsougeras by precluding questions directed to whether the claimed feature of trained pattern recognition would have been obvious to one with ordinary skill is *granted*; and

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FURTHER ORDERED that cross-examination of Dr. Koutsougeras by counsel for Petitioner shall not include questions asking for the opinion of Dr. Koutsougeras on whether the claimed feature of trained pattern recognition would have been obvious to one with ordinary skill in the art.

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