

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SMR AUTOMOTIVE SYSTEMS USA, INC.,
Petitioner,

v.

MAGNA MIRRORS OF AMERICA, INC.,
Patent Owner.

Case IPR2018-00517
Patent 8,128,244 B2

Before SALLY C. MEDLEY, JESSICA C. KAISER, and
SCOTT E. BAIN, *Administrative Patent Judges*.

BAIN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

I. INTRODUCTION

SMR Automotive Systems USA, Inc. (“Petitioner”)¹ filed a Petition for *inter partes* review of claims 1–26 of U.S. Patent No. 8,128,244 B2 (Ex. 1001, “the ’244 patent”). Paper 2 (“Pet.”). Magna Mirrors of America, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). Institution of an *inter partes* review is authorized, though not required, by statute when “the information presented in the petition . . . and any response . . . 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.” 35 U.S.C. § 314(a). We have considered the Petition, the Preliminary Response, and accompanying exhibits submitted by the parties. For the reasons set forth herein, we decline to institute *inter partes* review of claims 1–26 of the ’244 patent.

A. Related Matters

The parties indicate that the ’244 patent is the subject of *Magna Mirrors of America, Inc. v. Samvardhana Motherson Reflectec Group Holdings Ltd.*, Case No. 1:17-cv-00077-RJJ-PJG (W.D. Mich.). Pet. 3; Paper 5, 1. The parties also identify numerous other petitions for *inter partes* review filed by Petitioner challenging claims of patents related to the ’244 patent:

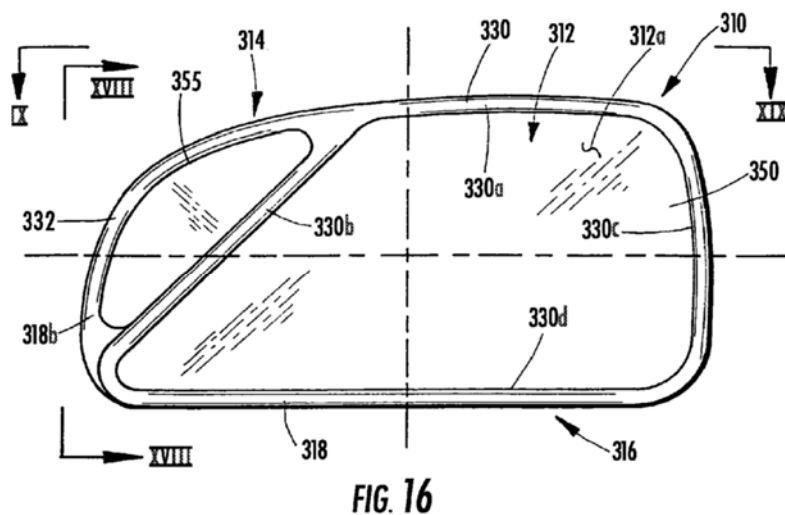
¹ Petitioner identifies itself and the following additional entities as the real parties-in-interest: Samvardhana Motherson Reflectec Group Holdings Ltd., SMR Automotive Mirror Parts and Holdings UK Limited, SMR Mirrors UK Limited, SMR Automotive Mirrors UK Limited, SMR Automotive Mirror Systems Holding Deutschland GmbH, SMR Automotive Mirrors Stuttgart GmbH, SMR Automotive Vision Systems Mexico S.A. de C.V., and SMR Automotive Servicios Mexico S.A. de C.V. Pet. 2–3.

IPR2018-00491	U.S. Patent No. 7,934,843 B2
IPR2018-00505	U.S. Patent No. 8,147,077 B2
IPR2018-00506	U.S. Patent No. 8,591,047 B2
IPR2018-00520	U.S. Patent No. 8,267,534 B2
IPR2018-00533	U.S. Patent No. 8,783,882 B2
IPR2018-00536	U.S. Patent No. 8,550,642 B2
IPR2018-00541	U.S. Patent No. 8,899,762 B2
IPR2018-00545	U.S. Patent No. 9,694,750 B2
IPR2018-00931 ²	U.S. Patent No. 8,128,243 B2

Pet. 3; *see also* Paper 5, 1.

B. The '244 Patent

The '244 patent is directed to an exterior sideview mirror. Ex. 1001, Abstract. The mirror includes a plano reflective element and an auxiliary reflective element mounted adjacent to each other in a side-by-side relationship. *Id.* Figure 16 of the '244 patent, reproduced below, is illustrative of the invention:



² See IPR2018-00931, Paper 1, 3.

Figure 16 depicts an embodiment of a plano reflective element assembly. As indicated in Figure 16, plano-auxiliary reflective element assembly 310 includes a first reflective element 312 and an auxiliary reflective element 314 supported in frame assembly 316. *Id.* at 15:60–63. Reflective element 312 comprises a plano reflective element 350, such as a flat reflector coated glass substrate. *Id.* at 16:20–22. Reflective element 314 comprises a radiused reflective element, preferably, a multiradiused reflective element 355 having a multiradiused curvature. *Id.* at 17:45–47.

C. Illustrative Claim

Petitioner challenges all claims (i.e., claims 1–26) of the '244 patent. Claims 1, 23, and 25 are independent. Claim 1 is reproduced below (with Petitioner's notations included for clarity).

1. An exterior sideview mirror system suitable for use on an automobile, said exterior sideview mirror system comprising:

[a] an exterior sideview mirror assembly adapted for attachment to a side of an automobile;

[b] said exterior sideview mirror assembly including a reflective element having a rearward field of view when attached to the side of the automobile;

[c] said reflective element attached to an electrically-operated actuator of said exterior sideview mirror assembly and movable by said actuator in order to position said rearward field of view to a driver-desired position when said exterior sideview mirror assembly is attached to the side of the automobile;

[d] wherein said reflective element comprises a plano-auxiliary reflective element assembly, said plano-auxiliary reflective element assembly comprising a plano reflective element having unit magnification and a separate auxiliary reflective element having a curvature;

[e] said plano reflective element and said auxiliary reflective element of said plano-auxiliary reflective element assembly mounted adjacently at said planoauxiliary reflective element assembly in a side-by-side relationship and not superimposed with one reflective element on top of the other reflective element;

[f] said plano reflective element and said auxiliary reflective element supported at a backing plate element, said backing plate element mounting to said actuator such that movement of said backing plate element of said planoauxiliary reflective element assembly by said actuator simultaneously and similarly moves said plano reflective element and said auxiliary reflective element;

[g] said auxiliary reflective element having a wide-angle field of view encompassing a blind spot in the side lane adjacent the side of the automobile to which said exterior sideview mirror assembly is attached;

[h] said backing plate element having a first support portion supporting said plano reflective element and a second support portion supporting said auxiliary reflective element;

[i] wherein said auxiliary reflective element is positioned at an outboard portion of said plano-auxiliary reflective element assembly when said exterior sideview mirror assembly is mounted to the side of the automobile;

[j] wherein said backing plate element comprises a polymeric substrate that is formed as a single element by injection molding of a polymeric resin;

[k] wherein said backing plate element is capable of supporting said plano reflective element and said auxiliary reflective element;

[l] wherein said first support portion of said backing plate element comprises a flat portion and wherein said plano reflective element is disposed at said flat portion;

[m] wherein said second support portion of said backing plate element comprises a curved portion and wherein said auxiliary reflective element is disposed at said curved portion;

[n] wherein the rearward field of view of said auxiliary reflective element is different from and angled to the rearward field of view of said plano reflective element when both are attached to said backing plate element of said planoauxiliary reflective element assembly when said plano-auxiliary reflective element assembly is included in said exterior sideview mirror assembly and when said exterior sideview mirror assembly is attached to the side of the automobile;

[o] wherein angling of the rearward field of view of said auxiliary reflective element relative to the rearward field of view of said plano reflective element is achieved, at least in part, by an angling of said second support portion of said backing plate element supporting said auxiliary reflective element relative to said first support portion of said backing plate element supporting said plano reflective element;

[p] wherein, when said exterior sideview mirror assembly is attached to the side of the automobile, the field of view of said plano reflective element generally views rearwardly of the equipped automobile and the field of view of said auxiliary reflective element generally views towards a blind spot in the side lane adjacent the side of the automobile to which said exterior sideview mirror assembly is attached, said blind spot being generally outside the rearward field of view of said plano reflective element when said plano reflective element is viewed by a driver of the equipped automobile when said exterior sideview mirror assembly is attached to the side of the automobile;

[q] wherein at least one of said plano reflective element and said auxiliary reflective element comprises one of (a) a glass substrate having a surface coated with a metallic reflector coating and (b) a polymeric substrate having a thin glass element applied to a surface thereof and with an opposing surface thereof having a reflecting layer applied thereto;

[r] wherein said plano reflective element and said auxiliary reflective element are adjacently supported at said backing plate element at a joint, and wherein said plano-auxiliary reflective element assembly includes a demarcation element, said demarcation element disposed at said joint to form a demarcation

between said plano reflective element and said auxiliary reflective element, said demarcation element having a portion visible to a driver of the automobile when said exterior sideview mirror assembly is attached to the side of the automobile;

[s] wherein at least a portion of said auxiliary reflective element adjacent said plano reflective element has its front surface generally coplanar with the front surface of said plano reflective element;

[t] wherein said demarcation element is dark colored;

[u] wherein said demarcation element comprises a polymer material;

[v] wherein said joint comprises a space between said plano reflective element and said auxiliary reflective element;

[w] wherein said demarcation element is at least partially disposed at said space between said plano reflective element and said auxiliary reflective element; and

[x] wherein said demarcation element comprises a wall on said backing plate element, said wall located on said backing plate element at said joint, said wall disposed between said plano reflective element and said auxiliary reflective element.

Pet. 81–83; Ex. 1001, 27:58–29:44.

D. Asserted Grounds of Unpatentability

Petitioner asserts that claims 1–26 are unpatentable based on the following grounds (Pet. 4–5):

Reference(s)	Basis	Challenged Claims
The '026 publication ³	§ 102	1–26
Henion, ⁴ Platzer, ⁵ and Catlin ⁶	§ 103(a)	23–26

II. DISCUSSION

A. Claim Construction

In an *inter partes* review, we construe claim terms in an unexpired patent according to their broadest reasonable construction in light of the specification. 37 C.F.R. § 42.100(b). Consistent with the broadest reasonable construction, claim terms are presumed to have their ordinary and customary meaning as understood by a person of ordinary skill in the art in the context of the entire patent disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

Petitioner proposes a construction for “side-by-side.” Pet. 7–8. Patent Owner proposes a construction for “generally views towards a blind spot,” Prelim. Resp. 37–41, and a construction for “backing plate,” *id.* at 42–46. For purposes of this decision, however, we need not expressly construe

³ U.S. Patent Application Publication No. 2002/0072026 A1, filed Dec. 20, 2000, published June 13, 2002 (Ex. 1011, “the '026 publication”).

⁴ PCT International Publication No. WO 01/44013 A1, pub. June 21, 2001 (Ex. 1012, “Henion”).

⁵ PCT International Publication No. WO 01/81956 A1, pub. Nov. 1, 2001 (Ex. 1013, “Platzer”).

⁶ U.S. Patent No. 5,721,646, issued Feb. 24, 1998 (Ex. 1034, “Catlin”).

any claim term. *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (holding that “only those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy”); *see also Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs.* in the context of an *inter partes* review).

B. Principles of Law

To establish anticipation, each and every element in a claim, arranged as recited in the claim, must be found in a single prior art reference. *See Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008); *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001). Although the elements must be arranged or combined in the same way as in the claim, “the reference need not satisfy an *ipsissimis verbis* test,” i.e., identity of terminology is not required. *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009) (*accord In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990)).

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when in evidence, objective

evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

C. The Level of Ordinary Skill

In determining the level of ordinary skill in the art, various factors may be considered, including the “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (citation omitted). We also are mindful that the level of ordinary skill in the art is reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978).

Petitioner relies on the testimony of Dr. Jose Sasian, who testifies that a person with ordinary skill in the art “will have had at the time of [the] invention a M.Sc. degree in Optics, Optical Engineering, or similar studies in a related field (e.g., Physics or Mechanical Engineering) with 2–3 years of experience in the optics/mechanical industry.” Ex. 1002 ¶ 18. Dr. Sasian further testifies that his description is approximate and “a higher level of education or skill may make up for less experience, and vice-versa.” *Id.* Patent Owner relies on the testimony of Mr. Michael Nranian, who disagrees with Dr. Sasian’s assessment and testifies that a person with ordinary skill in the art “would have had a M.S. in an engineering discipline relevant to automotive component design (e.g., electrical engineering, mechanical engineering, or optical engineering), as well as 2–3 years of experience in the automotive industry designing components for automobiles.” Ex. 2001 ¶ 26.

The levels of ordinary skill proposed by the parties differ primarily regarding work experience. Mr. Nranian's description of the person of ordinary skill in the art requires a person to have had two to three years of experience in the automotive industry designing components for automobiles. Dr. Sasian's description of the person of ordinary skill in the art, in contrast, requires the hypothetical person to have had two to three years of experience in the optics/mechanical industry. Moreover, Dr. Sasian testifies that additional education can compensate for less work experience.

Based on the record before us, we determine Dr. Sasian's description of a person of ordinary skill in the art to be the more accurate one. His description of the level of skill in the art is more inclusive and reflective of the prior art of record, as opposed to Mr. Nranian's description. *See, e.g.*, Ex. 1001, 1:25–32 (citing U.S. Pat. Nos. 4,737,188; 4,944,581; and 5,483,386 (none of which are directed to only automobile mirrors, but directed to mirror elements in general)).

D. Dr. Sasian Is Qualified To Testify

Patent Owner argues that Dr. Sasian is “not qualified” to testify regarding what would have been known to a person of ordinary skill in the art, and that his “unqualified” testimony is entitled to little weight, because Dr. Sasian does not have experience in the automotive industry. Prelim. Resp. 48–50. Patent Owner further argues that the problems addressed by the '244 patent “would not be familiar to a person with an optics degree” such as Dr. Sasian. *Id.* at 49.

As explained above, however, we do not agree that a person having ordinary skill in the art at the time of the invention must have had two to three years of experience in the automotive industry designing components

for automobiles. Moreover, Dr. Sasian has significantly more experience and education than acknowledged by Patent Owner, including industry experience and involvement in projects that included automotive optics. Ex. 1002 ¶¶ 2–12. Dr. Sasian’s qualifications and experience are sufficient to qualify him as an expert in the pertinent field under Federal Rule of Evidence 702. *Id.* Accordingly, we determine Dr. Sasian is qualified to testify as to the matters before us.

Moreover, it is within our discretion to assign the appropriate weight to be accorded evidence. *See* 37 C.F.R. § 42.65(a); *see also, e.g., Yorkey v. Diab*, 601 F.3d 1279, 1284 (Fed. Cir. 2010) (holding the Board has discretion to give more weight to one item of evidence over another “unless no reasonable trier of fact could have done so”); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1368 (Fed. Cir. 2004) (“[T]he Board is entitled to weigh the declarations and conclude that the lack of factual corroboration warrants discounting the opinions expressed in the declarations.”); *Velandier v. Garner*, 348 F.3d 1359, 1371 (Fed. Cir. 2003) (“In giving more weight to prior publications than to subsequent conclusory statements by experts, the Board acted well within [its] discretion.”). Based on the record before us, we reject Patent Owner’s argument that we should give the entirety of Dr. Sasian’s declaration little weight.

*E. Asserted Anticipation of
Claims 1–26 by the ’026 Publication*

1. Overview

Petitioner contends that claims 1–26 are unpatentable under 35 U.S.C. §§ 102(a), (b), and (e) as anticipated by the ’026 publication. Pet. 35–50. The ’026 publication is a United States Patent Application Publication, filed December 20, 2000 and published June 13, 2002. Ex. 1011, 1. The ’026

publication lists Niall R. Lynam, John O. Lindahl, and Hahns Y. Fuchs as inventors. *Id.* The application that issued as the '244 patent was filed March 24, 2011, lists Niall R. Lynam as the sole inventor, and includes the following statement of "Related U.S. Application Data" (Ex. 1001, 1):

Division of application No. 12/851,045, filed on Aug. 5, 2010, now Pat. No. 7,934,843, which is a continuation of application No. 12/197,666, filed on Aug. 25, 2008, now Pat. No. 7,842,154, which is a division of application No. 10/709,434, filed on May 5, 2004, now Pat. No. 7,420,756. [] Provisional application No. 60/471,872, filed on May 20, 2003.

Petitioner's anticipation challenge relies upon two alternative contentions. First, Petitioner contends that the '026 publication is prior art under 35 U.S.C. § 102(b) because the '244 patent only is entitled "to the actual filing date of its ancestor U.S. Patent No. 7,934,843" (Ex. 1008, "the '843 patent"), i.e., August 5, 2010, which is well over one year after the '026 publication date, i.e., June 13, 2002. Pet. 9. Petitioner explains that the '244 patent is not entitled to any effective filing date earlier than the '843 patent filing date because the immediate parent application of the '843 patent (Ex. 1014, U.S. Patent Application No. 12/197,666 ("the '666 application")) "does not provide written description support for the '244 patent's claims." *Id.*

Second, Petitioner alternatively contends that the '026 publication is prior art under 35 U.S.C. §§ 102(a) and 102(e), because the '026 publication is "by another" and was published on June 13, 2002, prior to the earliest alleged effective filing date of the '244 patent. Pet. 8. Petitioner asserts that the '026 publication is "by another" because it names three inventors (Lindahl, Fuchs, and Lynam) whereas the '244 patent names just one (Lynam). *Id.*

Patent Owner responds that each of the foregoing issues were considered by the Patent Office repeatedly during prosecution of the '244 patent and its family, and, therefore, we should deny institution under 35 U.S.C. § 325(d). Prelim. Resp. 11–17, 24–27.

For the reasons that follow, we determine that the Patent Office considered during prosecution both (1) whether the '244 patent is entitled to a May 20, 2003 filing date, and (2) whether the '026 publication qualifies as prior art under 35 U.S.C. §§ 102(a) and (e) because it is not the work of another. We, therefore, exercise our discretion under 35 U.S.C. § 325(d) to decline review on Petitioner's anticipation challenge.

*2. Prosecution of the '843 patent and the '244 patent*⁷

The '843 patent is the parent to the '244 patent and also lists Niall R. Lynam as the sole inventor. Ex. 1008, 1.⁸ During prosecution of the application that issued as the '843 patent, the Examiner initially found that the claims were not entitled to the benefit of any earlier filing date. Ex. 1009, 139–141. Based on that finding, the Examiner rejected claims 1–23 and 27–39 under 35 U.S.C. § 102(b) as anticipated by the '026 publication and rejected claims 24–26 under 35 U.S.C. § 103(a) as obvious over the '026 publication in view of another reference. *Id.* at 141–155.

In response to the Examiner's rejections, the Applicant argued that the '026 publication was not prior art under 35 U.S.C. § 102(b) because the application was entitled to an effective filing date of May 20, 2003, as “[t]he

⁷ Petitioner provides a chart illustrating the relevant dates and relationships between the various patents and applications discussed herein. Pet. 12.

⁸ On March 24, 2011, the Applicant filed a terminal disclaimer on the '843 patent. Ex. 1006, 128–133.

present application and each of the parent patent applications . . . have identical disclosures” and “incorporate by reference U.S. Patent Nos. 6,522,451 and 6,717,712.” *Id.* at 46–49. In addition, the Applicant submitted a declaration from Niall R. Lynam in support of Applicant’s arguments. *Id.* at 53–56. Dr. Lynam declared that the invention recited in the independent claims of the application which matured into the ’843 patent was reduced to practice prior to June 13, 2002, and referred to U.S. Patent No. 6,522,451 as evidence of that fact.⁹ *Id.* at 55.

Upon consideration of the Applicant’s arguments and the declaration of Dr. Lynam, the Examiner allowed the claims. *Id.* at 23. In the Reasons for Allowance, the Examiner explained that “Applicant has overcome the prior art rejection and questions regarding priority by filing a 37 CFR 1.131 affidavit which proved sufficient to overcome the Lynam et al reference. The 37 CFR 1.131 affidavit *proves that Niall Lynam conceived or invented the subject matter disclosed in the patent application publication.*” *Id.* (emphasis added).

The prosecution history of the ’244 patent is similar to that of the ’843 patent. The same Examiner rejected claims 1–26 under 35 U.S.C. § 102(e) as anticipated by the ’026 publication, finding that it “constitutes prior art” based upon its “earlier effective U.S. filing date.” Ex. 1006, 145. Applicant responded with nearly identical arguments to those made in the ’843 patent prosecution, including that the application was entitled to a May 20, 2003 filing date because “[t]he present application incorporates by reference U.S.

⁹ U.S. Patent No. 6,522,451 is the parent to U.S. Patent No. 6,717,712. *See* Ex. 1017. The publication of the application that matured into the 6,717,712 patent is the ’026 publication. *See id.*

Patent Nos. 6,522,451 and 6,717,712.” *Id.* at 248–50. In addition, the Applicant submitted a declaration of Niall R. Lynam similar to the one submitted during prosecution of the ’843 patent. *Id.* at 166–69. The Examiner then allowed the claims. *Id.* at 258.

3. Discussion

Petitioner asserts that the ’244 patent is entitled to the filing date of the ’843 patent, but is not entitled to the filing date of any preceding applications. Pet. 9. Petitioner argues that the application immediately preceding the ’843 patent (i.e., the ’666 application) does not provide written description support for the claims of the ’244 patent. *Id.* Although Petitioner acknowledges that this issue was raised previously, Petitioner argues that the Examiner failed to determine whether U.S. Patent Nos. 6,522,451 (“the ’451 patent”) and 6,717,712 (“the ’712 patent”) were incorporated in their entireties into the ’843 patent, and whether the combined disclosures supported the claimed invention. *Id.* at 14–15, 19. Petitioner argues that the “examiner did not explain his reasoning” in allowing the claims. *Id.* at 19.

In particular, Petitioner argues that a passage from the ’666 application does not incorporate by reference the ’451 and ’712 patents in their entireties, so as to provide written description support for the claims in the ’244 patent. Pet. 21–25. That passage, reproduced from the ’666 application, is as follows.

Reflective element 12 may comprise an aspheric or multi-radius or wide angle single element reflective element substrate. *The reflective element 12 may provide a field of view similar to the plano-auxiliary reflective element assembly disclosed in U.S. Pat. Nos. 6,522,451 and 6,717,712, which are hereby incorporated herein by reference.*

Ex. 1014 ¶ 28 (emphasis added).

Petitioner argues that the foregoing passage incorporates only the “field of view” aspect from the ’451 and ’712 patents, applicable to the one-piece reflective element 12 described in the ’666 application. Pet. 22–23. Petitioner argues that, by contrast, in other instances during the prosecution when Patent Owner intended to incorporate a reference into the ’666 application in its entirety, Patent Owner expressly said so. *Id.* at 23 (citing Ex. 1014 ¶¶ 1, 45, 46).

Patent Owner responds that because the Office considered the issue of whether the ’244 patent and other patents in the same family are entitled to claim priority to provisional application No. 60/471,872 (filed May 20, 2003) (“the ’872 provisional application”), we should exercise discretion to not consider such arguments again. Prelim. Resp. 11, 14–17. Specifically, Patent Owner argues that the ’026 publication “is not prior art to the ’244 patent and the question has been considered eight times, by two different examiners.” *Id.* at 17; *id.* at 1. Moreover, Patent Owner argues that the Examiner did not err in determining that the ’666 application incorporates the ’451 and ’712 patents in their entirety. *Id.* at 17.

Our institution of an *inter partes* review is discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (explaining that under § 314(a), “the PTO is permitted, but never compelled, to institute an IPR proceeding” if the threshold standard is met). Moreover, 35 U.S.C. § 325(d) states, in relevant part, “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request

because, the same or substantially the same prior art or arguments previously were presented to the Office.”

We have considered the prosecution history of the '244 patent and related patents, including the '843 patent. We determine that the issue of whether the '244 patent is entitled to Patent Owner's claimed priority date, i.e., May 20, 2003 (Prelim. Resp. 12), was indeed considered previously by the Office. Petitioner acknowledges that this issue was presented and argued to the Examiner. *See, e.g.*, Pet. 14–15. Moreover, Petitioner has not presented further sufficient evidence on this record that would persuade us to reach a different conclusion from the Examiner's determination that the challenged claims are adequately disclosed in the priority applications. In particular, we disagree with Petitioner's argument that the above-quoted passage from the '666 application incorporates only the “field of view” aspect from the '451 and '712 patents applicable to the one piece reflective element 12 described in the '666 application. As Patent Owner asserts (Prelim. Resp. 18–20), the passage is subject to at least one additional interpretation, and we agree that Patent Owner's interpretation of the passage is the correct one. *See Harari v. Lee*, 656 F.3d 1331, 1335–36 (Fed. Cir. 2011) (explaining that broad and unequivocal language of a first clause incorporates the entire disclosures of the two applications and that a second clause's narrower language did not diminish the scope of the earlier incorporation).

Moreover, we disagree with Petitioner's arguments that, even if the '712 and '451 patents were incorporated in their entireties, the '666 application lacks written description support for the '244 patent's claims. Pet. 26–32. The Examiner of the applications that matured into the '843 and

'244 patents would have had to consider whether the '666 application provides written description support for the '244 patent's claims, in determining that the '244 patent was entitled to the priority date asserted by the Applicant. *See, e.g.*, Ex. 1009, 21–23.¹⁰ Moreover, we find persuasive Patent Owner's arguments (Prelim. Resp. 20–24) that “the text from the '451 and '712 patents that is in the '666 application through the incorporation by reference defines the invention more broadly” than is characterized by Petitioner. It states, for example, that the invention “relates to . . . plano-auxiliary reflective elements assemblies,” that the reflective elements may be made of a glass substrate with metallic reflector coating, and that “thin glass” may be used in a variety of mirror assemblies. *Id.* at 23 (citing Ex. 1016, 1:7–10, 7:13–15, 8:18–20). Accordingly, we determine that the '026 publication's status as possible Section 102(b) prior art to the '244 patent and its family has been considered extensively by the Office, and that Petitioner has failed to sufficiently show error in the Office's previous determinations.

We next consider Petitioner's arguments that even if the '244 patent is entitled to the May 20, 2003 priority date of the '872 provisional application, the '026 publication still qualifies as prior art under 35 U.S.C. §§ 102(a) and (e) because the '026 publication is “by another.” Pet. 8. Petitioner argues that during prosecution of the '244 patent, the issue of whether relevant

¹⁰ By indicating that the affidavit overcame the '026 publication as prior art, the Examiner implicitly found that the Applicant had shown sufficiently that the claims were entitled to the '872 provisional application's filing date of May 20, 2003.

material from the '026 publication is by the same inventor as the '244 patent was not raised before the Office. *Id.* at 15.

Patent Owner argues that the '026 publication is not prior art pursuant to §§ 102(a) and (e) because it is not the work of another and that the issue was raised previously before the Office. Prelim. Resp. 25–28. In particular, Patent Owner argues that the declaration of Dr. Lynam submitted by Patent Owner during prosecution of the '244 patent is “sufficient to show that Lynam '026 was not the work of another because the [two other] co-inventors listed on Lynam '026 were not involved in the conception of the subject matter of the '244 patent claims, which were solely conceived of by Dr. Lynam.” *Id.* at 25–26; Ex. 1006, 166–69. Patent Owner also argues that during prosecution of the '843 patent, the Examiner determined that the '026 publication was not prior art because it was not the work of another. Prelim. Resp. 14–15.

We have considered the prosecution history of both the '843 patent and the '244 patent, along with the Lynam declarations filed in those cases. We determine that the issue of whether the '026 publication is prior art under 35 U.S.C. §§ 102(a) and (e) was considered by the Office. During prosecution of the '843 patent, the Examiner considered the Lynam declaration and determined that the declaration “proves that Niall Lynam conceived or invented the subject matter disclosed *in the patent application publication.*” Ex. 1009, 23 (emphasis added). The same Examiner considered a similar Lynam declaration during prosecution of the '244 patent, and concluded that the declaration “is sufficient to overcome the Lynam et al US 2002/0072026 reference.” Ex. 1006, 258. For these

reasons, we disagree with Petitioner that the Office did not previously consider the issue of whether the '026 publication is “by another.”

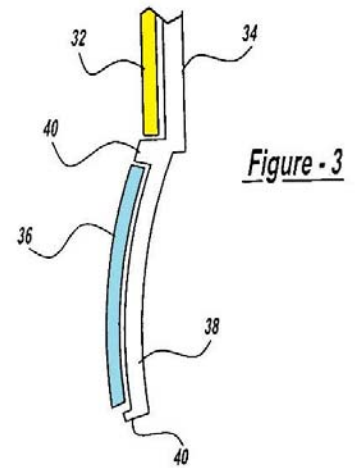
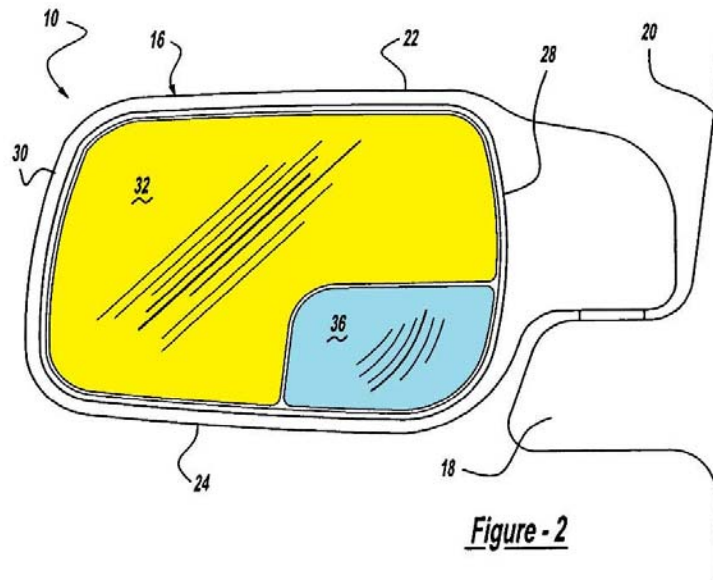
For the foregoing reasons, we exercise our discretion under 35 U.S.C. § 325(d) and decline to institute *inter partes* review of claims 1–26 on the asserted ground that those claims are unpatentable under 35 U.S.C. §§ 102(a), (b), and (e) as anticipated by the '026 publication.

*F. Asserted Obviousness of Claims 23–26
over Henion, Platzer, and Catlin*

Petitioner argues claims 23–26 are unpatentable under 35 U.S.C. § 103(a) as obvious over Henion, Platzer, and Catlin. Pet. 51–79. In support of its argument, Petitioner relies upon the testimony of Dr. Sasian (Ex. 1002). *Id.*

1. Henion

Henion describes a side view mirror with integral lighting. Ex. 1012, Abstract. Petitioner’s annotated Figures 2 and 3 of Henion are reproduced below. Pet. 57.

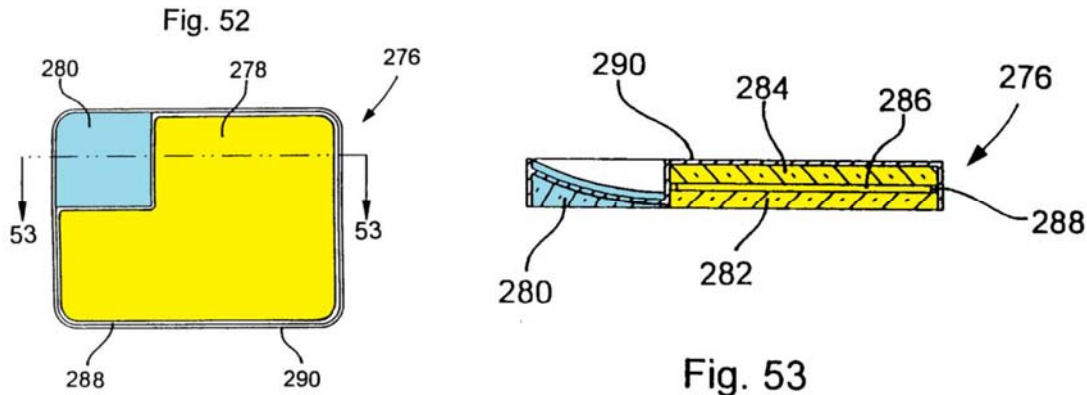


Petitioner's annotated Henion Figures 2 and 3 depict a mirror assembly. As seen in Figures 2 and 3, mirror assembly 10 includes housing 16 pivotally supported on arm 18 extending outwardly from triangular shaped mounting plate 20. Ex. 1012, 5:9–14. A first reflective element 32 is preferably a flat mirror to provide a generally unaltered field of view. *Id.* at 5:22–6:1. Backing plate 34 is secured within housing 16 and serves to movably support first reflective element 32 within the opening. *Id.* at 6:1–4. Backing plate 34 also supports second reflective element 36 and various light structures. *Id.* at 6:7–13. Second reflective element 36 is preferably a convex shape and is described as a spotter mirror or fisheye mirror, for providing a wide angle of view of the area rearward and sideward of the vehicle. *Id.* at 6:13–17.

2. Platzer

Platzer describes a rearview mirror with a main viewing mirror and an auxiliary blindzone viewing mirror juxtaposed to expose the vehicle blindzone to the operator. Ex. 1013, Abstract. Petitioner's annotated Platzer

Figures 52 and 53 are reproduced below. Pet. 61.



Petitioner’s annotated Platzer Figures 52 and 53 depict a rearview mirror assembly. As seen from the above, Platzer Figures 52 and 53 show a magnification region 278 and a second magnification mirror 280 for viewing primarily the blindzone. Ex. 1013, 37:20–22. The second mirror is “placed in the upper and outer quadrant of the rearview mirror.” *Id.* at 15:16–17.

3. Catlin

Catlin describes a rearview mirror for use on larger vehicles. Ex. 1034, 1:5–9. Mirror element 12 and heating element 14 are supported and adhered to support plate 24. *Id.* at 5:22–24, Fig. 3. The support plate is “preferably injection molded from a resinous plastic.” *Id.* at 5:25–26.

4. Discussion

Petitioner contends independent claims 23 and 25, and their respective dependent claims 24 and 26, are unpatentable as obvious over Henion, Platzer, and Catlin. Ex. 1001. Petitioner asserts that claims 23–26 “cover variations on the same basic structure: a side-view mirror with a flat primary mirror and a curved secondary mirror for *viewing the blind spot*, both *mounted on the same backing plate*.” Pet. 51 (emphasis added). Petitioner argues that Henion teaches nearly every limitation of claims 23–26, and

relies on the additional references (Catlin and Platzer) only for the following. First, Petitioner relies on Catlin for the limitation of the “backing plate element comprises a polymeric substrate that is formed as a single element by injection molding of a polymeric resin” (claims 23–26). *Id.* at 51, 53. Second, Petitioner relies on Platzer for the limitation that the auxiliary reflective element “is positioned at an outboard portion of said plano-auxiliary reflective element assembly when said exterior sideview mirror assembly is mounted to the side of the automobile” (claims 23–26) and for the limitation that the “total field of view of the rearview mirror assembly subtends an angle of at least about 25 degrees” (claims 24–26). *Id.*

Independent claims 23 and 25 each recite “[g] said auxiliary reflective element *having a wide-angle field of view encompassing a blind spot* in the side lane adjacent the side of the automobile to which said exterior sideview mirror assembly is attached.” Ex. 1001, 36–38 (emphasis added); *see also* Ex. 1002 ¶¶ 273, 376.¹¹ Claims 23 and 25 also recite “[p] . . . when said exterior sideview mirror assembly is attached to the side of the automobile . . . the field of view of said auxiliary reflective element *generally views towards a blind spot* in the side lane adjacent the side of the automobile to which said exterior sideview mirror assembly is attached, said blind spot being generally outside the rearward field of view of said plano reflective element.” Ex. 1001, 36–38 (emphasis added); *see also* Ex. 1002 ¶¶ 274, 376.¹²

¹¹ The parties refer to this phrase as element [g] of the claims. Ex. 1002, ¶ 273; Prelim. Resp. 39.

¹² The parties refer to this phrase as element [p] of the claims. Ex. 1002, ¶¶ 274, 376; Prelim. Resp. 37.

Petitioner addresses the foregoing limitations [g] and [p] as follows:

Henion discloses that the auxiliary element has a wide field of view that includes a blind spot in the adjacent lane, as recited in claim element 23[g]. Sasian Decl. ¶¶ 273–79. Henion teaches that the auxiliary element is a “spotter” or “fisheye” mirror and has a “convex” shape. Henion 6:13–17. A POSA would have understood that a convex mirror provides a wide-angle FOV by virtue of its geometry. Sasian Decl. ¶ 276. Further, a POSA would have appreciated that a flat exterior sideview mirror would not have covered all portions of the vehicle to the side and rear of the vehicle, thus leaving a blind spot outside of the driver’s field of view in the main planar mirror, as recited in claim element 23[p]. Sasian Decl. ¶¶ 273–79. *A POSA would have understood that a “spotter” or “fisheye” mirror would allow the driver to view into that blind spot.* Sasian Decl. ¶ 278.

Pet. 59–60 (emphasis added).

We are not persuaded by Petitioner’s showing because Petitioner does not account sufficiently for all of the elements of the limitations [g] and [p]. Claims 23 and 25 do not, as Petitioner contends, merely recite an auxiliary reflective element that would allow a driver to view into a blind spot. Rather, claims 23 and 25 require that when the exterior sideview mirror assembly is attached to the side of the automobile “the field of view of said auxiliary reflective element generally views towards a blind spot . . . , said blind spot being generally outside the rearward field of view of said plano reflective element” The portion of Henion that Petitioner relies on (Pet. 59) does not specify that when the exterior sideview mirror assembly is attached to the side of the automobile, the field of view of reflective element 36 generally views towards a blind spot, as recited in claims 23–26. Ex. 1012, 6:13–17. Indeed, “blind spot” is nowhere in that passage, nor do we find that Henion describes blind spots at all.

Petitioner asserts that a person having ordinary skill in the art would have understood Henion's reflective element 36 *would allow* the driver to view into a blind spot. Pet. 60. Dr. Sasian testifies that a person having ordinary skill in the art would have understood the problem of automotive rearview blind spots and would have understood that Henion's mirror "could be used to view areas not visible in the plano mirror's field of view, namely, the blind spot on the side lane." Ex. 1002, ¶¶ 277–78. Dr. Sasian's testimony, however, also does not address the language of the claims. We do not know, nor has Petitioner explained, why showing that a reflective element would allow a driver to view into a blind spot, or that the driver could use a mirror to view into a blind spot, meets the claim requirement that when the exterior sideview mirror assembly is attached to the side of the automobile "the field of view of said auxiliary reflective element generally views towards a blind spot." For this reason alone, Petitioner has not shown that there is a reasonable likelihood that it would prevail on this ground.

Moreover, even assuming that using a mirror to view into a blind spot meets the claim language, which Petitioner has not shown, Petitioner has not provided a sufficient showing that, based on the teachings of Henion, a person having ordinary skill in the art would have used Henion's auxiliary mirror to view into a blind spot. Although Dr. Sasian testifies that a person having ordinary skill in the art would have understood that plano mirrors have a shortcoming as they cannot view into the blind spot, and that the plano mirror in Henion would have suffered from such shortcomings, we

find insufficient support for such assertions in the record.¹³ *See, e.g.*, Ex. 1002 ¶¶ 275–78. Based on the record before us, we do not know that Henion’s first reflective mirror also needed an auxiliary mirror whose field of view generally views towards a blind spot. While Henion describes an auxiliary spotter mirror that provides a wide angle of view of the area rearward and sideward of the vehicle next to a first reflective element, we cannot assume that Henion’s spotter mirror is used for viewing blind spots not captured by Henion’s first reflective element. Indeed, Henion shows embodiments of a *single* flat mirror element with no spotter mirror, presumably because a spotter mirror is not necessary for viewing rearward and sideward of the vehicle. *See, e.g.*, Ex. 1012, Figs. 6, 9. Petitioner does not explain this discrepancy, but would have us assume that Henion’s spotter mirror is necessary for viewing into a blind spot. We will not make such an assumption.

For the foregoing reasons, Petitioner has not shown, with sufficient supporting evidence, that when Henion’s exterior sideview mirror assembly is attached to the side of the automobile “the field of view of said auxiliary reflective element generally views towards a blind spot,” as recited in the challenged claims.¹⁴

¹³ Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight. 37 C.F.R. § 42.65(a).

¹⁴ Because we find Petitioner has not shown a reasonable likelihood of prevailing on this challenge for the reasons discussed above, we do not reach Patent Owner’s other arguments as to this challenge.

III. ORDER

For the foregoing reasons, it is

ORDERED that the Petition is *denied* as to all challenged claims, and no trial is instituted; and

FURTHER ORDERED that Patent Owner's Motions for Pro Hac Vice Admission (Papers 8, 9) are *dismissed*.

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