

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MACAUTO U.S.A.  
Petitioner

v.

BOS GMBH & KG  
Patent Owner

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Case IPR2012-00004 (TLG)  
Patent 6,422,291 B1

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Before HOWARD B. BLANKENSHIP, THOMAS L. GIANNETTI, and BRIAN  
J. MCNAMARA, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

DECISION  
INSTITUTION OF INTER PARTES REVIEW  
37 C.F.R. § 42.108

## I. BACKGROUND

Petitioner Macauto U.S.A. (“Macauto US”) requests inter partes review of claims 1-21 of US Patent 6,422,291 B1 pursuant to 35 U.S.C. §§ 311 et seq. The Patent Owner, BOS GmbH & KG (“BOS”), submitted a preliminary response under 37 C.F.R. § 42.107(b) on December 26, 2012. Paper No. 17. We have jurisdiction under 35 U.S.C. § 314.

The standard for instituting an inter partes review is set forth in 35 U.S.C. § 314(a) which provides as follows:

THRESHOLD -- The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 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.

Petitioner challenges claims 1-21 as obvious (35 U.S.C. § 103). We grant the petition as to claims 1-5 and 8-21 and deny the petition as to claims 6 and 7.

### *A. The '291 Patent (EX 1001)*

The technology of the patent is a roll-up blind especially designed for mounting on the rear window of an automobile. Such roller blinds typically have a roll-up blind material having one edge fixed to a windup shaft disposed below an outlet slot in a hat deposit (shelf) area below the rear window of the automobile, and an opposite edge fixed to a pull rod that can be moved from a retracted (reeled-in) position overlying or within the outlet slot, and an extended (reeled-out)

position which draws the blind material through the outlet slot to a position overlying the window. The windup shaft is typically pre-stressed in a reeled-in direction by a spring motor. Col. 1, ll.19-27. The blind in its reeled-out state is illustrated in Fig. 1 of the patent reproduced below:

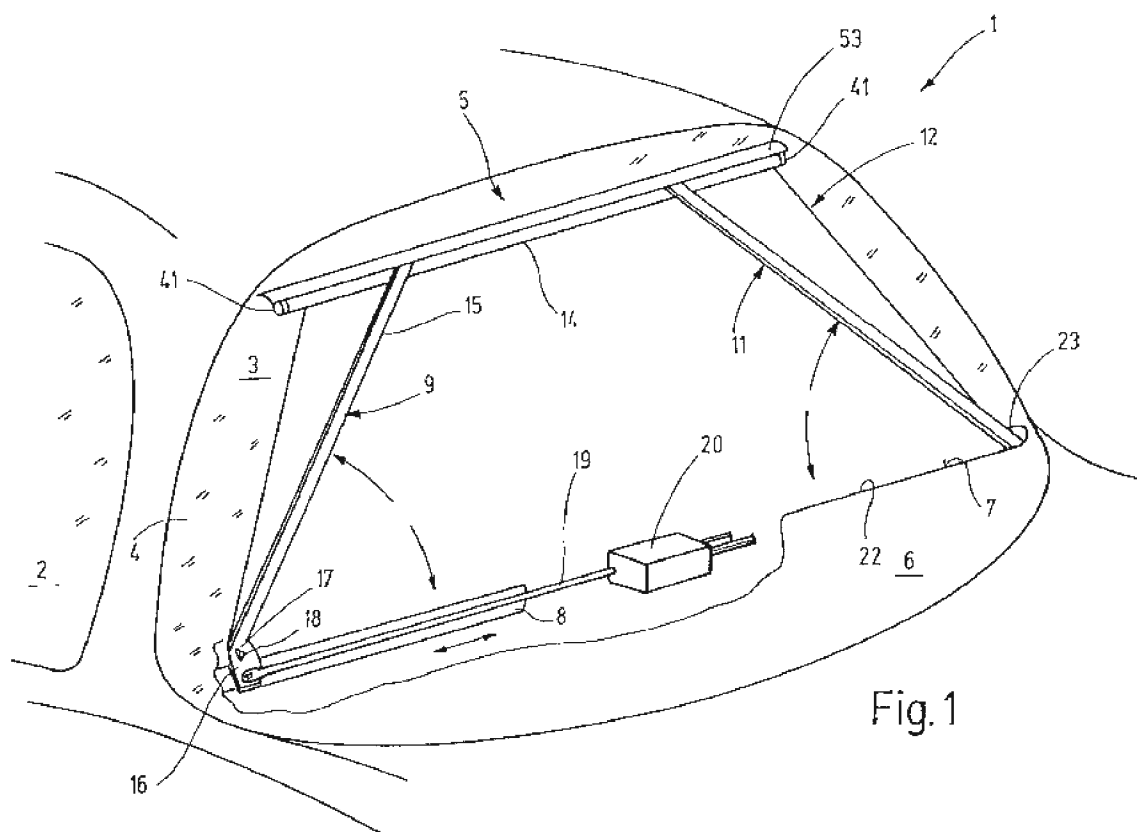
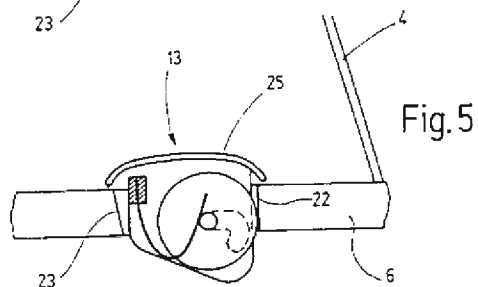
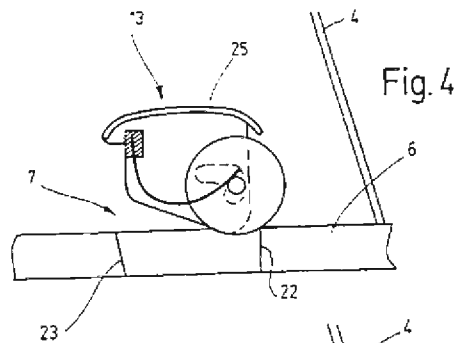
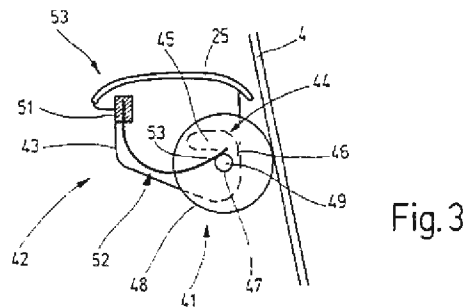


Figure 1 shows the blind material web (12) with one edge attached to the winding shaft (8) and the other edge (14), parallel thereto, attached to the pull rod, shown in Fig. 1 and labeled (13) in Fig. 2. The pull rod is provided with guide elements (41) in the vicinity of the ends. This is so the pull rod, when pressed against the inner side of the window pane, will not damage the heating wires. Col. 3, ll. 44-48; 5, ll. 3-10. The guide elements (e.g., wheels) are movable, and in one position stand over the outer contour of head strip (25) of pull rod 13 (Fig. 2), while in the other position they are drawn back with respect to the outer contour. This is further illustrated in Figs. 3-5 reproduced below, showing the guide element position as the blind is reeled in and out:



In the reeled-in state (Fig. 5), pull rod (13) rests with the edges of its cover strip (25) resting on the hat deposit (rear shelf) area, thus closing outer slot (7) which it overhangs with the cover strip. As the blind rolls out, bending spring (52) moves the axle (49) of guide roller (41) into the position of Fig. 4, i.e., into the transition area of the two branches of guide slot (44). As soon as the guide roller (41) with its circumferential surface (48) has become completely free from the slot edge (22), the bending spring (52) will move the axle (49) downward in direction

to the lower end (47) of vertical branch (46) of guide channel (44). *See* Fig. 3; col.6, ll.28-34. In an alternative embodiment the guide elements are skids instead of wheels. *See* Fig. 6; col.7, ll.12-16.

### *B. Illustrative Claim*

Claim 1 of the '291 patent (the only independent claim) illustrates the claimed subject matter:

1. A roll-up window blind for a window of a motor vehicle, the window having an associated window pane, the roll-up blind comprising:
  - a rotatable winding shaft,
  - a blind material having parallel first and second edges with the first edge being connected to the winding shaft for movement between a reeled-in position and a reeled-out position,
  - a first drive arrangement which pre-stresses the winding shaft in a direction corresponding to moving the blind material to the reeled-in position,
  - a pull rod fastened to the second edge of the blind material,
  - at least one deflection-resistant actuating element for transferring an associated second drive arrangement between a first position in which the pullrod [sic] is disposed adjacent the winding shaft and a second position in which the pullrod is disposed relatively further away from the winding shaft, and
  - two guide elements for guiding the pull rod on the window pane, the guide elements being disposed in spaced relation to each other and being supported on the pull rod by corresponding bearing arrangements for movement between a first retracted position and a second guide position, wherein in the first retracted position the guide elements are retracted with respect to a circumferential surface of the pullrod and in the second guide position the guide element [sic] project beyond the circumferential surface of the pullrod in order to guide the pull rod on the window pane as the blind material moves from the reeled-in position to the reeled-out position.

### *C. Prior Proceedings*

1. Petitioner filed a request for ex parte reexamination of the '291 patent on July 9, 2011. Pet.1.<sup>1</sup> The request was granted on August 3, 2011 as Ex Parte Reexamination Control Number 90/011,790. *Id.* On April 10, 2012, the USPTO issued an Ex Parte Reexamination Certificate confirming the patentability of claims 1-21 of the '291 patent.

Petitioner contends that the Reexamination Examiner failed to utilize the closest prior art, Ament US Patent 4,836,263. Pet. 1; EX 1002. The Ament patent and the '291 patent are commonly owned by BOS, and according to Petitioner Ament “covers a substantial portion of the limitations of the '291 patent.” Pet. 1-2. Petitioner contends that the Declaration of Gerald Zimmerman (EX1003), submitted by BOS under 37 C.F.R. § 1.132 to address secondary indicia of obviousness, was “biased,” and that the Reexamination Examiner failed properly to analyze the Declaration of Timothy M. Hicks (EX1004), submitted also by BOS. Pet. 1-3.

Patent Owner contends that the Petition relies on the same arguments and prior art that the PTO previously considered and should be denied for this reason, among others. P.Resp. 16.<sup>2</sup> In support of this Patent Owner relies on 35 U.S.C. § 325(d), specifically: “In determining whether to institute or order a proceeding under ... chapter 31 [Inter Partes Review] ... 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.” (Emphasis added.) *Id.* at 17.

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<sup>1</sup> “Pet.” refers to the Amended Petition for Inter Partes Review of U.S. Patent No. 6,422,291 (Paper No. 5).

<sup>2</sup> “P.Resp.” refers to Patent Owner’s Preliminary Response to the Amended Petition (Paper No. 17).

2. On April 7, 2011, BOS filed an action for infringement of the '291 patent against Petitioner's Taiwanese parent, Macauto Industrial Co., Ltd. ("Macauto Taiwan") in the Northern District of Illinois. *BOS GmbH & Co. KG v. Macauto Industrial Co., Ltd.*, Case No. 1:11-CV-02363 (N.D. Ill.). Ex. 2003; P.Resp. 3. BOS claims the complaint was delivered to Macauto Taiwan no later than May 13, 2011. Ex. 2004; *Id.* at 4. Macauto Taiwan moved to dismiss the action for lack of personal jurisdiction. *Id.* Subsequently the action was dismissed without prejudice pursuant to a stipulation. EX 2016; P.Resp. 4. Patent Owner contends that this previous action, which was not disclosed by Petitioner, is a statutory bar under 35 U.S.C. § 315(b). P.Resp. 6-15.

3. On May 30, 2012, BOS filed an action for infringement of the '291 patent against Macauto US and Kunshan Macauto ("Macauto China") in the Western District of New York. *BOS GmbH v. Macauto USA, Inc. and Kunshan Macauto*, Civil Action No. 6:12-cv-06294 (W.D.N.Y.). Ex. 2006; P.Resp. 4-5 Depositions in that action have been stayed pending a decision on this petition. P.Resp. 5.

#### *D. Claim Construction*

As a step in our analysis for determining whether to institute a trial, we determine the meaning of the claims. Consistent with the statute and the legislative history of the AIA, the Board will interpret claims using the broadest reasonable construction. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48766 (Aug. 14, 2012); 37 CFR § 100(b). There is a "heavy presumption" that a claim term carries its ordinary and customary meaning. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002). By "plain meaning" we refer to the ordinary and customary meaning the term would have to a person of



ordinary skill in the art. Such terms have been held to require no construction. *E.g., Biotec Biologische Naturverpackungen GmbH & Co. KG v. Biocorp, Inc.*, 249 F.3d 1341, 1349 (Fed. Cir. 2001) (finding no error in non-construction of “melting”); *Mentor H/S, Inc. v. Med. Device Alliance, Inc.*, 244 F.3d 1365, 1380 (Fed. Cir. 2001) (finding no error in court’s refusal to construe “irrigating” and “frictional heat”).

Petitioner relies principally on the claim charts provided with the Petition (at pp. 40-60) to provide the required construction of the claim language. Pet. 5-6 (“Claim construction is indicated in the attached claim chart. Where not specified, claims are construed according to their ordinary meaning”). The claim charts, in a separate column, purport to provide a “construction” for each claim element. However, in all cases the construction is merely a paraphrase of the claim language itself. With one exception, Petitioner has provided no basis for a construction other than plain and ordinary meaning.

That exception is the term “circumferential surface” appearing in all claims. Pet. 8. Citing an on-line dictionary definition (EX 1008), Petitioner contends that the broadest reasonable interpretation for that term should be “of, at, or near the circumference; surrounding.” *Id.* As Petitioner’s construction of “circumferential surface” does not appear unreasonable at this stage of the proceeding, and is not challenged by Patent Owner, we adopt it. For the other claim terms, as Petitioner has requested we apply the plain and ordinary meaning to a person of ordinary skill in the art.

#### *E. Prior Art*

Petitioner relies on the following prior art:

Ament	US 4,836,263	June 6, 1989	EX 1002
Nagase	JP H9-207565	Aug. 12, 1997	EX 1019

Naruse	JP H10-24734	Jan. 27, 1998	EX 1020
Nishiwaki	JP S54-144521	March 30, 1978	EX 1005
Knowles	US 4,254,850	March 10, 1981	EX 1006
Burdick	US 3,829,116	Aug. 13, 1974	EX 1007
Koike	JP S58-20515	Feb. 7, 1983	EX 1009
Zweigart	DE 42 02 081	Nov. 3, 1993	EX 1021
Blondin	FR 614,687A	Sept. 21, 1926	EX 1022

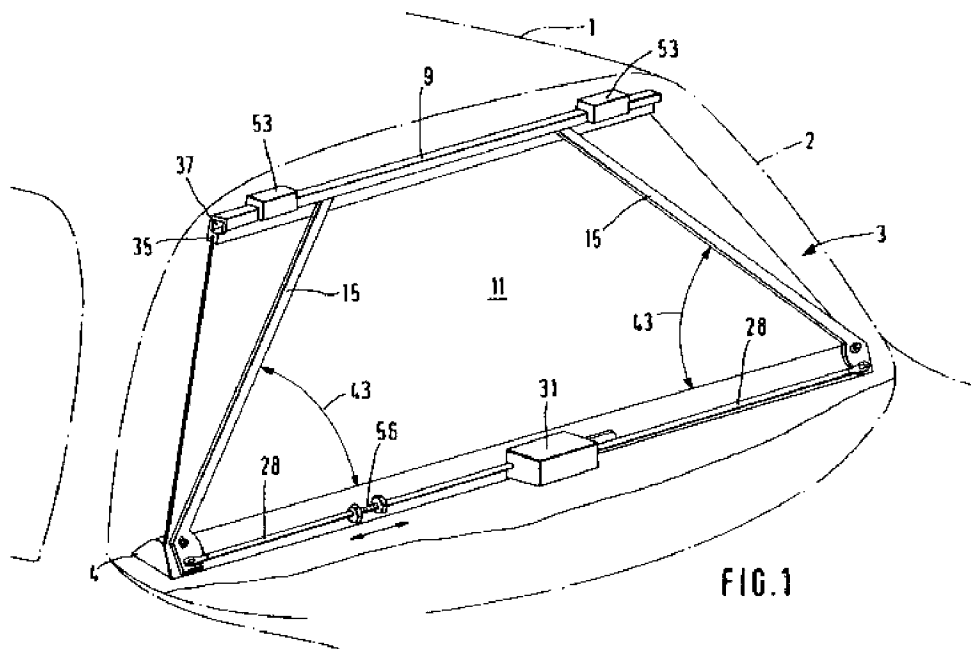
In addition, Petitioner cites the following references (EX 1010-18) as evidence of the level of ordinary skill in the art: US Patent 2,183,105; US Patent 3,402,802; China Patent Publication No. CN 2142030Y; GB Patent 424,204; US Patent 2,779,049; US Patent 3,705,731; US Patent 5,119,872; US Patent 2,196,946; and US Patent 3,057,636. *See* Pet. 10-11. As Petitioner provides no analysis of these references in relation to the elements of the claims, we do not consider them further. *See* 37 C.F.R. § 42.104(b)(4).

*1. Ament (EX 1002)*

Ament and the '291 patent are commonly assigned to BOS. Ament's German counterpart is cited in the '291 patent's Background of the Invention. Col. 1, l.19.<sup>3</sup> Ament describes the basic roll-up blind structure of the '291 patent claims with the exception of the guide elements. Fig. 1 of Ament below shows such a window shade:

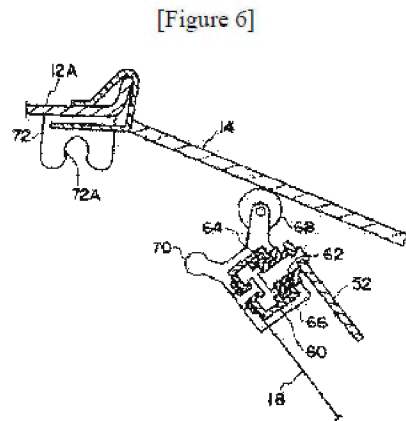
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<sup>3</sup> Patent Owner incorrectly identifies this reference as the German counterpart of Cherng (US 5,752,560). *See* P.Resp. at p.21 n.2.

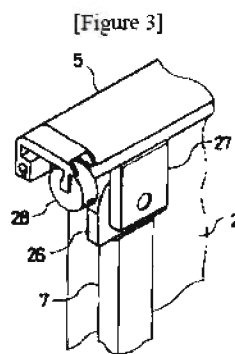


2. Nagase and Naruse (EX 1019-20)

These references are similar to Ament insofar as they disclose automotive window shade systems that operate between an extended position to a closed position by means of a pull rod and an electric winding mechanism. Unlike Ament, however, both teach guide rollers that contact the inside of the rear window. According to Petitioner, Nagase teaches each element of claim 1 except the specific location of the retracting guides. Pet.14. Petitioner recognizes also that while Nagase does disclose guide rollers, the reference does not teach the retractable guides recited of claim 1. *Id.* at 16. See Fig. 6 of Nagase below, which shows guide roller (68) rotating along rear window glass (14):

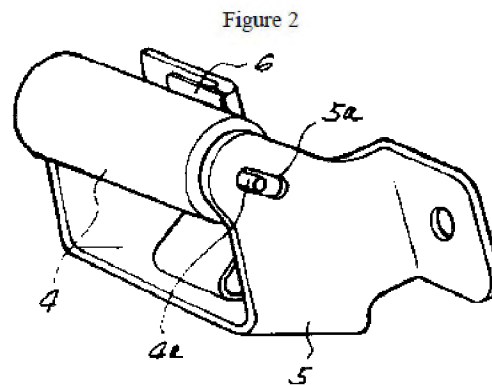


Likewise Petitioner contends that Naruse meets every element of claim 1 except for the specific type of retracting guide claimed. *Id.* at 21. The Petitioner cites Naruse's teaching of guide rollers (28) protruding from the circumferential surface of stay (5). These are shown in Fig. 3, reproduced below. *See also* Naruse p.5, ll.48-51.



3. *Nishiwaki and Koike (EX 1005, EX1009)*

Nishiwaki relates to preventing vibration of window glass in an automobile. The reference describes a roller that engages the window and is pressed against the glass by a spring. The roller is shown in Fig. 2 of Nishiwaki, reproduced below:



The roller 4 can freely rotate with its shaft 4a being installed at either end in elongated hole or slot 5a of holder 5. The shaft can move in the direction of vibration of the window glass 1 (not shown in Fig. 2) perpendicular to the plane of the window, in slot 5a. Roller 4 is pressed toward and against the surface of the window glass by spring 6, one end of which is mounted on holder 5. Nishiwacki p.1, l.50-p.2, l.5.

Koike is similar in purpose to Nishiwacki (preventing vibration of window glass) and in one embodiment (Figs. 3 and 4) has a movable arm 21 and a roller 22 disposed on the distal end thereof. The arm is rotatably attached to the inner door. A leaf spring 23 presses against one end of the movable arm 21 and the distal roller 22 comes into contact with the door glass face. Col. 4, ll. 32-43.

4. Knowles, Burdick (EX 1006-07)

These references are grouped together by Petitioner and are cited as teaching retractable wheels. Pet.5. Knowles, for example, describes a suitcase having extensible wheels that move out when the handle is extended but return to the storage position when the handle is retracted. Col.1, ll. 23-26. Burdick describes collapsible wheels for an air cushion transporter that retract within a housing when not in use. Col.1, ll.26-53.

*5. Zweigart and Blondin (EX 1021-22)*

Zweigart describes a roll-up window blind for an automobile that is installed under the hat shelf having a slot that is completely covered by a flap held in a closed position by a spring. Col. 2, ll. 18-21.

Blondin describes a “jack” having foldable wheels for moving trunks wherein the swing axis for folding the wheels extends at right angles to the lower edge of the device. *See* Blondin Fig. 2; cf. ’291 patent, claim 17, Figs. 7-9.

## II. ANALYSIS

### *A. Statutory Bar*

A threshold issue is Patent Owner’s contention that Petitioner is barred from pursuing inter partes review under 35 U.S.C. § 315(b), which provides as follows:

An inter partes review may not be instituted if the petition requesting the proceeding is filed more than one year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.

According to Patent Owner, a complaint charging infringement of the '291 patent was served on Macauto Taiwan, Petitioner's parent, "on or by" May 13, 2011.

P.Resp. 7. Patent Owner further contends that the above statute is applicable because Macauto Taiwan (not Macauto US) is the real party in interest here, and is in any event a privy of Petitioner as required by the statute. *Id.* at 7-12. We disagree that Patent Owner has adequately demonstrated that the statutory bar is applicable.

The statute requires that the service date of the complaint be more than a year before the petition was filed. Patent Owner has not established that this is the case. In making this determination the Board looks to the Federal Rules of Civil Procedure.

As to the requirement of service, the Board notes that the infringement suit against Macauto Taiwan was voluntarily dismissed without prejudice under Fed.R.Civ.P. 41(a), pursuant to a joint stipulation. EX 2016. The Federal Circuit has consistently interpreted the effect of such dismissals as leaving the parties as though the action had never been brought. *Graves v. Principi*, 294 F.3d 1350, 1356 (Fed. Cir. 2002) ("The dismissal of an action without prejudice leaves the parties as though the action had never been brought"); *Bonneville Associates, Ltd. Partnership v. Baram*, 165 F.3d 1360, 1364 (Fed. Cir. 1999) ("The rule in the federal courts is that '[t]he effect of a voluntary dismissal without prejudice pursuant to Rule 41(a) is to render the proceedings a nullity and leave the parties as if the action had never been brought.'") (Citations and internal quotes omitted.) *Accord*, Wright, Miller, Kane, and Marcus, 9 Federal Prac. & Proc. Civ. § 2367 (3d. ed.) ("[A]s numerous federal courts have made clear, a voluntary dismissal without prejudice under Rule 41(a) leaves the situation as if the action never had been filed.") (footnote omitted). Accordingly, the dismissal of the earlier action

against Macauto Taiwan nullifies the effect of the alleged service of the complaint on Petitioner.

As to the date of the alleged service, Macauto apparently signed and returned a waiver of service under Fed.R.Civ.P. 4(d). EX 2004. Under subdivision (d)(4) of that Rule, to establish a service date the waiver or proof of service must be filed. There is no evidence in the record or otherwise that Patent Owner has done so.<sup>4</sup> As explained in the Advisory Committee Note to Rule 4(d), “Paragraph (4) clarifies the effective date of service when service is waived; the provision is needed to resolve an issue arising when applicable law requires service to toll the statute of limitations.” Advisory Committee Note to 1993 Amendment to Rule 4(d) (citations omitted). The Advisory Committee Note further makes it clear that the act of waiving service under Rule 4(d) was not intended to effect service: “It is hoped that, since transmission of the notice and waiver forms is a private nonjudicial act, does not purport to effect service, and is not accompanied by any summons or directive from a court, use of the procedure will not offend foreign sovereignties ...” As Patent Owner has not demonstrated that a service waiver (EX 2004) or other proof of service was ever filed, we conclude that it has not established a service date under the statute.

In view of our conclusion that for two separate, independent reasons there was no effective service date of the prior complaint on Petitioner, we do not reach the issues relating to real party in interest or privity raised by Patent Owner.

#### *B. Effect of the Reexamination*

Under 35 U.S.C. § 325(d), “the Director may ... reject the petition or request because, the same or substantially the same prior art or arguments previously were

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<sup>4</sup> A check of the docket entries on PACER turned up no such filing.



presented to the Office.” Patent Owner contends that the Petition should be denied here because the same arguments and prior art were before the Office previously in an ex parte reexamination. P.Resp. 15-17. Consistent with the statute we have reviewed the record in the prior proceeding.

Of the art cited in the Petition, only Ament, Knowles, and Koike were considered in the reexamination. *See* Information Disclosure Statement dated 7/27/11 in Ex Parte Reexamination 90/011,790; ex 3001. The reexamination focused on patents to Cherng (*supra*), Knowles (*supra*), and Jeuffray (US 5,067,546), and the Examiner’s obviousness rejections of claims 1-5 and 8-21 were overcome by the submission of a response including declarations from an engineer, Timothy M. Hicks (EX1004), and a BOS managing director, Gerald Zimmerman (EX1003), on December 28, 2011. The Examiner in the reexamination found the arguments in those declarations “persuasive.” *See* Notice of Intent to Issue Ex Parte Reexamination Certificate mailed February 28, 2012 in Ex Parte Reexamination 90/011,790; ex 3002.

We have reviewed the declarations and agree with Petitioner that they should not have been given determinative weight by the Examiner. Turning first to the Hicks declaration, we disagree with the conclusion that Knowles is not relevant art to the ’291 patent. Hicks Decl. ¶14. This contention is repeated by Patent Owner in the Preliminary Response, pp. 22-24. The test for analogous art includes whether the art is in the inventor’s field of endeavor or is reasonably pertinent to the problem which the inventor was concerned. *See In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1380 (Fed. Cir. 1374) (“Nothing about Icon’s folding mechanism requires any particular focus on treadmills; it generally addresses problems of supporting the weight of such a mechanism and providing a stable resting position.”); *also see Wyers v. Master Lock Co.*, 616 F.3d 1231, 1238 (Fed. Cir. 1020); *Tokai Corp. v. Easton Enter., Inc.*, 632 F.3d 1358, 1371 (Fed.

Cir. 2011); *Innovention Toys, LLC v. MGA Enter., Inc.*, 637 F.3d 1314, 1321-11 (Fed. Cir. 2011). From the background of the '291 patent we conclude that the problem addressed was retracting the guide wheels “so that in the reeling-in they can plunge through the outer slot.” '291 patent col. 1, ll. 54-59. We conclude that Knowles is analogous art because it is directed to a similar problem of retracting the wheels of a piece of luggage to make it more compact for storage.

We further disagree with the Hicks analysis in that it attacks references individually when the rejection was based on the combination. *See* Hicks Decl. at ¶13, attacking Cherng for not teaching retracting wheels, and at ¶14, attacking Knowles for not teaching window blinds. Finally, we disagree with the Hicks approach of hypothesizing that a “complete[] redesign” of Cherng (a rationale that was adopted in part by the Examiner) would be required to add retractable wheels. *See id.* ¶ 16; *compare* Examiner’s “Statement of Reasons for Patentability And/Or Confirmation,” *supra* at p. 2. “The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference . . . . Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art.” *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). *See also In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983) (“[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review.”); and *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973) (“Combining the *teachings* of references does not involve an ability to combine their specific structures.”). Rather, “if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007).

The Zimmerman Declaration, which purports to demonstrate commercial success, is unpersuasive chiefly for its failure to establish a nexus between the alleged “value” to car makers or the commercial sales and the claimed invention. *See, e.g., Tokai Corp.*, supra, 632 F.3d at 1370 (“Tokai proffered no evidence from which one could reasonably infer a nexus between its sales data and its utility lighters’ automatic-locking features.”)

On the other hand, despite an opportunity to do so here, Petitioner has not provided any expert declarations of its own to refute Hicks or Zimmerman. While such declarations might be helpful in determining obviousness they are nevertheless not always a prerequisite. *Perfect Web Tech., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1329 (Fed. Cir. 2009).

In summary, we are not required by statute to reject a Petition based upon the fact that certain arguments or art were previously considered by the Office, and after reviewing the reexamination, we decline to do so in this case. *See* 35 U.S.C. § 325(d) (quoted supra). The record before us is not the same as that previously before the Office, and we are in any event not persuaded by the declarations previously submitted in the reexamination that apparently determined the outcome.

*C. Obviousness of Claims 1, 5, 8-16, and 18-20 Over Ament etc.*

Petitioner’s analysis of this grouping of claims in relation to Ament in combination with Nishiwaki, or Knowles, or Burdick, appears at pages 4-14 of the Petition and in the claim chart appearing at Pet. 40-43. According to Petitioner, those claims would have been obvious over Ament and Nishiwara combined with any one of the additional references. Petitioner contends that Ament teaches every element of claim 1 except for the retractable guides. Pet. 4-5. Petitioner asserts that Ament teaches guide elements that retract from a first extended position away

from the hat deposit area to a second retracted position on the hat deposit area of a vehicle, but not into the circumferential surface of the pull rod. *Id.* at 5. Petitioner asserts that Nishiwaka, Burdick, and Knowles each teach retractable rollers and further meet the “circumferential surface” limitation. *Id.* at 8.

Petitioner contends that it would have been obvious to a person of ordinary skill to combine Nishiwaki’s moveable roller with Ament to create a system where the roller moved into and out of the circumferential surface of the stay, especially because Ament and Nishiwaki both relate to automotive window systems. Pet. 9. Furthermore Knowles teaches retractable wheels in a related art. *Id.* Thus, according to Petitioner a practitioner searching for a method of hiding or limiting the needed clearance for a guide or wheel would have been motivated to search out other collapsible wheels such as those taught by Knowles. *Id.* Additionally, Burdick teaches retractable guide wheels in a related art. *Id.* at 10. Moreover, one of ordinary skill in the art at the time of the invention would have been aware of retractable guide wheels from similar applications in related fields. *Id.* at 10-11.

Patent Owner contends that Ament and Knowles were considered by the Examiner in the reexamination and were rejected. P.Resp. 21. Patent Owner further contends that Ament lacks any appreciation of the claimed invention, and specifically teaches that holding elements (53) in Fig. 1, supra, are fixed to the vehicle body and not movable. *Id.* at 22. Patent Owner further contends that Knowles is not available as a reference because it is not analogous art. *Id.* at 22-23.

We agree with Patent Owner that Ament lacks any teaching of guide elements as claimed in that Ament’s holding elements (53) are not movable with the shade. In that respect, Ament is less relevant than the Cherng patent (US 5,752,650) cited in the reexamination. EX 1002. We do not find this teaching, missing from Ament, in the other art relied on by Petitioner. Nishiwacki and

Koike relate to damping vibrations of automobile windows. We agree with Patent Owner they do not teach or suggest retractable rollers on a pull rod, as their rollers are biased for pressing against the pane of glass to stop the glass from rattling.

P.Resp. 25-26. Burdick teaches retractable wheels, but for a different purpose.

*See* description *supra*. We conclude therefore that Petitioner has not demonstrated a reasonable likelihood of prevailing on its obviousness arguments based on Ament in combination with these references.

As to Knowles, while we agree with Patent Owner (P.Resp. 23) that the reference does not teach adding roller wheels to a pull rod, we do not agree that the disclosure in Knowles of retracting wheels on luggage is not pertinent to the particular problem which the '291 patent purportedly solves. *See* discussion *supra*. As the background of the '291 patent recognizes, the basic structure of the claimed blind with guide elements on the pull rod was already known, as was the use of an outlet slot to receive the blind when it is reeled in. Col. 1, ll. 50-59 (referred to by Patent Owner as “admitted prior art” P.Resp. 27). Most claims, in fact, do not even recite the outlet slot. The claims and the written description instead emphasize the retractable wheels, which are said to “require a corresponding enlargement of the slot opening on the outlet slot, so that in the reeling-in they can plunge through the outlet slot.” Col. 1, ll. 36-39. As noted *supra*, Knowles provides retractable wheels for a similar purpose: to provide compact storage of large luggage having wheels of two to four inches in diameter. Knowles col. 2, l.66 - col.3, l.1. Thus, while we are not persuaded by Petitioner’s arguments for obviousness of these claims based on Ament and Knowles due to Ament’s lack of guide elements, we conclude that Knowles is relevant art.

*D. Obviousness of Claims 1, 2, 5, 8-16, and 18-21 Over Nagase etc.*

Petitioner contends this grouping of claims would have been obvious over Nagase in combination with Nishiwaki, or Knowles, or Burdick, or Koike. This analysis, appearing at pages 14-21 of the Petition and in the chart at pages 44-50, is similar to the obviousness contention based on Ament: thus Petitioner contends that Nagase teaches every element of claim 1 except the specific location of the retractable guides. Pet. 14. In contrast to Ament, however, Nagase discloses guide rollers (68) on the ends of the pull rod. *See* description *supra*. As noted, Nishiwaki, Burdick, Knowles, and Koike each teach retractable guide wheels. Koike and Nishiwaki in particular teach guide wheels for automotive windows that retract in response to pressure. *Id.* at 15. Petitioner contends that it would have been obvious to combine the retractable elements of Nishiwaki, Knowles, Burdick, or Koike with the roller/stay combination of Nagase to create a system wherein the roller moved into and out of the circumferential surface of the stay. *Id.* For the reasons just stated we are not persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on that issue as to Nishiwaki, Burdick, or Koike. Our conclusion is different as to combining Nagase with Knowles, however, as Knowles is directed to solving a problem (compact storage) similar or identical to that addressed by the '291 patent. *See supra*.

Petitioner contends that Nagase's mechanism is not "sunk" into a vehicle panel and thus would have no need for retracting guide elements. P.Resp. 28-29. But the claims in this grouping do not require such a housing configuration; only a few claims in the patent even recite the outlet slot (i.e., claims 2, 4, 6, and 7).

*E. Obviousness of Claims 1, 2, 5, 8-16, and 18-21 over Naruse etc.*

Petitioner contends this grouping of claims would have been obvious over Naruse in combination with Nishiwaki, or Knowles, or Burdick, or Koike. This analysis, appearing at pages 21-28 of the Petition and in the charts at pages 50-55,

is similar to the obviousness contentions based on Ament and Naruse, discussed supra. According to Petitioner, Naruse teaches every element of claim 1 except for the specific type of retracting guide. Pet. 21. In contrast to Ament, however, Naruse discloses guide rollers (28). *See supra*. Nishiwaki supplements Naruse and emphasizes the importance of using freely rotating rollers or wheels to guide and dampen vibration. *Id.* at 22. Knowles, Burdick, and Koike each teach retractable wheels. *Id.* Thus, according to Petitioner it would have been obvious to combine the retractable elements of Nishiwaki, Burdick, or Koike with the roller/stay combination of Naruse to create a system where the roller moved into and out of the circumferential surface of the stay. *Id.* Petitioner says this is so especially because both Naruse and Nishiwaki relate to automotive window systems. *Id.* at 25. Again, for the reasons stated above we are not persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on that issue as to Nishiwaki, Burdick, or Koike. Our conclusion again is different as to Knowles, however, as Knowles is directed to solving a problem (compact storage) similar or identical to that addressed by the patent.

*F. Obviousness of Claims 3, 4, 6, and 7*

Petitioner directs three separate but similar obviousness contentions to this group of dependent claims which recite the slot (claims 4, 6, and 7) and/or the hat deposit area (claims 3 and 4):

1. Petitioner contends the claims would have been obvious over Ament in combination with Nishiwaki, or Knowles, or Burdick, further in combination with Zweigart. *See* Pet. 29-31 and chart at Pet. 55-56. Petitioner's analysis in support of this contention follows the analysis set forth supra for claims 1, 5, 8-16, and 18-21. The additional reference, Zweigart, provides a teaching of recesses, slots, and containment of window blinds. Pet. 29.

2. Petitioner alternatively contends that the claims would have been obvious over Nagase in combination with Nishiwaki, or Knowles, or Burdick, or Koike, further in combination with Zweigart. *See* Pet. 31-33 and charts at Pet. 56-57. Petitioner's analysis in support of this contention follows the analysis set forth *supra* for claims 1, 2, 5, 8-16, and 18-21, with the addition of Zweigart.

3. Petitioner further contends that the claims would have been obvious over Naruse in combination with Nishiwaki, or Knowles, or Burdick, or Koike, further in combination with Zweigart. *See* Pet. 33-35 and charts at Pet. 57-59. Petitioner's analysis in support of this contention follows the analysis set forth *supra* for claims 1, 2, 5-8, and 16-21, with the addition of Zweigart.

Patent Owner contends that Petitioner has "misread" Zweigart in that Zweigart teaches a movable flap (17) that is attached to the vehicle and this flap covers the slot, and not the pull rod. P.Resp. 27. We agree with Patent Owner. We find no disclosure in Zweigart of a pull rod shaped to close the outlet slot when the blind is reeled in. *See* Pet. 30. We therefore conclude that Petitioner is not reasonably likely to prevail on these issues as to claims 6 and 7 which recite such a relationship. As to the other claims (claims 3 and 4) in this group, for the above reasons we conclude that Petitioner has demonstrated a reasonable likelihood of prevailing based on either Nagase or Naruse, further combined with Knowles and Zweigart.

#### *G. Claim 17*

This dependent claim recites a pivotable bearing whose axis is at right angles to the pull rod. *See* '291 patent Fig. 7-9. Petitioner directs three separate but similar obviousness contentions to this claim that parallel those previously presented:



1. Petitioner contends the claim would have been obvious over Ament in combination with Nishiwacki, or Knowles, or Burdick, further in combination with Blondin. *See* Pet. 35-36 and chart at Pet. 59. According to Petitioner, Blondin discloses a bearing axis extending at right angles to the pull rod as required by the claim. Pet. 36.

2. Petitioner contends the claim would have been obvious over Nagase in combination with Nishiwaki, or Knowles, or Burdick, or Koike, further in combination with Blondin. *See* Pet. 36-38 and chart at Pet. 59-60.

3. Petitioner contends the claim would have been obvious over Naruse in combination with Nishiwaki, or Knowles, or Burdick, or Koike, further in combination with Blondin. *See* Pet. 38-39 and chart at Pet. 60.

Patent Owner contends that there would be no reason to configure Blondin, directed to a baggage dolly with folding wheels, to cover a slot or insert a wheel. P.Resp. 27. We are not persuaded by Patent Owner's argument as claim 17 does not recite a slot. In any event, Petitioner cites Blondin for a different teaching, namely, the bearing axis configuration of claim 17. Pet. 36.

For reasons stated above we conclude that Petitioner has demonstrated a reasonable likelihood of prevailing on this issue based on either Nagase or Naruse in combination with Knowles and Blondin.

#### *H. Objective Indicia of Obviousness*

Patent owner contends that objective evidence supports the denial of the Petition. P.Resp. 31-32. Patent Owner relies on the Zimmerman Declaration discussed supra. For the reasons previously stated we are not persuaded by Patent Owner's arguments. Patent Owner also alleges copying by Petitioner (*id.* at 32), but there is no record evidence that would support such a conclusion.

### III. SUMMARY

Petitioner has demonstrated a reasonable likelihood of prevailing on its challenge to the patentability of the following claims of the '291 patent: claims 1-5 and 8-21. Petitioner has not demonstrated a reasonable likelihood of prevailing on its challenge to the patentability of the following claims of the '291 patent: claims 6 and 7.

The Petition is granted as to the following grounds:

- I. Obviousness over Nagase and Knowles: claims 1, 2, 5, 8-16, 18-21.
- II. Obviousness over Naruse and Knowles: claims 1, 2, 5, 8-16, 18-21.
- III. Obviousness over Nagase, Knowles, and Zweigart: claims 3 and 4.
- IV. Obviousness over Naruse, Knowles, and Zweigart: claims 3 and 4.
- V. Obviousness over Nagase, Knowles, and Blondin: claim 17.
- VI. Obviousness over Naruse, Knowles, and Blondin: claim 17.

### IV. ORDER

In consideration of the foregoing, it is hereby:

**ORDERED** that the Petition is granted as to claims 1-5 and 8-21 of the '291 patent.

**FURTHER ORDERED** that the Petition is denied as to claims 6 and 7 of the '291 patent.

**FURTHER ORDERED** that pursuant to 35 U.S.C. § 314(a), inter partes review of the '291 patent is hereby instituted, commencing on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial.

**FURTHER ORDERED** that the trial is limited to the grounds identified as I – VI above and no other grounds are authorized.

**FURTHER ORDERED** that an initial conference call with the Board is scheduled for 2 PM Eastern Time on February 22, 2013. The parties are directed to the Office Trial Practice Guide, 77 Fed. Reg. 48756, 48765-66 (Aug. 14, 2012) for guidance in preparing for the initial conference call, and should come prepared to discuss any proposed changes to the Scheduling Order entered herewith and any motions the parties anticipate filing during the trial.

IPR2012-00004

Patent 6,422,291

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