

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the *Inter Partes* Review of:

Trial Number: To Be Assigned

U.S. Patent No. 8,217,612

Filed: January 28, 2009

Issued: July 10, 2012

Inventor(s): Mario Boisvert, Randall
Perrin, John Washeleski

Assignee: UUSI, LLC

Title: Collision Monitoring System

Panel: To Be Assigned

Mail Stop *Inter Partes* Review
Commissions for Patents
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**SUBMISSION PURSUANT TO 35 U.S.C. § 301 AND 37 C.F.R. § 1.501 IN
SUPPORT OF PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT NO. 8,217,612**

Pursuant to 35 U.S.C. § 301 and 37 C.F.R. § 1.501, Brose North America, Inc. (“BNA”) and Brose Fahrzeugteile GmbH & Co. KG, Hallstadt (“Brose”) (collectively, “Petitioners”) offer this Submission Pursuant to 35 U.S.C. § 301 and 37 C.F.R. § 1.501 in Support of Petition for *Inter Partes* Review of U.S. Patent No. 8,217,612 (“Submission”) regarding: (1) prior art that bears on the patentability of claims 1-2, 5 and 6-8 of U.S. Patent No. 8,217,612 (“the ’612 Patent”); and (2) statements that the patent owner, UUSI, LLC (“UUSI”) has served in Federal court proceedings regarding the scope of claims 1-2, 5 and 6-8 of the ’612 Patent. BNA and Brose file this Submission in connection with, and as Exhibit 1003 to, their Petition for *Inter Partes* Review Under 37 C.F.R. § 42.100 of U.S. Patent No. 8,217,612 (“Petition”).

I. PRIOR ART BEARING ON THE PATENTABILITY OF CLAIMS 1-2, 5 AND 6-8 OF U.S. PATENT NO. 8,217,612

Pursuant to 35 U.S.C. § 301(a)(1) and 37 C.F.R. § 1.501(a)(1), Petitioners identify the following prior art that they believe bears on the patentability of claims 1-2, 5 and 6-8 of the ’612 Patent:

- U.S. Patent No. 4,870,333 to Itoh *et al.* (“Itoh”). Itoh was filed in the United States on October 2, 1987, and issued September 26, 1989, and is thus prior art under 35 U.S.C. § 102 (b). (Ex. 1007.)

- U.S. Patent No. 4,468,596 to Kinzl *et al.* (“Kinzl”). Kinzl was filed in the United States on September 10, 1981, issued August 28, 1984, and is thus prior art under 35 U.S.C. § 102(b). (Ex. 1008.)
- U.S. Patent No. 5,069,000 to Zuckerman (“Zuckerman”). Zuckerman was filed in the United States on March 22, 1990, issued December 3, 1991, and is thus prior art under at least 35 U.S.C. § 102(e). (Ex. 1009.)

As required by 37 C.F.R. § 1.501(b)(1), the pertinence of this prior art to claims 1-2, 5, and 6-8 of the '612 Patent is explained in Section V of the Petition, and in particular, the manner of applying this prior art to claims 1-2, 5, and 6-8 of the '612 Patent may be found in the claim-by-claim analysis of Section V.E of the Petition, and a summary of how the construed Challenged Claims are unpatentable is provided in Section V.C of the Petition.

II. STATEMENTS ABOUT THE SCOPE OF CLAIMS 1-2, 5, AND 6-8 OF U.S. PATENT NO. 8,217,612 IN A PROCEEDING BEFORE A FEDERAL COURT OR THE OFFICE

Pursuant to 35 U.S.C. § 301(a)(2) and 37 C.F.R. § 1.501(a)(2), Petitioners identify the following statements made by UUSI in which UUSI implicitly took a position on the scope of claims 1-2, 5, and 6-8 of the '612 Patent and that were served in a proceeding before a Federal Court.

UUSI's Infringement Positions in UUSI v. Brose North America, Inc.

UUSI implicitly took a position on the scope of claims 1-2, 5, and 6-8 of the '612 Patent when it made statements about how the accused BNA products allegedly infringe independent claims 1 and 6 of the '612 Patent. (Ex. 1021, UUSI's September 19, 2013 First Supplemental Response to Interrogatory No. 1, including Attachment F thereto.) As required by 37 C.F.R. § 1.501(a)(3), Petitioners identify the following:

37 C.F.R. § 1.501(a)(3)(i), Forum: UUSI served these statements during the district court litigation captioned *UUSI, LLC v. Robert Bosch LLC and Brose North Am., Inc.*, Case No. 2:13-cv-10444 (United States District Court for the Eastern District of Michigan).

37 C.F.R. § 1.501(a)(3)(ii), Specific Documents: UUSI made these statements about the scope of claims 1-2, 5 and 6-8 of the '612 Patent in the following document: UUSI's September 19, 2013 First Supplemental Response to Interrogatory No. 1, including Attachment F thereto. (Ex. 1021.)

37 C.F.R. § 1.501(a)(3)(iii), How Statement is a Position on the Scope of Any Claim: UUSI's infringement contentions, as set forth in its interrogatory response, are an implicit statement about the scope of the asserted claims. By saying that certain features or functionalities of the BNA accused products allegedly infringe a limitation of independent claims 1 and 6, UUSI is stating that

the scope of that claim limitation is such that it would encompass that feature or functionality. (*See Ex. 1021.*)

An explanation of the pertinence of these statements and how to apply them to independent claims 1 and 6 (and their respective dependent claims 2, 5 and 7-8) of the '612 Patent, as required by 37 C.F.R. § 1.501(b)(1), may be found in Sections IV.C (claim construction), V.C (summary of invalidity positions) and V.E (detailed invalidity claim charts) of the Petition. In that Petition, Petitioners note that UUSI has taken the position that a Hall effect sensor that indirectly monitors window movement by monitoring the rotation of a motor coupled to the window satisfies the “sensor” limitations of the Challenged Claims. *See Ex. 1021 at 14-15 and 20-21.*

Ground 2 in the Petition asserts that Itoh anticipates the Challenged Claims under the apparent constructions advocated by UUSI. In its infringement positions, UUSI takes the position that a system that does not de-active the motor in response to an obstacle, but instead reverses the motor, falls within the “de-activate” limitations of the Challenged Claims. *See Ex. 1021 at 13-14, 19-20 and 24.*

In its infringement positions, UUSI also takes the position that the limitation in claim 1 of the '612 Patent of “one or more switches for use by the controller to determine window or panel position” is found in the accused Brose products in the

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