

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MACAUTO U.S.A.
Petitioner

v.

BOS GMBH & KG
Patent Owner

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

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:

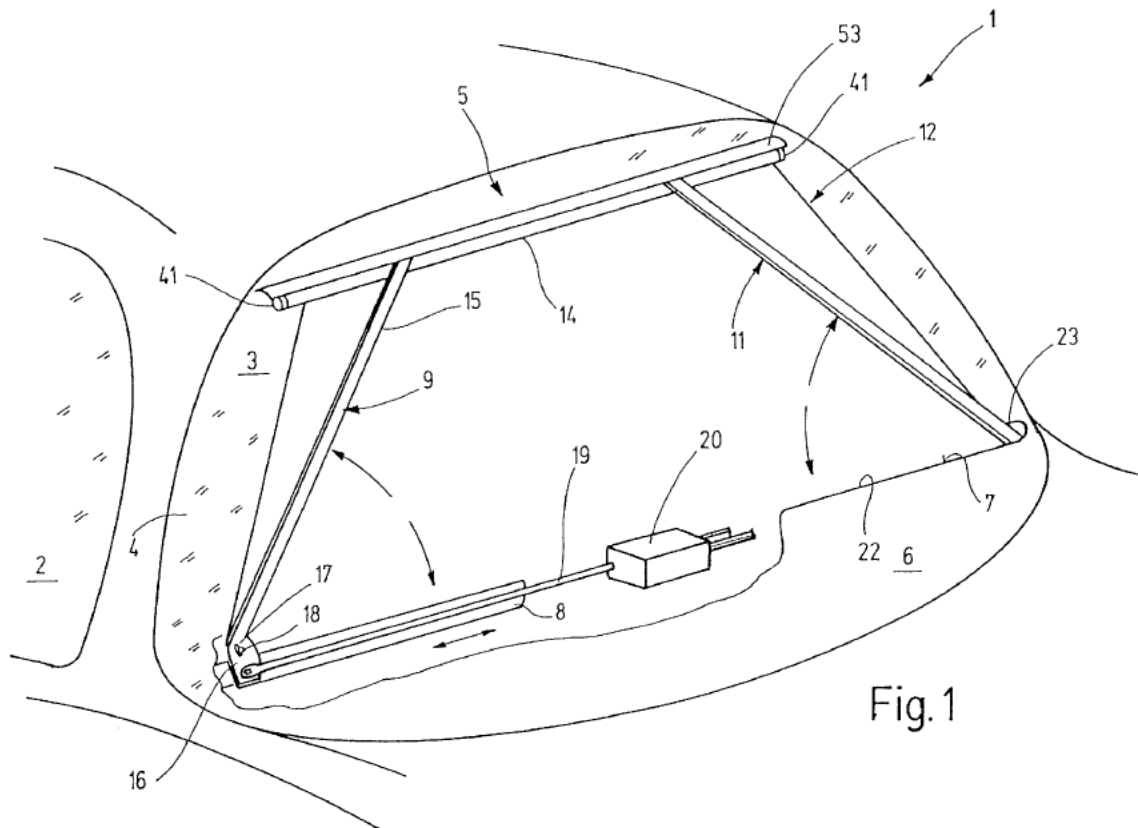
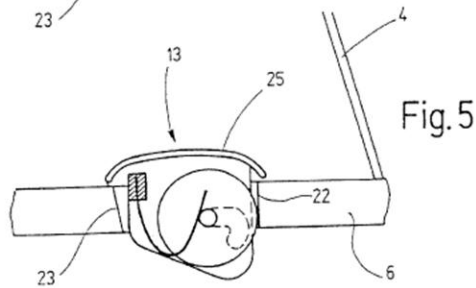
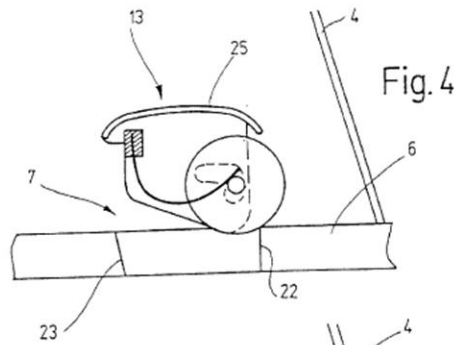
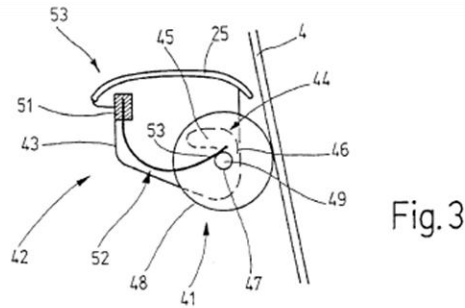


Figure 1 shows the blind material web (12) with one edge attached to the winding shaft (8) and the other edge (14), parallel thereto, attached to the pull rod, shown in Fig. 1 and labeled (13) in Fig. 2. The pull rod is provided with guide elements (41) in the vicinity of the ends. This is so the pull 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

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