

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BMW OF NORTH AMERICA, LLC,  
Petitioner

v.

ADAPTIVE HEADLAMP TECHNOLOGIES, INC.  
Patent Owner

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Case IPR2016-00196  
Patent 7,241,034

**PATENT OWNER ADAPTIVE HEADLAMP TECHNOLOGIES, INC.'S  
PRELIMINARY RESPONSE**

Petitioner BMW of North America, LLC (“BMW” or “Petitioner”) filed a petition for *inter partes* review (the “Petition”) of claims 3, 5, 7, 14-16, 31-32, and 36 of U.S. Patent No. 7,241,034 (“the ‘034 Patent”). Patent Owner Advanced Microscopy, Inc. (“Patent Owner” or “AMI”) respectfully requests that the Petition be denied as redundant, so as to “secure a just, speedy, and inexpensive resolution of the proceedings.” 37 C.F.R. § 42.1.

The Petition includes eight grounds for invalidity all based on obviousness under 35 U.S.C. § 103. The grounds are grouped into three categories based on one of three primary prior art references: U.S. Patent No. 6,229,263 to Izawa (“Izawa”), Japanese Patent Application No. JP2001-2777938 to Nishimura et al. (“Nishimura”), and U.S. Patent No. 5,562,336 to Gotou (“Gotou”). The secondary references include U.S. Patent No. 5,868,488 to Speak (“Speak”), U.S. Patent Appl. Publ. No. 2001/0012206 (“Hayami”); Japanese Patent Application Publication H01-223042 (“Uguchi”); U.S. Patent No. 6,671,640 (“Okuchi”); UK Published Patent Application GB 2309774 (“Takahashi”).<sup>1</sup>

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<sup>1</sup> The Petition also identifies additional references in its list of Exhibits, including Exs. 1016-1019, but does not offer these references in any ground for challenging the claims of the ‘034 Patent or specify where each element of the claim is found in the prior art patents or printed publications relied upon. *See* 37 C.F.R. §

This proceeding, IPR2016-00196, involves the same patent (i.e., the '034 Patent) and similar prior art that is involved in three currently pending but as of yet uninitiated proceedings:

<b>Proceeding</b>	<b>Patent</b>	<b>Claims Challenged</b>
IPR2016-00079	'034 Patent	3-39
IPR2016-00193	'034 Patent	3-39
IPR2016-00501	'034 Patent	3, 5, 7, 14-16, 31-32, 36

The prior art and obviousness arguments in this proceeding are the same or substantially similar to those raised in the three other proceedings, the original prosecution, and the previous reexaminations. Each prior art reference involves various systems for movement of a headlight either in the horizontal or vertical direction, but the prior art here similarly fails to teach or suggest each and every feature of the reexamined independent claims 3 and 7 of the '034 Patent, and the modifications and combinations for obviousness are suggested using improper hindsight without providing a sufficient motivation to do so.

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42.104(b)(4). As such, 37 C.F.R. § 42.104(b)(5) provides that the Board may exclude or give no weight to these references since the Petition “has failed to state [the] relevance or to identify specific portions of the evidence that support the challenge[s].”

Petitioner has not explain why the grounds set forth in this Petition are better than any of the prior art involved in these other three proceedings, the original prosecution, or the previous reexaminations, or why the grounds based on Izawa, Nishimura, or Gotou are not understood reasonably as being based on “substantially the same prior art or arguments” that were presented in these other three proceedings, the original prosecution, or the previous reexamination. 35 U.S.C. § 325(d); *see Prism Pharma Co., Ltd. v. Choongwae Pharma Corp.*, IPR2014-00312, Paper 14 at 12-13 (PTAB, July 8, 2014) (rejecting the petition because the same prior art and substantially the same arguments were presented to the Office during prosecution); *U.S. Endodontics, LLC v. Gold Standard Instruments, LLC*, IPR2015-01476, Paper 13 at 9 (PTAB, October 26, 2015) (rejecting the petition because the same prior art and substantially the same arguments were presented to the Office during other co-pending *Inter Partes Review* proceedings);. As such, the Board should deny this Petition as redundant.<sup>2</sup>

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<sup>2</sup> Patent Owner’s present response is limited to the redundancy of the prior art references and arguments as set forth in the Petition. Patent Owner does not waive the right to make additional arguments on the merits if the Petition is granted and the *Inter Partes Review* of the ‘034 Patent is instituted, and Patent Owner hereby expressly reserves the right to do so.

Case IPR2016-00196  
Patent 7,241,034

Dated: February 19, 2016

Respectfully submitted,

By: / Brett M. Pinkus /

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Lead Counsel for Patent Owner

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