

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SL CORPORATION,
Petitioner,

v.

ADAPTIVE HEADLAMP TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2016-01368
Patent 7,241,034 C1

Before MICHAEL P. TIERNEY, RAMA G. ELLURU, and
SCOTT C. MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION
Instituting *Inter Partes* Review
37 C.F.R. § 42.108
Granting Motion for Joinder
37 C.F.R. §§ 42.5, 42.122(b)

SL Corporation (“Petitioner” or “SL”) filed a Petition (Paper 5, “Pet.”)¹ requesting *inter partes* review of claims 3–26 and 28–35 (the “challenged claims”) of U.S. Patent No. 7,241,034 C1 (Ex. 1001, “the ’034 Patent”) pursuant to 35 U.S.C. §§ 311–319. SL also filed a Motion for Joinder (Paper 3, “Mot.”), seeking to join this case, under 35 U.S.C. § 315(c), with *Koito Manufacturing Co., Ltd. v. Adaptive Headlamp Technologies, Inc.*, Case IPR2016-00079 (“the Koito IPR” and “Petitioner Koito”), which was instituted on May 5, 2016. See IPR2016-00079 Paper 11 (instituting *inter partes* review of claims 3–26, 28–32, and 35 of the ’034 Patent).

Patent Owner Adaptive Headlamp Technologies, Inc. (“Patent Owner” or “Adaptive”) did not file an Opposition to the Motion for Joinder. Adaptive also did not file a Preliminary Response to the Petition. In addition, SL attests that Koito does not oppose joinder. Mot. 7.

For the reasons set forth below, we conclude that SL’s Petition warrants institution of *inter partes* review as to claims 3–26, 28–32, and 35 of the ’034 Patent. This determination is consistent with our Institution Decision in the Koito IPR. See IPR2016-00079 Paper 11, 39. We also determine that joinder is appropriate under the circumstances present here.

Accordingly, on this record, we institute *inter partes* review as to claims 3–26, 28–32, and 35 of the ’034 Patent, and Grant SL’s Motion for Joinder, and join SL as a Petitioner in IPR2016-00079. In view of our

¹ SL filed its original Petition (Paper 2) on July 6, 2016. SL subsequently filed a Corrected Petition (Paper 5) on July 23, 2016. All citations to the Petition in this document refer to the Corrected Petition (Paper 5).

decision on joinder, we also terminate the present proceeding, IPR2016-01368.

I. PETITION FOR *INTER PARTES* REVIEW

The parties indicate that the '034 patent is being asserted in a number of district court proceedings. Pet. 2–3; Paper 7, 3. As discussed above, the '034 Patent is the subject of the Koito IPR. The '034 Patent is also the subject of a separate *inter partes* review proceeding filed by SL:

SL Corporation v. Adaptive Headlamp Technologies, Inc., Case IPR2016-00193, which was instituted on June 7, 2016. See IPR2016-00193 Paper 10 (instituting *inter partes* review of claims 7–10, 12–21, 23, 24, and 28–39 of the '034 Patent).

In the Koito IPR, we instituted *inter partes* review of claims 3–26, 28–32, and 35, of the '034 patent on the same grounds of unpatentability asserted in the present Petition:

Claim(s)	Statutory Basis	References
7–9, 13–18, 20, 21, 23, 24, 28, 29, 31, 32, and 35	35 U.S.C. § 103(a)	Kato ² and Takahashi ³
10	35 U.S.C. § 103(a)	Kato, Takahashi, and Mori ⁴

² Japan Patent Application Publication H10-324191 (pub. Dec. 8, 1998) (Exs. 1006, 1007).

³ UK Patent Application GB 2 309 774 A (pub. Aug. 6, 1997) (Ex. 1008).

⁴ Japan Patent Application Publication H7-164960 (pub. June 27, 1995) (Exs. 1009, 1010).

Claim(s)	Statutory Basis	References
11 and 19	35 U.S.C. § 103(a)	Kato, Takahashi, and Uguchi ⁵
12	35 U.S.C. § 103(a)	Kato, Takahashi, and Ishikawa ⁶
22	35 U.S.C. § 103(a)	Kato, Takahashi, and Panter ⁷
25, 26	35 U.S.C. § 103(a)	Kato, Takahashi, and Suzuki ⁸
30 ⁹	35 U.S.C. § 103(a)	Kato, Takahashi, and Okuchi ¹⁰
3 and 6	35 U.S.C. § 103(a)	Kato and Uguchi
4	35 U.S.C. § 103(a)	Kato, Uguchi, and Ishikawa
5	35 U.S.C. § 103(a)	Kato, Uguchi, and Takahashi

Pet. 7; Mot. 3; IPR2016-00079 Paper 11, 6.

⁵ Japan Patent Application Publication H01-223042 (pub. Sept. 6, 1989) (Exs. 1011, 1012).

⁶ M. Ishikawa et al, *Auto-Levelling Projector Headlamp System with Rotatable Light Shield*, SAE TECHNICAL PAPER SERIES NO. 930726, (1993) (Ex. 1013).

⁷ U.S. Patent No. 5,751,832 (iss. May 12, 1998) (Ex. 1014).

⁸ Japan Patent Application Publication H6-335228 (pub. Dec. 2, 1994) (Exs. 1015, 1016).

⁹ Koito also asserted that claims 33 and 34 are invalid under 35 U.S.C. § 103(a) over Kato, Takahashi, and Okuchi (*see* IPR2016-00079 Paper 2, 6), and SL repeats this contention in its Petition (*see* Pet. 7). We decided, however, that Koito's Petition did not demonstrate a reasonable likelihood that Koito would prevail on its challenge to claims 33 and 34. IPR2016-00079 Paper 11, 33.

¹⁰ U.S. Patent No. 6,193,398 B1 (iss. Feb. 27, 2001) (Ex. 1017).

SL represents in its Petition that it is asserting the same challenges that were asserted by Koito in the Koito IPR:

The instant *inter partes* review petition presents challenges which are identical to those on which trial was instituted in IPR2016-00079. Paper No. 11. The petition in the instant case copies verbatim¹ the challenges set forth in the petition in IPR2016-00079 (Paper No. 2) (“Koito petition”) and relies upon the same evidence, including the same expert declaration. . . .

¹To meet the new word limits of 37 CFR §42.24 which went into effect on May 2, 2016, Petitioner has omitted Sections III. E and F of the Koito petition addressing potential issues under 35 U.S.C. §112, ¶6 (and references to the same), neither of which was addressed or referenced in the institution decision.

Pet. 1 & n.1. We have reviewed SL’s Petition and find that it raises substantially the same arguments and evidence that were proffered by Koito in the Koito IPR. *Compare* Pet. 8–57 with IPR2016-00079 Paper 11, 7–38. Although SL has submitted a declaration from Mr. Harvey Weinberg (Ex. 1019, “Weinberg Declaration”) that was not offered during the Koito IPR, the Weinberg Declaration merely adopts the opinions set forth in the Declaration of Ralph V. Wilhelm, Ph.D. (“Wilhelm Declaration”) from the Koito IPR. Ex. 1019 ¶¶ 7–11.

In view of the fact that SL’s Petition “copies verbatim the challenges set forth in the petition in [the Koito IPR]” (Pet. 1) and raises substantially the same evidence and arguments as the petition in the Koito IPR, and the fact that Adaptive (which did not file a preliminary response) has not raised any additional patentability arguments in this proceeding, we incorporate herein our analysis from the Institution Decision in the Koito IPR.

IPR2016-00079, Paper 11, 6–38. For the same reasons discussed in our

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