

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORPORATION,
Petitioner

v.

ADAPTIVE HEADLAMP TECHNOLOGIES, INC.
Patent Owner

Case IPR2016-01740
Patent 7,241,034

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

Petitioner Toyota Motor Corporation (“Toyota” or “Petitioner”) filed a petition for *inter partes* review (the “Petition”) of claims 7, 14-16, and 31 of U.S. Patent No. 7,241,034 (“the ‘034 Patent”). Patent Owner Adaptive Headlamp Technologies, Inc. (“Patent Owner” or “AHT”) 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.

Redundancy-based denials are authorized as an exercise of the Patent and Trademark Office’s (“PTO”) broad discretion in deciding whether to grant *inter partes* review petitions. The Patent Act gives the PTO authority to prescribe regulations governing the handling of review petitions. 35 U.S.C. § 316(a), for example, states that “[t]he Director shall prescribe regulations . . . (2) setting forth the standards for the showing of sufficient grounds to institute [IPR review].” Further, 35 U.S.C. § 316(b) identifies “the efficient administration of the Office, and the ability of the Office *to timely complete proceedings*” as relevant factors to be considered in setting standards for institution of review (emphasis added). The Patent Rules governing *inter partes* review proceedings authorize “the Board [to] deny some or all grounds for unpatentability for some or all of the challenged claims. Denial of a ground is a Board decision not to institute *inter partes* review on that ground.” 37 C.F.R. § 42.108(a).

In *Liberty Mutual Ins. Co. v. Progressive Cas. Ins. Co.*, No. CBM2012-00003, Paper 7 (PTAB 2012), for example, the PTAB elected not to institute review over many grounds asserted by the Petitioner because they were found to be redundant of other grounds identified in the Petitions. The PTAB explained that review of the redundant prior art grounds asserted would create an undue burden on the patent owner and on the PTAB, and would delay final resolution of the matter. Similarly, in *Shaw Indus. Group Inc. v. Automated Creel Sys. Inc.*, IPR2013-00132, Paper 9 (PTAB 2013), the PTAB denied review on several asserted grounds because the asserted grounds were redundant of other grounds upon which *inter partes* review was instituted. Patent Owner respectfully requests that the PTAB use its discretion in the present matter to deny review of the challenged claims of the '034 Patent because the grounds asserted by Petitioner are redundant of other grounds upon which review has been either petitioned for or instituted in other proceedings.

The Petition includes two grounds for invalidity, each based on obviousness under 35 U.S.C. § 103. The first ground relies upon Japanese Patent Application Publication H10-324191 to Kato (hereinafter "Kato"; Ex. 1006) as modified by U.K. Published Patent Application GB-2-309-774 A to Takahashi (hereinafter "Takahashi"; Ex. 1008). The second ground relies upon U.S. Patent No. 5,868,488 to Speak (hereinafter, "Speak"; Ex. 1009) as modified by both Takahashi and

Japanese Patent Application Publication H01-223042 to Uguchi (hereinafter “Uguchi”; Ex. 1010). This proceeding, IPR2016-01740, involves the same patent (i.e., the ’034 Patent) and similar prior art that is involved in several already instituted *inter partes* review proceedings, as detailed in the following table:

Proceeding	Patent	Claims Challenged	Status
IPR2016-00079	’034 Patent	3-39	Trial instituted for claims 3-26, 28-32, and 35 ¹
IPR2016-00193	’034 Patent	3-39	Trial instituted for claims 7-10, 12-21, 23, 24, and 28-39 ²
IPR2016-00196	’034 Patent	3, 5, 7, 14-16, 31-32 and 36	Terminated prior to entry of Institution Decision ³
IPR2016-00501	’034 Patent	3, 5, 7, 14-16, 31-32, 36	Terminated prior to entry of Institution Decision ⁴
IPR2016-01368	’034 Patent	3-26 and 28-35	Trial instituted for claims 3-26, 28-32, and 35; proceeding joined with IPR2016-00079 ⁵

The prior art and obviousness arguments in this proceeding are the same or substantially the same as those raised in the proceedings listed above, the original

¹ See IPR2016-00079, Paper 19 (Decision at 2).

² See IPR2016-00193, Paper 10 (Decision at 2).

³ See IPR2016-00196, Paper 11 (Decision at 2).

⁴ See IPR2016-00501, Paper 10 (Decision at 2).

⁵ See IPR2016-01368, Paper 9 (Decision at 10).

prosecution of the '034 Patent, and the previous reexaminations of the '034 Patent. Specifically, both IPR2016-00079 and IPR2016-01368 assert the prior art combination of Kato as modified by Takahashi in challenging the patentability of claims 7, 14-16, and 31, among others, of the '034 Patent as being obvious. These challenges, for which *inter partes* review was instituted, are identical to those of the first ground of the present Petition.⁶ Patent Owner respectfully submits that institution of review under this ground would be counter to efficient administration of the Office and the ability of the Office to timely complete proceedings as resolution of the already-instituted proceedings will fully dispose of the issue and remove any motivation for continued or additional review of the claims of the '034 Patent for non-obviousness over the combination of Kato and Takahashi.

Petitioner's second ground for challenging the validity of claims of the '034 Patent are similarly redundant because it relies upon prior art references which were considered during the prosecution of the '034 Patent and are cumulative of the references considered by the PTAB in the prior *inter partes* review proceedings listed above. The primary reference relied upon for Petitioner's second ground, the Speak patent, was considered by the Examiner during prosecution of the '034 Patent along with Takahashi. Ex. 1001 at 2. In addition, Uguchi has been relied upon as a

⁶ See IPR2016-01740, Paper 2 (Petition at 14).

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.