UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SMR AUTOMOTIVE SYSTEMS USA, INC., Petitioner,

v.

MAGNA MIRRORS OF AMERICA, INC., Patent Owner.

Case IPR2018-00506 Patent No. 8,591,047

PATENT OWNER MAGNA MIRRORS OF AMERICA, INC.'S PRELIMINARY RESPONSE



TABLE OF CONTENTS

			Page
INTRODU	CTION	١	1
BACKGRO	DUND		2
I.	Magr	ıa	2
II.	The '	047 Pa	ntent
			O SHOW A REASONABLE LIKELIHOOD THAT GED CLAIMS ARE ANTICIPATED OR OBVIOUS7
I.	Lega	l Stand	lards7
II.	The I	Board S	Should Deny Institution On Grounds 1 And 28
	A.		nds 1 and 2 Should Be Denied Because Lynam '026 at Prior Art, As The PTO Repeatedly Found8
		1.	The Prosecution History of the '047 Patent9
		2.	SMR Fails To Show Why The Board Should Reconsider The PTO's Conclusion That The '047 Patent Properly Claims Priority To The '872 Provisional
			a. The '666 application incorporates by reference the '451 and '712 patents in their entirety15
			b. The Written Description Of The '666 Application Supports The Claims Of The '047 Patent
		3.	The '047 Patent Priority Claim Is Not Defective22
		4.	SMR Fails To Show Why The Board Should Reconsider The PTO's Conclusion That Lynam '026 Is Not Prior Art23



	В.	Raise	nds 1 and 2 Should Also Be Denied Because They Inventorship Questions That Are Better Addressed strict Court.	27
III.	The Board Should Deny Institution On Ground 3 Because SMR Has Not Shown That The Prior Art Discloses All Claim Limitations Or A Sufficient Motivation To Combine.			
	A.		Petition Improperly Incorporates By Reference The n Declaration	30
	B.		on '013 Discloses A Trailer Towing Mirror, Not A Spot Mirror	33
	C.	Back	on '013 Does Not Disclose Or Render Obvious A ing Plate With The Claimed Angle Ranges Or That des An Overlapping Field Of View	36
		1.	Claim Construction	37
		2.	Henion '013 and/or Yamabe Do Not Disclose Limitations 1[n], 19, 27, or 39	41
	D.	Hinds	's Obviousness Arguments Rely On Impermissible sight And The Unsupported Opinions Of Its alified "Expert."	42
		1.	SMR's Expert Is Not A POSA	43
		2.	SMR Fails To Show That Specific Degrees Of Overlap Are Obvious	46
		3.	SMR Fails To Show That Claim 19 Is Obvious	47
		4.	SMR Fails To Show That Specific Fields Of View Are Obvious.	49
CONCLUS	ION	•••••		51
CERTIFIC	ATE O	E COM	MDI IANCE	52



TABLE OF AUTHORITIES

	Page(s)
Cases	
Allergan, Inc. v. Apotex Inc., 754 F.3d 952 (Fed Cir. 2014)	24
Apple, Inc. v. Contentguard Holdings, Inc., IPR2015-00358, Paper 9 (PTAB July 2, 2015)	32
Ariad Pharm., Inc. v. Eli Lily & Co., 598 F.3d 1336 (Fed. Cir. 2010) (en banc)	18
Callaway Golf Co. v. Acushnet Co., 576 F.3d 1331 (Fed. Cir. 2009)	17
Cisco Sys., Inc. v. C-Cation Techs., LLC, IPR2014-00454, Paper 12 (PTAB Aug. 29, 2014)	32
Cultec, Inc. v. Stormtech LLC, IPR2017-00777, Paper 7 (PTAB Aug. 22, 2017)	8
<i>Harari v. Lee</i> , 656 F.3d 1331 (Fed. Cir. 2011)	.15, 16, 17
Hopkins Mfg. Corp. v. Cequent Performance Prods., Inc., IPR2015-00616, Paper 9 (PTAB Aug. 17, 2015)	8, 30
Hospira, Inc. v. Genentech, Inc., IPR2017-00739, Paper 16 (PTAB July 27, 2017)	8
Husky Injection Molding Sys. Ltd. v. Athena Automation Ltd., 838 F.3d 1236 (Fed. Cir. 2016)	17
Johns Manville Corp v. Knauf Insulation Inc., IPR 2015-1633	47
In re Katz, 687 F.2d 450 (C.C.P.A. 1982)	24
Medtronic CoreValve, LLC v. Edwards Lifesciences Corp., 741 F 3d 1359 (Fed. Cir. 2014)	23



Modine Mfg. Co. v. ITC, 75 F.3d 1545 (Fed. Cir. 1996), abrogated by Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 234 F.3d 558 (Fed.	
Cir. 2000) (en banc)	19
PPC Broadband, Inc. v. Corning Optical Commc'ns RF, LLC, 815 F.3d 747 (Fed. Cir. 2016)	38
SCHOTT Gemtron Corp. v. SSW Holding Co., IPR2014-00367, Paper No. 62 (PTAB May 26, 2015)	45
Sewall v. Walters, 21 F.3d 411 (Fed. Cir. 1994)	28
In re Smith Int'l, Inc., 871 F.3d 1375 (Fed. Cir. 2017)	37
In re Suitco Surface, Inc., 603 F.3d 1255 (Fed. Cir. 2010)	37
Telemac Cellular Corp. v. Topp Telecom, Inc., 247 F.3d 1316 (Fed. Cir. 2001)	18
Unified Patents Inc. v. Berman, IPR2016-01571, Paper 10 (PTAB Dec. 14, 2016)9	, 29
WBIP, LLC v. Kohler Co., 829 F.3d 1317 (Fed. Cir. 2016)	, 35
Zenon Envtl., Inc. v. U.S. Filter Corp., 506 F.3d 1370 (Fed. Cir. 2007)	17
Statutes	
35 U.S.C. § 102(a)	ssim
35 U.S.C. § 102(b)	23
35 U.S.C. § 102(e)	ssim
35 U.S.C. § 256(b)	28
35 IJ S C 8 314(a)	7



DOCKET A L A R M

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.

