

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 IPR2018-00517
Patent 8,128,244 B2

Before SALLY C. MEDLEY, JESSICA C. KAISER, and
SCOTT E. BAIN, *Administrative Patent Judges*.

BAIN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

I. INTRODUCTION

SMR Automotive Systems USA, Inc. (“Petitioner”)¹ filed a Petition for *inter partes* review of claims 1–26 of U.S. Patent No. 8,128,244 B2 (Ex. 1001, “the ’244 patent”). Paper 2 (“Pet.”). Magna Mirrors of America, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). Institution of an *inter partes* review is authorized, though not required, by statute when “the information presented in the petition . . . and any response . . . 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.” 35 U.S.C. § 314(a). We have considered the Petition, the Preliminary Response, and accompanying exhibits submitted by the parties. For the reasons set forth herein, we decline to institute *inter partes* review of claims 1–26 of the ’244 patent.

A. Related Matters

The parties indicate that the ’244 patent is the subject of *Magna Mirrors of America, Inc. v. Samvardhana Motherson Reflectec Group Holdings Ltd.*, Case No. 1:17-cv-00077-RJJ-PJG (W.D. Mich.). Pet. 3; Paper 5, 1. The parties also identify numerous other petitions for *inter partes* review filed by Petitioner challenging claims of patents related to the ’244 patent:

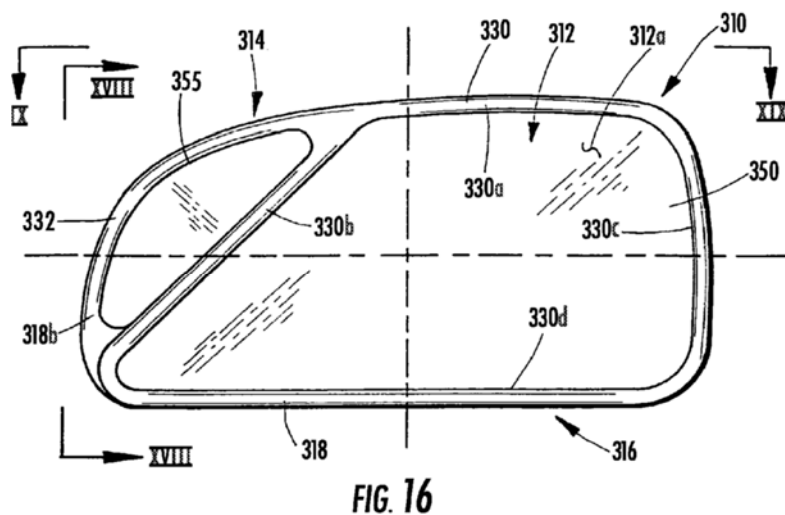
¹ Petitioner identifies itself and the following additional entities as the real parties-in-interest: Samvardhana Motherson Reflectec Group Holdings Ltd., SMR Automotive Mirror Parts and Holdings UK Limited, SMR Mirrors UK Limited, SMR Automotive Mirrors UK Limited, SMR Automotive Mirror Systems Holding Deutschland GmbH, SMR Automotive Mirrors Stuttgart GmbH, SMR Automotive Vision Systems Mexico S.A. de C.V., and SMR Automotive Servicios Mexico S.A. de C.V. Pet. 2–3.

IPR2018-00491	U.S. Patent No. 7,934,843 B2
IPR2018-00505	U.S. Patent No. 8,147,077 B2
IPR2018-00506	U.S. Patent No. 8,591,047 B2
IPR2018-00520	U.S. Patent No. 8,267,534 B2
IPR2018-00533	U.S. Patent No. 8,783,882 B2
IPR2018-00536	U.S. Patent No. 8,550,642 B2
IPR2018-00541	U.S. Patent No. 8,899,762 B2
IPR2018-00545	U.S. Patent No. 9,694,750 B2
IPR2018-00931 ²	U.S. Patent No. 8,128,243 B2

Pet. 3; *see also* Paper 5, 1.

B. The '244 Patent

The '244 patent is directed to an exterior sideview mirror. Ex. 1001, Abstract. The mirror includes a plano reflective element and an auxiliary reflective element mounted adjacent to each other in a side-by-side relationship. *Id.* Figure 16 of the '244 patent, reproduced below, is illustrative of the invention:



² *See* IPR2018-00931, Paper 1, 3.

Figure 16 depicts an embodiment of a plano reflective element assembly. As indicated in Figure 16, plano-auxiliary reflective element assembly 310 includes a first reflective element 312 and an auxiliary reflective element 314 supported in frame assembly 316. *Id.* at 15:60–63. Reflective element 312 comprises a plano reflective element 350, such as a flat reflector coated glass substrate. *Id.* at 16:20–22. Reflective element 314 comprises a radiused reflective element, preferably, a multiradiused reflective element 355 having a multiradiused curvature. *Id.* at 17:45–47.

C. Illustrative Claim

Petitioner challenges all claims (i.e., claims 1–26) of the '244 patent. Claims 1, 23, and 25 are independent. Claim 1 is reproduced below (with Petitioner's notations included for clarity).

1. An exterior sideview mirror system suitable for use on an automobile, said exterior sideview mirror system comprising:

[a] an exterior sideview mirror assembly adapted for attachment to a side of an automobile;

[b] said exterior sideview mirror assembly including a reflective element having a rearward field of view when attached to the side of the automobile;

[c] said reflective element attached to an electrically-operated actuator of said exterior sideview mirror assembly and movable by said actuator in order to position said rearward field of view to a driver-desired position when said exterior sideview mirror assembly is attached to the side of the automobile;

[d] wherein said reflective element comprises a plano-auxiliary reflective element assembly, said plano-auxiliary reflective element assembly comprising a plano reflective element having unit magnification and a separate auxiliary reflective element having a curvature;

[e] said plano reflective element and said auxiliary reflective element of said plano-auxiliary reflective element assembly mounted adjacently at said planoauxiliary reflective element assembly in a side-by-side relationship and not superimposed with one reflective element on top of the other reflective element;

[f] said plano reflective element and said auxiliary reflective element supported at a backing plate element, said backing plate element mounting to said actuator such that movement of said backing plate element of said planoauxiliary reflective element assembly by said actuator simultaneously and similarly moves said plano reflective element and said auxiliary reflective element;

[g] said auxiliary reflective element having a wide-angle field of view encompassing a blind spot in the side lane adjacent the side of the automobile to which said exterior sideview mirror assembly is attached;

[h] said backing plate element having a first support portion supporting said plano reflective element and a second support portion supporting said auxiliary reflective element;

[i] wherein said auxiliary reflective element is positioned at an outboard portion of said plano-auxiliary reflective element assembly when said exterior sideview mirror assembly is mounted to the side of the automobile;

[j] wherein said backing plate element comprises a polymeric substrate that is formed as a single element by injection molding of a polymeric resin;

[k] wherein said backing plate element is capable of supporting said plano reflective element and said auxiliary reflective element;

[l] wherein said first support portion of said backing plate element comprises a flat portion and wherein said plano reflective element is disposed at said flat portion;

[m] wherein said second support portion of said backing plate element comprises a curved portion and wherein said auxiliary reflective element is disposed at said curved portion;

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