

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 IPR2018-00536
Patent No. 8,550,642

**DECLARATION OF NIAL LYNAM IN SUPPORT OF PATENT OWNER
MAGNA MIRRORS OF AMERICA, INC.'S PRELIMINARY RESPONSE**

Niall R. Lynam declares as follows:

1. I am the sole named inventor of U.S. Pat. No. 8,550,642 (“the ‘642 patent”).

2. During the prosecution of the ‘642 patent, I submitted a declaration. Ex. 1006, 144-46. In my prior declaration, I declared, *inter alia*, that I “conceived of the claimed invention of at least the independent claims.” *Id.*, 144-45. I hereby reaffirm that I solely conceived of the claimed inventions of independent claims 1, 4, and 7 of the ‘642 patent.

3. I also declared in my prior declaration that “I am the sole named inventor of ... the present application.” *Id.*, 145. I hereby reaffirm that I am properly named as the sole inventor of the ‘642 patent. I solely conceived of the inventions of each of the dependent claims (claims 2-3, 5-6, and 8-11), in addition to the claimed invention of claims 1, 4, and 7.

4. I noted in my prior declaration that I am also “the sole named inventor of ... U.S. Patent No. 6,522,451” (“the ‘451 patent”). I hereby reaffirm that I was properly named as sole inventor of the ‘451 patent. I solely conceived of the inventions disclosed in the ‘451 patent.

5. I understand that the petitioners in this proceeding contend that the claims of the ‘642 patent are anticipated and/or rendered obvious by U.S. Patent Appl. Pub. No. 2002/0072026 (“Lynam ‘026”), which issued as U.S. Pat. No.

6,717,712 (“the ‘712 patent”). I am named as an inventor of Lynam ‘026, along with two co-inventors, Hans Fuchs and John Lindahl. Messrs. Fuchs and Lindahl were named as co-inventors on Lynam ‘026 and the ‘712 patent because they contributed the concept of a “frame element assembly,” as seen in, for example, claim 1 of the ‘712 patent. The frame element assembly was an alternative to the single backing plate element that is claimed in the ‘642 patent. Messrs. Fuchs and Lindahl did not invent any of the claimed inventions of the ‘642 patent.

under 18 U.S.C. § 1001. I declare under penalty of perjury that the foregoing is true and correct.

Date: April 30 2018

By: Niall Ryan

Niall R. Lynam