

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 8,550,642 B2

Before SALLY C. MEDLEY, JESSICA C. KAISER, and
AMBER L. HAGY, *Administrative Patent Judges*.

HAGY, *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 1–11 of U.S. Patent No. 8,550,642 B2 (Ex. 1001, “the ’642 patent”). Paper 1 (“Pet.”). Magna Mirrors of America, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Institution of an *inter partes* review is authorized 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). Upon consideration of the Petition and Preliminary Response, we decline to institute review of claims 1–11 of the ’642 patent.

A. Related Matters

The parties indicate that the ’642 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 4, 1. The parties also identify numerous other petitions for *inter partes* review filed by Petitioner challenging claims of patents related to the ’642 patent:

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
IPR2018-00517	U.S. Patent No. 8,128,244 B2
IPR2018-00520	U.S. Patent No. 8,267,534 B2
IPR2018-00533	U.S. Patent No. 8,783,882 B2

¹ Petitioner, SMR Automotive Systems USA, Inc., identifies several entities as real parties-in-interest. Pet. 2–3.

IPR2018-00541	U.S. Patent No. 8,899,762 B2
IPR2018-00545	U.S. Patent No. 9,694,750 B2
IPR2018-00931	U.S. Patent No. 8,128,243 B2 ²

Pet. 3; *see also* Paper 4, 1.

B. The '642 Patent

The '642 patent is directed to an exterior rearview 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, reproduced below, is illustrative of the mirror.

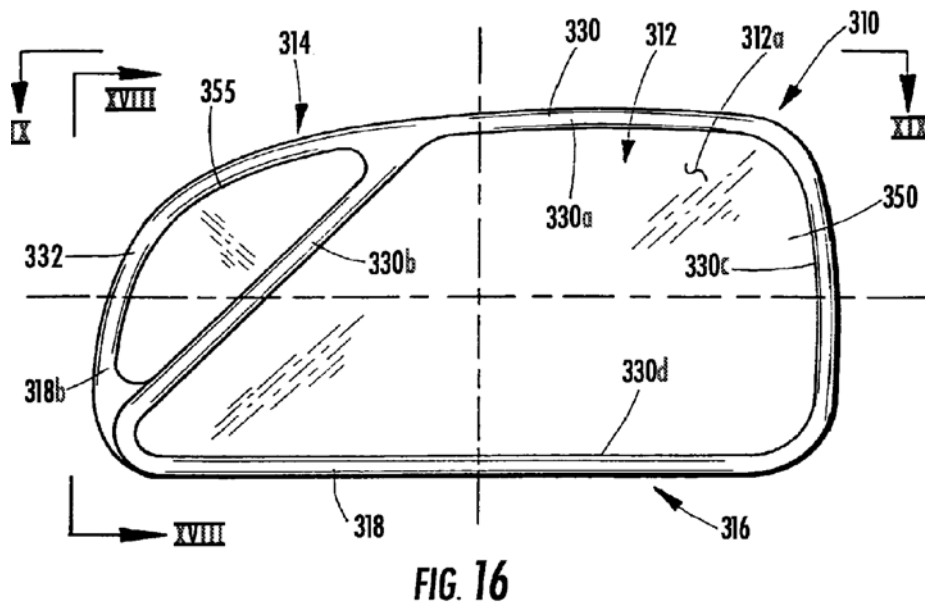


Figure 16 of the '642 patent, reproduced above, shows an embodiment of a plano reflective element assembly. Ex. 1001, 4:22–23.

As seen from the above, plano-auxiliary reflective element assembly 310 includes a first reflective element 312 and an auxiliary reflective

² IPR2018-00931 was not identified by either party, but is related to this proceeding. IPR2018-00931, Paper 1, 3; Paper 4, 1.

element 314 supported in frame assembly 316. Ex. 1001, 15:61–64.

Reflective element 312 comprises a plano reflective element 350, such as a flat reflector coated glass substrate. *Id.* at 16:21–23. Reflective element 314 comprises a radiused reflective element, preferably, a multiradiused reflective element 355 having a multiradiused curvature. *Id.* at 17:46–48.

C. Illustrative Claim

Petitioner challenges claims 1–11 of the '642 patent. Claims 1 and 7 are independent claims. Claim 7 is reproduced below.³

7. An exterior rearview mirror assembly for a motor vehicle, said exterior rearview mirror assembly comprising:

- [a] a bracket fixedly secured to the motor vehicle;
- [b] a mirror casing secured to said bracket, said mirror casing defining a primary opening;
- [c] a primary mirror disposed within said primary opening for providing a view rearward of the motor vehicle through a primary field of view, said primary mirror defining a primary plane;
- [d] a spotting mirror spaced apart from said primary mirror, said spotting mirror extending through a secondary plane different from said primary plane;
- [e] wherein said spotting mirror is at an angle relative to said primary mirror;
- [f] wherein said primary mirror and said spotting mirror are supported on a mirror backing plate, and wherein said primary mirror is supported at a first portion of said mirror backing plate and said spotting mirror is supported at a second portion of said mirror backing plate;

³ For expediency, Petitioner and Patent Owner both annotate claim 7 into limitations 7[a]–[k]. Pet. 73–74; *see also, e.g.*, Prelim. Resp. 43. We adopt that format herein for ease of reference.

- [g] a divider of said backing plate extending between said primary mirror and said spotting mirror to separate said primary and secondary mirrors visually;
- [h] wherein said primary mirror comprises one of (a) a generally flat glass substrate having a surface coated with a metallic reflector coating and (b) a generally flat polymeric substrate having a thin glass element applied to a surface thereof and with an opposing surface thereof having a reflecting layer applied thereto;
- [i] wherein said divider extends from said mirror backing plate and demarcates said first portion of said mirror backing plate from said second portion of said mirror backing plate;
- [j] wherein said first portion of said mirror backing plate, said second portion of said mirror backing plate and said divider are commonly injection molded to form said mirror backing plate; and
- [k] wherein, when supported at said second portion of said mirror backing plate, said spotting mirror is tilted downwardly with respect to said primary mirror at an angle in a range of about 0.75 degrees to about 5 degrees.

Id. at 29:7–30:15 (annotations [a]–[k] added).

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.