

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VALEO NORTH AMERICA, INC.; VALEO S.A;
VALEO GmbH; VALEO SCHALTER UND SENSOREN GmbH;
and CONNAUGHT ELECTRONICS LTD.,
Petitioner,

v.

MAGNA ELECTRONICS, INC.,
Patent Owner.

Case IPR2015-01413
Patent 8,676,491 B2

Before RICHARD E. RICE, JAMES A. TARTAL, and
BARBARA A. PARVIS, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

Petitioner, Valeo North America, Inc., Valeo S.A., Valeo GmbH, Valeo Schalter und Sensoren GmbH, and Connaught Electronics Ltd., filed a corrected Petition requesting an *inter partes* review of claims 1–12 and 16–20 of U.S. Patent No. 8,676,491 B2 (“the ’491 patent”). Paper 6 (“Pet.”). Patent Owner, Magna Electronics, Inc., filed a Preliminary Response. Paper 10 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . 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.”

Petitioner previously sought institution of an *inter partes* review of claims 1–20 of the ’491 patent. *Valeo North America, Inc., Valeo S.A., Valeo GmbH, Valeo Schalter und Sensoren GmbH, and Connaught Electronics Ltd. v. Magna Electronics, Inc.*, Case IPR2015-00251 (“IPR2015-00251”), Paper 1 (“the 251-Petition”). We instituted trial in IPR2015-00251 on claims 13–15 of the ’491 patent, but further determined that the information presented by Petitioner failed to demonstrate a reasonable likelihood that Petitioner would prevail in showing the unpatentability of claims 1–12 or 16–20. IPR2015-00251, Paper 7 (“the 251-Decision”). Petitioner did not request rehearing of the 251-Decision.

Petitioner subsequently filed the instant Petition challenging the patentability of each claim that was denied review in IPR2015-00251. For the reasons below, based on the circumstances of this case, we exercise our

discretion under 35 U.S.C. § 325(d) to deny the Petition and, therefore, decline to institute an *inter partes* review.

I. BACKGROUND

A. *The '491 Patent (Ex. 1001)*

The '491 patent, titled "Driver Assist System for Vehicle," issued March 18, 2014, from U.S. Application No. 14/033,963, filed September 23, 2013. Ex. 1001. The '491 patent is directed to a driver assist system for a vehicle, including a camera and a video display screen viewable by a driver of the vehicle. *Id.* at Abstract. The video display screen displays a visual cue in conjunction with the captured image data. *Id.* During a reversing maneuver image data from the camera is displayed to assist the driver in reversing the vehicle, and when not reversing, the display screen may display information associated with a navigational system, telematics system, or vehicle information system. *Id.*

B. *Illustrative Claim*

Claims 1, 13, and 18 of the '491 patent are independent. Claims 2–12 ultimately depend from claim 1, claims 14–17 ultimately depend from claim 13, and claims 19 and 20 ultimately depend from claim 18. Claim 1 of the '491 patent is illustrative of the claims at issue:

1. A driver assist system for a vehicle, said driver assist system comprising:
 - a CMOS camera disposed at a vehicle equipped with said driver assist system and having a field of view exterior of the equipped vehicle;
 - wherein said CMOS camera is mounted at the rear of the equipped vehicle;
 - a video display screen viewable by a driver of the equipped vehicle when the driver is normally operating the

equipped vehicle, wherein said video display screen is operable to display images derived, at least in part, from image data captured by said CMOS camera with a display intensity of at least about 200 candelas/sq. meter for viewing by the driver of the equipped vehicle;
wherein a visual cue is displayed by said video display screen in conjunction with display of said captured image data, said visual cue comprising an electronically-generated overlay;
wherein said video display screen comprises a TFT liquid crystal display screen backlit by a plurality of white light emitting light emitting diodes;
a human machine interface, said human machine interface comprising a user input;
wherein said user input comprises at least one of a (i) a vocal input, (ii) a non-vocal input, (iii) a key input and (iv) a touch input;
wherein, during a reversing maneuver of the equipped vehicle, image data captured by said CMOS camera is displayed by said video display screen as video images so as to assist the driver in reversing the equipped vehicle;
and wherein, when a reversing maneuver of the equipped vehicle is not being executed, said display screen is operable to display information associated with at least one of (i) a navigational system, (ii) a telematics system and (iii) a vehicle information system.

Ex. 1001, 35:34–36:2.

C. Related Proceedings

Petitioner states that the '491 patent is a subject of the following civil action: *Magna Electronics Inc. v. Valeo, Inc.*, No. 2:14-cv-10540 (E.D. Mich.). Pet. 2.

D. Asserted Grounds of Unpatentability

The table below compares the combinations of references Petitioner asserted against claims 1–12 and 16–20 under 35 U.S.C. § 103(a) in

IPR2015-00251, for which institution was denied, to the combinations
Petitioner asserts in this proceeding:

Challenged Claim(s)	References Asserted in IPR2015-00251	References Asserted in IPR2015-01413 (New References in Bold)
1–7, 9, 10, 16, and 18–20	Lemelson, ¹ Huang, ² Kajimoto, ³ and Toyoda ⁴	Lemelson, Huang, Kajimoto, Toyoda, and Millikan ⁵
8 and 17	Lemelson, Huang, Kajimoto, Toyoda, and Matsushita ⁶	Lemelson, Huang, Kajimoto, Toyoda, Matsushita, and Millikan
8 and 17	Lemelson, Huang, Kajimoto, Toyoda, and Tagusa ⁷	Lemelson, Huang, Kajimoto, Toyoda, Tagusa, and Millikan
11	Lemelson, Huang, Kajimoto, Toyoda, and Hsu ⁸	Lemelson, Huang, Kajimoto, Toyoda, Hsu, and Millikan
12	Lemelson, Huang, Kajimoto, and Toyoda	Lemelson, Huang, Kajimoto, Toyoda, Millikan , and Turnbull ⁹

¹ U.S. Patent No. 6,553,130 B1 (“Lemelson,” Ex. 1004), issued April 22, 2003, from an application filed June 28, 1996.

² U.S. 2002/0011611 A1 (“Huang,” Ex. 1005), published January 31, 2002.

³ U.S. Patent No. 5,920,367 (“Kajimoto,” Ex. 1008), issued July 6, 1999, from an application filed October 10, 1997.

⁴ EP 1 022 903 A2 (“Toyoda,” Ex. 1006), published July 26, 2000.

⁵ U.S. Patent No. 5,883,684 (“Millikan,” Ex. 1011), issued March 16, 1999.

⁶ U.S. Patent No. 6,864,930 B2 (Matsushita,” Ex. 1010), issued March 8, 2005, from an application filed July 11, 2001.

⁷ U.S. Patent No. 6,226,061 B1 (Tagusa,” Ex. 1009), issued May 1, 2001.

⁸ U.S. Patent No. 6,100,811 (“Hsu,” Ex. 1007), issued August 8, 2000.

⁹ WO01/080353A1 (“Turnbull,” Ex. 1012), published October 25, 2001.

II. ANALYSIS

In determining whether to institute an *inter partes* review, we may “deny some or all grounds for unpatentability for some or all of the challenged claims.” 37 C.F.R. § 42.108(b); see 35 U.S.C. § 314(a). Our discretionary determination of whether to institute review is guided by 35 U.S.C. § 325(d), which states, in relevant part, that “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or *substantially the same* prior art or arguments previously were presented to the Office (emphasis added).”¹⁰

As shown in the table above, Petitioner’s second attempt to challenge claims 1–12 and 16–20 of the ’491 patent as obvious relies on the identical references Petitioner asserted in the 251-Petition, with the addition of Millikan and, for claim 12, also Turnbull. In the 251-Petition, Petitioner asserted that “[b]ut for the fact that the Challenged Claims recite a few essentially trivial matters of design choice that were well known by January 2002, they would all be anticipated by Lemelson, which disclosed virtually the entirety of the claimed inventions years earlier.” 251-Petition, 18.

According to Petitioner, Millikan has been added to Petitioner’s prior allegations “to demonstrate that the number of LEDs used to backlight an LCD panel was a routine matter of design choice at the time of the invention of the ’491 patent, and that it was known that a plurality of LEDs may be used when the other components of the LCD display so require, in order to

¹⁰ Chapter 31 of the Patent Act covers *inter partes* review proceedings. Thus, although § 325(d) appears in Chapter 32, which is directed to post-grant reviews, it is applicable to *inter partes* reviews.

avoid ‘undesirable dark spots.’” Pet. 4–5. Petitioner also relies on Turnbull as disclosing a navigation system with features recited in dependent claim 12. *Id.* at 41. In the 251-Petition, Petitioner argued that the features recited in claim 12 were disclosed by Lemelson. 251-Petition 35–40. In this case, Petitioner offers no explanation for why Turnbull is necessary to demonstrate the obviousness of claim 12 in light of Petitioner’s prior contention in IPR2015-00251 that the features are disclosed in Lemelson.

Rather than identify new arguments based on Millikan or Turnbull, Petitioner instead makes the identical argument presented in the 251-Petition, asserting once again that, “[b]ut for the fact that the Challenged Claims recite a few essentially trivial matters of design choice that were well known by January 2002, they would all be anticipated by Lemelson, which disclosed virtually the entirety of the claimed inventions years earlier.” Pet. 21. Thus, Petitioner’s explanation of the asserted grounds concedes that both Millikan and Turnbull are either superfluous or redundant to the previously asserted references, having been included in support of Petitioner’s argument that various features are “trivial matters of design choice.”

Petitioner also makes several broad assertions purportedly to differentiate its new allegations from its prior petition, including that the Petition “presents for the first time new arguments, additional prior art references, and combinations that could not have been presented previously, and could not have been based on prior art searches previously performed and/or interpretations of those references then available to Petitioner.” *Id.* at 4. Petitioner, however, offers no evidence in support of its contention that

the arguments raised in this proceeding “could not have been presented previously,” or “could not have been based on prior art searches.”

On multiple occasions the Board has recognized that an allegation of obviousness in a second petition may be based upon “substantially the same” prior art and arguments previously presented to the Office in an earlier petition, within the meaning of 35 U.S.C. § 325(d), even if the second petition includes prior art not asserted in the prior petition. *See Customplay, LLC, v. Clearplay, Inc.*, IPR2014-00783, slip op. at 11–13 (PTAB Nov. 7, 2014) (Paper 9) (exercising § 325(d) discretion to decline to institute trial when ground presented in second petition presents substantially same prior art and arguments as prior petition despite addition of prior art); *Unilever, Inc. v. The Proctor & Gamble Co.*, IPR2014-00506 (PTAB July 7, 2014) (Paper 17) (same); *Medtronic, Inc. v. Robert Bosh Healthcare Sys., Inc.*, IPR2014-00436, slip op. at 11–12 (PTAB June 19, 2014) (Paper 17) (same). As explained above, in this case Petitioner’s contentions amount to nothing more than an argument that the additional references support Petitioner’s contention in the 251-Petition that certain features of the challenged claims are a matter of design choice. Thus, despite Petitioner’s addition of Millikan and Turnbull to the obviousness grounds previously asserted in IPR2015-00251, Petitioner’s grounds present substantially the same art, and substantially the same arguments, as previously asserted by Petitioner in the 251-Petition.

With respect to claim 16, Petitioner further argues that in IPR2015-00251 we “apparently overlooked” Petitioner’s assertion that Lemelson discloses the recited features. Pet. 5. Petitioner does not rely on

Millikan or Turnbull for any feature of claim 16, presenting instead the same ground rejected in IPR2015-00251. *Id.* at 47–48. Thus, Petitioner’s proposed ground with respect to claim 16 is effectively an attempt to request rehearing of a prior decision denying institution of trial, outside the time period provided in our Rules for such requests. *See Microsoft Corp. v. Enfish, LLC*, Case IPR2014-00577, slip op. at 8 (PTAB Sept. 29, 2014) (Paper 12) (denying second petition that is “essentially a rehearing request”).

Finally, we take into consideration the fact that the Petition was filed after our decision denying institution of review of the same challenged claims was entered in IPR2015-00251, and that it seeks to correct deficiencies with the prior petition identified in our denial of those prior grounds. Such a consideration is a factor which weighs against institution of a second petition. *See ZTE Corp. v. ContentGuard Holdings Inc.*, IPR2013-00454, slip op. at 5–6 (PTAB. Sept. 25, 2013) (Paper 12) (“A decision to institute review on some claims should not act as an entry ticket, and a how-to guide, for the same Petitioner . . . for filing a second petition to challenge those claims which it unsuccessfully challenged in the first petition.”); *Butamax Advanced Biofuels LLC v. Gevo, Inc.*, Case IPR2014-00581, slip op. at 12–13 (PTAB Oct. 14, 2014) (Paper 8) (“Allowing similar, serial challenges to the same patent, by the same petitioner, risks harassment of patent owners and frustration of Congress’s intent in enacting the Leahy-Smith America Invents Act.”); 37 C.F.R. § 42.1(b) (patent rules promulgated for AIA post-grant proceedings, including those pertaining to institution, are “construed to secure the just, speedy, and inexpensive resolution of every proceeding.”); *see also* 35 U.S.C. § 316(b) (regulations for AIA post-grant

proceedings take into account “the efficient administration of the Office” and “the ability of the Office to timely complete [instituted] proceedings”).

Accordingly, we exercise our discretion under 35 U.S.C. § 325(d) to deny institution of review.

III. CONCLUSION

For the foregoing reasons, based on the circumstances of this case, we exercise our discretion under 35 U.S.C. § 325(d), and deny the Petition requesting institution of *inter partes* review of claims 1–12 and 16–20 of the ’491 patent.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is denied as to claims 1–12 and 16–20 of the ’491 patent.

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