

TRW Automotive U.S. LLC v. Magna Electronics: Decision on Institution of Inter Partes Review IPR2014-01347

Article By:

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Takeaway: The Board may consider a copyright date and price printed on the first page of a reference as sufficient evidence of public availability of the document as of the copyright date.

In its Decision, the Board concluded that Petitioner had established “a reasonable likelihood that it will prevail with respect to at least one challenged claim” of U.S. Patent No. 8,508,593 and instituted *inter partes* review. The ’593 patent generally relates to “accessories used in windshield electronics modules and interior rearview mirror assemblies.” Petitioner sought IPR of claims 1-3, 6-12, 16, 18-31, 33-29, 76-80, and 82-85, arguing that claims 22, 37, and 39 were unpatentable under § 103 as obvious over Campbell, Goldbeck, Kuehnle, and Yanagawa and that the remaining claims were obvious over Campbell, Goldbeck, and Kuehnle.

The Board began with an analysis concerning the real parties-in-interest. Patent Owner argued that Petitioner’s ultimate parent and a related company also should have been named as real parties-in-interest because they are involved in the co-pending litigation, the parent company “undoubtedly exhibits a significant measure of control” over Petitioner, and the parent company’s discussion of Petitioner’s “fiscal position and operating results” in its annual report “suggests a tight financial integration” between the companies. The Board reviewed the evidence relied upon by Patent Owner and characterized its statements concerning what that evidence “suggest” or “undoubtedly exhibits” as “speculation” that is “based on general evidence of a parent/subsidiary relationship.” Ultimately, the Board concluded that the evidence submitted by Patent Owner “fail[ed] to establish that either [the parent company] or [the related company] is a real party-in-interest in this proceeding.”

The Board then turned to claim construction and considered the broadest reasonable interpretation of the phrase “generally wedge-shaped structure.” Petitioner argued that the phrase should be interpreted to mean “recess in the housing that tapers from one portion to another, and Patent Owner did not propose a construction for the limitation. The Board concluded that it means “a structure that tapers from a wider portion at one end to a narrower portion at the other end.”

Next the Board analyzed the asserted grounds of unpatentability.

It first considered the arguments concerning unpatentability over the combination of Campbell, Goldbeck, and Kuehnle. Patent Owner argued that the cited references do not disclose several of the

claimed features, but the Board was not persuaded by Patent Owner's arguments. Patent Owner also argued that Petitioner "did not establish that Goldbeck qualified as a printed publication under 5 U.S.C. § 102(b)" because it "failed to provide sufficient evidence that Goldbeck was publicly accessible prior to the alleged 2002 priority date of the '593 patent." The Board was not persuaded and concluded instead that, "in view of the current record, which includes a 1999 copyright to IEEE that appears on the first page of Goldbeck with amount '\$10.00' immediately preceding the copyright," the 1999 date "appears to be an accurate statement as to when IEEE made this document publicly available." Finally, the Board also considered Patent Owner's argument that the declaration of Petitioner's expert should be disregarded because Petitioner and the witness did not "establish[] that [the expert] can attest to the perspective of a skilled artisan in the relevant technology at the time of the invention."

The Board reviewed the witness's credentials, noting his educational background and experience as a Professor of Mechanical Engineering, including during the relevant time frame, where he "taught students who were employed subsequently in engineering jobs where they undertook routine assignments such as the design of mounting structures for electronics and optoelectronics," teaches graduate and undergraduate courses in design, electromechanical devices, robotics, and control and has received numerous awards and affiliations" as well as researches "machine design, robotics, control systems, mechatronics, orthoses, prostheses, bioengineering, and power and propulsion." In light of the record, the Board concluded that the witness was "qualified to address the level of ordinary skill in the art and the other matters discussed in his Declaration."

The Board then considered whether claims 22, 37 and 39 are obvious over Campbell, Goldbeck, Kuehnle, and Yanagawa. With respect to these claims, Patent Owner argued that Petitioner "fail[ed] to explain why it would have been obvious to modify an already-modified Campbell with Yanagawa's headlamp control system and it is unclear how TRW's rationale for claim 22 applies to claims 37 and 39, which recite headlamp control systems" and that Yanagawa's "disclosure of an analog television camera does not teach a camera capturing 'image data' as recited in claim 39." The Board, however, was not persuaded by these arguments.

Accordingly, the Board concluded that Petitioner had "demonstrated that a reasonable likelihood exists that it would prevail in establishing the unpatentability of claims 1–3, 6–12, 16, 18–31, 33–39, 76–80, and 82–85 of the '593 patent" and ordered institution of *inter partes* review.

***TRW Automotive U.S. LLC v. Magna Electronics Inc.*, IPR2014-01347**

Paper 17: Decision on Institution of *Inter Partes* Review

Dated: February 26, 2015

Patent: 8,508,593 B1

Before: James P. Calve, Michael J. Fitzpatrick, and Barry L. Grossman

Written by: Calve

Related Proceedings: *Magna Electronics Inc. v. TRW Automotive Holdings Corp.*, Case 1:13-cv-00324 (W.D. Mich.)

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