

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOSHIBA CORPORATION,
Petitioner,

v.

OPTICAL DEVICES, LLC,
Patent Owner.

Case IPR2014-01439
Patent RE42,913 E

Before ERICA A. FRANKLIN, GLENN J. PERRY, and JAMES B. ARPIN,
Administrative Patent Judges.

PERRY, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

In this *inter partes* review trial, instituted pursuant to 35 U.S.C. § 314, Petitioner, Toshiba Corporation (“Toshiba”), challenges the patentability of claims 48–53 of U.S. Patent No. RE42,913 E (Ex. 1001, “the ’913 patent”), owned by Patent Owner, Optical Devices, LLC (“Optical Devices”). This Final Written Decision, issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73, addresses issues and arguments raised during trial. For reasons discussed below, we determine that Toshiba has met its burden to prove, by a preponderance of the evidence, that claims 48–53 of the ’913 patent are unpatentable under 35 U.S.C. § 102 as anticipated by Ando.¹ We also *deny* Optical Devices’ motion to amend its claims.

A. Procedural History

On September 3, 2014, Toshiba filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 48–53 of the ’913 patent. Optical Devices filed a Patent Owner’s Preliminary Response. Paper 6. On March 9, 2015 we issued a decision instituting an *inter partes* review directed to claims 48–53 of the ’913 patent and limited to the ground of anticipation based on Ando. Paper 7 (“Dec. Inst.”).

After institution of trial, Optical Devices filed a Response to the Petition (Paper 14, “PO Resp.”), and Toshiba replied (Paper 20, “Pet. Reply”). Optical Devices filed a contingent Motion to Amend its claims. Paper 15, “Mot. Amend.” Toshiba opposed. Paper 21, “Opp.” We heard oral argument on January 12, 2016. Paper 37 (“Tr.”).

¹ US Patent 3,506,839 to Ando *et al.*, issued April 14, 1970, Ex. 1007.

B. Real Parties in Interest

Optical Devices states that it is the only real party in interest for the Patent Owner. Paper 5, 1. Toshiba states the Petitioner's real parties-in-interest are Toshiba Corporation and Toshiba America Information Systems, Inc. Pet. 1.

C. Related Proceedings

Toshiba indicates that the '913 patent is related by a common parent to U.S. Patent No. RE40,927 E ("the '927 patent") and to U.S. Patent No. RE43,681 E ("the '681 patent"), which also are asserted in the above identified lawsuits. Pet. 1.

The specifications of the Wild patents challenged in IPR2014-01439 (U.S. Patent No. RE42,913 E), IPR2014-01441 (U.S. Patent No. RE43,681 E), and IPR2014-01443 (U.S. Patent No. RE40,927 E) are substantively identical.

Optical Devices indicates that the following judicial and administrative matters could affect or be affected by a decision in this proceeding:

Inter partes review IPR2014-00302 (not instituted) and IPR2014-01440 (not instituted) (each involving the '913 patent);

Inter partes review IPR2014-01441 (pending) and IPR2014-01442 (pending)² (each involving the '681 patent);

Inter partes review in IPR2014-00303 (instituted), IPR2014-01443 (pending), and IPR2014-01444 (not instituted) (each involving the '927 patent);

² IPR2014-01442 is consolidated with IPR2014-01441.

IPR2014-01439
Patent RE42,913 E

In the Matter of Certain Optical Disc Drives, Components Thereof, and Products Containing The Same, International Trade Commission, Proceeding No. 337-TA-897;

Optical Devices, LLC v. Toshiba Corp., et. al., Civil Case No. 1:13-cv-01530 (D. Del. 2013);

Optical Devices, LLC v. Panasonic Corp., et. al., Civil Case No. 1:13-cv-00726 (D. Del. 2013);

Optical Devices, LLC v. Lenovo Group, Ltd., et. al., Civil Case No. 1:13-cv-01526 (D. Del. 2013);

Optical Devices, LLC v. Nintendo Co., Ltd., et. al., Civil Case No. 1:13-cv-01528 (D. Del. 2013);

Optical Devices, LLC v. Samsung Electronics Co., Ltd., et. al., Civil Case No. 1:13-cv-01529 (D. Del.); and

Optical Devices, LLC v. LG Electronics, Inc., Civil Case No. 1:13-cv-01033 (D. Del. 2013).

Paper 5, 1–2.

II. THE '913 patent (EX. 1001)

A. Described Invention

The '913 patent is a reissue of U.S. Patent No. 6,603,134 B1 (“the '134 patent”) which issued from U.S. Patent Application No. 04/623,186 (“the '186 application”). The '186 application was filed on March 10, 1967, but remained subject to secrecy order(s) for many years because of its potential military use. Pet. 10. The '913 patent relates to detection of retroreflective optical systems. Ex. 1001, Abstract. Retroreflective optical systems are found in many military surveillance systems including

binoculars, telescopes, periscopes, range finders, cameras, and the like. *Id.* at 1:60–63. Retroreflective characteristics of the human eye are described with respect to Figure 5. *Id.* at 5:26–44.

Retroreflective optical systems are those in which incident rays and reflected rays are parallel for any angle of incidence within a field of view. Ex. 1001, 1:23–26. Retroreflectors are discernible from the background in which they are positioned.

It should be noted that in almost all cases, the retroreflector will be disposed within an environment that produces background radiation in a Lambertian manner. Thus, the radiant intensity of the retroreflector is so much greater than that of a Lambertian radiator that it is easily discernible from the background, even when, (as shown in FIG. 2) a large percentage of the retroreflected radiant flux is lost due to vignetting.

Ex. 1001, 5:1–6

Figure 1 of the '913 patent is reproduced below:

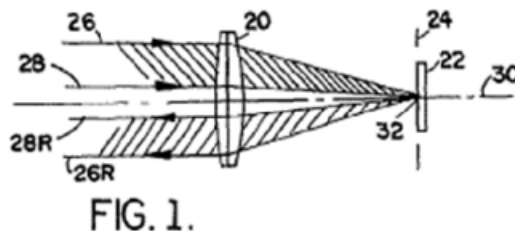


Figure 1 of the '913 patent explains retroreflection. It depicts an optical system including lens 20 and reflective surface 22 (e.g., a mirror) positioned in focal plane 24 of lens 20. Ex. 1001, 3:4–25. Radiation rays 26 and 28 are directed towards lens 20 of the optical system from a radiation (e.g., light) source (not shown). *Id.* at 3:14–16. For purposes of clarity, Figure 1 of the '913 shows the *incident* rays at the top of lens 20 and the *reflected* rays at

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