

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRW AUTOMOTIVE U.S. LLC,
Petitioner,

v.

MAGNA ELECTRONICS INC.,
Patent Owner.

Case IPR2015-01685
Patent 8,710,969 B2

Before PHILLIP J. KAUFFMAN, MITCHELL G. WEATHERLY, and
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

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

I. INTRODUCTION

TRW Automotive U.S. LLC (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–11 and 13–23 of U.S. Patent No. 8,710,969 B2 (Ex. 1002, “the ’969 patent”). Magna Electronics Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”) to the Petition. An *inter partes* review may not be instituted “unless . . . 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).

For the reasons set forth below, Petitioner demonstrates a reasonable likelihood of prevailing in showing the unpatentability of claims 1–11 and 13–23 of the ’969 patent. Accordingly, we institute an *inter partes* review as to claims 1–11 and 13–23 of the ’969 patent on the grounds specified below.

A. *Related Proceedings*

The parties indicate that the ’969 patent is at issue in the following district court case: *Magna Electronics Inc. v. TRW Automotive Holdings Corp.*, No. 1:14-cv-341 (W.D. Mich.). Pet. 3; Paper 5, 1.

B. *The ’969 Patent*

The ’969 patent relates to an accessory module that is mountable at an interior surface of a vehicle windshield. Ex. 1002, col. 1, ll. 18–21. The accessory module may house an accessory, such as an imaging device. *Id.* at col. 1, ll. 42–46. Specifically, the accessory module may include a portion that holds an imaging sensor and a portion that holds a lens. *Id.* at col. 1, ll. 48–53, col. 2, ll. 16–21. These portions of the accessory module may be unitarily molded of a polymeric or plastic material so that the imaging

sensor and lens may be readily attached at the desired location and/or orientation. *Id.* at col. 1, ll. 53–56, col. 2, ll. 43–46.

C. *Illustrative Claim*

Claims 1, 13, 17, and 21 are independent. Claim 1 is reproduced below.

1. An accessory system for a vehicle, said accessory system comprising:

a windshield, said windshield having an outer surface that is exterior of the vehicle when said windshield is mounted to a vehicle equipped with said accessory system and an inner surface that is interior of the vehicle when said windshield is mounted to the equipped vehicle;

wherein said windshield is at a windshield angle relative to vertical when said windshield is mounted to the equipped vehicle;

wherein said windshield has a mounting element attached at said inner surface;

wherein said mounting element is adapted for mounting of an accessory module thereto and demounting of said accessory module therefrom;

an accessory module adapted for mounting to and demounting from said mounting element;

said accessory module accommodating a camera comprising a CMOS photosensor array and a lens;

wherein said CMOS photosensor array is accommodated at said accessory module separate from said lens;

wherein said CMOS photosensor array is disposed on a circuit board;

wherein said accessory module is configured so that, when mounted to said mounting element attached at said windshield, said lens has a field of view through said windshield appropriate for a driver assistance system of the equipped vehicle; and

wherein said driver assistance system comprises at least one of (i) a lane departure warning system of the equipped vehicle, (ii) an object detection system of the equipped vehicle, (iii) a traffic sign recognition system of the equipped vehicle, (iv) an adaptive cruise control system of the equipped vehicle, (v) a traffic lane control system of the equipped vehicle, (vi) a lane change assist system of the equipped vehicle and (vii) a blind spot detection system of the equipped vehicle.

Id. at col. 16, l. 46–col. 17, l. 16.

D. *Evidence of Record*

Petitioner relies on the following references and declaration (*see* Pet. 2–3):

Reference or Declaration	Exhibit No.
PCT Pub. No. WO 03/065084 A1 (“Schofield PCT”)	Ex. 1003
U.S. Patent No. 5,796,094 (“Schofield ’094”)	Ex. 1004
Declaration of Homayoon Kazerooni, Ph.D.	Ex. 1007
U.S. Patent No. 6,201,642 B1 (“Bos”)	Ex. 1009

E. *Asserted Grounds of Unpatentability*

Petitioner asserts that the challenged claims are unpatentable on the following grounds¹ (*see* Pet. 2–3):

Claim(s)	Basis	Reference(s)
1–7, 9–11, 13–16, 21, and 22	35 U.S.C. § 102(b)	Schofield PCT
1–7, 9–11, 13–16, 21, and 22	35 U.S.C. § 103(a)	Schofield PCT and Schofield ’094
8, 17–20, and 23	35 U.S.C. § 103(a)	Schofield PCT, Schofield ’094, and Bos

¹ Patent Owner argues that the asserted grounds are redundant, and, thus, should be denied. Prelim. Resp. 44–45. The decision cited by Patent Owner in support of that argument is not binding precedent and does not require that alternative grounds be denied, and we do not deny any grounds asserted in the Petition on that basis.

II. ANALYSIS

A. *Identification of Real Parties in Interest*

The Petition identifies Petitioner as the real party in interest. Pet. 3. Patent Owner argues that ZF TRW Automotive Holdings Corp. (“TRW Holdings”) and ZF Friedrichshafen AG (“ZF”) are real parties in interest that are not identified in the Petition. Prelim. Resp. 45. According to Patent Owner, the Petition should be denied because, under 35 U.S.C. § 312(a)(2), a petition that does not identify all the real parties in interest cannot be considered. *Id.*

Whether a party is a real party in interest is a “highly fact-dependent question” that is evaluated “on a case-by-case basis.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,759–60 (Aug. 14, 2012). Some of the common considerations for determining whether a party is a real party in interest include whether the party funds, directs, or controls the petition or proceeding. *Id.* at 48,760. For the reasons discussed below, we are not persuaded, on this record, that TRW Holdings or ZF is a real party in interest in this case.

1. *TRW Holdings*

Patent Owner argues that TRW Holdings should have been identified as a real party in interest in the Petition because: 1) Petitioner is a wholly owned subsidiary of TRW Holdings (Prelim. Resp. 47); 2) an Annual Report filed by TRW Holdings contains financial information relating to its subsidiaries, including Petitioner (*id.* at 49); and 3) Petitioner and TRW Holdings share a website and sometimes are referenced jointly (*id.* at 49–50). We are not persuaded that TRW Holdings is a real party in interest in this case. Specifically, Patent Owner does not identify evidence indicating

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.