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PTAB Rejects Previously Presented Arguments, Gives Examiner Deference, and Denies IPR Institution

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Regarding the first argument, the petitioner maintained that the incorporated patent applications were incorporated only for their descriptions of a particular claimed component, and not for descriptions of other claimed components, which petitioner alleged lacked written description support. The patent owner, however, argued that the incorporated patent applications were incorporated in their entirety and that two separate examiners had made such a determination during prosecution. After examining the prosecution histories of the challenged patent and its family members, the PTAB found that the examiners had previously considered whether adequate written description support existed. Further, the PTAB disagreed with the petitioner that the incorporation by reference was limited to the particular component because the relevant passage "is subject to at least one additional interpretation." Finally, the PTAB presumed that the examiners also previously considered whether the parent application itself provided written description support. In light of the forgoing, the PTAB ruled that review is discretionary and that under 35 U.S.C. § 325(d) it 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." Thus, the PTAB found that the petitioner "failed to sufficiently show error in the Office's previous determinations" and rejected petitioner's first argument.

Regarding petitioner's second argument, the PTAB again found that the issue was previously considered during prosecution of the challenged patent and its family members. There, the named inventor provided two declarations, which the examiner found "proves that the [named inventor] conceived or invented the subject matter disclosed in the [alleged prior art

patent publication]." Based on the examiner's finding, the PTAB rejected the petitioner's argument that the allegedly invalidating disclosures in the prior art patent publication were "by another" and admonished the petitioner for failing to address the prosecution history of one of the parent applications, which disclosed the examiner's findings.

Finally, regarding a third invalidity ground raised by the petitioner, the PTAB found that petitioner had failed to demonstrate that a purported prior art combination disclosed all of the claim limitations of the independent claims. In particular, the PTAB did not agree that the petitioner's purported showing that a component would "allow the driver to view into a blind spot" satisfied a claim limitation requiring the "field of view of [the component to] generally view[] towards a blind spot." The PTAB also found that petitioner did not demonstrate that a person of ordinary skill would have used the disclosures of one of the combined references to modify the other. Specifically, the PTAB did not find a factual basis to support petitioner's expert's argument that the modified prior art reference would suffer from the shortcoming serving as the reason for making the combination. Based on the forgoing, the PTAB rejected all of petitioner's grounds for review.

SMR Automotive Sys. USA, Inc. v. Magna Mirrors of America, Inc., IPR2018-00505 (PTAB June 28, 2018) [Medley (opinion), Kaiser, Hagy].

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