

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 IPR2015-00436¹
Patent 8,599,001 B2

Before JUSTIN T. ARBES, BART A. GERSTENBLITH, and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ Cases IPR2015-00437, IPR2015-00438, and IPR2015-00439 have been consolidated with this proceeding.

A conference call in the above proceeding was held on January 12, 2016, among respective counsel for Petitioner and Patent Owner, and Judges Arbes, Gerstenblith, and Ippolito.² Petitioner initiated the conference call to seek authorization to file a motion to compel Patent Owner to produce certain materials as routine discovery pursuant to 37 C.F.R. § 42.51(b)(1) or a motion for additional discovery pursuant to 37 C.F.R. § 42.51(b)(2).

Petitioner argued during the call that Patent Owner has relevant information that is inconsistent with positions taken in its Response and assertions made by Patent Owner's declarant, Ralph Etienne-Cummings, Ph.D., during cross-examination. Specifically, Petitioner pointed to Patent Owner's arguments regarding the asserted prior art that (1) it would not have been obvious to combine the teachings of Vellacott and Kenue because there was no reasonable expectation of success that the proposed modified system would work, (2) Vellacott fails to teach "pattern recognition," as recited in claim 28 of the challenged patent, and (3) Vellacott has not been shown to be prior art under 35 U.S.C. §§ 102(a) or 102(b). *See* Paper 19, 25–30, 48–49, 88. Petitioner further argued that Patent Owner has inconsistent information in its possession because Dr. Etienne-Cummings testified that documentation regarding the commercial device described in Vellacott would have been provided to Donnelly Corporation ("Donnelly"), the original assignee of the challenged patent. Petitioner requested documents inconsistent with Patent Owner's statements about the device described in Vellacott, depositions of the named inventors of the challenged patent, and an admission from Patent Owner as to Vellacott's status as a prior art

² A court reporter, retained by Petitioner, was present on the call. Petitioner filed a transcript of the call as Exhibit 1012.

reference. Patent Owner opposed Petitioner's requests, arguing that they are untimely and overbroad, and that Petitioner had not shown a basis for producing them as routine discovery or additional discovery.

We directed Petitioner to provide, by email after the call, the specific list of discovery it would request in a motion, if authorized. Petitioner provided the following list:

1. The datasheet(s), User Manual(s), and Library Reference(s) for the VLSI Vision Limited "Imputer" as described in Exhibit 1004 ("CMOS In Camera" by Oliver Vellacott) and used by Donnelly Corporation in development of electro-chromic rearview mirrors, which automatically reduce headlamp glare from behind, including:
 - a. *"Imputer . . . User Manual"*, VLSI Vision Limited,
 - b. *"Imputer . . . IP Library Reference"*, VLSI Vision Limited,
2. The Datasheet(s), User Manual(s), and Library Reference(s) for the VLSI Vision Limited ASIS #1011 device cited in the '001 Patent.

Upon further consideration, we are not persuaded that Petitioner has shown a basis for authorizing a motion to compel routine discovery or for additional discovery. With respect to routine discovery, Petitioner's speculation that the listed materials are in Patent Owner's possession (via its purchase of Donnelly), and that they might contain inconsistent information, is not sufficient under 37 C.F.R. § 42.51(b)(1)(iii). In addition, the arguments in Patent Owner's Response pertain to the merits of Petitioner's obviousness analysis, i.e., whether Vellacott teaches certain claim limitations and whether the challenged claims would have been obvious based on Vellacott and other references. Petitioner has not explained

sufficiently why the additional documents it seeks would be inconsistent with positions taken by Patent Owner regarding what *Vellacott* teaches.

For similar reasons, Petitioner has not explained sufficiently how it could demonstrate that producing the requested materials (if available to Patent Owner) would be “necessary in the interest of justice” to justify a motion for additional discovery. *See* 35 U.S.C. § 316(a)(5); 37 C.F.R. § 42.51(b)(2); *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001 (PTAB Mar. 5, 2013) (Paper 26). At issue in this proceeding is what *Vellacott* teaches to a person of ordinary skill in the art and what would have been obvious to a person of ordinary skill in the art based on *Vellacott* and the other cited references. Patent Owner made various arguments in its Response on those issues, and Petitioner is free to dispute those arguments in its Reply if it disagrees. Further, as reflected in the transcript of the conference call, Patent Owner indicated that it was not challenging whether *Vellacott* is prior art, contrary to assertions made in Patent Owner’s Response. *See* Paper 19, 86–88 (asserting that Petitioner “failed to prove that *Vellacott* is prior art”).

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner is not authorized to file any discovery motion at this time.

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