

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

MAGNA ELECTRONICS, INC. ,)	
Plaintiff,)	
)	No. 1:12-cv-654; 1:13-cv-324
-v-)	
)	HONORABLE PAUL L. MALONEY
TRW AUTOMOTIVE HOLDINGS CORP.,)	
TRW AUTOMOTIVE US LLC, and)	
TRW VEHICLE SAFETY SYSTEMS INC.,)	
Defendants.)	
_____)	

**OPINION AND ORDER GRANTING DEFENDANT’S MOTION
FOR PARTIAL SUMMARY JUDGMENT UNDER THE
DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING**

This matter is before the Court on TRW’s motion for partial summary judgment as to claim 41 of the ‘149 patent. (ECF No. 583 *in* 1:12-cv-654; ECF No. 518 *in* 1:13-cv-324). TRW argues that the claim is invalid under the doctrine of obviousness-type double patenting. (*Id.*)

Legal Framework: Summary Judgment

Summary judgment is appropriate only if the pleadings, depositions, answers to interrogatories and admissions, together with the affidavits, show there is no genuine issue of material fact and that the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c); *Tucker v. Tennessee*, 539 F.3d 526, 531 (6th Cir. 2008). The burden is on the moving party to show that no genuine issue of material fact exists, but that burden may be discharged by pointing out the absence of evidence to support the nonmoving party’s case. *Bennett v. City of Eastpointe*, 410 F.3d 810, 817 (6th Cir. 2005) (quoting *Celotex*, 477 U.S. at 325).

The facts, and the inferences drawn from them, must be viewed in the light most favorable to the nonmoving party. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986) (quoting *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986)). Once the

moving party has carried its burden, the nonmoving party must set forth specific facts, supported by evidence in the record, showing there is a genuine issue for trial. Fed. R. Civ. P. 56(e); *Matsushita*, 475 U.S. at 586. The question is “whether the evidence presents a sufficient disagreement to require submission to the jury or whether it is so one-sided that one party must prevail as a matter of law.” *Anderson*, 477 U.S. at 251–252; see *Barrett v. Whirlpool Corp.*, 556 F.3d 502, 519 (6th Cir. 2009) (holding that “conclusory statements, subjective beliefs, or intuition cannot defeat” a summary judgment motion). The function of the district court “is not to weigh the evidence and determine the truth of the matter but to determine whether there is a genuine issue for trial.” *Resolution Trust Corp. v. Myers*, 9 F.3d 1548 (6th Cir. 1993) (citing *Anderson*, 477 U.S. at 249).

Legal Framework: Double Patenting

Obvious-type double patenting “is designed to prevent an inventor from securing a second, later expiring patent for the same invention.” *Abvie Inc. v. Mathilda & Terence Kennedy Inst. of Rheumatology Trust*, 764 F.3d 1366, 1373 (Fed Cir. 2014); see *Eli Lilly & Co. v. Barr Labs. Inc.*, 251 F.3d 955, 967–68 (Fed Cir. 2001) (Obvious-type double patenting was created “to prevent unjustified timewise extension of the right to exclude granted by a patent no matter how the extension is brought about.”). The Federal Circuit has noted that this “problem . . . exists” in a couple of contexts: “[1] [p]atents claiming overlapping subject matter that were filed at the same time still can have different patent terms due to examination delays at the PTO. . . . [and 2], [where] the applicant chooses to file separate applications for overlapping subject matter and to claim different priority dates for the applications, the separate patents will have different expiration dates since the patent term is measured from the claimed priority date.” *Abvie*, 764 F.3d at 1373. “When such situations arise, the doctrine of obviousness-type double patenting

ensures that a particular invention (and obvious variants thereof) does not receive an undue patent extension.” *Id.*

“[T]he doctrine of obviousness-type double patenting . . . appl[ies] where two patents that claim the same invention have different expiration dates”; therefore, a patent holder “is not entitled to an extra [term of] years of monopoly solely because it filed a separate application *unless the two inventions are patentably distinct.*” *Id.* at 1374 (emphasis added).

In order to determine whether the doctrine indeed applies, the Court must follow a two-step analysis: “First, the court ‘construes the claim[s] in the earlier patent and the claim[s] in the later patent and determines the differences.’ Second, the court ‘determines whether those differences render the claims patentably distinct.’” *Id.* (quoting *Sun Pharm. Indus., Ltd. v. Eli Lilly & Co.*, 611 F.3d 1381, 1385 (Fed. Cir. 2010)). Thus, a “later claim that is not patentably distinct from . . . an earlier claim is invalid for obviousness-type double patenting.” *Id.*

Patentable differences do not exist when later claims represent, for example, “minor linguistic difference[s],” “obvious variations,” are “slightly broader” or “merely a subset” of the earlier claims. *Georgia Pacific Corp. v. U.S. Gypsum Co.*, 195 F.3d 1322, 1327–28 (Fed. Cir. 1999). “A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim.” *Eli Lilly*, 251 F.3d at 968.

Further, the “case law firmly establishes that a later genus claim limitation is anticipated by, and therefore not patentably distinct from, an earlier species claim.” *Eli Lilly*, 251 F.3d at 971. When a later claim attempts to claim subject matter broader than an earlier claim, it does not claim identical subject matter under *statutory*-double patenting¹, but it is “anticipated by” the earlier, narrower claim under non-statutory double patenting. An example comes from *Perricone*

¹ The statutory basis for the doctrine stems from the Patent Act entitling a person to “a patent” for an invention. *See* 35 U.S.C. § 101; *Abvie*, 764 F.3d at 1373 (“The ban on double patenting ensures that the public gets the benefit of the invention after the original period of monopoly expires.”).

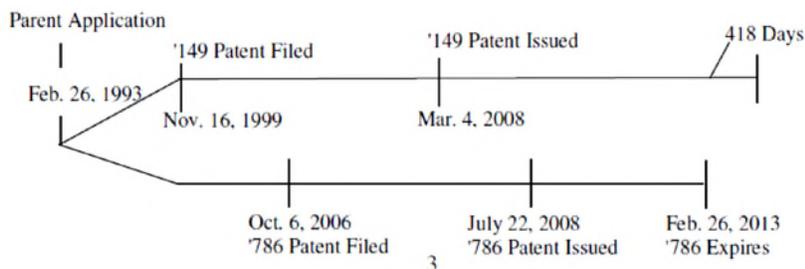
v. Medicis Pharma. Corp., 432 F.3d 1368, where the Federal Circuit upheld a trial court determination that an earlier species claim to a method of treating sun burn anticipated a later genus claim to a method of treating skin damage because “[s]unburn is a species of skin damage.” *Id.* at 1374 (“As such, this court perceives no error in the district court’s determination that the earlier species claim renders the later genus claim invalid under non-statutory double patenting.”).

As a final note, the Federal Circuit instructs courts to look to the expiration dates, not issuance dates, to determine whether a double patenting defense exists. *See Gilead Sciences Inc. v. Natco Pharma. Ltd.*, 753 F.3d 1208, 1217 (Fed. Cir. 2014) (“We therefore hold that an earlier-expiring patent can qualify as an obviousness-type double patenting reference for a later-expiring patent under the circumstances” where the later-expiring patent issued after the non-expired patent.”).

Analysis

TRW first argues that one of Magna’s asserted patents (the ‘149 patent) which claims a priority date of 1993 in the “Magna I” family should have expired in February of 2013, “like 28 other Magna I patents which claim priority back to the 1993 patent.” Indeed, as Defendants note, it appears the ‘149 patent’s term was adjusted by 418 days under 35 U.S.C. § 154(b).

Magna provides the following chart:



TRW argues that “[t]he ‘149 patent claim 41 is invalid as a non-patentably distinct variation of the ‘7[8]6 claim 6 or 7. *See* Ex. A (chart comparing claim language). The ‘149 patent was filed before the ‘7[8]6 patent and issued before the ‘7[8]6 patent. However, due to its patent term adjustment, the ‘149 patent still expired later than the ‘7[8]6 patent. Therefore, under *Gilead*, the ‘7[8]6 patent is an available reference for [obviousness-type double patenting].” (ECF No. 584 at PageID.21217.)²

It is true that the doctrine seeks to prevent the situation where non-patentably distinct claims have the same priority date but “different patent termination dates due to examination delays at the PTO.” *Id.* at 1373.³

Dr. Darrell, TRW’s technical expert, opined on invalidity, including under double patenting and non-infringement regarding the ‘149 patent. (*See* ECF No. 585-4 at PageID.21308.) Magna’s expert provides a rebuttal on double patenting, but the Court finds Mr. Nranian’s rebuttal largely unpersuasive. For example, Mr. Nranian opined that a later issued patent (but still earlier expiring one) cannot be used for double patenting. (ECF No. 585-5 at PageID.21340–41.) This is a clear misstatement of the law, as TRW notes. *See Gilead*, 753 F.3d at 1217. Regardless, however, it’s the Court’s duty to interpret and apply the law.

TRW notes that Magna failed to file a terminal disclaimer knowing that it contained similar claims to an earlier expiring patent, and that plainly, the claims are not patentably distinct. Magna argues first that the patent office did not reject either ‘149 or ‘786 because they were patentably distinct, second, *Gilead* should not apply here, and third, the claims at issue here are patentably distinct.

² TRW periodically refers to a “726 patent” rather than the correct “786 patent” at issue.

³ A patent applicant may avoid the consequence of invalidity for obviousness-type double patenting by filing a “terminal disclaimer,” which ensures the later expiring patent with similar claims will not enjoy a longer term than the original patent term which the patentee received. Magna did not file such a disclaimer on the ‘149 patent.

a. Patent Office Involvement

Magna's first argument is unpersuasive. The fact that the Patent Office—including one examiner that examined the '786 patent and a small portion of the '149 patent—is not relevant here. As TRW notes, “[t]he '149 patent was not primarily examined by the same examiner.” (ECF No. 641 at PageID.27398.) And even if it was, a trial court can still invalidate a patent under this doctrine. The Patent Office occasionally makes mistakes. However, here, it's not even clear that the primary examiner was aware of the '786 claims when issuing the '149 patent.⁴

Further, the examiner did not consider the '786 patent when issuing the '149 patent after its complicated reexamination. As TRW aptly notes, “[t]he only fact Magna cites to support this is that *during the prosecution of the '786 patent*, Magna provided the examiner with a citation to the interference proceeding regarding the '149 patent. . . . This at best shows that the examiner knew about the '149 patent *while examining the '786 patent*, not the other way around. Nothing cited to by Magna indicates that the examiner was aware of the '786 claims when issuing the '149 patent.” (ECF No. 641 at PageID.27399.)

b. Gilead and Expiration Versus Issuance Dates

Gilead is indistinguishable from this case for purposes of deciding whether the doctrine can apply here.

TRW correctly notes that *Gilead* stands for the simple proposition that a court should look to the expiration dates not the issuance dates to determine if a patent can be used as the prior art patent under the doctrine. The Court stated:

Looking instead to the earliest expiration date of all the patents an inventor has on his invention and its obvious variants best fits and serves the purpose of the doctrine of double patenting. Permitting any earlier expiring patent to serve as a double patenting reference for a patent subject to the URAA guarantees a stable

⁴ Interestingly, the '786 patent *was itself provisionally rejected for double patenting*. (ECF No. 641-1 at PageID.27407.)

benchmark that preserves the public's right to use the invention (and its obvious variants) that are claimed in a patent when that patent expires.

Furthermore, using the expiration date as a benchmark in post-URAA cases of obviousness-type double patenting preserves the ability of inventors to use a terminal disclaimer of later-expiring patents to create one expiration date for their term of exclusivity over their inventions and obvious variants, “which is tantamount for all practical purposes to having all the claims in one patent.” *Braithwaite*, 379 F.2d at 601. Such disclaimers would preserve the public's right to use a patented invention and obvious modifications of it when the earliest patent expires and would effectively overcome any objection to improper term extension.

Indeed, looking to the expiration date instead of issuance date is consistent with the PTO's guidance in the Manual of Patent Examining and Procedure (“MPEP”). The MPEP presents a hypothetical where two pending patent applications filed by the same inventor are subject to provisional obviousness-type double patenting rejections over each other. *See* MPEP § 804.I.B.1. In such a situation, the MPEP instructs that a terminal disclaimer is required for the later of the two applications (which the hypothetical anticipates to have the later expiration date) before that application can issue. *See id.* Applied to the facts here, a terminal disclaimer would have been required for the '483 patent.

We therefore hold that an earlier-expiring patent can qualify as an obviousness-type double patenting reference for a later-expiring patent under the circumstances here. In cases where such obviousness-type double patenting is present, a terminal disclaimer can preserve the validity of the later-expiring patent by aligning its expiration date with that of the earlier-expiring patent. That disclaimer will most effectively enforce the fundamental right of the public to use the invention claimed in the earlier-expiring patent and all obvious modifications of it after that patent's term expires.

Gilead, 753 F.3d at 1216–17.

In fact, another district court recently concurred with TRW's analysis of the case: “The Federal Court has recently explained that expiration dates, not issuance dates, are determinative in assessing a double patenting defense.” *Koninklijke Philips N.V. v. Zoll Med. Corp.*, No. CIV.A. 10-11041, 2014 WL 2810206, at *2 (D. Mass. June 20, 2014). Magna notes that “double

patenting is to prevent unjustified timewise extension of the right to exclude granted by a patent *no matter how the extension is brought about.*” (See ECF No. 622 at PageID.24653.) Magna argues that the extension is “justified” because there are differences in the claims. But Magna’s analysis is circular, and of course, true, if the two patents are patentably distinct.

Here, the ‘149 patent expires almost fourteen months after the ‘786 patent and each has the same inventor and assignee. Thus, since *Gilead* applies and Magna’s claims are subject to possible application of the doctrine, we must proceed to examine the claims themselves.

c. Patentably Distinct Differences

First, the court ‘construes the claim[s] in the earlier patent and the claim[s] in the later patent and determines the differences.’ Second, the court ‘determines whether those differences render the claims patentably distinct.’” *Abbvie*, 764 F.3d at 1374 (quoting *Sun Pharm. Indus., Ltd. v. Eli Lilly & Co.*, 611 F.3d 1381, 1385 (Fed. Cir. 2010)). If a “later claim . . . is not patentably distinct from . . . an earlier claim[, the later claim] is invalid for obviousness-type double patenting.” *Id.*

Construing the Claims and Determining the Differences

With regard to this motion, both parties recognize that the Court must compare one claim to another claim (or two related claims). Thus, the later issued claim 41 of the ‘149 patent must be compared to the earlier issued claim 6 (or 7) of the ‘786 patent. The chart on the following two pages assist with the Court’s analysis.

Claim 41, '149 Patent	Claim 6, '786 Patent
41. A control system for automatically controlling the high beam state of the headlamps of a controlled vehicle comprising:	6. A control system for automatically controlling the state of the headlamps of a controlled vehicle, said control system comprising:
an optical system for imaging external sources of light within a predetermined field of view onto an image sensor containing a plurality of pixels,	an optical system for imaging external light emitting sources within a predetermined field of view, said optical system including an image array sensor, said image array sensor comprising a CMOS pixelated imaging array; said pixelated imaging array comprising a plurality of light-sensing pixels arranged on a substantially planar semiconductor substrate;
said optical system configured to selectively transmit one or more predetermined spectral bands of light, and	said optical system further comprising a first spectral filter for passing visible light that is within a first spectral region that generally corresponds with the visible light spectral signature of a taillight of a vehicle, said first spectral filter substantially attenuating light having a wavelength greater than about 830 nanometers;
said optical system configured to image light within each predetermined spectral band onto particular portions of said image sensor; and	said optical system imaging visible light passing via said first spectral filter onto a first predetermined array portion of said pixelated imaging array; said optical system imaging visible light passing via a second spectral filter onto a second predetermined array portion of said pixelated imaging array; wherein each of said first and second predetermined array portions of said pixelated imaging comprises a respective predetermined array portion of contiguous pixels; and

Claim 41, '149 Patent	Claims 6 and 7, '786 Patent
an image processing system for processing images from said optical system and providing a control signal for controlling the high beam state of the headlamps	an image processing system for processing images from said optical system and for providing a control signal for controlling the state of headlamps of the controlled vehicle
as a function of the output of one or more pixels within one of said portions relative to the output of other pixels within the same portion.	as a function of the output of at least one pixel sensing light passing via said first spectral filter and the output of another at least one pixel sensing light passing via said second spectral filter. 7. The control system of claim 6, wherein at least one of (a) said second spectral filter encompasses at least a spectral portion of said first spectral filter, (b) said second spectral filter encompasses at least a spectral portion of said first spectral filter and wherein said first spectral filter comprises a red filter that passes visible light of wavelength generally in the visible red spectral band and that substantially attenuates light having wavelengths outside the visible red spectral band, (c) said second spectral filter comprises a blue filter that passes visible light of wavelength generally in the visible blue spectral band and that substantially attenuates light having wavelengths outside the visible blue spectral band and (d) said optical system comprises a first lens and a second lens arranged to image said predetermined field of view onto respective ones of said first and second array portions of said pixelated imaging array and wherein light passing through said first lens and said first spectral filter reaches said first array portion

TRW argues that there is no question that the two patents are not patentably distinct. On balance, TRW prevails. TRW's reply brief successfully addresses each of the five differences that Magna alleges create a patentably distinct claim from the '786 claims.

The first issue, the "high beam" state in the preamble does not distinguish the '149 patent. The Federal Circuit provides the genus-species framework in *Abbvie*, 764 F.3d at 1379,

noting that “when a ‘genus is so limited that a person of ordinary skill in the art can ‘at once envisage each member of this limited class,’ . . . a reference describing the genus anticipates every species within the genus.” *Id.* The genus claim in the ‘786 patent claim anticipates the ‘149 patent. Magna even admits that controlling the “state of headlamps” (‘786 claim) includes a “high beam state.” (ECF No. 622 (“controlling the ‘state of the headlamps’ encompasses off, low and high beam states.”).)

The second issue is the effect of the omission of the CMOS limitation in the ‘149 patent claim. An omission of a limitation alone in the ‘149 patent claim does not render it non-obvious. *See U.S. Gypsum*, 195 F.3d at 1327. TRW correctly notes that “[a]ny time a CMOS array containing a plurality of pixels is used as required by the expired ‘786 claim 6 it would infringe the non-expired claim of the ‘149 patent.” (ECF No. 641 at PageID.27401.)

The third issue is that the ‘149 claims include “configured to selectively transmit” light, whereas the ‘786 claims include a “spectral filter for passing visible light.” TRW’s expert explained the following regarding the ‘786 claim: “[b]y only passing light within a first spectral region, the first spectral filter is selectively transmitting bands of light.” (ECF No. 584.) TRW also points to another patent by Bayer, which highlighted the (non-)difference of these phrases. (ECF No. 641 at PageID.27402.) Magna’s expert counters that the ‘786 patent claim 6’s inclusion of “attenuating light having a wavelength greater than 830 nanometers” is a patentable distinction; yet Magna’s expert also admits this makes the ‘149 claim “broader.” The Federal Circuit has noted that the failure to claim a limitation (because the non-expired claim is then broader) is not a patentable distinction. *See U.S. Gypsum*, 195 F.3d at 1327.

The fourth alleged distinction is that the ‘149 patent requires imaging light “onto particular provisions of said image sensor,” whereas the ‘786 patent specifies that the portions

comprise “contiguous pixels.” Even Magna’s expert essentially agrees that the ‘149 patent would be infringed if a sensor was used where the “particular portions” were “contiguous.” (ECF No. 584-1 at PageID..) For the purposes of this analysis, pixels can either be “contiguous” or “non-contiguous.” “When a genus by its very definition only has two species, one of which is in the later claim, that claim is anticipated.” *Eli Lilly & Co.*, 251 F.3d at 971 (“[C]ase law firmly establishes that a later genus claim limitation is anticipated by, and therefore not patentably distinct from, an earlier species claim.”). One of ordinary skill would find no patentable distinction here.

Finally, with regard to claim 6, the Court finds persuasive TRW’s argument that the scope of the ‘786 patent claims and the ‘149 patent claim is the same. As to claim 6, the following provides:

‘149 Claim 41 (non-expired “target” claim)	‘786 Claim 6 (expired “prior art” claim)
as a function of the output of one or more pixels within one of said portions relative to the output of other pixels within the same portion.	as a function of the output of at least one pixel sensing light passing via said first spectral filter and the output of another at least one pixel sensing light passing via said second spectral filter.

The plain text above illuminates the similarities (and non-patentably distinct nature) of the claims. There are only two differences in the claims here: (1) the ‘149 patent calls for analyzing two pixels within the same spectral band (“within the same portion”) whereas the ‘786 patent claims “at least one pixel” within a spectral band; and (2) the ‘786 patent further calls for analyzing at least one pixel from another filtered portion.

The ‘786 claim already calls for “a portion” to be multiple pixels. In addition, the phrase “at least one pixel” is a genus with two species: only one pixel or more than one pixel. *See Rhine v. Casio, Inc.*, 183 F.3d 1342, 1345 (Fed. Cir. 1999) (“Use of the phrase ‘at least one’ means that

there could be only one or more than one.”). The ‘149 patent claims one of these two species: “more than one pixel.” Again, when a genus by its definition only has two species, one of which is in the later claim, that claim is anticipated. *See Eli Lilly & Co.*, 251 F.3d at 971 (“[C]ase law firmly establishes that a later genus claim limitation is anticipated by, and therefore not patentably distinct from, an earlier species claim.”).

With respect to the latter difference, Magna’s expert entered an errata to his report stating a POSITA would *know* the ‘149 patent covers the situation where the ‘786 patent calls for analyzing at least one pixel from another filtered portion. Since the ‘149 patent claim does not exclude analyzing at least one pixel from another filtered portion as called for in ‘786 claim 6, one of ordinary skill would find no patentably distinct differences here.

Based upon Magna’s allegations as to the scope of claim 41 of the ‘149 patent, claim 6 alone renders the claim invalid under obviousness-type double patenting doctrine. Nonetheless, even analyzing claim 7 reveals no patentably distinct differences. Claim 7 states that the second filter of claim 6 can “encompass[] at least a spectral portion of said first spectral filter.” Under this claim, the spectral bands transmitted through the filter specifically are claimed as being at least the same spectral band. Under claim 7, the first spectral band and second spectral band could both pass “blue light.” The function is the same for both claims. The same hypothetical situation would infringe both because the “output” that ultimately controls the headlamps would be the same—it would be based upon the same underlying function of comparing two pixels with the same spectral band of light.

The Court thus GRANTS TRW’s motion for partial summary judgment (ECF No. 583) and DECLARES claim 41 of the ‘149 patent INVALID under the doctrine of obviousness-type

double patenting. The '149 patent should have expired in February 2013, like 28 other Magna I patents which claim priority back to the 1993 application (including the '786 patent).

ORDER

For the reasons contained in the accompanying opinion, TRW's "Motion for Partial Summary Judgment of Invalidity Due to Obviousness Type Double Patenting for Patents Claiming a 1993 Priority Date" is **GRANTED** (ECF No. 583 *in* 1:12-cv-654; ECF No. 518 *in* 1:13-cv-324). Claim 41 of the '149 patent is **DECLARED INVALID** for double patenting.

IT IS SO ORDERED.

Date: December 10, 2015

/s/ Paul L. Maloney
Paul L. Maloney
United States District Judge