

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LEDVANCE LLC, GENERAL ELECTRIC COMPANY, CONSUMER
LIGHTING (U.S.), LLC D/B/A GE LIGHTING, CURRENT LIGHTING
SOLUTIONS, LLC, AND OSRAM SYLVANIA, INC.

Petitioner,

v.

CAO LIGHTING, INC.,
Patent Owner.

IPR2023-00123
Patent 6,465,961 C2

Before GRACE KARAFFA OBERMANN, CHRISTOPHER M. KAISER,
and BRIAN D. RANGE, *Administrative Patent Judges*.

RANGE, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Review

35 U.S.C. § 314

Granting Motion for Joinder

35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

LEDVANCE LLC (“LEDVANCE”), OSRAM Sylvania, INC. (“OSRAM”), General Electric Company, Consumer Lighting (U.S.), LLC d/b/a GE Lighting (“GE”), and Current Lighting Solutions, LLC (“Current”) (together “Petitioner”) filed a Petition (Paper 3, “Pet.”) seeking *inter partes* review of claims 21, 22, 25, 26, 28–30, 32–36, 40–44, 47–49, 52, 53, 56–59, 62, 63, 65–68, 71–73, 77, 78, 81, 82, 85, 86, and 88–91 (the “Challenged Claims”) of U.S. Patent No. 6,465,961 C2 (“the ’961 patent”), assigned to CAO Lighting, Inc. (“Patent Owner”). Petitioner also filed a motion for joinder to be joined as a petitioner to *Wolfspeed, Inc. and Ideal Industries Lighting, LLC d/b/a Cree Lighting v. CAO Lighting*, IPR2022-00847, filed April 8, 2022, and instituted October 19, 2022 (“the Cree IPR” with the Petitioners in that matter referred to herein as “Cree”). Paper 2 (“Mot.”).

Patent Owner filed an opposition to the Motion for Joinder. Paper 7. (“Opp.”) Petitioner filed a Reply to the Opposition to Motion for Joinder. Paper 9 (“Reply”). Patent Owner also filed a Waiver of Preliminary Response to Petition wherein Patent Owner maintains that joinder would be inappropriate. Paper 18 (“Waiver”).

For the reasons described below, we institute an *inter partes* review of the challenged claims and grant Petitioner’s Motion for Joinder.

II. RELATED PROCEEDINGS

Petitioner states that the ’961 patent is asserted in the following district court actions: *CAO Lighting, Inc. v. Cree, Inc. et al.*, No. 1:21-cv-00634 (M.D.N.C.); *CAO Lighting, Inc. v. GE Lighting, Inc.*, No. 1:20-cv-

00681 (D. Del.)¹; *CAO Lighting, Inc. v. OSRAM Sylvania Inc. et al.*, No. 1:20-cv-00690 (D. Del.); *CAO Lighting, Inc. v. Feit Electric Company, Inc.*, No. 2:20-cv-04926 (C.D. Cal.); *CAO Lighting, Inc. v. Lights of America, Inc.*, No. 5:20-cv-02367 (C.D. Cal.); *CAO Lighting, Inc. v. Topaz Lighting Corp.*, No. 2-21-cv-08912 (C.D. Cal.); and *CAO Lighting, Inc. v. Signify NV f/k/a Philips Lighting NV et al.*, No. 2-21-cv-08972 (C.D. Cal.). Pet. 126–127. Patent Owner identifies the following additional district court proceedings: *CAO Group v. GE Lighting et al.*, 2-11-cv-0042 (D. Utah) and *CAO Lighting, Inc. v. Light Efficient Design et al.*, 4-16-cv-00482 (originally filed in D. Id.), 1-17-cv-07359 (transferred to N. D. Ill.). Paper 6, 1–2. Patent Owner also identifies the following Patent Office proceedings: the Cree IPR; *Inter Partes* Reexamination Control No. 95/000,680 (USPTO); *Inter Partes* Reexamination Control No. 95/002,324 (USPTO); *Ex Parte* Reexamination Control No. 90/012,957 (USPTO); *Feit Electric Company, Inc. v. CAO Lighting, Inc.*, IPR2023-00129 (PTAB); *Signify North America Corporation v. CAO Lighting, Inc.*, IPR2023-00213 (PTAB); and *Signify North America Corporation v. CAO Lighting, Inc.*, IPR2023-00214 (PTAB). *Id.*

In the Cree IPR, we instituted an *inter partes* review of claims 21, 22, 25, 26, 28–30, 32–36, 40–44, 47–49, 52, 53, 56–59, 62, 63, 65–68, 71–73, 77, 78, 81, 82, 85, 86, and 88–91 of the ’961 patent on the following grounds:

¹ Patent Owner reports a jury verdict in its favor in this matter. Prelim. Resp. 4.

Claims Challenged	35 U.S.C. §	References/Basis
21, 22, 25, 26, 28–30, 32–36, 40–44, 47–49, 52, 53, 56–59, 62, 63, 65–68, 71–73, 77, 78, 81, 82, 85, 86, 88–91	103(a)	Begemann, ² Krames, ³ Allen ⁴
21, 22, 25, 26, 28–30, 32–36, 40–44, 47–49, 52, 53, 56–59, 62, 63, 65–68, 71–73, 77, 78, 81, 82, 85, 86, 88–91	103(a)	Begemann, Nakamura ⁵ , Allen, Krames
21, 22, 25, 26, 28–30, 32–36, 40–44, 47–49, 52, 53, 56–59, 62, 63, 65–68, 71–73, 77, 78, 81, 82, 85, 86, 88–91	103(a)	Begemann, Sugiura ⁶ , Allen, Krames

Cree IPR, 10, 45–46 (PTAB Oct. 19, 2022) (“Cree Dec.”).

III. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same grounds of unpatentability as the ones on which we instituted review in the Cree IPR. *Compare* Pet. 12–124, *with* Cree Dec. 10, 45–46. Indeed, Petitioner contends that the Petition and evidence Petitioner relies upon is “identical to the grounds in the Cree IPR petition.” Mot. 1. Petitioner acknowledges that the Petition relies on a different expert; however, Petitioner asserts that “the expert declaration of Dr. Christian Wetzel (Ex. 1021, “Wetzel Decl.”), [] is substantively identical to the declaration put forth in the Cree IPR.” *Id.* at 2. Petitioner further states that Dr. Wetzel agrees with the opinions of Cree’s expert and “adopts them as his own.” *Id.* at 2, n. 1.

² WO 00/17569, published March 30, 2000, Ex. 1007 (“Begemann”).

³ Krames et al., *High-brightness AlGaInN light-emitting diodes*, Proc. SPIE 3938, LIGHT-EMITTING DIODES: RESEARCH, MANUFACTURING, AND APPLICATIONS IV (2000), Ex. 1008 (“Krames”).

⁴ WO 99/57945, published November 11, 1999, Ex. 1011 (“Allen”).

⁵ US 5,777,350, issued July 7, 1998, Ex. 1009 (“Nakamura”).

⁶ US 6,015,979, issued January 18, 2000, Ex. 1010 (“Sugiura”).

Patent Owner waives its preliminary response, and it does not dispute Petitioner's arguments or evidence. *See generally* Waiver.

Thus, for the same reasons set forth in our institution decision in the Cree IPR, we determine that the information presented in the Petition shows a reasonable likelihood that Petitioner would prevail in showing that claims 21, 22, 25, 26, 28–30, 32–36, 40–44, 47–49, 52, 53, 56–59, 62, 63, 65–68, 71–73, 77, 78, 81, 82, 85, 86, and 88–91 are unpatentable. *See* Cree Dec. 17–45. Accordingly, we institute an *inter partes* review of the same claims on the same grounds as the ones on which we instituted review in the Cree IPR.

For the above reasons, we institute an *inter partes* review. 35 U.S.C. § 314(a).

IV. MOTION FOR JOINDER

The Petition in this proceeding was accorded a filing date of October 31, 2022. *See* Paper 4. The Cree IPR was instituted on October 19, 2022. Cree Dec. Petitioner filed a Motion for Joinder on October 31, 2022. Paper 2. Thus, Petitioner's Motion for Joinder is timely because joinder was requested no later than one month after the Cree IPR. *See* 37 C.F.R. § 42.122 (b).

The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads:

If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join as a party to that *inter partes* review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

A motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, 4 (PTAB Apr. 24, 2013) (Paper 15).

The Petition in this case asserts the same unpatentability grounds on which we instituted review in the Cree IPR. *See* Mot. 5. Petitioner states that it uses “the same arguments, analysis, evidence, and grounds of unpatentability as the Cree IPR.” *Id.* Thus, this *inter partes* review does not present any ground or matter not already at issue in the Cree IPR.

Petitioner agrees that, if joinder is granted, it will have a “true understudy role.” Reply. 1–2. Petitioner agrees to various restrictions as a true understudy and further agrees to *any further limitations the Board may impose*. Reply 2; Mot. 7–8 (“Petitioner will also abide by any additional conditions the Board deems appropriate”). Along these lines, Petitioner will abide by the following conditions so long as Cree is actively participating in this proceeding:

1. Petitioner will not take any depositions or otherwise participate in the proceeding (Reply 2);
2. Petitioner will not rely on its own witness declarations (*id.*);
3. Petitioner will not raise any new grounds, argument, or discovery requests (Mot. 7);
4. Petitioner will be bound by any agreement between Patent Owner and Cree regarding discovery and depositions (*id.*);
5. Cree and all joined Petitioners will collectively designate attorneys to conduct cross-examination of any witnesses and the time limits for

- such cross-examination will not go beyond that permitted to the Cree Petitioner unless otherwise agreed to by the parties;
6. Cree and all joined Petitioners will collectively designate attorneys to present consolidated oral argument at the final oral hearing (if requested) or during conference calls;
 7. Petitioner will not introduce substantive argumentative papers relating to the Cree IPR petition; and
 8. For purposes of the consolidated proceeding, Petitioner is bound by every paper filed by and every representation made by Cree except for papers and representations regarding settlement.⁷

The conditions above mean that joinder will have no impact on the Cree IPR trial schedule and will not complicate the Cree IPR briefing or discovery.

These understudy provisions are consistent with the provisions imposed by, for example, *Ecobee Techs. ULC v. EcoFactor, Inc.*, IPR 2022-01460, IPR2022-00473, Paper 7 (PTAB Jan. 24, 2023) and *Apple Inc. v. INVT SPE LLC*, IPR2019-00959, Paper 8 (PTAB May 30, 2019).

Patent Owner argues that joinder will increase the complexity and cost of the Cree IPR because Petitioner presents testimony from a different expert declarant. Opp. 2. Patent Owner argues that it is entitled to depose Petitioner's new declarant, Dr. Wetzel, and that Dr. Wetzel has "personal experience" that Cree's declarant, Dr. Lebby, will not share. *Id.* at 3. Patent Owner further argues that such a deposition would derail the Cree IPR schedule. *Id.* at 5.

⁷ If special circumstances arise such that Petitioner seeks an exception to one of these conditions, Petitioner must seek authorization from the Board after conducting a meet-and-confer with Patent Owner and Cree.

Petitioner, here, agrees not to rely on the declaration of Dr. Wetzel as long as Cree remains an active participant in the proceeding. Reply 2. As such, there is no need at this time for Patent Owner to depose Dr. Wetzel. Any differences, including different personal experiences, between the opinions of Dr. Wetzel and Dr. Libby have no relevance so long as Petitioner is not relying on the deposition of Dr. Wetzel. Thus, joinder will not in any way complicate the already instituted Cree IPR.

Patent Owner further argues that Petitioner should not “file any papers or evidence, nor participate in any way in the preparation of any filings made by the active petitioners.” Waiver 4. Patent Owner also argues that Petitioner should not “participate in the examination of any witnesses in any way (including attendance), nor assist any witness or the active petitioners in preparing for such examination” and that Petitioner should not “participate in any conference call, hearing, or argument before the Board, nor assist any witness or the active petitioners.” *Id.* at 5. These restrictions are too broad. Petitioner could, for example, file a motion for *pro hac vice* or attend depositions without disrupting the Cree IPR. Also, if attorneys for Petitioner assist Cree behind the scenes, this will not disrupt the Cree IPR. We are not inclined to restrict Petitioner in the manner Patent Owner suggests. Nonetheless, we tailor the restrictions on Petitioner above in a manner to prevent disruption to the ongoing Cree IPR.

If Cree ceases to actively participate in the Cree IPR, then the Board will consider what procedural modifications are necessary. We ask the parties to inform us expeditiously if Cree ceases to actively participate in the Cree IPR or if Cree reaches settlement, formal or informal, with regard to the Cree IPR.

Thus, we agree with Petitioner that joinder with the Cree IPR is appropriate under the circumstances. Accordingly, we *grant* Petitioner's Motion for Joinder.

V. CONCLUSION

For the above reasons, we institute an *inter partes* review. 35 U.S.C. § 314(a).

VI. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted as to claims 21, 22, 25, 26, 28–30, 32–36, 40–44, 47–49, 52, 53, 56–59, 62, 63, 65–68, 71–73, 77, 78, 81, 82, 85, 86 and 88–91 of the '961 patent based on all grounds set forth in the Petition;

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), an *inter partes* review of claims 21, 22, 25, 26, 28–30, 32–36, 40–44, 47–49, 52, 53, 56–59, 62, 63, 65–68, 71–73, 77, 78, 81, 82, 85, 86 and 88–91 of the '961 patent shall commence on the entry date of this Decision, and notice is hereby given of the institution of trial;

FURTHER ORDERED that Petitioner's Motion for Joinder with Case IPR2022-00847 is GRANTED, and Petitioner is hereby joined as a Petitioner in IPR2022-00847;

FURTHER ORDERED that the grounds on which trial in Case IPR2022-00847 were instituted are unchanged and no other grounds are added in IPR2022-00847;

FURTHER ORDERED that the Scheduling Order entered in IPR2022-00847 along with any schedule changes agreed by the parties are not affected by joinder;

FURTHER ORDERED that Petitioner will abide by the eight conditions stated above;

FURTHER ORDERED that if special circumstances arise such that Petitioner seeks an exception to one of these conditions, Petitioner must seek authorization from the Board after conducting a meet-and-confer with Patent Owner and Cree;

FURTHER ORDERED that the parties will inform the Board within four business days if Cree reaches settlement, formal or informal, with regard to IPR2022-00847 or otherwise ceases to actively participate in the IPR2022-00847;

FURTHER ORDERED that the case caption in IPR2022-00847 shall be changed to reflect joinder of all joined parties;

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2022-00847; and

FURTHER ORDERED that all further filings shall be made in IPR2022-00847.

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