

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CURRENT LIGHTING SOLUTIONS, LLC
D/B/A GE CURRENT,
Petitioner

v.

JIAXING SUPER LIGHTING ELECTRIC APPLIANCE CO., LTD.,
Patent Owner

IPR2023-00269
Patent 10,560,989 B2

**PETITIONER'S PRELIMINARY REPLY
TO PATENT OWNER'S PRELIMINARY RESPONSE**

PETITIONER'S EXHIBIT LIST

Exhibit	Shorthand	Description
1001	'989 Patent	U.S. Patent No. 10,560,989
1002	'989 File History	Prosecution History of U.S. Patent No. 10,560,989
1003	Ackley	Declaration of Donald E. Ackley, Ph.D.
1004	Ackley CV	CV of Donald E. Ackley, Ph.D.
1005	Li	Chinese Patent Publication 103899939A to Li Certified Translation
1006	Ono	Japanese Patent Publication JP 2014-103000A to Ono et al. Certified Translation
1007	Guang	U.S. Patent No. 9,338,853 to Guang
1008	Miyamichi	U.S. Patent No. 8,779,679 to Miyamichi
1009	Xu	Chinese Patent Publication 2802892Y to Xu Certified Translation
1010	Liu	<i>LED Packaging for Lighting Applications – Design, Manufacturing and Testing</i> , Sheng Liu et al., Chemical Industry Press (2011)
1011	Garbowicz	U.S. Patent No. 5,616,990 to Garbowicz et al.
1012	Deng	Chinese Patent No. CN203797412U to Deng Certified Translation
1013	Draft Stipulation	Draft Stipulation of Invalidity Contentions, <i>Jiaxing Super Lighting Electric Appliance Co., Ltd. et al. v. Current Lighting Solutions, LLC d/b/a GE Current</i> , Civil Action No. 6:22-cv-00534-ADA (W.D. Tex. 2022)
1014	Zhang	U.S. Patent No. 10,104,723 to Zhang
1015	Halliwell	U.S. Patent No. 9,206,970 to Halliwell et al.
1016		Omitted
1017	Litigation Scheduling Order	Scheduling Order, <i>Jiaxing Super Lighting Electric Appliance Co., Ltd. et al. v. Current Lighting Solutions, LLC d/b/a GE Current</i> , Civil Action No. 6:22-cv-00534-ADA (W.D. Tex. 2022)
1018	<i>CH Lighting</i> JPTO	Proposed Joint Final Pretrial Order, <i>Jiaxing Super Lighting Electric Appliance Co., Ltd. v. CH Lighting Technology Co., Ltd.</i> , No. 6:20-cv-00018, Dkt. 173 (W.D. Tex. Sept. 9, 2021)

Exhibit	Shorthand	Description
1019		Appeal Docketed, <i>Jiaxing Super Lighting Electric Appliance Co., Ltd. v. CH Lighting Technology Co., Ltd.</i> , No. 23-1715 (Fed. Cir. Apr. 7, 2023)
1020		Federal Circuit Case Statistics
1021		Purchase Order
1022		Current Lighting Conditions of Purchase, available at https://www.gecurrent.com/sites/default/files/documents/Current-Conditions-of-Purchase.pdf
1023		Summary of LED Tube Lamp Purchases by Current Lighting
1024		Declaration of Gino Marella
1025		Revised Draft Litigation Stipulation
1026		Redacted Version of Ex. 1024

I. Introduction

PO contends that Ruising is an RPI or privy of Petitioner, first because Ruising was also sued for infringement of the '989 Patent in the earlier *Ruising* Litigation. But PO fails to identify a link between Petitioner and that litigation, which was filed more than a year before PO's relied-on Supply Agreement (Ex. 2006) and appears to have tried no claims against Ruising involving Petitioner LED tubes. PO next relies on the Supply Agreement, and particularly Ruising's indemnity obligations contained therein. But those indemnity obligations reflect Petitioner's standard conditions of purchase from any supplier and would, at best, mandate that Ruising defend PO's infringement claims against Petitioner, for [REDACTED] of PO's total accused tubes. Inconsistent with those indemnity obligations, it was Petitioner, without any input or funding from Ruising, that prepared and filed this Petition. PO's arguments and evidence fall short of even calling into question Petitioner's RPI identifications, and in any event should be denied: Petitioner filed this Petition because PO sued Petitioner with this (and 10 other) patents, not at Ruising's behest.

II. The Circumstances of the *Ruising* Litigation Foreclose Privity

Privity and its preclusive impact present a due process issue that is not assessed in a vacuum, and that issue under §315(b) concerns mainly two questions: “whether the petitioner and the prior litigant’s relationship—as it relates to the lawsuit—is sufficiently close that it can be fairly said that the petitioner had a full

and fair opportunity to litigate the validity of the patent in that lawsuit” and “whether the petitioner is simply serving as a proxy to allow another party to [re-]litigate the patent validity.” *WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1319 (Fed. Cir. 2018).

As to the first question, PO references the *Ruising* Litigation (POPR at 3) but fails to identify a preclusive connection between Ruising and Petitioner related to that litigation (*see generally* POPR).¹ This is because PO cannot, as (1) Petitioner was not a party to the *Ruising* Litigation; (2) the *Ruising* Litigation was filed more than a year before Petitioner entered into PO’s relied-upon Supply Agreement; and (3) per its pre-trial order, the *Ruising* Litigation appears to have tried no claims against Ruising involving Petitioner LED tubes. *See* Ex. 1018 at 8-9 (accusing “[d]efendant Elliot”—not Ruising—of selling “GE Current BDT series” tubes).

As to the second, proxy question, PO touts a March 17, 2023 verdict (Ex. 2005 at 5) in the *Ruising* Litigation, finding that “Ruising ... infringed three of Patent Owner’s patents.” POPR at 3. That verdict was docketed for appeal on April 7, 2023 (Ex. 1019 at 1), and that appeal will likely be decided by August 15, 2024 based on recent average-time-to-decision data (Ex. 1020 at 7). Notably, this is

¹ PO’s privity arguments regarding the ’989 Patent are particularly weak given that the *Ruising* Litigation did not go to trial on the ’989 Patent. POPR at 3.

before the August 17, 2024 FWD date in this proceeding and well before any such FWD would become “final,” rendering illogical any argument that Petitioner is now representing Ruising’s interests in the *Ruising* Litigation.

And in any event, unlike in *Ventex*, Petitioner—even if the Supply Agreement or similar was in place—would have been the indemnatee, who was not sued for infringement of the ’989 Patent in the *Ruising* Litigation (*see* Ex. 2006 at 22). *Compare Ventex Co. Ltd. v. Columbia Sportswear N.A., Inc.*, IPR2017-00651, Paper 148 at 7 (P.T.A.B. Jan. 24, 2019) (“Supplier Agreement ... required [Petitioner] Ventex to indemnify ... Seirus”) (cleaned-up). The notion that Petitioner, as the non-sued indemnatee, already had a full and fair opportunity to litigate the validity of the ’989 Patent in the *Ruising* Litigation or is now acting on behalf of its alleged indemnitor (for [REDACTED] of accused products) strains credibility.

III. PO’s “Preexisting Legal Relationship” Nevertheless Fails

PO relies exclusively on a Supply Agreement (Ex. 2006) between Petitioner and Ruising to establish a “preexisting legal relationship.” *See generally* POPR. This Supply Agreement, however, [REDACTED] (Ex. 2006 at 1), [REDACTED]. When procuring LED tube lamps, Petitioner issues purchase orders to Ruising—as it does with its other suppliers—pursuant to conditions of purchase that are available on the internet. Ex. 2021 at 1; Ex. 2022; Ex. 1024 at ¶¶ 5-6. Notably, those conditions of purchase, which

supersede the Supply Agreement (*see* Ex. 1022 at 21), do not include the Supply Agreement's provisions related to [REDACTED]

[REDACTED]
(*see generally* Ex. 1022) upon which PO relies (*see, e.g.*, POPR at 3-5). Those provisions are therefore irrelevant.

The conditions of purchase do contain an indemnity provision for Petitioner's suppliers—including Ruising—to “handle, defend or settle” any infringement claim based on a product provided under the conditions of purchase. *See* Ex. 1022 at 11. But as evidenced by the conditions of purchase being available on the internet (*see* Ex. 1024 at ¶ 6), this constitutes nothing more than “generic indemnification obligations” that do not support a finding of privity. *See R.R. Donnelley & Sons Co. v. Scriptchek Visual Verification Sys. Inc.*, IPR 2021-00564, Paper 56 at 35-36 (P.T.A.B. Sept. 6, 2022).

Beyond that, the products potentially covered by Ruising's indemnity obligations constitute [REDACTED] of the total number of LED tubes alleged to infringe the '989 Patent in the *Current* Action, which include those produced by numerous non-Ruising manufacturers. Ex. 1024 at ¶ 7 (citing Ex. 1023). Particularly when viewed with this context, the notion that Petitioner filed this petition to benefit Ruising, its alleged indemnitee, rather than itself, fails.

IV. Ruising Has No Control Over the Proceeding

A non-party's ability to control a proceeding remains a central inquiry in the RPI and privity analysis. *See VirnetX Inc. v. Mangrove Partners Master Fund, Ltd.*, 778 Fed. Appx. 897, 902-03 (Fed. Cir. 2019) (evidence that a non-party did not “exercise[] any control over these proceedings ... support[ed] the Board’s finding that [the non-party] did not need to be named as a[n] RPI”). Here, only Petitioner directs, controls, and funds this proceeding (Ex. 1024 at ¶ 8), meaning Ruising is not an unnamed RPI. *See Unified Patents Inc. v. Uniloc USA, Inc.*, IPR2018-00199, Paper 33 at 8-9 (P.T.A.B. May 31, 2019).

V. Petitioner Will Moot *Fintiv*

In the interest of efficiency, Petitioner will file a *Sotera* stipulation (Ex. 1025) in the related litigation in order to moot the *Fintiv* issues raised by PO (*see* POPR at 37-42). *See* Director’s Interim Guidance at 7.²

Dated: June 21, 2023

Respectfully submitted,

/Eagle H. Robinson/

Eagle H. Robinson (Reg. No. 61,361)

² Available at: https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621.pdf

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on June 21, 2023, copies of Petitioner's Preliminary Reply and EX1018-EX1025 were served on Patent Owner via email (by consent) to:

IPRSuperLighting-GECurrent@perkinscoie.com

/Eagle H. Robinson/
Eagle H. Robinson (Reg. No. 61,361)