

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

IPR2023-00270
Patent 9,723,662 B2

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

PETITIONER'S EXHIBIT LIST

Exhibit	Shorthand	Description
1001	'662 Patent	U.S. Patent No. 9,723,662
1002	Baker	Expert Declaration of Dr. R. Jacob Baker
1003		CV of Dr. R. Jacob Baker
1004	Zhang	U.S. Patent No. 10,045,406
1005	Tao	U.S. Patent App. Pub. No. 2016/0174307
1006	Langovsky	U.S. Patent No. 8,330,381
1007		<i>MaxLite, Inc. v. Jiaxing Super Lighting Electric Appliance Co., Ltd.</i> , IPR2020-00181, Paper 1 (PTAB Nov. 25, 2019)
1008		<i>MaxLite, Inc. v. Jiaxing Super Lighting Electric Appliance Co., Ltd.</i> , IPR2020-00181, Paper 7 (PTAB May 26, 2020)
1009		Excerpts of the '662 Patent prosecution history
1010	Litigation Scheduling Order	Scheduling Order, <i>Jiaxing Super Lighting Electric Appliance Co., Ltd. v. Current Lighting Solutions LLC</i> , No. 6:22-cv-00534, Dkt. 31 (W.D. Tex. Dec. 12, 2022)
1011		U.S. Patent No. 9,338,853
1012		U.S. Patent No. 5,616,990
1013	D'Andrade Report	Excerpts of the Infringement Report of Dr. D'Andrade, <i>Jiaxing Super Lighting Electric Appliance Co., Ltd. v. MaxLite, Inc.</i> , Case No. 2:19-cv-04047 (C.D. Cal.)
1014		Draft Litigation Stipulation
1015		U.S. Patent No. 8,888,976
1016		Infringement Contentions, Cover Pleading and Claim Chart C
1017		U.S. Patent No. 8,441,824
1018		U.S. Patent No. 7,256,505
1019		U.S. Patent No. 7,557,521
1020		U.S. Patent No. 9,148,922
1021		U.S. Patent No. 6,703,795
1022		OMITTED
1023		U.S. Patent No. 8,841,897
1024		U.S. Patent No. 8,792,253
1025		U.S. Patent No. 8,134,297

Exhibit	Shorthand	Description
1026		U.S. Patent No. 3,731,148
1027		U.S. Patent App. Pub. No. 2016/0345394
1028		U.S. Patent No. 7,966,075
1029		U.S. Patent App. Pub. No. 2012/0256551
1030		U.S. Patent App. Pub. No. 2012/0038289
1031		OMITTED
1032		U.S. Patent App. Pub. No. 2013/0076255
1033		U.S. Patent No. 9,237,610
1034		U.S. Patent App. Pub. No. 2013/0234620
1035		U.S. Patent App. Pub. No. 2012/0206433
1036		U.S. Patent App. Pub. No. 2014/0009076
1037		U.S. Patent App. Pub. No. 2014/0084701
1038		U.S. Patent App. Pub. No. 2012/0300501
1039		U.S. Patent App. Pub. No. 2012/0147564
1040		U.S. Patent No. 9,066,403
1041		U.S. Patent App. Pub. No. 2010/0265732
1042		PCT App. No. WO 2014/115010
1043		U.S. Patent No. 8,247,999
1044		Complaint, <i>Jiaxing Super Lighting Electric Appliance Co., Ltd. v. MaxLite, Inc.</i> , Case No. 2:19-cv-04047, Dkt. 1 (C.D. Cal. May 8, 2019)
1045		Exhibit 14 to Complaint, <i>Jiaxing Super Lighting Electric Appliance Co., Ltd. v. MaxLite, Inc.</i> , Case No. 2:19-cv-04047, Dkt. 1-14 (C.D. Cal. May 8, 2019)
1046		Exhibit 15 to Complaint, <i>Jiaxing Super Lighting Electric Appliance Co., Ltd. v. MaxLite, Inc.</i> , Case No. 2:19-cv-04047, Dkt. 1-15 (C.D. Cal. May 8, 2019)
1047		Revised Draft Litigation Stipulation
1048		First Amended Complaint, <i>Jiaxing Super Lighting Electric Appliance Co., Ltd. v. Current Lighting Solutions, LLC</i> , No. 6:22-cv-00534, Dkt. 12 (W.D. Tex. Sept. 16, 2022)

I. *General Plastic* is Inapplicable: There Is No Relationship Between MaxLite and Petitioner (Factor 1)

PO attempts to draw a “Significant Relationship” between prior petitioner MaxLite and Petitioner here under *General Plastic* factor 1 because CH Lighting was identified as a real party in interest in MaxLite’s IPR petition, CH Lighting and its subsidiary, Ruising, were listed “as parties having a financial interest in the [MaxLite] litigation,” and Ruising is one of Petitioner’s manufacturers. POPR at 36-37 (emphasis added).

The only legal support for this tenuous argument is PO’s citation to *Valve* (*id.*), in which two petitioners had a significant relationship because, *inter alia*, they were “codefendants ... were accused of infringing [a] patent based on the same product.” *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 at 9-10 (P.T.A.B. Apr. 2, 2019) (Precedential) (emphasis added). But MaxLite and Petitioner have never been co-defendants, and MaxLite was accused of infringing the ’662 Patent for its own “MaxLite_L13T8DF440-CG4” and “MaxLite_L25T5DF450-CG4” products (Ex. 1044 at 9-10 (“infringing products ... identified in Exhibits 14-15”); Ex. 1045 (Exhibit 14) at 2; Ex. 1046 (Exhibit 15) at 2), which are competing products to Petitioner’s. There is therefore no “significant relationship” between MaxLite and Petitioner under factor (1). *See Google Inc. v. Uniloc 2017*, IPR2020-00396, Paper 11 at 11 (P.T.A.B. Aug. 3, 2020) (“direct

competitors ... sued separately” “weighs against finding a significant relationship”); *see also* Petition at 5.

And with no significant relationship, factors (2)-(5) of *General Plastic* are irrelevant. *See Google LLC v. Parus Holdings, Inc.*, IPR 2020-00847, Paper 9 at 22-25 (P.T.A.B. Oct. 21, 2020).

II. The Timing of the Petition was Dictated by PO (Factors 2-5)

The MaxLite IPR Petition was denied institution on May 26, 2020 (Ex. 1008 at 1), over two years before PO sued Petitioner with the '662 Patent on September 16, 2022 (Ex. 1048 at 2). The present Petition was diligently filed three months into Petitioner's twelve-month statutory window in response to PO's lawsuit. Thus, “this subsequent challenge against the ['662 Patent]”—including its timing—is “a result of [PO's] litigation activity, rather than Petitioner's abuse of the review process,” and denial under *General Plastic* is unwarranted. *See Nearmap US, Inc. v. Eagle View Techs., Inc.*, IPR2022-01090, Paper 9 at 8-9 (P.T.A.B. Jan. 12, 2023); *see also Apple, Inc. v. UUSI*, IPR2019-00358, Paper 12 at 15-19 (P.T.A.B. Aug. 5, 2019) (finding factors (2)-(5) weighed in favor of institution: “Petitioner could not have ‘delay[ed]’ its Petition to gain a strategic advantage by learning from [an earlier] IPR because, by the time [PO] sued Petitioner, the [earlier] IPR was already complete.”).

Moreover, and setting aside that the present Petition challenges claims not challenged in and raises arguments distinct from MaxLite's Petition (Petition at 5, 9), PO's road-mapping contentions (POPR at 37-38) ring hollow: "there is no policy reason for discretionary denial of institution where, as here, Petitioner, when filing a Petition *after* being sued for infringement, takes into account prior proceedings that occurred *before* it was sued." *Apple*, IPR2019-00358, Paper 12 at 17.

III. Petitioner Will Moot *Fintiv*

In the interest of efficiency, Petitioner will file a Sotera stipulation (Ex. 1047) in the related litigation in order to moot the *Fintiv* issues raised by Patent Owner (see POPR at 29). See Director's Interim Guidance at 7.¹

Dated: June 21, 2023

Respectfully submitted,

/Eagle H. Robinson/

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

¹ 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 EX1044-EX1048 were served on Patent Owner via email (by consent) to:

IPRSuperLighting-GECurrent@perkinscoie.com

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