

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.

Case No. IPR2023-00271

Patent No. 10,295,125

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

Exhibit List

Exhibit	Description
Ex. 2014	Email thread containing May 11, 2021 email serving GE Current documents in response to Patent Owner subpoena
Ex. 2015	Defendants' Motion to Strike Final Infringement Contentions (Public / Redacted Version), <i>Jiaxing Super Lighting Electric Appliance Co., Ltd. v. CH Lighting Technology Co., Ltd.</i> , No. 6:20-cv-00018-ADA (W.D. Tex.), Dkt. 88
Ex. 2016	Order Denying Defendants' Motion to Strike Final Infringement Contentions, <i>Jiaxing Super Lighting Electric Appliance Co., Ltd. v. CH Lighting Technology Co., Ltd.</i> , No. 6:20-cv-00018-ADA (W.D. Tex.), Dkt. 123
Ex. 2017	Declaration of Miguel Bombach in support of Patent Owner's Sur-Reply to Petitioner's Preliminary Reply
Ex. 2018	Excerpt of hearing transcript for discovery hearing on Aug. 25, 2021, <i>Jiaxing Super Lighting Electric Appliance Co., Ltd. v. CH Lighting Technology Co., Ltd.</i> , No. 6:20-cv-00018-ADA (W.D. Tex.), Dkt. 152
Ex. 2019	Excerpt of jury trial transcript from Nov. 1, 2021, <i>Jiaxing Super Lighting Electric Appliance Co., Ltd. v. CH Lighting Technology Co., Ltd.</i> , No. 6:20-cv-00018-ADA (W.D. Tex.)
Ex. 2020	Supplemental Exhibit 7.1 to Supplemental Expert Report of Patent Owner's damages expert, Lauren R. Kindler dated Oct. 26, 2021 (redactions added)

I. INTRODUCTION

Petitioner's Reply to the POPR fails to meet Petitioner's burden of persuasion to show that Ruising is not its privy or an RPI. Regarding privity, Petitioner mischaracterizes the law and the *Ruising* litigation, and makes a spurious argument that its detailed Supply Agreement with Ruising was supplanted by generic purchase terms it tries to impose on all suppliers. Regarding RPI, Petitioner only argues that Ruising is not controlling this proceeding because it cannot dispute its preexisting, established relationship with Ruising or that Ruising is a clear beneficiary of this proceeding.

II. RUISING AND PETITIONER ARE PRIVIES.

A. The *Ruising* Litigation Supports a Finding of Privity.

Petitioner mischaracterizes *WesternGeco* to suggest privity "mainly" concerns "two questions." Paper 15 ("Reply") at 1. On the contrary, the court identified the *six* *Taylor* factors. 889 F.3d 1308, 1319 (Fed. Cir. 2018).

Petitioner next argues the *Ruising* litigation cannot support a finding of privity because Petitioner was not a party, and the litigation was filed before Petitioner entered into the Supply Agreement. Reply at 2. Petitioner cites no legal support for this argument. Moreover, Petitioner cannot dispute that it entered into the Supply Agreement with Ruising while the *Ruising* litigation was pending or that it was aware that products Ruising manufactured for Petitioner were at issue in the

litigation. Indeed, Petitioner produced documents regarding accused Petitioner products in response to a subpoena in that litigation. Ex. 2014. Petitioner also cites no legal support for its argument that Ruising cannot be a privy since Petitioner is the indemnitee rather than indemnitor under the Supply Agreement. Reply at 3.

Petitioner also wrongly asserts that the *Ruising* litigation tried no claims against Ruising involving Petitioner LED tubes. Reply at 2. The *Ruising* defendants stipulated that Petitioner products infringed three patents that were tried. Ex. 2013 at 9-10. Indeed, the defendants *unsuccessfully* tried to strike PO's infringement contentions against Petitioner products, in part by trying to deny CH/Ruising manufactured the products. Exs. 2015, 2016. CH/Ruising produced both technical information and sales data for accused Petitioner products. Ex. 2017 (Bombach Decl.) ¶¶ 7-10; *see also* Ex. 2018 at 6:21-22; Ex. 2019 at 159:23-161:8 (reading into trial record CH/Ruising interrogatory response providing information about "accused products" including those "CH has manufactured for GE"). PO's damages expert accounted for CH/Ruising's sales of Petitioner products in her calculation of damages owed by CH/Ruising. Ex. 2017 ¶¶ 11-12; Ex. 2020 at 1, 4 (note (k)).

B. *Taylor* Factor 2 Supports a Finding of Privity.

Petitioner suggests the terms of the Supply Agreement are "irrelevant" because of additional generic purchase terms it tries to impose on all suppliers when they accept purchase orders from Petitioner. Reply at 3-4. As an initial matter,

Petitioner’s declarant, Mr. Marella, describes Ex. 1029 as the “current version” of its purchase terms (Ex. 1031 ¶ 6), and Petitioner presents no evidence that this version of its purchase terms was applicable to any (let alone all) of its orders from Ruising. As another initial matter, Petitioner identified and produced the Supply Agreement, and *only that agreement*, in response to PO’s discovery requests seeking its agreements with CH/Ruising.

Petitioner’s dubious claim that the terms of the Supply Agreement were supplanted by its generic purchase order terms is unsupported attorney argument. Indeed, Mr. Marella says *nothing* in his declaration about the Supply Agreement or any of its terms being ineffective. *See* Ex. 1031. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Petitioner next argues that the “indemnification obligations” in its standard purchase terms are too “generic” to support a finding of privity. Reply at 4. First, as discussed, Petitioner has not shown that [REDACTED]

Finally, Petitioner argues that Ruising cannot be a privy because Ruising has only provided [REDACTED] of the products accused of infringing the '125 patent in the *Current* litigation. Reply at 4. In *PayPal*, the Board rejected effectively the same argument by the petitioners that Amazon could not be a privy because the petitioners were not *exclusively* accused based on products supplied by Amazon. IPR2019-01111, Paper 27 at 26 (Nov. 22, 2019); *see also AIT*, 897 F.3d 1336, 1347 (Fed. Cir. 2018) (Congress “chose language that bars petitions where proxies or privies would *benefit* from an instituted IPR, *even where the petitioning party might separately have its own interest in initiating an IPR.*”) (second emphasis added).

Petitioner does not dispute that Ruising “is a clear beneficiary” of this

proceeding,¹ or that Ruising “has a preexisting, established relationship with” Petitioner. *See AIT*, 897 F.3d at 1351. Tellingly, Petitioner does not address *Ventex* which was the focus of PO’s RPI argument. *See* POPR at 15-17.

Petitioner’s only argues lack of control. Reply at 5. Neither case cited by Petitioner holds that control of the IPR proceeding is strictly necessary for a third party to be an RPI. Indeed, in *VirnetX*, the Federal Circuit explained that “[t]he real-party-in-interest inquiry ... ‘seeks to ascertain who, from a practical and equitable standpoint, will benefit from the redress that the chosen tribunal might provide.’” 778 F. App’x 897, 902 (Fed. Cir. 2019) (quoting *AIT*, 897 F.3d at 1349). Further, Petitioner does not dispute [REDACTED]

[REDACTED]

[REDACTED]

See POPR at 4-5.

IV. CONCLUSION

For the reasons set forth above and in the POPR, the Petition in this case is time-barred because Ruising is a privy of Petitioner and an RPI.

¹ Petitioner suggests Ruising cannot benefit from this IPR because its appeal may conclude *two days* before the FWD is due in this proceeding. Reply at 2. But the *Ruising* appeal could exceed the average time-to-decision and/or the FWD could issue early. CH/Ruising has already sought multiple extensions in the appeal.

Dated: July 5, 2023

Respectfully submitted,

/Patrick J. McKeever/

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CERTIFICATE OF SERVICE

I hereby certify that on this 5th day of July 2023, true and correct copies of the foregoing Patent Owner's Sur-Reply to Petitioner's Preliminary Reply to Patent Owner's Preliminary Response, and Exhibits 2014-2020 were served via electronic mail upon the following counsel of record for Petitioner:

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