

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioner,

v.

JIAXING SUPER LIGHTING ELECTRIC APPLIANCE CO., LTD.

Patent Owner.

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Case No. IPR2023-00272

Patent No. 10,830,397

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**PATENT OWNER'S PRELIMINARY RESPONSE**

## Table of Contents

|                                                                                                                                                       |    |
|-------------------------------------------------------------------------------------------------------------------------------------------------------|----|
| Exhibit List.....                                                                                                                                     | ii |
| I. Introduction .....                                                                                                                                 | 1  |
| II. The '397 Patent.....                                                                                                                              | 2  |
| III. Petitioner has not established a reasonable likelihood of proving any challenged claims invalid.....                                             | 5  |
| A. Ground 1 Based on Jing and Huang.....                                                                                                              | 5  |
| 1. A POSITA Would Not Have Been Motivated to Combine Jing and Huang.....                                                                              | 5  |
| 2. The Combination Fails to Disclose Elements 1[d], 8[f], and 14[d].....                                                                              | 12 |
| B. Ground 2 Based on Jing and Halliwell.....                                                                                                          | 14 |
| 1. Petitioner Has Failed to Meet Its Burden of Showing That A POSA Would Have Combined Jing with Halliwell.....                                       | 14 |
| 1. The Combination Fails to Disclose Elements 1[d], 8[f], and 14[d].....                                                                              | 18 |
| 2. The Combination Fails to Disclose Elements 1[g], 8[j], and 14[g].....                                                                              | 19 |
| C. Grounds 3-10.....                                                                                                                                  | 21 |
| IV. The Board Should Deny Institution Under 35 U.S.C. § 314(a) / <i>Fintiv</i> .....                                                                  | 22 |
| A. Legal Standard.....                                                                                                                                | 22 |
| B. The Co-Pending District Court Litigation.....                                                                                                      | 23 |
| C. Factor 1: The Court Has Not Stayed the District Court Case and Is Very Unlikely to Do So.....                                                      | 24 |
| D. Factor 2: The District Court's Trial Date is Four Months Before the Expected Date of any Final Written Decision.....                               | 25 |
| E. Factor 3: Both Parties And The Court Have Invested Substantial Effort Into This Case And Will Invest Even More Before an Institution Decision..... | 25 |
| F. Factor 4: Overlap Of Issues Raised In The Petition And District Court Case.....                                                                    | 26 |
| G. Factor 5: Petitioner and the Defendant in the District Court Case Are the Same Party.....                                                          | 26 |
| H. Factor 6: Fatal Flaws in the Petition Favor Discretionary Denial.....                                                                              | 26 |
| I. Conclusion .....                                                                                                                                   | 27 |
| V. Conclusion.....                                                                                                                                    | 28 |

**EXHIBIT LIST**

| <b>Exhibit</b> | <b>Description</b>                                                                                                                                                                                                                                            |
|----------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Ex. 2003       | Case Docket for <i>Jiaxing Super Lighting Electric Appliance Co., Ltd. and Obert, Inc. v. Current Lighting Solutions, LLC</i> , Case No. 6:22-CV-00534-ADA-DTG (W.D. Tex.)                                                                                    |
| Ex. 2004       | Scheduling Order in <i>Jiaxing Super Lighting Electric Appliance Co., Ltd. and Obert, Inc. v. Current Lighting Solutions, LLC</i> , Case No. 6:22-CV-00534-ADA-DTG (W.D. Tex.)                                                                                |
| Ex. 2005       | Defendant Current Lighting Solutions, LLC d/b/a GE Current's Preliminary Invalidity Contentions in <i>Jiaxing Super Lighting Electric Appliance Co., Ltd. and Obert, Inc. v. Current Lighting Solutions, LLC</i> , Case No. 6:22-CV-00534-ADA-DTG (W.D. Tex.) |

## **I. INTRODUCTION**

Current's Petition should be denied because the proposed obviousness combinations are fatally flawed. First, a POSITA would not have been motivated to combine the Jing and Huang references because the central teachings of the two references are directly at odds with one another. Specifically, Jing eliminates the type of mounting bracket that Huang relies on for improved structural durability. Moreover, even if a POSITA did combine the references, they fail to disclose a power supply disposed at one or both ends of the glass lamp tube as claimed.

Second, a POSITA would not have combined Jing with Halliwell. Petitioner's motivation arguments are conclusory and untethered to the references. Given Jing already addresses the need for heat dissipation, a POSITA would not have been motivated to extend Jing's circuit board beyond the lamp tube in hopes of achieving still greater heat dissipation. But even if a POSITA did combine the references, they fail to teach the power supply location required by the claims and also the requirement that the length of the light strip exceed the length of the main body portion of the lamp tube. Petitioner focuses on Halliwell's disclosure that the reflective back plate 19 extends into the end caps,

but ignores the fact that the surrounding lamp tube extends into the end caps as well.

Additionally, the Petition should also be denied under § 314(a) / *Fintiv* given the co-pending district court case that is set to go to trial several months before a final written decision would issue.

## **II. THE '397 PATENT**

The '397 Patent, titled "LED Lamp Tube" issued on Nov. 10, 2020 from a continuation application. The '397 patent claims priority to several earlier-filed U.S. applications filed between 2015 and 2017 and two Chinese applications filed in 2014 and 2015.

The '397 Patent describes improved LED tube lamp designs and features for improving such products by addressing issues such as light diffusion. *See, e.g.,* Ex. 1001 ("'397 Patent") at 2:42-44 (explaining that LED light sources are point light sources and emit highly concentrated light rays that are hard to be evenly distributed).

The '397 Patent discloses LED lamps containing light strips 2 that contain LEDs. '397 Patent at 8:7-9 ("Referring to FIG. 1 and FIG. 4A, the LED light strip 2 is disposed inside the glass lamp tube 1 with a plurality of LED light sources 202 mounted on the LED light strip 2.").

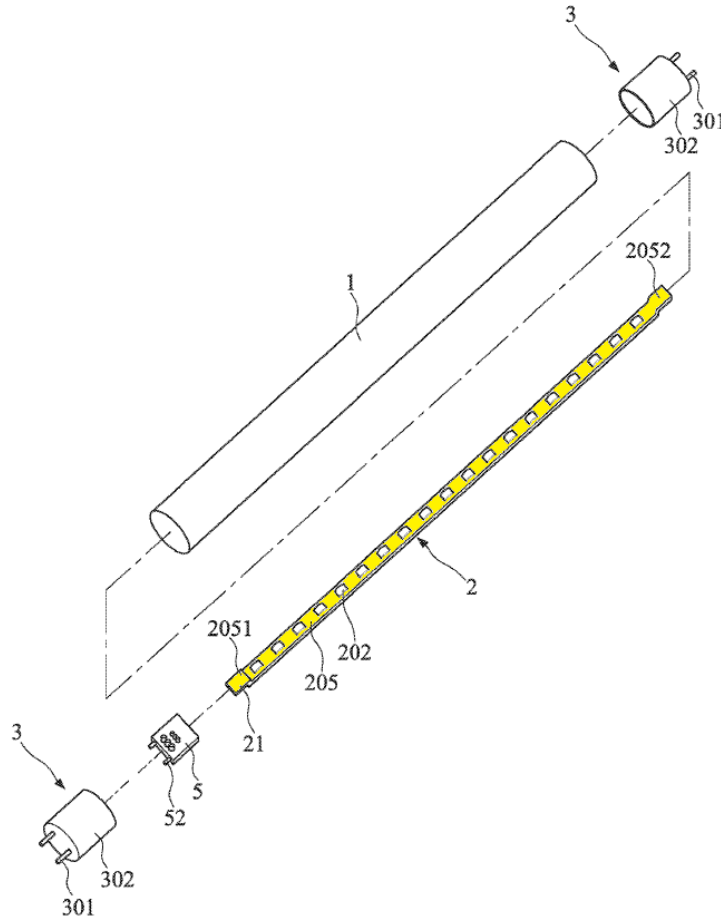


FIG.1

*Id.* at Fig. 1 (highlighting added).

The '397 Patent discloses the use of reflective films to reflect light from the LED sources in desired directions. *Id.* at 11:55-57 ("Referring to FIG. 30, in some embodiments, the glass lamp tube 1 may further include one or more reflective films 12 disposed on the inner surface of the glass lamp tube 1."); *see also id.* at 11:58-12:9; Fig. 30.

The '397 Patent further discloses diffusion films and coatings through which the light from the LEDs is transmitted. *Id.* at 12:10-14 ("Referring to FIG.

31, in some embodiments, the glass lamp tube 1 may further include a diffusion film 13 so that the light emitted from the plurality of LED light sources 202 is transmitted through the diffusion film 13 and the glass lamp tube 1.”); *see also id.* at 12:14-13:33; Fig. 31.

The '397 Patent also discloses that the lamp tube may include a rough inner surface for spreading light transmitted through it. *Id.* at 11:13-18 (“At least a part of the inner surface of the glass lamp tube 1 is formed with a rough surface and the roughness of the inner surface is higher than that of the outer surface, such that the light from the LED light sources 202 can be uniformly spread when transmitting through the glass lamp tube 1.”).

Fig. 31 (below) shows a cross-sectional view of a lamp tube embodiment that includes many of these features including reflective films 12, diffusion film 13, and inner roughness 17.

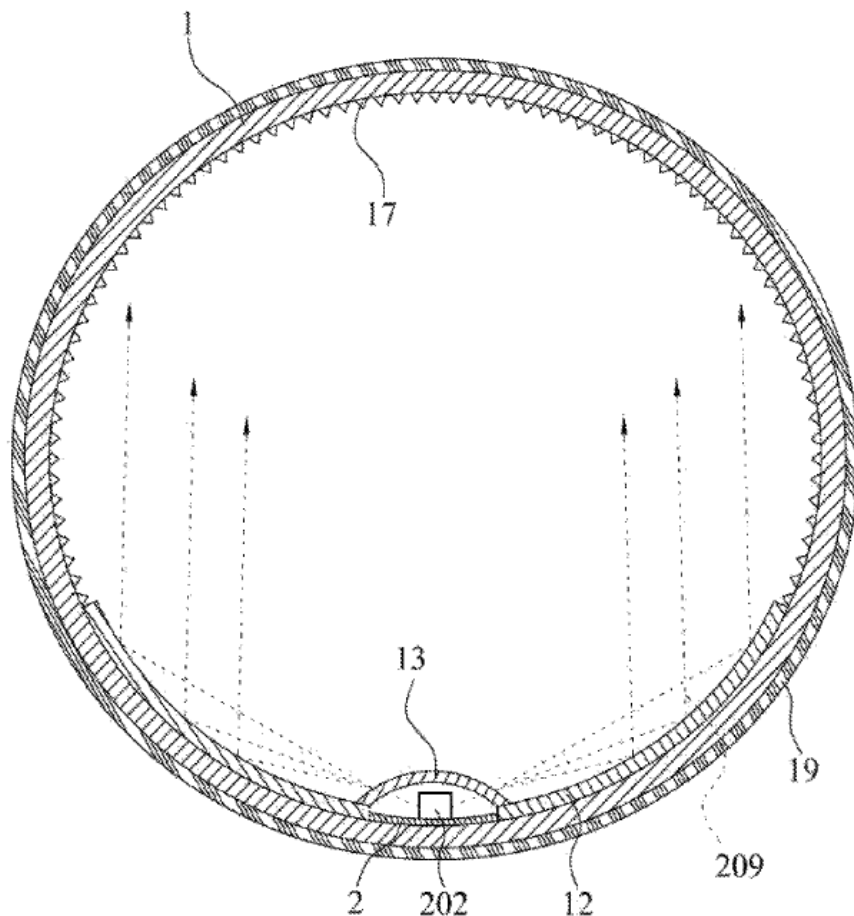


FIG.31

*Id.* at Fig. 17.

**III. PETITIONER HAS NOT ESTABLISHED A REASONABLE  
LIKELIHOOD OF PROVING ANY CHALLENGED CLAIMS  
INVALID.**

**A. Ground 1 Based on Jing and Huang**

**1. A POSITA Would Not Have Been Motivated to Combine  
Jing and Huang.**

A party asserting that a claimed invention is obvious “must demonstrate ...  
that a skilled artisan would have had reason to combine the teachings of the prior

art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success from doing so.” *PAR Pharm., Inc. v. TWI Pharm., Inc.*, 773 F.3d 1186, 1193 (Fed. Cir. 2014) (internal quotation marks omitted).

A POSITA would not have been motivated to combine Jing and Huang. As an initial matter, while both references relate to LED lamps, they have very different objectives. Jing’s objective is simply to reduce manufacturing cost of an LED lamp. Ex. 1002 (“Jing”) at Abstract; [0006] (“The technical problem to be solved is to reduce the manufacturing cost.”). Huang’s objective, on the other hand, is to improve structural durability and reduce breakage risk. Ex. 1003 (“Huang”) at 1:19-21. Jing says nothing whatsoever about structural durability or breakage and Huang says nothing whatsoever about reducing manufacturing cost. *See* Jing, Huang.

More importantly, the specific way in which Jing purports to reduce manufacturing cost is to eliminate a rigid mounting bracket that runs the length of the tube and provides a surface for mounting the PCB:

Compared with the prior art, the LED fluorescent lamp of the Utility Model uses the structure that directly fixes the LED circuit board with the same curvature as the inner wall of the lamp tube onto the inner wall of the lamp tube through the fixing layer. ***This omits the metal bracket***

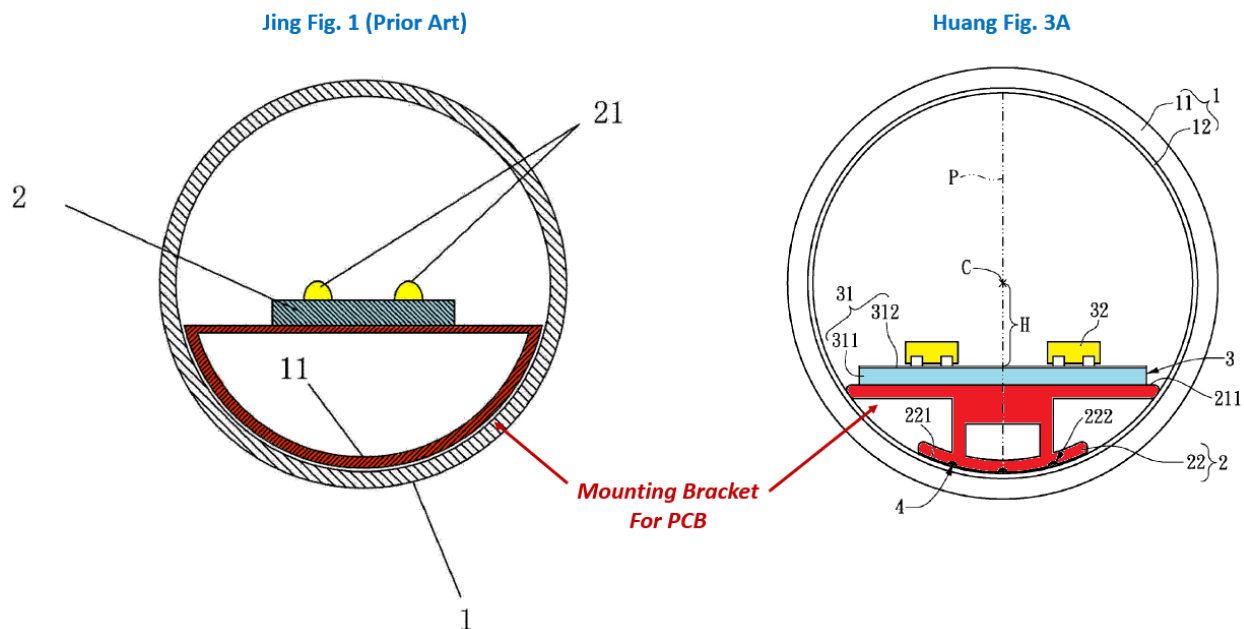
*used to fix the LED circuit board in the LED fluorescent lamp tube in the prior art, and greatly reduces the manufacturing cost of the LED fluorescent lamp.*

Jing at [0018] (emphasis added); *see also id.* at Abstract (“The structure that directly fixes the circuit board into the inner wall of the lamp tube through the fixing layer *omits the metal bracket used to fix the circuit board in the LED fluorescent lamp tube in the prior art, and greatly reduces the manufacturing cost of the LED fluorescent lamp.*”) (emphasis added); [0004] (describing prior art lamp in Fig. 1: “Each fluorescent lamp needs to be equipped with *a bracket with the same length as the lamp tube, so the manufacturing cost is high.*”) (emphasis added); [0028] (“This structure can fix the circuit board 2 onto the inner wall of the lamp tube 1 *without using the tube bracket, thereby greatly reducing the manufacturing cost of the LED fluorescent lamp.*”) (emphasis added).

Jing thus repeatedly states that the elimination of the mounting bracket is the key to reducing manufacturing costs. Moreover, Jing never points to anything other than the elimination of the mounting bracket as reducing manufacturing costs.

Turning to Huang, the specific way in which Huang purports to achieve its objective of improving structural durability involves using precisely the type of

mounting bracket that Jing proposes to eliminate. Indeed, Jing's Figure 1 depicting the prior art design with bracket 11 is very similar to Huang's figure showing base / mounting bracket 2.



Jing Fig. 1 (inverted, highlighting and annotation added); Huang Fig. 3A (highlighting and annotation added).

In describing figure 1, Jing explains that “the light emitting component includes a bracket 11 made of aluminum profiles extending from one end of the lamp tube to the other end, and a circuit board 2 fixed on the bracket ....” Jing at ¶ [0003]. Jing explains that the shape of the bracket is an arch with the arc part being connected to the inner wall of the lamp tube. *Id.* Similarly, Huang states that base 2 may be made of aluminum and “has an elongated shape corresponding

to the glass tube 1.” Huang at 2:44-47. Further, the bottom portion 22 of base 2 “has a circular arc surface 221.” *Id.* at 2:65-66.

Huang makes clear that base 2 is the key to the improved structural durability of the LED lamp because force is transferred from the lateral cover assemblies to the base and then to the glass tube rather than directly from the cover assemblies to the glass tube:

Thus, the length of the base 2 is larger than the length of the glass tube 1 for *providing the lateral cover assemblies 5 to be fixed on the end portions of the base 2 by a fixing means (e.g., screw or buckled)*. The *force is transferred* from the lateral cover assemblies 5 to the glass tube 1 *via the base 2, so that the force is uniformly dispersed to the glass tube 1 for preventing the glass tube 1 from loading the force directly and reducing the broken possibility of the glass tube 1 resulted from concentrating the force on a specific point*.

Huang at 6:59-67 (emphasis added). In the preferred embodiment, the lateral cover assemblies are fixed to the base with screws. *Id.* at 6:30-33; 6:46-50. In

Where, as here, the central teaching of one reference is to eliminate the structure the second reference treats as critical, a POSITA would not be motivated to combine the references. *See Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d

1353, 1360 (Fed. Cir. 1999) (“There is no suggestion to combine, however, if a reference teaches away from its combination with another source.”).

Even if a POSITA had a reason to combine Jing and Huang notwithstanding their incompatible core teachings, a POSITA would not have reasonably expected to successfully achieve the structural integrity benefits of Huang without using Huang’s base 2 as Petitioner proposes. While both references disclose circuit boards, neither suggests that a circuit board by itself would provide comparable structural integrity to Huang’s rigid base 2. Petitioner points to Jing’s disclosure that the circuit board may be “aluminum-based.” Pet. at 25. But aluminum is not always rigid—consider aluminum foil and aluminum cans. Dr. Lebby’s opinion is conclusory and repeats the attorney argument in the Petition. *Compare* Ex. 1004, ¶ 102 with Pet. at 25. Further, while Huang discloses that base 2 may be made of aluminum, Huang suggests the structural design of the base, not merely its material makeup provides its strength. Huang at 3:29-31 (“Thus, the ***strength of base 2 is increased*** for preventing deformation ***by the above structure design.***”). Neither Petitioner nor its expert provide any reason why a POSITA would expect a relatively thin arc-shaped PCB (*see, e.g.*, Jing at ¶ [0028]) even if it contains some aluminum would provide comparable strength to Huang’s base 2.

Petitioner asserts that a POSITA would have known that aluminum-based PCBs provide rigidity. Pet. at 7-8. The only evidence Petitioner and its expert cite to support this assertion is the Choi patent (Ex. 1012). Choi discloses specific PCB designs that do use aluminum in a “metal core layer 101.” Ex. 1012 at 3:10-26. Although Choi does state that its purportedly inventive PCB design has “increased heat dissipation and bending strength properties,” Choi does not suggest the use of aluminum in the PCB is solely responsible for these properties or that all PCBs including aluminum have these properties.

Petitioner’s reference to Choi does not cure the failings of the Jing-Huang combination. Petitioner chose not to include Choi as part of the obviousness combination, and nothing in Jing indicates that circuit board 2 is constructed according to Choi’s PCB design. *See, e.g., Helmerich & Payne Int’l Drilling Co. v. Nabors Drilling Techs. Usa, Inc.*, IPR2021-00671, Paper 12 at 19 (PTAB Oct. 1, 2021) (“Even if we were inclined to accept the alleged knowledge of the ordinary artisan to fill gaps left by the references listed in Petitioner’s ground, we would be looking for evidence that a concept was well known in the art, not merely ‘known’ in a single reference.”). Jing’s circuit board is arc-shaped and Choi’s is not. *Compare* Jing at Figs. 2-5 *with* Ex. 1012 (Choi) at Figs. 1-27. Nor does Choi’s vague reference to “increased ... bending strength” provide any concrete basis to conclude it would provide comparable rigidity to Huang’s base.

Accordingly, Petitioner has not demonstrated that a POSITA would have been motivated to combine Jing and Huang to achieve the claimed invention, or that a POSITA would have had a reasonable expectation of success in making the proposed combination.

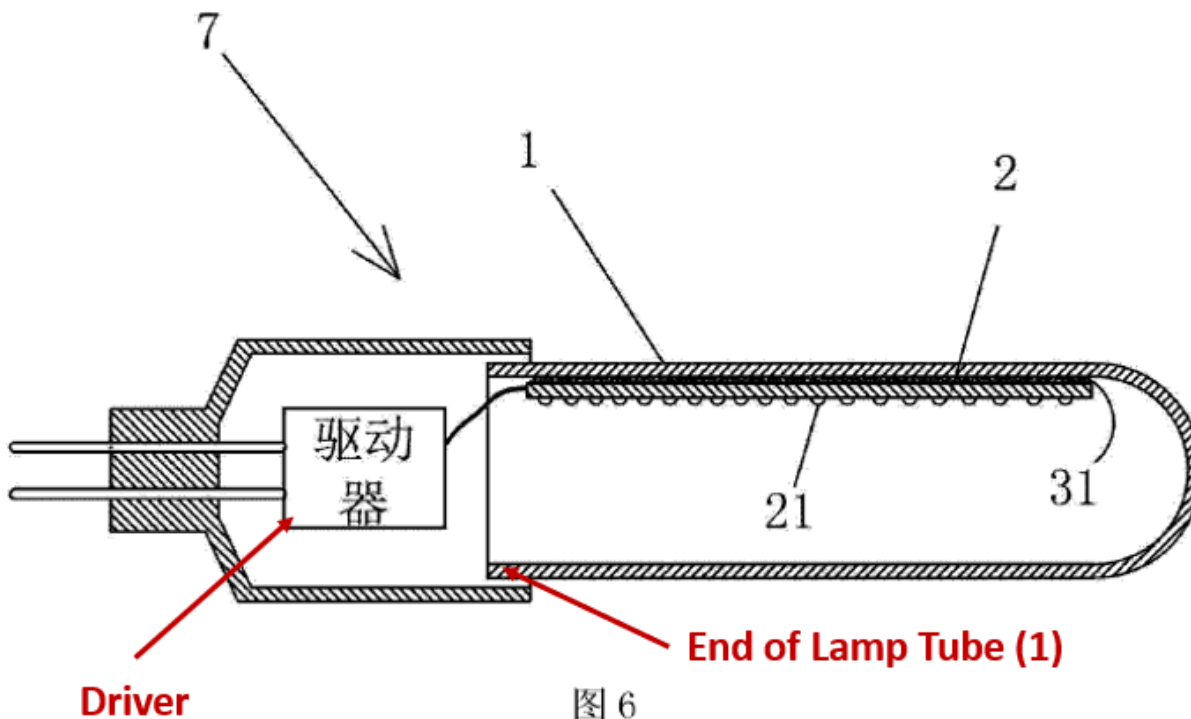
**2. The Combination Fails to Disclose Elements 1[d], 8[f], and 14[d]**

Element 1[d] recites: “a power supply disposed at one end or two ends of the glass lamp tube, the power supply electrically connected to the plurality of LED light sources[.]” Elements 8[f] and 14[f] are identical.

Petitioner relies on Jing for these elements. *See* Pet. at 38-39.<sup>1</sup> However, Jing does not disclose a power supply disposed at one end or two ends of the glass tube as claimed. Instead, Jing discloses a driver that is located within a plug that is connected to an end of the glass tube 1. As shown in Jing’s Figure 6, the driver itself is located completely outside the tube 1.

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<sup>1</sup> Although Petitioner also discusses some of Huang’s disclosures in connection with these elements (*see* Pet. at 40), Petitioner’s proposed combination does not incorporate Huang’s lamp tube or end caps. *See* Pet. at 25-27 (describing proposed combination).



Jing at Fig. 6 (annotations added). Similarly, the disclosures Petitioner cites from Jing state that *the plug* is located at an end of the lamp tube, not that the driver contained somewhere within the plug is located at an end of the lamp tube. See Pet. at 39 (quoting Jing at ¶¶ [0003] and [0027]).

Accordingly, Petitioner has failed to show that the proposed combination of Jing and Huang teaches or suggests elements 1[d], 8[f], and 14[d] of independent claims 1, 8, and 14. For at least this reason, Petitioner has not shown that claims 1, 8, and 14 are obvious based on Ground 1. Further, because the remaining challenged claims are dependent claims that depend from claims 1, 8, or 14, Petitioner has failed to show that Ground 1 renders any challenged claim obvious.

**B. Ground 2 Based on Jing and Halliwell**

**1. Petitioner Has Failed to Meet Its Burden of Showing That A POSA Would Have Combined Jing with Halliwell**

Petitioner's arguments as to why a POSITA would have combined Jing and Halliwell are conclusory, hindsight-driven, and largely untethered to the references themselves. *See Mentor Graphics Corp. v. In-Depth Test LLC*, IPR2017-02009, Paper 9 at 16-17 (PTAB Mar. 9, 2018) ("We require more definitive and specific reasoning for why a person of ordinary skill in the art would have combined the prior art teachings at the time of the invention to guard against hindsight basis.") (citing *KSR*, 550 U.S. 418); *see also, e.g., Juniper Networks, Inc. v. Smart Path Connections, LLC*, IPR2021-01356, Paper 27 at 47 (PTAB Jan. 19, 2023) (rejecting obviousness combination where "the articulated motivation to combine [wa]s overly general and [wa]s disconnected with the circumstances and requirements of [the primary reference]").

Petitioner begins by pointing out that Halliwell discloses a back cover 14 that provides improved heat dissipation. Pet. at 57. Petitioner does not argue that a POSITA would be motivated to modify Jing's lamp to include Halliwell's back cover 14, however. Indeed, Jing already discloses features to address heat dissipation including a thermally conductive adhesive layer 3 between the PCB and the tube and a heat sink 6. *See* Jing at [0011], [0018], [0037], Figs. 2-5.

Petitioner abruptly shifts from discussing Halliwell's back cover 14 to arguments that lengthening a circuit board can improve heat dissipation and provide other benefits. Pet. at 57. Notably, Halliwell says *nothing whatsoever* about lengthening the circuit board (or reflective back plate 19), let alone doing so in order to achieve improved heat dissipation or any of the other purported benefits Petitioner argues. See Halliwell. Accordingly, Petitioner's arguments do not persuasively demonstrate a POSITA would have had a reason to combine Jing and Halliwell in the manner Petitioner proposes.

Petitioner's heat dissipation arguments are also dubious given Petitioner is proposing to extend Jing's circuit board only in one direction and only a limited amount, and given that altering the spacing of the LEDs would directly impact light output, especially where end caps might block light output by LEDs near the ends of the extended circuit board. Additionally, Jing teaches that the thermal conductive layer is effective at cooling the lamp by transferring heat from the circuit board through the tube surface to the external environment. Jing at ¶ [0029]. If the circuit board were extended beyond the bounds of the lamp tube, as Petitioner seemingly proposes, there would be no thermal conductive layer under the extended portion of the circuit board to dissipate heat through the lamp tube surface. Without Jing's thermal conductive layer beneath it, the proposed extended region of the circuit board might very well *increase* heat buildup in the

lamp. Thus, the proposed modification is contrary to Jing’s teachings regarding heat dissipation.

Importantly, Halliwell never discloses lengthening the reflective back plate 19 beyond the length of glass tube, and Petitioner does not argue that it does. Instead, Petitioner points to Halliwell’s Figs. 7-9, 16, and 17 that purportedly show “reflective back plate 19 extends into end caps 11.” Pet. at 54-56. But Halliwell discloses that *the tube* formed by lens 13 (and optionally back cover 14) that surrounds the back plate *also extends into end caps 11*. Ex. 1008 (“Halliwell”) at 8:23-24 (“In various embodiments, some portion of the length of the lens 13 and back cover 14 is inserted into each end cap 11.”);<sup>2</sup> *see also id.* at 8:25-33. Halliwell further explains that the diameter of the end cap is configured to fit over the tube, and that the end caps can include a step profile where the larger-diameter portion fits over the end of the tube. *Id.* at 8:34-52. The figures referenced by Petitioner show end caps with such a step profile, and none of them actually show reflective back plate 19 extending into the smaller-diameter portion of the end caps (*i.e.*, the portion that would not surround the end of the tube). *Id.* at Figs. 7-9, 16, and 17. Indeed, the figures—at best—show back plate 19

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<sup>2</sup> Although this disclosure does reference “some embodiments,” Huang describes no embodiments where the lamp tube does not extend into the end caps.

extending only slightly into end caps 11. *Id.* By glossing over the claim requirement that the length of the light strip exceeds the length of the main body region of the glass lamp tube, Petitioner and its expert “fail[] to explain why a person of ordinary skill in the art would have combined elements from specific references *in the way the claimed invention does.*” *ActiveVideo Networks, Inc. v. Verizon Commc’ns, Inc.*, 694 F.3d 1312, 1328 (Fed. Cir. 2012) (italics original) (citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)).

Petitioner’s argument that lengthening the circuit board would provide additional space for marking the circuit board with identifiers is also unconvincing. *See* Pet. at 58. Petitioner cannot and does not argue that Jing’s circuit board 2 could not be marked without lengthening it. Obviously, components other than Jing’s circuit board 2 (*e.g.*, end plug(s), rear side of tube 1) could also be marked to the extent additional space was desired.

Petitioner’s argument that the increased costs of lengthening Jing’s circuit board 2 would be “substantially outweighed” by the identified benefits is conclusory. *See* Pet. at 58. Jing discloses an LED lamp specifically designed to reduce manufacturing costs and the design includes features to address heat dissipation. Neither Petitioner nor Dr. Lebby explain why a POSITA would have viewed Jing’s heat dissipation features (*e.g.*, thermal conductive layer, heat sink) as inadequate or why increasing the length of the PCB would produce further heat

dissipation benefits that would outweigh added material costs. *See, e.g., Blackberry Corp. v. Facebook, Inc.*, IPR2019-01596, Paper 7 at 17-18 (PTAB Mar. 5, 2020) (rejecting motivation to combine where Petitioner and its expert did not meaningfully compare the alleged advantage (reduced CPU load) to the drawbacks of the proposed modification).

Finally, the proposed combination is vaguely defined at best. Petitioner notes that Halliwell discloses securing end caps to the reflective back plate 19. *See* Pet. at 53 (citing Halliwell at 8:56-58). But Petitioner does not suggest the proposed combination includes Halliwell's end caps 11. *See* Pet. at 61. Jing, on the other hand, is vague as to how the end plugs are connected to the LED lamp tube 1. *See, e.g.,* Jing at Fig. 6. The proposed combination, to the extent Petitioner understands it, would extend Jing's circuit board 2 so that it sticks out of the side of lamp tube 1. Petitioner does not address how this change would impact Jing's end plugs or how they are attach to Jing's lamp tube 1.

**1. The Combination Fails to Disclose Elements 1[d], 8[f], and 14[d]**

Element 1[d] recites: "a power supply disposed at one end or two ends of the glass lamp tube, the power supply electrically connected to the plurality of LED light sources[.]" Elements 8[f] and 14[f] are identical.

For Ground 2, Petitioner primarily points back to its discussion of Jing from Ground 1 for this element. *See* Pet. at 63. For the reasons discussed above in addressing Ground 1, however, Jing fails to disclose this limitation.

Petitioner also references certain disclosures from Halliwell in discussing this limitation. *See* Pet. at 63. However, Petitioner's proposed combination does not incorporate Halliwell's lamp tube or end caps. *See* Pet. at 61 (describing proposed Jing-Halliwell combination as relying on Halliwell only to increase the length of the LED light strip).

Accordingly, Petitioner has failed to show that the proposed combination of Jing and Halliwell teaches or suggests elements 1[d], 8[f], and 14[d] of independent claims 1, 8, and 14. For at least this reason, Petitioner has not shown that claims 1, 8, and 14 are obvious based on Ground 2. Further, because the remaining challenged claims are dependent claims that depend from claims 1, 8, or 14, Petitioner has failed to show that Ground 2 renders any challenged claim obvious.

## **2. The Combination Fails to Disclose Elements 1[g], 8[j], and 14[g]**

Element 1[g] recites: "and further wherein a length of the light strip is longer than a length of the main body region of the glass lamp tube." Elements 8[j] and 14[g] are identical.

As discussed above in addressing the lack of motivation to combine Jing and Halliwell, Halliwell never actually discloses lengthening the reflective back plate 19 beyond the length of glass tube. Instead, Petitioner points to Halliwell's Figs. 7-9, 16, and 17 that purportedly show "reflective back plate 19 extends into end caps 11." Pet. at 65-66. But Halliwell discloses that the tube formed by lens 13 (and optionally back cover 14) likewise extends into end caps 11. Halliwell at 8:23-24 ("In various embodiments, some portion of the length of the lens 13 and back cover 14 is inserted into each end cap 11.");<sup>3</sup> *see also id.* at 8:25-33. Halliwell further explains that the diameter of the end cap is configured to fit over the tube, and further that the end cap can include a step profile where the larger-diameter portion fits over the end of the tube. *Id.* at 8:34-52. The figures referenced by Petitioner show end caps with such a step profile and none of them actually show reflective back plate 19 extending into the smaller-diameter portion of the end caps (*i.e.*, the portion that would not surround the end of the tube). Indeed, the cited Halliwell figures—at best—show back plate 19 extending only very slightly into end caps 11. *Id.* at Figs. 7-9, 16, and 17.

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<sup>3</sup> Although this disclosure does reference "some embodiments," Huang describes no embodiments where the lamp tube does not extend into the end caps.

Because Halliwell discloses *the tube* extending into the end caps as well, a POSITA would not understand the reference to disclose that reflective back plate 19 is longer than a main body region of the tube lamp as Petitioner asserts. *See* Pet. at 66-67. Petitioner's argument for these limitations also fails because it focuses exclusively on Halliwell's disclosures notwithstanding the fact that Petitioner does not assert that the Jing-Halliwell combination actually uses Halliwell's reflective back plate 19 or end caps 11. *See* Pet. at 61 (describing proposed modification of Jing with Halliwell).

Accordingly, Petitioner has failed to show that the proposed combination of Jing and Halliwell teaches or suggests elements 1[g], 8[j], and 14[g] of independent claims 1, 8, and 14. For at least this reason, Petitioner has not shown that claims 1, 8, and 14 are obvious based on Ground 2. Further, because the remaining challenged claims are dependent claims that depend from claims 1, 8, or 14, Petitioner has failed to show that Ground 2 renders any challenged claim obvious.

### **C. Grounds 3-10**

Grounds 3 through 10 add additional secondary references to the combinations in Grounds 1 and 2 in order to challenge dependent claims. *See* Pet. at 3-4. Because none of these grounds address the failings of Grounds 1 and 2 with respect to the three independent claims discussed above, Petitioner has

failed to show that any of Grounds 3 through 10 render obvious any of the challenged dependent claims.

**IV. THE BOARD SHOULD DENY INSTITUTION UNDER 35 U.S.C. § 314(a) / *FINTIV***

**A. Legal Standard**

The Board's precedential decision in *Apple, Inc. v. Fintiv, Inc.* identified six factors for consideration in determining whether to deny institution under § 314(a) where there is a parallel district court litigation:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020) (precedential).

On June 21, 2022, the USPTO issued a Director's Memorandum, titled "Interim Procedure for Discretionary Denials in AIA Post Grant Proceedings with Parallel District Court Litigation" ("Director's Memo"). Among other things, the Director's Memo stated "Consistent with *Sotera Wireless, Inc.*, the PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB." Director's Memo at 3 (referencing *Sotera Wireless Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A).

Petitioner has not presented any *Sotera Wireless* stipulation here and the *Fintiv* factors discussed below weigh in favor of a discretionary denial in view of the parallel district court litigation.

#### **B. The Co-Pending District Court Litigation**

On May 24, 2022, Patent Owner filed a patent infringement complaint against Petitioner. Ex. 2003 (docket report) at ECF 1. On September 16, 2022, Patent Owner filed an amended complaint which asserted infringement of the '397 patent. *Id.* at ECF 12.

A scheduling order was entered on December 12, 2022. Ex. 2004 (scheduling order). Fact discovery opened on April 20, 2023 and is scheduled to close on November 15, 2023. *Id.* at 2, 3. Final infringement and invalidity

contentions are due June 14, 2023. A jury trial is scheduled for April 2024—four months before any final written decision would be due in this proceeding. *Id.* at 4.

Claim construction briefing has been completed and a claim construction hearing is set for June 2, 2023. Ex. 2003 (docket report) at ECF 74.

Petitioner moved to transfer the district court case to the Northern District of Ohio. Following venue discovery and a hearing, the transfer motion was denied on April 20, 2023. Ex. 2003 (docket report) at ECF 69.

Petitioner has also filed a motion to dismiss certain claims in the litigation, and that motion has been fully briefed. *Id.* at ECF Nos. 14, 18, and 19.

**C. Factor 1: The Court Has Not Stayed the District Court Case and Is Very Unlikely to Do So**

Petitioner has not moved to stay the district court case in view of its IPR filings nor even indicated it intends to do so.<sup>4</sup> Even if Petitioner does so move, Judge Albright has typically denied motions to stay litigations based on instituted IPR proceedings. *See, e.g., Ravgen, Inc. v. Lab'y Corp. of Am. Holdings*, No. W-20-CV-00969-ADA, 2022 WL 4240937 (W.D. Tex. Aug. 16, 2022); *Sonrai*

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<sup>4</sup> Recently, on May 12, 2023, Petitioner did move to stay the district court case pending resolution of its objections to Magistrate Judge Gilliland's denial of Petitioner's transfer motion. Ex. 2003 (docket report) at ECF 75.

*Memory Ltd. v. LG Elecs. Inc.*, No. 6:21-CV-00168-ADA, 2022 WL 2307475 (W.D. Tex. June 27, 2022) (both denying post-institution motions to stay). Judge Albright is even less likely to stay the district court case given Petitioner has filed IPRs on just a subset of the patents-in-suit. Accordingly, *Fintiv* Factor 1 favors discretionary denial.

**D. Factor 2: The District Court’s Trial Date is Four Months Before the Expected Date of any Final Written Decision**

Jury Trial is currently set for April 17, 2024. Ex. 2004 (scheduling order) at 4. A final written decision in this case is unlikely to be due much before August 17, 2024 (*i.e.*, one year and 3 months after the May 17, 2023 filing date of the present paper). Accordingly, *Fintiv* Factor 2 favors discretionary denial.

**E. Factor 3: Both Parties And The Court Have Invested Substantial Effort Into This Case And Will Invest Even More Before an Institution Decision**

The parties have already invested substantial effort into this case. The claim construction process is almost complete and the parties are already into fact discovery. Final infringement and invalidity contentions are due in less than a month on June 14, 2023—roughly two months before the Board is likely to issue an institution decision in this proceeding. Moreover, Patent Owner already prevailed on Petitioner’s transfer motion and Petitioner’s motion to dismiss has been fully briefed. Accordingly, *Fintiv* Factor 3 favors discretionary denial. *See*

*Fintiv*, Paper 15 at 15 (reasoning that factor 3 favored discretionary denial based on efforts already invested into claim construction and invalidity conventions).

**F. Factor 4: Overlap Of Issues Raised In The Petition And District Court Case**

Petitioner's invalidity contentions in the district court case rely on the same prior art advanced in the Petition. Ex. 2005 (invalidity contentions cover pleading) at 34-36 (listing Jing, Huang, Halliwell, Foo, Zhao, and Deng as prior art for the '397 patent). Accordingly, *Fintiv* Factor 4 favors discretionary denial. *See Fintiv*, Paper 15 at 15. As noted above, Petitioner opted not to present a *Sotera Wireless* stipulation in its Petition. Petitioner apparently intends to pursue the same invalidity theories simultaneously before the PTAB and in district court. This is inefficient and increases the chance of inconsistent outcomes between the two fora.

**G. Factor 5: Petitioner and the Defendant in the District Court Case Are the Same Party**

Petitioner here is itself a defendant in the parallel district court proceeding. Accordingly, *Fintiv* Factor 5 favors discretionary denial. *See Fintiv*, Paper 15 at 15.

**H. Factor 6: Fatal Flaws in the Petition Favor Discretionary Denial**

Given the flaws in the proposed Jing-Huang and Jing-Halliwell combinations discussed above in Sections III(A) and III(B), the present Petition

falls well short of the “compelling merits” standard required to avoid a discretionary denial based on *Fintiv* Factors 1-5. *See* Director’s Memo at 4 (When determining whether there is a compelling unpatentability challenge, the Board evaluates whether the Petition presents challenges “in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.”).

### **I. Conclusion**

Similar to *Fintiv*, “the District Court case is ongoing, trial is scheduled to begin [four] months before [the Board] would reach a final decision in this proceeding, the District Court has expended effort resolving substantive issues in the case, the identical claims are challenged based on the same prior art in both the Petition and in the District Court, and the defendant in District Court and the Petitioner here are the same party.” *Fintiv*, Paper 15 at 17. Given that the *Fintiv* factors decidedly favor a discretionary denial, instituting a trial based on this Petition would be an inefficient use of the Board’s resources. Accordingly, the Board should deny institution under § 314(a).

## V. CONCLUSION

For all the reasons discussed above, the Board should deny institution of Petitioner's Petition for inter partes review of the '397 Patent.

Dated: May 17, 2023

Respectfully submitted,

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**CERTIFICATION OF WORD COUNT UNDER 37 C.F.R. § 42.24(d)**

Pursuant to 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the word count for the foregoing Patent Owner's Preliminary Response totals 5,359, excluding the parts exempted by 37 C.F.R. § 42.24(a). Accordingly, this Petition is under the word count limit of 14,000 words.

This word count was calculated by using the built-in word-count tool in Microsoft Word 2016, the software used to prepare the document.

Dated: May 17, 2023

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**CERTIFICATE OF SERVICE**

I hereby certify that on this 17th day of May 2023, true and correct copies of the foregoing PATENT OWNER'S PRELIMINARY RESPONSE and Exhibits 2003-2005 were served via electronic mail upon the following counsel of record for Petitioner:

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