

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HISENSE USA CORPORATION,
Petitioner,

v.

BRIGHTPLUS VENTURES LLC,
Patent Owner.

IPR2023-01385
Patent 7,690,812 B2

Before STACEY G. WHITE, KEVIN C. TROCK, and
JOHN D. HAMANN, *Administrative Patent Judges*.

PER CURIAM.

ORDER
Conduct of the Proceeding
Authorizing Additional Briefing
37 C.F.R. § 42.5

Based on the papers submitted by the parties to date in this proceeding, we have determined that additional briefing from the parties relating to claim construction is warranted for the reasons we discuss below.

In the Petition, Petitioner argued “that no claim term requires construction.” Paper 1, 10. In its Preliminary Response, Patent Owner pointed out that in related district court litigation Petitioner proposed a construction for the phrase “reflector sheet configured to conform to a shape of a protruding feature on the tile,” as recited in claim 1. Paper 6, 4–6. In particular, Petitioner proposed that this phrase means “the reflector sheet overlays (e.g., by deformation), and has the same shape, outline, or contour of a protruding feature,” according to Patent Owner. *Id.* at 5.

Moreover, Patent Owner argued “that the plain and ordinary meaning should apply” to this phrase, but to the extent that we construe this phrase, that Patent Owner’s proposed construction from the related district court litigation should be adopted. *Id.* at 5–6. In particular, Patent Owner submits, in the alternative to its plain and ordinary meaning, that this phrase means “reflector sheet that provides cover and relief for a shape of a protruding feature on the [solid state lighting] tile.” *Id.* at 5 (alteration in original). In support of this proposed construction, Patent Owner argued that “the specification makes clear that there are several ways of achieving ‘conformance,’” such as shown in Figures 3 and 4. *Id.* at 5–6.

In the Decision on Institution, “we preliminarily agree[d] with Patent Owner that the ’812 patent shows alternative ways for a reflector sheet ‘to conform.’” Paper 7 (“Dec. on Inst.”), 13. In particular, we noted that the embodiments shown in Figures 3 and 4 provided alternative ways to provide relief for surface protrusions, and that “we preliminarily agree[d] with Patent

Owner that these are alternative ways for a reflector sheet ‘to conform to a shape of a protruding feature.’” *Id.* at 13–14. We also stated that “[t]he parties, however, should consider during trial whether these different descriptions concerning reflector sheet 14 instead disclose distinct embodiments that may not both be covered by a different construction of ‘to conform to a shape of a protruding feature.’” *Id.* at 14.

In its Response, Patent Owner again argued that “[t]he ’812 patent provides several examples of protruding features,” and “that there are several ways of achieving ‘conformance.’” Paper 11, 5–6 (citing Ex. 1001, Figs. 3–4). In its Reply, Petitioner argued that “[t]he term ‘conform’ should be given its plain meaning, which is the same as the meaning provided by Petitioner in the underlying litigation as argued in the Petition,” and that “under either construction (Petitioner’s or P[atent Owner]’s), the claims are” unpatentable. Paper 15, 2.

In addition, Patent Owner filed a Contingent Motion to Amend and Petitioner filed an Opposition to the motion. Papers 12, 16. These papers also implicate the construction of “conform.”

“The Board will construe patent claims . . . based on the record of the . . . proceeding, taking into account the claim language itself, specification, and prosecution history pertaining to the patent, as well as relevant extrinsic evidence” Consolidated Trial Practice Guide November 2019¹ (“CTPG”) 46. “Thus, as in a district court proceeding, the parties should point out the specific portions of the specification, prosecution history, and relevant extrinsic evidence they want considered, and explain the relevancy

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

of any such evidence to the arguments they advance. Each party bears the burden of providing sufficient support for any construction advanced by that party.” *Id.*

At this juncture, we seek additional briefing as to the meaning of “conform” as used in the challenged and proposed substitute claims. For example, the parties should address whether the embodiments shown in Figures 3 and 4, and described in their accompanying text, both illustrate a reflector sheet that is configured to conform to a shape of a protruding feature. Or do “these different descriptions concerning reflector sheet 14 instead disclose distinct embodiments that may not both be covered by” the plain and ordinary meaning of “conform” or the parties’ constructions. Dec. on Inst. 14. And the parties should address explicitly whether “conform” includes not taking on the exact shape of the protruding feature.

Accordingly, we authorize additional briefing to address these issues. CTPG 45 (“If the Board raises a claim construction issue on its own, both parties will be afforded an opportunity to respond before a final written decision is issued.”). We remind the parties that we will “tak[e] into account the claim language itself, specification, and prosecution history pertaining to the patent, as well as relevant extrinsic evidence.” *Id.* at 46. And thus, the parties should address these items, where relevant.

We also authorize the parties to address the effect of the aforementioned construction on the unpatentability issues before us. In the additional briefing, the parties may point to evidence already in the record, but may not introduce new evidence.

Accordingly it is

ORDERED that each party is authorized to file an opening brief, not to exceed ten pages, that addresses the above-identified issues no later than ten days after the date of this order; and

FURTHER ORDERED that each party is authorized to file a responsive brief, strictly limited to addressing issues raised in the opposing party's opening brief, not to exceed ten pages, and no later than twenty days after the date of this order.

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