

Luminex International Co., Ltd.*

v.

Signify Holdings B.V.,

**IPR 2024-00101
U.S. Patent No. 10,299,336**

Petitioner's Demonstratives, June 11, 2025

*Menard, Inc. filed a petition and a motion for joinder in IPR2024-01469 and has been joined as a petitioner in this proceeding.

**Luminex Ex. 1046
Luminex v. Signify
IPR2024-00101**

Key Issues



The Claimed Switch Locations Are Anticipated and/or Obvious



Claims 13, 15, and 16 Are Not Entitled to the '424 Provisional's Priority Date



Claim 13's "Body" and "At Least One Coupling Feature" Are Obvious



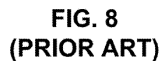
Reiff Discloses and/or Renders Obvious a CCT Switch



The Petition Is Not Time Barred

U.S. Patent No. 10,299,336

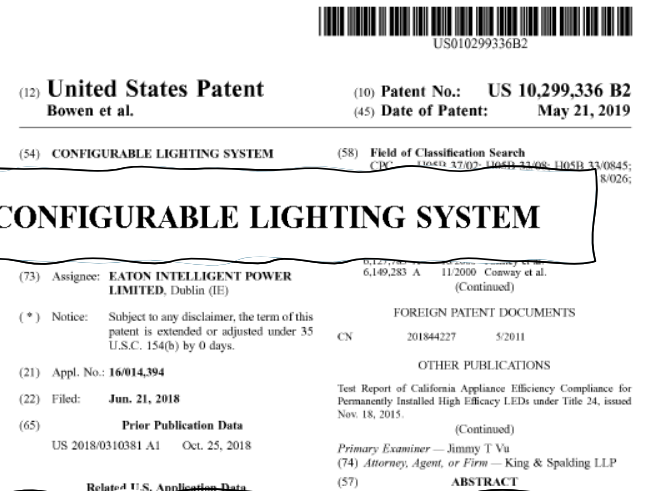
Patent Introduction



EX1001, Fig. 8 (*see e.g.* Pet. at 12).

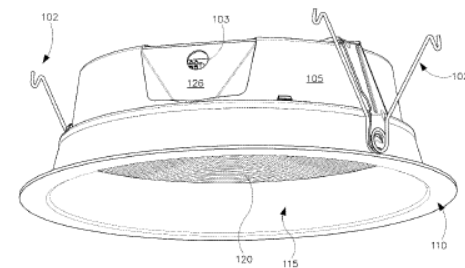


EX1001, Fig. 9B (annotated) (*see e.g.* Pet. at 12).



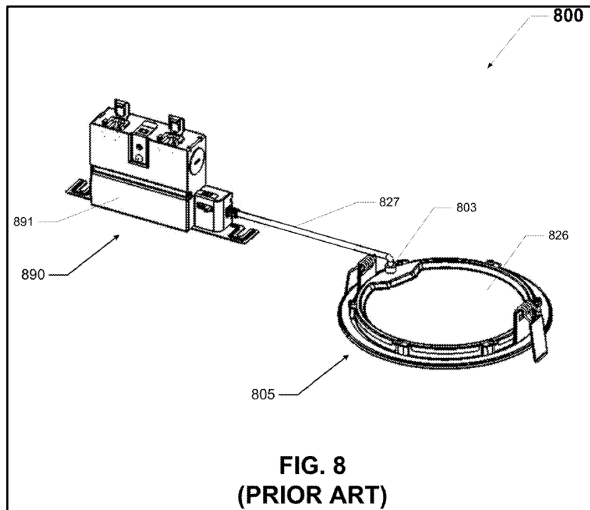
TECHNICAL FIELD

Embodiments of the technology relate generally to lighting systems and more specifically to lighting systems that can be readily configured to produce illumination of different color temperatures.

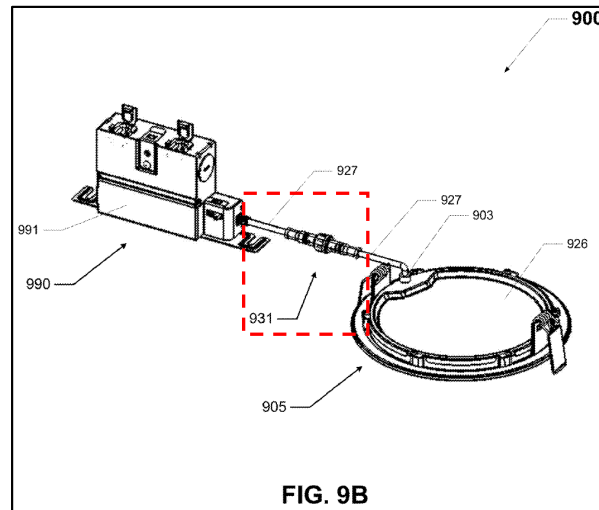


U.S. Patent No. 10,299,336

Independent Claim 1



EX1001, Fig. 8 (*see e.g.* Pet. at 12).

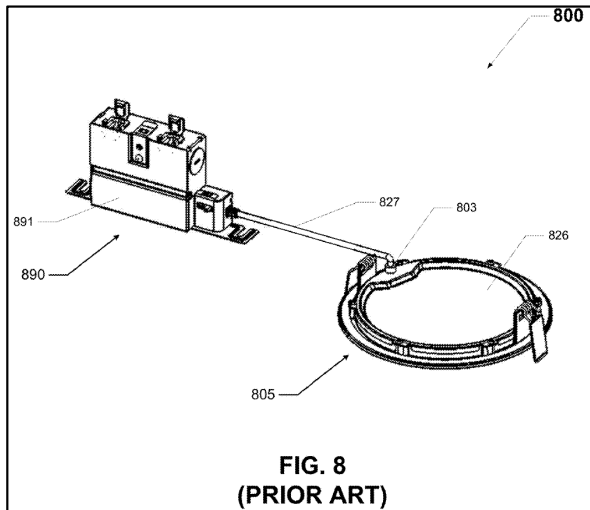


EX1001, Fig. 9B (annotated) (*see e.g.* Pet. at 12).

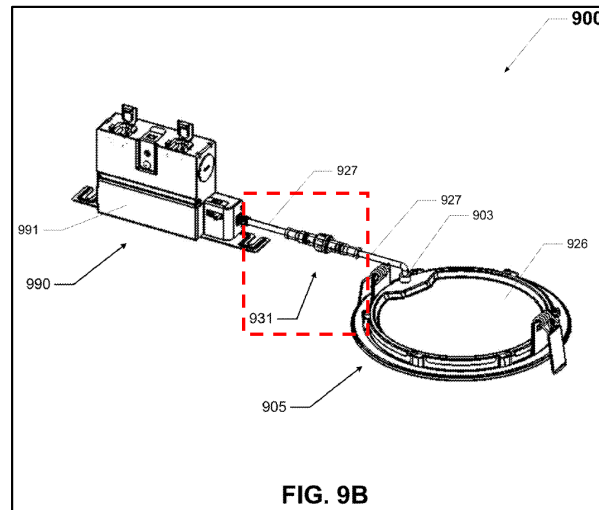
1. A luminaire comprising:
 - a housing comprising at least one outer surface that forms a first cavity;
 - at least one electrical component disposed, at least in part, within the first cavity;
 - an electrical cable comprising a first end and a second end, wherein the first end is coupled to the at least one electrical component; and
 - a switch coupled to the electrical cable, wherein the switch is disposed remotely from the housing, wherein the switch has a plurality of positions, wherein each position of the plurality of positions of the switch corresponds to a discrete correlated color temperature (CCT) output by one or more light sources of the luminaire.

U.S. Patent No. 10,299,336

Independent Claim 13



EX1001, Fig. 8 (*see e.g.* Pet. at 12).



EX1001, Fig. 9B (annotated) (*see e.g.* Pet. at 12).

13. A switch for controlling a correlated color temperature (CCT) of light emitted by a luminaire, the switch comprising:

a body;

at least one first coupling feature disposed on the body, wherein the at least one first coupling feature is configured to electrically couple to an electrical cable of the luminaire; and

an actuator disposed on the body, wherein the actuator has a range of positions,

wherein each position of the range of positions of the actuator corresponds to a CCT of the light emitted by the luminaire.

CCT Switches Were Known For Decades

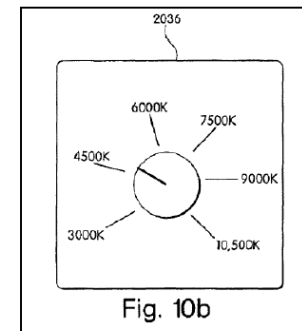
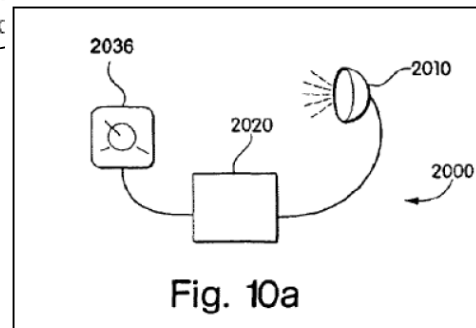
Ducharme (EX1002) *Filed in 2000*

77. As another example, in 2000, Fig. 29 of Ducharme disclosed a "lighting fixture [i.e. luminaire that] may also comprise a program control switch (2512). This switch may be a selector switch for selecting the color temperature" of the luminaire. Ex. 1002, 29:4-13 ("For example, the switch may have multiple settings for different colors. Position 'one' may cause the LED system to produce 3200K white light, position 'two' may cause 4000K white light, position 'three' may be for blue light and a fourth position may be to allow the system to receive external signals for color or other illumination control.") Ex. 1031, 148:18-149:2. Ducharme even states that

EX1027, ¶ 77 (see Reply at 4-5).

One such manual control system (2036) is in detail in FIG. 10b. The depicted control unit features a dial marked to indicate a range of color temperatures, e.g., from 3000K to 10,500K. This device would be useful on a lighting fixture used to produce a range of temperatures ("colors") of white light, such as the one discussed below. It would be understood by one of skill in the art that broader, narrower, or overlapping ranges may be employed, and a similar system could be employed to control lighting fixtures that can produce light of a spectrum beyond white, or not including white. A manual control system (2036) is in detail in FIG. 10b.

EX1002, 16:64-17:7 (see Pet. At 6-7).



CCT Switches Were Known For Decades

Roberge (EX1011) *Filed in 2003*

Ex. 1031, 86:13-87:17, 88:4-7. In fact, “FIG. 34g shows a dipswitch 3410, which can be[] used to set simple modes of a lighting unit 102” including “color temperature.” Ex. 1011, 42:25-38 (“In various embodiments the slides, switches, dials, dipswitches and the like can be used to control a wide range of variables, such as color, color temperature ...”); see also Ex. 1031, 83:2-5. Roberge goes on to

EX1027 ¶ 76 (see Reply at 4-5).

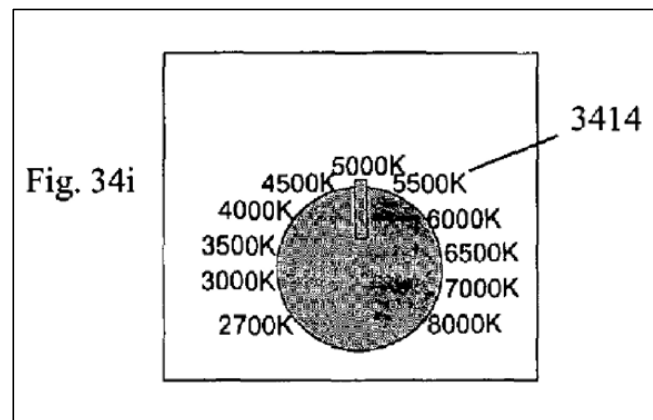
Dr. Krames “conceded that Roberge’s LED lighting units with housings ‘would be considered luminaire’ (*id.*, 86:20-88:7).” Reply at 12

Referring to FIG. 34i, in embodiments a dial allows a user to select one or more colors or color temperatures from a scale 3414. For example, the scale 3414 can include different color temperatures of white light. The lighting

EX1011, 42:51-54 (see Pet. at 48-49).

position on the scale 3414 with the dial. A slide mechanism can be used like the dial to set a particular color temperature of white light, or to select a particular color of non-white

EX1011, 42:57-59 (see Pet. at 48-49).



CCT Switches Were Well Known (cont.)

“Dr. Krames himself disclosed LED lighting devices with adjustable CCT (3000K/4000K/5000K) **in 2014** ‘that can output a few specific spectra and be controlled by a simple mechanical switch’ **using the same tuning methods of the ’336 patent and Chaimberg.** [EX1034], 26:15-17; EX1027, ¶¶70-74. The location of a well-known CCT switch amounts to an elementary, obvious design choice.” Reply at 5-6.

'424 Provisional, 2:9-16	'644 Patent, 26:43-52
The power supply can utilize a switching scheme that can turn each group of light emitting diodes on and off to change the color temperature of the luminaire. For example, the luminaire can comprise a 3,000 K group of light emitting diodes and a 4,000 K group of light emitting diodes. When only the 3,000 K group is on, the luminaire can deliver 3,000 K illumination. When only the 4,000 K group is on, the luminaire can deliver 4,000 K illumination. When the 3,000 K group and the 4,000 K group are both on, the luminaire can deliver 3,500 K illumination.	For instance, in a given embodiment, about 10 watts of power are consumed by the lamp. LED1 4142 has a CCT of 3000K. LED2 4144 has a CCT of 5000K. In position A, only LED1 receives power [yielding a CCT of 3000K]. In position B, LEDs 1 and 2 receive power yielding a CCT between 3000K and 5000K [e.g., 4000K]. In position C, only LED 2 receives power [yielding a CCT of 5000K]. In all [switch] positions, a similar amount of light is emitted because the same amount of power is driven through the LEDs. In position B, the balance of power feeding LEDs 1 and 2 can be tuned to achieve a desired spectrum[of CCT].

EX1027, ¶ 70 (see Reply at 4-6).



Key Issue #1:

The Claimed Switch Locations Are Anticipated and/or Obvious

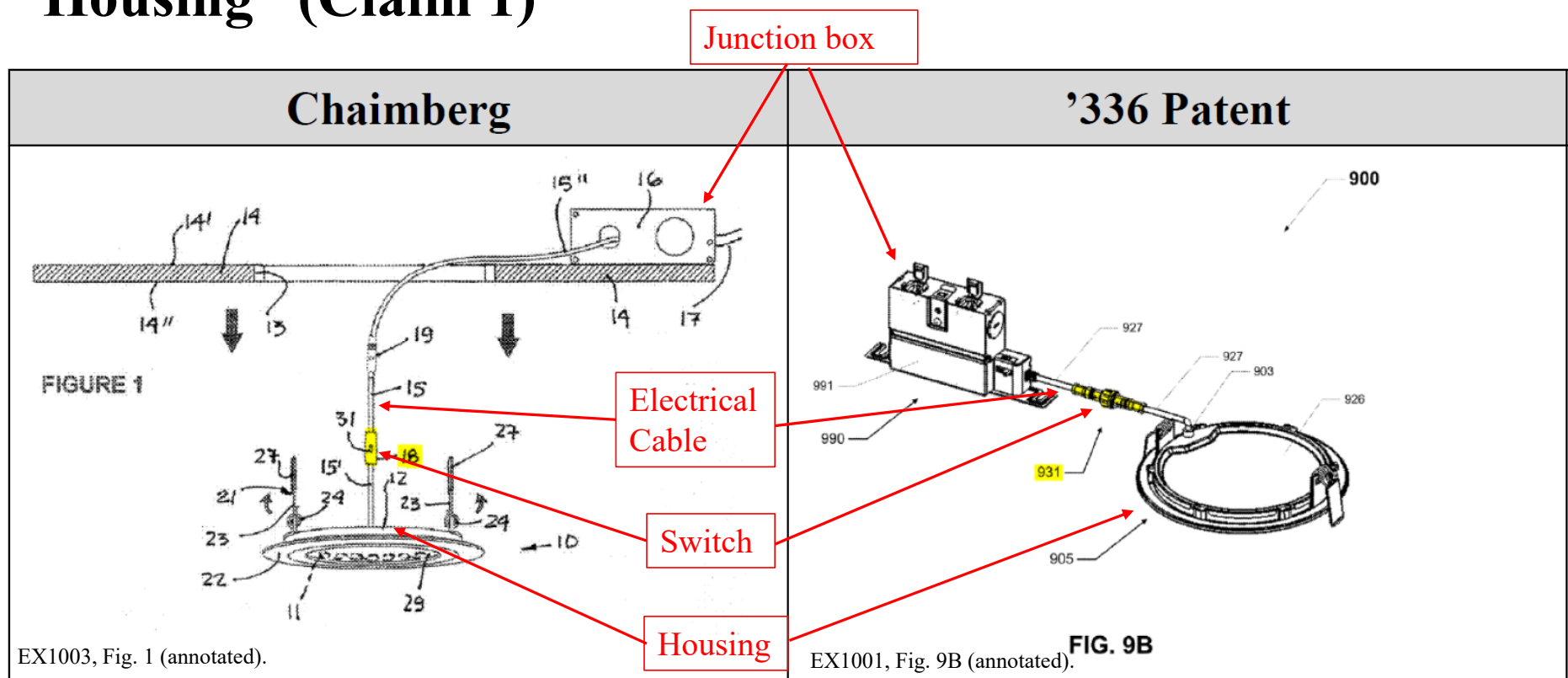
Claimed Switch Locations

Claim 1: “the switch is disposed remotely from the housing”

Claim 7: “the switch is disposed within the second cavity [of a junction box]”

Claim 11: “the switch is inaccessible when the housing is installed”

Chaimberg's CCT "Switch Is Disposed Remotely from the Housing" (Claim 1)



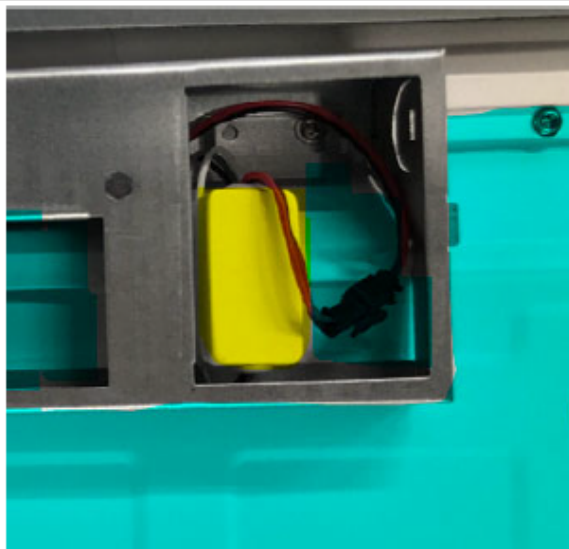
Reply at 2.

Patent Owner and Dr. Krames Agree: A CCT Switch Can Touch The Housing, and Still Be Remote

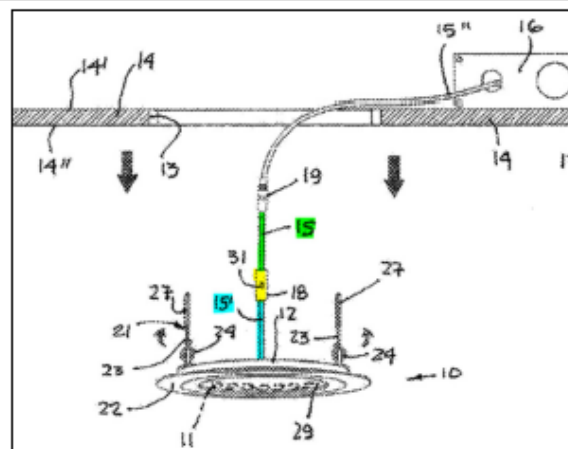
17 THE WITNESS: If the switch was as shown
18 here, an external element but touching the light
19 fixture housing, would it be remote? Yes, it would
20 be remote.

EX1031, 69:17-20 (Dr. Krames Dep. Tr.)
(see Reply at 3-4).

SKU 348-2107



Chaimberg



Reply at 3.

12

Chaimberg Describes a Junction Box-mounted Switch (Claim 7)

over the rear surface of the sheeting material. A switch is mounted on the driver housing to select a desired color temperature of the LED light fixture. To change the switch 50

EX1003, 1:48-50 (see Pet. at 17).

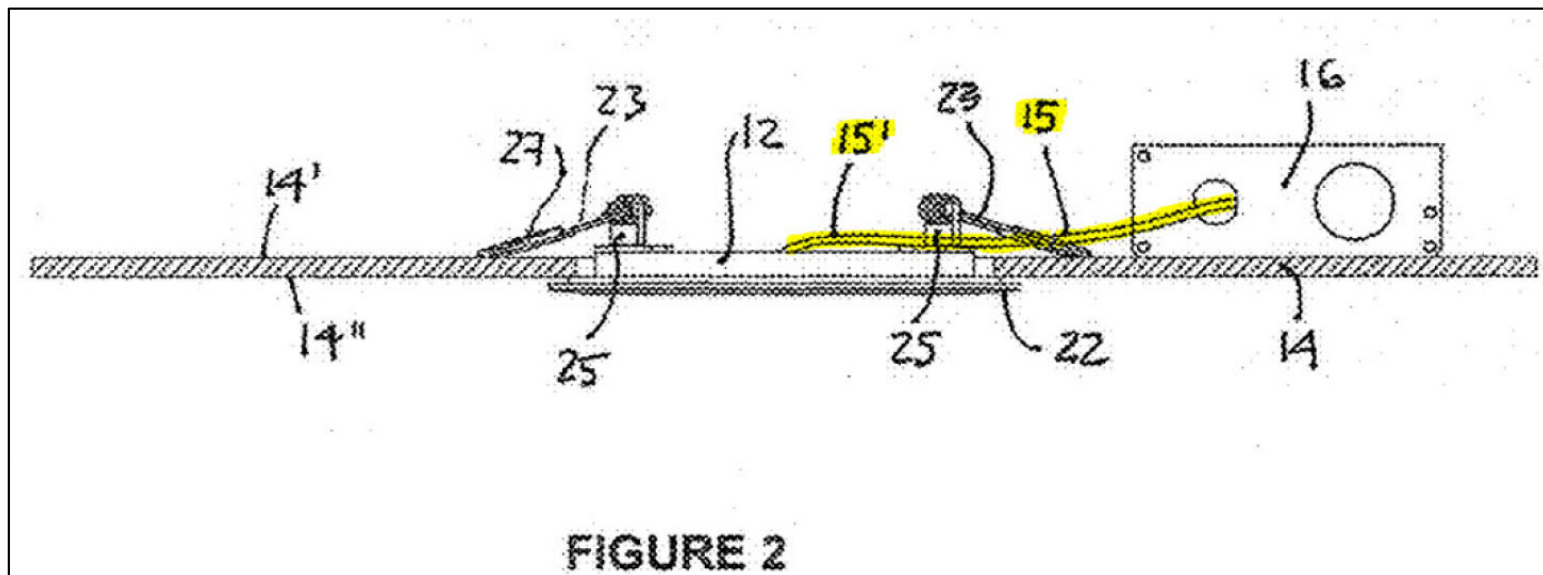
hole after the ceiling sheeting material is installed. Usually, a selector switch is mounted on the driver housing 16 to select a desired color temperature to be emitted by the light fixture and this is done by pulling the housing 16 out from 30

EX1003, 3:29-32 (see Pet. at 17).

“A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.”

In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994) (see Reply at 5).

Chaimberg's CCT Switch Is “Inaccessible when the Housing Is Installed” (Claim 11)



EX1003, Fig. 2 (annotated) (see Pet. at 38).

Institution Decision:

(e) Limitation 1d

Claim 1 recites “a switch coupled to the electrical cable, wherein the switch is disposed remotely from the housing.” Ex. 1001, 14:39–40 (limitation 1d).

Paper 14 at 27.

Based on the current record and for the reasons stated by Petitioner and supported by Dr. Eden’s testimony, Petitioner establishes sufficiently that Chaimberg discloses limitation 1d. *See* Pet. 29; Ex. 1004 ¶¶ 104–108.

Paper 14 at 27.

Based on the current record and for the reasons stated by Petitioner and supported by Dr. Eden’s testimony, Petitioner establishes sufficiently that Chaimberg discloses or renders obvious each limitation in claims 3, 6–9, 11, 12, 15, and 17–19. *See* Pet. 30–39, 45–46; Ex. 1004 ¶¶ 113–148,

Paper 14 at 33.

Halliwell Discloses the Claimed Switch Locations

range of the LED lamp 10 or LED lighting device 20. For example, the remote switch 40 may be a wall and/or junction box mounted toggle switch, dimmer switch and/or the like in wired communication with the switch control unit 35. In

EX1012, 17:39-42 (see Pet. at 62-63).

housing 24. In example embodiments, the electrical components of the LED lighting device 20 (e.g., the driver circuitry 19, switch control unit 35, and/or the like) may be configured to be directly wired to line voltage (e.g., through a junction box) or may be configured to be connected to line voltage through a power cord comprising a two- or three-prong polarized plug.

EX1012, 7:13-19 (see Pet. at 66).

tures. In example embodiments, the remote selector 44 may be a slide, push button, rotary, passive infrared and/or other type of interactive element that the user may interact with, select, press, touch, voice activate, and/or the like. Thus, the remote selector 44 may be configured to allow a user to select a desired operating color temperature, brightness, CRI, and/or other operating light aspects or qualities, and/or a combination thereof during operation of the LED lamp 10 or LED lighting device 20 (e.g., when the LED lamp 10 or LED lighting device 20 is in the configurable operating mode). In example embodiments, the remote switch 40 may

EX1012, 18:31-41 (see Pet. at 62-63).

Institution Decision:

Based on the current record and for the reasons stated by Petitioner and supported by Dr. Eden's testimony, Petitioner establishes sufficiently that Halliwell renders obvious limitation 1d. *See* Pet. 67–68; Ex. 1004

Paper 14 at 49.

Based on the current record and for the reasons stated by Petitioner and supported by Dr. Eden's testimony, Petitioner establishes sufficiently that Halliwell discloses or renders obvious each limitation in claims 2–5, 7, 9–12, 15, 16, 19, and 20. *See* Pet. 69–76, 81–82; Ex. 1004 ¶¶ 266–302,

Paper 14 at 55-56.

Key Issue #2:

Claims 13, 15, and 16 Are not Entitled to the '424 Provisional's Priority Date

All Descriptions of Claim 13 Were Added In 2018

Claim 13 of the '336 Patent

13 [a] a **body**;

13 [b] at least one first **coupling feature disposed on the body**, wherein the at least one first coupling feature is configured to **electrically couple to an electrical cable of the luminaire**; and

13 [c] an **actuator disposed on the body**, wherein the actuator has a range of positions,

13 [d] wherein each position of the range of **positions of the actuator corresponds to a CCT** of the light emitted by the luminaire.

'336 Patent Description (2018)

927. The **switch 931** can be substantially the same as the example switches discussed above. For instance, the switch 931 can have **one or more coupling features (e.g., terminal points)** that are used to **couple to one or more electrical conductors of one or more electrical cables 927**. As another example, the switch 931 can have **an actuator having multiple positions**.

EX1001, 11:66-12:5 (*see* Pet. at 21).

'424 Provisional:

- No **express** disclosure of CCT switch “configured to electrically couple to an electrical cable of the luminaire”
- No **inherent** disclosure

PO Relies on Obviousness and Hindsight

“It is the disclosures of the applications that count. Entitlement to a filing data does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed. **It extends only to that which is disclosed.** ... It is not sufficient for purposes of the written description requirement of § 112 that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose.”

Lockwood v. Am. Airlines, 107 F.3d 1565, 1571-72 (Fed. Cir. 1997)
(see Reply at 19).

“[The written description] test requires an objective inquiry into the **four corners** of the specification from the perspective of a person of ordinary skill in the art.”
Ariad Pharms., Inc. v. Eli Lilly & Co., 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (see Reply at 19).

The Provisional Does Not Describe an “Electrical Cable”

5 THE WITNESS: DIP switches are most
6 commonly disposed on circuit board, but -- yeah, so
7 it depends -- so that circuit board may -- it may
8 include cables, in which case there would be a
9 coupling, but in many cases there are no cables and
10 so there is no cable to connect to.

EX1031, 109:2-10 (Krames Deposition) (*see* Reply at 18).

8 Q. Could a luminaire be powered by a battery,
9 for example?
10 A. Yes.

EX1031, 100:8-10 (Krames Deposition) (*see* Reply at 17-18).

A POSITA would not have understood existing house wiring that is wired directly into a lighting device to constitute “an electrical cable *of the luminaire*,” which Dr. Eden likewise acknowledged. Ex. 2030 at 91:12-16. Dr. Eden further recognized

EX2031, ¶233 (Krames Declaration) (*see* Reply at 16).

12 Q. Are each of these lines shown on the
13 schematic a wire?
14 MR. DORSKY: Object to form.
15 THE WITNESS: Wires in a circuit schematic
16 generally indicate an electrical connection for
17 current flow. The current flow can be carried
18 through various topologies. It could be wire. It
19 could be a circuit trace on a print circuit board.
20 It could be through -- those are the two most common
21 things that you see in a schematic.

EX1031, 101:12-21 (Krames Deposition) (*see* Reply at 18).

The Provisional Does not Describe an “Electrical Cable”

Patent Owner’s Argument

In fact, the Provisional describes “electrical wiring” extending from the luminaire housing to power the substrate (and thus the DIP switch), as reflected in Figures 1-2 and 4. POR, 16-21. The Provisional figures also show the interior of the

Sur-Reply at 4.

electrical cable of the luminaire. As described below, the ’424 Provisional discloses an electrical cable that connects and provides power to the substrate into which the pins of the disclosed DIP switch are inserted, thereby electrically coupling the pins to the electrical cable. Ex.2031, ¶87.

POR at 17.

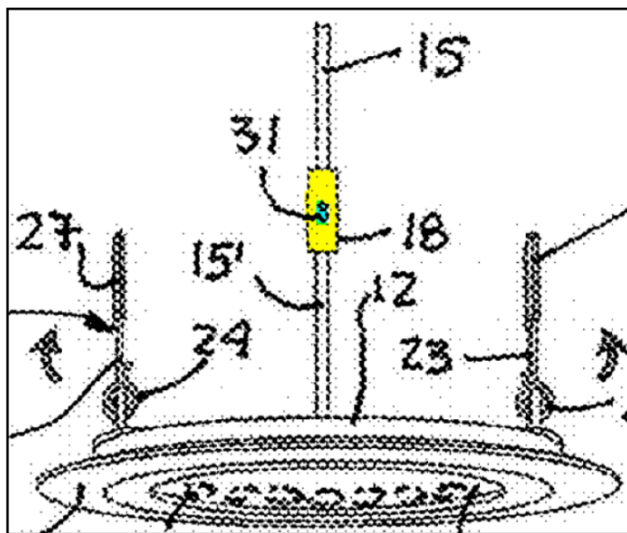
Actual Disclosure in ’424 Provisional

“Electrical wiring (not illustrated) extends through an aperture 103 in the housing 105.” EX1008, 18:24-25 (see Reply at 16-17).

Key Issue #3:

Claim 13's "Body" and "At Least One Coupling Feature" Are Obvious (13[a] & 13[b])

Chaimberg Discloses a “Body” and “Coupling Feature”



EX1003, Fig. 1 (cropped and annotated).

As shown in FIG. 1, with the present invention the selector switch 18 is mounted on the cable 15 adjacent to the 50

EX1003, 3:49-50 (see Pet. at 31).

35 Kelvin set and at 30° for the 5000 Kelvin set. The switch 18 is a toggle switch provided with a slide button 31 having two conducting arms 32 and 33 and displaceable to three switch positions. At a first position, the contacts 8 and 7, as well as

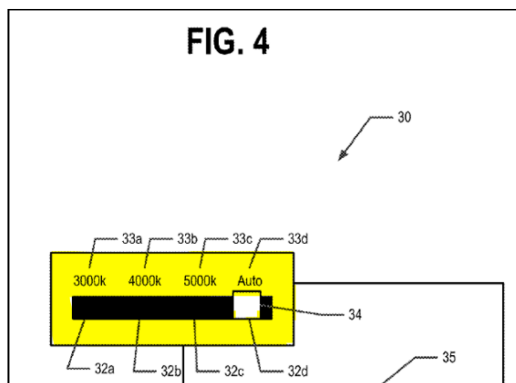
EX1003, 4:34-37 (see Pet. at 30).

Switch 18's “conductor arms 32, 33 move based on slide button 31, controllably directing current to Chaimberg's LEDs to achieve a desired CCT.” Reply at 22; EX1003, 4:30-5:10.

“The switch 18 provides a body wherein the slide button 31 is located.” Pet. at 40.

“[T]he switch 18 includes at least one coupling feature and is configured to electrically couple to the electrical cable 15.” Pet. at 42.

Halliwell Discloses a “Body” and “Coupling Feature”



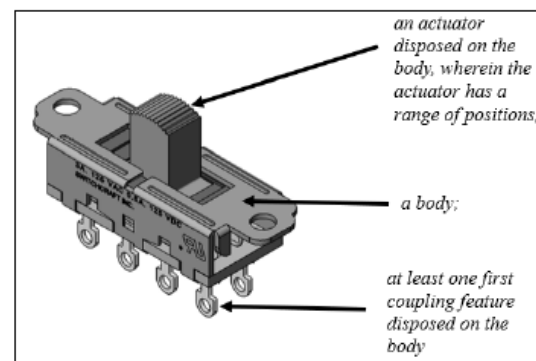
EX1012, Fig. 4 (cropped and annotated) (see Pet. at 77).

housing 24. In example embodiments, the electrical components of the LED lighting device 20 (e.g., the driver circuitry 19, switch control unit 35, and/or the like) may be configured to be directly wired to line voltage (e.g., through a junction box) or may be configured to be connected to line voltage through a power cord comprising a two- or three-prong polarized plug.

EX1012, 7:13-19 (see Pet. at 66).

98. Further, Halliwell describes the switch 30 of Figure 4 as a slide switch.

A POSA would have understood a slide switch to include a body. For example, the figure below shows a typical three-position slide switch from Switchcraft that was readily available for purchase off the shelf at the time of the '336 Patent:



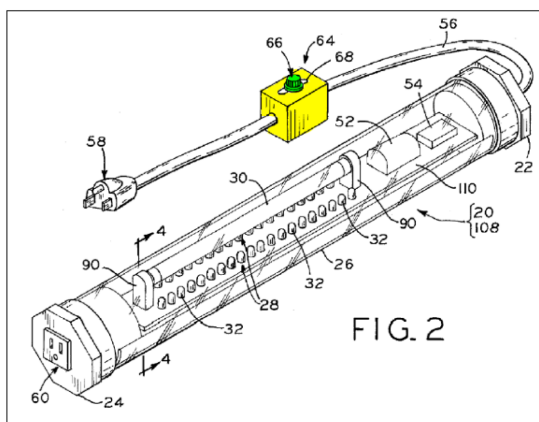
Ex. 1029 (annotated).

EX1027, ¶98 (Eden Reply Dec.); Reply at 25.

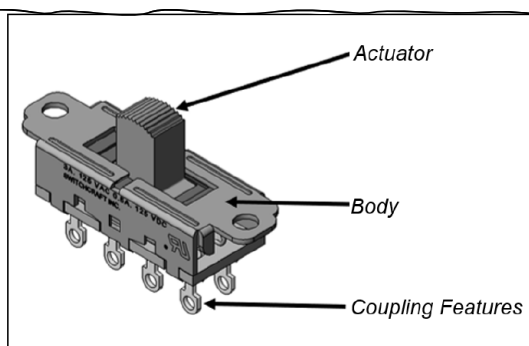
range of the LED lamp 10 or LED lighting device 20. For example, the remote switch 40 may be a wall and/or junction box mounted toggle switch, dimmer switch and/or the like in wired communication with the switch control unit 35. In

EX1012, 17:39-42 (see Pet. at 62-63).

Reiff Discloses a “Body” and “Coupling Feature”



EX1013, Fig. 2 (annotated) (see Pet. at 88).



EX1029. Dr. Krames also confirmed that the image above “looks like a standard slide switch,” with an actuator, body, and coupling features “such as identified...in the ’336 Patent.” EX1031, 155:17-156:20.

Reply at 28.

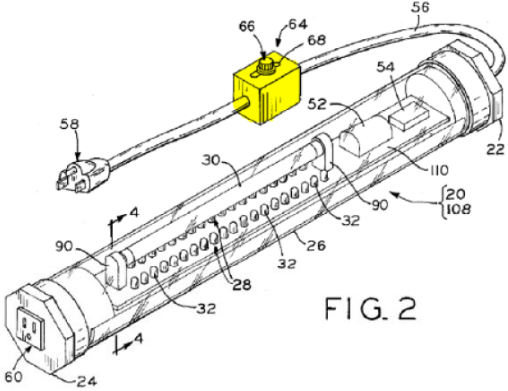
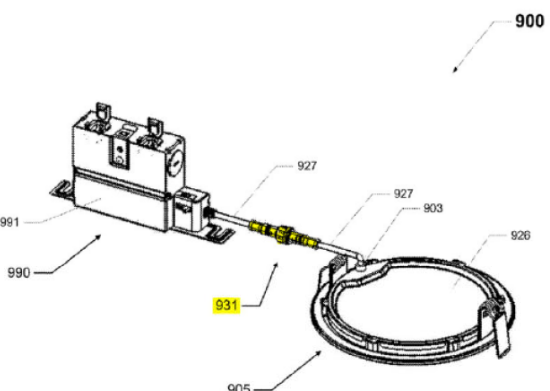
Referring to FIGS. 1 and 2, control box 64 may include switch 66 which is a stepped dimmer switch linearly slide-
 35 able in slot 68 to select light source 28 and rotatable to control the brightness of light source 28. Referring to FIG.

EX1013, 4:33-36 (see Pet. at 85).

“[T]he control box 64 ... provides and necessarily includes a body for the switch.”
 Petition, 85.

“Because the control box 64 is located on the electrical cable 56, it is necessarily electrically coupled to electrical cable 56, and therefore must include at least one coupling feature.”
 Pet. at 86.

Reiff Discloses a “Body” and “Coupling Feature”

Reiff	'336 Patent
 FIG. 2 EX1013, 1:6-10, 1:50-55 (“in line switch”)	 FIG. 9B EX1001, 11:65-66 (“[S]witch 931 is <i>in-line</i> with the electrical cable 927”)

Reply at 30.

Institution Decision:

Based on the current record and for the reasons stated by Petitioner and supported by Dr. Eden's testimony, Petitioner establishes sufficiently that Chaimberg discloses limitation 13a. *See* Pet. 40–41; Ex. 1004 ¶¶ 153–155.

Paper 14 at 49.

Based on the current record and for the reasons stated by Petitioner and supported by Dr. Eden's testimony, Petitioner establishes sufficiently that Chaimberg renders obvious limitation 13b. *See* Pet. 41–42; Ex. 1004 ¶¶ 156–159. More specifically, on this record, Petitioner establishes sufficiently for § 103 that Chaimberg teaches or suggests limitation 13b, but

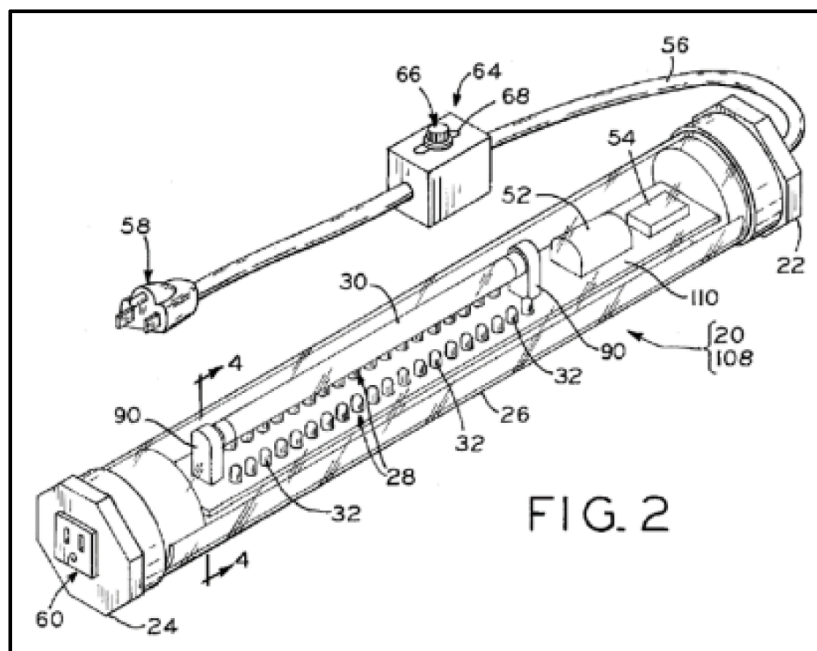
Paper 14 at 55-56.



Key Issue #4:

Reiff Discloses and/or Renders Obvious a CCT Switch

Reiff Discloses and/or Renders Obvious a CCT Switch



EX1013, Fig. 2 (see Pet. at 88).

1. A light fixture comprising:
 - a base;
 - two light sources mounted on said base, wherein one of said two light sources is one of an incandescent light and a fluorescent light, each of said light sources emitting a different color of light;
 - an enclosure substantially surrounding said light sources, at least a portion of said enclosure formed from a transparent material to allow the passage of light there-through; and
 - a control for selectively energizing one or another of said light sources, whereby said light fixture emits one or another color of light.

EX1013, 7:45-58 (see Reply at 32-33).

illuminating materials 36 and 38. When electrical current is supplied to electrode 48 of LED 34, illuminating material 36 is excited and LED 34 emits a first color, red or white for example. When electrical current is supplied to the second electrode 50, the second illuminating material 38 is excited and LED 34 emits the second color.

EX1013, 3:67-4:5 (see Reply at 32-33).

Reiff's Broad Disclosures

1. Field of the Invention 5

The present invention relates to lighting having multiple sources of light particularly useful for specialized industrial or military applications. In particular, this invention relates to such a light wherein the color of light emitted can be changed by an in line switch. 10

2. Description of the Related Art 10

In general, lighting is necessary for a multitude of industrial and military applications including in warehousing areas, military tents, and military vehicles. In some of these applications, specialized lighting may be required. Such 15 specialized lighting includes the use of "invisible" light, e.g., the use of a red or blue light for tasks including map reading, tent lighting, or cockpit lighting. Other specialized lighting may include infrared light for night vision, and UV lights used for curing epoxies or detecting leaks. 20

EX1013, 1:5-20 (see Reply at 29-30).

(57)

ABSTRACT

A light for use in applications requiring conventional and specialized, dimmable lighting wherein the color of the emitted light can easily be switched. The light includes fluorescent and/or LED light sources which are dimmable by a control box. The control box further allows for switching between two light sources provided in the light. The light sources may provide white light or specialized light including red or blue "invisible" light required in some military applications or UV lighting.

EX1013, Abstract (see Reply at 33).

Reiff's Broad Disclosures

LEDs have an outer shell in which an active substance such as a phosphor compound, gallium nitride, or gallium arsenide is contained. When electrical current is supplied to the LEDs, the active substance is excited causing the emission of visible light. The color of the LED is determined by the color of the outer shell or the type of active substance located in the LED. The LEDs may be of any suitable type emitting white light, or red, blue, or infrared "invisible" light which is of particular use in military applications. Additionally, the LEDs may emit UV light which is useful in leak detection or curing applications in industrial areas. LEDs may be purchased from several sources including LEDtronics, Inc., 4009 Pacific Coast Highway, Torrence, Calif.; Chicago Miniature Lamp, Inc., 147 Central Avenue, Hackensack, N.J.; Q.T. Optoelectronics, 610 North Mary Avenue, Sunnyvale, Calif.; Lumex Optocomponents, Inc., 292 East Hellen Road, Palatine, Ill.; and Gelcore, 6180 Halle Drive, Valley View, Ohio.

EX1013, 3:41-58 (see Reply at 33).

It is desired to provide a light having the capability of producing both conventional and specialized light colors for an area while being sturdy and durable enough to endure harsh and extreme environments, and wherein the color of the emitted light can be switched by means of an in line switch.

EX1013, 1:50-55 (see Reply at 30).

red and white light. Besides the use of red and white light LEDs, other color LEDs could be selected such as blue, green, UV, or infrared.

EX1013, 6:43-45 (see Reply at 33).

LEDs have an outer shell in which an active substance such as a phosphor compound, gallium nitride, or gallium arsenide is contained. When electrical current is supplied to the LEDs, the active substance is excited causing the emission of visible light. The color of the LED is determined by the color of the outer shell or the type of active substance located in the LED. The LEDs may be of any suitable type emitting white light, or red, blue, or infrared "invisible" light which is of particular use in military applications. Additionally,

EX1013, 3:41-49 (see Reply at 33).

Institution Decision:

Based on the current record and for the reasons stated by Petitioner and supported by Dr. Eden's testimony, Petitioner establishes sufficiently that Reiff discloses limitation 13d. *See* Pet. 88–89; Ex. 1004 ¶¶ 349–351.

Paper 14 at 63.



Key Issue #5: The Petition Is Not Time Barred

Menard Is Not an RPI

- The RPI determination “demands a flexible approach,” “with the heart of the inquiry focused on whether a petition has been filed at a party’s behest.” *Uniloc 2017 LLC v. Facebook Inc.*, 989 F.3d 1018, 1027-28 (Fed. Cir. 2021).
- Relevant considerations include “whether a party exercises or could exercise control over a petitioner’s participation in a proceeding, or whether a party is funding the proceeding or directing the proceeding.” *Id.* at 1028 (*see* Reply at 36).

Menard Is Not an RPI

Instead, I determine that the record does not include evidence showing any control or funding of this IPR by Menard, or substantial coordination between Petitioner and Menard in this IPR. *See* Paper 8 at 3–4 (“Luminex certifies that: Menard had no role whatsoever in Petitioner’s IPR; Petitioner never communicated with Menard regarding the substance of the IPR petition and never told Menard why the IPR petition would be filed . . .”).

Paper 20 at 16.

35 U.S. Code § 315(b)

An *inter partes* review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.

Luminex now acknowledges that Menard had relayed Signify's infringement allegations to it "almost three years before the IPR," and made clear its expectation that Luminex would defend Menard's interests in any lawsuit concerning the same. Reply, 35-36. These were not mere "routine business communications," but rather evidence that Luminex was acting on behalf of Menard and in Menard's interests. Consequently, the Petition should be time barred.

Sur-Reply at 28.

Patent Owner's "New" Evidence Does Not Alter The Director's and Board's Well-Reasoned Decisions

The February 24, 2021, letter from Menard's counsel to Patent Owner's counsel (Exhibit 2018) and the March 15, 2021, letter from Petitioner's counsel to Patent Owner's counsel (Exhibit 2016) do not amount to evidence tending to show beyond speculation that Petitioner "filed the IPR *because of or in response to* any request by Menard to do so" or that Menard is "controlling, funding, or directing" this proceeding. *See* Ex. 2016; Ex. 2018. Those letters relate to infringement allegations that Patent Owner made in a February 8, 2021, letter to Menard and predate the Petition by more than thirty months. *See* Ex. 2015; Ex. 2016; Ex. 2018.

Paper 26 at 18-19.

Patent Owner's "New" Evidence Does Not Alter The Director's and Board's Well-Reasoned Decisions

For *Garmin* factor I, Patent Owner does not identify evidence or provide sufficient reasoning “tending to show beyond speculation that in fact something useful will be uncovered,” e.g., showing that Petitioner “filed the IPR *because of or in response to* any request by Menard to do so” or that Menard is “controlling, funding, or directing” this proceeding. Mot. 4–7;

Paper 26 at 18.

IPR2024-01469, Ex. 1004. Instead, Menard’s decision to file its own IPR challenging claims in the ’336 patent undermines an inference that Menard is “controlling, funding, or directing” this proceeding.

Paper 26 at 21.

Regarding proposed production request nos. 5, 6, 7, and 8, Petitioner and Menard taking “steps” in the Wisconsin case as directed by district court to coordinate and act “as a united front whenever possible,” e.g., when working with Dr. Eden, does not tend to show beyond speculation that Petitioner “filed the IPR *because of or in response to* any request by Menard to do so” or that Menard is “controlling, funding, or directing” this proceeding. Mot. 7; *see* Suppl. Op. 8, 15–16; Paper 19, 6–7.

Paper 26 at 20.

Patent Owner's "New" Evidence Does Not Alter The Director's and Board's Well-Reasoned Decisions

As for pre-suit communications between Petitioner and Menard listed on a Menard privilege log, Patent Owner speculates that they may show that Petitioner “filed the IPR *because of or in response to* any request by Menard to do so” or that Menard is “controlling, funding, or directing” this proceeding. *See* Mot. 4–6. Those pre-suit communications predate the Petition by more than fourteen months. *See, e.g.,* Ex. 2016; Ex. 2017; Ex. 2018. Hence, even if those pre-suit communications are not privileged, which the parties dispute, the timing of those pre-suit communications lessens the likelihood that they have any relation to the preparation or filing of the Petition. *See* Mot. 4–6; Opp. 3–4, 10 & n.4; Ex. 3004, 2.

Paper 26 at 19.



Conclusion

CERTIFICATE OF SERVICE

The undersigned hereby certifies that, on June 6, 2025, a complete and entire copy of the foregoing Petitioner's Demonstratives and Updated Exhibit List have been served via electronic mail on Patent Owner's lead and backup counsel at the following email addresses:

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Counsel for Patent Owner

Dated: June 6, 2025

Respectfully submitted,

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