

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUMINEX INTERNATIONAL CO., LTD. and
MENARD, INC.,
Petitioner,

v.

SIGNIFY HOLDINGS B.V.,
Patent Owner.

Case IPR2024-00101
Patent 10,299,336 B2

Record of Oral Hearing
Held: June 11, 2025

Before CHRISTOPHER M. KAISER, KEVIN C. TROCK, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

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P-R-O-C-E-E-D-I-N-G-S

(1:03 p.m.)

JUDGE AMUNDSON: Good morning, or afternoon, depending on where you are located. I'm Judge Amundson, and with me on the panel are Judges Kaiser and Trock. We have our final hearing in IPR2024-00101 involving U.S. Patent Number 10,299,336 between Luminex International and Menard as Petitioners and Signify Holdings as Patent Owner.

Let's get the parties' appearances. Who do we have for the Petitioners?

Mr. Nightingale, you might be on mute.

MR. NIGHTINGALE: Thank you. So sorry about that. Good afternoon, Your Honor. Josh Nightingale of Jones Day on behalf of the Petitioner, Luminex International Co., LTD. With me here today is my colleague, Jeffrey Messing also of Jones Day.

JUDGE AMUNDSON: All right. And you're representing Luminex?

MR. NIGHTINGALE: That's correct, sir.

JUDGE AMUNDSON: And do we have anyone on the line for Menard?

MR. COLLINS: Yes, Your Honor, good morning. Or good afternoon, I'm sorry. Scott Collins from Woodard, Emhardt representing Menard, Inc.

JUDGE AMUNDSON: All right. Very well. And who do we have for the Patent Owner?

MR. OLIVER: Your Honor, Justin Oliver at Venable on behalf of the Patent Owner. With me in the room I have Jason Dorsky, also of Venable on behalf of the Patent Owner, Signify.

1 JUDGE AMUNDSON: All right. And who will --

2 (Simultaneous speaking.)

3 JUDGE AMUNDSON: Go ahead.

4 MR. OLIVER: No, that's all, Your Honor.

5 MR. COLLINS: All right. And who will be presenting the argument?

6 MR. OLIVER: I will, Your Honor.

7 JUDGE AMUNDSON: All right, thank you. Well, because we are
8 doing this hearing by video, we wanted to start by addressing a few items.
9 First, our main concern is your right to be heard. So if at any time during the
10 hearing you encounter technical or other difficulties that you feel undermine
11 your ability to adequately represent your client, please let us know
12 immediately, for example, by contacting the team members you provided
13 you with the connection information.

14 Second, when not speaking, please mute yourself. Third, please
15 identify yourself each time you speak. This will help the court reporter
16 prepare an accurate transcript. Fourth, we have the entire record including
17 the demonstratives. So when referring to a demonstrative or an exhibit or a
18 paper, please do so by identifying the slide or the page number. Also, please
19 pause a little after identifying the slide or page number to give others the
20 time to find it.

21 Fifth, there is a public line for people to call in and listen to the
22 hearing. I don't know if anyone has taken advantage of that opportunity.
23 But that's a possibility. Sixth, we set forth the procedure for today's hearing
24 in the order granting the requests for oral argument. That's Paper 40.

25 But just to remind everyone the way this will work, the order granting
26 the requests for oral argument said each side would have 60 minutes of total

1 argument time to present arguments. Petitioner bears the ultimate burden of
2 proof and will go first, and Petitioner may reserve time for rebuttal. Patent
3 Owner will go next and Patent Owner may reserve time for surrebuttal but
4 Patent Owner's surrebuttal must be limited to the issues in Petitioner's
5 rebuttal.

6 Also, please do not interrupt the other party while that party is
7 presenting its argument. If you have an objection, please raise it during your
8 argument. I will keep time and will try to give you a warning when you are
9 nearing the end of your time.

10 So, with that said, are there any questions before we begin?

11 MR. NIGHTINGALE: No, Your Honor.

12 MR. OLIVER: No, Your Honor.

13 JUDGE AMUNDSON: All right, very well. I do have questions for
14 counsel starting with Petitioner's counsel. Do you expect to discuss any
15 confidential information today?

16 MR. NIGHTINGALE: No, we do not, Your Honor.

17 JUDGE AMUNDSON: All right. That's good. What about Mr.
18 Collins?

19 MR. COLLINS: No, Your Honor.

20 JUDGE AMUNDSON: All right. Then let's -- what about Mr.
21 Oliver? Do you expect to discuss any confidential information today?

22 MR. OLIVER: That's not the expectation. I noticed that there are
23 issues about the RPI on the slide. To the extent those are raised, I might
24 have rebuttal. I don't know, because I don't know what will be discussed,
25 the scope of the rebuttal. But as far as a primary argument, no, I do not.

1 JUDGE AMUNDSON: All right. Well, if we get into the argument
2 and the situation changes, you know, just let us know right away so that we
3 can make appropriate arrangements with the PTAB staff, the hearing room
4 staff, and the court reporter so that we can make things confidential, okay?
5 All right.

6 Okay, let's begin with the argument. Mr. Nightingale, would you like
7 to reserve any time for rebuttal?

8 MR. NIGHTINGALE: Yes, Your Honor. We would like to reserve
9 10 minutes of rebuttal time.

10 JUDGE AMUNDSON: All right, very well. You may begin
11 whenever you are ready.

12 MR. NIGHTINGALE: Thank you, Your Honor. Again, Josh
13 Nightingale of Day Jones on behalf of the Petitioner Luminex. Today we
14 will be referring to Petitioner's demonstratives, which were filed as Exhibit
15 1046. So if you could now please turn to Slide 2 of our demonstratives.

16 Today we will be discussing the unpatentability grounds that were set
17 forth in the petition at page 15. The petition applies three primary
18 references, Chaimberg, Halliwell, and Reiff. Roberge is a secondary
19 reference that is combined with Chaimberg for only certain claims. The '336
20 Patent has two independent claims, 1 and 13. And you can see on page 15
21 of the petition that we are applying the Chaimberg and Halliwell grounds
22 against Claim 1 and its dependents.

23 For Claim 13 and its dependents we are applying grounds based on all
24 three primary references, Chaimberg, Halliwell, and Reiff. Today during
25 our presentation, Petitioner will be focusing on the five issues listed on Slide
26 Number 2. And those are number one, the claimed switch locations are

1 anticipated or obvious. Number two, Claims 13, 15, and 16 of the '336
2 Patent are not entitled to the '424 Provisional's priority date.

3 Number three, the body and at least one coupling feature of Claim 13
4 are obvious. Number four, Reiff discloses and/or renders obvious the CCT
5 switch. And number five, the petition is not time barred. Today I will be
6 addressing the first four issues and my colleague Jeff will be addressing the
7 fifth one.

8 Your Honors, if you could turn now to Slide 3. Before we discussed
9 the unpatentability of the challenged claims, I would like to briefly introduce
10 the '336 Patent. You can see on Slide 3 that the '336 Patent is entitled
11 Configurable Lighting System. The patent states that it relates to lighting
12 systems that can be readily configured to produce illumination of different
13 color temperatures.

14 So this is what the '336 Patent is generally directed to. We are talking
15 about lighting systems with a selectable correlated color temperature or
16 CCT. So the patent encompasses, for example, lighting systems where a
17 user can choose between a warm white light having a lower CCT like 2500K
18 and a cool white light having a higher CCT like 5000K.

19 So what is the purported invention of the '336 Patent? If you can turn
20 to Slide 4, you can see that one of the purported inventions is disposing a
21 well-known CCT switch remotely from the housing of the luminaire. Claim
22 1 reproduced on Slide 4 recites a basic luminaire with a housing, an
23 electrical component, an electrical cable, and a switch. All of these
24 components, Your Honors are well known and common in luminaires.

25 And to show this '336 Patent includes an applicant admitted prior art
26 figure. This is Figure 8 as shown on Slide 4 which it says is substantially

1 the same as the embodiment of the invention shown in Figure 9b. So both
2 the admitted prior art and the embodiment of Figure 9b include a housing, a
3 junction box, an electrical cable, and light sources.

4 All of these components were well-known common components of
5 luminaires. And the only difference between the admitted prior art and the
6 purported invention here is that the purported invention includes a CCT
7 switch, 931, that is located on the cable. You can see there we have a box in
8 red drawn around the switch 931 that is located on the cable.

9 Claim 1 and its dependents are directed to this embodiment. They
10 require a luminaire with a CCT switch coupled to the electrical cable and
11 disposed remotely from the luminaire's housing.

12 Turning to Slide 5 now, the other independent claim of the '336 Patent
13 is Claim 13. Claim 13 is even broader than Claim 1. Whereas Claim 1 was
14 directed to a luminaire, Claim 13 is claiming a CCT switch for use with a
15 luminaire. And you can see on the slide that the switch of Claim 13 requires
16 basic components of a body, a coupling feature disposed on the body, and an
17 actuator disposed on the body.

18 And all of these elements, Your Honors, are well known and common
19 in switches. And in fact, Patent Owner acknowledges this. Patent Owner is
20 contending that these elements have written descriptions of art in the '424
21 Provisional merely because it references a well-known DIP switch. So as
22 we will discuss, when Patent Owner later argues that the toggle switches,
23 slides switches, dial switches, and all of the other switches disclosed in the
24 prior art somehow failed to disclose the body and at least one coupling
25 feature disposed on the body limitations. This directly contradicts Patent
26 Owner's prior argument.

1 You can see here that the switch in Claim 13 does not need to be
2 remote from the luminaire housing. The Claim 13 switch just needs to be
3 electrically coupled to an electrical cable of the luminaire.

4 Finally, before I jump into the petition's unpatentability showing I'd
5 like to make three quick points up front. First, the '336 Patent is a
6 continuation in part, or a CIP application, and independent Claims 1 and 13
7 are claiming material that was first added in the CIP, material that is not
8 included in any of the parent applications. Figure 9b shown on Slides 4 and
9 5 is part of the new disclosure. This figure was not included in any of the
10 previous applications and this is the first time that Applicant disclosed the
11 CCT switch remote from the housing and electrically coupled to an electrical
12 cable of the luminaire. And as we just saw, Claims 1 and 13 include
13 limitations directed to this new disclosure.

14 It's patent law 101 that claims in the CIP do not get an earlier priority
15 date if they are directed to material that has been added in the CIP. And that
16 is the case here.

17 Second, Your Honors, it's also undisputed that Signify did not invent
18 the CCT switch. Slides 6 through 8, if you can please take a look at those,
19 capture earlier CCT switches from the years 2000, 2003, and 2014
20 respectively. The earliest claimed priority date of the '336 Patent is 2016.
21 So the first two examples predate the '336 Patent by over a decade.

22 And briefly on Slide 6, Ducharme filed in year 2000 shows a dial
23 switch such as the one you see here in Figure 10b on Slide 6 for selecting
24 color temperatures ranging from 3000K to 10,500K. Slide 7, the Roberge
25 reference filed in 2003, disclosed a wide range of switches, DIP switches,
26 slide switches, dial switches, other types of switches that were all used for

1 varying CCT. On Slide 8 we see that Patent Owner's own expert, Dr.
2 Krames, disclosed CCT switches in 2014.

3 And finally for my third point before we get started, Signify also did
4 not invent the concept of putting a CCT switch on a luminaire. On Slide 6
5 for example, there is text from our expert describing the Ducharme reference
6 filed in year 2000 again as having a lighting fixture, which is another term
7 for luminaire, with a selector switch for selecting color temperature and the
8 light generated, or excuse me, of the light generated by the luminaire.

9 And Patent Owner's expert, Dr. Krames, conceded that Roberge's
10 LED lighting units with CCT switches are luminaires. And the citation for
11 that, Your Honors is Exhibit 1031, page 86, line 20 to page 88, line 7. So
12 CCT switches were known. Luminaires were known. Luminaires with CCT
13 switches were known.

14 Unless Your Honors have any questions about this background
15 material, let's move to Slides 9 and 10 and begin discussing the first key
16 issue. The first key issue is that the switch locations claimed in the '336
17 Patent were disclosed or obvious. So I've shown in Slide 10 independent
18 Claim 1 and its dependents claim placing a well-known CCT switch in
19 various positions. I discussed earlier Petitioner is applying the Chaimberg
20 and Halliwell grounds against Claim 1 and its dependents. The Reiff
21 reference is not applied against these claims. For Claim 1 Signify's central
22 argument is that Chaimberg and Halliwell do not disclose a luminaire with a
23 CCT switch disposed remotely from the housing of the luminaire.

24 Signify also makes arguments about Claims 7 and 11 which
25 respectively requires that the switch be disposed within a cavity of the
26 junction box throughout a junction box, and that the CCT switch be

1 inaccessible when the housing is installed. So as I will discuss, the claim
2 locations in addition to being very basic elementary design choices, all of
3 these locations are disclosed or rendered obvious by Chaimberg and
4 Halliwell.

5 If you turn to Slide 11 now, Your Honors, let's start with Chaimberg.
6 Slide 11 shows that Chaimberg's CCT switch 18 is disposed remotely from
7 the housing just like the '336 Patent's switch 931 is disposed remotely from
8 its housing. This is a very straightforward issue with Chaimberg's disclosure
9 being nearly identical to that of the '336 Patent in terms of the switch
10 locations.

11 And more generally, Your Honors, Chaimberg and the '336 Patent are
12 nearly identical in that they both disclose a junction box, an electrical cable,
13 a switch, a housing. That's what we're showing here on this Slide 11.

14 Turning to Slide 12, even if it were possible that when Chaimberg's
15 luminaire is installed up in the ceiling, even if it were possible that the CCT
16 switch could possibly touch the housing in that scenario, Signify's expert has
17 testified that the switch would still be remote. Dr. Krames applied this
18 interpretation in arguing an infringement of the '336 Patent. You can see on
19 Slide 12, Dr. Krames argued that the switch, which is highlighted in yellow
20 and touching the housing is still remote from the housing. And Dr. Krames
21 further confirmed at deposition that the switch touching the housing is still
22 remote so long as the switch is external from the housing and not physically
23 integrated as part of the housing.

24 Now to be clear, Luminex disagrees that the Chaimberg switch would
25 touch the housing when it's installed up in the ceiling. We covered that in
26 our reply. But Your Honors do not need to reach that question because even

1 if the switch were touching the housing it would still be remote from it
2 according to Dr. Krames.

3 Moving to Slide 13, Your Honors, Claim 7 requires that the switch is
4 disposed within a cavity of a junction box. For this claim the petition
5 showed that Chaimberg describes the conventional approach of mounting a
6 CCT switch on the junction box. Now Chaimberg refers to this as the usual
7 approach. Chaimberg describes this in the background of its patent and later
8 says this is the usual approach, putting the CCT switch on the driver
9 housing, which is another word for the junction box.

10 And the petition further explained that it would have been an obvious
11 design choice for, to not only to put the switch on the driver housing or on
12 the junction box, but to put the switch within the junction box as required by
13 Claim 7. We showed that a POSA would have been guided by known
14 considerations like the desired level of accessibility and the desire to shield
15 the switch from dust and other debris that could affect a ceiling mounted
16 luminaire like Chaimberg's.

17 Our expert, Dr. Eden, explained that the choice of the switch location
18 is really determined by the application. For example, in a retail
19 establishment, if you don't want customers tampering with the CCT switch
20 and changing the CCT values, it would have been obvious to a POSA that
21 you would want to put the switch somewhere inaccessible such as on or in a
22 junction box that is located above the ceiling and thus customers could not
23 access it.

24 And Petitioner explained that even if Chaimberg's main embodiments
25 do not use the conventional approach where the switch is placed on the
26 junction box, the case law is clear that something known or obvious does not

1 become patentable simply because it has been described as somewhat
2 inferior to another approach. So even if putting the switch on the electrical
3 cable is preferred for Chaimberg's application, this does not confer
4 patentability on the known junction box mounted switch approach.

5 Turning to Slide 14, Your Honors, the Chaimberg switch is also
6 inaccessible when the housing is installed. You can see this clearly in
7 Figure 2. When the housing is installed in the ceiling the switch on cable 15
8 would be above the ceiling level making it inaccessible until you pull the
9 light fixture down. So again, this is straightforward. Chaimberg discloses or
10 renders obvious all of the claimed switch locations, the remote, the switch
11 being remote from the luminaire's housing in the junction box of the
12 luminaire and inaccessible with the luminaire's housing is installed. And as
13 seen on Slide 15, the Board agreed in its institution decision.

14 Moving on to Slide 16, the Halliwell reference also discloses or
15 renders obvious all of the claimed switch locations. So very briefly before I
16 jump into Halliwell, just a little bit of background on this reference. So the
17 Halliwell reference actually discloses not one, but two CCT switches. There
18 is a switch 30 that is mounted in or on the housing of the lighting device.
19 But the second CCT switch in Halliwell is a remote switch 40 which is
20 described as having a slide or push button, quote, to allow a user to select the
21 desired operating color temperature. That is Halliwell at column 17, lines 51
22 to 63, and column 18, lines 28 through 43.

23 JUDGE AMUNDSON: This is Judge Amundson. I had a question on
24 that second Halliwell switch. I think Halliwell identifies it as switch 40.

1 I seem to recall from the briefing that Signify pointed out that Dr.
2 Eden said that wasn't a switch. How do you respond to that, your expert
3 saying switch 40 is not a switch?

4 MR. NIGHTINGALE: Respectfully to our expert, Your Honor, he
5 was mistaken. Halliwell explicitly describes the remote switch 40 as having
6 a slide or push button. And Halliwell also says that the remote switch 40 is a
7 wall and/or junction box mounted toggle switch, dimmer switch, or the like.
8 Even if Halliwell contemplates embodiments where the remote switch 40 is
9 not a true switch as we would consider it, like some kind of electronic
10 device, Halliwell very clearly says that this remote switch can be a toggle
11 switch, a slide switch, or another type of switch.

12 JUDGE AMUNDSON: All right, thank you.

13 MR. NIGHTINGALE: So with this background in mind we've
14 discussed again, that Halliwell has the two switches, that the housing
15 mounted one 30 and the remote switch 40. Having this background in mind
16 we can easily step through the claim locations of Claims 1, 7, and 11.

17 So for Claim 1, Halliwell's remote switch 40 is clearly disposed
18 remotely from the luminaire's housing. Again, we talked about how the
19 remote switch 40 can be mounted on a junction box. And I don't think
20 there's any dispute that the junction box is remote from the luminaire's
21 housing.

22 For Claim 7, likewise the remote switchboard being junction box
23 mounted renders obvious what is required by Claim 7. Again, Claim 7
24 requires that the switch be placed within the cavity of the junction box and
25 similar to what we discussed with respect to Chaimberg, putting the switch
26 inside of the junction box as opposed to merely on it would have been

1 obvious to a POSA. Again, the application that you want to use the switch
2 for would dictate the location of the switch. And in applications where you
3 want the switch to be inaccessible it would have been obvious to use this
4 option described in Halliwell.

5 And for Claim 11, similar to Chaimberg, because Halliwell's
6 luminaire is ceiling mounted the junction box and its switch would be
7 located above the ceiling making it inaccessible to users, again, similar to
8 what we saw for Chaimberg.

9 Unless Your Honors have questions about Chaimberg or Halliwell's
10 disclosures of the claimed switch locations, I would like to move on to the
11 second key issue at Slide 18.

12 UNIDENTIFIED SPEAKER: No questions.

13 MR. NIGHTINGALE: The second key issue at Slide 18 is that
14 Claims 13, 15, and 16 of the '336 Patent are not entitled to the '424
15 Provisional's filing date and such that Chaimberg and Halliwell are prior art
16 against these Claims, 13, 15, and 16. And again, this is another
17 straightforward issue.

18 I talked about earlier the '336 Patent is a CIP and Claims 13, 15, and
19 16 are claiming portions of the new disclosure that was added in the CIP. So
20 they are clearly not entitled to an earlier filing date.

21 Turning to Slide 19, we see that Independent Claim 13 recites a CCT
22 switch with a body, a coupling feature disposed on the body, and an actuator
23 disposed on the body. Your Honors, none of these features are described in
24 the '424 Provisional. The Provisional never mentions a body, it never
25 mentions a coupling feature, and it never mentions an actuator. And there's

1 absolutely no disclosure of a CCT switch that is configured to be electrically
2 coupled to an electrical cable of the luminaire.

3 JUDGE AMUNDSON: This is Judge Amundson. I have a question
4 about this. And there are a couple of aspects to it. But on your Slide 19 you
5 say there is no inherent disclosure. But Signify says that I think it's Figure 2
6 or maybe Figure 4, they disclose a switch with part number 1571999-4. And
7 then Signify goes out and gets product literature that shows what a switch
8 with that part number is. And that product literature seems to show that it's
9 got the switch with that part number, has a body and pins. So what's wrong
10 with Signify doing that, if anything?

11 MR. NIGHTINGALE: Perhaps Your Honor, our Slide 19 could have
12 been a little more clear. Petitioner is not challenging that the DIP switch of
13 the '424 Provisional has a body or a coupling feature or an actuator. We
14 don't dispute that. What we do dispute is that the CCT switch, or the DIP
15 switch described in the '424 Provisional is, there is no disclosure of it being
16 configured to electrically couple to an electrical cable of a luminaire. That is
17 the dispute here.

18 There is no express disclosure of this switch being electrically coupled
19 to an electrical cable of the luminaire and there is no inherent disclosure of
20 that either. And that is what the slide is attempting to convey.

21 JUDGE AMUNDSON: Let me make sure I understand your position.
22 I understand, I think I understand your position that there is no disclosure in
23 the Provisional of an electrical cable of the luminaire. But are you disputing
24 that the Provisional discloses a switch configured to couple to any kind of
25 cable, or not?

1 MR. NIGHTINGALE: Well, Your Honors, neither party has
2 suggested or put forth the argument that merely being configured to a cable
3 is enough. The parties believe that, you know, in this case, the prior art
4 needs to show a cable being electrically coupled to an electrical cable of the
5 luminaire. I think any switch, Your Honor, as I think your question gets at,
6 any old switch with coupling features with pins, for example, potentially
7 could couple to an electrical cable. That's not the issue.

8 The question is whether, in this case, whether the '424 Provisional
9 actually provides written description support for a switch being electrically
10 coupled to an electrical cable of the luminaire.

11 JUDGE AMUNDSON: All right. And then I said that, you know,
12 you had a couple of aspects here. So it seems to me that in a certain respect,
13 Signify is relying upon extrinsic evidence to show what the Provisional
14 discloses. For example, they are relying on contemporaneous product
15 literature to show what that switch part number is. But it also seems to me
16 they are relying on other extrinsic evidence to show what some other things
17 are. They are relying on the '336 Patent specification to show what a couple
18 of things, to show there is a switch and to show there is a receptacle, and I
19 think Luminex disputes the propriety of doing that.

20 So here's my question. Why is it okay or acceptable for Signify to use
21 extrinsic evidence to show what the, what a certain feature is, but not use
22 other extrinsic evidence to show what the receptacle is?

23 MR. NIGHTINGALE: Well, Your Honor, Judge Amundson, again,
24 were not disputing about some of the basic features of the body, the coupling
25 feature or an actuator. Yes, Signify is using extrinsic evidence that may or
26 may not be correct but we're not disputing those features. We do take issue

1 with using the '336 Patent and trying to show that there is a receptacle based
2 on that. We know that written descriptions for it cannot be, or cannot be
3 based on hindsight. It really needs to be within the four corners of the
4 priority document. So in looking at the '336 Patent, which came years later,
5 that would absolutely be using hindsight. Using the '336 Patent to kind of
6 say, yeah, this is the receptacle, whereas when you look at the '424
7 Provisional you have this grainy image, and our expert testified note POA
8 looks at that and says that's a receptacle. It's just not clear from the '424
9 Provisional.

10 JUDGE AMUNDSON: I'm not sure I agree with it, like analytically.
11 Okay. As far as I know when you're talking about, well, maybe it's easier in
12 the anticipation context. So you, okay, you can use extrinsic evidence in the
13 anticipation context to show what something that's disclosed really means to
14 a skilled artisan. And I don't think there's any, you know, when it's proper to
15 do that it doesn't matter, I think to say it's hindsight. But what I'm just trying
16 to get a grip on, why is it okay to use some extrinsic evidence of the
17 contemporaneous product literature and it's not okay to use later developed
18 or later created patent specifications? I'm having a difficult time
19 understanding that distinction.

20 MR. NIGHTINGALE: Respectfully, Your Honor, I just don't know
21 that we need to address that particular issue. Again, we're not disputing any
22 of those, you know. When Signify goes and gets the extrinsic evidence
23 from, of the switch, for example the DIP switch, but we don't, you know,
24 we are not contesting that the DIP switch has a body or a coupling feature.

25 The real issue is whether the CCT switch or the DIP switch disclosed
26 in the '424 Provisional is configured to electrically couple to an electrical

1 cable of the luminaire. That is the point of the dispute and the extrinsic
2 evidence, there is no really extrinsic evidence in regards to that. We are
3 looking at the '424 Provisional and the parties are arguing about whether the
4 DIP switches are configured to electrically couple to an electrical cable of
5 the luminaire.

6 Does that help any, Your Honor?

7 JUDGE AMUNDSON: Yes. That helps. And then to follow up, on
8 that, all right, so if we look at page 3 of the surreply, do you have that?

9 MR. NIGHTINGALE: Yes, I can grab it, Your Honor. Yeah.

10 JUDGE AMUNDSON: All right. So on page 3 of the surreply
11 Signify quotes Dr. Eden's deposition testimony where he says he doesn't
12 think there's any reason to believe that the electrical wiring referenced in the
13 '424 Provisional could be house wiring. And they say that this admission
14 settles the matter. Why are they wrong?

15 MR. NIGHTINGALE: Your Honor, this, the way that Signify framed
16 the issue in their demonstratives is very misleading. The notion that the only
17 issue is whether the electrical cable, or excuse me, the electrical wiring is of
18 the luminaire or not, that is kind of a, that's a side issue. If you look back to
19 the petition, Your Honor, Luminex showed that the '424 Provisional has no
20 written description support for the entire limitation, not just the electrical
21 cable on the housing, the entire limitation which is that the CCT switch
22 needs to be configured to electrically couple to an electrical cable of the
23 luminaire.

24 In the '424 Provisional there is no description of any coupling between
25 the DIP switch and any electrical cable. Setting aside the luminaire piece,
26 there's no electrical coupling between the DIP switch and any cable. So

1 what happened Your Honor, is that when Signify filed its Patent Owner
2 response it said, it concocted this argument that somehow the electrical
3 wiring is allegedly connected to the substrate. What we pointed out is there
4 is no coupling between the electrical wiring and the substrate.

5 The only thing we know about the electrical wiring is what the
6 Provisional says, this is Exhibit 1008 at page 018. The Provisional says the
7 electrical wiring is, number one, not illustrated. Number two, it extends
8 through an aperture in the housing. So two things, not illustrated, extends
9 through an aperture. Nothing about that describes the cable as being
10 connected to the substrate period. So when this issue about of the luminaire,
11 that was really raised in response to Signify's argument. We said that even if
12 there was a coupling, which there's not, the electrical wiring is not described
13 as a being of the luminaire. Again, it just does not tell us that, Your Honor.

14 JUDGE AMUNDSON: All right. I think I understand your position.
15 Thank you.

16 MR. NIGHTINGALE: So Your Honors, moving on to Slide 20, this
17 exchange between myself and Judge Amundson, I talked about how there is
18 no description of a CCT switch being electrically coupled to an electrical
19 cable of the luminaire. Because the Provisional lacks any description of this,
20 Your Honors, the Patent Owner is relying on obviousness and alleged
21 knowledge in the art to argue somehow Section 112 support. This kind of
22 recaps some of what we just discussed. But again, the Provisional describes
23 a DIP switch being mounted on a substrate -- or, excuse me, what I would
24 like to present now is Signify's argument.

25 What Signify argues to find written description support allegedly is
26 that the Provisional describes a DIP switch being mounted on the substrate.

1 The Provisional also describes one isolated mention of electrical wiring
2 which, as I said, it is at Exhibit 1008 at page 018. It says, quote, electrical
3 wiring not illustrated extends through an aperture 103 in the housing 105.
4 Based on these disclosures Patent Owner argues number one, it was known
5 that a DIP switch has pins for electrical coupling.

6 Number two, the electrical wiring would allegedly pass through the
7 aperture, be connected to the substrate. Number three, this electrical wiring
8 would allegedly power the, power an electrical circuit on the substrate. And
9 number four, because the DIP switches are mounted on the substrate the DIP
10 switches would be coupled to the electrical wiring via the substrate. That is
11 Patent Owner's argument and it is clearly relying on obviousness and alleged
12 knowledge of the art to fill the gaps in the Provisional.

13 The Provisional does not describe the wiring being coupled to the
14 substrate. The Provisional does not describe the wiring providing power to a
15 circuit on the substrate. Again, all we know about the wiring is that it's not
16 illustrated and that it extends through an aperture. Even if connecting the
17 wiring to the substrate would have an obvious, or even if a POSA would
18 have known that to be a possibility, the law is clear that this cannot be used
19 to fill the gaps to provide Section 112 support.

20 In Slide 20, Your Honors, we cited the *Ariad v. Eli Lilly* case. In that
21 case the en banc Federal Circuit made this clear. Quote, the hallmark of
22 written description is disclosure. And in fact, the en banc Federal Circuit
23 further referenced the possession standard for Section 112 and said the
24 hallmark for written description is disclosure. Thus, possession as shown in
25 the disclosure is a more complete formulation. What this means, Your
26 Honors, is that when we're talking about Section 112 support it's not about

1 showing, it's not about possession in the abstract. It is about possession as
2 evidenced by the actual disclosure.

3 We also cite the *Lockwood* case on Slide 20. And *Lockwood* says
4 entitlement to a filing date does not extend to subject matter which is not
5 disclosed but would be obvious over what is expressly disclosed. It extends
6 only to that which is disclosed. Further, *Lockwood* said it's not sufficient for
7 purposes of the written description requirement of Section 112 that the
8 disclosure when combined with the knowledge and the art would lead one to
9 speculate as to modifications that the inventor might have envisioned but
10 failed to disclose.

11 So in sum, Your Honors, written description support must be met
12 within the four corners of the '424 Provisional. Patent Owner's argument
13 goes well beyond the four corners. It's based on obviousness. It's based on
14 what a POSA allegedly would have understood, and that is not permitted
15 under the law. Accordingly, Patent Owner has not met its burden of
16 establishing priority to the earlier '424 Provisional application.

17 And further, Your Honors, Patent Owner also made no attempt to
18 establish that the other applications in the priority chain leading back to the
19 '424 Provisional provided written description support for any claim of the
20 '336 Patent. And this is required. The *Lockwood* case cited here said, in
21 order to gain the benefit of the filing date of an earlier application under 35
22 U.S.C. 120 each application in the chain leading back to the earlier
23 application must comply with the written description requirement of 35
24 U.S.C. 112.

1 Patent Owner made no attempt, Your Honors, to establish that the
2 other applications in the priority chain leading back to the '424 Provisional
3 provided written description support for any claim of the '336 Patent.

4 JUDGE AMUNDSON: This is Judge Amundson. On that point that
5 you're making now, I have two questions. First, does Luminex dispute that,
6 I'll call it the grandparent application and the parent application, the
7 grandparent application being the first application filed after the Provisional,
8 does Luminex dispute that the grandparent application and the parent
9 application lack any disclosure that is in the Provisional?

10 MR. NIGHTINGALE: Well, Your Honor, we've not -- I've not
11 compared the '424 Provisional to those patents recently. But we did explain
12 in our petition, this is pages 19 through -- excuse me, 19 to 21, that none of
13 these intervening applications provided written description support for any
14 of the claims.

15 JUDGE AMUNDSON: Okay. And my second -- okay. My second
16 question is did you argue in the reply, did you make the argument in the
17 reply, the one that you're making now that Signify cannot point to anything
18 in the grandparent or parent application to show a continuous stream of
19 disclosures? Or however you want to phrase it. The continuity of
20 disclosure.

21 MR. NIGHTINGALE: I don't believe that argument was explicitly
22 raised, but frankly, we didn't have to, Your Honor. At that point after Patent
23 Owner failed to make the requisite showing in the Patent Owner response
24 the ship had sailed. Your Honors' scheduling order says that arguments not
25 raised in the Patent Owner response are considered waived. So it would

1 have been too late for Patent Owner to fix this problem in the surreply in any
2 event.

3 And more generally, Luminex believed that it is Patent Owner's
4 burden to make the required showings, and it was not Petitioner's job to
5 prompt Patent Owner to make the argument that it should make.

6 JUDGE AMUNDSON: All right. All right. I think I understand your
7 position. Thank you.

8 MR. NIGHTINGALE: If Your Honors have no further questions
9 about the priority issue we can go on to Slide 23, and begin discussing the
10 third key issue.

11 So starting on Slide 23 for Claim 13 and its dependents, the petition
12 applies grounds based on all three primary references, Chaimberg, Halliwell,
13 and Reiff. And for these claims, Signify's central argument is that
14 Chaimberg, Halliwell, Reiff and do not disclose or render obvious a CCT
15 switch with a body and at least one coupling feature disposed on the body.

16 And this is another straightforward issue, Your Honors. The body and
17 coupling feature limitation, they are trivial. All switches, including the
18 toggle switches, slide switches, and other switches that were cited in the
19 prior art, all of them included bodies with coupling features disposed on the
20 bodies. That is simply how switches are built now and how they've always
21 been built. And Patent Owner concedes this. I think I mentioned this
22 earlier, but in its priority argument the Patent Owner says that the '424
23 Provisional's mere disclosure of a DIP switch provides disclosure of a body
24 and at least one coupling feature disposed on the body.

25 Likewise, then Chaimberg, Halliwell, and Reiff and their toggle
26 switches, slide switches and other switches, they all have bodies with

1 coupling features disposed on them. So turning to Slide 24, starting with
2 Chaimberg for the claim to CCT switch in Claim 13, the petition cited that
3 Chaimberg's switch 18 stating that it provides the body where the slide
4 button 31 was located. Chaimberg says that the slide, excuse me, the switch
5 18 is a toggle switch and we showed that a POSA at the time of the alleged
6 invention understood that toggle switches have bodies with coupling features
7 disposed on the bodies.

8 The petition also stated that the toggle switch 18 providing the body
9 and coupling feature is configured to electrically couple with the electrical
10 cable 15 of Chaimberg's luminaire. The switch 18 is used to adjust the CCT
11 output and a POSA therefore would have understood the switch must be
12 electrically connected to the cable 15 that passes power from the junction
13 box to the LEDs.

14 We also rebutted, Your Honors, Patent Owner's argument that
15 Chaimberg's switch is somehow wireless. We cited to Chaimberg's
16 disclosure about its switch having quote conductor arms that moved based
17 on slide button 31 controlling direct current to Chaimberg's LEDs to achieve
18 a desired CCT. That is Chaimberg at column 4, line 30 to column 5, line 10.
19 So the switch 18 is not wireless, it is a wired in-line switch just like the
20 switch 931 of the '336 Patent.

21 Turning to Slide 25, Your Honors, we discussed earlier today that
22 Halliwell discloses two CCT switches. There's the housing mounted switch
23 30, and the remote switch 40. For the CCT switch of Claim 13, Luminex
24 cited to Halliwell's disclosure that it's remote switch 40 with a slide button
25 and used to control CCT, and Luminex further showed that a POSA at the

1 time of the '336 Patent understood that slide switches had bodies with
2 coupling features disposed on the bodies.

3 We also showed that Halliwell's remote CCT switch is electrically
4 coupled to an electrical cable from the luminaire. Halliwell describes a
5 ceiling mounted luminaire with the electrical, excuse me. Halliwell
6 describes a ceiling mounted luminaire with, quote, electrical components
7 that are directly wired to line voltage, e.g., through a junction box. And this
8 means that the LED lighting device would necessarily include an electrical
9 cable that is electrically coupled to Halliwell's remote switch 40.

10 And to be clear, the electrical cable, Your Honors, is the one that goes
11 between the junction box and the electrical components of the luminaire.
12 Now, Patent Owner has said that in reference to line voltage in Halliwell
13 means that this cable must be house wiring, and not a cable of the luminaire.
14 And this really misses the point. At the junction box, your honors, yes the
15 line voltage coming into the junction box might very well be house wiring.
16 But the connection between the junction box and the electrical components
17 of the luminaire would absolutely be via an electrical cable of the luminaire.

18 And not only that, we also pointed out that Halliwell describes a
19 second wired connection. A wired connection between the remote switch 40
20 and electrical components of the luminaire, including the switch control unit
21 35. That is Halliwell at column 17, lines 39 to 42. So both of the wired
22 connections in Halliwell would have been via electrical cables of the
23 luminaire. It would make no sense to use house wiring to connect to internal
24 components of a luminaire.

25 On Slide 26 then, Your Honors, for Reiff for Claim 13 CCT switch
26 the petition cited to the Reiff disclosure at column 4, lines 33 through 36,

1 stating that the control box 64 includes a switch 66 which is linearly
2 slideable in slot 68. We further showed that a POSA at the time of the '336
3 Patent understood that slide switches like Reiff's had a body and the
4 coupling feature disposed on the body.

5 Your Honors, if there are no further question about the body and
6 coupling feature disposed on the body limitations I'd like to go to key issue
7 number 4 on Slide 29.

8 So on Slide 29, for Ground 3, Patent Owner argues that Reiff does not
9 disclose a switch for the controlling of correlated color temperature of light
10 emitted by a luminaire. So in other words, Reiff does not disclose the CCT
11 switch. Let's go to Slide 30, please. On Slide 30, breaking down Reiff, we
12 know that it has two light sources. Fluorescent lamps 30, and LEDs 32.
13 Now, there's no dispute that the fluorescent lamps 30 emit white light.

14 Reiff says fluorescent lamps 30 are conventional lamps which emit
15 white light. That is Reiff at column 3, lines 30 through 31. So the
16 fluorescent lamp 30 is always emitting white light. Reiff also says that in
17 some embodiments the LEDs emit white light too. You can see this is in
18 Reiff's abstract on the next slide, Slide 31, which says that the fluorescent
19 and LED light sources may provide white light.

20 And on Slide 32, we see that Reiff discloses the use of white LEDs
21 and that the LEDs may be of any suitable type emitting white light. So in
22 Reiff we know that the fluorescent lamp is emitting white light. We know
23 that in some embodiments the LEDs are also emitting white light.

24 Importantly, Reiff tells us that the big point of its invention is configuring
25 the fluorescent lamp and the LEDs to emit quite different colors, such that

1 when you switch between the two light sources that gives you different
2 colors.

3 The very first sentence of Reiff's abstract is a light for use in
4 applications requiring conventional and specialized dimmable lighting
5 wherein the color of the light can easily be switched. The abstract says that
6 you switch the color of the light by switching between the two light sources.
7 So putting this all together, Reiff discloses two white light sources having
8 different colors. A POSA knows that different colors of white light have
9 different CCTs. A warm white light has a lower CCT and a cooler white
10 light has a higher CCT.

11 This is basic and obvious to a POSA. Reiff doesn't need to explicitly
12 mention CCT. The reference clearly encompasses the scenario Your Honors
13 where the fluorescent lamps and the LEDs are emitting different colors of
14 white light having different CCTs.

15 And Reiff also explains that the color of the LED is determined by the
16 color of the outer shell or the type of the active substance located in the
17 LED, such as the phosphor. And the phosphor is a compound commonly
18 used in LEDs to adjust CCT.

19 Now, Your Honors, even it would have been possible, even if it would
20 have been possible to engineer the two white light sources having different
21 colors to make them have the exact same CCT, the more typical situation is
22 the one I described, that the two different colors of white light would have
23 different CCTs. Again, the 2500K reddish-white light, a 5000K bluish-
24 white light. For all these reasons, Your Honors Reiff disclosed or renders
25 obvious the CCT switch with each position of the switch corresponding to a
26 different CCT.

1 JUDGE AMUNDSON: This is Judge Amundson. I have you roughly
2 about 5 minutes away from your initially requested 50 minutes.

3 MR. NIGHTINGALE: Thank you, Your Honor. And at this point if
4 Your Honors have no further questions about the material I presented I'd like
5 to give the presentation to my colleague Jeff to discuss the last issue.

6 JUDGE AMUNDSON: That seems fine. Looks like no one has any,
7 on the Panel, has any questions. Thank you.

8 MR. MESSING: Thank you, Your Honors. I'm, as Josh mentioned,
9 I'm Jeff Messing, also of Jones Day. I am going to quickly discuss Key
10 Issue 5, which is first addressed on Slide 34 of Exhibit 1046 that the Petition
11 is not time barred. It is our position that this issue has been resolved in
12 particular by previous decisions from then Director Vidal, who made clear
13 that Luminex's petition is not time barred. But to make the record clear we
14 wanted to address a few points that were raised in Patent Owner's response
15 and surreply.

16 So as an initial matter, at the time of our preliminary response the
17 record then demonstrated that Menard was not an RPI. Now, later on, the
18 Patent Owner has gone on to cite two new buckets of evidence to try and
19 overcome this previous ruling but the Board has already rejected both
20 categories of evidence in Paper 26. The first set of evidence was a set of
21 nine correspondence, some emails and letters between Patent Owner and
22 Menard or Patent Owner and Luminex.

23 The Board had all these exhibits when considering Patent Owner's
24 motion for additional discovery and the Board determined that these
25 correspondence did not amount to evidence tending to show beyond
26 speculation that Petitioner filed the IPR because of or in response to any

1 request by Menard to do so, or that Menard is controlling, funding, or
2 directing this proceeding. And that analysis can be found in Paper 26, pages
3 18 and 19. And those exhibits are 2015 through 2023.

4 The second bucket of evidence that Patent Owner points to now is two
5 correspondence between Menard and Luminex. And while the Board did
6 not consider these two particular documents in addressing Patent Owner's
7 motion, the Board did consider this category of evidence to be a category of
8 correspondence between Luminex and Menard and likewise held that this
9 evidence did not show beyond the mere possibility or mere allegation that
10 Luminex filed this petition on Menard's behalf.

11 And finally, just as closing on this, that all of this evidence, all of the
12 11 new cited exhibits were in Patent Owner's possession long before a
13 preliminary response was filed, so he's going to have any, that they could
14 have and should have been used at that time. I believe that is the final
15 arguments affirmatively from Petitioner.

16 JUDGE AMUNDSON: This is Judge Amundson. On the RPI issue, I
17 had a question and if you could go to page 35 of the reply.

18 MR. MESSING: Okay. I am there.

19 JUDGE AMUNDSON: And then, at the end of the top paragraph,
20 Luminex says Luminex's products can be sold to other customers without
21 Menard's branding. There is no exclusivity agreement or fee here. So my
22 question is what evidence do we have in the record that supports those
23 assertions?

24 MR. MESSING: I believe what we have in the record was in our
25 previous papers under our duty of good candor, Luminex represented that
26 these are simply white label products where Luminex creates the products

1 and sells them to Menard for Menard to then just put their logo on it and
2 ship them out.

3 JUDGE AMUNDSON: So you're, if I understand your position
4 correctly, your evidence is your attorney representations in briefs. Is that it
5 or am I missing something?

6 MR. MESSING: I believe that is it and that exactly pursuant to its
7 standard agreement that Menard's gives to their suppliers.

8 JUDGE AMUNDSON: All right. I think I understand. So unless
9 there are any questions from the other panel members then we'll turn it over
10 to Mr. Oliver. And so let me ask if you would like to reserve any time for
11 surrebuttal?

12 MR. OLIVER: I would, Your Honor. I'd like to reserve 10 minutes.

13 JUDGE AMUNDSON: All right. You may begin whenever you're
14 ready.

15 MR. OLIVER: Thank you, Your Honor.

16 May it please the Board, I'd like to focus this afternoon on Claims 1,
17 7, and 13, and I intend to address them in reverse order simply to cover what
18 we believe to be the easiest issues first. As a brief overview Claim 13
19 involves a priority issue as we've heard. Luminex's only argument against
20 priority although it seemed to waiver a little bit in the opening argument is
21 that the disclosed electrical cable in the '424 Provisional would be, have to
22 be understood to be house wiring rather than the cable of a luminaire.

23 As we'll discuss, Luminex's own expert says he would have to have
24 his head x-rayed if he used house wiring in that context, as well as other
25 quotes where he rejected that position. With the failure of that single

1 untenable argument presented by Luminex there is no basis for objecting to
2 the priority date for Claim 13.

3 With that, neither Chaimberg nor Halliwell are prior art against Claim
4 13 leaving only the Reiff reference. As we will discuss Reiff does not
5 disclose CCT selectability at all. It is directed at selecting different light
6 sources of different colors. The concept of CCT, as it is now not disputed,
7 only applies to white light. Thus, as we'll discuss, none of the grounds
8 applied against Claim 13 are viable.

9 With respect to Claim 7, that claim requires a CCT switch be disposed
10 not only remotely from the housing of a luminaire, but in a junction box of
11 the luminaire. The main reference relied upon by Luminex on this point in
12 Chaimberg cautions against even putting such a switch on the junction box
13 and instead directs it to be moved away from the junction box. For that
14 reason the arguments presented against Claim 7 fail.

15 And then, finally, I will ultimately address Claim 1, which deals with
16 the remote positioning of a switch. The dispute between the parties there
17 essentially comes down to whether the switch in Chaimberg Figure 2 is
18 hidden behind an element outside of the housing or within the housing. And
19 as I'll discuss the hidden switch argument is not tenable. Now, I'd like to
20 turn to the demonstratives, Your Honor. And before getting into the
21 provisional issue I want to talk about two slides for context, which I think
22 will help inform the discussion that we have. And I would direct the Panel's
23 attention to Slide 4 of our demonstratives.

24 Slide 4 just to give context to the discussion we have discusses the
25 innovation award granted by Home Depot to the original assignee of the '336
26 Patent. And for context again, prior to this invention and the product

1 embodying this invention if one were to go to a store like Home Depot and
2 try and buy different recessed lighting for use in a home there would be
3 several different options that you choose from. A light that had a very cool
4 white with one CCT, a light that had an in between cool and warm with
5 another and perhaps another CCT option on the warm band.

6 The invention is directed to solving a problem of having to stock all of
7 that and potentially having a contractor buy the wrong color CCT setting
8 lights for use. And because of this simple, elegant solution which was
9 embodied in these products Home Depot provided this award and stated as
10 we can see on Slide 4 of the demonstratives, that this was just a great, huge,
11 awesome innovation. And the reason I bring this up, Your Honor, is
12 because often years later there's the tendency towards hindsight as we all
13 know.

14 And we can look at inventions and say well, it seems somewhat
15 simple but may be an elegant solution but we have to look at it at the context
16 of what was happening at the time. And at the time this solved a problem
17 that people didn't even realize could be solved in a simple and efficient
18 manner. And that should inform the discussions that we have here today.

19 JUDGE AMUNDSON: This is Judge Amundson. On this point you
20 are raising in Slide 4, I think in the response at page 9 you mentioned
21 industry awards and praise from market leaders. And so here's my question.
22 Is Signify relying on those industry awards and that praise from market
23 leaders as objective evidence of non-obviousness?

24 MR. OLIVER: Well, we certainly think it provides objective
25 evidence of non-obviousness and I don't think there's been any dispute in the
26 record as to things such as nexus or commensurateness of the scope. That

1 being said, the primary reason why it was addressed in the background and
2 in the background context here is because it helps inform what was known
3 or what was understood prior to the invention versus after to avoid that
4 hindsight of, I mean to put it bluntly, often people when they see a new idea
5 they're like, oh, why didn't I think of that?

6 And years later, it's much easier for someone to say well, I could've
7 come up with that, or that would have been obvious. So whether it is
8 specifically being relied upon as true, objective indicia of non-obviousness,
9 which I certainly think it is, it at the very least provides context to avoid the
10 hindsight bias that could come years later from establishing what would or
11 would not have been obvious to a person of ordinary skill at the time.

12 JUDGE AMUNDSON: Well, okay. I think I understand your
13 position. This is Judge Amundson. I think I understand your position but
14 what I'm concerned about is whether when the Panel analyzes the issues we
15 have to analyze objective evidence of non-obviousness going through
16 whether you establish a nexus, and all of that. Or, you know, as part of the
17 Graham analysis, the three Graham factors and the objective evidence of
18 non-obviousness. So I'm still not clear if we have to do that. If we have to
19 do that, we'll do that. But if we don't have to do that then it makes it easier.

20 MR. OLIVER: Well, Your Honor, I'm not waiving the argument of
21 objective indicia, we think that is provided enough in our papers that,
22 particularly in Dr. Krames' expert report, Exhibit 2131 at paragraph 58. So
23 I'm not waiving the option of objective indicia and I don't think there's any
24 dispute as to something like nexus. I don't think there's been any dispute
25 from Luminex on that point.

1 However we still provide that either way it is relevant to the
2 consideration of obviousness as to understanding what would or would not
3 have been obvious to a person of ordinary skill in the art.

4 JUDGE AMUNDSON: All right. Thank you.

5 MR. OLIVER: Okay. So, the other slide I'd like to address for
6 context is Slide 7 of our demonstratives. And if we look at Slide 7, as we
7 can see the '336 Patent on the top has a provisional application, the 424, with
8 a filing date of February of 2016. With the establishment, which we'll
9 discuss, of entitlement to that priority date for Claim 13 neither Halliwell nor
10 Chaimberg are prior art and those grounds simply go away. And also what's
11 important to understand from this is that the only reference that would
12 remain would be Reiff, and Reiff does not mention CCT selectability at all.

13 And this dovetails into the Slide 4 discussion of what was and was not
14 known at the time and what would have been and would not have been
15 obvious to someone at the time. With that context, I'd like to turn to a
16 discussion of the support and the position demonstratives. And I'd direct the
17 Panel's attention to Slide 10 of the demonstratives.

18 On the right-hand side of Slide 10 we see the '424 Provisional. On the
19 left we see the '336 Patent. There is no dispute that both of them show a
20 luminaire that has a housing that has LEDs, the same circuit diagram, the
21 same CCT selectability.

22 Also as shown below each of those images from the text, there's no
23 dispute that both of them describe a DIP switch which is not disputed as we
24 heard earlier, although it was a little bit unclear at first as to whether there
25 was going to be a new argument of that being disputed. But it now sounds

1 like it is still not disputed, that that DIP switch has a body and coupling
2 features as required by the claim.

3 And in particular, if we look at Slide 12 of the demonstratives, while
4 it seems Counsel may have gone back and forth a little bit from what I was
5 hearing on what the argument actually is, looking at the reply, pages 16 and
6 17, the argument that was actually presented by Luminex to which we
7 responded did not dispute any of the preamble, 13a, 13c, and 13d. And in
8 fact, only really disputed 13b, which has the first coupling feature disposed
9 on the body wherein the first coupling feature is configured to electrically
10 couple to an electrical cable. And it doesn't really seem from the actual
11 reply that any of that leading up to the highlighted language was actually
12 disputed.

13 What seemed to be disputed in the briefing, although it seems maybe
14 the argument is shifting a little bit now, the only thing actually raised in the
15 briefing is whether or not the specific wiring disclosed in the Provisional
16 was to be considered house wiring which they say would not count, versus
17 the cable of a luminaire which they don't dispute would count. That makes
18 this a very simple issue to decide in argument and in particular looking at
19 Slide 13, there's a general argument to be made and a precise argument to be
20 made with respect to this issue of the electrical cable for the luminaire. With
21 respect to the general argument I'll note that luminaire, Luminex's own
22 expert, Dr. Eden when asked about whether the dipswitch, which was
23 disclosed in the 336 and the 424, would meet the requirements of Claim 13,
24 we can see on Slide 13 that he agreed, yes. Yes, it would. That should
25 really end the analysis.

1 But to the extent we have that specific argument of whether or not the
2 luminaire's wiring is house wiring I would direct the Panel's attention to
3 Slide 15. Slide 15 has at the top the quote from the Provisional application.
4 The Provisional says electrical wiring (not illustrated). It does not need to
5 be illustrated to be supported. It is disclosed as being used. And it says it
6 extends through the aperture or extends through a wiring aperture 103 in the
7 housing 105. So it's extending into the luminaire.

8 Looking at the actual briefing, putting aside whatever arguments
9 might have been newly made today, the argument made by Luminex was,
10 well a person ordinarily skilled in the art wouldn't think that that's a cable of
11 luminaire, they think maybe that could be house wiring wired directly into
12 the device. That argument fails for simple admissions, one of which Your
13 Honor already brought out and I would direct the Panel's attention to Slide
14 17.

15 And on Slide 17 on the right-hand side we have the quote that Your
16 Honor brought up from the briefing, which is their own expert, Luminex's
17 own expert was asked about this and whether it could be house wiring. He
18 explicitly said no. Thus, the very argument presented by Luminex to say
19 that the Provisional does not support the claims is rejected by both experts.
20 If both experts don't think that argument is credible there is simply no basis
21 for Luminex to dispute the priority. And this is not an isolated quote from
22 Luminex's expert, Dr. Eden. If we look at Slide 18 we can see that he
23 doubled down on this. And I alluded to this into my introduction.

24 On Slide 18 he was asked about the possibility of taking house wiring
25 as Luminex proposes and putting it right through that aperture and wiring it
26 right in directly to the substrate. And he refuted that. He ultimately said,

1 well, it could be done, but he concluded I think I'd have to have my head x-
2 rayed if I did that. The simple issue before the panel is this. Where
3 Luminex's own expert thinks that the argument they're making is crazy and
4 would not have been something that they would have expected from reading
5 the reference to electrical cable, then there's simply no basis in the evidence
6 to support their argument.

7 With that it seems that the argument being presented today is well, it's
8 not just about whether it's house wiring or a cable of the luminaire.
9 Apparently, Counsel is now saying that the argument is broader and that
10 there's no indication of coupling. I have read the briefing, particularly the
11 reply at pages 16 and 17 where this appears. I've seen no alternative
12 argument that's being presented here today.

13 So I don't think that is a argument that was actually briefed. To the
14 extent however the Board may entertain that argument it seems to be that
15 Luminex's argument is, yes, the Provisional calls for electrical cable. Yes,
16 the Provisional calls for that electrical cable to extend through the housing
17 inside the luminaire but no one would ever expect that that would actually
18 connect and provide electricity to the circuit board. That seems to be the
19 argument presented today and that just doesn't seem credible. And I don't
20 know of any place where that argument was made or is supported by any
21 evidence such as the testimony by their own expert, Dr. Eden.

22 For those reasons we do not believe the rebuttal to the claim of
23 priority is proper. And I'll also just finally touch upon what I also believe is
24 going not be the argument, which is this argument that somehow the
25 intervening applications might lack support. That argument, I did not see
26 that in the briefing, and I'm not aware of that being made or that that's ever

1 been challenged. And it sounds like from the questioning and it sounds like
2 from the questioning that is perhaps assumed, but not actually made.

3 We on the Signify side responded to the arguments actually made.
4 That is not one that's made, and there is basis for making a finding on that
5 where Luminex has not actually made that as a challenge to the priority
6 issue. For those reasons we do not believe there's any basis to deny priority
7 to the Provisional application with respect to Claim 13.

8 We also discussed 15 and 16 in our briefing. I'm going to focus on 13
9 here today. With that, Chaimberg and Halliwell simply don't matter because
10 they don't qualify as priority. That leaves only Reiff. But I'd like to turn to
11 Reiff absent any questions on the priority argument.

12 JUDGE AMUNDSON: Well, this is Judge Amundson. And correct
13 me if I'm wrong. But I mean, I -- if I understand the grounds correctly,
14 we've got to deal with a challenge to claims 17, 18, and 19 based on
15 Chaimberg. Don't we?

16 MR. OLIVER: Yes, Your Honor. We are not alleging that 17, 18,
17 and 19 are supported by the original provision. So that's not an argument
18 that we presented. We believe that claims 13, 15, and 16 are supported.

19 JUDGE AMUNDSON: So the Panel will still have to deal with issues
20 about what -- whether Chaimberg discloses or teaches Claim 13's limitations
21 on the way to getting to whether Chaimberg teaches limitations in claims 17,
22 18, and 19.

23 MR. OLIVER: Yes, Your Honor, and on that point, that's why the
24 briefing also included separate and apart from the priority issue, that none of
25 Reiff, Chaimberg, or Halliwell provide the disclosure of the switch body and

1 the coupling feature. And I will address that as soon as I address the Reiff
2 reference.

3 JUDGE AMUNDSON: All right.

4 MR. OLIVER: Unless you'd like me to take it in a different order?

5 JUDGE AMUNDSON: No. Just proceed however you planned to.

6 MR. OLIVER: Thank you, Your Honor.

7 JUDGE TROCK: This is Judge Trock. Can you hear me?

8 MR. OLIVER: Yes, I can.

9 JUDGE TROCK: Okay. Thank you. Sorry, we had a problem a little
10 while ago with the -- a microphone problem in San Jose. So I had several
11 questions for you that I was not able to get through.

12 MR. OLIVER: Oh.

13 JUDGE TROCK: These are quite basic, but the first question is who's
14 got the burden here with respect to priority date?

15 MR. OLIVER: Well, the burden of showing that there's support in the
16 Provisional, which is the only argument presented in the petition is on us.
17 But the only argument in the petition is whether or not --

18 JUDGE TROCK: That's fine. I understand. I don't want to cut you
19 off, but it's a simple question. I just want to understand it. It's your burden.
20 Correct?

21 MR. OLIVER: Correct.

22 JUDGE TROCK: So I'm looking at your Slide 15. And I think the
23 argument from Petitioner was that there's no express disclosure here of the
24 switch being attached to the cable. And it sounds like you're arguing that
25 there is electrical wiring that could be placed through that aperture which
26 would be the cable and that someone of ordinary skill in the art would

1 understand that. So aside from what somebody of ordinary skill in the art
2 would understand could be done here, where is the express disclosure of the
3 switch being attached or electrically coupled to the cable? I'd like to see
4 that.

5 MR. OLIVER: Certainly, Your Honor. So I think the issue in the
6 petition originally was that the petition assumed that the Claim 13 switch
7 also had to be remote and it didn't. And that the language is simply coupled
8 to the cable. Claim 13 only requires that it is electrically coupled to the
9 cable. So there just has to be a electrical coupling in some way.

10 There is no dispute that if the circuit board is connected to the writing
11 that comes into it, there would be an electrical coupling. There's been no
12 arguing, argument that electrically coupled means directly attached one to
13 the other. It just means that the two are coupled in an electrical manner.
14 That, there is also notice through this, as far as I know that that dipswitch
15 actually controls what power goes to what LED. I mean, the dipswitch
16 operates so that some LEDs are turned on, some LEDs are not turned on. So
17 it is the gatekeeper.

18 So it is the question of support here is what a person of ordinary skill
19 in the art understood possession of a dipswitch that is the gatekeeper of
20 power to the LEDs to be electrically coupled to the power that goes to the
21 LEDs. That is not a question of obviousness, it's a question of whether a
22 person of ordinary skill in the art would understand that the patentee, or the
23 applicant at that time would have been in possession of that idea.

24 So there the issue would be is it more likely that the person of
25 ordinary skill would have said yeah, I see that your dipswitch controls power
26 to the LEDs and I see that a cable comes in, but it's baffling me whether or

1 not the electricity that's coming in actually gets to the toggle switch in order
2 to get to the luminaire. We think a person of ordinary skill in the art looking
3 at this would say, look, if this dipswitch is controlling the power to these
4 LEDs and we have a cable coming in, there is an electrical connection. And
5 as such --

6 JUDGE TROCK: This is Judge Trock. Where is the cable coming
7 in?

8 MR. OLIVER: Oh.

9 JUDGE TROCK: I see the aperture, but I don't see the cable coming
10 in.

11 MR. OLIVER: Well, the Provisional specifically says electrical cable
12 not shown goes through the aperture. It does not need to be depicted in a
13 figure to be supporting. There is written description support in the
14 specification saying we have a cable that enters through an aperture, and it
15 says electrical cable not shown. But the fact that it's not depicted in a figure
16 is a separate question from whether it's supported from the specification as a
17 whole. That would be our argument.

18 JUDGE TROCK: It sounds like what you're relying on and I'm going
19 to use your words here, "idea," that there is a disclosure of an idea here that
20 this electrical cable would come through the aperture and attach to the
21 dipswitch. And that's your electrical coupling. So it sounds like you're
22 relying on what someone of ordinary skill in the art would understand or
23 interpret from this drawing. Is that correct?

24 MR. OLIVER: Well, let me put it this way, Your Honor. On Slide 72
25 of our demonstratives we have cited certain case law. It's also cited in our
26 brief, including the *Strech* decisions and the *Hybritech* decisions. Both of

1 them say that a patentee can rely on information that is well known in the art
2 to satisfy written description.

3 And the second quote from *Hybritech* says you need not teach, and
4 preferably omit, things that are well known in the art. The patentee isn't
5 required to put down every single detail needed to ultimately make the
6 invention work where a lot of them are well understood in the field. We
7 have an explicit disclosure of a cable. If there's an explicit disclosure that
8 that cable goes through an aperture. Inside that aperture is a circuit board.

9 The question here is would a person of ordinary skill in the art have
10 needed to be told that the wire actually connects to the circuit board or is that
11 something that would have been known to the person of ordinary skill in the
12 art such that that is not a detail that is needed for disclosure.

13 We think under those two cases it is not explicitly needed to tell a
14 person of ordinary skill in the art here who would be well versed in these
15 types of operations that you actually have the wire to provide the power
16 because otherwise the light doesn't turn on. And --

17 JUDGE TROCK: Well then, how do you respond to Petitioner's
18 cases, for example, *Ariad* and *Lockwood*?

19 MR. OLIVER: Well, *Ariad* -- well, those are about whether or not
20 obviousness is known. We're not saying that we're using an obviousness
21 standard here. We're talking about what's the standard for written
22 description support. And the standard for written description support is
23 would a person of ordinary skill in the art think you were in possession of
24 the invention.

25 And if the only question is if you describe a cable coming into an
26 aperture and you describe a circuit board inside that has light that has to be

1 powered and a toggle switch that actually controls the power to those lights,
2 would a person of ordinary skill in the art understand that you're really
3 describing that the electrical cable connects and could we really say that a
4 person of ordinary skill in the art would say I have no idea whether you
5 possess the idea of actually attaching the cable. I mean, if that is a, I'll speak
6 a little informally. It seems a little ticky-tack for purposes of the case law of
7 whether or not you just happen to demonstrate to a person of skill to
8 possession.

9 JUDGE TROCK: Then this is my last question on this topic. How do
10 you respond to Petitioner's argument that you, the Patent Owner, did not go
11 through the chain of priority and establish it, establish this for all the
12 applications in the chain back to the Provisional?

13 MR. OLIVER: It wasn't disputed, Your Honor. The only argument
14 made is --

15 JUDGE TROCK: Well --

16 MR. OLIVER: -- whether or not --

17 JUDGE TROCK: Well, okay. Hold on.

18 MR. OLIVER: Yes.

19 JUDGE TROCK: Let me stop you right there. Who's got the burden?
20 Disputed or not, who's got the burden to establish this?

21 MR. OLIVER: We have the burden, Your Honor, but we work within
22 the arguments raised in the petition here. We provided a rebuttal, a proper
23 rebuttal to the argument in the petition that the Provisional does not support
24 that. And that question we have answered. As far as whether or not there's
25 any dispute about what comes later, it doesn't even seem like at the oral

1 argument Luminex is disputing whether or not there's a dispute as to that
2 issue.

3 JUDGE TROCK: Right. But I think the point he's making is that the
4 burden falls on Patent Owner, because you're the ones who wanted to rely on
5 this early priority date. But you didn't go back through and establish that
6 connection all the way through the chain of priority, and it sounds to me a
7 little bit like you're burden shifting here. You're putting the onus back onto
8 the Petitioner to do this.

9 MR. OLIVER: Well, not that we're putting it on the, the ultimate
10 burden, but they haven't even disputed it. There's a difference between
11 whether or not someone is putting a burden to prove the ultimate issue back
12 on someone is one thing. Actually having them dispute something is
13 another. It hasn't been an issue that's even been disputed up until today
14 during the oral argument. Had it been disputed then certainly we would
15 have addressed it and we would have certainly accepted that we have to
16 ultimately prove that.

17 But when it doesn't seem to be disputed, you know, I mean, to put it
18 another way if we address the arguments that are in dispute, and that does
19 not appear to be an argument in dispute until today during the oral argument.
20 Had it been disputed then certainly we would have addressed it and we
21 would have certainly accepted that we have to ultimately prove that. But
22 when it doesn't seem to be disputed, I mean, to put it another way, we
23 addressed the arguments that are in dispute and that did not appear to be an
24 argument in dispute until today. Had it been raised in any briefing we
25 certainly would have addressed it and we don't think there would have been
26 any issue then. But had it not even --

1 JUDGE TROCK: Okay. I think I understand your position. So let
2 me ask you this. How do you think we should handle this issue?

3 MR. OLIVER: Well, Your Honor, I think we have addressed the
4 issues that have been raised. And for that reason we think it's appropriate.
5 If Your Honor believes that there's more briefing on that particular issue the
6 panel is more than welcome to invite that from both sides. Our position is
7 that since it was never disputed it didn't seem to be an issue that Luminex
8 wanted to raise as an argument. And if it had been, we would have
9 addressed it. But I'll leave it at that. We're happy to provide more briefing
10 to that but we don't think it was ever an dispute.

11 JUDGE TROCK: Okay.

12 MR. OLIVER: And we think that it would be improper for it to
13 suddenly be raised as an issue in dispute for the first time by Luminex at oral
14 argument.

15 JUDGE TROCK: Okay. Thank you very much.

16 MR. OLIVER: With that, I would like to turn to Reiff. Because Reiff
17 has to be addressed separately from the Provisional argument and I would
18 direct the panel's attention to Slide 24 of the demonstratives. Reiff is about a
19 device, a portable device that provides mainly two different light sources. A
20 white light source such as a fluorescent light and an LED source that can
21 provide what Reiff calls invisible colors. Not really invisible but that help
22 evade detection.

23 And the idea and the primary example given in Reiff is that this would
24 be used in military applications. Specifically when someone is inside of
25 their tent and they want to be able to see things they would use the

1 fluorescent light to provide normal white light for illumination as one would
2 in the home.

3 However, for someone in the military, a soldier, when they're out on
4 the battlefield and they want to look at a map using a white light would
5 attract attention. And for that reason there is a second the LED that provides
6 these colored lights such as a red light which will allow someone to see
7 what's on a map but not expose the soldiers position to the enemy.

8 That is what this is about and that was the embodiment relied upon by
9 Petitioner, and I would direct the Panel's attention to Slide 25 of the
10 demonstratives. Specifically, the petition relies upon the Figure 2
11 embodiment which has a white fluorescent light and a red LED light, or blue
12 or UV. For purposes of our discussion I'll focus on the red. And that's
13 described in the two bullets on the right-hand side.

14 I think what happened here is when the original petition was filed
15 Luminex's experts simply did not understand that only white lights have
16 CCT values.

17 CCT does not apply to colored light such as a red light. And that's
18 required by Claim 13. As we see on Slide 26 there is a requirement that
19 each position correspond to a CCT of the light. And looking at Slide 27, just
20 to make this point and then I'll address some of the issues raised by
21 Luminex's counsel, on slide 27 on the left-hand side we have quotes from
22 Exhibit 2044, which made clear that CCT is a way of describing different
23 warmths or temperatures of white light.

24 And this is not now disputed as we saw from opposing counsel's
25 opening remarks. He agrees that what this determines is describing either a

1 cool white light, such as a fluorescent light, or a warm white light such as
2 something you would get from an incandescent bulb.

3 Importantly, looking at the quote on the right-hand side CCT is not
4 used for colored light. It is a way of describing white light alone and
5 specifically is the differences among types of white light.

6 Thus, looking at Slide 28 of our demonstratives, a red light simply
7 doesn't have a CCT, and we could see this from Luminex's own expert's
8 admission on the right-hand side Slide 28 at the top. So if light is the color
9 red but it's not on this curve, that color red light would have, would not have
10 a CCT. That's correct. That's the issue here.

11 What is described in Reiff is not describing switching between
12 different CCT values of a light. It's describing switching between a white
13 light which would have a CCT value and a colored light which would have
14 no CCT value. And I would note that Luminex's own expert in Exhibit 2030
15 at page 150 admitted that he's not even sure Reiff would even understand
16 what CCT is anyway. This shows that Reiff about CCT selectability at all.
17 And Luminex and its experts simply misunderstood this.

18 As noted in our briefing in his initial deposition Luminex's expert
19 wasn't able to answer basic questions about CCT. It wasn't until his reply
20 declaration and deposition where he seemed to understand what CCT
21 actually referred to. There is simply a misunderstanding of this reference
22 and it does not apply. Since --

23 JUDGE AMUNDSON: This is Judge Amundson. I understand your
24 point about Reiff disclosing LEDs that produce red, blue, or infrared or
25 invisible light but if we look at column 3 in Reiff, that's Exhibit 1013 and
26 then, do you have that? Column 3. If we go to line, starting at line 47, it

1 says that the LEDs may be of any suitable type emitting white light or red,
2 blue, or infrared "invisible" light which is of particularly use in military
3 applications.

4 And then, further up in column 3 it says that the light fixture includes
5 fluorescent lamps 30 that are conventional lamps which emit white light. So
6 it seems like there's disclosure in Reiff about two light sources and each
7 light source emits white light. What's your position on that?

8 MR. OLIVER: You're right about what it discloses there. The
9 conclusion that Luminex draws from that, I believe, is what is incorrect.
10 There is a discussion in Reiff that the LEDs might emit white or red. And
11 I'll note in their own slides and I'll actually bring up a specific name, but this
12 is actually cited in their briefing and in their demonstratives at 32. And that
13 is the citation to column 6, lines 43 to 45 at Reiff. And I'd direct the Panel's
14 attention to that, and the lead-up to that starting around line 31.

15 The reason that Reiff describes that an LED could be white, red, blue,
16 UV is basically what's described here and I'll read just a little bit from that
17 paragraph that they cite to. A further embodiment of a light in accordance
18 with the present invention is illustrated in Figure 5. Light 112 is provided
19 with one light source. It then goes on to basically explain what Luminex
20 cites to which is that one light source may be an LED that can emit white
21 and red light.

22 So here's the problem with their argument. Reiff is describing using a
23 light source that is, well first of all, we take this in a few steps. The petition
24 relies on an anticipation analysis for this element, first and foremost. And
25 cites to Figure 2's embodiment. Those are what we've addressed. What has
26 been happening in the reply is Luminex now saying well, look about this

1 other thing where the LED could be white or red. That is true, but that is
2 described with respect to an embodiment of saying you don't have to have 2
3 light sources. You don't have to have a fluorescent and LED. You could
4 just provide an LED because the LED could provide both white and red
5 light.

6 That, however, is not a suggestion of providing a light that has two
7 light sources, both disclosing white light. Basically what Luminex is trying
8 to do, now that they realize the problem with the petition is saying, okay, we
9 know that LEDs could be white or red and we know that Reiff describes two
10 light sources and while both have embodiments described providing a white
11 and red light where that's, in one embodiment it's fluorescent and LED and
12 another it's an LED that provides white and red, we're going to pick from
13 one embodiment the LED white light and from the other embodiment the
14 fluorescent white light and we're going to put them together in one and say
15 it's all fine.

16 Not only is that argument not in their original petition but it's not
17 supported by anything as far as reasoning. Put another way, why? The
18 Petitioner has to show why and again, this isn't something that was
19 addressed in the petition. It's a new argument raised in the reply. Why
20 would someone say, reading Reiff, you know what, it would be obvious to
21 take a white fluorescent and a white LED and put it together and that way I
22 can switch between white light and white light. Wouldn't that be great? It
23 will be two light sources that provide white light.

24 That doesn't really make any sense and it's not truly supported by
25 what's actually disclosed in Reiff. For that reason as well as the fact that it's
26 not in the original petition we believe that argument fails. Separately, and

1 I'm going to move from that to another point and I'll direct the Panel back to
2 our slides. Looking at Slide 30 of our demonstratives, even if one were to
3 assume that you could make that modification to Reiff, again not in the
4 petition, not any arguments as to why someone would want to do that.
5 Looking at the left-hand side of Slide 30, we can see the question raised to
6 Luminex's own expert. You could have two different types of light sources,
7 one LED and one non-LED that output light at the same color temperature,
8 correct? Yes, he admits that's correct.

9 So not only does Luminex need to come up with this new argument
10 and basically combine different embodiments of Reiff to have two white
11 lights in the same light source for whatever reason, we don't know why. But
12 then, you would have to take the next step and say would those actually have
13 different CCTs? And the only argument I seem to get from the oral
14 argument here is it's possible. Maybe they could. But it's not necessarily the
15 case that you're going to have different CCTs just because you have two
16 different white light sources.

17 And ultimately, what Luminex needs to do is to prove that there
18 would be a switch to switch between different CCT values. Even if their
19 proposed modification applied it doesn't get there. And for all of those
20 reasons we believe the analysis with respect to Reiff fails.

21 Does that answer Your Honor's questions?

22 JUDGE AMUNDSON: Yes, thank you.

23 MR. OLIVER: With that, I'd like to, absent any more questions on
24 Reiff, I would like to just touch on what I raised a little bit earlier which is a
25 separate and an independent reason other than priority and this CCT issue is

1 why all of the Reiff, Chaimberg and Halliwell fail with respect to Claim 13.
2 And I'd direct the Panel's attention to Slide 32 of the demonstratives.

3 We can see the highlighted language of Claim 13 which requires a
4 body and at least one first coupling feature disposed on the body. I'd like to
5 address them in the order of Reiff and Chaimberg, but the issue is the same
6 throughout there. And essentially, in the petition in each case Luminex
7 pointed to a casing which is just not a switch body, and which does not have
8 anything disposed on that body. And now, the argument seems to be in each
9 case, well, maybe if you opened up that casing you might find the right type
10 of switch inside. That was ultimately their burden to put in the petition and
11 it simply was not there. And I'll address those one reference at a time
12 starting on Slide 33 of the demonstratives.

13 In the original petition Luminex identified for Reiff the box 64. And
14 it says, well, that's a switch body and the cable seems to go through that
15 casing or box 64. There doesn't seem to be anything disposed on it, let alone
16 any sort of coupling feature. However, during the trial, the progression of
17 the briefing, looking at Slide 34 of the demonstratives, Luminex's own
18 expert admitted that he was just wrong about this and this was an oversight.
19 He shouldn't have pointed to box 64. And you can see on the right-hand side
20 form his quote that statement was an oversight, I missed that in the review of
21 the declaration.

22 And instead, he says well, it could be a body of the switch. It depends
23 on the nature of the switch and the way it was manufactured. What
24 Luminex's expert is saying is I pointed to the wrong thing, that thing's not an
25 actual switch body. Maybe it could be a switch body if you wanted to, but
26 in order to perform the analysis that should have been in the petition I would

1 need to know what switch we're using. And I'll note on Slide 35 of the
2 demonstratives on the top left, this was an issue already noted by this Panel
3 in the institution decision that Reiff doesn't actually disclose the coupling
4 feature on the body. So this is a known problem.

5 And then, on the right we see, again, more quotes from Luminex's
6 own expert as to whether or not this is actually disclosed and he admits that
7 Reiff does not disclose what the switch looks like. For that reason, the
8 petition's ground does not actually, and this an anticipation analysis in the
9 petition, it simply does not meet this feature.

10 I think Luminex seems to understand the problem now because if we
11 turn to Slide 36 of our demonstratives their reply is essentially putting forth
12 arguments of well, maybe you're right, but if we open up box 64 maybe
13 there will be a switch in there that looks like the one from Exhibit 1029,
14 when it's not even clear whether this qualifies as a printed publication or not.
15 What we do know for certain that whatever is shown in the right-hand side
16 of Slide 36 from Exhibit 1029, it's not an argument that was actually
17 presented in the petition. They're saying here's one type of switch that might
18 be able to combine with Reiff to meet the claim in the petition. But that's
19 simply not in the petition.

20 And this argument pervades the other grounds as well. I would direct
21 the Panel's attention to Slide 40 of the demonstratives. And in Slide 40 for
22 Chaimberg we will see a similar issue where the petition relies on this box
23 18. Again, the wire goes inside of that box 18. There's no coupling feature
24 that extends or is exposed on the outside of it. Everything seems to be
25 happening inside because ultimately that is a casing.

1 Looking at Slide 42, again, Luminex's own experts were proving the
2 point here. On the right-hand side he was asked about this and what might
3 be in that switch 18 and how would we know whether it would meet what is
4 actually required of the claim. And you can see his response highlighted and
5 bolded at the very bottom right of Slide 42. He says there could be a pot of
6 gold inside it. I have no idea. If Luminex's own expert has no idea of what
7 type of switch would be in that box 64, then Luminex has simply not met its
8 burden in the petition with respect to the petition.

9 And then, finally, well, I'll note also looking at Slide 44 again
10 Luminex in its reply seems to want to address other possibilities including
11 this Globe product that is shown which is itself not even prior art as
12 addressed in our briefing, to say well, maybe you could combine this with
13 Chaimberg to get to what's actually claimed. Again, not in the petition.

14 Finally, I direct the Panel's attention to Halliwell which is provided on
15 Slide 50. And on Slide 50 there is a, basically housing, of the luminaire
16 itself shown in Figure 4 and that was what was pointed to as being a switch.
17 Well, whatever is happening it's happening inside of the housing and there's
18 not any disclosure of what is being shown. And again, Luminex's own
19 expert admitted the same looking at Slide 51 of the demonstratives.

20 On the bottom left, question. So if I understand your testimony,
21 Halliwell doesn't depict or describe the switch body? Answer. Correct.
22 Again, this is basically a common failure throughout the petition of the
23 casings or bodies or other things that are being disclosed are not switch
24 bodies and haven't been shown to be bodies that actually have disposed
25 thereon electrical coupling features.

1 Separate and apart from the support from the Provisional, separate and
2 apart from the CCT issue, we believe that the application and the grounds
3 against Claim 13 fail for those additional reasons. And I'll just note to sort
4 of conclude on this point, Slide 52 of our demonstratives.

5 (Simultaneous speaking.)

6 JUDGE TROCK: This is Judge Trock. Can you hear me?

7 MR. OLIVER: A little bit. It's a little soft, but I can hear you, Your
8 Honor.

9 JUDGE TROCK: Sorry, this is Judge Trock. Can you hear me?

10 MR. OLIVER: I can.

11 JUDGE TROCK: Is that better? Okay.

12 MR. OLIVER: Yes.

13 JUDGE TROCK: I'm getting the sense here that you're applying a
14 double standard. So we're talking about this coupling feature and you're
15 taking issue with Petitioner because they're pointing to these features and
16 you're saying well, there's no disclosure that it electrically couples. But
17 then, when we're going back to your priority you're saying, well, there's no
18 wire being shown but a person of ordinary skill in the art would understand
19 that if it's going to power that switch that it would be coupled to it. So how
20 is it on the one hand you can rely on that but on the other hand the Petitioner
21 cannot?

22 MR. OLIVER: So I don't think it's a double standard, Your Honor.
23 With respect to a written description, the case law is different. And the case
24 law we pointed to basically says all that is needed is that a person with
25 ordinary skill in the art understand that there was possession of the
26 invention. The question there is then, does a person of ordinary skill in the

1 art understand that the cable that's discussed would actually connect to the
2 circuit board? And I don't think there's any real dispute on a person with
3 ordinary skill in the art would have understood that.

4 With respect to the application in the petition, I'll note that if you look
5 at the petition for all of these grounds with respect to 13a and 13b there is no
6 obviousness analysis. There is only a basically a pure disclosure analysis.
7 The difference here is that Luminex's own expert who they are relying upon
8 for their support for their arguments says, you know what, I got it wrong and
9 if I were to actually know whether or not the switch inside would meet the
10 limitations I'd have to see which one. Because there are a lot of different
11 design choices.

12 And we see that on Slide 52. There are many design choices on the
13 wall-mounted switch. Whether someone could pick one switch versus the
14 other is something that needs to be addressed in the petition. Whether
15 someone says here's the cable, here's the circuit. This cable actually
16 provides power; we didn't actually tell you to plug it in or not is not one of,
17 there's different design choices where sometimes the cable never powers the
18 circuit or never gets connected to the circuit. That's I think the distinction
19 that we're --

20 JUDGE TROCK: Right. But not to interrupt you. Not to interrupt
21 your argument here, but what's the claim language we're trying to meet here?
22 Coupling feature?

23 MR. OLIVER: Certainly, Your Honor.

24 JUDGE TROCK: Okay. So you're telling me that someone of
25 ordinary skill in the art wouldn't understand that if this is a switch there's an
26 electrical coupling feature? And that because there might be different design

1 choices that somehow or other that precludes them from understanding that a
2 coupling feature is being disclosed?

3 MR. OLIVER: Yes. I understand your point, your honor. Maybe I
4 can answer it easily this way.

5 JUDGE TROCK: Before you answer let me just ask one last
6 question, what's the level of ordinary skill we're talking about here in this
7 case?

8 MR. OLIVER: It's addressed in the petition. I can bring it up.
9 Actually, I have someone bring it up right now. But let me answer --

10 JUDGE TROCK: Do the parties agree on what the level of ordinary
11 skill is?

12 MR. OLIVER: It wasn't disputed, Your Honor.

13 JUDGE TROCK: So whatever the papers say it is or what we
14 adopted in the DI, you're good with that?

15 MR. OLIVER: Yes.

16 JUDGE TROCK: Okay. Go ahead, then. I didn't want to interrupt.

17 MR. OLIVER: So to answer your question, to the extent Your Honor
18 believes that there's tension between those two arguments, let me say that
19 that doesn't change the outcome because for Petitioner to prevail they need
20 to win both arguments. They need to win that there is no support for the
21 Provisional and that way they can apply Chaimberg, and they need to have
22 Chaimberg read in the way that they are arguing. We only need one of
23 those. If we win on the Provisional, Chaimberg doesn't apply at all.

24 So for us the, however way Your Honor decides to go to the extent
25 there's tension between those two arguments, if they go to, well, we're going
26 to be on the conservative side and Chaimberg doesn't apply, we're going to

1 be on the less conservative side and there is support, if you decide between
2 one or the other then we prevail. Petitioner has to win both. And I think that
3 is maybe the easiest way to think about this. So for us there's not tension
4 there. Does that make sense, Your Honor.

5 JUDGE TROCK: Right. And then I guess what my last follow-up
6 question is, should we apply the same standard with respect to their
7 application of obviousness and the interpretation of what's disclosed in that
8 Provisional?

9 MR. OLIVER: Well, the standards, the legal standards are different.
10 What would have, the standard for written description is not the same
11 standard for obviousness. Or for anticipation and again, I don't believe
12 there's an obviousness analysis in there. But even putting that aside, if we
13 were to even just pick obviousness and written description, written
14 description is what a person of ordinary skill in the art understands
15 possession of what is claims. That's all. It's not a question of would the
16 person have found it obvious. Could they have done it a different way, or
17 would it make sense to that person. It's --

18 JUDGE TROCK: And this is a coupling feature we're talking about,
19 right? Coupling features?

20 MR. OLIVER: Coupling. Correct. So the legal standards are not the
21 same and we would again cite to the case law that's provided in our
22 demonstratives and our briefing at Slide 72, which says you don't need to
23 disclose the things that are minutia, essentially. Again, if you had to
24 disclose every single detail, the specification would become quite lengthy
25 and maybe unnecessarily so.

1 JUDGE TROCK: Okay. I just wanted to put my mind at ease, the
2 claim language we're talking about in both of these different analyses is the
3 same, coupling feature. Correct?

4 MR. OLIVER: Well, for the prior art argument of Chaimberg
5 applying it is switch bodies with a coupling feature on the outside. For the
6 Provisional it is just, there is no dispute about whether there is a body,
7 whether there's a coupling feature. It's only about electrically connected to
8 the cable of the luminaire. So it is not exactly the same issue. There is no
9 dispute for the priority issue that there would be, that the DIP switch
10 described is a, would have had a body with a coupling feature. That is
11 disputed with respect to the prior art.

12 So while it's also a different legal standard, it's not the exact same
13 question, if that makes sense.

14 JUDGE TROCK: Okay. I understand. Thank you very much.

15 JUDGE AMUNDSON: This is Judge Amundson. I have you at
16 about 50 minutes into your time.

17 MR. OLIVER: I'll just touch very quickly upon Claim 7 and then I'll
18 reserve the rest of my time for rebuttal. Looking at Slide 60 in the
19 demonstratives, Claim 7 requires a luminaire comprising a junction box,
20 wherein the switch is disposed within a second cavity, that second cavity
21 being defined by a wall of the junction box. So we have this junction box of
22 the luminaire; not any junction box.

23 Chaimberg, looking at Slide 61, gives very specific and multiple
24 admonitions about associating a switch with a junction box at all. He
25 explains that these junction boxes of a luminaire are put up on the ceiling
26 connected to the luminaire. They're difficult to get to. You could damage

1 the ceiling. There's hazards associated with reaching up there to try and get
2 to that junction box. And, because of that, Chaimberg explicitly says don't
3 do that. And it says, manipulating the driver housing is therefore not
4 recommended for safety reasons.

5 While I know that a lot of patent owners come before the panel and
6 say, well, there's a teaching away, and teaching away is a very specific thing,
7 we do have specific admonitions here in Chaimberg. Despite those specific
8 admonitions, Luminex's concept is someone would read all these
9 admonitions and say -- that say you should put the switch somewhere not
10 associated with the junction box, and read that to say, according to their
11 petition, you would certainly put the switch inside the junction box. That is
12 simply contradicted by the specific statements in Chaimberg.

13 And I'd like to raise one other specific point on that. The argument in
14 the petition is that you would take this remote control which, again, as noted
15 in the opening discussion, Luminex's own expert doesn't believe it's actually
16 a switch. And then there's a remote control to allow a person to control the
17 lighting fixture. And Luminex's arguments say, well, obviously we take that
18 remote control and put it up in the ceiling inside of a junction box where no
19 one could get to it.

20 That simply doesn't make any sense and I won't go through it all to
21 save my time for rebuttal, but I will note that with respect to some of these
22 issues, well, that's, that was with respect to Halliwell. Chaimberg's a little
23 bit different so I confused the two of those and I apologize, Your Honor.
24 But Chaimberg has a specific admonition, Halliwell has the remote-control
25 authority that their own expert says he would not want to put up and make
26 inaccessible, yet that is their very argument for doing so.

1 So with respect to Claim 7, neither reference, whether it be
2 Chaimberg or Halliwell describes making a switch to be inside a cavity
3 defined by a junction box of a luminaire and for that reason we believe that
4 the arguments made by Luminex on this point are simply incorrect.

5 Absent any questions on Claim 7, I'd like to reserve the rest of my
6 time for rebuttal.

7 JUDGE AMUNDSON: All right. Fine. I think you have, I have you
8 roughly at about 53 minutes into your time. Okay. But I do have two
9 questions, two unrelated questions.

10 The first question concerns Claim 1 and Chaimberg and Chaimberg's
11 Figures 1 and 2. So here's the question. And it concerns the limitation
12 about, in Claim 1, about a switch being remote from the housing. So I see
13 your point about Chaimberg Figure 2 and you know, the dispute about
14 whether the switch is hidden behind a spring-loaded clamp or whether it's
15 inside the luminaire. But if we look at Chaimberg Figure 1 where the
16 luminaire is pulled out from the ceiling mounting the switch seems to be
17 remote. And so here's the question.

18 So why doesn't the principal that prior art that sometimes meets a
19 claim limitation suffices when you're talking about obviousness?

20 MR. OLIVER: Our position on this, and it's, I would note that
21 Luminex did not seem to dispute the argument and said in response to our
22 argument about Figure 2 they made this hidden switch argument. So there
23 didn't seem to be a dispute about our analysis that Figure 2 is the right figure
24 to look at. That being said, Your Honor, with respect to Figure 1 versus
25 Figure 2, obviously you have to look at something in its normal state or you
26 have to pick some way to actually look at it.

1 Obviously, when something's being assembled for instance, it might
2 not yet meet the physical limitations of a claim. Figure 1 is basically when
3 the wire is being pulled out and stretched sort of away from it for
4 installation, not in its sort of normal state.

5 And we're thinking about if you were to actually, whether it's post
6 installation or whether you just put this thing on a table and look at it and
7 say it doesn't meet the requirements of the claim. We think if you just put
8 this on a table and say it doesn't meet the requirements it would not. And
9 the reasons we give for that are stated in our petition and we would look at
10 Figure 2.

11 I'd also note with respect to the relationship between Figure 1 and
12 Figure 2 we see that box 18 connected to a wire that connects to the very
13 center it appears of the luminaire, such that it doesn't seem to be spaced
14 along the wire that it could even clear the housing in a normal sort of not
15 sort of pulled apart situation. And our argument is just because you could
16 pull something apart in one situation does not mean that it in its normal state
17 it actually discloses that. And that's our argument for that. And I don't see
18 that Luminex disputed that. They only seemed to dispute whether or not
19 Figure 2 discloses a, you know, remote switch or not at that time.

20 JUDGE AMUNDSON: All right.

21 JUDGE TROCK: This is Judge Trock. Sorry, not to interrupt you --

22 JUDGE AMUNDSON: Go ahead.

23 JUDGE TROCK: -- Judge Amundson. But is it correct for looking at
24 Figure 1 and Figure 2 that Figure 1 is the same device shown in Figure 2 but
25 Figure 2 is put into the ceiling housing and attached? Is that --

26 MR. OLIVER: Yes.

1 JUDGE TROCK: Am I reading this correctly?

2 MR. OLIVER: Yeah. Figure 2 --

3 (Simultaneous speaking.)

4 JUDGE TROCK: Okay. So in other words the features that are
5 shown in Figure 1 that we can see when it's removed or not attached to the
6 ceiling tiles there, for example, Item 18, that doesn't disappear in Figure 2,
7 right? It's still there. You just haven't shown it.

8 MR. OLIVER: Yes. Yeah. Our position, Your Honor, is that it
9 would be in the device in figure 2 but the reason that it does not appear is
10 because it is inside the housing of that device. And that's why you don't see
11 it. And therefore, in that situation it would not be remotely --

12 JUDGE TROCK: I see and what are you defining as the housing of
13 the device there in Figure 2?

14 MR. OLIVER: The housing is 12. So basically, this box 18 would be
15 basically resting inside of 12.

16 JUDGE TROCK: I see. Okay. Thank you.

17 JUDGE AMUNDSON: All right. This is Judge Amundson. And my
18 second question concerns the statements I asked Mr. Messing about in the
19 reply. I think it's in the reply, page 39. If you could pull that up. I'm sorry,
20 the reply 35. Yes, reply 35. If you could pull up the reply.

21 MR. OLIVER: Yes, I know the question you're referring to, Your
22 Honor. I am not aware of any evidence that's been submitted that would
23 suggest that these devices could be sold to anyone else. If that's the question
24 you're asking.

25 JUDGE AMUNDSON: Well, no. My question for Signify is a little
26 bit different. It's for the statements that Luminex's products can be sold to

1 other customers without Menard's branding and there is no exclusivity
2 agreement or fee here. My question for Signify is whether Signify disputes
3 those assertions.

4 MR. OLIVER: We don't have evidence to be able to agree or to
5 dispute that. If that was an argument that was going to be presented and
6 there wanted to be evidence if there is indisputable evidence and we couldn't
7 dispute it I would admit that. However, I just don't have the evidence to
8 know that one way or the other.

9 JUDGE AMUNDSON: You don't have, I mean, just so I understood.
10 You don't have the evidence because it's not in, presented or filed in this
11 proceeding or you don't have the evidence because it wasn't produced in the
12 underlying district court litigation?

13 MR. OLIVER: Just to be clear, Your Honor, I am not handling the
14 litigation. I don't know whether it was produced in that litigation or not. I
15 do know that there are protective orders in place that I believe would prevent
16 me from seeing everything in that, which is why we had some of these
17 motions to produce because, just because it was in the litigation doesn't
18 mean it's available for use in the IPR. I have not been privy to any
19 documentation from the litigation on that point and I don't know that
20 because it hasn't been presented in the IPR and it hasn't been presented to
21 me.

22 JUDGE AMUNDSON: All right. I think I understand. Thank you.

23 JUDGE TROCK: This is Judge Trock, can I ask the question slightly
24 differently? Counsel, as you sit here now is it correct to say that you have
25 no factual basis with which to dispute these statements here on page 35?

1 MR. OLIVER: I have no basis to agree with or dispute them because
2 I haven't seen evidence one way or the other.

3 JUDGE TROCK: Okay. Thank you.

4 JUDGE AMUNDSON: All right. Unless there are any further
5 questions from the Panel let's go back to Luminex's counsel. Mr.
6 Nightingale, I think you have 10 minutes for your rebuttal. If you could try
7 to keep it to that, or close to that.

8 MR. NIGHTINGALE: Thank you, Judge Amundson. Yes, I don't
9 plan to use my 10 minutes. I just have a few quick points I'd like to make.
10 There was some discussion about secondary considerations. And I would
11 just like to say that the Patent Owner has not presented any real secondary
12 considerations analysis. The Patent Owner never showed any nexus
13 between the claims and the purported objective indicia of non-obviousness.

14 The Patent Owner's counsel said Luminex never disputed nexus. But
15 it is Patent Owner's burden to show nexus. It is not Luminex's burden to
16 show that there is no nexus. And the citation for that, Your Honor, is at the
17 *Demaco Corp. v. F. Von Langsdorff Licensing* case, which is 851 F.2d 1387.
18 It's a Federal Circuit case establishing that it is the Patent Owner's to
19 establish nexus.

20 The second, Your Honor, the other point I'd like to raise is that Patent
21 Owner's counsel suggested that there was some kind of shifting of
22 arguments that Petitioner shifted its arguments and that during the hearing
23 today I was arguing that there was no electrical coupling between the '424
24 Provisional's dipswitch and any electrical cable wherein as in our reply I was
25 only, or we, Luminex was only disputing the of the luminaire claim

1 language about whether the cable needed to be of the luminaire. And this is
2 just wrong, Your Honors.

3 Luminex has always maintained that the '424 Provisional describes no
4 electrical coupling between the DIP switches of the '424 Provisional and any
5 electrical cable. If you look at page 16 of our reply, I'll read this. Patent
6 Owner's response argues that the DIP switch identified in the '424
7 Provisional is the claimed switch. But nowhere does the Provisional
8 describe an "electrical cable" electrically coupled to the DIP switch. Instead,
9 the POR claims that the '424 Provisional's isolated mention of "electrical
10 wiring (not illustrated)" is the claimed "electrical cable that connects and
11 provides power to the substrate into which the pins of the disclosed switches
12 210 are inserted."

13 This argument is technically and legally wrong for several reasons. In
14 that paragraph, we never mentioned an electrical cable of the luminaire.
15 Again, the language of the luminaire only became relevant when Patent
16 Owner argued that the electrical wiring of the '424 Provisional would
17 somehow connect to the substrate, even though that's not described.

18 And further, Your Honors, if you looked at Dr. Eden's reply
19 declaration, this is Exhibit 1027 at paragraph 60. Dr. Eden said, "Further,
20 the '424 Provisional does not describe the substrate 125 as receiving power
21 via an electrical cable, and in fact, no such electrical cable is necessary to
22 power the substrate 125. As I confirmed during my deposition, a luminaire,
23 such as seasonal LED decorations, can be powered by a battery. Battery-
24 powered luminaires were well known at the time of the '424 Provisional, and
25 at least some of these battery-powered luminaires did not utilize an electrical

1 cable for powering their substrates. Rather, they received power via
2 batteries, i.e., DC power supplies, not via electrical cables."

3 Again, no mention of this of the luminaire language.

4 JUDGE AMUNDSON: This is Judge Amundson. I'm going to make
5 a couple of points on this. This is a battery-powered thing concept, it seems
6 to be a two-way street. As I understood the briefing Signify says well,
7 Chaimberg or Reiff they could have a battery-powered switch. So why isn't
8 it a two-way street here with regard to the battery-powered issue?

9 MR. NIGHTINGALE: Well, Your Honor, the battery, excuse me,
10 Judge Amundson, the battery-powered issue again is secondary. The
11 Provisional just doesn't describe the electrical wiring as connecting to the
12 substrate period. We brought up, again, we brought up the battery point in
13 response to Patent Owner's argument that somehow there's a connection,
14 even though this connection is not expressly described, and even though
15 there wouldn't necessarily, or inherently be a connection between the wiring
16 and the substrate.

17 And just to, you know, further put a bow on this point, Your Honors,
18 about why the wiring is not necessarily coupled to the substrate, if you look
19 at our slides, Slide 21, we see that Patent Owner's expert, Dr. Krames,
20 discussed DIP switches, saying yes, they're mounted on circuit boards but
21 they don't need to be powered by an electrical cable.

22 He said, in many cases there are no cables. So there's no cable to
23 connect to it.

24 JUDGE AMUNDSON: Well, this is Judge Amundson. Okay, in
25 many cases, okay, whatever he said, okay fine. But it seems to me the
26 Provisional shows in the figures a wiring aperture for the luminaire housing

1 and sets forth in words in the specifications that electrical wiring comes into
2 the luminaire. So what would be the purpose of the electrical wiring if it
3 didn't go to power things connected to the circuit board?

4 MR. NIGHTINGALE: The point is, Your Honor, we don't know.
5 The '424 Provisional doesn't tell us. It says the electrical wiring is not
6 illustrated and extends through an aperture. We simply don't know what the
7 point of that electrical wiring is. What we do know is it's a never described
8 as connecting to the substrate.

9 JUDGE AMUNDSON: Okay. I think I understand your position.
10 All right. So go ahead.

11 MR. NIGHTINGALE: I have nothing further, Your Honor.

12 JUDGE AMUNDSON: All right. It looks like the Panel has no
13 further questions so let's go back to Mr. Oliver.

14 MR. OLIVER: Thank you, Your Honor. A few points. First and
15 foremost, looking at the reply brief, the arguments that were raised by
16 Luminex are about whether the Provisional shows house wiring or the
17 wiring of a luminaire. That was the focus of their argument. It seems to
18 have changed here today, but I wanted to point to that specifically, I believe
19 it's pages 16 and 17 of the reply.

20 With respect to this issue of the battery, I would direct the Panel's
21 attention to Slide 19 of the demonstratives. The question Your Honor had
22 and we had of Luminex's own expert and asked him what would be the
23 purpose of that wiring if this wasn't being run by a battery. And as we can
24 see on Slide 19 of our demonstratives on the bottom his answer was I don't
25 know that. And I want to just take a step back again and make a point that I
26 made earlier. There has been some arguments here as to, from the other side

1 as to whether there is tension between the battery argument for the
2 Provisional versus the battery argument for Chaimberg or Halliwell or
3 anything else, as well as the question of, you know, electrical coupling
4 feature for the Provisional versus the other one.

5 We don't believe there's any tension on our side because we don't need
6 to win both. We only need to win one for the petition to fail. Petitioner
7 needs to win both of those arguments. That the Provisional doesn't have
8 support but there's enough in Halliwell or Chaimberg to meet those
9 limitations. The tension is not on our side. One or the other could be picked
10 and the argument that claim, the arguments against Claim 13 fail would
11 work in our favor.

12 That is not true of the Petitioner side. And for that reason we believe
13 that Claim 13 would survive regardless of which way the Board seems to go
14 on one or the other of these issues. Particularly whereas with respect to
15 features 13a and 13b, the analysis in the petition was purely an anticipation
16 analysis, and there's no obviousness discussion therein. For those reasons
17 we believe the Petitioner simply failed to meet its burden. And that is
18 ultimately on the Petitioner.

19 Absent any further questions I am happy to, that I'm happy to answer,
20 that's all we would have to say on these issues.

21 JUDGE AMUNDSON: This is Judge Amundson. I have no further
22 questions. Let's see if the other panel members have any questions.

23 Well, it looks like the other panel members do not have any questions.
24 So with that, our hearing today is concluded. Thank you to both parties for
25 your time and helpful presentations. The case is submitted and the hearing

1 is adjourned. But please stay on the line to see if the court reporter wants
2 assistance with any spellings. And thank you again.

3 MR. OLIVER: Thank you, Your Honor.

4 MR. NIGHTINGALE: Thank you.

5 (Whereupon, the above-entitled matter went off the record at 3:13
6 p.m.)

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