

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUMINEX INTERNATIONAL CO., LTD.
and MENARD, INC.,
*Petitioners**

v.

SIGNIFY HOLDINGS B.V.,
Patent Owner

Case IPR2024-00101

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

PETITIONER'S SUPPLEMENTAL BRIEF

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

The first and second arguments of Signify's Supplemental Brief—both relying on portions of the '141 and '062 applications not previously cited—were waived under the Board's "waiver rule." *3G Licensing v. Honeywell*, No. 23-1557, 2024 WL 5054806 at *3 (Fed. Cir. Dec. 10, 2024). The rule is simple: Patentability arguments not made in the Patent Owner Response (POR) are waived. *Id.*; Paper 15 at 10. Here, the Petition (at 18-23) identified that the '141 and '062 applications both failed to support the claims of the '336 patent. Signify's POR did not address the '141 and '062 applications, thus waiving its new arguments relying on previously uncited portions of these applications. A finding of waiver is "especially appropriate because [Signify] has the burden" of establishing an earlier priority date. *See PPC Broadband v. Times Fiber Comms.*, IPR2022-01088, Paper 42 at 65 (Dec. 20, 2023). Further, Signify's POR contained 13,984 words, 16 under the 14,000 word limit, and its new arguments amount to an improper self-help increase in the length of the POR.

Recognizing its waiver problem, Signify's third argument is that "continuity was established prior to the hearing." It was not. First, Signify's argument that the "foregoing evidence was already of record"—referring to the '141 and '062 applications—is unavailing. Signify's burden of establishing an earlier priority date is not "met simply by throwing ... evidence at the Board without explanation or identification of the relevant portions of that evidence." *Parus v. Google*, 70 F.4th 1365, 1373 (Fed. Cir. 2023). Second, the Petition did not "*establish*[]" a complete

continuity of [the '424 provisional's] disclosure.” Supp Br. at 2 (Signify's emphasis). The Petition recognized that the '141 and '062 applications share the “same disclosures” but *never* stated that the '424 provisional's disclosure is included in these later applications. The Petition's isolated remark that the '141 application “added additional disclosures” recognizes that the '141 application includes disclosure not present in the '424 provisional but does not suggest (much less establish) that all disclosures of the provisional are included in the later applications.

Finally, Signify's burden-shifting argument misunderstands *Tech. Licensing*. Signify cites this case in arguing that its POR burden was merely to respond to the arguments made in the Petition. Supp. Br. at 2. In fact, *Tech. Licensing* makes clear that after Luminex proffered evidence “that there is [invalidating] prior art,” Signify then had the burden to produce “sufficient evidence and argument to show that [the '141 and '062 applications]” contain “a written description that supports all the limitations of [claims 13, 15, and 16].” 545 F.3d 1316, 1327 (Fed. Cir. 2008). In ignoring the '141 and '062 applications in the POR, Signify failed to carry its burden. Even setting aside Signify's failures, the merits dictate that claims 13, 15, and 16 are only entitled to the June 2018 filing date of the '336 patent. Signify designated the '336 patent as a CIP, adding new matter and presenting claims directed to this new matter. Signify should not be permitted to reap the benefits of its CIP (*i.e.*, adding and claiming new matter) while avoiding its June 2018 filing date.

Dated: July 3, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on July 3, 2025, a complete and entire copy of **Petitioner's Supplemental Brief** has been served in its entirety by e-mail to Patent Owner's counsel of record:

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