

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUMINEX INTERNATIONAL CO., LTD.
and MENARD, INC.,
*Petitioners*¹

v.

SIGNIFY HOLDINGS B.V.,
Patent Owner

Case IPR2024-00101

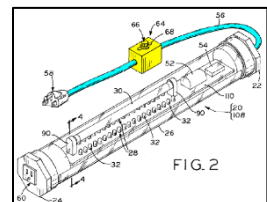
U.S. Patent No. 10,299,336

**LUMINEX INTERNATIONAL CO., LTD.’S RESPONSE TO
DELEGATION ORDER**

¹ Menard, Inc. filed a petition and a motion for joinder in IPR2024-01469 and has been joined as a petitioner in this proceeding.

In delegating Signify’s Request, which challenges the Board’s determination that claim 13 is obvious, the Director raised a single “disputed limitation,” asking as a threshold issue whether the Petition specifically argued 13b’s “at least one first coupling feature *disposed on the body*.” Order, 2-3. The answer is “yes.” Accordingly, the Reply argued within its proper scope in support of the Petition and to respond to the POR, the Board did not gap-fill the Petition, and the other issues the Director raised are easily resolved, as Luminex’s Opposition (Paper 52) shows.

The Petition sequentially addressed the elements of claim 13’s “switch for controlling a correlated color temperature (CCT) of light emitted by a luminaire.” For 13a (“a body”), the Petition identified Reiff’s “control box 64 ... includ[ing] switch 66”; “control box 64 ... provides and necessarily includes a body for the switch.” Pet., 84-87 (annotated Reiff’s Fig. 2 as shown to the right); EX1013, 4:28-36. For 13b, the Petition, in pictures and

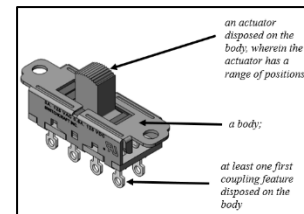


words and relying on expert testimony, showed coupling features “*disposed on the body*” of the switch because Reiff’s “control box 64 (with switch 66)” necessarily includes “input and output terminals,” e.g., “pins[]” or other “connectors,” for electrically coupling the control box switch to cord 56, without which Reiff’s light fixture would lack electrical continuity and not function. Pet., 86-87; EX1004, ¶¶343-45. Regardless whether this passage expressly recited “disposed on the body” (the Board understood that is not required), it argued the limitation, including relying

on Dr. Eden’s opinion that this shows “disposed on the body.” EX1004, ¶¶344-45; *see Sage Prods., LLC v. Stewart*, 133 F.4th 1376, 1384-85 (Fed. Cir. 2025).

To the extent the Director took Signify or the Board to have suggested the Petition failed to address “disposed on the body,” that would be incorrect. Throughout the IPR, Signify never made such argument. Instead, it advanced merits arguments aimed at rebutting the Petition, reinforcing that the Petition argued “disposed on the body.” For example, Signify argued that “Reiff does not disclose a ‘coupling feature disposed on the body,’” speculating that Reiff’s switch could be wireless and hence lack a “coupling feature.” POR, 40-42. These responded to the Petition’s showing of coupling features disposed on the switch body. *See* POR, 41 (recognizing these arguments in “the Petition”); Sur-Reply, 12 (similar); EX2031,

¶¶143-44 (similar). Accordingly, when the Reply (27-28) cited evidence, such as the depiction to the right here, showing how such coupling features are disposed on the bodies of slide



switches like Reiff’s, its showings were “proper”; they “simply expand[ed] on previously raised arguments” in the Petition regarding “disposed on the body,” and directly responded to Signify’s contrary arguments. *Rembrandt Diagnostics, LP v. Alere, Inc.*, 76 F.4th 1376, 1384 (Fed. Cir. 2023).

Likewise, while the Board took issue with whether Reiff expressly teaches 13b for § 102 purposes (based on the Board’s apparent view that because no

coupling features are depicted on the exterior of control box 64, any such coupling features in Reiff would be disposed “in” and not “on” the body), it consistently understood the Petition argued “sufficiently for § 103 that Reiff teaches or suggests limitation 13b.” DI, 61; FWD, 149. Moreover, the in-versus-on misunderstanding was exacerbated by Signify’s misrepresentations that the Petition used only “the outer surfaces of control box 64” for the “body,” and that Dr. Eden “conceded that the control box is not a switch body.” POR, 39-41. The Petition and Dr. Eden made no mention of “outer surfaces,” and instead identified “***the control box 64 including the switch [66]***” for 13b. Pet., 85; EX1004, ¶¶337-342; EX2030, 140:5-8; Reply 28-29. The lack of coupling features on control box 64’s outer surfaces is irrelevant because the claimed “body” is the switch body included within control box 64, and the Petition showed that any coupling features, even if enclosed within control box 64, are still disposed “***on the body***” of the switch. Indeed, “all slide switches include ‘a body’ with ‘at least one first coupling feature.’” FWD, 149. (Signify itself argues a switch body “is the entirety of the body (including its contents)” and “‘disposed on the body’ means disposed on any part or portion of the body, whether that be an outer or interior surface,” rendering any in-versus-on distinction immaterial. *Signify N. Am. Corp. v. Menard, Inc.*, No. 3:22-cv-00706-jdp (W.D. Wis.), Dkt. 321, 59.)

Thus, as explained here and in Luminex’s Opposition, claim 13’s obviousness should be upheld, whether through denial of Director Review or on the merits.

Dated: January 6, 2026

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a complete and entire copy of **LUMINEX INTERNATIONAL CO., LTD.’S RESPONSE TO DELEGATION ORDER** has been served in its entirety by e-mail to Patent Owner’s counsel of record and Petitioner Menard’s counsel of record:

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