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90/015,328	11/17/2023	8124988	GBSZZD001-EPR	5465
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BACON & THOMAS, PLLC			EXAMINER	
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Alexandria, VA 22314			ART UNIT	PAPER NUMBER
			3992	
			MAIL DATE	DELIVERY MODE
			02/15/2024	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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***EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/015,328 .

PATENT UNDER REEXAMINATION 8124988 .

ART UNIT 3992 .

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Order Granting Request For Ex Parte Reexamination	Control No. 90/015,328	Patent Under Reexamination 8124988	
	Examiner DEANDRA M HUGHES	Art Unit 3992	AIA (FITF) Status No

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 11/17/2023 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) ☐ PTO-892, b) ☒ PTO/SB/08, c) ☐ Other: _____

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

/DEANDRA M HUGHES/ Reexamination Specialist, Art Unit 399	/CHRISTINA Y. LEUNG/ Primary Examiner, Art Unit 3991	/MICHAEL FUELLING/ Supervisory Patent Examiner, AU3992
cc:Requester (if third party requester)		

ORDER GRANTING REQUEST FOR *EX PARTE* REEXAMINATION***Acknowledgements***

1. This is an order granting *Ex Parte* Reexamination of claims 1-24 of U.S. Patent No. 8,124,988, (“’988 Patent”) issued Feb. 28, 2012 and filed on May 28, 2008 as U.S. application No. 12/153,910 (“’910 Application”), titled “LIGHT EMITTING DIODE LAMP PACKAGE STRUCTURE AND ASSEMBLY THEREOF.”
2. Examiners do not find the litigation involving the ‘988 Patent.
3. Examiners do not find any previous and/or co-pending *Ex parte* reexaminations or supplemental examinations for the ‘988 Patent.
4. Examiners find post grant challenge *Inter Partes* Review IPR2024-00157 filed after the filing of the instant *ex parte* reexamination request.

Evidence Considered

5. The following is the evidence considered in this order:
 - CN Patent 201017882Y to Lai published February 6, 2008 (“Lai”)
 - US PG PUB 2005/0012457 to Wu published January 20, 2005 (“Wu”)
 - US Patent 7,168,862 B2 to Qi et al. published January 30, 2007 (“Qi”)
 - US Patent 7,276,739 B2 to Chen et al. published October 2, 2007 (“Chen”)
 - US Patent 6,994,455 B2 to Okabe published February 7, 2006 (“Okabe”)
 - US Patent 6,123,433 to Chen published September 26, 2000 (“Chen”)
 - US Patent 6,726,502 B1 to Hayes published April 27, 2004 (“Hayes”)
 - CN Patent 2560827Y to Yin published July 16, 2003 (“Yin”)
 - US Patent 6,858,870 B2 to Lee published February 22, 2005 (“Lee”)
 - CN Patent 1731907A to Shang published February 8, 2006 (“Shang-907”)
 - CN Patent 1725924A to Shang published January 25, 2006 (“Shang-924”)

Proposed Substantial New Questions of Patentability (“SNQs”)

6. The following SNQs are alleged to present an SNQ as to claims 1-24:

- (1) Claims 1-3, 5-12, and 23-24 are alleged to be anticipated by CN Patent 201017882Y published February 6, 2008 (“Lai”) (see Request pgs. 3-13);
- (2) Claim 4 is alleged to be obvious over Lai in view of US PG PUB 2005/0012457 published January 20, 2005 (“Wu”) (see Request pgs. 13-14);
- (3) Claim 13 is alleged to be obvious over the combination of Lai in view of US Patent 7,168,862 published January 30, 2007 (“Qi”) (see Request pgs. 14-15);
- (4) Claim 15 is alleged to be obvious over the combination of Lai and US Patent 6,994,455 published February 7, 2006 (“Okabe”) (see Request pgs. 15-16);
- (5) Claims 16-17 and 19-22 are alleged to be obvious over the combination of Lai and US Patent 6,123,433 published September 26, 2000 (“Chen”) and further in view of Yin (see Request pgs. 16-24);
- (6) Claim 18 is alleged to be obvious over the combination of Lai, Chen, and Yin and US Patent 6,858,870 published February 22, 2005 (“Lee”) (see Request 25);
- (7) Claim 18 is alleged to be obvious over the combination of Lai, Chen, and Yin and US Patent 6,726,502 published April 27, 2004 (“Hayes”) (see Request 25);
- (8) Claims 1-2, 6-12, and 23-24 are alleged to be obvious over the combination of CN 1731907A published February 8, 2006 (“Shang907”) and CN 1725924 published January 25, 2006 (“Shang924”) (see Request pgs. 26-36);
- (9) Claims 3 and 5 are alleged to be obvious over the combination of Shang907 in view of Shang 924 and Yin (see Request pgs. 36-37);

Priority

7. Because Examiners do not find a claim of priority under 35 U.S.C. §120 or 35 U.S.C. §119(e), the effective filing date of the ‘988 Patent is the filing date of the ‘910 Application, which is **May 28, 2008**.

Basis of the Substantial New Question of Patentability

8. Under MPEP §2242, for a substantial new question (“SNQ”) of patentability to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in an earlier concluded examination or review of the patent, raised to or by the Office in a pending reexamination or supplemental examination of the patent, or decided in a final holding of invalidity (after all appeals) by a federal court in a decision on the merits involving the claim.

Relevant Prosecution History

9. On May 28, 2008, claims 1-24 were presented for examination and claims 5, 7, 8, 13, 14, and 16-24 were subsequently withdrawn from examination as being directed to a non-elected species.

10. Over two non-final rejections mailed April 28, 2010 and February 16, 2011, claims 1-4, 6, 9-12, and 15 were rejected over:

- US PG PUB 2008/0087903 to Stoyan;
- USP 7,473,933 to Yan; and
- USP 7,717,596 to Bell.

11. Applicant filed an Appeal Brief on September 19, 2011 arguing the prior art did not disclose or make obvious the following:

- (1) each light emitting diode (“LED”) having two electrode ends, wherein one of the electrode ends is a common electrode;

- (2) a 1st conductor as a positive DC voltage pad, wherein the 1st conductor is connected to a common electrode of each LED and a positive power-in electrode of a control integrated circuit;
- (3) a 3rd conductor connected to a data output electrode; and
- (4) a data output electrode.

12. In response to the Appeal Brief, claims 1-4, 6, 9-12, and 15 were allowed and claims 5, 7, 8, 13, 14, and 16-24 were rejoined and allowed. The statement of the reasons for allowance was merely a recitation of claim 1 in its entirety. As such, the Examiner's statement of the reasons for allowance did not give any indication as to which limitations of the claims placed them in condition for allowance. Nevertheless, the allowance of the claims in response to the filing of the Appeal Brief indicates that Applicant's arguments were persuasive.

--The teachings that form the basis of the SNQ--

13. Based on the prosecution history of the '988 Patent, Examiners consider the following teachings of a LED light package to form the basis of the SNQ:

- (1) a LED light package where each light emitting diode has two electrode ends
 - wherein one of the electrode ends is a common electrode;
- (2) a LED light package where a 1st conductor is a positive DC voltage pad
 - wherein the 1st conductor is connected to a common electrode of each LED and a positive power-in electrode of a control integrated circuit;
- (3) a LED light package having a 3rd conductor connected to a data output electrode.¹

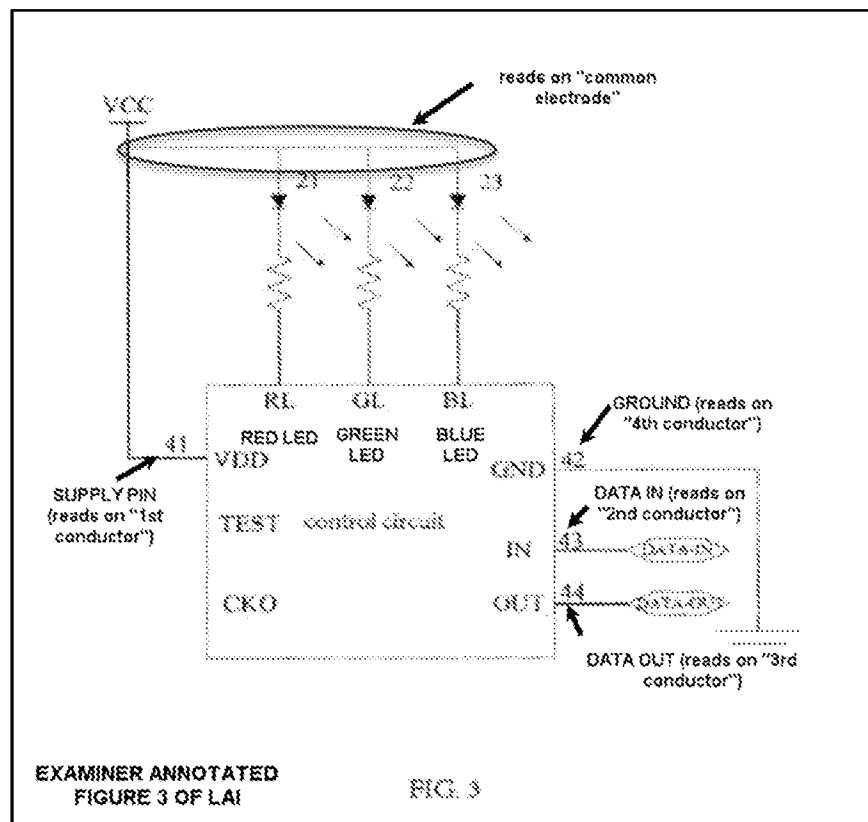
¹ The Appeal Brief argued that the prior art did not disclose or make obvious a data output electrode nor a 3rd conductor connected to a data output electrode. Because a teaching of a 3rd conductor connected to a data output electrode necessarily requires a data output electrode, Examiners consider a teaching of a 3rd conductor connected to a data output electrode sufficient to form this part of the basis of the SNQ.

These teachings of the (prior art) patents and printed publications would be considered “new” if the same question of patentability as to the claims has not been decided by the Office in the ‘910 Application. In this proceeding, all cited (prior art) patents and printed publications are “new” because they were not applied or discussed in the prosecution of the ‘130 Application.

ORDER FOR EX PARTE REEXAMINATION

--SNQs (1)-(7) over Lai alone or in combination--

14. Examiners agree that the teachings of Lai, alone or in combination, forms the basis of the SNQ. Lai was published February 6, 2008, which is before the presumed effective filing date of the ‘988 Patent (i.e., May 28, 2008). And, Lai was not cited in the prosecution of the ‘910 Application. Thus, it is ‘new’ prior art.



Lai reasonably teaches a LED light package because in the statement of the technical field, Lai states that the field “relates to a kind of encapsulating structure of LED lamp.”

Lai reasonably teaches a LED light package where each light emitting diode has two electrode ends, wherein one of the electrode ends is a common electrode because, as shown in the Examiner annotated figure 3 of Lai, each LED (i.e., red LED marked “RL,” green LED marked “GL,” and blue LED marked “BL”) has two electrode ends wherein one of the electrode ends is a common electrode, as shown by the Examiner drawn oval.

Lai reasonably teaches a LED light package where a 1st conductor is a positive DC voltage pad wherein the 1st conductor is connected to a common electrode of each LED and a positive power-in electrode of a control integrated circuit because the supply pin (i.e., “1st conductor”) is connected to the control circuit at VDD and the supply pin (i.e., “1st conductor”) is connected to the common electrode as indicated by the Examiner drawn oval.

Lai reasonably teaches a LED light package having a 3rd conductor connected to a data output electrode because, as shown in the Examiner annotated figure above, DATA OUT (#44) reads on the claimed “3rd conductor.”

Thus, for the above reasons, Lai forms the basis of the SNQ.

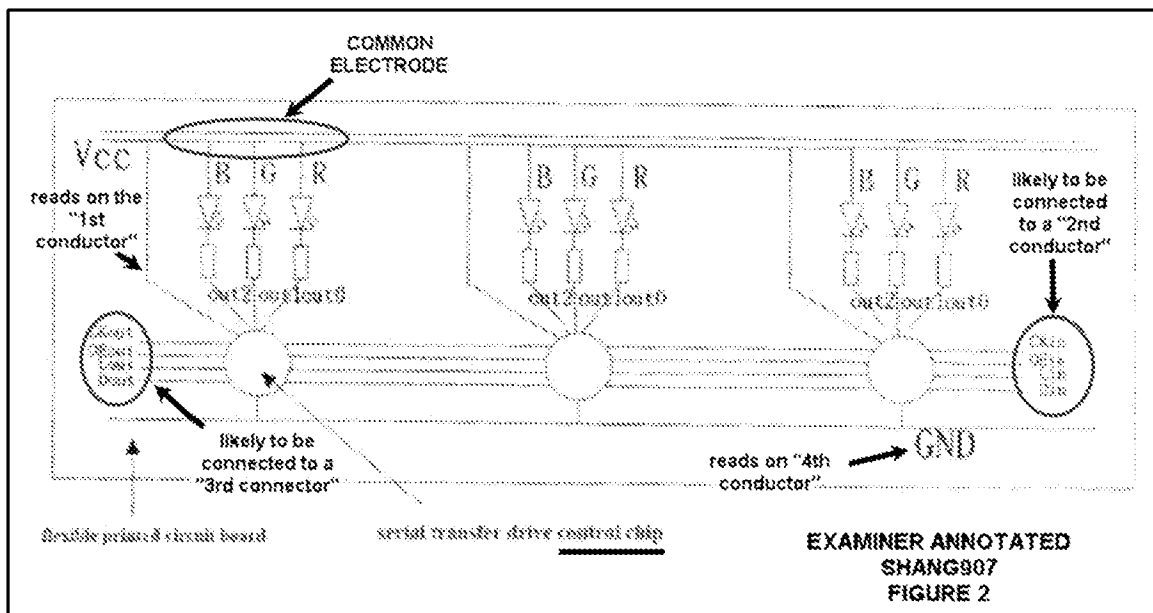
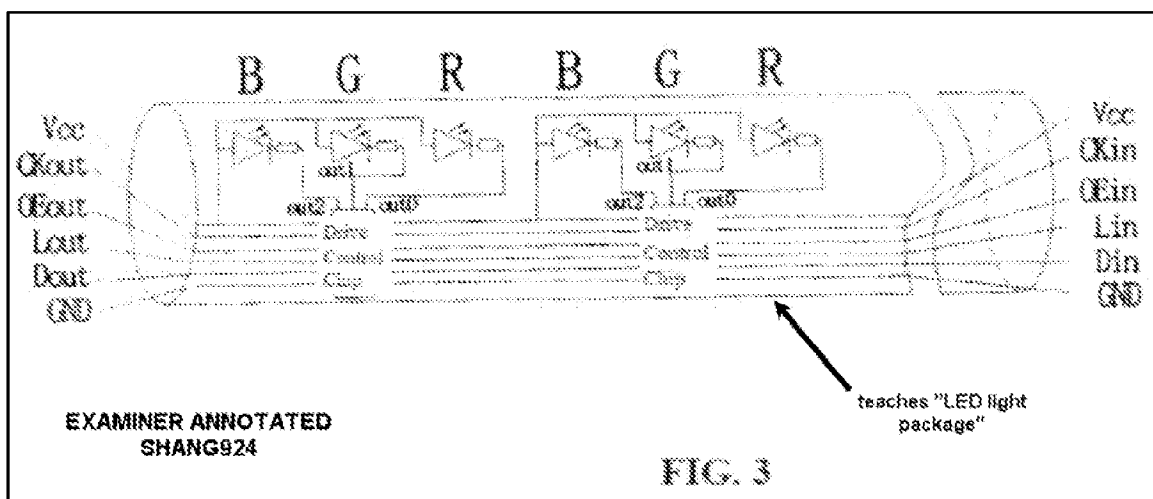
--SNQs (8)-(9) over the combination of Shang907 and Shang 924 alone or in combination with Yin--

15. Examiners agree that the teachings of the combination of Shang907 and Shang924 forms the basis of the SNQ. Shang907 was published February 8, 2006 and

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Shang924 was published January 25, 2006, which is before the presumed effective filing date of the '988 Patent (i.e., May 28, 2008). And, neither Shang907 nor Shang924 were cited in the prosecution of the '910 Application. Thus, both Shang907 and Shang924 are 'new' prior art.

While Shang907 does not specifically teach a LED light package, Shang924 reasonably teaches a LED light package as shown by the cylindrical body encapsulating the LED lamp string of Shang924 figure 2 (see Shang924 figure 3).



Also, the combination of Shang907 and Shang924 reasonably teaches a LED light package where each light emitting diode has two electrode ends, wherein one of the electrode ends is a common electrode because Shang907 reasonably teaches blue (B), green (G), and red (R) LEDs have two electrode ends with one end connected to a common electrode, as annotated by the Examiner in Shang907 figure 2.

Also, the combination of Shang907 and Shang924 reasonably teaches a LED light package where a 1st conductor is a positive DC voltage pad wherein the 1st conductor is connected to a common electrode of each LED and a positive power-in electrode of a control integrated circuit because the conductor from Vcc to the control chip reasonably teaches the 1st conductor. Moreover, the connection from Vcc to the control chip reasonably teaches a positive DC voltage and the connection from Vcc to the control chip reasonably teaches a positive power-in because the Vcc reasonably teaches a positive DC voltage. Further, the conductor from Vcc to control chip is connected to the common electrode.

Also, the combination of Shang907 and Shang924 reasonably teaches a LED light package having a 3rd conductor connected to a data output electrode because the CKout, OEout, Lout, and Dout reasonably teaches a data output electrode and it is well known to connect an electrode to a conductor, which is likely to read on the “3rd conductor.”

Thus, for the above reasons, the combination of Shang907 and Shang924 forms the basis of the SNQ.

35 U.S.C. 325(d)

16. 35 USC 325(d) states in part that “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”. Thus, in order for the Director to exercise discretion as to whether to Order a reexamination proceeding under chapter, 30, the request must first be determined to be based on the same or substantially the same prior art or arguments that previously were presented to the Office.

A review of the post grant history of the ‘988 patent indicates that the patent is the subject of a single Office post grant challenge filed after the filing of the instant *ex parte* reexamination request (90/015,328).

On November 8, 2023 (after the filing of this *ex parte* reexamination request), Petitioner Xu Peicheng (Hong Kong) Optoelectronic Technology Co., Limited, filed a petition (IPR2024-00157) for *inter partes* review of claims 1-17 and 20-21 of the ‘988 patent which asserted the following grounds as raising a reasonable likelihood in prevailing (RLP):

RLP Ground	Claims	Basis	References
#1	1-3, 5-10, and 13-14	35 USC 103(a)	Lai and general knowledge of a POSITA
#2	4 and 11-12	35 USC 103(a)	Lai, Stoyan, and general knowledge of a POSITA
#3	1-3, 5-6, 9-10, 13, 16-17, and 20-21	35 USC 103(a)	Morgan and general knowledge of a POSITA
#4	4 and 11-12	35 USC 103(a)	Morgan and Stoyan and general knowledge of a POSITA

#5	16	35 USC 103(a)	Allsop and general knowledge of a POSITA
#6	15	35 USC 103(a)	Lai and Yan
#7	15	35 USC 103(a)	Morgan and Yan

As of the mailing date of this Order, there has been no decision on institution of the petition, issued by the Patent Trial and Appeal Board (PTAB).

A comparison between the prior art and arguments presented in the instant reexamination request and the later filed IPR petition indicates that at least two (2) grounds (i.e., SNQ Ground #1 and SNQ Ground #4) presented in the reexam request is based on substantially the same prior art that was presented in the IPR petition.

SNQ Ground	Claims	Basis	References
#1	1-3, 5-12, and 23-24	35 USC 102	Lai
#2	4	35 USC 103(a)	Lai and Wu
#3	13	35 USC 103(a)	Lai and Qi
#4	15	35 USC 103(a)	Lai and Okabe
#5	16-17 and 19-22	35 USC 103(a)	Lai, Chen, and Yin
#6	18	35 USC 103(a)	Lai, Chen, Yin, and Lee
#7	18	35 USC 103(a)	Lai, Chen, Yin, and Hayes
#8	1-2, 6-12, and 23-24	35 USC 103(a)	Shang907 and Shang924
#9	3 and 5	35 USC 103(a)	Shang907, Shang924, and Yin

SNQ Ground #1 is substantially the same as that presented in the later filed IPR petition for RLP Ground #1 with the difference being that RLP Ground #1 bolsters the teachings disclosed in Lai with that of the general knowledge of a POSITA. In other words, SNQ ground #1 alleges Lai anticipates the claims whereas RLP Ground #1 alleges Lai makes obvious the claims wherein the limitations anticipated by Lai are bolstered via the general knowledge of a POSITA. For example, while SNQ Ground #1 alleges figure 3 of Lai teaches a control integrated circuit with a data input electrode

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(#43), a data output electrode (#44), a positive power-in electrode (VDD #41), and a negative power-in electrode (GND #42), RLP Ground #1 bolsters these teachings that are found to anticipate the claim limitations by alleging that this disclosure by Lai is also understood by POSITA.

Moreover, RLP Ground #1 bolsters SNQ Ground #1's allegation that the VDD power supply pin acts as a positive DC voltage pad because "VDD" represents a positive DC voltage with an allegation with an allegation that POSITA would understand it as such. Further, RLP Ground #1 bolsters SNQ Ground #1's allegation that Lai's VDD DC voltage pad is a "pad" because POSITA would understand it as such.

Further, SNQ Ground #4 is substantially the same as that presented in RLP Ground #6. Specifically, SNQ Ground #4 alleges claim 15 is obvious over the combination of Lai and Okabe whereas RLP Ground #6 alleges that claim 15 is obvious over the combination of Lai and Yan. Because both Okabe and Yan are presented in SNQ Ground #4 and RLP Ground #6, respectively, for the same teaching (i.e., a package body in rectangular shape, said rectangle having a light emitting window, the LEDs aligning with the light emitting window inside the rectangle), SNQ Ground #4 and RLP Ground #6 are substantially the same.

However, because the request for reexam was filed before the petition for IPR, the prior art and arguments were not "previously" presented to the Office relative to the art and arguments presented in the reexamination request, and thus the threshold under 325(d) for the Director to exercise discretion to reject the request is not met.

Moreover, even if the 325(d) threshold was met, the Director would decline to exercise such discretion to reject the instant reexamination request in view of the following facts:

- 1.) There is no evidence that petitioner and third-party requester are the same real party-in-interest because the petitioner is *Xu Peicheng (Hong Kong) Optoelectronic Technology Co., Limited* and the third-party requester ("3PR") is *Brightek Optoelectronics Co., Ltd.*
- 2.) The PTAB has yet to make any decision on institution with respect the prior art prior art presented in the pending IPR petition.
- 3.) There has been no finding of serial abusive Office challenges to the '988 patent.
- 4.) While the instant reexamination request presents substantially similar assertions of unpatentability of claims 1-3, 5-10, and 13-15 because of the substantial similarity of SNQ Ground #1 with RLP Ground #1 and SNQ Ground #4 with RLP Ground #6; 3PR presents SNQ Ground #8 and SNQ Ground #9, which allege a wholly distinct grounds of unpatentability over Shang 907 and Shang 924, which Examiners find forms the basis of the SNQ.

In view of these facts, to the extent the threshold for exercising discretion under 325(d) is met, the Director declines to exercise discretion to reject this request.

Accordingly, *ex parte* reexamination is ordered in view of the determination that the request raises a substantial new question of patentability to the claims of the '988 patent.

Order

17. Because Examiners consider the new teachings of Lai, alone or in combination and the combination of Shang907 and Shang924, alone or in combination with Yin, to be important in deciding whether the '988 Patent claims are patentable and there is no basis to reject the request under 35 USC §325(d), *Ex Parte* Reexamination of claim 1 is

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ordered. Moreover, *Ex Parte* Reexamination of dependent claims 2-24 are likewise ordered because of their dependency upon independent claim 1. Thus, all claims requested for *Ex Parte* Reexamination, i.e., claims 1-24 is ORDERED.

Conclusion

18. The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving **Patent No. 8,124,988** throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extension of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

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19. All correspondence relating to this *ex parte* reexamination proceeding should be directed as follows:

By U.S. Postal Service Mail to:
Mail Stop *Ex Parte* Reexam
ATTN: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to:
(571) 273-9900
Central Reexamination Unit

Signed:

/DEANDRA M HUGHES/
Reexamination Specialist, Art Unit 3992

Conferees:

/CHRISTINA Y. LEUNG/
Primary Examiner, Art Unit 3991

/MICHAEL FUELLING/
Supervisory Patent Examiner, Art Unit 3992