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May 20, 2022

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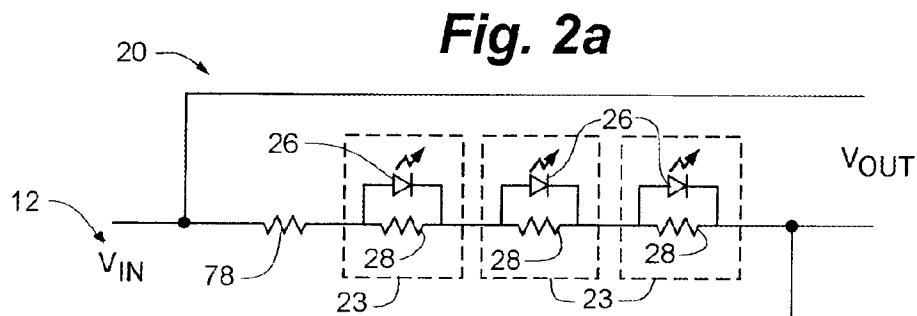
Re: Seasonal Specialties U.S. Patent No. 11,096,252 - Costco
Your Reference: 40617.0576USAA
Our Reference: 157691-00102

Dear Mr. Lasky:

We represent Inliten LLC in intellectual property matters.

We are responding (on behalf of Inliten and Costco) to your letter of May 2, 2022, charging Costco with infringement of U.S. Patent No. 11,096,252 (Seasonal Specialties), based on sales of two light strings supplied to Costco by Inliten. As explained below, U.S. Patent No. 11,096,252 is invalid, and your charge of infringement is therefore unfounded.

U.S. Patent No. 11,096,252 issued from a series of continuation applications, and claims a resistor bypass circuit for a series LED light string in which a bypass resistor 28 is connected in parallel with each LED light 26 to allow current to continue to flow in remaining LEDs if one of the LEDs is burnt out, defective or has a loose connection.



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During prosecution of the application for U.S. Patent No. 11,096,252, the Examiner rejected the claims (which, as filed, recited a light string with resistive shunts) as anticipated by U.S. Patent No. 5,886,423 (Gershen). In response to the rejection, the claims were amended to recite “the bypass resistor being in circuit and conducting current at all times when current is flowing in the circuit, regardless of whether LED light sources are conducting current therethrough.” You argued that Gershen does not disclose bypass resistors which continuously conduct current, but instead discloses breakdown shunts (SCRs 34), which only conduct when the voltage across the shunt exceeds the breakdown voltage. The Examiner accepted this distinction, allowed the claims, and the patent issued as U.S. Patent No. 11,096,252.

The Examiner erred in allowing U.S. Patent No. 11,096,252 to issue because he did not realize that the broad subject matter recited in the claims, i.e., a light string circuit with resistive shunts, is in the prior art and thus unpatentable, as shown, for example, in prior art U.S. Patent No. 7,963,670 (Yu) and U.S. Patent No. 6,283,797 (Wu).

Yu discloses an LED light string with a resistive bypass shunt 318:

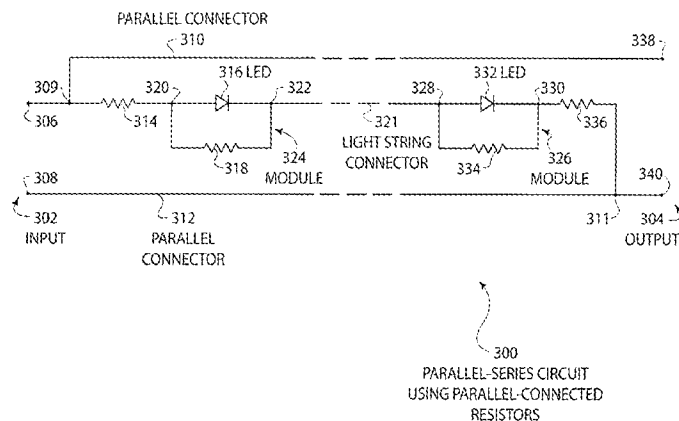


FIG. 3

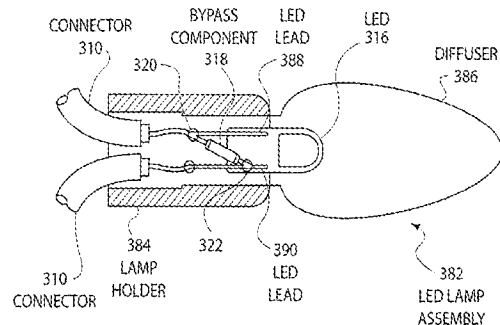


FIG. 4

The USPTO file history reveals that you were aware of Yu (which was buried in an IDS listing 44 prior art patent documents) and attempted to eliminate Yu as prior art by filing an unsolicited Rule 131 declaration swearing behind the July 31, 2006 filing date of Yu – notably, without alerting the Examiner that Yu was the prior art at issue. However, the declaration is deficient in that: (1) Attachment A, referenced in the declaration as allegedly establishing a date of conception of January 12, 2006, was not attached to the declaration; and, in any event (2) the declaration does not establish diligence for the period between the filing date of Yu (July 31, 2006) and the constructive reduction to practice (the filing of the provisional application on Dec. 22, 2006) – indeed, there is a considerable unexplained period void of activity between June 2006 and December 2006, which is fatal to the declaration.

Wu discloses a lamp base for a series light string, with a resistive shunt 5:

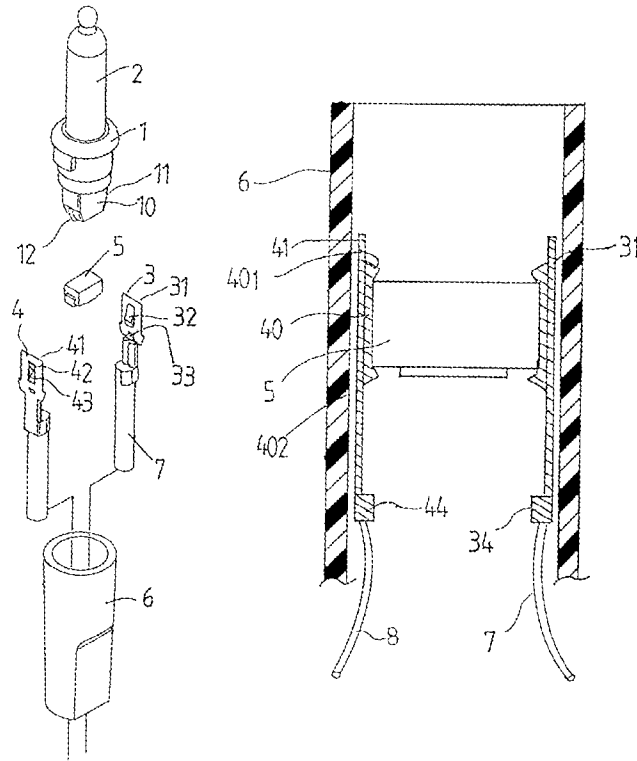


FIG 2

FIG 5

As stated in Wu, col. 2, lines 17-22:

When the lamp series are turned on, the current will flow from wires 7, 8 to connection plug 3, 4 and the conductive sheets 11, 12 under the lamp socket 1 to light on the lamp in the lamp base of the lamp series. If the lamp 2 is burnt out or loose, the resistor sheet 5 will become short to make the lamp in other lamp base units light as the same.

Wu is 102(b) prior art and cannot be overcome by a Rule 131 declaration.

Both Yu and Wu clearly disclose the fundamental feature of the claimed subject matter – i.e., a resistor bypass circuit for a series lighting circuit comprising a plurality of serially connected light sources, and a bypass resistor connected in parallel with at least one of the respective light sources – subject matter that Seasonal Specialties had previously sought to patent in the parent patent applications, but had been denied.

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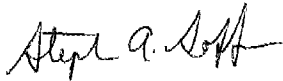
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For the reasons set forth above, we have advised Costco that U.S. Patent No. 11,096,252 is invalid and that your charge of infringement is unfounded.

We trust that you will not pursue this matter further with Costco, and will refrain from interfering with Inliten's customer relations by attempting to enforce the patent against other Inliten customers.

Very truly yours,



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