

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAVANT TECHNOLOGIES LLC d/b/a GE LIGHTING,
and LEDVANCE LLC

Petitioners,

v.

FEIT ELECTRIC COMPANY, INC.,
Patent Owner.

IPR2024-01357
Patent 8,604,678

SAVANT TECHNOLOGIES LLC d/b/a GE LIGHTING,
ELONG INTERNATIONAL USA INC., and
XIAMEN LONGSTAR LIGHTING CO. LTD.

Petitioners,

v.

FEIT ELECTRIC COMPANY, INC.,
Patent Owner.

IPR2025-00260
Patent 8,604,678

**PETITIONERS' OPPOSITION TO PO's MOTION TO TERMINATE FOR
ALLEGEDLY INCONSISTENT CLAIM CONSTRUCTION POSITIONS**

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I. INTRODUCTION

Consistent with the Director’s reasoning in *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 at 3-4 (PTAB Nov. 5, 2025) (informative) and the Federal Circuit’s guidance, Patent Owner’s motion should be denied because there is no dispute (in Patent Owner’s Response or in any other paper filed after institution) that the prior art discloses the “improved off state white appearance” limitation. There was no reason for Petitioners to flag in their petition that they may argue for indefiniteness in the district court because it was not (and is not) necessary to construe the “improves off state white appearance” term in order determine patentability. Moreover, Patent Owner – who only began seeking termination months after the Director’s first *Revvo* decision and after the Board issued its preliminary guidance rejecting the proposed amended claims – unreasonably delayed in bringing this motion. Finally, Petitioners’ stipulation to be bound by the Board’s claim construction determinations, including any rejection of indefiniteness, resolves any chance of duplication of effort, additional expense for the parties, or risk of inconsistent decisions arising from the district court cases (all of which have been stayed pending the outcome of these proceedings or dismissed). For these reasons, and those set forth herein, the motion should be denied.

II. ARGUMENT

A. The Motion to Terminate Should Be Denied Consistent with the Federal Circuit’s *Intel* Decision and the Director’s *Tesla* Decision Because There is No Dispute That the Prior Art Satisfies the “Improves Off State White Appearance” Limitation

Patent Owner’s motion should be denied because there is no dispute that the prior art discloses the “improves off state white appearance” limitation. The Board’s rules “do not necessarily prohibit petitioners from taking inconsistent claim construction positions before the Board and a district court.” *Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper 12 at 8–9 (PTAB Dec. 13, 2024). “[W]hen a petitioner takes alternative [claim construction] positions before the Board and a district court, that petitioner should, at a minimum, explain why alternative positions are warranted.” *Revvo Techs., Inc. v. Tire Stickers LLC*, IPR202500631, Paper 34 at 2-3 (Director Feb. 3, 2026). For example, inconsistent positions may be warranted when the art specifically discloses each limitation notwithstanding the indefiniteness. *See, e.g., Tesla*, IPR2025-00340, Paper 18 at 3-4 (informative) (“Petitioner’s explanation may have risen to a sufficient level [if], for example, Petitioner had shown that, notwithstanding the alleged indefiniteness of the claim term, an ordinarily skilled artisan would understand that the asserted art satisfies the claim limitation....”).

The Director’s reasoning in *Tesla* is not surprising given the Federal

Circuit’s repeated guidance that “only those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.” *See, e.g., Vivid Techs., Inc. v. Am. Sci. & Eng’g., Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). The Director’s reasoning is likewise consistent with *Intel Corp. v. Qualcomm Inc.*, 21 F.4th 801 (Fed. Cir. 2021), in which the Federal Circuit vacated a Board decision finding that Petitioner failed to show that certain challenged claims were invalid as obvious because Petitioner did not “show structure corresponding to the claimed function” so that the Board “can compare the prior art’s disclosure” to the challenged claim. *Id.* at 807, 813. Specifically, the panel instructed the Board on remand to determine “whether it can resolve the prior-art challenge to the patentability of [the challenged claims] despite the potential indefiniteness” in the claim. *Id.* at 814. As the panel reasoned:

The Board simply accepted Intel’s concession that the required structure for the means-plus-function claim was missing. The Board did not itself conclude that the prior-art analysis task was impossible, and it could not so conclude here without determining for itself that such structure was missing, a legal question that is part of claim construction. Nor did the Board decide whether it could resolve the patentability dispute even if claim 16 is indefinite.

Id. at 813. *See also Samsung Elecs. Am., Inc. v. Prisia Eng’g Corp.*, 948 F.3d 1342, 1355 (Fed. Cir. 2020) (vacating Board decision and stating that “[o]n remand, the Board should address [petitioner’s] argument that the Board may analyze the patentability of a claim even if that claim is indefinite”).

This is precisely the type of case where Petitioners' alternative indefiniteness position is justified. There is no dispute that the prior art satisfies the "improves off state white appearance" limitation. For example, Basin-2007's title is "LED with Particles in Encapsulant for Increased Light Extraction and Non-Yellow Off-State Color." EX1005. In granting institution, the Board agreed that, on the current record, Petitioners demonstrated a reasonable likelihood that the claim was not patentable. Paper 17 at 25. Patent Owner does not argue in any of its papers that this limitation is not satisfied. While it made such arguments in its Patent Owner Preliminary Response (*see, e.g.*, Paper 15 at 15, 17, 19, 22, 24, 26), Patent Owner made no such arguments in its papers after institution. Accordingly, any belatedly raised argument disputing that the prior art discloses an "improved off state white appearance" is waived. *See* Paper 19 (Scheduling Order) at 9.

Petitioners argued in the district court that the phrase "improves off state white appearance" was indefinite because a person skilled in the art would not know the bounds of this term of degree. *See, e.g.*, EX1044. Patent Owner, supported by expert testimony, disagreed. One district court already agreed with Patent Owner, finding the phrase "improves an off state white appearance" not indefinite and giving the phrase its plain and ordinary meaning. EX1044 at 9-10. The Board independently reached the same conclusion at institution. Paper 17 at 18-25. Patent Owner's expert in this proceeding agreed that the terms require no

construction beyond their plain and ordinary meaning. EX2026 ¶ 39. Petitioners' position is therefore justified for this additional reason. *See Apple Inc. v. Theta IP, LLC*, IPR2024-00819, Paper 32, at 12-13 (PTAB Nov. 25, 2025) (analyzing petitioner's inconsistent positions under *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 at 3–5 (Director Nov. 3, 2025) and holding that petitioner was justified in advancing broader plain and ordinary meaning definition in IPR and narrower position in district court).

Under 37 C.F.R. § 42.104(b)(3), the petition must identify “[h]ow the challenged claim is to be construed.” The Director’s recent decisions require petitioners to disclose and explain any cross-forum positions taken on that question, and that obligation is typically assessed at the time of filing. *See, e.g., Am. Airlines, Inc., et al. v. Intellectual Ventures I LLC*, IPR2025-01055, Paper 11 at 13 (PTAB Nov. 21, 2025). The IPR2024-01357 Petition was filed August 26, 2024; the IPR2025-00260 Petition was filed December 9, 2024. The first district court claim construction brief was not filed until January 2025. So there was nothing to disclose in either Petition. Unlike the petitioner in *Am. Airlines*, who was ‘silent’ about how to construe limitations it alleged were indefinite (IPR2025-01055, Paper 11 at 13), Petitioners here affirmatively stated no construction was needed because the art unambiguously disclosed the “improve off-state white appearance” limitation despite the indefiniteness.

Petitioners further note that there was no need to raise indefiniteness at the petition stage given the Federal Circuit’s guidance to only construe claims when necessary to resolve a dispute. *See, e.g., Vivid Techs.*, 200 F.3d at 803. Moreover, Petitioners should not be penalized for not raising the fact that either one may argue indefiniteness in the district in its petition because the petitions were filed long before the decision in *Revvo*. Every case Patent Owner cites involved a petitioner that either refused to explain or could not explain genuinely inconsistent claim construction positions. In *Revvo*, the petitioner took contradictory constructions without explanation. Paper 20 at 4-5. In *Tesla*, the petitioner offered only a structural excuse—that indefiniteness “cannot” be raised in IPR—not a substantive explanation for why the positions were compatible. IPR2025-00340, Paper 18 at 3-4 (informative). *Orca Sec. Ltd., v. Wiz Inc.* and *TikTok Inc., v. ShopSee, Inc.* followed the same pattern. IPR2025-01086, Paper 13 (PTAB Dec. 15, 2025); IPR2025-01485, Paper 13 at 2-3 (PTAB Jan. 16, 2025). In *Am. Airlines*, the petitioner failed to address its construction positions at all. IPR2025-01055, Paper 11. None of those petitioners explained why their positions were compatible.

B. The Board considered the cross-forum positions and proceeded

Petitioners are further justified in advancing both plain and ordinary meaning positions and indefiniteness positions because Patent Owner has proposed substitute claims. Petitioners’ expert Prof. Doolittle acknowledged Petitioners’

positions at deposition, explaining they reflect “different specifications and different guidelines.” EX2025 at 41:1-9. He articulated the *Nautilus* standard, explaining that indefiniteness means that claims “failed to inform with reasonable certainty” those skilled in the art. EX2025 at 46:8-47:17. Petitioners defended this rationale in their Reply (Paper 40) at 15-16 and went further in their MTA Opposition, citing the Markman Order and telling the Board they “do not contest this plain meaning construction” while arguing that “the construction itself highlights the term’s subjectivity (indefiniteness).” Paper 41 at 1. Patent Owner briefed the cross-forum positions in its PO Response but argued only that they undermined Prof. Doolittle’s credibility—not that they prevented the Board from evaluating the prior art or warranted any procedural consequence. Paper 26 at 26.

Petitioners’ MTA Opposition put both positions squarely before the Board. *See* Paper 41 at 1. The Board reviewed the Markman Order and found it “well-reasoned and persuasive.” Paper 42 at 16-17. In its guidance, the Board applied *Nautilus*, the same standard as the district court, and rejected indefiniteness: “Petitioner has not shown a reasonable likelihood that the proposed substitute claims are indefinite for including this limitation. We agree with and adopt the reasoning of the *Markman* Order.” Paper 42 at 19-20. The Board had no difficulty understanding the terms for purposes of mapping prior art while separately evaluating whether those terms satisfy *Nautilus*. It flagged no inconsistency and

identified no disclosure problem.

Patent Owner invokes the Director’s warning that the Office “cannot and will not” allow petitioners to “wait and see.” *Revvo*, IPR2025-00632, Paper 36 at 4 (Director Jan. 26, 2026). But that language addressed a petitioner at the *institution stage* who wanted to defer resolving an inconsistency until after the district court ruled. *Revvo*, Paper 36 at 3-4. Here, nobody is waiting. The district court ruled (EX1044, Jul. 2, 2025). The Board considered the ruling (Paper 42, Oct. 24, 2025). Both reached the same conclusion.

Any argument that Petitioners took a “wait and see” approach is belied by Patent Owner’s own conduct. Patent Owner’s PO Response in IPR2024-01357 (Paper 26, June 25, 2025) did not argue the positions were legally irreconcilable. Patent Owner’s PO Response in IPR2025-00260 (Paper 34, July 25, 2025), filed twenty-three days after the Markman Order rejected indefiniteness, did not mention the issue at all. Patent Owner filed two Schubert declarations after the Doolittle deposition (EX2026, EX2039); neither addresses the consistency of Petitioners’ positions. Patent Owner’s Sur-Reply (Paper 45, Nov. 13, 2025), filed ten days after *Revvo*, offered no substantive response to the rationale Petitioners had explained in their Reply.

“A party should seek relief promptly after the need for relief is identified. Delay in seeking relief may justify a denial of relief sought.” 37 C.F.R. § 42.25(b).

As detailed above, Patent Owner was aware of the cross-forum positions throughout these proceedings and had at least five opportunities to raise an inconsistency argument. Patent Owner first argued for termination only after the Board issued unfavorable Preliminary Guidance (Paper 42, Oct. 24, 2025) and *Revvo* provided a new theory (Paper 20, Nov. 3, 2025). It is Patent Owner, not Petitioners, who waited. Patent Owner has shown no good cause for the delay.

C. Petitioners Stipulation to Be Bound By the Board's Decisions If the District Court Cases Are Unstayed Eliminates Any Risk of Inconsistent Proceedings

The Board and parties have invested seventeen months in these proceedings. The Board has issued Institution Decisions in both IPRs, a Discretionary Denial decision in IPR2025-00260, and Preliminary Guidance evaluating both indefiniteness and obviousness across every substitute claim term. Whatever cross-forum tension may have existed has been resolved. The N.D. Texas case, the only court to reach claim construction, has been dismissed. N.D. Tex., Doc. 168 (Jan. 30, 2026). The Eastern District of Kentucky and Northern District of Ohio cases are stayed. The only active proceeding is this IPR. The purpose of the *Revvo* framework, preventing inconsistent outcomes across forums, has been fully served.

To remove any residual concern, Petitioners represent that they will be bound by the Board's claim construction determinations in these proceedings, including its rejection of indefiniteness. The only remaining question is whether

the prior art renders the claims obvious under the construction the Board has already adopted, the same construction every tribunal to consider the issue has endorsed. Unlike the conditional hedging the Director rejected in *TikTok*, this is an unconditional representation, made after the Board and the district court have both resolved the question the same way. And it goes further than the abandonment that satisfied the Director in *Samsung Elecs. Co., Ltd. v. Wilus Inst. of Standards and Tech. Inc.* (IPR2025-00933, Paper 14 at 6, Dec. 31, 2025): Petitioners are not merely dropping a position in another forum but agreeing to be bound by the Board's determinations in this one. This is yet another reason why *Revvo* does not apply here. *See Caption Health, Inc. v. Uni. of British Columbia*, IPR2025-01422, Paper 15, at 3 (Director Dec. 18, 2025) (noting that the Office accepts Petitioner's stipulation to construe a claim term in a specific way in the instant and any future proceeding and stating that such a stipulation "resolves any potential inconsistency in claim construction positions between forums and does not require further explanation under *Revvo*").

Every decision in the *Revvo* line that Patent Owner invokes was a Director-level decision under 35 U.S.C. § 314(a), not panel-level trial management. Patent Owner already sought Director Review on this issue; the Director denied the request as untimely, EX3100, and then denied Patent Owner's request for a good-cause extension the following day, EX3101.

IPR2024-01357, IPR2025-00260

U.S. Patent No. 8,604,678

Date: February 20, 2026

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that on February 20, 2026 the foregoing was served on counsel at the following electronic service addresses:

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