

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

FEIT ELECTRIC COMPANY, INC.,
Patent Owner

IPR2024-01357 (Patent 8,604,678 B2)
IPR2025-00260 (Patent 8,604,678 B2)

Record of Oral Hearing
Held: February 26, 2026

Before KEVIN W. CHERRY, SCOTT B. HOWARD, and ANDREW L.
NALVEN, *Administrative Patent Judges*.

IPR2024-01357 (Patent 8,604,678 B2)

IPR2025-00260 (Patent 8,604,678 B2)

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1 P R O C E E D I N G S

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3 JUDGE CHERRY: Good morning. I'm Judge Cherry. And with
4 me are Judges Nalven and Howard. This is the hearing in IPRs 2024-01357
5 and IPR2025-00260. The cases have been consolidated at the direction of
6 the acting director.

7 IPR2024-01357 is Savant Technologies and LEDVANCE, LLC v.
8 Feit Electric Company. And IPR2025-00260 is Savant Technologies, Elong
9 International, and Xiamen Longstar Lighting v. Feit Electric. Both
10 proceedings involve U.S. Patent 8,604,678. Will the parties please make
11 their appearances?

12 MR. BROWN: Andy Brown of the Radulescu firm on behalf of
13 Petitioner Savant and LEDVANCE in IPR2025-01357 and Petitioners
14 Savant, Elong, and Longstar in the 260 proceeding. With me is Mr.
15 Radulescu.

16 JUDGE CHERRY: And for Patent Owner?

17 MR. MCMAHON: Good morning, Your Honors. Charles
18 McMahon from Benesch for Patent Owner Feit Electric. With me here in
19 the room are Mr. Tom DaMario, who will also be arguing, as well as Carlton
20 Hemphill.

21 JUDGE CHERRY: Welcome.

22 MR. MCMAHON: Do you want to note that there were two
23 members of our team who could not join us today? I believe they have
24 connected via the public link. And I just wanted to alert you to that fact and
25 make sure that that's not a problem.

1 JUDGE CHERRY: Oh, no, that's no problem, you know. It's a
2 public link, everyone's welcome to join. So the parties have the hearing set
3 for 60 minutes per side. And I think the Patent Owner's counsel is a LEAP
4 practitioner, correct?

5 MR. BROWN: I --

6 JUDGE CHERRY: Oh, I'm sorry, Mr. Brown, you're a LEAP
7 practitioner, so you will get an extra 15 minutes, for 75 minutes. The way
8 we will proceed is the Petitioner has the burden of proof, so they will go first
9 and present their case in chief and then reserving any time for rebuttal.

10 And then we'll proceed to the Patent Owner's presentation. And
11 they can reserve time for surrebuttal. And then we'll do the rebuttal and
12 surrebuttal. And that will be our hearing. How much time would you like to
13 reserve for your rebuttal?

14 MR. BROWN: I didn't have an exact time in mind, but I think 30
15 minutes.

16 JUDGE CHERRY: Sure. So you'll have 45 minutes for your
17 opening presentation. And you can proceed whenever you're ready.

18 MR. BROWN: Thank you. Good morning. So turning to Slide 2.
19 I intend to proceed in four parts, walking through four sections here, starting
20 with the originally challenged claims where Petitioner's position is that the
21 primary reference is Basin 2007 and Krummacher disclosed the structure
22 and the wavelength blue light is well-known.

23 And then move on to Claims 11 through 14, which are dependent
24 claims and the subject of the 260 proceeding. And for those, again, the
25 primary references have nanoparticles preferentially scatter.

26 And then moving on to the revised contingent motion to amend,

1 the substitute claims that are presented there are obvious. They, once again,
2 just show the physical results of the structure that is already obvious. And
3 then finally, I'd like to turn to the 112 issues with the substitute claims where
4 there are written descriptions and indefiniteness problems with the new
5 claims.

6 So turning to Slide 3. For a little bit of background, this is an
7 annotated figure from the Basin reference. And this shows what a typical,
8 blue-pumped white LED looked like in the prior art. You have a blue LED
9 that's covered with a phosphor. The blue LED emits bright blue light. Some
10 of that light is converted by the phosphor to yellow light. Some of it passes
11 through and the combination of the two appears white.

12 And this has been around since the introduction of the bright blue
13 LED around 30 years ago. And to this very day, it is the basis for the white
14 replacement LED bulbs that we're all familiar with.

15 Turning to Slide 4, this is another example of an annotated figure
16 from Basin. And this is also the prior art. And this simply shows the
17 placement of titanium dioxide scattering particles in the outer silicon layer,
18 which serves multiple purposes, you know, one, as Basin 2007 says,
19 obscuring the appearance of the phosphor. But it also diffuses the light and
20 increases the uniformity, which is essentially the same thing that diffusers
21 have been doing with light bulbs for decades as well.

22 And some of this has already been gone through in the
23 introduction. But what is before the Board, we have the two consolidated
24 proceedings. The majority of the claims were challenged in the 1357
25 proceeding. Claims 11 through 14 were added in the 260 petition filed
26 shortly thereafter when those claims were added by patent order to the

1 litigation against Savant after the first IPR petition had been filed. And there
2 is a single motion to amend that has been filed in the consolidated
3 proceedings, and that is also before the Board.

4 Turning to Slide 6. We just have a summary of some of the claims
5 here that are at issue. Turning to the next slide, the description of the person
6 of ordinary skill in the art and this is an undergraduate degree in electrical
7 engineering, material science or physics, with one or two years of experience
8 in LED packaging design. And the parties don't dispute the level of ordinary
9 skill in the art.

10 So now, turning to the originally challenged claims. I'm going to
11 start with Independent Claim 19 here because the structure of the claims is a
12 little bit unusual. And I think Claim 19 is clearer than Claim 1 for this. And
13 that is if you look at Claim 19, you can see three structural elements. You
14 have the at least one solid state light emitter operable to generate excitation
15 light, and that is the LED that you can see highlighted in blue on the figure.

16 You can also see the wavelength conversion layer excitable by the
17 excitation light, wherein the wavelength conversion layer comprises
18 particles of at least one photoluminescent material. And that, again, is just
19 the phosphor layer that is highlighted in yellow here on the figure from the
20 '678 Patent.

21 And then finally, you have the light diffusing layer, which is the
22 layer with the particles of a light-scattering material, again, the diffusion
23 layer. And as you may have noticed the solid state light emitter, it doesn't
24 specify what color that needs to be or what wavelength that needs to emit,
25 you know. Those features of the claims are found in the wherein clauses at
26 the end.

1 And this is not disputed, but the wherein the light diffusing layer
2 improves an off state white appearance appears in the wherein clause. And
3 also, then in the final wherein clause, there's a requirement that the
4 wavelength conversion component be configured such that an operation
5 portion of light comprising blue light having a wavelength of greater than or
6 equal to 440 nanometers generated by the at least one solid state light emitter
7 is emitted through the wavelength compression component to contribute to a
8 final visible emission product.

9 And so that is where we get the actual requirement for blue light
10 greater than or equal to 440 nanometers. It's not with respect to the LED
11 structure; it's with respect to the wavelength conversion component. In
12 Petitioner's showing -- we've been showing that we have blue LEDs in the
13 prior art emitting in that range because, of course, that's the straightforward
14 way of indicating that, you know, the prior art wavelength conversion
15 components were capable of that.

16 So after talking about Claim 19, we can turn to Claim 1. And
17 Claim 1 claims, essentially, the same thing as Claim 19, only rather than
18 being the entire device including the LED, this just claims the wavelength
19 conversion component part. So even though the light emitting device is not
20 part of the necessary structure, you still have the requirement that the
21 wavelength conversion component allows the blue light to pass through.

22 And I actually have a -- this is the wavelength conversion
23 component part. It's just no led. It's just the phosphor layer and the titanium
24 dioxide layer. Here, I have images from both the Basin 2000 reference and
25 the Krummacher reference, which are our primary references for most of the
26 grounds.

1 And you see the checkboxes here for the structural elements and
2 off state white appearance in both Basin 2007 and Krummacher, both
3 explicitly have a solid state light emitter, a wavelength conversion layer, a
4 light diffusing layer, and the light diffusing layer causes an off state white
5 appearance.

6 So the only question with respect to these two references is what is
7 the wavelength of the conventional blue LED that both references disclosed?
8 And when we look at this question, I think the first thing that comes to mind
9 is where does this 440 nanometers come from? And the answer is that it was
10 added during prosecution.

11 And the purpose for adding it during prosecution was to
12 distinguish the McNulty reference. In the McNulty reference, in comparison
13 to our prior art references and the '678 Patent itself was directed to UV-
14 pumped LEDs. So LEDs with a lower wavelength, the light would not be
15 visible. And so you need multiple phosphors in order to create white light.
16 And that was the sort of device that was being distinguished.

17 And the 440-nanometer light, essentially, excludes the UV light.
18 It's not anything specific about the blue light other than that it is excluding
19 the UV light. And when we've looked at references for blue-pumped white
20 LEDs, uniformly, the conventional LEDs, you know, emit in a range above
21 440 nanometers, typically with peaks around 450 to 470 nanometers.

22 This is consistent with the '678 Patent itself, which in its
23 description doesn't describe anything special about the blue LEDs, but in
24 fact describes them as being commercially available from Intematix
25 (PHONETIC). And the conventional LEDs that are described here can have
26 a peak wavelength from 400 to 480 nanometers. But of course, it says

1 typically, they are from 450 nanometers to 470 nanometers.

2 Turning to Slide 14, I have the testimony from Prof. Doolittle,
3 Petitioner's expert, is at top. And below, we have a summary of the various
4 prior art references that have been submitted on the record in these
5 proceedings. And again, all of them have blue LEDs that are emitting above
6 440 nanometers and so fall within the scope of the claims.

7 Patent Owner hasn't identified a single example of a device
8 described as a blue-pumped white LED or a blue LED that does not fall
9 within that claim scope. When we deposed Patent Owner's expert when
10 asked him about the wavelength of blue light typically emitted by such a
11 device as compared to Petitioner's expert who was quite clearly able to
12 explain why these wavelengths were typical, Patent Owner's expert
13 essentially dodged the question repeatedly.

14 And this is an example of an answer he gave where -- when faced
15 with the question, you know, in a typical device, an LED package that emits
16 white light using a blue LED chip and a yellow phosphor, which
17 wavelengths of blue light would typically be emitted by the blue LED? And
18 he said, I would not be able to answer that question with certainty because
19 the description of blue depends to some degree on the context.

20 And it was that nature of answer that he gave repeatedly. And so
21 he essentially turned the question around when asked what a person of
22 ordinary skill in the art would understand blue to mean, his answer was,
23 well, it depends on what you mean by blue. And that's, I think, a reflection
24 of the fact that the prior art consistently shows blue LEDs with a wavelength
25 within the scope of the claims.

26 Again, turning to Slide 16. We have a textbook from Patent

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1 Owner's expert. And this was the second edition that was published shortly
2 before the filing of the '678 Patent. And here, you can see there is a table in
3 Prof. Schubert's textbook which actually lists the colors and associated
4 typical LED peak wavelength ranges. And so for a typical LED, well, Dr.
5 Schubert was unable to provide a wavelength range during his deposition.
6 In his textbook, he had no such problem, and he identified the typical ranges.
7 And for blue, that was 455 to 490 nanometers.

8 One complaint that Dr. Schubert made and that was repeated in
9 Patent Owner's briefing is that most of the examples in Dr. Schubert's
10 textbook, of course, did not relate to blue-pumped white LEDs. As the chart
11 shows, it's typical LEDs.

12 Now, the prior art references refer to conventional LEDs as well.
13 So there's no reason to think that there's any difference. But as far as actual,
14 blue-pumped white LEDs, Dr. Schubert's textbook has those as well. So you
15 can see at the bottom of this slide, Figure 21.8 from the textbook is the
16 emission spectrum of a phosphor-based white LED manufactured by Nichia
17 Corporation.

18 And you can see the two curves there. We've highlighted the blue
19 luminescent curve, that would be the blue LED. And it's worth noting there
20 that the blue LED doesn't just emit a single point. Even though it's relatively
21 narrow, it still covers a range of around 100 nanometers.

22 The curve for phosphorescence you see there is the light emitted
23 by the phosphor. And the combination of these two lights is what creates the
24 white light perceivable by the human eye.

25 Turning now to Slide 17. This is another quote from Dr.
26 Schubert's textbook. And again, one of the arguments that Patent Owner has

1 made, supported by Dr. Schubert, was that a person of ordinary skill in the
2 art would prefer a lower wavelength LED on the notion that such LEDs have
3 higher efficiency. But of course, a person of ordinary skill in the art, when,
4 you know, creating the device disclosed by Basin 2007 or Krummacher is
5 not just looking at a curve for how efficient the LED is, they're going to look
6 at the efficiency of the overall system.

7 And in particular, as we discussed briefly, UV LEDs are -- UV-
8 pumped white LEDs are significantly different from blue-pumped white
9 LEDs just because the UV light is not visible. So you need the multiple
10 phosphors. And you also have a greater distance that you need to convert
11 the light in terms of wavelength. And all of those lead to decreased
12 efficiency.

13 Now, there are a lot of factors that go into this consideration. But
14 Dr. Schubert had a section in his own textbook, which, you know, says that
15 a fundamental drawback of UV-pumped white LEDs is the energy loss and
16 incurred when converting UV light to white light and that the potential
17 luminous efficiency of UV pumped phosphor white LEDs is lower than that
18 of blue-pumped phosphor-based white LEDs.

19 And we see this reflected in the art as well, you know. This is the
20 reason why we have so many references with blue-pumped LEDs where the
21 blue LEDs are emitting, you know, within a relatively narrow range. That's
22 because that is, you know, what has been found to be the optimal
23 wavelength in view of a number of factors, including the available
24 phosphors.

25 Dr. Schubert was asked about this during his deposition as well.
26 And he denied this point until he was shown his textbook. And he was

1 never redirected on the point. And he has not submitted any expert
2 testimony since.

3 Turning to Slide 18. Patent Owner is now making the argument
4 following Petitioner's reply that Petitioners are arguing for a new ground.
5 Essentially, that well, you know, the petition put forward a multi reference
6 combination that Petitioners are now arguing for single reference
7 combination.

8 And that's simply not true. Petitioners have been consistent in
9 terms of what they've argued. And we are arguing a multi-reference
10 combination because, of course, you know, the Board's rules require that the
11 prior art be patents and printed matter. And so we wanted to make sure that
12 we had prior art that actually listed that 440 nanometer number.

13 But the fact that it's a two-reference combination does not mean
14 that you're physically combining the two references. As we said in the
15 petition, you know, a person of ordinary skill in the art would have
16 understood the blue light disclosed in Basin 2007 to include blue light with a
17 wavelength greater than 440 nanometers. So you already have Basin 2000
18 disclosing essentially everything except for the wavelength.

19 A person of ordinary skill in the art making the device disclosed by
20 Basin 2007 would have to choose an LED of some wavelength. And so the
21 question is what would that wavelength be? Well, you know, they would
22 look to Basin 2005 as one example, or, you know, any of the other dozen
23 references that disclose the same thing. And so in making that device
24 disclosed by Basin 2007, you would use the wavelength that falls within the
25 scope of the claims.

26 JUDGE CHERRY: Are the Petitioners proposing to essentially

1 use the LED, the same LED that's in Basin 2005, or are they just looking to
2 Basin 2005, you know, as guidance or -- could you clarify that for me?

3 MR. BROWN: No. There are multiple paths to obviousness, and
4 here in the petition, we presented both paths, you know, as to cover our
5 bases. And that is, I think, how you would combine the two, you look at it
6 from the perspective of a person of ordinary skill, you know. The reality, as
7 Prof. Doolittle testified to, is that a person of ordinary skill in the art is not
8 going to look to a secondary reference. They're going to know what the
9 wavelength of blue LEDs is.

10 However, you know, if it were required to physically combine the
11 two somehow, these LEDs are off-the-shelf commercial LEDs. A person of
12 ordinary skill in the art would have no difficulty swapping the physical LED.

13 JUDGE CHERRY: How do you address that, you know, the
14 Patent Owner, I believe, makes an argument about -- that the uses of the two
15 Basin references are the end uses for the devices in the -- and the two
16 references is different? Does that matter? And how should we deal with
17 that difference in the end uses?

18 MR. BROWN: In this case, it doesn't matter. That's because the
19 patent claims -- the '678 claims themselves do not require a certain
20 application looking at the prior art, you know. Although there are examples
21 of applications, there's nothing in the prior art that actually limits them to a
22 specific application. And there's been no indication of a real difficulty in
23 trying to use an LED in one application as compared to another as disclosed
24 in, say, Basin 2005 or in Shimizu.

25 And so actually my next slide -- turning to Slide 19 -- talks about
26 this a little bit. And I think the -- in addition to what I said, the -- you know,

1 another thing that I should address is that Claim 29 is unique among the
2 claims and that it requires a light bulb in addition to what is essentially in
3 Claim 19. And as with the references where you're just looking for the
4 wavelength, you already have the entire structure.

5 Here, you know, whereas Patent Owner is saying how do you
6 combine a non-remote disclosure with a remote phosphor disclosure? And
7 the answer from Petitioners is we're not saying that you're combining the
8 remote phosphor and the non-remote phosphor.

9 You're starting with the structure that's already disclosed in the
10 primary reference, which is Hussell (PHONETIC), and then adding a
11 coating on the outside of the bulb. And that was well-known in the prior art.
12 And we cited references for that, including the Tanda (PHONETIC)
13 reference and the Tong (PHONETIC) reference as well.

14 And in the lower right here, you know, there's a reference to the
15 Guardant Health case, which was issued just a month ago. And it's not
16 precedential, but I think it's persuasive on this point and that it discusses that
17 each element of the claim requiring a motivation to combine for each
18 element of the claim, even those present together in a reference improperly
19 dissects prior art references into collections of individual elements.

20 I think that's what Patent Owner is trying to do here. Rather than
21 looking at the actual combination that's proposed, they're pointing at the
22 overall applications or the nature of the thing to try to argue that they would
23 not be combined. But, you know, you need to address what the actual
24 proposed combination is. And that's consistent with KSR and its flexible
25 approach to obviousness.

26 With respect to the dependent claims, Patent Owner hasn't disputed

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1 that. And when I say dependent claims, I'm excluding Claims 11 through
2 14, which are part of the 260 IPR proceeding. But for the remainder of the
3 dependent claims, the Patent Owner doesn't dispute or doesn't argue that
4 they lend patentability beyond the independent claims. So if the
5 independent claims are obvious, the dependent claims are as well.

6 Patent Owner argues that there is objective evidence of
7 nonobviousness or secondary considerations. There are a number of
8 responses to that, one is that there was an actual product that, you know, was
9 designed by the inventors -- the alleged inventors for the '678 Patent that
10 was released. And there's no evidence that it was successful at all. Since the
11 filing of the patent and the introduction of that product, a significant period
12 of time has passed.

13 And so to the extent there is any success attributable to Patent
14 Owner's product, it's related to things that happened in the vast advances in
15 LED technology in the past decade. And it's to the specific filament format
16 that, of course, was not claimed in the '678 Patent and not disclosed in '678
17 Patent.

18 JUDGE CHERRY: Am I correct to understand that the product
19 that they're referring to is -- are those bulbs that look like incandescent
20 bulbs, like a clear incandescent bulb?

21 MR. BROWN: So they're typically referred to, I think, in the
22 design space as Edison-style bulbs, where you can see what appears to be a
23 filament. And of course, if you see a lot of those, they tend to be yellow, it's
24 part of the aesthetic. But certain people don't like the yellow. And so they
25 want white ones where the filament appears white.

26 And of course, we refer to those as filaments, but they're not

1 actually filaments. What they are is they're a flexible substrate that has
2 LEDs placed along it and then it's coated in a phosphor.

3 And none of that would have been possible 10 years ago just
4 because of heat management reasons, among others. And all of the evidence
5 that Patent Owner has come forward with is all anecdotal evidence, its, you
6 know, reviews on websites, awards won from their retail partners, their
7 pricing decisions. But there's no actual financial information, there's nothing
8 really detailed.

9 And I think, you know, the biggest issue from Petitioner's
10 perspective is that, of course, they're pointing to white as compared to
11 yellow as being the differentiator for their product and the evidence that the
12 Petitioners have allegedly copied their product. But the '678 Patent didn't
13 invent having, you know, a white -- blue-pumped white LED with the off
14 state white appearance. That was known in the prior art in Basin 2007 and
15 Krummacher, among others.

16 And so that can't form the basis for commercial success under the
17 Federal Circuit's objective evidence framing. And that's consistent as well
18 with there not any evidence of nexus really at all, no mapping of the
19 products that supposedly embody the claims to the claims.

20 Unless there are any questions on the originally challenged claims,
21 I'll move on to Claims 11 through 14. And these were challenged in the 260
22 proceeding.

23 And if I turn to Slide 24. We have three images here. And the one
24 on the left is Figure 10 from the '678 Patent. In Claims 11 through 14, all
25 require some variation of either preferential scattering, which -- I call it
26 preferential scattering, but it's scattering blue light relatively more than other

1 colors of light. And this is what's shown in Figure 10 where you can see the
2 curve, you know, the relative scattering for blue is higher than for green and
3 red at particle sizes that are nanoscale, where you have the size of the
4 particle measured in nanometers.

5 And this is a well-known, you know, physical phenomenon. This
6 is the reason that the sky appears blue. You have particles in the sky that are
7 nanoparticles. They scatter the blue more than the other colors that creates
8 that appearance.

9 And it's because once you get down to the nanoscale, the particles,
10 you know, approach the wavelength of the light. And so how they interact
11 with the light is dependent on the wavelength of light. As the particles get
12 larger, the wavelength of the light doesn't matter as much.

13 Now, Figure 10 was presented in the '678 Patent without any
14 attribution at all. It was presented as if it were the work of the inventors.
15 And in the middle figure, we have Figure 6 from the Stokes reference. And
16 you'll see it is an identical curve. And looking at Figure 6 from the Stokes
17 reference, it's labeled as prior art. And Stokes attributes that to Dupont
18 (PHONETIC).

19 And while we weren't able to find the Circuit 2000 marketing
20 material from Dupont, we do have marketing materials from around the time
21 of the patent. And that's shown on the right. And it's, once again, you
22 know, the same -- actually, this sphere is a little bit stretched out given the
23 way they presented it, but it is in fact the same graph.

24 And so that physics is unrebutted and also the fact that this is the
25 same chart that was known in the prior art is unrebutted. And Patent Owner
26 says that it's inflammatory and it's irrelevant. And, you know, it may be

1 somewhat inflammatory. But it's very relevant because Figure 10 from the
2 '678 Patent was presented to the examiner as if it were not in the prior art,
3 when it was in fact well-known in the prior art.

4 Turning to Slide 25, we have three columns with Basin 2007,
5 Krummacher, and Stokes. And this is another one where when you get to
6 the question of combining Stokes with the other references, you know, we're
7 not physically combining anything necessarily. You already have the prior
8 art that discloses titanium dioxide particles. And they disclose titanium
9 dioxide particles, including those in the range that would have preferential
10 scattering. Basin 2007 and Krummacher both involve nanoscale particles.

11 And so for those particles, you know, not only would a person of
12 ordinary skill in the art know that they would preferentially scatter so that
13 it's obvious in that way. It's also essentially inherent in the particle size
14 itself.

15 This is just a larger image. This is a graph. Figure 10. Turning to
16 Slide 27. And again, Patent Owner has, you know, what they're
17 characterizing now as a teaching away argument. But Stokes doesn't teach
18 away from the particle sizes that Petitioners are using it for, you know. The
19 thing that it criticizes is a layer arrangement that is in Shimizu.

20 But Petitioners aren't proposing to use the layer arrangement from
21 Stokes. We already have Basin 2007 and Krummacher that are being used
22 for the layer arrangement. Stokes is just being looked to one, so it's
23 evidence that nanoparticles would preferentially scatter.

24 And also, you know, again, in the same way that the wavelength of
25 blue light, if the person of ordinary skill in the art were trying to decide what
26 particle size to make, they could look at Stokes and his disclosure in order to

1 confirm the range where preferential scattering would take place. And Prof.
2 Doolittle testified what the benefits of that would be in Basin 2007 and
3 Stokes, which largely mirror what is said in Stokes itself.

4 Again, you know, in terms of teaching away, it's not enough that
5 there are multiple option. It's not enough that Stokes teaches a different
6 layer arrangement. The prior art must actually criticize, discredit, or
7 otherwise discourage in order to teach away. And we don't have that here.

8 Turning now to the substitute claims. And I'll start with the
9 obviousness of claims that follows the obviousness arguments for the
10 originally challenged claims, as well as Claims 11 through 14. And again,
11 you know, the patent has -- the claims have a relatively simple structure in
12 terms of what they require. And the prior art discloses the exact same
13 structure. So what Patent Owners now attempted to do through their
14 amendments is to take parts of specification that describe, you know, the
15 natural result of that structure and add that to the claim and say, you haven't
16 proved that that's the result.

17 But here, it's natural that if you add titanium dioxide -- a layer of
18 titanium dioxide, it will reflect blue light back through the phosphor and less
19 phosphor will be needed. That means, you know, that there's a phosphor
20 reduction based on including the titanium dioxide layer. And in the same
21 way, using nanoscale titanium dioxide particles, you know, will naturally
22 result in preferential scattering of blue light.

23 Patent Owner criticizes Petitioner's reliance on Prof. Doolittle and
24 his testimony and has called it conclusory. But, you know, Prof. Doolittle, I
25 think, gave compelling testimony regarding how this phosphor reduction
26 happens. It wasn't based just on his own say so. He cited to prior art,

1 including the Vriens and Oh (PHONETIC) prior art describing it.

2 And Prof. Doolittle's testimony is completely un rebutted. He was
3 never deposed on this testimony. And Dr. Schubert, despite Patent Owner
4 having the opportunity to present more testimony from Dr. Schubert, they
5 chose not to. And so Prof. Doolittle's word on this is the only word on this
6 matter.

7 JUDGE CHERRY: Mr. Brown, what do you understand the -- for
8 the reduction in the amount of phosphor? Does the patent give us any
9 guidance on how to measure that or how to determine, like, what benchmark
10 does it have to hit to -- are we saying that it has to perform the same way and
11 then use less phosphor? Does it provide us guidance of, like, what
12 performance we're supposed to measure to determine that it's meeting that
13 benchmark? Or can you provide me some -- the -- do you -- what your
14 understanding of how we would determine less phosphor?

15 MR. BROWN: So the short answer is no. I don't know how you
16 would determine that. I don't think the patent gives you enough information
17 to be able to do that. And, you know, I intend to talk through it a little bit
18 more later. But this is a particular concern, I think, with the claim that
19 requires a 20 percent to 40 percent reduction in phosphor.

20 Because it's impossible to know 20 percent of what are we talking
21 about, the mass, the volume, the thickness, the grain density, which one of
22 those should be changes, you know, the percentage calculation. And so
23 there's no real way for person of ordinary skill in the art to know whether
24 there's infringement or not.

25 And so how you would measure that, especially when you're just
26 dealing with a device and you don't have whatever the baseline would be?

1 You'd almost have to create a -- you would have to create a second device in
2 order to try to compare them. And that's just not feasible.

3 And then again, Claim 31 is the claim with a 20 to 40 percent
4 reduction range. And there, it is a -- you know, from Petitioner's
5 perspective, it's an arbitrary range. The 40 percent figure comes from the
6 patent specification where the '678 specification describes, essentially, the
7 best results they were able to attain. And then the 20 percent floor, rather
8 than being a floor somewhere in the specification, instead seems intended to
9 just cut off the case where you have some amount of phosphor reduction, but
10 you haven't quantified what that is.

11 For example, Vriens and Oh don't say 20 percent to 40 percent.
12 They, you know, support reduction. And so in that case where the '678
13 specification discloses the same structure as the prior art does, obtaining that
14 20 to 40 percent range is simply optimizing for, you know, the best phosphor
15 reduction.

16 JUDGE CHERRY: What is your understanding of what the
17 -- when I read the claim, it seems that it's configured to achieve this
18 reduction. Is that the physical arrangement of the layer or is it, you know, in
19 terms of the shape or is that the grain, the particle size or is it -- what is
20 being configured to achieve this reduction, in your understanding?

21 MR. BROWN: In my understanding, there's nothing that's being
22 done to obtain this result. It's just a matter of the structure. That was an
23 obvious structure. And, you know, that -- excuse me, that also gets into the
24 issue of these are component and device claims requiring operation to
25 determine and figure the operational context is -- also renders the claims
26 indefinite as well because it's impossible to figure out what infringes and

1 doesn't.

2 So Claims 40 and 45, along with their dependent claims, have the
3 same sort of limitations that Claims 11 through 14 do and the same analysis
4 applies. There's no reason why the claims' preferential scattering limitations
5 and the substitute claims would be any different than it was in Claims 11
6 through 14.

7 Again, both the phosphor reduction claim and the preferential
8 scattering claims, those both reflect physics that are the result of the claim
9 structure. So we've discussed this a little bit already, but, you know, turning
10 finally to the section 112 issues for the substitute claims. I think the biggest
11 one from the perspective of Petitioners is the amendment to the wavelength
12 claimed in the claims.

13 In the Board's preliminary guidance, the Board preliminarily found
14 that the 440 nanometer greater than 440 nanometer range in the original
15 -- originally challenged claims lacked written description support. And so
16 Patent Owner amended the claim to instead require a wavelength between
17 450 and 470 nanometers as it's disclosed in the claim -- in the specification.

18 And so this applies to all of the substitute claims because they
19 made this amendment in every claim. And the issue is that the portion of the
20 specification that they were trying to duplicate related to peak wavelength,
21 not to just any wavelength. Whereas as amended, the claim covers any
22 wavelength falling within the range. And those are two very different
23 things.

24 As we discussed earlier, wherever the peak of an LED may be, it's
25 going to have some width, where it has substantial emission and depending
26 on the particular LED, it can even have a longer tail. And so Figure 7 is

1 from Exhibit 2004, which I believe is the re-patent. And this shows a blue
2 LED or a violet-blue LED with a peak at 430 nanometers.

3 So under the substitute claims, you know, for the 450 to 470 as
4 described in the specification, a 430-nanometer peak doesn't fall within that
5 range, doesn't fall within what's disclosed in the specification. On the other
6 hand, as you can see, you know, there is plenty of emission of some kind
7 between 450 and 470. And so, you know, under the substitute claims, the
8 430-nanometer peak blue LED would fall within the scope of the claims,
9 even though it's not within the scope of what is disclosed in the
10 specification, and that mismatch.

11 JUDGE HOWARD: But wouldn't the person of ordinary skill in
12 the art realize when you're talking about light and wavelengths, that you're
13 talking about the peak and not just any point along the spectrum where there
14 might be some, you know, small amount of light going with that
15 wavelength?

16 MR. BROWN: I don't think that's so. And we have some support
17 for this in Prof. Doolittle's testimony. If you go all the way back to the
18 petition, we have a series of graphs showing LEDs that are disclosed in
19 Shimizu and the fact that wherever the peak is, you still have blue light
20 above 440 nanometers. And that's because Petitioner's reading of that claim,
21 as well as Prof. Doolittle's reading of that claim, was that any emission in
22 that wavelength would comply.

23 The reason why we are using this prior art for our obviousness
24 combinations, LEDs with peak wavelengths within that range is not because
25 we believe it's required but simply because that is what exists is ones with
26 prior art with peak wavelengths in that range. Otherwise, we run into

1 potentially a claim construction issue, I guess. But it's certainly not clear to
2 me that what -- that range and substitute claims that it's referring to would be
3 understood to be a peak wavelength.

4 JUDGE HOWARD: Okay. Thank you.

5 MR. BROWN: And turning to Slide 39, you know. One of the
6 arguments that Patent Owner made is that the earlier range, you know, above
7 440 nanometers had been examined and that the examiner had no issue with
8 it. And I guess the first point I would make is that the examiner made no
9 issue of the fact that the 440-nanometer range didn't fall within the scope of
10 the claims either -- or sorry, wasn't disclosed in the specification either.

11 But in particular here, you're dealing with a particular portion of
12 the spec being repeated in the claims. And this is an issue that was nowhere
13 in the original prosecution. There's really no way that it could have been
14 raised in the original prosecution. And so, you know, the examiner's
15 consideration of the 440-nanometer range isn't relevant to this issue and
16 doesn't bear on the substitute claims.

17 So we already discussed the 20 percent floor not appearing in the
18 claims in the Claim 31, the 20 to 40 percent range. And so just one
19 additional point that I wanted to make on this is that Patent Owners cited the
20 Rai (PHONETIC) case for allowing a range to be essentially constructed
21 from disclosed values, even if they're not necessarily disclosed as endpoints.

22 The first thing I want to point out is that when Patent Owner cited
23 Rai, they were actually, you know, reciting the facts from the Wertheim
24 (PHONETIC) case that is cited by Rai. But, you know, in the Ray case
25 itself, the endpoints were actually explicit.

26 But the main reason I bring that up is that if you look at the

1 Wertheim case along with, you know, Nvidia, which we cited -- Nvidia,
2 which was cited by Petitioners before, the Wertheim case says, you cannot
3 construct a range out of different embodiments that you're picking and
4 choosing. And here, you have the 40 percent ceiling is referring to the
5 typical embodiment where you have two separate layers.

6 The other values, the 25 percent and 33 percent values that Patton
7 owner points to are actually for a different embodiment where you have a
8 single layer that mixes both the phosphor as well as the scattering particles.
9 And so combining, you know, those two values along with the endpoint for a
10 different embodiment is improper and doesn't provide written description
11 support for that range in the substitute claims.

12 Again, we've already discussed this, but the reduced by 20 percent
13 to 40 percent claim term lacks any defined measure. And we raised a similar
14 argument, I think, in our opposition to the original motion to amend. And
15 the preliminary guidance preliminarily rejected that.

16 But we did want to point out that for this Claim 31, the reduced by
17 20 percent to 40 percent, presents a different issue because of the fact that it
18 requires reduction by 20 percent to 40 percent. If it just says reduction, any
19 level of reduction suffices.

20 And so, you know, whatever the reduction is, it presumably falls
21 within the scope of the claim. But when the claim says reduced by 20 to 40
22 percent, you need to know what that 20 percent and that 40 percent mean,
23 you know, what that's a percentage of.

24 JUDGE CHERRY: I just wanted to note you're into your rebuttal
25 time now.

26 MR. BROWN: Thank you. And so again, on Claim 31, we also

1 made the point -- Petitioners also made the point that in order to -- as we
2 discussed, in order to know whether this falls within the scope of the claims
3 or not, subsequent -- sorry, substitute Claim 31, you would have to actually
4 operate the device. You'd have to go through multiple steps, building a
5 baseline, choosing a target somehow -- target color temperature -- and then
6 operating both and comparing. And conflating the apparatus with
7 operational characteristics in this way is contrary to the Federal Circuit's
8 holding IPXL.

9 So just to summarize, if I can, the Petitioner's position is that the
10 original claims are obvious because the structure is in the prior art. And the
11 wavelength of blue light is also consistent throughout all of the references
12 and would have been obvious to a person of ordinary skill in the art.

13 Claims 11 through 14 are similarly obvious because preferential
14 scattering was both known as well as being inherent to the particle sizes that
15 are disclosed in the primary references. The substitute claims are obvious
16 for the same reason with respect to preferential scattering. And with respect
17 to the phosphor reduction, that's also simply a physical characteristic.

18 And then finally, the substitute claims, they all lack -- a written
19 description support are indefinite. In particular, the 450-470 nanometer
20 range is unsupported by the specification.

21 Unless there are any questions, I'll reserve the rest of my time.

22 JUDGE CHERRY: No. I don't have any questions.

23 MR. BROWN: Thank you.

24 JUDGE CHERRY: You have 28 minutes left. Good morning, Mr.
25 McMahon. How much time would you like to reserve for rebuttal?

26 MR. MCMAHON: Good morning, Your Honors. We're going to

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1 divide the opening argument with my colleague, Mr. DaMario.

2 JUDGE CHERRY: Okay.

3 MR. MCMAHON: If you wouldn't mind setting the timer for 40
4 minutes.

5 JUDGE CHERRY: Sure.

6 MR. MCMAHON: And I expect that Mr. DaMario will use 10 to
7 15. And we will reserve 5 for rebuttal, so 40 for now.

8 JUDGE CHERRY: Forty for now. That'll be your time. And then
9 -- okay. Then he'll do 10, and then we'll have 5 to 10 left of the 60 because
10 you have 60.

11 MR. MCMAHON: Correct.

12 JUDGE CHERRY: Okay.

13 MR. MCMAHON: Thank you, Your Honor.

14 JUDGE CHERRY: No problem. I'm sure it's all right. Whenever
15 you're ready.

16 MR. MCMAHON: I'd like to begin, Your Honors, with the two
17 motions to terminate that we filed a few weeks ago and to which the
18 Petitioners just responded on Friday. And between the two, I'll start with the
19 one directed to claim construction because there were just some recent
20 developments from the director on that topic.

21 In fact, on Thursday, one week ago, the day before Petitioners
22 responded to that motion, two decisions issued that same day, one was
23 Carbyne Tech -- Carbyne v. Tritech, that's IPR2025-00959, Paper 20; the
24 other is Infineon v. Mosaid, IPR2025-01171, Paper 27. And the
25 circumstances in both of those cases were nearly identical with one another
26 and with this case.

1 In both cases, the Petitioner argued for the plain and ordinary
2 meaning in the IPR and argued that the claims were indefinite in District
3 Court. And in Carbyne and Infineon, the director vacated institution
4 decisions. So those IPRs had been instituted. And the director vacated those
5 decisions on the basis that the Petitioner had failed in the petition to explain
6 why it was taking contradictory positions between the District Court and the
7 Board. And --

8 JUDGE HOWARD: What are we supposed to make about the
9 difference in timing? That yes, those cases were both after institution, but
10 they were still relatively early on, probably not much having happened in the
11 case. While, on the other hand, this case we fully had briefing on the merits.
12 We're at the oral hearing. How does that impact your motion to terminate?
13 It would seem to me pretty inefficient to have done all this work and now to
14 say, well, we're ready to issue our decision, but we're just going to throw out
15 all the work that's been done.

16 MR. MCMAHON: And Your Honor, we -- you know,
17 unfortunately, it is an unusual situation, but that happens sometimes when
18 there is a change in the law. And that's exactly what this was. Going back
19 to the Revvo decision that issued in November -- I believe November
20 -- October or November -- in which the director said that we are enforcing
21 this rule, that you cannot take contradictory positions.

22 And it's intended to ensure that Petitioners make efficient use of
23 the Board's resources and District Court resources and don't offer
24 contradictory positions in those two proceedings, which is what happened in
25 Carbyne, it's what happened in Infineon, it's what happened in Tesla. And
26 it's the same thing that has happened here.

1 JUDGE HOWARD: And since that time, has there been any
2 decision by the director in -- or Board panel in which they de-instituted a
3 case that was after briefing had been completed?

4 MR. MCMAHON: I'm not aware of one with that specific timing,
5 Your Honor. What I can say is that the director has been increasingly active
6 in denying and vacating institution decisions on precisely these grounds.

7 JUDGE HOWARD: Thank you.

8 MR. MCMAHON: And what the director has said in each of these
9 cases is that at a minimum, if a Petitioner is going to take contradictory
10 positions between the two tribunals, it must explain why. Perhaps there are
11 circumstances where an explanation would suffice, but there must be some
12 explanation. And where there has been no explanation, the director has
13 either denied or vacated institution. And that's exactly the situation that we
14 have here.

15 Now, Petitioner does cite some recent cases as well. One of them
16 that they cite is Samsung v. Willis. There are actually two related cases with
17 that same name, one is IPR2025-00933; the other is IPR-2025-988, both
18 Paper 14. And the difference is that in those proceedings, that -- the director
19 did permit institution but because the Petitioner said that they had not and
20 would not take an inconsistent position on claim construction.

21 And the circumstance there is that the Patent Owner, in requesting
22 discretionary denial, cited an email that the Petitioner had provided saying
23 that they intended to take certain positions. But they had not actually taken
24 any contradictory positions in the District Court. As opposed to this case,
25 where in three different District Courts, the Petitioner took contradictory
26 positions.

1 Now, the Petitioners waited until their backs were against the wall.

2 JUDGE HOWARD: What about the stipulation that Petitioners
3 have offered on page 9 of their opposition brief where they state, to remove
4 any residual concern, Petitioners represent that they will be bound by the
5 Board's claim construction determinations in these proceedings, including its
6 rejection of indefiniteness. Wouldn't that eliminate any issue?

7 MR. MCMAHON: That's exactly where I was headed next, Judge
8 Howard. So yes, with their back against the wall, Petitioners now have
9 offered to stipulate -- or at least in their brief have represented that they will
10 not take inconsistent positions in the District Court. There are two problems
11 with that, the first is that we have a history of not being able to trust
12 Petitioners when they represent that they will do something like this.

13 They also represented in seeking -- in opposing our request for
14 discretionary denial of the institution decision in the 260 proceeding. One of
15 our bases was that there was a parallel -- there was overlap with the District
16 Court cases and there was another proceeding at the time, the 258 petition,
17 IPR2025-258. And in opposing our request for discretionary denial,
18 Petitioner said that if institution is denied in the 258 proceeding, then two of
19 the Petitioners here, Elong and Longstar, would withdraw from this
20 proceeding -- would withdraw from the 260 proceeding.

21 That never happened. The institution was denied in the 258
22 proceeding. And yet they never withdraw -- they never withdrew. So
23 there's a history of not being able to trust these representations.

24 The other problem, frankly, is that in cases where the Board has
25 relied on representations from parties that they won't do something, as far as
26 I know, it has been that they will not do something before the Board. And

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1 so when a party makes a representation to the Board that they won't do
2 something before the Board, that's something the Board can enforce. But
3 when a party makes a representation to the Board that they won't do
4 something in District Court, there's no way for the Board to enforce that.

5 And in this case, there is something that Petitioners could have
6 done. They could have notified the two remaining District Courts who have
7 these arguments still pending before them, stayed as they may be, could
8 have notified them, hey, we're withdrawing those petitions. They have not
9 done that. We don't see this as a serious effort to actually reduce the issues.

10 JUDGE HOWARD: Is the issue of indefiniteness or the
11 limitations that you're talking about in your motion before the Board at this
12 time or before the panel?

13 MR. MCMAHON: Nobody has argued to the Board that the claim
14 should be indefinite, only to the District Court. That's where Petitioner has
15 done.

16 I'll turn then to the -- actually, I -- there's one more thing I would
17 say --

18 JUDGE HOWARD: No. I guess, in that case, it's your position
19 this is meaningless because the Board will -- doesn't have the ability to
20 determine whether that's -- that limitation is indefinite or not?

21 MR. MCMAHON: Well, let me make sure I understand your
22 question, Judge Howard. You're correct. I mean, if the Board were to
23 determine that these were indefinite, then the Board would have to stop.
24 There would be no ability to do any further work on the case.

25 JUDGE HOWARD: But we don't have -- do we actually -- we
26 don't -- and this is an IPR, we don't have the ability to just determine

1 indefiniteness of whether or not claims are indefinite or not.

2 MR. MCMAHON: As I understand it, Your Honor, the Board
3 does not have the ability, doesn't have the jurisdiction in an IPR proceeding
4 to consider indefiniteness. I believe there was at least one case in the early
5 IPR days in which a Board panel came to the conclusion that the claims
6 were indefinite and therefore could do no further work applying those claims
7 to the art. I don't remember that case name.

8 But my point in answering your original question, Judge Howard,
9 is that here, Petitioners are not arguing indefiniteness to the Board. That's
10 the argument they've made to the District Court.

11 And one more point that I'll make about this motion and then move
12 on is that the director expressly rejected this type of wait-and-see approach
13 from Petitioners in Revvo, which was the first case in this line and the one
14 that the director made presidential with this change in the law saying that the
15 director is not going to tolerate Petitioners who take a wait-and-see
16 approach. And that's exactly what Petitioners have done here.

17 They now know indefiniteness did not work very well for them in
18 one District Court case. They still have it pending in two other District
19 Court cases. And up until this point, throughout these proceedings, as long
20 as we've been here, they've tried to maintain both of those petitions -- both
21 of those positions.

22 Turning to the second motion for termination, I'll be brief on this
23 one. This is about the petition of LEDVANCE's failure to name a real party
24 of interest in the original petition. The motion presents all the evidence. I
25 won't go over that chapter and verse at this point. But the short story is that
26 LEDVANCE, LLC, as Petitioner now acknowledges, is fully owned by its

1 grandparent company, LEDVANCE GmbH, which is fully owned by a
2 company called MLS based in China.

3 The leader of both MLS and LEDVANCE GmbH is a gentleman
4 named Qinghuan Sun. He owns 40 percent of the both companies and is the
5 executive leader for both companies, so complete overlap leadership
6 between those two companies.

7 And when that purchase was made, Mr. Sun came out and said, we
8 are embarking on an expansion into the lighting industry with two brands,
9 MLS and LEDVANCE. That was the representation we made. That was the
10 representation we made. We presented that in our motion. And that, to us,
11 seems very relevant to the question of real party of interest and MLS's
12 interest in this proceeding.

13 Now, moving on to what LEDVANCE has said on Friday. They
14 presented a declaration, a very, very lengthy declaration representing certain
15 facts. And in short, their story is, that's not us. MLS and LEDVANCE
16 GmbH, they're completely different. We are an independent company. And
17 we are doing our own thing. We're not influenced by them. That hardly
18 seems credible under the circumstances and given the ownership and given
19 the representations that we have seen in the media from Mr. Sun.

20 And so we would ask that to the extent the Board is inclined to
21 credit anything in that declaration, especially since it's late breaking. I
22 mean, we've been talking to them for a couple of months about this issue,
23 they could have brought these facts to our attention earlier. We would
24 appreciate the opportunity to cross-examine Mr. Martin (PHONETIC) and
25 find out more about what he's represented in that declaration and probe the
26 credibility of the representations.

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1 Now, one more point I'd like to --

2 JUDGE HOWARD: Before you move on, let me just ask you a
3 procedural question.

4 MR. MCMAHON: Go ahead.

5 JUDGE HOWARD: Let's just say, completely hypothetically, you
6 said, yes, we're going to terminate on failure to name a real party of interest.
7 So that would apply, of course, to IPR2024-01357 because LEDVANCE is a
8 party to that proceeding. But for IPR2025-00260, LEDVANCE isn't a party
9 of that proceeding, too. In your opinion, have you argued, should that
10 proceeding still go -- is there a reason to get rid of that proceeding?

11 MR. MCMAHON: Not based on --

12 JUDGE HOWARD: You haven't alleged an RPI issue.

13 MR. MCMAHON: Right, Judge Howard, not based on the RPI
14 motion. So our motion to terminate on the basis of the RPI is limited to the
15 1357 proceeding. Our motion to terminate based on claim construction is
16 directed to both proceedings because every Petitioner took those same
17 contradictory claim construction positions.

18 And the last thing I'll say on both of these motions in terms of
19 timing is that because of the timing of the change in the law relative to this
20 proceedings, we do find ourselves here at the oral argument addressing these
21 motions to terminate. And we're putting all these issues in the panel's hand
22 to decide.

23 We submit that the panel, really, should decide the motion to
24 terminate first for a couple of reasons, one, because if you were to grant
25 those motions in a decision addressing -- a final written decision addressing
26 the merits, you would effectively be giving Petitioners an advisory opinion

1 on a petition that was never proper to begin with. That's the first reason.

2 And the second reason, quite frankly, is that these are issues that
3 clearly have become of importance to the director. And we tried to get the
4 director's attention on these ones previously but for procedural reasons only.
5 The director denied our request for review originally because, of course, the
6 change in law happened more than 10 days after the institution decision. So
7 our request to the director was more than 10 days after the institution
8 decision.

9 But if the panel is disinclined to agree with us on this, we would
10 like to take that issue to the director and get his take on it. So that's the
11 second reason that we would request that the panel address the termination
12 motions first before the final written decision.

13 Now, I'll move on to the merits. If we could go to the next slide,
14 please. This is Slide 2. And this is simply a summary of the grounds, which
15 is something I've always presented in every IPR argument I've done. But I
16 think it's particularly important here because as you can see, every ground
17 here is a combination of multiple prior art references.

18 That's important in this proceeding because the Board has always
19 been firm in its conviction that the scope of the proceeding is defined by the
20 grounds as instituted by the Board. These are the grounds as instituted by
21 the Board. And there is no single reference ground anywhere in -- on that
22 page. You can see these are all multi-reference grounds.

23 I say that because we've already heard today emphasis on single
24 references teaching all of the claims. That's a new argument that arose for
25 the first time in the reply brief from Petitioners. And they continue to press
26 it today. And that's a new argument that the Board simply should not

1 consider.

2 I will also broaden that to say there were quite a few new
3 arguments that arose today. I'm going to try and call some of those out as
4 we walk through the argument. But of course, the Board has traditionally
5 always enforced the rule that you can't raise a new argument in public
6 library, that oral argument, the scope of the proceedings defined by the
7 petition and the order granting institution.

8 Next slide, please. So here are the topics that I'd like to go over in
9 terms of the merit, touch on claim construction very briefly, then secondary
10 considerations, witness credibility, the four grounds of the 1357 proceeding,
11 the three grounds of 260 proceeding. And then finally, I will hand things
12 over to Mr. DaMario to address the contingent motion (PHONETIC).

13 Slide 6, please. And so turning to secondary considerations, as the
14 Board I'm sure is aware, in most cases, secondary considerations come last.
15 Usually, you address the prior art first and then turn to the secondary
16 considerations. We're doing the opposite here because this case is unusual
17 in my experience because of how clear the nexus is between the secondary
18 considerations and the claimed invention and also because all of the grounds
19 that Petitioners are presenting are multi-reference grounds where they're
20 talking about combining prior art.

21 I'll come back to this in more detail. But we submit that their
22 arguments just aren't there for combining this art, particularly when you
23 view those arguments against the backdrop of these strong secondary
24 considerations.

25 So this is all addressed in the briefs. I'll step through it briefly.
26 But next slide, Patent Owner Slide 7, addresses the long felt but unresolved

1 need. This one in particular is emphasized by what happened after these
2 products were released into the market and a commercial success and other
3 factors that were indicated that there was in fact a long-felt need in the
4 industry to address the question of these light bulbs that have yellow
5 filaments that were unattractive to customers.

6 Slide 8, please. This is anecdotal, admittedly. But this is a
7 customer interested in bulbs, specifically saying, hey, why can't we get these
8 with the white filaments?

9 Slide 9, please. Commercial success. And I'm going to pause on
10 this one a little bit because this one, I think, is perhaps the most clear
11 indication of the significance of the secondary considerations and events in
12 the invention. Here, we have Home Depot selling two different bulbs and
13 the only difference is one has the white filament and one doesn't.

14 And you can see they are able to sell the one with the white
15 filament at a 36 percent premium over the corresponding bulb as yellow
16 bulb. So that is a clear example of the claimed invention being used in the
17 marketplace and customers strongly preferring the bulb that uses the --

18 JUDGE HOWARD: What evidence do we have of nexus?

19 MR. MCMAHON: Of?

20 JUDGE HOWARD: Of nexus.

21 MR. MCMAHON: The nexus here is the difference between these
22 two bulbs, Your Honor, is that one is using claimed invention and one is not.

23 JUDGE HOWARD: But what evidence do we have that the bulb
24 in question is using the claimed invention?

25 MR. MCMAHON: Well, the white filament is certainly there,
26 Your Honor. And that is -- sorry.

1 JUDGE HOWARD: But do we have evidence that the -- that this
2 white filament meets the limitations of the claim?

3 MR. MCMAHON: The evidence we have is in the brief, Your
4 Honor. We did not do a limitation-by-limitation analysis. But I think the
5 evidence that we have submitted shows a clear preference in the market.
6 Four bulbs that happen --

7 JUDGE HOWARD: But don't we have evidence that these -- that
8 off-white filament -- off-white LED devices existed? You know, I mean, I
9 think that -- don't we have evidence that there -- that this existed? That it
10 doesn't have to be necessarily what the claimed invention is to be off-white,
11 correct? Because the Basin reference has an off-white -- white when off
12 device, and so does the Krummacher device?

13 I mean, I know there's disputes about the particular LED being
14 used. But do we have any evidence about what particular LED is being used
15 and how it meets the requirements of the claim?

16 MR. MCMAHON: So the argument on each of those references is
17 a combination, right? So there's no -- well, there's no original argument in
18 the petitions that any of those references or products that they --

19 JUDGE HOWARD: But my point is that just being white doesn't
20 -- I mean, your contention, I mean, about these references is that just being
21 white isn't enough, that it has to have this particular type of LED at a
22 particular wavelength, right? And do we have evidence that these devices
23 use this particular type of LED with -- at a particular wavelength?

24 MR. MCMAHON: I don't believe there's any evidence in the
25 record on particular wavelengths with respect to the commercial products.

26 JUDGE HOWARD: Okay. Then how can we say there's a nexus?

1 MR. MCMAHON: Well, I think that our argument is that the
2 nexus is to that white filament in particular. We're not talking about camera
3 flash bulbs here. We're not talking about any of the prior art reference.
4 We're talking about commercial products that embody the white filament
5 invention here.

6 JUDGE HOWARD: Okay. I mean, I think still doesn't answer the
7 question of how is -- well, first off, you know, practicing the claimed
8 invention. And then there's also the requirement that it's coextensive, which
9 is a second requirement. And I guess, how is a white -- it seems that a white
10 filament bulb is -- a filament bulb, period, is a unique kind of product in the
11 marketplace, right?

12 And how is that coextensive with what is claimed here, which isn't
13 -- doesn't require a white -- a filament-style bulb? It just requires a bulb in a
14 more general structure.

15 MR. MCMAHON: So I think, if I understand your question
16 correctly, Your Honor, you may be speaking to what Petitioner said about
17 the intervening technology, that in fact it's other features of these products.

18 JUDGE HOWARD: Yes.

19 MR. MCMAHON: And there are two problems there, the first is
20 that they say it's intervening technology. They didn't identify, at least I don't
21 think until today, what that alleged intervening technology is. And they said
22 that's the style of these sort of vintage bulbs, Edison-style bulbs is what they
23 say.

24 But that is addressed in the evidence itself because we're
25 comparing two different so-called Edison-style bulbs, one with the
26 traditional, yellow-colored filament, the other with the white. And there's a

1 clear difference in the market with those (PHONETIC).

2 JUDGE HOWARD: I mean, usually, the most persuasive types of
3 commercial success evidence is sales figures is amount sold and how
4 profitable is this? I mean, why should we just credit that there is a
5 difference in price? I mean, maybe there's a difference in price, but you
6 don't -- the sales are different. So I guess why should we -- what -- how can
7 we assign value to this without more information? Just that there's a
8 difference in price -- I mean, what more information do we have to kind of
9 be able to assign that weight to this?

10 MR. MCMAHON: Yeah. I want to answer your question, Your
11 Honor. I do also want to get on to some other topics.

12 JUDGE HOWARD: Okay.

13 MR. MCMAHON: But the answer to your question is it is a
14 simple difference in price with the only difference in feature being the
15 claimed invention. And nothing else. So there's nothing about the filament
16 or the bulb or the glass or anything else about the product that is different to
17 which the increase in price and the market's willingness to pay more might
18 be attributed.

19 Moving on to Slides 10 to 13 address the rest of the secondary
20 considerations. But I'm going to jump ahead to Slide 14 and touch briefly
21 on witness credibility. And I'm doing that here because as I said from the
22 beginning, every ground in this case involves a combination of references.
23 And for every ground, the sole source of evidence, alleged evidence, for
24 combining these references is Dr. Doolittle's testimony -- Prof. Doolittle's
25 testimony.

26 And Prof. Doolittle, in his deposition -- I'm not going to go into

1 this in a lot of detail. But the evidence is in the brief we've cited at the
2 deposition transcripts. You can take a look at them. He was conclusory in
3 his testimony, cites very little evidence to support his positions. And he was
4 evasive and nonresponsive through many, many questions in his original
5 deposition.

6 So I'll leave that. Obviously, it's up to the Board to determine
7 credibility. I don't mean to make that decision for you. But I wanted to
8 highlight the point because Dr. -- Prof. Doolittle's opinions here are so
9 fundamental to the grounds and the arguments that Petitioner has made.

10 So moving on to Slide 18 --

11 JUDGE HOWARD: I mean, I guess I do want to push back on
12 that a little bit because -- I mean, I guess we also have the cross examination
13 testimony of your expert and his textbook which suggests that blue LEDs are
14 in this wavelength range, that we have all these other prior art references that
15 talk about blue LEDs with wavelengths in this range. I mean, I guess I'm
16 failing to see why it is only his testimony that's supplying this.

17 When for example, the Basin reference says it uses a conventional
18 blue LED. And we have references that teach that conventional blue LEDs
19 fall within this range. I mean, I guess I'm struggling a little bit with that.

20 MR. MCMAHON: Sure, Your Honor. The distinction is that
21 when we were asking Prof. Doolittle questions, they were just
22 nonresponsive. We were getting arguments in return. The testimony we
23 saw on the slide today from Dr. Schubert was a reasonable question, you
24 know, to clarify a question. They were asking what wavelength is blue?

25 And Dr. Schubert was responding by saying, I need more
26 information to understand exactly what you're talking about. And his

1 textbook is no different. His textbook provides different examples. And the
2 answer varies depending on the particular circumstances of that -- of the
3 question. That is what Dr. Schubert was -- he wasn't refusing to answer the
4 question. He was simply saying, I need more information to answer your
5 question. That's very different.

6 And again, I defer to the panel to compare their testimony side by
7 side. But in our view, that's very different from the evasiveness that we
8 encountered with Prof. Doolittle.

9 JUDGE CHERRY: Was there any evasiveness with regards to this
10 wavelength and the blue light, or it's just about the claim construction? I'm
11 looking at your slide here. The contradiction here you're putting here is
12 about the plain and ordinary meaning.

13 MR. MCMAHON: It was on a number of topics, and we detailed
14 them all in our response brief, Your Honor. So it wasn't limited to this
15 particular topic. I don't recall that there was a particular -- you're asking
16 about Prof. Doolittle?

17 JUDGE CHERRY: Yeah. I mean, I think the main question we're
18 looking at here is this blue light issue and the wavelength. I just want to see
19 if there was any, you know, contradiction in the testimony with regards to
20 that from Petitioner's expert.

21 MR. MCMAHON: Thank you for clarifying. So I don't know that
22 there was any pushback on those -- on blue light in particular. But I do want
23 to push back on the premise to your question. You're saying that the main
24 question here is the blue light. We would submit that's not the case at all.
25 Because that might be the question if we were talking about a single
26 reference ground here. There is no single reference ground in this case. So

1 for every ground in this case, it's Petitioner's burden to establish a motivation
2 to combine the different references.

3 And as I'll get into -- actually, if we could go to Slide 19 -- sorry,
4 Slide 20. Slide 20 addresses for Ground 1 -- and this is true of all the other
5 grounds, too -- that Petitioners are relying on a number of different
6 references that have very different applications, very different packaging.

7 Dr. Schubert provided an extensive opinion on why those things
8 would matter. And most of the questions, as I recall, that Prof. Doolittle
9 tried to evade were, why would you combine this with that? Why would
10 you put these things together? And he had no answer.

11 We'll come to a slide in a few minutes on a different ground where
12 he expressly acknowledged the challenges of putting together, for example,
13 a reference that teaches a remote phosphor against a reference that teaches a
14 non-remote phosphor. There are a lot of challenges and incompatible
15 features among these different references. And one of the problems in both
16 of the petitions was a failure to explain exactly, are you going to combine
17 these different references?

18 And I think, Judge Cherry, that speaks to one of the questions that
19 you asked earlier about the details of how exactly would we take these
20 features from two different references that have different applications,
21 different packaging, how would we put those together? I think in our
22 original response, we said it's kind of a Frankenstein approach. They don't
23 explain what the motivation would be other than Prof. Doolittle's conclusory
24 analysis. (INDISCERNIBLE)?

25 JUDGE CHERRY: You're not contending that they have to show
26 how you would physically incorporate the LED, the particular led from the

1 exact LED from the one reference to the other, are you?

2 MR. MCMAHON: We're saying -- there's a premise in your
3 question, Judge Cherry, that I think they haven't answered even to begin
4 with. They haven't explained exactly what the combination is and how
5 features would be combined, much less why would -- one would look what's
6 --

7 JUDGE CHERRY: So you think that they'd have to specify how
8 you would take the particular part described in the one reference and how
9 you would physically incorporate it into the structure of the other reference?

10 MR. MCMAHON: I mean, there's a long-standing requirement
11 that if you're going to offer a combination theory, then it's not enough to just
12 say this reference plus that reference. You have to explain the motivation to
13 combine. And you have to explain how features from different references
14 would be put together. And we submit that they have not done that here.
15 They have not explained which features would be taken from different
16 references and how those features would be combined.

17 JUDGE CHERRY: But the way I understand the combination is
18 that Basin 2007 discloses all of the features except for the particular
19 wavelength, right? It does say it uses a conventional blue LED, right?

20 MR. MCMAHON: Right.

21 JUDGE CHERRY: And so then they're saying we look to these
22 second references for -- what does that mean? What is a conventional blue
23 LED? And it would be an LED of this -- these particular wavelengths,
24 right?

25 MR. MCMAHON: I don't think it has been explained exactly that
26 way, but yes. So why would you look to -- if you're looking for insight on

1 what wavelength to use in Basin 2007, why would you look to a reference
2 that has a completely different application to figure out what wavelength to
3 use?

4 As Dr. Schubert explained, the applications matter significantly.
5 The packaging matters significantly. All LEDs are not the same. And so
6 when you're looking to figure out how do I do something in a camera flash,
7 which is an instantaneous type of application, why would I look to an
8 application that is not at all like that?

9 JUDGE CHERRY: Again, I guess I'm kind of pushing back
10 because I feel like we're not supposed to -- you know, we don't have to
11 -- there doesn't have to be a showing that you could bodily incorporate one
12 reference into the other, correct? We just look to what the teachings are.
13 And it does seem that the consistent teachings across these various
14 references, the Basin 2005, the Shimizu, and the other references that they
15 cite seems to be that blue LEDs fall within this particular -- have these
16 particular wavelengths that they fall into. Why isn't that sufficient?

17 MR. MCMAHON: I don't think that they have connected the dots
18 the way that they need to do to show that one of ordinary skill in the art
19 would have been motivated. It's a conclusory analysis from Prof. Doolittle.
20 He doesn't rely on anything in the disclosures themselves to say, look to this
21 other reference.

22 It's purely Prof. Doolittle saying, frankly, with the benefit of
23 hindsight saying, look to this other reference to find this very thing that has
24 been recited in the claim today. You can't use the patent's disclosure and
25 claims as hindsight to go back and reconstruct the features that are in the
26 claim from the prior art.

1 JUDGE HOWARD: This is Judge Howard. This sort of seems
2 like a damned if you do, damned if you don't argument, that I have seen
3 plenty of cases where Petitioners are making obvious arguments based on
4 one reference and have their expert go and say, well, we would understand
5 -- for example, in this case -- that it says it's a blue LED light. And it would
6 have a certain wavelength associated with it.

7 And they'd cite other references in the expert declaration. And
8 then the Patent Owners will come back and say, oh, but you're combining
9 multiple references, and you don't identify that in your petition.

10 Here, they've done that. It looks to me, reading the petition, it's
11 like Petitioners relying on, at least, for example, Ground 1, Basin 2007, for
12 everything, except since it doesn't actually say what the wavelength is of
13 blue LEDs. It's saying, well, a person skilled in the art would have known
14 this from Basin 2005.

15 And here you are saying, well, you haven't said how you would
16 combine them. It doesn't matter what Petitioner is doing. It seems like
17 Patent Owner say you're doing it wrong, even when they meet the arguments
18 in the other case. I don't understand what else Petitioner could do.

19 MR. MCMAHON: Well, Your Honor, I can't speak to the
20 hypothetical --

21 JUDGE HOWARD: I mean, so here it is, if Petitioner just said, it's
22 obvious over Basin 2007. And a person skilled in the art from having
23 looked at Basin 2005 would know that blue LEDs have this range, would
24 that be okay? Is your problem just they've combined it?

25 MR. MCMAHON: The problem, Your Honor, is that they are now
26 making an argument that there's a single -- that you don't need to combine

1 references. I think the quote that they provided in their brief was that each
2 of these references independently teaches each of the claimed features. And
3 that's not only not true, it's contrary to what they said in the petition. The
4 petition defines the scope of the proceeding. And in the petition, they said
5 Basin 2007 does not teach this feature.

6 Now, they're saying it does. And they're trying to pivot. And we
7 submit they're doing that because of the flaws in their motivation to
8 combine.

9 JUDGE HOWARD: That's not what they say. That isn't -- there's
10 -- they go and say, it doesn't mention the wavelength. That doesn't mean it
11 doesn't teach it.

12 MR. MCMAHON: Can we go, please, to Slide -- so I think what
13 I'm pointing to here, Your Honor, is the petition at pages -- I don't have a
14 pincite for you -- 1939, where they said that Basin 2007 does not teach
15 -- does not -- maybe they did say mention, Your Honor. I don't have the
16 exact language in front of me. But the point is they acknowledged in the
17 petition something that was missing from a reference, which, of course, is
18 why they combined multiple references. And as soon as you do that, you
19 take on the burden of combining those references.

20 JUDGE HOWARD: But I think there's a difference between
21 saying -- you know, it's -- they say that Basin 2007 has a blue light LED.
22 And blue light LEDs have certain ranges of light. I mean, they're certainly
23 not going to produce light that's a thousand nanometers because it's not blue.
24 And all they're doing, as I read the petition, is saying Basin 2005 says that
25 blue LEDs go and have this wavelength which is, you know, discussed
26 throughout the prior art.

1 And so I am -- it strikes me as having read it, they're not saying
2 take the LED and put it in. They're saying, the person skilled in the art
3 would understand from this, watching Basin 2007 is in this range. And, you
4 know, I don't see what else is needed.

5 MR. MCMAHON: So let me try to come at it this way, Your
6 Honor. The 440-nanometer range was specifically added and was -- the
7 claims were allowed when that amendment was made. So this is not an
8 insignificant feature. This is a feature that was clearly important to the
9 examiner during original prosecution.

10 And in the petition, Petitioners acknowledge that their primary
11 reference does not specifically teach that feature. Now, you can argue that it
12 teaches something close and they can say that. But in the petition, they
13 acknowledge that they need a second reference in order to get that specific
14 feature. That was what resulted in the allowance of the claims. And as soon
15 as a Petitioner says, I need this second reference, they meet -- they take on
16 the burden.

17 JUDGE CHERRY: But the motivation to combine, it's in the
18 DyStar case, certainly, in the -- in multiple cases, where it talks about the
19 motivation to combine can come from any source. It can come from the
20 interrelated -- the teachings of interrelated patents.

21 And it seems like these two patents by the same inventor, both by
22 Basin, separated by only a couple of years, one references a conventional
23 blue LED and another -- his references that talks about this is what -- a blue
24 LED emits light in this range. That does seem like the kind of interrelated
25 teachings that a person of ordinary skill would look to find what does Basin
26 mean when he says a conventional blue LED, right?

1 This case seems, to me, almost indistinguishable from the Realtime
2 Data versus Iancu case, where the first reference talked about dictionary
3 encoding. And so they brought in a secondary reference to teach what is
4 dictionary encoding. And that the Federal Circuit said was the kind of thing
5 that a person of ordinary skill would do and would look to explain what is
6 meant.

7 I mean, there's a suggestion in Basin 2007, the conventional blue
8 LED, and these are -- the second reference is brought in as to define what
9 that would mean. why wouldn't that be what a person of ordinary skill
10 would do?

11 MR. MCMAHON: So I want to answer that question, Your
12 Honor, but I also do want to move on to the 260 proceeding, Claims 11 to
13 14.

14 JUDGE CHERRY: Okay.

15 MR. MCMAHON: But the answer to your question, Your Honor,
16 is I would agree with the several commonalities that you listed when you
17 began that question. There certainly are commonalities between Basin 2007,
18 Basin 2005, same inventor, they were close in time.

19 But what you left out of that list is the differences. And the
20 differences here are important. They were very different applications. As
21 Dr. Schubert has explained, the wavelength does matter when you change
22 application -- from application to application. And what we submit here is
23 that Petitioner, who bears the burden here, when they presented their
24 motivation to combine those two references, did not establish why one of
25 ordinary skill in the art looking at Basin 2007 would turn to base in 2005 for
26 anything in specific reasons.

1 If I could move on just to the other proceeding, the consolidated
2 proceeding. So the 260 proceeding addresses Claims 11 to 14 in particular.
3 And one thing that is common with all three grounds -- there are three
4 grounds in that proceeding, the first one is simply addressing Claim 1. And
5 that overlaps with Ground 1 of the 1357. So I'm going to skip over that one.

6 What's common to Grounds 2 and 3 in the 260 proceeding, and
7 also common to Ground 3 in 1357 proceeding, is the addition of the Stokes
8 reference. And that's important because Stokes expressly teaches a way
9 from the configurations of the other references.

10 So in particular, what we're talking about here -- bear with me just
11 a moment. Slide 42, please. So this is an illustration of what Stokes teaches.
12 And what Stokes teaches is the opposite of the '678 Patent. Stokes says that
13 luminescent material you put on the outside, the light scattering material you
14 put on the inside, and there's a particular reason for that because of the
15 penumbra effect that Stokes criticizes that you get if you do the reverse.

16 In other words, Stokes is saying, if you do what we claim, what
17 Patent Owner claim, that's bad, don't do that. Others have taken that
18 structural approach in the past, including Shimizu, which Stokes specifically
19 criticizes, and that's bad, don't do that.

20 Now, we presented this argument in response to the original
21 petitions when we responded. And the initial answer we got in their reply
22 from Petitioners was, well, that's just a mere preference by Stokes. It's not.
23 If you read the Stokes passages that we've cited in the brief, it's far more
24 than a mere preference. It is Stokes specifically saying, don't do what
25 Shimizu teaches you to do. That's bad.

26 And that's important here because they are reaching over to Stokes

1 to try to capture some of these features. And there is absolutely no credible
2 evidence that one of ordinary skill in the art would have combined these
3 references.

4 On the contrary, one of skilled in the art, looking at Krummacher
5 or at Basin, would have said Stokes teaches something completely different.
6 If I'm looking for more features, Stokes is not the place to go. Petitioners
7 have not had any answer to that throughout any of the briefing in these
8 proceedings.

9 Two other brief points I'd like to touch on, one is, in terms of new
10 arguments, there was -- there were two words that appeared through, I think,
11 Claims 20 to -- or Slides 20 to 25 -- Petitioner Slides 20 to 25 that are a new
12 argument. I think the phrases were physics, unrebutted, and something
13 about an inherent disclosure.

14 And if you go back to either of the original petitions, you will find
15 that the word physics doesn't appear anywhere in the grounds. It does
16 appear in the background in one of ordinary skill in the art. But the point is,
17 none of their grounds were based on concepts of physics when they
18 originally presented them, nor were they based on any sort of inherent
19 disclosure in the prior art. And so those are entirely new arguments that we
20 submit before -- should this count.

21 And the other thing I point out is that -- Slides 27 to 28
22 -- Petitioners are relying on arguments that they made in connection with the
23 motion to amend briefing. And they're relying on those arguments to
24 support their original grounds, which is entirely improper.

25 Their original grounds stand as they are based on the petition and
26 the arguments that they made directed to those grounds. They can't mix and

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1 match new arguments that -- they can't use the motion to amend briefing as a
2 vehicle to bring in new arguments that they did not make in their petition.

3 With that, Your Honors, unless you have any further questions on
4 the original petitions and the grounds, I'll turn things over to Mr. DaMario to
5 address the motion to amend.

6 JUDGE CHERRY: Okay. How much time did you want to use?

7 MR. DAMARIO: Good -- 10 minutes (CROSSTALK) --

8 JUDGE CHERRY: Great. (CROSSTALK) whenever you're
9 ready.

10 MR. DAMARIO: Thank you, Your Honor. And good morning,
11 Your Honors. I want to start by saying that the proposed amendments to the
12 claims in Feit Electric's revised contingent motion to amend are both -- each
13 fully supported by the specification, not indefinite and not obvious.

14 Before I dive into the merits of the claims, I respect that having a
15 motion to amend be part of an IPR can throw a little bit of a wrench into the
16 work. So I want to thank the panel for dealing with the changes in schedule
17 associated with the motion to amend, I do -- and especially complicated by
18 the fact that there are two proceedings, so thank you all.

19 I do, just for the Board's sake, want to go through a little bit of the
20 procedural history just so that we are all aligned there. There was an initial
21 motion to amend that was filed as part of the 1357 proceeding. That is Paper
22 27. That was filed on June 25th, 2025.

23 There was a supplemental motion to amend that encompassed
24 Claims 11 through 14 that is part of the 260 proceeding. That's Paper 35.
25 Paper 41 is in opposition to both of the original motions to amend. And then
26 the Board issued its preliminary guidance as Paper 42.

1 The reason I'm stopping here is because after the Board's
2 preliminary guidance, the Patent Owner issued a revised motion to amend.
3 The revised motion to amend is Paper 46. That revised motion to amend
4 was met with an opposition, which is Paper 49. And Patent Owner Feit
5 Electric replied as Paper 55.

6 The revised motion to amend opposition to the revised motion to
7 amend in the reply are the operative briefings at this point. So I want to
8 keep that in mind.

9 So if we could go to Slides 49 through 52. These layout the
10 revised claim amendment -- contingent claim amendments that Feit Electric
11 is proposing. If we could start with Slide 49. This is revised substitute
12 Claim 30. And it is substitute for original Claim 1. There are a few new
13 elements here. I'm going to step through all of these. But I just want to
14 highlight them for the time being.

15 So we have a couple of additional claim limitations. First off,
16 wherein the light diffusing layer is configured such that a portion of the
17 excitation light generated by the light emitting device is directed back at the
18 wavelength conversion component.

19 And I'm going to skip down to the third highlighted item on Slide
20 49, which is wherein the portion of excitation light generated by the light
21 emitting device and directed back at the wavelength conversion layer
22 reduces the wavelength conversion layer material necessary for given color
23 emission product.

24 We also see in amended Claim 30 that in response to the Board's
25 preliminary guidance, we have narrowed the claimed wavelength of greater
26 than or equal to 440 nanometers to between 450 nanometers and 470

1 nanometers, that's directly coming from the specification.

2 If we could go to Slide 50, please. This is contingent substitute
3 claim for original Claim 2. So it's claim -- amended Claim 31, which
4 depends from amended Claim 30. Adding the element wherein the white
5 -- wherein the wavelength conversion layer material necessary for a given
6 color emission product is reduced between 20 and 40 percent. And again,
7 we'll talk about this in a little bit.

8 If we could go to the next slide, please. Again, we see on
9 contingent Claim 40, the 450 to 470 nanometer limitation. And we also
10 have where in the light scattering material scatters excitation light from the
11 one or more solid state light emitters relatively more than the light scattering
12 material scatters light generated by the at least one photoluminescent
13 material.

14 And finally, Slide 52, we see a similar limitation to contingent
15 Claim 45. If we go to Slide 53, please. I first want to briefly address the
16 450 to 470 nanometer limitation. So the original specification discloses
17 bright blue light in a wavelength range of 400 nanometers to 480 nanometers
18 and typically 450 nanometers to 470 nanometers. That's found in the
19 original patent application, which is Exhibit 1004, at paragraph 47.

20 The claims, as originally allowed, recited blue light having a
21 wavelength of greater than or equal to 440 nanometers. And in the original
22 motion to amend, the Board's preliminary guidance suggested that the
23 original limitation may not have specification support. So Patent Owner
24 took that back. Again, we appreciate your guidance in this matter.

25 While we may disagree that there is sufficient specification support
26 for the 440-nanometer limitation, we wanted to narrow the disputes here.

1 And so we put in the 450 to 470-nanometer limitation. This apparently is
2 still an issue. But we agree and I think we heard Petitioners say that this is
3 less of an indefiniteness issue as it is a claim construction issue. Whether or
4 not peak is involved is something that one of skill in the art would know
5 based on reading the disclosure.

6 And again, this is not something that is a written description issue,
7 but maybe a claim interpretation issue. The cited range is fully supported by
8 the original specification, which, again, discloses 450 to 470 nanometers.

9 We could move on to Slide 54, please. Amended Claim 30 recites
10 wherein the light diffusing layer is configured such that a portion of
11 excitation light generated by the light emitting device is directed back at the
12 wavelength conversion layer. And that directing back of the light -- of the
13 excitation light reduces the wavelength conversion layer material necessary
14 for a given color emission product.

15 Petitioners claim that this is a natural result of obvious structure.
16 But they don't really identify any analogous art on point. In the original
17 opposition to the motion to amend, Petitioners relied on the Tong reference
18 here to suggest that this limitation was obvious.

19 In its revised motion to amend, Patent Owner took the feedback
20 that the Board provided and amended the claims and specifically noted why
21 Tong is not applicable. Tong's disclosure merely stated that it can lead to
22 increased amounts of down conversion and thus a shift in the color
23 temperature. Shift in the color temperature is not the same as a reduction in
24 wavelength conversion material necessary for a given color emission
25 product.

26 In their opposition to the revised motion to amend, Petitioners did

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1 not renew the Tong invalidity argument. They shifted to Verens and Oh.
2 Now, Verens and Oh have deficiencies on the merits, but the main problem
3 with Verens is Oh -- Verens and Oh is that they are supported solely by
4 attorney arguments. Outside of Verens and Oh, the only other support that
5 Petitioners have in their argument here is a citation to Prof. Doolittle's
6 declaration, which is Exhibit 1065.

7 And I want to -- I just want to focus on 1065 a little bit. We heard
8 a little bit about that early on. And we said that -- or we heard that Dr.
9 Doolittle considered Tong and Verens and Oh. Declaration 1065 is -- was
10 supported in -- Declaration 1065 was filed in support of Petitioner's
11 opposition to the original motion to amend. It does not cite Verens. It does
12 not cite Oh. It does not cite Tong. It cites a total of three references. It cites
13 the '678 Patent.

14 For the purposes of incorporating his background, it cites Prof.
15 Doolittle's prior technical background. And it also cites to Dr. Schubert's
16 textbook. The remainder of the 24 paragraphs are completely unsupported
17 by any other references.

18 I want to move on to Claim 31, which talks about the 20 to 40
19 percent limitation. So Dependent Claim 31 replaces the original --

20 JUDGE CHERRY: I have a question about the --

21 MR. DAMARIO: Yes.

22 JUDGE CHERRY: -- Claim 30 limitation.

23 MR. DAMARIO: Sure.

24 JUDGE CHERRY: So the reduction has to be -- so the claim
25 requires that the reduction be a result of the light that's reflected back; is that
26 correct?

1 MR. DAMARIO: So if we could go to Slide -- I want to make
2 sure I put the claim language up for everybody's benefit. So if we go to
3 Slide 53, please -- or sorry, 49. Thank you. So in revised Claim 49, we see
4 the final limitation says, wherein the portion of excitation light generated by
5 the light emitting device and directed back at the wavelength conversion
6 layer reduces the wavelength conversion layer material necessary for a given
7 color emission product. So I would agree with you that that is due to the
8 light that's reflected back.

9 JUDGE CHERRY: And for wavelength conversion material that
10 that is the phosphor?

11 MR. DAMARIO: The wavelength conversion material is the
12 phosphor, yes, Your Honor.

13 JUDGE CHERRY: So the light has to cause the reduction in the
14 amount --

15 MR. DAMARIO: The light that is transmitted through the
16 phosphor that hits the wavelength diffusion layer and the amount that's
17 reflected back into the phosphor actually makes the phosphor more efficient.
18 And therefore, you need less phosphor for a given amount of light.

19 JUDGE CHERRY: I guess, what -- why -- what is the structure
20 -- I guess -- I mean, this is an apparatus claim, right? How does the structure
21 do that? Because there's the -- I mean, what -- why isn't that an inherent
22 characteristic about light diffusing layer reflecting light back?

23 MR. DAMARIO: So I want to make sure I understand your
24 question. Maybe if you could rephrase it, Your Honor.

25 JUDGE CHERRY: I guess I'm struggling with -- wouldn't
26 anything you put over the wavelength conversion layer wouldn't that reflect

1 some light back to the wavelength conversion layer?

2 MR. DAMARIO: And we'll get into this in the next claim. This
3 might become a little bit more clear. But what the drafters or the applicants
4 in the '678 Patent were trying to do is effect a greater reduction more than
5 just a de minimis reduction in the phosphor material. So we're also --

6 JUDGE CHERRY: We've construed it, right, as any reduction is
7 sufficient? Wasn't that what we said in our preliminary guidance that it
8 wasn't indefinite because any reduction -- so you're saying that it was -- this
9 actually requires some non de minimis reduction?

10 MR. DAMARIO: It requires a little bit more than a de minimis
11 reduction. I believe that's what the -- you know, if we look at the examples
12 that are cited in this particular specification, it is more than just a de minimis
13 amount of reflection. And --

14 JUDGE CHERRY: So how would someone know that there
15 -- they would have to -- I guess I'm struggling with how would we -- how
16 would someone determine if they are infringing this claim. So they would
17 have to make one without the wavelength, without a light diffusing layer?
18 But it has to be a light diffusing layer that improves the off-white appearance
19 of the wavelength conversion component?

20 MR. DAMARIO: So when we're talking about -- and again, this
21 may become a little bit more clear when we talk about Claim 31, which has
22 the specified range, but I think it's equally applicable here. We are talking
23 about a reduction in phosphor material between a device that does not have a
24 wavelength -- or excuse me, a light diffusing layer and one that does that
25 affects this reduction in phosphor material, so yes. Hopefully, that answers
26 your question, Your Honor.

1 JUDGE CHERRY: Yeah. It does a bit, but it still leaves me
2 struggling with how someone would determine if they are infringing this
3 claim.

4 MR. DAMARIO: So Your Honor, I think it needs to be a little bit
5 more than a de minimis amount. And again, it's -- you know, if we're
6 looking for specificity, Claim 31 further refines that to 20 to 40 percent
7 reduction.

8 JUDGE CHERRY: Yeah. And I have some other problems with
9 that. So when we talk about giving color -- well, first, I guess this goes back
10 also to Claim 30. When we're talking a given color emission product, what
11 does that mean?

12 MR. DAMARIO: So again, we're talking about a -- maybe I can
13 point you to a portion in the specification that may be helpful.

14 JUDGE CHERRY: Yes. That will be helpful.

15 MR. DAMARIO: So I'm going to -- if we look at column 16, lines
16 14 through 18, we see this is an example of a reduction in phosphor material.
17 It says, the data indicates that by inclusion of a 2 percent weight loading of
18 light reflective material, it is possible to generate the same color and
19 intensity of light using a phosphate conversion layer that comprises 33
20 percent less phosphor material.

21 This is just one example. But when we're talking about a uniform
22 -- sorry, I want to make sure I'm using the right words -- a given color
23 emission product, we are talking about the same color and intensity of light.

24 JUDGE CHERRY: I mean, I -- so -- I mean, I guess I'm struggling
25 because how does a person know that -- so you're saying you have to
26 compare two light bulbs or two of these devices and for a given color, they

1 have to choose the same color and then determine whether it uses less
2 phosphor?

3 MR. DAMARIO: Your Honor, I will answer your question. I just
4 want to note that I'm running into my own time --

5 JUDGE CHERRY: I know, I will adjust your time. Don't worry
6 about that.

7 MR. DAMARIO: Okay. All right. So yes, the comparison here is
8 between a light emitting device that does not have the wavelength
9 conversion component, it has a what I'll call a standard amount of phosphor
10 and a wavelength conversion -- or wavelength -- excuse me, a light emitting
11 device that practices the claim that has the light diffusion layer that reflects
12 light back at the phosphor layer, thus affecting the reduction.

13 JUDGE CHERRY: And I guess -- okay. Then that kind of leads
14 me into this 20 to 40 percent, what is -- 20 to 40 percent of what?

15 MR. DAMARIO: Twenty to 40 percent of the actual amount of
16 phosphor. And so again, you know, turning to that exact same passage that I
17 pointed you to, that's column 16, lines 14 through 18, the patent talks about,
18 for example, a percentage of weight loading of the phosphor material.

19 JUDGE CHERRY: Okay. Well, what you just said there kind of
20 gives me a lot of pause. Because you just said, for example, how -- so what
21 is exactly being claimed? Are you claiming -- did you mean to claim the
22 weight percentage or are we doing something else?

23 MR. DAMARIO: Your Honor, given the fact that in the
24 specification, it describes, you know, various ranges. In each of those
25 ranges, it -- for example, it talks about a reduction in phosphor material of
26 up to 40 percent. It also talks about a reduction of phosphor material 25

1 percent. It talks about a reduction of phosphor material 33 percent. In each
2 of those situations, it talks about a percentage of weight loading.

3 JUDGE CHERRY: Sorry. That's my phone. Sorry.

4 MR. DAMARIO: No worries. In each of those situations, it talks
5 about a percentage of weight loading. So I don't know that that's something
6 that necessarily needs to -- again, I think that may be a question of claim
7 interpretation or claim construction. But I also believe that that is something
8 that one of skill in the art would understand after reading those passages in
9 the specification.

10 JUDGE CHERRY: I mean, I guess -- and then that leads me to my
11 next question, which -- I mean, the examples you just gave were 25, 33, and
12 40 percent. Nowhere did I hear 20 percent. Where is the 20 percent coming
13 from?

14 MR. DAMARIO: The 20 percent is not specifically called out in
15 the specification. But, you know, I'm happy to refer to -- again, the 20 to 40
16 percent, there are specific disclosures for up to 40 percent. There is a
17 specific example of 25 percent. And there's a specific example of 33
18 percent. Twenty to 40 percent was clearly within the applicant's purview at
19 the time of the invention.

20 JUDGE CHERRY: But you didn't disclose that entire range, right?

21 MR. DAMARIO: We did disclose the entire range in the sense
22 that we said there was up to a 40 percent reduction. That much is not
23 disputed at all.

24 JUDGE CHERRY: But you didn't disclose the 20 percent.

25 MR. DAMARIO: That's correct, Your Honor. The absolute 20
26 percent was not disclosed.

1 JUDGE CHERRY: And why is that written description support
2 for 20 percent, and so --

3 MR. DAMARIO: Again, it's within the range that is cited in the
4 specification, which is between up to 40 percent. So again, 20 to 40 percent
5 is within that range. And then we have examples of what one of skill in the
6 art, the applicants at the time, understood were test examples.

7 JUDGE CHERRY: But then why are we selecting 20 percent out
8 of that up to 40 percent range?

9 MR. DAMARIO: I'm sorry, why are we selecting 20 percent?

10 JUDGE CHERRY: Yeah.

11 MR. DAMARIO: I mean, that is within the range that the
12 applicant had when drafting the patent based on the examples provided in
13 the specification.

14 JUDGE CHERRY: Okay. Thanks. You're over. But we'll give
15 you guys your time back to be questioned about the motion. And I guess if
16 you could maybe wrap up and --

17 MR. DAMARIO: Yes, Your Honor. Your Honor, I guess I'll
18 wrap up by saying that Claims 40 and 45, again, are -- sorry, on Slide 56.
19 Ours rest on similar arguments to the Stokes argument that we heard earlier.
20 And so with that, I don't need to re-explain that to you. So I will rest there
21 unless there are any further questions.

22 JUDGE CHERRY: No further questions. Thank you very much.

23 MR. DAMARIO: Thank you.

24 JUDGE CHERRY: And we did want to note -- you know, I know
25 Mr. McMahon asked about deposing the LEDVANCE witness that
26 submitted a declaration. And our understanding is that that would be

1 covered under routine discovery under the rules that are in 42.51. So I think
2 that there's no need to request authorization from us to depose the witness
3 and that to us would be covered under the rules. So the parties should work
4 out a deposition if that's what they want to do.

5 MR. MCMAHON: And Your Honor, the reason I asked that was
6 simply because of where we stand in the procedural posture of the case.
7 We're already at oral argument. Can you provide any guidance on how we
8 would update the Board with any results from that type of deposition?

9 JUDGE CHERRY: Well, why don't we do the deposition first and
10 then we can -- then the parties can contact us with what they propose to do
11 with it.

12 MR. MCMAHON: Thank you.

13 JUDGE CHERRY: Mr. Brown?

14 MR. BROWN: So first, I'd like to address the motion to terminate
15 based on allegedly inconsistent claim construction positions. As an initial
16 matter, I want to address the new cases that were cited by Patent Owner,
17 which, of course, were both director-level decisions, as every decision we've
18 seen regarding this issue has been.

19 And that's important for a reason, which is that the Federal Circuit
20 has said that the indefiniteness of a limitation precludes a patentability
21 determination only when the indefiniteness renders it logically impossible
22 for the Board to reach such a decision. And of course, the Board is obligated
23 to issue a final written decision with respect to the patentability of every
24 claim challenged by the Petitioner.

25 And so the question here, I think, is whether it's logically
26 impossible for the Board to reach a decision? And the answer is really

1 simple.

2 JUDGE HOWARD: But that's not the issue that the director was
3 addressing in Revvo, which is a precedential opinion, which means it's
4 designed to be binding on the Board. The director doesn't have to do a
5 presidential decision to bind him. The Director, you know, gets to do what
6 the director wants to do. So clearly, Revvo is directed towards panels of the
7 Board like us.

8 And it doesn't say to go and do this analysis to say, can you go and
9 solve it? Can you go and reach the issue of obvious or not? Revvo says if
10 there are different claim constructions being argued, then you should not be
11 instituting or de-instituting, which actually happened in Revvo. We should
12 be de-instituting. So I don't see how that case was particularly relevant to
13 our issue.

14 MR. BROWN: So if I can just, you know, finish. I wanted to say
15 that this is regarding the alleged inconsistency with the term improves an off
16 state white appearance. The prior art explicitly says the same thing. You're
17 right, Revvo is precedential. I think there are two issues, one is that the
18 portion of the rules that Revvo is citing to is considered at the time of
19 institution -- sorry, the time of the filing of the petition, you know, not any
20 time at all.

21 And also, I think the director's decisions are consistent with the
22 Federal Circuit case law in the sense that the Tesla case says that the Board
23 may proceed or a person of ordinary skill in the art would understand that
24 the art satisfies the limitation. And that's what we have here.

25 So we have had now this issue considered multiple times. And
26 every time, regardless of whether Petitioners or in the case of the District

1 Court cases, defendants have raised indefiniteness issue or not, every
2 tribunal has determined that the plain and ordinary meaning should apply.

3 And Patent Owner's expert also conceded that the plain and
4 ordinary meaning should apply. Again, all because the prior art discloses
5 the limitation in the same terms. So on that basis, there's no risk of
6 inconsistency between the proceedings.

7 JUDGE HOWARD: Then why didn't you just say that? Why
8 didn't you just do a stipulation and saying, we're withdrawing our
9 indefiniteness arguments from the District Court cases and this whole issue
10 could have been resolved. You did some sort of stipulation that sort of
11 depends on us ruling on indefiniteness. And that's not an issue that we're
12 able to address.

13 MR. BROWN: I think our intention of addressing it there was that
14 -- in fact, you did address it with regard to the opposition to the motion to
15 amend.

16 JUDGE HOWARD: It was done in a preliminary guidance, which
17 isn't binding. And that issue is no longer being raised in the revised motion
18 to amend. So we can't go back and consider that. There, you know, hasn't
19 been -- and that issue is really before us anymore. Parties aren't arguing it.
20 There's not going to be a decision that we can make on indefiniteness. But
21 that seems to be what your stipulation is being based on.

22 MR. BROWN: So regardless of the determination having been
23 preliminary, you know, defendants have agreed to take that as -- they're not
24 going to contest that anymore -- we're not going to contest that anymore.
25 Even though it was it one of the decision --

26 JUDGE HOWARD: But that's not the stipulation that you made.

1 That's the problem.

2 MR. BROWN: Well --

3 JUDGE HOWARD: If you had said that -- you know, as clear as
4 you just said that we're not raising this issue anymore. I think we'd be in a
5 different procedural state. But you didn't say that.

6 MR. BROWN: If we could insert the word preliminary into the
7 stipulation so that we agree to the preliminary determination, you know, that
8 is what we would agree to. And the other issue with -- there's the question
9 of why we didn't just disclose it in the first place is that in addition to Revvo
10 not having been released at that point, the parties had not yet taken their
11 claim construction positions in the District Court at the time that the petition
12 was filed. So defendants didn't know yet that they were going to take that
13 position.

14 And in the process of filing the IPR petitions, there was no reason
15 to even consider indefiniteness for two reasons, one, of course, the Board
16 doesn't consider indefiniteness. But the more important reason is that there's
17 no reason to try to construe the claim other than the plain and ordinary
18 meaning, when the plain and ordinary meaning is both clear and clearly
19 present in the prior art.

20 So addressing the contention that Petitioners didn't raise this issue
21 until their back was against the wall, obviously, we responded to it once it
22 was raised in the form of, first, the Director reviewed the request and then
23 the motion to terminate. But that wasn't the first time that Petitioners raised
24 it.

25 We did submit the decision when the decision was made, along
26 with our papers. And again, we were -- we took the same position in front

1 of the Board that we had taken in the District Court, which was, again, that
2 there is no necessary inconsistency between this term both being indefinite
3 because the boundaries are unclear, while at the same time clearly being
4 within the prior art which discloses it in the very same words.

5 I guess, if we're willing to take the representation that the
6 stipulation is intended to cover the determination of the Board made
7 preliminarily, you know, I did want to address the notion that Petitioners had
8 made a promise that they went back on because we take allegations like that
9 very seriously. Petitioners agreed to withdraw as contingent on the
10 proceeding being instituted. They did not say that they would withdraw.

11 As the Board knows, once a proceeding has been instituted,
12 Petitioner cannot unilaterally withdraw. And so although Petitioners agreed
13 to withdraw, you know, they were never asked by Patent Owner to actually
14 withdraw. And so it never happened.

15 But, you know, that was not because Petitioners were going back
16 on their word, it's because they could not do so unilaterally. And Patent
17 Owner had not sought to do so.

18 In terms of notifying the courts of this issue of the stipulation
19 during the stay, I would have to confirm for both of the cases that are still
20 live. One of the cases has now been dismissed. The two cases that are still
21 live. They've been stayed. At least one of the stayed cases has been
22 administratively closed. It's not a matter of just filing stipulation in the
23 District Court.

24 And of course, although there's been the allegations that were
25 untrustworthy, you know. When we make representations, we're officers of
26 the court, we stand by them. And so that should not be an issue.

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1 Turning to the real party in interest issue, you heard from Patent
2 Owner and all you really heard was that this company is owned by a parent
3 company. The parent company is owned by another company, so it's wholly
4 owned. You have an individual in charge and then the insinuation that that
5 means control.

6 But, you know, there's no evidence at all that the corporate form is
7 not being respected here. We have significant corporations both in the U.S.,
8 in Europe, and worldwide, as well as in China. They all operate
9 independently. And we have evidence in support of that. I suppose that you
10 will be cross-examined. But as it is, I think that the evidence is clear that
11 these petitions were filed for and at the behest of LEDVANCE and not to the
12 benefit of LEDVANCE's parent company.

13 Again, this is -- you know, we've had a few cases where the
14 director has considered this issue. And I think if you look at those cases,
15 YMTC is one where institution was vacated and that is one where they
16 refused to answer questions about the nature of the company. And they had
17 direct ties to the Chinese government.

18 BOE Technology is a case where the director issued a summary
19 determination. However, the facts in that case involved BOE Technology
20 being on the entity list, having a congressional committee find a state-
21 backed foreign actor, an annual report with a state-owned entity as actual
22 controller. All of these facts and the director still found it unpersuasive.

23 Here, we have none of those facts. And of course, as was
24 discussed, even if IPR2024 were to be -- IPR2024-01357 were to be
25 terminated, that, of course, should not affect the also pending 260 case.

26 I wanted to address the idea that Prof. Doolittle was obstructionist

1 or refused to answer questions. One question from the panel was whether
2 they received any -- whether the Patent Owner received any pushback on
3 questions regarding the typical wavelengths of blue light.

4 He did not push back because he was never asked about it once.
5 PO quoted Prof. Doolittle's answers in a number of places, especially with
6 his alleged obstructing questions regarding the motivation to combine where
7 he said I find the question irrelevant.

8 As Patent Owner said, I would agree. Reading the transcripts of
9 the two experts is very enlightening. And I think that Prof. Doolittle did his
10 best to answer the questions despite them -- the two different applications
11 being irrelevant to his analysis, which is very similar to what the Board
12 found preliminarily in the institution decision.

13 And, you know, Prof. Doolittle answered every question that was
14 put to him. And I think as he was being asked and asked to answer
15 questions yes or no, only, repeatedly, I think what he said was very helpful,
16 which is I'm just a professor, I'm not a lawyer. I'm trying to answer your
17 questions as honestly as I can. I've taken an oath to answer them honestly.

18 And if I view that question as no -- yes or no answer, then I need to
19 explain that because I've taken this oath. And I have to answer according to
20 my conscience. And that is in fact how Prof. Doolittle answered. And I
21 think you will see that if you review the transcripts.

22 There was additional -- Patent Owner discussed Prof. Doolittle's
23 supplemental declaration that was submitted with the opposition to the
24 motion to amend and the lack of citations in one place or another. He, once
25 again, was not cross-examined on that declaration, no contrary testimony
26 was provided. Again, his testimony is consistent with the prior art and did

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1 cite the prior art. But more than that, you know it's cogent testimony that
2 was not rebutted in any way.

3 Unless there are any further questions, that is what I have.

4 JUDGE CHERRY: No questions for us. Thank you very much,
5 Mr. Brown.

6 MR. BROWN: Thank you.

7 MR. MCMAHON: Your Honor, just a couple of brief points.

8 JUDGE CHERRY: Well, sure. We give you back your 10
9 minutes, so.

10 MR. MCMAHON: Thank you.

11 JUDGE CHERRY: Whenever you want to begin.

12 MR. MCMAHON: So I'll begin with the claim construction issue
13 because I think there are a couple of important considerations there. Again,
14 as I said before, the director in Revvo rejected this kind of wait-and-see
15 approach. And as I read the director's decisions, not just in Revvo but Tesla
16 and the other more recent decisions, the key is the sort of gamesmanship or
17 inconsistency -- or I'm sorry, inefficiency of having contradictory arguments
18 addressed in two tribunals.

19 And part of the basis for the AIA in the IPR proceeding in the
20 beginning was supposed to be efficiency, not duplicating resources, not
21 duplicating proceedings. But that is exactly what we have done here. Many
22 of us in this room gathered in another room, in a courtroom in Dallas,
23 months ago to argue the indefiniteness issues and their indefiniteness
24 arguments that Petitioners have presented to the District Court.

25 Those did not prevail. But that is exactly the type of inconsistency
26 and overlap in contradictory positions that we read the director to be

1 concerned about in Revvo and Tesla and the more recent Carbyne and
2 Infineon decisions.

3 And the other thing I would say is if -- I don't want to try to quote,
4 perhaps I misheard, but I understood Counsel to just say, you know, the
5 reason that they did not argue indefiniteness to the PTAB was because they
6 were able to understand the claims. And that may well be true.

7 But then why argue indefiniteness to the District Court without
8 offering any explanation to either tribunal as to why they were taking those
9 positions? Though, I believe Revvo addresses that too, and says these types
10 of excuses, after the fact, are insufficient to avoid either the denial of
11 institution or making (INDISCERNIBLE) of the institution.

12 I wanted to address briefly, Judge Cherry, your questions about
13 Claim 31 and the question of how exactly would you compare and determine
14 infringement. And I think we thought about it from the question -- the
15 perspective of proving infringement.

16 And you would do tests. Exactly as you said, you would have two
17 devices and compare them to see how they compare, align them to make
18 sure that they have the correct -- that the same color emission product, one
19 with the light scattering material, one without, and see what the difference is
20 in the required phosphor material to accomplish that. That would give you a
21 direct comparison and a direct written measure.

22 And on the 20 to 40 percent, I just refer back to the Board's
23 comments in the preliminary guidance on the original motion to amend.
24 When the Board noted that disclosure, in haec -- verbatim, I said I believe is
25 the in haec verba -- my Latin pronunciation is not great -- but that it is not
26 required, right? The law does not require in haec verba disclosure. And to

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1 the 20 to 40 percent, you know, that is a range that falls within the up to 40
2 percent range that was disclosed and reasonably captures the very specific
3 examples that were given in the disclosure of 25 and 33 percent.

4 So just to share your last why 20 to 40 percent? I think that's the
5 answer. It's a very reasonable range within the larger range that was
6 disclosed that captures this specific example that were disclosed.

7 Your Honors, those were the points that I wanted to cover. If the
8 Board has any other questions, I'd be happy to address them.

9 JUDGE CHERRY: Any questions? Well, thank you both very
10 much for your presentations. They were very helpful. And with that, the
11 case is submitted.

12 (Whereupon, the above-entitled matter went off the record at 12:16
13 p.m.)

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