

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioner,

v.

FEIT ELECTRIC COMPANY, INC.,

Patent Owner.

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

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

Petitioner,

v.

FEIT ELECTRIC COMPANY, INC.,

Patent Owner.

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

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

CHERRY, *Administrative Patent Judge*.

ORDER

Denying Patent Owner’s Motion to Terminate for Failure to Disclose Contradictory Claim Construction Positions Taken in District Court

Pursuant to our authorization, Patent Owner filed a “Motion to Terminate for Failure Disclose Contradictory Claim Construction Positions Taken in District Court.” Paper 56¹ (“Motion” or “Mot.”). Petitioner filed an Opposition. Paper 60 (“Opposition” or “Opp.”). For the following reasons, we *deny* Patent Owner’s Motion.

I. BACKGROUND

A. Board Preliminary Proceedings

On August 26, 2024, Petitioner LEDVANCE LLC and Savant Technologies LLC filed a Petition in IPR2024-01357 (Paper 1) seeking *inter partes* review of claims 1–3, 6, 7, 9, 10, 16–21, 25, 26, and 29 of U.S. Patent No. 8,604,678 B2 (Ex. 1001, “the ’678 patent”). On March 5, 2025, we instituted an *inter partes* review on all claims challenged in the Petition on all the grounds raised in the Petition. *See* Paper 17.

On December 9, 2024, Petitioner Savant Technologies LLC, Elong International LLC, and Xiamen Longstar Lighting Co. Ltd. filed a Petition in IPR2025-00260 challenging claims 11–14 of the ’678 patent. IPR2025-00260, Paper 1. On June 12, 2025, the Acting Director denied Patent Owner’s Request for Discretionary Denial. *See* IPR2025-00260, Paper 16. On June 23, 2025, we instituted IPR2025-00260 and consolidated it with IPR2024-01357. *See* IPR2025-00260, Paper 17.

Both Petitions assert that the “[c]laims should be understood according to their ordinary and customary meaning as understood by a

¹ All citations are to the docket in IPR2024-01357, unless otherwise noted.

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[person of ordinary skill in the art] at the time of the invention considering the language of the claims, the specification, and the prosecution history of record,” and that “no construction should be necessary to institute this petition.” Paper 1, at 18–19; IPR2025-00260, Paper 1, at 20–21.

B. District Court Proceedings

The parties have identified three district court proceedings involving the ’678 patent:

- *Feit Electric Co., Inc. v. Savant Technologies LLC d/b/a GE Lighting*, No. 1:24-cv-473 (N.D. Ohio) (“Ohio Litigation”);
- *Feit Electric Co., Inc. v. LEDVANCE, LLC*, No. 5:24-cv-31 (E.D. Ky.) (“Kentucky Litigation”); and
- *Feit Electric Co., Inc. v. Elong International USA Inc. and Xiamen Longstar Lighting Co. Ltd.*, No. 3:24-cv-1089 (N.D. Tex.) (“Texas Litigation”).

Paper 64, 1; Paper 65, 2–3.

Between January 23, 2025 and April 16, 2025, the Petitioners all made arguments in their respective district court litigations that the claim term “improves an off-state white appearance”/“improves an OFF state white appearance” found in all of the challenged claims was indefinite under 35 U.S.C. § 112(b). Mot. 4–5 (citing Ex. 2051, 6–13 (Kentucky Litigation); Ex. 2054, 3–7 (Ohio Litigation); Ex. 2053, 2–7 (Texas Litigation)).

Subsequently, the district court in the Texas Litigation issued a claim construction order finding the disputed claim term was not indefinite. *See* Ex. 1044, 6–11 (Texas Litigation Markman Order).

The Ohio Litigation was stayed April 1, 2025, without resolving this issue. Paper 65, 3 (citing Ex. 1067). The Kentucky Litigation was stayed April 2, 2025, without resolving this issue. *Id.* at 2 (citing Ex. 1066). The

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Texas Litigation was stayed November 21, 2025, and dismissed pursuant to a settlement agreement on January 30, 2026. *Id.* at 3 (citing Ex. 1068 (stay); Ex. 1087 (dismissal)).

C. Board Trial Proceedings

After institution, Patent Owner filed contingent motions to amend the challenged claims in both proceedings. *See* IPR2024-01357, Paper 27 (Motion to Amend), Paper 35 (Supplemental Motion to Amend). In opposition to the motions to amend, Petitioner argued that the term “improves an off-state white appearance” was indefinite under § 112(b). Paper 41, 7. On October 24, 2025, we issued Preliminary Guidance that agreed with the district court claim construction order from the Texas Litigation, and found that “improves an off-state white appearance” in the proposed substitute claims was not shown to be indefinite under § 112(b). *See* Paper 42, 19–20 (citing Ex. 1044, 7).

Patent Owner has filed a Revised Motion to Amend in response to our Preliminary Guidance. *See* Paper 46. Petitioner filed an opposition to Patent Owner’s Revised Motion to Amend, which did not argue that “improves an off-state white appearance” was indefinite. *See* Paper 49.

D. Revvo and Tesla Decisions

On November 3, 2025, the Director issued a precedential Director Review decision in *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 (Director Nov. 3, 2025) (precedential). In *Revvo*, the Director held that “[a]lthough the Board’s trial rules ‘do not necessarily prohibit petitioners from taking inconsistent claim construction positions before the Board and a district court,’ when a petitioner takes alternative positions before the Board and a district court, that petitioner should, at a

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minimum, explain why alternative positions are warranted.” *Id.* at 3–4; *see also id.* at 5 (“Thus, although a petitioner is not necessarily precluded from arguing different claim construction positions before a district court and the Board, the petitioner should explain sufficiently why the different positions are warranted, even in instances that do not implicate Section 112(f).”). The Director noted that “[f]or example, if a party advances a narrow construction in the district court and the district court declines to adopt the narrow construction, the party would have sufficient reason for advancing the broader, court-adopted construction in a proceeding before the Board.” *Id.* (quoting *Sun Pharm. Indus. Inc. v. Nivagen Pharm., Inc.*, IPR2025-00893, Paper 18, at 3 (Director Sept. 19, 2025)(informative)). “Simply noting that the petitioner is adopting a patent owner’s claim construction proposals from district court, however, is not a sufficient reason for advancing different positions in the two forums.” *Id.*

On November 5, 2025, the Director issued a Director Review decision in *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 (Director Nov. 5, 2025) (informative). In that decision, the Director addressed a situation where the Petitioner asserted a claim limitation was indefinite in the district court, but argued for the plain and ordinary meaning before the Board. *Id.* at 2. The Director reiterated the holding of *Revvo* that a Petitioner must explain why different claim constructions are warranted between the two forums. *Id.* at 3. The Director held that “Petitioner’s statement that it cannot raise indefiniteness challenges in an *inter partes* review is not a sufficient explanation,” and that “the statement amounts to an assertion that a petitioner should be permitted to raise inconsistent invalidity challenges in the two forums.” *Id.* The Director also explained that

“Petitioner’s explanation may have risen to a sufficient level, for example, if Petitioner had shown that, notwithstanding the alleged indefiniteness of the claim term, an ordinarily skilled artisan would understand that the asserted art satisfies the claim limitation (such as if the limitation prescribed a range and only the outer bounds of the range were unclear).” *Id.* at 3–4. The Director determined that “[i]nstead, Petitioner argued indefiniteness in the district court and then adopted Patent Owner’s plain and ordinary meaning construction from the district court litigation in its Petition.” *Id.* at 4. The Director held that “[a]llowing petitioner to advance a claim construction before the Board when that petitioner has made inconsistent indefiniteness arguments in district court fails to further, but instead detracts from, the Office’s goal of ‘providing greater predictability and certainty in the patent system.’” *Id.* (citing *Revvo*, at 4–5). Thus, the Director found that denial of institution was appropriate in that case. *Id.*

E. Patent Owner’s Request for Director Review

On November 14, 2025, Patent Owner filed a request for Director Review seeking, *inter alia*, vacatur of our decisions to institute trial in these proceedings under *Revvo* because of the Petitioner’s allegedly inconsistent claim construction proceedings. *See* Paper 47. On November 18, 2025, the Director notified the parties, by email, that Patent Owner’s request for Director Review of our institution decisions was untimely, and would not be considered. *See* Ex. 3101. Patent Owner subsequently requested a good cause extension of the deadline to file Director Review, but that was also denied. *See* Ex. 3102.

II. PARTIES' ARGUMENTS

A. Patent Owner's Arguments

Patent Owner argues that “[a]ll four Petitioners took contradictory claim construction positions in parallel district court proceedings yet chose not to explain these contradictions to the Board in their Petitions.” Mot. 6. Patent Owner contends that “Petitioners’ failure to explain their contradictions in the Petitions warrant vacatur of the institution Decisions and termination of the consolidated *inter partes* review.” *Id.* (citing *Revvo*, at 3–5; *Tesla*). Patent Owner asserts that we should not permit Petitioner to abandon its positions, but instead, we should deny institution. *Id.* at 8–9. Patent Owner further argues that Petitioner’s explanation should have been in its Petition, and so we should reject any belated explanation. *Id.* at 9–10.

B. Petitioner's Arguments

Petitioner argues that, consistent with *Tesla*, Patent Owner’s motion should be denied because “there is no dispute (in Patent Owner’s Response or in any other paper filed after institution) that the prior art discloses the ‘improved off state white appearance’ limitation.” Opp. 1, 4. Petitioner further argues that Patent Owner’s motion to terminate is untimely, and that its stipulation to be bound by the Board’s claim construction determination, including any rejection of indefiniteness, “resolves any chance of duplication of effort, additional expense for the parties or risk of inconsistent decisions arising from the district court cases (all of which have been stayed pending the outcome of these proceedings or dismissed).” *Id.* at 1. Petitioner asserts that it did not violate any requirement to disclose because, at the time of filing of both petitions, no claim construction briefs had been filed in the district court proceedings. *Id.* at 5. Petitioner submits that the

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Board also fully considered its claim construction arguments in its preliminary guidance addressing Patent Owner’s motion to amend. *Id.* at 7–8. Finally, Petitioner notes that the case is at an advanced stage and one district court case is dismissed and the others are stayed, and it represents that it “will be bound by the Board’s claim construction determination in these proceedings, including its rejection of indefiniteness.” *Id.* at 9.

Petitioner contends that such stipulations were accepted by the Director in other cases. *Id.* at 10 (citing *Samsung Elecs. Co. Ltd. v. Wilus Inst. Of Standards & Tech. Inc.*, IPR2025-00933, Paper 14, at 6 (Director Dec. 31, 2025); *Caption Health, Inc. v. Univ. of British Columbia*, IPR2025-01422, Paper 15, at 3 (Director Dec. 18, 2025)).

III. ANALYSIS

We find that we lack authority to grant the relief Patent Owner requests. *See Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 76 (PTAB Mar. 4, 2026) (denying motion to terminate because the Board lacked authority to decide discretionary issues), *cited with approval in Berkshire Hathaway Energy Co. v. Birthtech Corp.*, IPR2025-00274, Paper 81 (Director Mar. 27, 2026) (noting “the Board correctly determined that it lacked the authority in these IPRs to terminate parallel proceedings challenging the same patents because, under current policy, the Director makes determinations on discretionary issues”). On March 26, 2025, the Acting Director issued a Memorandum on Interim Processes for

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PTAB Workload Management (“Interim Process Memo”).² The Acting Director stated:

[D]ecisions on whether to institute an IPR or PGR will be bifurcated between (i) discretionary considerations and (ii) merits and other non-discretionary statutory considerations. Under this interim procedure, the Director, in consultation with at least three PTAB judges, will determine whether discretionary denial of institution is appropriate. If it is appropriate, the Director will issue a decision denying institution. If it is not appropriate, the Director will issue a decision regarding that determination and refer the petition to a three-member panel of the PTAB assigned according to Standard Operating Procedure (SOP) 1 (Rev. 16). The three-member panel will then handle the case in the normal course.

Interim Process Memo at. 1. Although the Interim Process Memo only applies to “proceedings where the deadline to file a preliminary repose has not yet passed” (Interim Process Memo at 2),³ in a subsequent memorandum, the Director restored his authority to exclusively determine discretionary institution issues in all proceedings. *Director Institution of AIA Trial Proceedings* (Oct. 17, 2025), available at https://www.uspto.gov/sites/default/files/documents/Director_Institution_of_AIA_Trial_Proceedings.pdf (“Director Institution Memo”).

The Interim Process Memo and Director Institution Memo, thus, reserves consideration of discretionary issues to the Director. The relief Patent Owner requests is that we exercise discretion to terminate these

² *Interim Processes for PTAB Workload Management* (Mar. 26, 2025), available at: <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>.

³ This process applies to IPR2025-00260. *See* IPR2025-00260, Paper 14 (PTAB May 19, 2025) (Discretionary Denial Order).

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proceedings based on *Revvo* and *Tesla*. *See generally* Mot. Because the basis for Patent Owner’s requested relief is discretionary, we lack the authority to grant Patent Owner’s request. In this regard, the present situation is different from that in *Revvo*. In that case, the Director explicitly instructed the Board “to determine whether Petitioner has provided a sufficient reason why different claim construction positions are warranted.” *Revvo*, at 5. The Director has not made such a determination or delegated such authority to the panel in this case. Indeed, at least in IPR2025-00260, Patent Owner has already briefed, and the Director has already ruled on, discretionary denial issues. IPR2025-00260, Paper 13 (Patent Owner’s Brief Regarding Discretionary Denial); Paper 16 (Director’s Decision referring the case to the merits panel).

Accordingly, we deny Patent Owner’s Motion to Terminate for Failure to Disclose Contradictory Claim Construction Positions Taken in the District Court.

IV. ORDER

Accordingly, it is

ORDERED that Patent Owner’s Motion to Terminate for Failure to Disclose Contradictory Claim Construction Positions Taken in the District Court (Paper 56) is *denied*.

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FOR PETITIONER:

David Radulescu
Andrew Brown
RADULESCU LLP
david@radip.com
andy@radip.com

FOR PATENT OWNER:

Charles McMahon
Thomas DaMario
CARTER ARNETT BENNETT & PEREZ PLLC
cmcMahon@beneschlaw.com
tdamario@beneschlaw.com