

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MENARD, INC.,
Petitioner,

v.

SIGNIFY HOLDINGS B.V.,
Patent Owner.

IPR2024-01469
Patent 10,299,336 B2

Before CHRISTOPHER M. KAISER, KEVIN C. TROCK, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

AMUNDSON, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314
Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

Menard, Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–20 in U.S. Patent No. 10,299,336 B2 (“the ’336 patent”) (Exhibit 1001) under 35 U.S.C. §§ 311–319. Paper 1 (“Pet.”). Signify Holdings B.V. (“Patent Owner”) did not file a Preliminary Response.

Concurrently with the Petition, Petitioner filed a Motion for Joinder seeking joinder as a party in *Luminex International Co., Ltd. v. Signify Holdings B.V.*, IPR2024-00101 (the “Luminex IPR”). Paper 2 (“Mot.”). Patent Owner did not respond to Petitioner’s Motion for Joinder.

Under 37 C.F.R. § 42.4(a), we have authority to determine whether to institute an *inter partes* review. We may institute an *inter partes* review only if “the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2024). The “reasonable likelihood” standard is “a higher standard than mere notice pleading” but “lower than the ‘preponderance’ standard to prevail in a final written decision.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 13 (PTAB Dec. 20, 2019) (precedential).

We also have authority to consider Petitioner’s Motion for Joinder. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122 (2024).

Based on the current record and for the reasons explained below, we (1) institute an *inter partes* review of claims 1–20 in the ’336 patent on all challenges included in the Petition and (2) grant Petitioner’s Motion for Joinder subject to the conditions detailed below.

II. BACKGROUND

A. Real Parties in Interest

Petitioner identifies itself as the sole real party in interest. Pet. 89. Patent Owner identifies the following real parties in interest: Signify Holdings B.V. and Signify North America Corp. Paper 6, 2. The parties do not raise any issue about real parties in interest.

B. Related Matters

Petitioner and Patent Owner identify the following civil action as a related matter involving the '336 patent: *Signify North America Corp. et al. v. Menard, Inc.*, No. 3:22-cv-00706 (W.D. Wis. filed Aug. 12, 2022). Pet. 90; Paper 6, 2. Further, Petitioner and Patent Owner identify the Luminex IPR as a related matter involving the '336 patent. Pet. 90; Paper 6, 2.

C. The '336 Patent (Exhibit 1001)

The '336 patent, titled “Configurable Lighting System,” issued on May 21, 2019, from an application filed on June 21, 2018. Ex. 1001, codes (22), (45), (54). The patent identifies that application as a continuation-in-part of an application filed on November 13, 2017 (later issued as U.S. Patent No. 10,299,335 B2 (Exhibit 1023)), that was a continuation of an application filed on February 16, 2017 (later issued as U.S. Patent No. 9,820,350 B2). *Id.* at 1:6–11, code (63). The '336 patent states that “the technology relate[s] generally to lighting systems and more specifically to lighting systems that can be readily configured to produce illumination of different color temperatures.” *Id.* at 1:19–22.

The '336 patent explains that luminaires incorporating incandescent or fluorescent technology provide some flexibility to meet user preferences

through lamp selection “in terms of correlated color temperature (CCT or color temperature) and light output (lumen output).” Ex. 1001, 1:31–36. The patent also explains that “light emitting diodes (LEDs) offer substantial potential benefit associated with their energy efficiency, light quality, and compact size.” *Id.* at 1:26–28.

According to the ’336 patent, however, “conventional light-emitting-diode-based luminaires typically offer reduced flexibility when the luminaire’s light-emitting-diode-based light source is permanently attached to the luminaire.” Ex. 1001, 1:42–45. For instance, “[s]tocking conventional light-emitting-diode-based luminaires at distribution to accommodate multiple configurations that users may desire can entail maintaining a relatively large or cumbersome inventory.” *Id.* at 1:45–49.

The ’336 patent identifies a need for a light-emitting-diode system “that can adapt to various applications, for example by delivering multiple color temperatures, multiple lumens, and/or multiple photometric distributions” so that “a single luminaire [may] be stocked at distribution and then quickly configured according to application parameters and deployment dictates.” Ex. 1001, 1:50–57. The ’336 patent endeavors to address that need by providing a luminaire including a housing, an electrical cable, and a switch coupled to the electrical cable with the switch “disposed remotely from the housing” and having “multiple positions” such that “each position of the switch corresponds to a discrete correlated color temperature (CCT) output by one or more light sources of the luminaire.” *Id.* at code (57).

The '336 patent's Figure 8 (reproduced below) depicts a luminaire "currently known in the art":

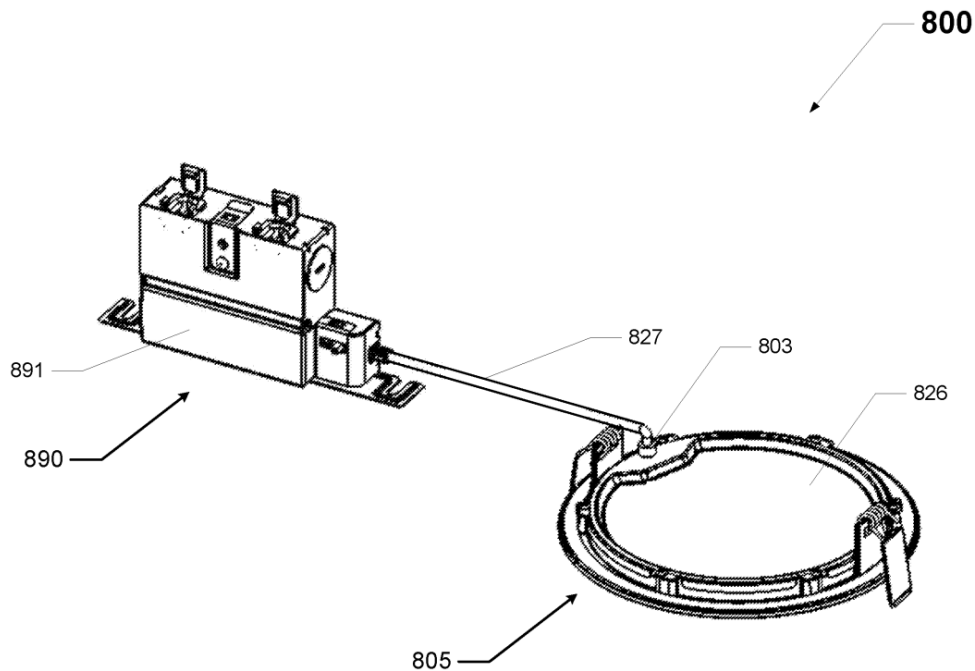


FIG. 8
(PRIOR ART)

Figure 8 illustrates "currently known" luminaire 800 with the following components:

- low-profile housing 805 having wiring aperture 803 in cover 826;
- electrical cable 827 extending through wiring aperture 803 in cover 826 and including "one or more electrical conductors to transfer power, control, communication, data, and/or any other type of electrical signals"; and
- junction box 890 located remotely from housing 805 and including "one or more walls 891 to enclose one or more electrical components (e.g., a driver)."

Ex. 1001, 3:24–25, 10:66–11:9, Fig. 8. The “electrical cable 827 electrically couples one or more electrical components in the junction box 890 with one or more electrical components in or on the housing 805,” such as light sources. *Id.* at 11:9–12, 11:17–20, Fig. 8.

The '336 patent's Figure 9B (reproduced below) depicts a luminaire with a switch according to “certain example embodiments”:

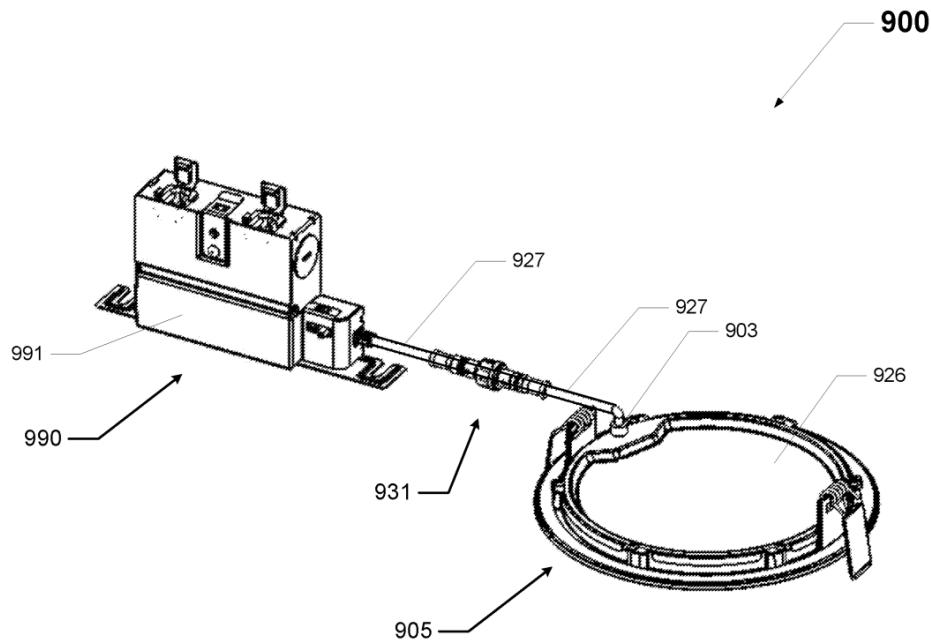


FIG. 9B

Figure 9B illustrates luminaire 900 with the following components:

- low-profile housing 905 having wiring aperture 903 in cover 926;
- electrical cable 927 extending through wiring aperture 903 in cover 926 and including “one or more electrical conductors to transfer power, control, communication, data, and/or any other type of electrical signals”;
- switch 931 located “outside of the housing 905” and “in-line with the electrical cable 927”; and

- junction box 990 located remotely from housing 905 and including “one or more walls 991 to enclose one or more electrical components (e.g., a driver).”

Ex. 1001, 3:26–27, 11:30–38, 11:44–47, 11:63–66, 12:21–23, Fig. 9B.

Luminaire 900 in Figure 9B “is substantially the same as” luminaire 800 in Figure 8 except that luminaire 900 “includes the example switch 931.” *Id.* at 11:25–29.

Housing 905 of luminaire 900 “can be installed in or on any of a number of structure members (e.g., drywall that forms a ceiling, a ceiling tile)” with junction box 990 “located behind the ceiling.” Ex. 1001, 11:42–45. When housing 905 “is mounted in its installed location (e.g., the ceiling), the entire electrical cable 927 (and so also the switch 931) is behind the structure member (e.g., ceiling) and is inaccessible.” *Id.* at 11:51–56. When housing 905 “is removed from its installed location, the junction box 990 and the electrical cable 927 (and so also the switch 931) can be accessible.” *Id.* at 11:58–60.

Switch 931 “can have one or more coupling features (e.g., terminal points) that are used to couple to one or more electrical conductors of one or more electrical cables 927.” Ex. 1001, 11:67–12:3. Switch 931 “can have an actuator having multiple positions” and “a range of selections that are either continuous or discrete.” *Id.* at 12:3–5, 12:16–17.

As examples of switch 931, the ’336 patent discloses a wide variety of devices as follows:

an inline pin switch, multiple DIP [dual inline pin] switches, one or more single in-line pin packages (SIP or SIPP), one or more rocker switches, one or more reed switches, one or more magnetic switches, one or more rotary switches, one or more rotary dials, one or more selectors or selector switches, one or

more slide switches, one or more snap switches, one or more thumbwheels, one or more toggles or toggle switches, one or more keys or keypads, or one or more buttons or pushbuttons.

Ex. 1001, 12:6–15.

The '336 patent's Figure 10 (reproduced below) depicts a luminaire with a switch according to “certain example embodiments”:

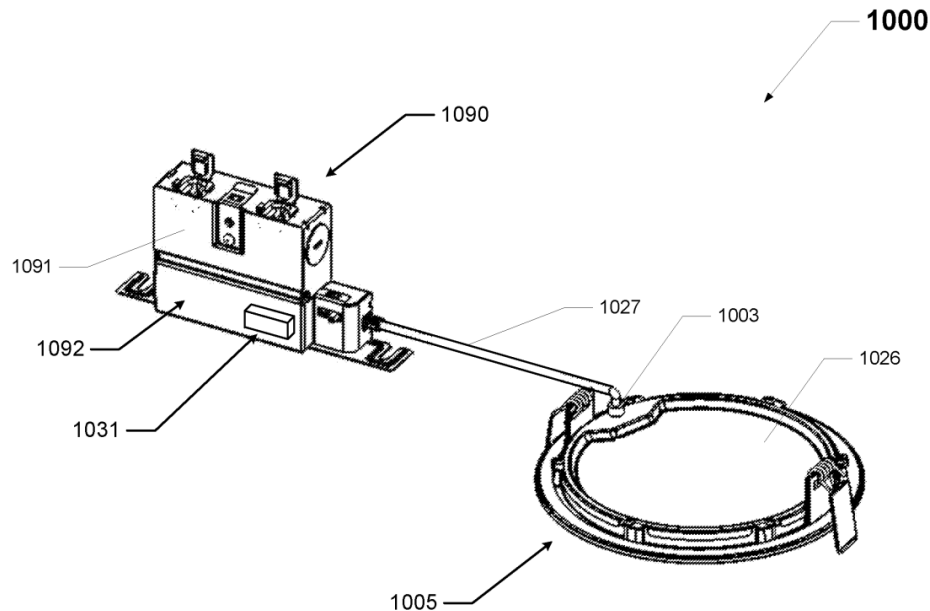


FIG. 10

Figure 10 illustrates luminaire 1000 with the following components:

- low-profile housing 1005 having wiring aperture 1003 in cover 1026;
- electrical cable 1027 extending through wiring aperture 1003 in cover 1026 and including “one or more electrical conductors to transfer power, control, communication, data, and/or any other type of electrical signals”;
- switch 1031; and
- junction box 1090 located remotely from housing 1005 and including “one or more walls 1091” that form

cavity 1092 “to enclose one or more electrical components (e.g., a driver, the switch 1031).”

Ex. 1001, 3:28–29, 12:40–49, 12:56–61, Fig. 10. In Figure 10, “one of the walls of the junction box 1090 is removed to show the switch 1031 disposed within the cavity 1092 formed by the walls 1091 of the junction box 1090.” *Id.* at 12:58–61, Fig. 10. Luminaire 1000 in Figure 10 “is substantially the same as” luminaire 900 in Figure 9 except that switch 1031 in luminaire 1000 “is in a different location separate from the housing 1005.” *Id.* at 12:35–39.

As alternatives to the arrangement shown in Figure 10, “rather than being disposed within the cavity 1092 of the junction box 1090, the switch 1031 can be disposed on a wall 1091 of the junction box 1090 or remotely from the junction box 1090 as well as remotely from the housing 1005 of the luminaire 1000.” Ex. 1001, 13:13–19.

The ’336 patent explains that a luminaire “can comprise a 3,000 K group of light emitting diodes and a 4,000 K group of light emitting diodes.”¹ Ex. 1001, 3:57–59. If so, the luminaire can deliver (1) 3,000 K illumination when “only the 3,000 K group is on,” (2) 4,000 K illumination when “only the 4,000 K group is on,” and (3) 3,500 K illumination when “the 3,000 K group and the 4,000 K group are both on.” *Id.* at 3:59–63. Further, if “the 4,000 K group of light emitting diodes is concurrently operated at a low lumen output and the 3,000 K group is operated at a high lumen output, the luminaire may deliver illumination of another selected color temperature, for example 3,100 K.” *Id.* at 3:63–67.

¹ “K represents Kelvin which is a measure of temperature similar to Fahrenheit and Celsius.” Ex. 1004 ¶ 32.

D. The Challenged Claims

The '336 patent includes 20 claims as follows:

- independent claim 1 for a “luminaire”;
- claims 2–12 that depend directly or indirectly from claim 1;
- independent claim 13 for a “switch for controlling a correlated color temperature (CCT) of light emitted by a luminaire”; and
- claims 14–20 that depend directly or indirectly from claim 13.

Ex. 1001, 14:31–16:27. Petitioner challenges all 20 claims in the '336 patent. Pet. 15–89.

Claims 1 and 13 exemplify the challenged claims and read as follows (with formatting added for clarity and with bracketed numbers and letters added for reference purposes):²

1. A luminaire comprising:

[1a] a housing comprising at least one outer surface that forms a first cavity;

[1b] at least one electrical component disposed, at least in part, within the first cavity;

[1c] an electrical cable comprising a first end and a second end, wherein the first end is coupled to the at least one electrical component; and

[1d] a switch coupled to the electrical cable, wherein the switch is disposed remotely from the housing,

[1e] wherein the switch has a plurality of positions, wherein each position of the plurality of positions of the switch

² We use the same numbers and letters that Petitioner uses to identify the claim language. See Pet. 23–30, 40–45.

corresponds to a discrete correlated color temperature (CCT) output by one or more light sources of the luminaire.

13. A switch for controlling a correlated color temperature (CCT) of light emitted by a luminaire, the switch comprising:

[13a] a body;

[13b] at least one first coupling feature disposed on the body, wherein the at least one first coupling feature is configured to electrically couple to an electrical cable of the luminaire; and

[13c] an actuator disposed on the body, wherein the actuator has a range of positions,

[13d] wherein each position of the range of positions of the actuator corresponds to a CCT of the light emitted by the luminaire.

Ex. 1001, 14:31–45, 15:21–16:5.

E. The Asserted References

For its challenges, Petitioner relies on the following references:

Name	Reference	Exhibit
Chaimberg	US 10,234,091 B1, issued March 19, 2019 (based on an application filed April 27, 2018)	1003
Roberge	US 7,178,941 B2, issued February 20, 2007 (based on an application filed May 5, 2004)	1011
Halliwell	US 9,801,250 B1, issued October 24, 2017 (based on an application filed September 23, 2016)	1012
Reiff	US 7,192,160 B2, issued March 20, 2007 (based on an application filed July 12, 2004)	1013

Pet. 15–89. Petitioner asserts that each reference qualifies as prior art “under at least 35 U.S.C. § 102(a)(2).” *Id.* at 16, 47, 60, 82; *see* 35 U.S.C. § 102(a)(2).³

F. The Asserted Challenges to Patentability

Petitioner asserts the following challenges to patentability:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 3, 6–9, 11–13, 15, 17–19	102 or 103	Chaimberg
2, 4, 5, 10, 14, 16, 20	103	Chaimberg, Roberge
1, 2–5, 7, 9–13, 15, 16, 19, 20	102 or 103	Halliwell
13, 15	102 or 103	Reiff

Pet. 15–89.

F. Testimonial Evidence

To support its challenges, Petitioner relies on the declaration of J. Gary Eden, Ph.D. (Exhibit 1004). Dr. Eden states, “I received the B.S.

³ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. § 102 and § 103 effective March 16, 2013. Petitioner contends that the challenged claims are “entitled to a priority date no earlier than” the June 21, 2018, filing date for the continuation-in-part application that issued as the ’336 patent. *See* Pet. 16, 18–23, 60. Patent Owner bears the burden of establishing the benefit of priority based on an earlier filed application. *See, e.g., In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1376 (Fed. Cir. 2016); *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1380 (Fed. Cir. 2015). Patent Owner did not file a Preliminary Response and, therefore, did not dispute Petitioner’s contention concerning the priority date for the challenged claims. Thus, this decision refers to the post-AIA versions of § 102 and § 103. But our analysis would not change under the pre-AIA versions of § 102 and § 103.

degree in Electrical Engineering from the University of Maryland (College Park) in 1972, the M.S. degree in Electrical Engineering in from the University of Illinois (Urbana) in 1973, and the Ph.D. degree in Electrical Engineering from the University of Illinois in 1976.” Ex. 1004 ¶ 6.

III. ANALYSIS

A. Statutory and Regulatory Provisions

Regarding joinder, § 315(c) permits joinder as a party and states:

If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

35 U.S.C. § 315(c).

Regarding timeliness, § 315(b) requires filing a petition for an *inter partes* review no later than “1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” 35 U.S.C. § 315(b). The Board’s rules include the same one-year time bar. 37 C.F.R. § 42.101(b). But § 315(b) also provides that the one-year time bar “shall not apply to a request for joinder” under § 315(c). 35 U.S.C. § 315(b); *see* 37 C.F.R. § 42.122(b).

Consistent with § 315(b) and § 315(c), the Board’s rules state:

Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested. The time period set forth in § 42.101(b) [the one-year time bar] shall not apply when the petition is accompanied by a request for joinder.

37 C.F.R. § 42.122(b).

The “plain language of § 315(c) requires two different decisions.” *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020) (“*Facebook*”). First, § 315(c) requires a determination “whether the joinder applicant’s petition for IPR ‘warrants’ institution under § 314.” *Id.* Second, § 315(c) requires an exercise of discretion “to decide whether to ‘join as a party’ the joinder applicant,” i.e., a joinder decision. *Id.* The statute “makes clear that the joinder decision is made *after* a determination that a petition warrants institution, thereby affecting the manner in which an IPR will proceed.” *Id.* (emphasis in original).

B. Whether the Petition Warrants Institution

1. THE “REASONABLE LIKELIHOOD” STANDARD FOR INSTITUTING TRIAL

In the Luminex IPR Institution Decision, we determined that Luminex International Co., Ltd. (“Luminex”) satisfied the “reasonable likelihood” standard for instituting trial. IPR2024-00101, Paper 14 (“Luminex Inst. Dec.”) at 2, 19–64.

Here, Petitioner presents substantively identical challenges to claims 1–20 in the ’336 patent based on the same prior art, the same evidence, and the same unpatentability theories as Luminex presents in the Luminex IPR. *Compare* Pet. 15–89, *with* IPR2024-00101, Paper 1 (“Luminex Pet.”) at 15–89. According to Petitioner, the Petition differs from Luminex’s petition only because of different party names and updated sections concerning standing, related matters, real parties in interest, and counsel. Mot. 4.

Because Petitioner presents substantively identical challenges to claims 1–20 in the ’336 patent based on the same prior art, the same evidence, and the same unpatentability theories as Luminex presents in the

Luminex IPR, Petitioner satisfies the “reasonable likelihood” standard for instituting trial for the same reasons Luminex satisfied the “reasonable likelihood” standard for instituting trial. *See* Luminex Pet. 15–89; Luminex Inst. Dec. 19–64; Pet. 15–89.

2. TIMELINESS

Referencing § 315(b)’s one-year time bar, the Federal Circuit has explained that § 315(b) “includes a specific exception to the time bar” because “[b]y its own terms, ‘[t]he time limitation . . . shall not apply to a request for joinder under subsection (c).’” *Facebook*, 973 F.3d at 1333 (alterations in original) (quoting 35 U.S.C. § 315(b)).

Consistent with § 315(b) and § 315(c), the Board’s rules provide that “[a]ny request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested.” 37 C.F.R. § 42.122(b). The Board’s rules also provide that § 42.101(b)’s one-year time bar “shall not apply when the petition is accompanied by a request for joinder.” *Id.*

We instituted an *inter partes* review in the Luminex IPR on September 9, 2024. Luminex Inst. Dec. 1. On September 23, 2024, Petitioner filed the Petition and the Motion for Joinder. Pet. 91; Mot. 7. Under § 42.122(b), Petitioner timely filed the Petition and the Motion for Joinder. *See* 37 C.F.R. § 42.122(b).

3. CONCLUSION WHETHER THE PETITION WARRANTS INSTITUTION

Because (1) Petitioner satisfies the “reasonable likelihood” standard for instituting trial and (2) Petitioner timely filed the Petition and the Motion for Joinder, the Petition “warrants the institution of an *inter partes* review

under section 314.” *See* Luminex Pet. 15–89; Luminex Inst. Dec. 19–64; Pet. 15–89; 35 U.S.C. § 315(c).

D. Whether to Grant Petitioner’s Motion for Joinder

1. INTRODUCTION

As the movant, Petitioner bears “the burden of proof to establish that it is entitled to the requested relief.” 37 C.F.R. § 42.20(c); *see* 37 C.F.R. § 42.122(b).

A joinder motion should:

- (1) “set forth the reasons joinder is appropriate”;
- (2) “identify any new grounds of unpatentability asserted in the petition”; and
- (3) “explain what impact (if any) joinder would have on the trial schedule for the existing review.”

See, e.g., AT&T Corp. v. Dali Wireless Inc., IPR2023-00818, Paper 8 at 8 (PTAB Aug. 14, 2023) (citing *Kyocera Corp. v. SoftView LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013)); *Hyundai Motor Am. v. StratosAudio, Inc.*, IPR2022-00224, Paper 11 at 7 (PTAB June 2, 2022) (citing *Kyocera*).

2. THE REASONS JOINDER IS APPROPRIATE

Petitioner asserts that joinder is appropriate because the Petition:

- (1) “is substantially identical to the petition in the Luminex IPR”;
- (2) “involves the same patent, same claims, same grounds of unpatentability, and the same evidence (including the same prior art combinations supported by the same expert declaration) as the Luminex IPR”;
- (3) “does not raise any new grounds of unpatentability”; and

- (4) “does not present issues that might complicate or delay the Luminex IPR.”

Mot. 1, 4.

Petitioner contends that joinder to the Luminex IPR will “have little, if any, impact on the Luminex IPR, the schedule would not be affected, no additional briefing or discovery would be required, and no additional burdens would be placed on any party” or the Board. Mot. 4. Petitioner also contends that joinder to the Luminex IPR will not prejudice Patent Owner or impose an additional burden on Patent Owner. *Id.* at 7. Petitioner explains that “Patent Owner need not expend any additional resources above and beyond those required in the current Luminex IPR.” *Id.*

For the reasons stated by Petitioner, we agree that joinder to the Luminex IPR is appropriate. *See* Mot. 1, 4, 7.

3. WHETHER THE PETITION RAISES NEW ISSUES

Petitioner asserts that the Petition does not raise new issues because the Petition “involves the same patent, same claims, same grounds of unpatentability, and the same evidence (including the same prior art combinations supported by the same expert declaration) as the Luminex IPR.” Mot. 1; *see id.* at 4–5.

For the reasons stated by Petitioner, we agree that the Petition does not raise new issues. *See* Mot. 1, 4–5.

4. THE IMPACT JOINDER WOULD HAVE ON THE TRIAL SCHEDULE FOR THE LUMINEX IPR

If joined to the Luminex IPR, Petitioner agrees to take an “understudy” role and only “substantively participate” if Luminex is terminated from the Luminex IPR. Mot. 1, 5–6. Further Petitioner agrees

that the following conditions will apply to it in its “understudy” role “so long as Luminex remains an active party”:

- (1) “all filings by [Petitioner] in the joined proceeding be consolidated with the filings of Luminex, unless a filing solely concerns issues that do not involve Luminex”;
- (2) Petitioner “shall not be permitted to raise any new grounds not instituted by the Board in the Luminex IPR, or introduce any argument not already introduced by Luminex”; and
- (3) “with regard to taking of testimony, [Petitioner] will abide by 37 C.F.R. § 42.53 or any agreement between the Patent Owner and Luminex.”

Id. at 6.

Therefore, according to Petitioner, “joinder would have no impact on the trial schedule for the Luminex IPR.” Mot. 3 n.1; *see id.* at 5.

For the reasons stated by Petitioner, we agree that joinder to the Luminex IPR will not materially affect the trial schedule for the Luminex IPR. *See* Mot. 1, 3 n.1, 5–6.

5. CONCLUSION

For the reasons discussed above, we determine that it is appropriate under the circumstances here to join Petitioner as a party to the Luminex IPR. *See* §§ III.D.2–III.D.4. The estoppel provisions of 35 U.S.C. § 315(e) will apply to Petitioner.

IV. CONCLUSION

For the reasons discussed in the Luminex IPR Institution Decision, we determine that there is a reasonable likelihood Petitioner would prevail with respect to at least one claim challenged in the Petition. *See* Luminex Inst. Dec. 19–64. We conclude that instituting an *inter partes* review in this

proceeding is in the interest of efficient administration of the Office and the integrity of the patent system. *See* 35 U.S.C. § 316(b). Hence, we institute an *inter partes* review of all challenged claims on all challenges included in the Petition. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018) (noting that the language of 35 U.S.C. § 314(b) “indicates a binary choice—either institute review or don’t”); *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (interpreting the statute as requiring “a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition”); 37 C.F.R. § 42.108(a).

At this preliminary stage, we have not made a final determination about the patentability of any challenged claim, the construction of any claim term, phrase, or limitation, or any other legal or factual issue.

Upon considering the papers and evidence presented, we determine that it is appropriate under the circumstances here to join Petitioner as a party to the Luminex IPR. Joinder to the Luminex IPR will result in the just, speedy, and inexpensive resolution of Petitioner’s challenge. *See* 37 C.F.R. § 42.1(b). Thus, for the reasons discussed above, we grant Petitioner’s Motion for Joinder and join Petitioner as a party to the Luminex IPR.

V. ORDER

Accordingly, it is

ORDERED that, according to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–20 in the ’336 patent is instituted on all challenges included in the Petition;

FURTHER ORDERED that, according to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial that commences on the entry date of this decision;

FURTHER ORDERED that Petitioner's Motion for Joinder (Paper 2) is granted, and Petitioner is hereby joined as a petitioner in IPR2024-00101;

FURTHER ORDERED that the instituted grounds for trial in IPR2024-00101 are unchanged, and no other grounds are added in IPR2024-00101;

FURTHER ORDERED that the Scheduling Order entered in IPR2024-00101 (Paper 15), including any schedule changes allowed by the Scheduling Order and agreed by the parties in that proceeding, shall continue to govern the trial schedule in IPR2024-00101;

FURTHER ORDERED that Petitioner's role in IPR2024-00101 shall be limited as stated in Petitioner's Motion for Joinder (Paper 2) unless and until Luminex International Co., Ltd. is terminated from IPR2024-00101;

FURTHER ORDERED that the case caption in IPR2024-00101 shall be changed to reflect joinder of Menard, Inc. as a petitioner according to the attached example;

FURTHER ORDERED that a copy of this decision be entered into the record of IPR2024-00101; and

FURTHER ORDERED that all further filings shall be made in IPR2024-00101.

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[Example Case Caption]

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUMINEX INTERNATIONAL CO., LTD.
and MENARD, INC.,
Petitioner,*

v.

SIGNIFY HOLDINGS B.V.,
Patent Owner.

IPR2024-00101
Patent 10,299,336 B2

* Menard, Inc. filed a petition and a motion for joinder in IPR2024-01469 and has been joined as a petitioner in this proceeding.