

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

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

v.

SIGNIFY HOLDINGS B.V.,
Patent Owner.

IPR2024-00101
Patent 10,299,336 B2

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent and Trademark Office.*

ORDER

Signify Holdings B.V. (“Patent Owner”) filed a request for Director Review of the Final Written Decision (“Decision,” Paper 47), and Luminex International Co., Ltd. and Menard, Inc. (collectively, “Petitioner”) filed an authorized response to the request. *See* Papers 49 (“Request”), 52.

Claim 13 requires a switch comprising “a body” and “at least one first coupling feature disposed on the body . . . configured to electrically couple to an electrical cable.” *See, e.g.*, Ex. 1001, 15:21–28. The Petition asserted that claim 13 is anticipated by or obvious over Reiff,¹ arguing that Reiff’s control box “provides and necessarily includes a body for the switch.” *See* Paper 1, 15, 85. Patent Owner argued in the Response that the Petition was deficient because “Reiff does not disclose a ‘coupling feature disposed on the body’” (the “disputed limitation”). Paper 29, 40–42 (contending that Petitioner’s expert “conceded that the control box is *not* a switch body”). The Board found that although Petitioner established that Reiff teaches the disputed limitation for obviousness, Petitioner failed to meet its burden for anticipation because Petitioner did not establish that Reiff’s switch “is ‘disposed on the body’ instead of ‘disposed in the body.’” Decision 151.

In the Request, Patent Owner reiterates that the Petition was deficient because it fails to address how Reiff’s coupling feature was “disposed on the body.” Request 5. Patent Owner also argues that the Petition contains “identifications” referring to Reiff as anticipating or rendering obvious claim 13 in its chart of grounds, but that Petitioner did not present any obviousness arguments until the Reply. *Id.* at 6 (citing Paper 35, 30). Thus, Patent Owner contends that the Board incorrectly determined that Petitioner

¹ US 7,192,160 B2, issued Mar. 20, 2007 (Ex. 1013).

established by a preponderance of the evidence that claim 13 is unpatentable as obvious. *Id.* at 11.

Petitioner responds that “[w]hether labeled anticipation or single-reference obviousness,” the Board correctly found that Reiff teaches the limitations of claim 13. Paper 52, 2. Petitioner further contends that its Reply argument was a proper response to Patent Owner’s argument in the Response that “Reiff does not disclose a ‘coupling feature disposed on the body.’” *Id.* at 13 (quoting Paper 29, 40–41).

Having considered the request and the response, the Decision warrants further review by a Delegated Rehearing Panel (“DRP”). The Board’s fact finding that Reiff does not teach the disputed limitation for anticipation but does teach the disputed limitation for obviousness appears to be inconsistent and rely on improper gap filling. Additionally, it appears that Petitioner did not specifically argue the disputed limitation in the Petition and that the Reply may rely on additional argument and evidence that is outside the proper scope of a reply. Accordingly, Director Review of the Decision is delegated to a DRP to review the Decision and determine whether the Board misapprehended or overlooked these issues, or otherwise erred.

Absent good cause, the DRP shall issue a decision within 60 days of this Order.

Accordingly, it is:

ORDERED that the request for Director Review is delegated to a DRP.

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