

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

**ELONG INTERNATIONAL USA INC. AND
XIAMEN LONGSTAR LIGHTING CO. LTD.**
Petitioners,

v.

FEIT ELECTRIC COMPANY, INC.,
Patent Owner.

Case No. IPR2025-00258
Patent No. 8,604,678

**MOTION FOR JOINDER TO IPR2024-01357 PURSUANT
TO 35 USC § 325(c) AND 37 CFR §§ 42.22 and 42.122(b)**

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I. PRECISE RELIEF REQUESTED

Elong International USA Inc. and Xiamen Longstar Lighting Co. Ltd. (“Petitioners”) submit this motion for joinder, together with a petition (“the Elong petition”) for *inter partes* review of U.S. Patent No. 8,605,678 (“the ’678 patent”). Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b), Petitioners request institution of an *inter partes* review and joinder with the *inter partes* review in *Savant Techs. LLC d/b/a GE Lighting et al. v. Feit Elec. Co.*, IPR2024-01357.

The Elong petition is narrowly tailored to the same claims, prior art, and grounds for unpatentability that are the subject of IPR2024-01357. Petitioners submit that joinder is appropriate because it will not unduly burden or prejudice the parties to IPR2024-01357 while efficiently resolving the question of the validity of the ’678 patent in a single proceeding.

Petitioners’ motion for joinder is timely under 37 C.F.R. §§ 42.22 and 42.122(b) because the Board has not yet issued an institution decision in IPR2024-01357. *Blue Coat Systems, Inc. v. Finjan, Inc.*, IPR2016-00480, Paper 9 at 7 (PTAB June 24, 2016) (granting motion for joinder and rejecting patent owner’s contention that joinder motion filed before institution was premature).

To the extent that IPR2023-01357 terminates prior to the Board’s decision on this motion, rendering this motion moot, Petitioners respectfully request that the Board evaluate the Elong petition on the merits.

II. MATERIAL FACTS

1. On February 2, 2024, Patent Owner filed an infringement action against Ledvance, LLC, *Feit Electric Company, Inc. v. Ledvance, LLC*, No. 5:24-cv-31 (E.D. Ky.), asserting the ’678 patent.

2. On March 13, 2024, Patent Owner filed an infringement action against Savant Technologies LLC d/b/a GE Lighting, *Feit Electric Company, Inc. v. Savant Technologies LLC d/b/a GE Lighting*, No. 1:24-cv-473 (N.D. Ohio), asserting the ’678 patent.

3. On May 6, 2024, Patent Owner filed an infringement action against Petitioners, *Feit Electric Company, Inc. v. Elong Int’l USA Inc. et al.*, No. 3:24-cv-1089 (N.D. Tex.), asserting the ’678 patent. On Oct. 23, 2024, Patent Owner served its Disclosure of Asserted Claims and Preliminary Infringement Contentions first identifying the claims of the ’678 patent that it was asserting Petitioners.

4. On August 26, 2024, Ledvance and Savant (“the IPR2024-01357 petitioners”) filed their petition request *inter partes* review of claims 1-3, 6, 7, 9, 10, 16-21, 25, 26, and 29 of the ’678 patent.

5. The IPR2024-01357 petition and the Elong petition are substantively identical. They contain the same grounds based on the same prior art combinations against the same claims. They rely on the same evidence, including the same expert declaration.

6. Petitioners have conferred with the IPR2024-01357 petitioners, and they do not oppose this motion.

III. REASONS FOR REQUESTED RELIEF

A. Legal Standard

Pursuant to 35 U.S.C. § 315(c), the Board may grant a motion for joining an *inter partes* review petition with another *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). The Board, in determining whether to exercise its discretion to grant joinder, considers whether the joinder motion: (1) sets forth the reasons why joinder is appropriate; (2) identifies any new grounds of unpatentability asserted in the petition; (3) explains what impact (if any) joinder would have on the trial schedule for the existing review; and (4) addresses specifically how briefing and discovery may be simplified. *Dell, Inc. v. Network-1 Security Solutions, Inc.*, IPR2013-00385, Paper No. 17 at 4 (PTAB July 29, 2013).

B. The Relevant Factors Weigh in Favor of Joinder

All four factors weigh in favor of granting this motion. The Elong petition is substantively identical to the IPR2024-01357 petition. Petitioners do not present any new grounds of unpatentability.

Because all substantive issues are identical and Petitioners will act as “understudies,” joinder will have no impact on the pending schedule of IPR2024-01357. *See Sony Corp. v. Memory Integrity, LLC*, IPR2015-01353, Paper No. 11 at 6 (Oct. 5, 2015) (granting motion for joinder where petitioners requested an “understudy” role); *see also Samsung Elecs. America, Inc. v. Uniloc 2017 LLC*, IPR2018-01383, Paper No. 9 at 4-5 (Nov. 19, 2018) (granting motion for joinder). Moreover, the briefing and discovery will be simplified by resolving all issues in a single proceeding. Accordingly, joinder should be granted.

1. Joinder with IPR2024-01357 is appropriate

The Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.” *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper No. 12 at 9 (Aug. 24, 2016) (internal quotations and citations omitted). Here, joinder with IPR2024-01357 is appropriate because the Elong petition submits identical arguments and the same grounds as in the existing IPR2024-01357.

More specifically, the Elong petition copies verbatim the challenges set forth in the IPR2024-01357 petition and relies on the same expert declaration. The only differences between the Elong petition and the IPR2024-01357 petition relate to formalities of different parties filing the petitions. There are no other changes to the facts, citations, evidence, or arguments introduced in the IPR2024-01357 petition. Because these proceedings are virtually identical, good cause exists for joining this proceeding with IPR2024-01357 so that the Board, consistent with 37 C.F.R. § 42.1(b), can “secure the just, speedy, and inexpensive resolution” of the IPR2024-01357 petition and the Elong petition in a single proceeding.

Moreover, granting joinder will not prejudice Patent Owner or the IPR2024-01357 petitioners. As discussed above, the Elong petition does not raise any new ground that is not raised in the IPR2024-01357 petition. Therefore, there will be little or no additional cost to Patent Owner or the IPR2024-01357 petitioners due to Petitioners’ joinder. Petitioners have conferred with the IPR2024-01357 petitioners and confirmed that they do not oppose this motion.

2. Petitioners do not propose new grounds of unpatentability

As discussed above, the Elong petition does not assert any new grounds of unpatentability. It challenges the same claims of the ’678 patent based on the same arguments, evidence, and grounds of unpatentability as IPR2024-01357. *See Sony*, IPR2015-01353, Paper No. 11 at 5-6 (granting institution of IPR and motion for

joinder where petitioners relied “on the same prior art, same arguments, and same evidence, including the same expert and a substantively identical declaration”); *Everlight Elecs. Co., Ltd., et al. v. Doc. Security Sys., Inc.*, IPR2018-01260, Paper No. 12 at 6-7 (Nov. 14, 2018) (granting motion for joinder where petitioner “asserts the same unpatentability grounds” and “relies on the same prior art analysis [even] though it relies on a different expert”); *see also Par Pharm., Inc. v. Novartis AG*, IPR2016-01023, Paper No. 20 at 14 (Oct. 27, 2016) (granting motion for joinder where petitioners “do not assert any new ground of unpatentability that is not already being considered in [an instituted IPR proceeding], rely on the same arguments and evidence, and do not require any modification to the existing schedule”).

3. *There will be no effect on the IPR2024-01357 trial schedule*

Joinder will have no effect on the IPR2024-01357 trial schedule because the Elong petition presents no new issues or grounds of unpatentability. *See Sony*, IPR2015-01353, Paper No. 11 at 6 (granting IPR and motion for joinder where “joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]”). There are no new issues for the Board to address, and Patent Owner will not be required to present any additional responses or arguments.

Petitioners will adhere to all deadlines set by the Board’s scheduling order for IPR2024-01357. The Patent Owner’s Response will not be impacted because the issues presented in the Elong petition are identical to the issues presented in the IPR2024-01357 petition. Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in responding to the IPR2024-01357 petition. Additionally, no additional expert discovery will be needed, because Petitioners rely on the same expert testimony submitted by the IPR2024-01357 petitioners.

Accordingly, joinder of Petitioners to IPR2024-01357 will not affect the Board’s ability to complete its review and final decision within the statutory time limits under 35 U.S.C. § 316(a)(11) and 37 C.F.R. § 42.100(c).

4. Briefing and discovery will be simplified

Petitioners agree to an “understudy” role. Specifically, Petitioners agree that, if joined, the following conditions will apply so long as any IPR2024-01357 petitioner remains an active party. These conditions are less burdensome on the Patent Owner and the IPR2024-01357 petitioners than conditions that have been previously approved by the Board in similar circumstances.

First, all substantive filings will be consolidated, for which the IPR2024-01357 petitioners will maintain responsibility (i.e., Petitioners will rely on the filings of the IPR2024-01357 petitioners), unless a filing solely concerns

issues that do not involve the IPR2024-01357 petitioners (e.g., Mandatory Notices).

Second, Petitioners will rely on the grounds instituted by the Board in IPR2024-01357 and the arguments and discovery introduced by the IPR2024-01357 petitioners. Petitioners will not raise any new grounds not instituted by the Board in IPR2024-01357 or introduce any argument or discovery not already introduced by the IPR2024-01357 petitioners. In particular, Petitioners will rely on the expert testimony submitted by the IPR2024-01357 petitioners.

Third, Petitioners will not request any direct, cross, or redirect examination time beyond that permitted for the IPR2024-01357 petitioners under either 37 C.F.R. § 42.53 or any agreement between Patent Owner and the IPR2024-01357 petitioners. *See Mylan Pharms. Inc. v. Novartis AG*, IPR2015-00268, Paper 17 at 5-6 (Apr. 10, 2015) (finding the same proposed limitations “are consistent with the ‘understudy’ role that Petitioners agree to assume, as well as Petitioner’s assertion that its presence would not require introducing any additional arguments, briefing, or discovery.”).

Finally, Petitioners will be bound by any agreement between Patent Owner and the IPR2024-01357 petitioners concerning discovery or depositions.

In short, Petitioners agree to participate in the joined proceedings as “understudies” and would assume an active role only if the IPR2024-01357

petitioners were dismissed from the joined proceedings or elected to transfer control to Petitioners.

By Petitioners accepting “understudy” roles, Patent Owner and the IPR2024-01357 petitioners can comply with the existing trial schedule, while avoiding any additional burden on the Board or Patent Owner. These steps will minimize any potential complications or delay that potentially may result from joinder. *See Sony*, IPR2015- 01353, Paper No. 11 at 6-7 (granting IPR and motion for joinder because “joinder would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board” where petitioners agreed to an “understudy” role). Petitioners are further willing to agree to any other conditions the Board deems necessary.

II. CONCLUSION

For the foregoing reasons, Petitioners respectfully request that the Board grant their petition for *inter partes* review of the ’678 patent and that the proceedings be joined with IPR2024-01357.

Date: December 9, 2024

Respectfully submitted,

/s/ David C. Radulescu

David C. Radulescu, Lead Counsel
Reg. No. 36,250

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(a), I certify that I caused to be served a true and correct copy of the foregoing Motion for Joinder by overnight courier (U.S. Postal Service, Federal Express, or UPS), on this date, on Patent Owner at the correspondence address of Patent Owner as follows:

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A courtesy copy was also sent to counsel for Patent Owner in IPR2024-01357 at the following email addresses:

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Date: December 9, 2024

/s/ David C. Radulescu
David C. Radulescu, Lead Counsel
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