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 IPR2025-00258
U.S. Patent No. 8,604,678

BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

Mail Stop Patent Board
Patent Trial and Appeal Board
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35 U.S.C. § 314(a) 1

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EXHIBIT LIST

Exhibit	Description
EX2001	*Feit Electric Company Inc. v. Elong International USA Inc. et al.*, N.D. Tex. Case No. 3:24-cv-01089, Dkt. No. 51, Amended Scheduling Order (April 7, 2025)
EX2002	*Feit Electric Company Inc. v. Elong International USA Inc. et al.*, N.D. Tex. Case No. 3:24-cv-01089, Dkt. No. 50, Order Denying Stay (April 7, 2025)
EX2003	*Feit Electric Company Inc. v. Elong International USA Inc. et al.*, N.D. Tex. Case No. 3:24-cv-01089, Dkt. No. 1, Complaint (May 6, 2024)
EX2004-EX2008	RESERVED
EX2009	*The Litebook Co., Ltd. v. Bombardier Aerospace Corp.*, No. 4:22-cv-0615-P, Dkt. No. 43 (N.D. Tex. Jan. 3, 2023)
EX2010	*MyPort, Inc. v. Samsung Electronics Co., Ltd., et al.*, No. 2:22-cv-00114, Dkt. No. 73 (E.D. Tex. June 12, 2023)

I. INTRODUCTION

Petitioners Elong International USA Inc. ("Elong") and Xiamen Longstar Lighting Co. Ltd. ("Longstar") belatedly seek to challenge claims of U.S. Patent No. 8,604,678 (the "'678 patent"). Patent Owner Feit Electric Company, Inc. ("Patent Owner" or "Feit Electric") filed its infringement complaint against Elong and Longstar nearly a year ago, on May 6, 2024, yet Elong and Longstar waited until December 9, 2024, to file this petition. In the meantime, the parallel district court case, which is not stayed, has reached an advanced stage. The parties and the court are scheduled to complete both claim construction and fact discovery before the Board's expected decision on the question of institution. If the Board were to institute, then the Board's final written decision would come *after* the jury trial on exactly the same issues, resulting in unnecessary duplication and risking inconsistent decisions.

As explained in more detail below, all six *Fintiv* factors weigh against instituting *inter partes* review on the present petition. Patent Owner respectfully requests that that Board exercise its discretion to deny institution.

II. ALL SIX *FINTIV* FACTORS WEIGH AGAINST INSTITUTION

The Board has discretion under 35 U.S.C. § 314(a) to deny institution of the requested *inter partes* review due to the advanced state of parallel district court litigation regarding the same issues. *See NHK Spring Co. v. Intri-Plex Techs., Inc.*,

IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019). The Board has set forth six factors (known as the "*Fintiv* factors") for determining whether discretionary denial is appropriate:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential, designated May 5, 2020) ("*Fintiv I*"); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 7-8 (PTAB May 13, 2020) (decision denying institution of inter partes review) ("*Fintiv II*"). "These factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding." *Fintiv I* at 6. In evaluating the factors, "the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review." *Id.*

As set forth below, all of the *Fintiv* factors weigh against institution. To avoid duplication of efforts, wasting resources, and potentially inconsistent decisions, the Board should deny institution.

A. Factor 1: No stay has been entered in the parallel district court case and there is no evidence that a stay will be granted.

Patent Owner has accused Petitioners Elong and Longstar of infringing the '678 patent in a case pending in the Northern District of Texas (*Feit Electric Company Inc. v. Elong International USA Inc. et al.*, No. 3:24-cv-01089 (the "Elong Case")). The Elong Case is scheduled to begin a jury trial in January 2026. *See* EX2001, Amended Scheduling Order, Elong Case, Dkt. No. 51 (April 7, 2025), at 1. The court has already denied one motion to stay the case for other purposes (EX2002, Order Denying Stay, Elong Case, Dkt. No. 50 (April 7, 2025)), and there is no evidence to suggest the court would grant a stay pending resolution of any IPR proceedings.

The Elong Case is not in its early stages. Jury selection is scheduled for the beginning of next year, on January 20, 2026. EX2001 at 1. In the Amended Scheduling Order, the court noted that it "will view with disfavor and will deny—absent a showing of good cause—requests for extensions of these deadlines." *Id.* at 6. The parties have just finished claim construction briefing, and the claim construction hearing is scheduled for May 15, 2025. *Id.* at 1. Fact discovery is

ongoing and is scheduled to end in less than two months, on June 23, 2025. *Id.* at 2. By comparison, an institution decision on the present IPR Petition is not due until July 24, 2025. A Final Written Decision would not be due until July 24, 2026, more than a month *after* the jury trial is scheduled to begin. *See id.* at 1.

It is unlikely that a stay would be granted in the Elong Case at this time. *See The Litebook Co., Ltd. v. Bombardier Aerospace Corp.*, No. 4:22-cv-0615-P, Dkt. No. 43 (N.D. Tex. Jan. 3, 2023) (denying motion for stay pending *inter partes* review because "the [Patent Board] had yet to initiate such review") (*quoting Freeny v. Apple Inc.*, No. 2:13-CV-00361-WCB, 2014 WL 3611948, at *1–3 (E.D. Tex. July 22, 2014) ("[T]he majority of courts that have addressed the issue have postponed ruling on stay requests or have denied stay requests when the PTAB has not yet acted on the petition for review.").

The Northern District of Texas is likely to find that a stay in this situation would unduly prejudice Feit Electric, disfavoring a stay. Every patent owner has an interest in the timely enforcement of its patent rights, and granting a stay could delay the Elong Case by nearly two years. The district court is also likely to find that the stage of litigation disfavors a stay. As noted above, by the date an institution decision is due in this proceeding, the parties will have substantially completed both claim construction and fact discovery in the Elong Case,

expending a substantial amount of work and financial resources during the eleven months that the Elong Case has been pending.

Moreover, because Elong has asserted multiple invalidity theories, including alleged indefiniteness of certain claim terms, a stay in the district court would be unlikely to simplify the issues. As district courts have recognized, when a party has raised multiple invalidity theories that will not go before the PTAB, a stay would leave in limbo these invalidity theories that will not go before the Board, weighing against a stay. *See*, *e.g.*, *MyPort, Inc. v. Samsung Electronics Co., Ltd., et al.*, No. 2:22-cv-00114, Dkt. No. 73 (E.D. Tex. June 12, 2023) at 5-6.

As the Board has explained, a stay of the district court litigation pending resolution of the PTAB proceedings "allays concerns about inefficiency and duplication of efforts." *Fintiv I* at 6; *Fintiv II* at 12. But here, the district court in the Elong Case has not stayed the pending litigation, nor is there any evidence that a stay will be granted. Allowing this IPR to proceed simultaneously with the district court litigation in the Elong case would be wasteful and inefficient.[1] This factor weighs against institution.

[1] For avoidance of doubt, Patent Owner opposes Petitioner's Motion for Joinder to IPR2024-01357 (Paper 4) for the reasons set forth herein.

B. Factor 2: The court's scheduled trial date will precede the Board's projected statutory deadline for a final written decision.

"If a district court's trial date is earlier than the Board's projected statutory deadline for a final written decision, the Board generally has weighed this fact in favor of exercising discretion to deny institution." *T-Mobile USA, Inc., et al., v. Wireless Alliance*, IPR2024-00608, Paper 16 (PTAB Sept. 3, 2024) (exercising discretion to deny institution of *inter partes* review). Petitioners filed the present petition on December 9, 2024, and a decision on institution is not due until July 24, 2026. If instituted, the Board's final written decision would not be due until March 5, 2026, which can be extended to September 5, 2026, for good cause in the case of joinder. 37 C.F.R. § 42.100.

Trial in the Elong Case is scheduled to begin earlier. Jury selection is scheduled to begin on January 20, 2026. EX2001, Amended Scheduling Order, Elong Case, Dkt. No. 51 (April 7, 2025) at 1. The trial cannot be extended absent a showing of good cause. *Id.* at 6.

Accordingly, the projected trial date for purposes of *Fintiv* would be at least a month before the expected timing of a Final Written Decision if proceedings are instituted. The Board recently found that this sequencing weighed in favor of exercising discretionary denial under similar circumstances. *See T-Mobile*, IPR2024-00608, Paper 16 at 13 ("Because the district court would address issues

relating to the validity of the [challenged] patent in a trial that, by any measure, would occur many months before we would issue a final written decision, we weigh the second *Fintiv* factor as favoring discretionary denial."). Accordingly, this factor weighs against institution.

C. Factor 3: The parties and the court have made a substantial investment in the parallel proceeding.

This factor relates to the "amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision." *Fintiv I* at 9 (emphasis added). For example, "if, at the time of the institution decision, the district court has issued substantive orders related to the patent at issue in the petition," this factor favors denial. *T-Mobile*, IPR2024-00608, Paper 16 at 9-10. Claim construction orders entered by the district court likewise "indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial." *Id.* at 10.

As discussed above, claim construction and fact discovery are ongoing in the Elong Case, with a claim construction hearing scheduled for May 15, 2025, and fact discovery scheduled to close on June 23, 2025. EX2001, Amended Scheduling Order, Elong Case, Dkt. No. 51 (April 7, 2025), at 1-2. By the date the institution decision is due, the parties will have begun expert discovery, and the court likely will have issued its claim construction ruling. *Id.* Even now, the

parties and the court have already made substantial investments in the Elong Case. The parties have completed claim construction briefing, and the court has already begun or will soon begin preparing for the May 15, 2025 claim construction hearing.

Thus, the parties and the district court will have invested significant time and resources in the litigation by the time the Board reaches an institution decision in this matter. This favors discretionary denial. *Fintiv I* at 10; *Fintiv II* at 13-14 (finding that "the level of investment and effort already expended on claim construction and invalidity contentions" favored denial).

D. Factor 4: There is complete overlap between this IPR and the Elong Case.

This factor looks at "whether all or some of the claims challenged in the petition are also at issue in district court," and whether the "petition includes the same or substantially the same claims, grounds, arguments, and evidence" as the parallel district court case. *Fintiv I* at 12-13. In the Elong Case, Petitioners have already incorporated by reference all of the grounds presented in the present petition into their invalidity contentions.

Thus, there is complete overlap with respect to the arguments and evidence presented here and in the district court litigation for Grounds 1, 2, 3, and 4. That the district court case may involve additional prior art references not asserted in

this IPR is "not relevant to the question of the degree of overlap for this factor." *Fintiv II* at 15. The fact that the Petition may challenge additional claims also does not warrant institution. *See*, *e.g.*, *Next Caller Inc. v. TRUSTID, Inc.*, IPR2019-00961, Paper 10 at 14 (PTAB Oct. 16, 2019) (denying institution where the district court case involved only a subset of the challenged claims).

In sum, this IPR and the district court case would involve the same claims—which will be construed under the same *Phillips* standard—and the same prior art (and, as discussed below, the same parties), which raises substantial "concerns of inefficiency and the possibility of conflicting decisions." *Fintiv I* at 12. This factor thus weighs in favor of a discretionary denial. *See Fintiv II* at 15; *NHK Spring*, IPR2018-00752, Paper 8 at 19–20.

E. Factor 5: The Petitioners are parties to the district court cases.

There is no dispute that Elong and Longstar are defendants in the Elong Case. "Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial." *Fintiv II* at 15.

F. Factor 6: Other circumstances impact the Board's exercise of discretion.

An additional circumstance weighs against institution on the present petition in light of the Petitioners' delay. Patent Owner filed the infringement complaint in the Elong Case on May 6, 2024. EX2003, Complaint, Elong Case, Dkt. No. 1

(May 6, 2024). Yet the Petitioners delayed until December 9, 2024, before filing the present petition. If the Board institutes on this petition, then Petitioners' delay will cause undue prejudice by forcing Patent Owner to defend the same claims against the same grounds at the same time in two different venues—even if the current petitioner in IPR2024-01357 were to settle by withdrawing from that proceeding. Under these circumstances, there is no basis for instituting review on Petitioners' untimely petition or granting their request for joinder with pending IPR2024-01357. This factor weighs against institution.

III. CONCLUSION

All six of the *Fintiv* factors weigh against institution of any ground presented in the present petition. Accordingly, Patent Owner respectfully requests that the Board exercise its discretion to deny institution.

Date: April 24, 2025

Respectfully submitted,

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CERTIFICATE OF WORD COUNT UNDER 37 C.F.R. § 42.24(b)(1)

I, the undersigned, do hereby certify that the foregoing Patent Owner Preliminary Response, including footnotes, contains 2,247 words, as measured by the Word Count function of Microsoft Word as specified by 37 C.F.R. § 42.24(b)(1).

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CERTIFICATE OF SERVICE

I hereby certify that on April 24, 2025, a true and correct copy of the foregoing was served by electronic mail upon the following counsel of record for Petitioners:

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