

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

PETITIONERS' OPPOSITION TO DISCRETIONARY DENIAL

EXHIBIT LIST

Exhibit No.	Description
EX1001	U.S. Patent No. 8,604,678
EX1002	Declaration of William A. Doolittle, Ph.D.
EX1003	Curriculum Vitae of William A. Doolittle, Ph.D.
EX1004	File History for U.S. Pat. Appl. No. 13/273,212 (excl. references)
EX1005	U.S. Pat. Pub. No. 2009/0057699 (“Basin-2007”)
EX1006	U.S. Pat. Pub. No. 2007/0045761 (“Basin-2005”)
EX1007	U.S. Pat. Pub. No. 2008/0079015 (“Krummacher”)
EX1008	U.S. Patent No. 6,791,259 (“Stokes”)
EX1009	U.S. Patent No. 5,998,925 (“Shimizu-APA”)
EX1010	U.S. Patent No. 6,069,440 (“Shimizu”)
EX1011	U.S. Pat. Pub. No. US2010/0124243 (“Hussell”)
EX1012	DuPont: Polymers, Light and the Science of TiO ₂ (2007)
EX1013	DuPont: Titanium Dioxide for Coatings (2007)
EX1014	Erik S. Thiele and Roger H. French, “Computation of Light Scattering by Anisotropic Spheres of Rutile Titania”, Adv. Mater. 1998, 10, No. 15
EX1015	Erik S. Thiele and Roger H. French, “Light-Scattering Properties of Representative, Morphological Rutile Titania Particles Studied Using a Finite-Element Method”, J. Am. Ceram. Soc., 81 [3] 469–79 (1998)
EX1016	Robert W. Johnson, Erik S. Thiele, And Roger H. French, “Light-scattering efficiency of white pigments: an analysis of model core - shell pigments vs. optimized rutile TiO ₂ ”, TAPPI JOURNAL, November 1997, Vol. 80(11)
EX1017	William D. Ross, “Theoretical Light-Scattering Power of TiO ₂ and Microvoids”, Ind. Eng. Chem., Prod. Res. Develop., Vol. 13, No. 1, 1974
EX1018	Feit Electric’s Initial Infringement Contentions - Claim Charts (May 28, 2024)
EX1019	U.S. Patent No. 8,547,010 (“Jagt”)
EX1020	Int’l Pat. Pub. No. WO 2008/044171 A2 (“Van Woudenberg”)
EX1021	Declaration of Etai Lahav

Exhibit No.	Description
EX1022- EX1039	[Intentionally Omitted]
EX1040	<i>Feit Elec. Co. v. Elong Int'l USA Inc. and Xiamen Longstar Lighting Co.</i> , No. 3:24-cv-1089 (N.D. Tex.), Dkt. 60, Memorandum and Opinion Order, dated May 5, 2025.

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<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11, March 20, 2020	<i>Passim</i>
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I. INTRODUCTION

Petitioners Elong and Longstar respectfully request that the Director decline to exercise her discretion to deny institution of *inter partes* review. Patent Owner has elected not to file a preliminary response and has not opposed Petitioners' Motion for Joinder (Paper 4). Accordingly, the Board should grant institution of *inter partes* review under 35 USC § 314(a) and join this proceeding to the already-instituted IPR2024-01357 pursuant to § 315(c).

As discussed in detail in Petitioners' unopposed Motion for Joinder, the instant Petition is a duplicate of the IPR2024-01357 Petition, and Petitioners have agreed to take only an "understudy" role in IPR2024-01357 if joined. (*See generally* Paper 4.). So Patent Owner's request for discretionary denial based on *Fintiv* is misplaced. IPR2024-01357 will proceed regardless of Petitioners' presence. Joinder will add no new grounds, no additional discovery, and no change to the existing schedule. Granting joinder therefore advances, rather than burdens, the efficiency goals articulated in the Director's March 26, 2025 *Interim Processes for PTAB Workload Management* memorandum and the Board's prior decisions under *Fintiv*. The Board has repeatedly found that duplicate petitions accompanied by a binding commitment to an "understudy" role are the type of petition that § 315(c) contemplates. *See, e.g., Biocon Biologics Inc. v. Regeneron Pharms., Inc.,*

IPR2024-00201, Paper 11 at 8 (Jan. 16, 2024). In that context, the *Fintiv* factors weigh against discretionary denial.

For these reasons, the Director should decline Patent Owner's request for discretionary denial. The Board should institute review on the grounds already found compelling in IPR2024-01357 and join Petitioners under the conditions set forth in their Motion for Joinder.

II. BACKGROUND

Patent Owner has brought three actions asserting the '678 patent: *Feit Elec. Co. v. LEDVANCE LLC*, No. 5:24-cv-31 (E.D. Ky.), filed February 2, 2024; *Feit Elec. Co. v. Savant Techs. LLC d/b/a GE Lighting*, No. 1:24-cv-473 (N.D. Ohio), filed March 13; and *Feit Elec. Co. v. Elong Int'l USA Inc. and Xiamen Longstar Lighting Co.*, No. 3:24-cv-1089 (N.D. Tex.), filed May 6.

Petitioner Savant (along with LEDVANCE) filed IPR2024-01357, requesting *inter partes* review of the '678 patent, on August 26, 2024.

On December 9, Elong and Longstar filed a duplicate of IPR2024-01357 as IPR2025-00258, along with a motion for joinder to IPR2024-01357.

The Board instituted IPR2024-01357 on March 5, 2025, rejecting Patent Owner's arguments in full. *Savant Techs. LLC v. Feit Elec. Co.*, IPR2024-01357, Paper 17 (Mar. 5, 2025). The *Savant* district court case was stayed on April 1. No. 1:24-cv-473, April 1, 2025 Order (N.D. Ohio). The *LEDVANCE* district court

case was stayed on April 2. *Feit Elec. Co. v. LEDVANCE LLC*, No. 5:24-cv-31, Dkt. 63 (E.D. Ky.).

Petitioners Elong and Longstar also moved to stay their district court case following institution of IPR2024-01357. The court denied the motion on May 5, 2025, citing the district court schedule and the fact that this Petition has not yet been instituted and the Motion for Joinder has not yet been granted. No. 3:24-cv-1089, Dkt. 60 (N.D. Tex.) (EX1040).

III. ARGUMENT

Institution and joinder of this proceeding are warranted, and the Director should decline to exercise her discretion to deny institution. Petitioners timely filed the Petition, duplicating the IPR2024-01357 Petition, and have committed to a limited understudy role with no separate arguments or filings, ensuring no disruption to the existing schedule. Granting joinder would promote efficiency, avoid duplication, and align with the Board's policies favoring joinder in such circumstances. Accordingly, as discussed below, the *Fintiv* factors do not support discretionary denial.

A. Institution and joinder promote efficiency and avoid unnecessary duplication

As discussed below, institution and joinder will streamline proceedings and align with the Board's established policies, weighing against discretionary denial.

1. Institution of IPR2024-01357 demonstrates the compelling merits of the challenges

The Board’s institution decision in IPR2024-01357 thoroughly rejected Patent Owner’s patentability arguments. Given that the present Petition is a duplicate of the instituted IPR2024-01357, it shares the same compelling merits.

In IPR2024-01357, the Board rejected Patent Owner’s attempts to distinguish the prior art based on unclaimed features, stating “[i]t is unclear to us from [Patent Owner’s brief] whether Patent Owner believes this is a claim construction argument or an obviousness argument, ... although, either way, we reject it.” IPR2024-01357, Paper 17 at 17-20. Thus, the Board repeatedly characterized Patent Owner’s proposed distinctions as “irrelevant.” *Id.* at 24-25. The Board further rejected Patent Owner’s nonobviousness arguments, stating “at this stage, we conclude that the skilled artisan would have found it obvious to include [the claimed feature]—as disclosed in so many references.” *Id.* at 27-28. Accordingly, the Board concluded IPR2024-01357 “presented strong evidence of unpatentability” based on the same grounds presented here. *Id.* at 15.

Thus, institution and joinder in this proceeding is consistent with the Board’s prior findings and the compelling merits of the challenges weigh against discretionary denial.

2. Joinder of IPR2025-00258 will not impose additional burden

As discussed in the Motion for Joinder (Paper 4), joinder will impose no additional burden on the Board or the parties to IPR2024-01357.

Joinder will have no effect on the IPR2024-01357 trial schedule because the Petition presents no new issues or grounds of unpatentability. *See Sony Corp. v. Memory Integrity LLC*, IPR2015-01353, Paper No. 11 at 6 (Oct. 15, 2015) (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 have agreed to adhere to all deadlines set by the Board’s scheduling order for IPR2024-01357. (Paper 4 at 9.) The Patent Owner’s Response will not be impacted because the issues presented in the 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. No additional expert discovery will be needed, because Petitioners rely on the same expert and 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 current schedule.

Further, Petitioners have agreed to an "understudy" role. (Paper 4 at 4, 7, and 9.) Specifically, Petitioners have agreed that, if joined, the following conditions will apply so long as any IPR2024-01357 petitioner remains an active party:

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.

(Paper 4 at 7-9.)

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.

The lack of burden on the parties to IPR2024-01357 or the Board weighs against discretionary denial.

3. Petitioners’ stipulation eliminates overlap with district court proceedings

Regardless of whether joinder is granted, IPR2024-01357 will proceed simultaneously with the district court action against Petitioners. Thus, some degree of overlap in issues is inevitable. Petitioners, however, have proactively addressed concerns about duplicative litigation through their explicit stipulation limiting the scope of prior art they will present in district court should joinder be granted.

Specifically, Petitioners have previously provided a district court stipulation in the context of IPR2024-01357. *See* IPR2024-01357, Paper 17 at 13-14.

Petitioners further stipulate as follows to avoid unnecessary duplication with the district court case should they be joined:

Petitioners Elong and Longstar stipulate that if *inter partes* review is instituted for a claim of the ’678 patent in either IPR2025-00258 or IPR2025-00260, Elong and Longstar will not assert that the claim is invalid in the related district court proceeding based on any grounds that include prior art asserted in the IPRs, including *inter alia* any grounds

asserting that the invention was known, used, or on sale in this country based on prior art asserted in the IPRs.

This stipulation directly addresses any potential concerns regarding duplicative litigation, as it expressly prevents Petitioners from asserting overlapping prior art in the district court proceedings.

Thus, Petitioners' commitment ensures efficiency and weighs against discretionary denial.

4. Joinder enhances efficiency in resolving patentability of the challenged claims

As explained above, joinder of Petitioners to IPR2024-01357 promotes overall procedural efficiency without imposing additional burdens. The institution decision in IPR2024-01357 demonstrates the compelling merits of Petitioners' challenges. Petitioners' explicit agreement to an understudy role ensures that joinder will not affect the existing trial schedule or require additional resources from the Board or Patent Owner. Petitioners' district court stipulation affirmatively eliminates the existing overlap between IPR2024-01357 and the concurrent district court litigation.

Thus, institution and joinder not only streamline the resolution of the challenged claims but also directly align with the Board's efficiency goals and established practices, further weighing against discretionary denial.

B. Discretionary denial under *Fintiv* is unwarranted

As discussed in detail above, the circumstances here favor institution and joinder. Consistent with that, the *Fintiv* factors weigh against discretionary denial.

Most significantly, under *Fintiv* factor 6, the nature of a substantively identical petition seeking joinder to an instituted IPR weighs against discretionary denial. The Board’s decision instituting IPR2024-01357 demonstrates the compelling merits of the challenges. Petitioners’ explicit commitment to an understudy role further enhances the efficiency of joinder. By agreeing not to raise new issues, arguments, or discovery, Petitioners ensure no additional burden and no disruption to the established schedule in IPR2024-01357.

Additionally, with respect to *Fintiv* factor 4, Petitioners’ district court stipulation effectively removes already-existing overlap between its district court case and IPR2024-01357. Specifically, Petitioners have explicitly stipulated that, should they be joined, they will not assert invalidity positions based on the same prior art in the district court. This stipulation ensures that granting joinder reduces rather than exacerbates duplicative litigation, further weighing heavily against discretionary denial.

The remaining *Fintiv* factors—the current lack of a district court stay (factor 1), the proximity of the trial date relative to the IPR final decision (factor 2), the extent of investment in the parallel proceeding (factor 3), and the

presence of the same parties (factor 5)—do not meaningfully favor discretionary denial here. The district court litigation and IPR2024-01357 proceedings will continue concurrently regardless of Petitioners’ joinder. Thus, these factors are at most neutral.

Therefore, on balance, the *Fintiv* factors favor institution and joinder. Petitioners’ strong merits position, robust stipulation removing district court overlap, and detailed commitments ensuring minimal burden collectively weigh heavily against discretionary denial.

IV. CONSENT TO REPLY

In view of the timing of this case and the Patent Office’s recent changes in guidance regarding discretionary denial (*see* Interim Processes for PTAB Workload Management (Mar. 26, 2025); and *NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556, Paper 13 (Sept. 7, 2022) no longer precedential as of April 25, 2025), Petitioners consent to Patent Owner having a reply to address *inter alia* the denial of stay in the district court case and the stipulations made by Petitioners.

V. CONCLUSION

For the above reasons, the Director should decline to exercise her discretion to deny institution under *Fintiv*, and the Board should institute and grant joinder of Petitioners to IPR2024-01357.

Date: May 16, 2025

Respectfully submitted,

/s/ David C. Radulescu

David C. Radulescu, Lead Counsel

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), I hereby certify that this motion complies with the type-volume limitation of 37 C.F.R. § 42.24 and the Director's Interim Processes for PTAB Workload Management (Mar. 26, 2005). The word count application of the word processing program used to prepare this motion indicates that the petition contains 2,154 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

Date: May 16, 2025

/s/ David C. Radulescu
David C. Radulescu, Lead Counsel
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CERTIFICATE OF SERVICE

I hereby certify that on May 16, 2025, a true and correct copy of the foregoing was served by electronic mail upon the following counsel of record for Patent Owner:

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