

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

**REPLY IN SUPPORT OF PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

Mail Stop Patent Board
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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EXHIBITS

Exhibit	Description
EX2001	<i>Feit Electric Company Inc. v. Elong International USA Inc. et al.</i> , N.D. Tex. Case No. 3:24-cv-01089, Dkt. No. 51, Amended Scheduling Order (April 7, 2025)
EX2002	<i>Feit Electric Company Inc. v. Elong International USA Inc. et al.</i> , N.D. Tex. Case No. 3:24-cv-01089, Dkt. No. 50, Order Denying Stay (April 7, 2025)
EX2003	<i>Feit Electric Company Inc. v. Elong International USA Inc. et al.</i> , N.D. Tex. Case No. 3:24-cv-01089, Dkt. No. 1, Complaint (May 6, 2024)
EX2004- EX2008	RESERVED
EX2009	<i>The Litebook Co., Ltd. v. Bombardier Aerospace Corp.</i> , No. 4:22-cv-0615-P, Dkt. No. 43 (N.D. Tex. Jan. 3, 2023)
EX2010	<i>MyPort, Inc. v. Samsung Electronics Co., Ltd., et al.</i> , No. 2:22-cv-00114, Dkt. No. 73 (E.D. Tex. June 12, 2023)
EX2011	Patent Owner's Power of Attorney in IPR2025-00258
EX2012	Email from C. McMahon to Board dated April 22, 2025
EX2013	Transcript of the <i>Markman</i> Hearing on May 15, 2025 in N.D. Tex. Case No. 3:24-cv-01089

I. INTRODUCTION

Petitioners' opposition (Paper 14) boils down to a brief in support of its Motion for Joinder. But the Board need not address the question of joinder here, because institution is not appropriate. As explained in Patent Owner's Request for Discretionary Denial (Paper 13), *all six Fintiv* factors weigh in favor of denying institution. In its opposition, Petitioners briefly mention factors 4 and 6 and wholly gloss over the remaining factors—without citing support for any of their fleeting arguments. Paper 14 at 10-11. Most importantly, Petitioners fail to address the fact that the jury in Case No. 3:24-cv-1089 pending before the Northern District of Texas will reach a verdict on the validity of the challenged claims prior to any final written decision of the Board in IPR2024-01357.¹

II. ARGUMENT

Petitioners tout the benefits of joinder (Paper 14 at 5-8), but joinder presumes institution. Petitioners largely ignore the more important *Fintiv* factors concerning institution itself. The possibility of joinder should not influence the

¹ Patent Owner respectfully discloses that it concurrently is in discussions that could potentially result in resolution of its disputes with Petitioners Elong and Longstar in this proceeding and the parallel district court case. Patent Owner submits its permitted reply brief today as the parties have reached no final resolution. Patent Owner will apprise the Director and the Board if the dispute should be settled with respect to these Petitioners.

Board's decision to deny institution of a Petition that would otherwise be denied.

Section 315 of Title 35 provides that the PTO Director has the discretion to "join as a party to [an instituted IPR] any person who properly files a petition" *that the Director "determines warrants institution."* 35 U.S.C. § 315(c) (emphasis added).

As explained in Patent Owner's opening brief, institution is not warranted because all six *Fintiv* factors favor denial. *See* Paper 13.

Factors 1, 2, and 3: The parallel district court case pending in the U.S.

District Court for the Northern District of Texas is not stayed and will reach a jury verdict on validity before any final written decision in IPR2024-01357.² EX2001.

Since Patent Owner filed its opening brief, the district court *confirmed* that it will not stay the case pending IPR. EX1040. The parties and the court have continued to make substantial investments in the district court proceeding. Indeed, since Patent Owner's opening brief, the parties completed the claim construction

² As evidenced by its motion for joinder, Petitioners are not parties to IPR2024-01357, so the Board did not factor in the time to trial in its decision to grant institution of IPR2024-01357. That the Board instituted IPR2024-01357 does not provide an independent basis for granting institution of the present Petition. *See, e.g.*, March 24, 2025 Guidance on USPTO's rescission of "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation" (hereinafter "March 24, 2025 Guidance") at 3 ("[T]he factors considered in the exercise of discretion are part of a balanced assessment of all the relevant circumstances in the case, including the strength of the merits. However, compelling merits alone is not dispositive in making the assessment.").

hearing³, and fact discovery is currently scheduled to close on June 26, 2025—less than one month away. *See* EX2001. Petitioners do not address these factors, but instead state that “these factors are at most neutral,” without explaining why or citing any support. Paper 14 at 10-11.

Factor 4: Petitioners assert that factor 4 weighs in their favor because “Petitioners’ district court stipulation effectively removes already-existing overlap between its district court case and IPR2024-01357” (Paper 14 at 10), but Petitioners’ stipulation is narrow. Petitioners’ stipulation is limited to only those grounds “that include prior art asserted in [IPR2025-00258 or IPR2025-00260].” Paper 14 at 8-9. Put another way, Petitioners’ stipulation is limited to those grounds it actually raised, and does not include “any other ground [that] could have been reasonably raised in an IPR (*i.e.*, any ground that could be raised under §§ 102 or 103 on the basis of prior art patent or printed publications).” *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 13-14 (PTAB Dec. 1, 2020); *c.f. Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 at 12 n.5 (PTAB Jun. 16, 2020). Indeed, Petitioners have asserted in the district court proceeding multiple invalidity

³ A claim construction order is expected around June 11, 2025 (three weeks from when the parties ordered the hearing transcript on May 21, 2025). *See* EX2013 at 67:8-11.

theories under §§ 102 and 103 that are not based on the “prior art asserted in [IPR2025-00258 or IPR2025-00260].” As such, Petitioner’s stipulation is hollow, and there would be no efficiency gains.

Factor 5: There is no dispute that Petitioners are defendants in the district court case. *Fintiv II* states that: “[b]ecause the petitioner and the defendant in the parallel proceeding are the same party, *this factor weighs in favor of discretionary denial.*” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 15 (PTAB May 13, 2020) (emphasis added). Yet Petitioners claim that this factor is “at most neutral” (Paper 14 at 11). As confirmed by the USPTO’s February 28, 2025 Guidance, *Fintiv* controls. See News & Updates, *USPTO rescinds memorandum addressing discretionary denial procedures*, USPTO.gov, available at <https://www.uspto.gov/about-us/news-updates/uspto-rescinds-memorandum-addressing-discretionary-denial-procedures> (last accessed on May 29, 2025) (“Parties to post-grant proceedings should refer to Patent Trial and Appeal Board (PTAB) precedent for guidance, including *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential).”).

Factor 6: Per the Director’s March 24, 2025 Guidance on USPTO’s rescission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” Petitioners’ reliance on the merits of IPR2024-01357 are overstated. See Paper 14 at 4. The March 24, 2025

Guidance states that, “the factors considered in the exercise of discretion are part of a balanced assessment of all the relevant circumstances in the case, including the strength of the merits. However, *compelling merits alone is not dispositive in making the assessment*” (emphasis added). Petitioners fail to acknowledge that their delay in seeking *inter partes* review tilts this factor in favor of denial. *See* Paper 13 at 9-10; Paper 14 at 10-11. Patent Owner filed the infringement complaint in the district court proceeding on May 6, 2024. EX2003. Yet the Petitioners delayed until December 9, 2024, before filing the present petition.

III. CONCLUSION

All six *Fintiv* factors support denying institution of IPR2025-00258. Petitioners fail to address four of these factors, and Petitioners’ arguments concerning the other two factors rest on faulty premises. For these reasons and those stated in its opening brief (Paper 13), Patent Owner respectfully requests that the Board exercise its discretion to deny institution.

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

Date: June 9, 2025

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

I, the undersigned, do hereby certify that the foregoing Reply in Support of Patent Owner's Request for Discretionary Denial is limited to 5 pages, pursuant to the Board's June 5, 2025 Email (EX3101).

/Charles M. McMahon/

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CERTIFICATE OF SERVICE

I hereby certify that on June 9, 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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