

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAVANT TECHNOLOGIES LLC d/b/a GE LIGHTING
ELONG INTERNATIONAL USA INC., and
XIAMEN LONGSTAR LIGHTING CO. LTD.,
Petitioners,

v.

FEIT ELECTRIC COMPANY, INC.,
Patent Owner.

Case IPR2025-00260
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
U.S. Patent and Trademark Office
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EXHIBIT LIST

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- EX2003	RESERVED
EX2004	<i>Feit Electric Company Inc. v. Savant Technologies LLC</i> , N.D. Ohio Case No. 1:24-cv-00473, Order Granting Motion to Stay (April 1, 2025)
EX2005	<i>Feit Electric Company Inc. v. Ledvance LLC</i> , E.D. Ky. Case No. 5:24-00031, Dkt. No. 63, Order Granting Motion to Stay (April 1, 2025)
EX2006	<i>Feit Electric Company Inc. v. Savant Technologies LLC</i> , N.D. Ohio Case No. 1:24-cv-00473, Amended Infringement Contentions, Savant Case (October 8, 2024)
EX2007- 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)

I. INTRODUCTION

This is not the first IPR petition challenging claims of U.S. Patent No. 8,604,678 (the “’678 patent”). Petitioner Savant Technologies LLC (“Savant”) already filed one petition challenging the ’678 patent (the “First Petition”). Savant could have presented these new grounds in the First Petition but chose not to do so.

For Petitioners Elong International USA Inc. (“Elong”) and Xiamen Longstar Lighting Co. Ltd. (“Longstar”), this is their first petition directed to the ’678 patent. But they too could have presented these grounds earlier. As a result of their delay, 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 lag the district court’s jury trial by more than five (5) months, 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, as do six of the seven *General Plastic* factors. With the relevant factors tilting overwhelmingly against institution, Patent Owner Feit Electric Company, Inc. (“Patent Owner” or “Feit Electric”) 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. Intrix-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 Elong Case and there is no evidence that a stay will be granted.

There are presently three district court cases involving the ’678 patent: one 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”)); one pending in the Northern District of Ohio (*Feit Electric Company Inc. v. Savant Technologies LLC*, No. 1:24-cv-00473 (the “Savant Case”))¹; and one pending in the Eastern District of Kentucky (*Feit Electric Company Inc. v. Ledvance LLC*, No. 5:24-00031 (the “Ledvance Case”))². The petitioners in this proceeding are

¹ Savant has already filed one earlier petition for IPR directed to the ’678 patent, which has been instituted (the “First Petition”). IPR2024-01357, Paper No. 17. Savant chose not to challenge claims 11-14 in that petition. IPR2024-01357, Paper No. 1 at 1. Savant filed a motion to stay the Savant Case, which the court granted. EX2004, Order Granting Motion to Stay, Savant Case (April 1, 2025).

² Ledvance filed a motion to stay the Ledvance Case, which the court granted. EX2005, Order Granting Motion to Stay, Ledvance Case, Dkt. No. 63 (April 1, 2025).

defendants in two of those cases. Petitioners Elong and Longstar are defendants in the Elong Case. Petitioner Savant is the defendant in the Savant Case.

The Elong Case is proceeding ahead of the other two cases, with a jury trial set to begin in January 2026. EX2001, Amended Scheduling Order, Elong Case, Dkt. No. 51 (April 7, 2025), at 1. The court in the Elong case has already denied one motion to stay the case for other purposes, 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, Amended Scheduling Order, Elong Case, Dkt. No. 51 (April 7, 2025), 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 are in the midst of 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 five (5) months 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 Patent Owner, 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.³ This factor weighs against institution.

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,

³ While the Savant Case and the Ledvance Case do not have a matching schedule to the Elong case, the resources expended in the Elong Case are nonetheless wasteful and inefficient as all the Petitioners have taken a predominantly common approach with respect to prior art invalidity in their respective invalidity contentions for the ’678 Patent.

2026. If instituted, the Board’s final written decision would not be due until July 24, 2026, which can be extended to January 24, 2027, for good cause in the case of joinder. 37 C.F.R. § 42.100.

Trial in the Elong Case is scheduled to begin months 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 five (5) months 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 ’662 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 substantial overlap between this IPR and the district court cases.

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 its district court invalidity contentions, Petitioner Savant has incorporated all of the grounds presented in this petition. Petitioners Elong and Longstar have similarly incorporated the underlying arguments as they relate to independent claim 1.

Thus, there is substantial overlap with respect to the arguments and evidence presented here and in the district court litigations for Grounds 1, 2, and 3. 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 challenges 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).

Notably, none of the Petitioners have stipulated to not pursue in a parallel district court proceeding all the same grounds as in the present petition or any grounds that could have reasonably been raised in the present petition (*i.e.*, a *Sotera* stipulation). Had the Petitioners done so, that could mitigate concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020) (precedential as to § II.A). Those concerns are particularly relevant when, as here, the Petitioners are expected to assert much of—if not all of—the same prior art in the district court and the PTAB, guaranteeing duplicative efforts between the district court and the PTAB and potentially conflicting decisions.

In sum, there is substantial overlap between the present petition and the disputes at issue in the district court cases, 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* 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. There is also no dispute that Savant is the defendant in the Savant 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.

Three additional circumstances weigh against institution on the present Petition in light of the prior conduct and delay of the petitioners.

First, Savant has already filed one petition directed to the ’678 patent, which the Board already instituted (the “First Petition”). IPR2024-01357, Paper 17, at 1. Absent exceptional circumstances, only one petition should be filed against a single patent. *See SolarEdge Techs. Ltd., v. SMA Solar Tech., AG.*, IPR2020-00966, Paper 9 at 10 (PTAB Jan. 11, 2021) (using discretion to deny institution where the petitioner had filed other petitions challenging the same patent). The Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) (“CTPG”) provides that “one petition should be sufficient to challenge the claims of a patent in most situations.” CTPG at 59. Thus, “multiple petitions by a petitioner are not necessary in the vast majority of cases.” *Id.* The CTPG recognizes that multiple petitions filed against the same patent at the same time “may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns.” *Id.* (*citing* 35 U.S.C. § 316(b)).

Savant asserts that this new Petition was necessitated by Patent Owner's assertion of new claims in the district court case. (Paper 1 at 1.) Yet both this petition and Savant's First Petition demonstrate that Savant knew how to challenge claims Patent Owner had not asserted in the district court. In the First Petition, Savant challenged claims 6, 7, 9, 10, 17, 18, and 26 even though Patent Owner had not—and still has not—asserted infringement of those claims. *See* IPR2024-01357, Paper 1 at 1; EX2006, Amended Infringement Contentions, Savant Case (October 8, 2024), at 1. Likewise, in the present Petition, Savant challenges claims 13-14, which Savant admits Patent Owner has not asserted in its infringement claims. Paper 1 at 13-14. Savant could have challenged claims 11-14 in its First Petition directed to the '678 but chose not to do so. There is no basis to justify the substantial and unnecessary burden that a second petition will place on the Board and Patent Owner. This factor weighs against institution.

Second, and relatedly, Savant is effectively circumventing the word count limits of 37 C.F.R. § 42.42. Savant's First Petition included 13,990 words directed to challenging claims of the '678 patent. IPR2024-01357, Paper 1, at 81. In the present Petition, Savant presents 11,637 additional words challenging the same patent. Savant's attempt at an end-run around the Board's word limits is an abuse of the Board's procedures and weighs against institution.

Third, the delay of all three petitioners in filing this Petition also weighs against institution. Patent Owner filed the infringement complaints in the Savant Case and the Elong Case on March 13, 2024, and May 6, 2024, respectively. Savant first challenged claims of the '678 patent in its First Petition on August 26, 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 prejudice Patent Owner by enabling Petitioners to monitor the developing arguments in the first IPR and then adapt their arguments in this proceeding. Petitioner's delay will cause even further prejudice by forcing Patent Owner to defend the '678 patent on three different fronts: the Elong Case, the first IPR, and now this second IPR, if instituted. This prejudice unduly weighs against institution.

III. THE *GENERAL PLASTIC* FACTORS ALSO WEIGH AGAINST INSTITUTION

The Board should also exercise its discretion to deny institution based on the factors presented in *General Plastic Indus. Co. v. Canon Kabushiki Kashia*, IPR2016-01357, Paper 19 at 9-10 (PTAB Sept. 6, 2017) ("*General Plastic*"). Although the present petition challenges some additional claims beyond those Savant challenged in its original petition in IPR2024-01357 ("First Petition"), six of the seven *General Plastic* factors weigh against institution.

A. Factor 1: The challenged claims overlap at least in part with the First Petition.

Petitioners admit that Ground 1 of the present petition is identical to Ground 1 of the First Petition. (Paper 1, 1-2.) Beyond that, there is no dispute that the other grounds in this Petition challenge some “new” claims of the ’678 Patent—meaning claims that were not challenged in a prior petition. (Paper 1, 1-2.) But merely challenging “new” claims does not automatically weigh in favor of institution. For example, the Board has denied institution even though a petition challenged a new claim because the challenges to the new claim were “based on...references that were cited in the[] earlier-filed proceedings.” *NetApp Inc. v. Realtime Data LLC*, IPR2017-01195, Paper 9 at 12 (PTAB Oct. 12, 2017). Here, as in *NetApp*, Petitioners rely exclusively on references Savant included in the grounds of the First Petition.

This case is also similar to *Apple Inc. v. Immersion Corp.*, IPR2016-01372, where the Petitioner filed a first petition that challenged Claims 1, 2, 9, 10, 17, 18, and 29 of the ’488 patent, and filed a second petition challenging Claims 3–8, 11–16, and 19–28. *Id.* at 11. *Apple Inc. v. Immersion Corp.*, IPR2016-01372, Paper 7 at 11-13 (PTAB Jan. 11, 2017). Although the second petition challenged “new” claims, the Board held that the limitations of the “new” claims were “substantially similar” to limitations found in the previously challenged claims and therefore

denied institution. *Id.* at 12. As the Board explained, “the Second Petition overwhelmingly challenges claims covering essentially the same scope as the claims challenged in the First Petition” and “Petitioner does not explain adequately why it could not have addressed” the new claims challenged in the Second Petition. *Id.* at 12-13. As in *Immersion Corp.*, the claims at issue here are similar to the claims challenged in the First Petition. For example, Claim 11 challenged in the instant Petition is similar to Claim 21 previously challenged in Grounds 1 and 3 of the First Petition (reciting average particle sizes). Similar overlap exists between Claim 14 challenged in the instant petition and Claim 21, which Savant challenged in the First Petition.

Given the overlap of challenged claims and claimed subject matter, this factor weighs against institution.

B. Factor 2: Petitioner Savant knew about the prior art when it filed the First Petition.

Petitioner Savant clearly knew about the prior art addressed in the present petition because Savant cited exactly the same prior art references in the First Petition. *See* Petition, 3 (“This petition does not rely on any new prior art, but rather the same prior art (and arguments) as used to challenge the claims in IPR2024-01357”). Accordingly, this factor weighs against institution.

C. Factor 4: Petitioner Savant delayed filing the instant Petition.

Savant waited nearly four months after filing its First Petition on August 24, 2024, before filing the present petition on December 9, 2024. As noted above in the discussion of Factor 2, Petitioner Savant admits that it knew of the prior art asserted in this Petition at the time of filing the First Petition. Thus, this factor weighs against institution.

D. Factor 5: Petitioner Savant provides no adequate explanation for its delay.

Savant purports to explain its delay in filing the present Petition by asserting that Patent Owner had not previously asserted infringement of claims 11-14. However, as discussed above, Savant challenged a number of unasserted claims in the First Petition, so the fact that claims 11-14 were unasserted at the time provides no basis for not timely challenging those claims in the First Petition. This factor weighs against institution.

E. Factor 6: Instituting review on this follow-on Petition would waste the Board's finite resources.

Savant's decision to file two petitions directed to the same patent, which, if instituted, would necessitate either two entirely separate IPRs or delay of the first IPR to consolidate with the present IPR, presents an unreasonable burden on the Board's finite resources. This factor weighs against institution.

F. Factor 7: If the Board institutes and consolidates with the First Petition, the Board would not meet the original deadline for issuing a final determination within one year.

If the Board were to institute and consolidate the present petition with the First Petition, then it would necessitate extending the deadline for issuing a final determination within one year after institution on the First Petition. This factor weighs against institution.

In addition to all six of the *Fintiv* factors, six of the seven *General Plastic* factors also weigh against institution. It is therefore appropriate for the Board to exercise its discretion pursuant to § 314(a) and § 325(d) to deny institution on the present petition.

IV. CONCLUSION

All six of the *Fintiv* factors and six of the seven *General Plastic* 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.

IPR2025-00260
U.S. Patent No. 8,604,678

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 3,939 words, as measured by the Word Count function of Microsoft Word as specified by 37 C.F.R. § 42.24(b)(1).

/Charles M. McMahon/

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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

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