

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

**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

TABLE OF CONTENTS

I.	Introduction.....	1
II.	Argument	2
III.	Conclusion	5

TABLE OF AUTHORITIES

Cases

<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020)	2, 3, 4, 5
<i>DexCom v. Abbott Diabetes Care</i> , IPR2024-00521, Paper 12 (PTAB Aug. 22, 2024)	3
<i>DexCom v. Abbott Diabetes Care</i> , IPR2024-00521, Paper 3 (PTAB Feb. 9, 2024)	3
<i>General Plastic Indus. Co. v. Canon Kabushiki Kashia</i> , IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017)	5
<i>Lenovo (United States) Inc. v. Universal Connectivity Technologies, Inc.</i> , IPR2024-01482, Paper 17 (PTAB Apr. 17, 2025)	2, 4
<i>Mercedes-Benz USA, LLC v. Carucel Invs., L.P.</i> , IPR2019-01644, Paper 9 (PTAB Mar. 26, 2020)	3, 4
<i>Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC</i> , IPR2019-01393, Paper 24 (PTAB Jun. 16, 2020)	5
<i>Sotera Wireless, Inc. v. Masimo Corp.</i> , IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020)	5

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- 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)
EX2011	Patent Owner's Power of Attorney in IPR2025-00260
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

The jury in Case No. 3:24-cv-1089 pending before the Northern District of Texas will reach a verdict on the validity of claim 1 prior to any final written decision of the Board in IPR2024-01357. Petitioners Elong and Longstar are not parties to IPR2024-01357, so the Board had no reason to consider denial of that proceeding based on the pending Elong and Longstar district court case. But Elong and Longstar *are* petitioners in the instant petition, and the Board should weigh this factor heavily in favor of denial.

Petitioners attempt to explain away multiple factors that support denial of institution. For example, Petitioners claim that the Petition merely “contains a *pro forma* recitation of the same grounds [found in IPR2024-01357] against claim 1.” Paper 14 at 1. Petitioners also suggest that “Savant filed the instant Petition” and “Petitioners Elong and Longstar [merely] chose to join.” Paper 14 at 4. **These are strategic decisions that Petitioners made prior to filing the instant Petition.** Petitioners chose to challenge claim 1 and to include Elong and Longstar as petitioners. These facts cannot be overlooked even if Petitioners present them in a casual manner.¹

¹ Patent Owner respectfully discloses that it concurrently is in discussions that could potentially result in resolution of its disputes with at least 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

II. ARGUMENT

As set forth in Patent Owner’s opening motion (Paper 13), all six *Fintiv* factors favor discretionary denial. Petitioners’ response changes nothing.

Fintiv Factor 1: The parallel district court case pending in the U.S. District Court for the Northern District of Texas will reach a jury verdict on validity before the final written decision in IPR2024-01357. EX2001. The district court confirmed that it will not stay the case pending IPR. EX1040. In their opposition, Petitioners rely completely on the *Savant* case, which has been stayed; however, the Board should account for *all* related district court cases. *See Lenovo (United States) Inc. v. Universal Connectivity Technologies, Inc.*, IPR2024-01482, Paper 17 at 9-10 (PTAB Apr. 17, 2025).

In instances where the district court case for one petitioner is stayed and the district court case for another petitioner may possibly be stayed, the Board has found this factor is at best neutral. *See id.* In *Lenovo*, the Board rightly expressed a hesitancy “to speculate as to how any of the involved district courts where no stay is pending might rule on any future motion to stay,” thus deeming the factor neutral. *Id.* at 9. Here, there is no uncertainty. The district court was clear that the case is too far advanced to stay the proceeding. EX1040 at 3-4 (“Because claim

resolution. Patent Owner will apprise the Director and the Board if the dispute should be settled with respect to these Petitioners.

construction briefing is complete and this Court is on a schedule that can resolve this litigation more quickly, the stage of litigation is so advanced that this factor weighs against a stay.”)². This factor weighs in favor of denying institution.

Fintiv Factors 2 and 3: Petitioners made a strategic decision to challenge claim 1 in the instant proceeding, despite full knowledge that Petitioner Savant challenged claim 1 in IPR2024-01357. *See* Paper 1 at 1 (“Savant filed a prior petition requesting inter partes review of the ’678 patent on August 26, 2024, which has been assigned case no. IPR2024-01357. . . . [The instant petition] *also* challenges independent claim 1.” (emphasis added)). Petitioners’ decision to overlap with IPR2024-01357 runs afoul of the two cases that Petitioners cite throughout their opposition—*DexCom v. Abbott Diabetes Care* and *Mercedes-Benz USA, LLC v. Carucel Invs., L.P.* *See, e.g.,* Paper 14 at 3; IPR2024-00521, Paper 12 (PTAB Aug. 22, 2024); IPR2019-01644, Paper 9 (PTAB Mar. 26, 2020). In *DexCom*, the petitioner acknowledged that it filed an earlier petition relating to the same patent, but it made sure not to challenge any overlapping claims. *See DexCom v. Abbott Diabetes Care*, IPR2024-00521, Paper 3 at Page 1 (challenging only dependent claims 13 and 29, which depend from previously challenged claim

² A claim construction order in the Elong case 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.

1). *Carucel* involved a similar fact pattern with no overlapping challenged claims. *See Mercedes-Benz USA, LLC v. Carucel Invs., L.P.*, IPR2019-01644, Paper 9 at 10.

The instant petition challenges claim 1, which therefore implicates all district court proceedings—including the Elong case. Where multiple district court cases are implicated, the Board has previously relied upon the *active case* in determining whether the proximity of the trial date to the Board’s statutory deadline weighs in favor of denial. *See Lenovo*, IPR2024-01482, Paper 17 at 10-11.

Fintiv Factors 4 and 5: These factors weigh in favor of denial because the district court cases—taken together—implicate only claims challenged in the present proceeding, and Petitioners Savant, Elong, and Longstar, as well as Patent Owner, are the parties in the district court cases. *See Lenovo*, IPR2024-01482, Paper 17 at 14 (finding Factor 5 weighs in favor of denial where “all defendants in the parallel district court litigations . . . are parties to this *inter partes* review.”).

Furthermore, the Elong Petitioners’ stipulation is unduly narrow and limited to only those grounds “that include prior art asserted in [IPR2025-00258 or IPR2025-00260].” Paper 14 at 16-17. The Elong 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). As such, Petitioners’ stipulation is hollow, and there would be no efficiency gains.

Fintiv Factor 6: Patent Owner’s discussion of *Fintiv* Factor 6 in its opening brief remains valid and largely unrebutted (Paper 13 at 11-13).

General Plastics Factors: In addition to the *Fintiv* factors, the *General Plastics* factors also provide an independent basis for denial of institution. As discussed in detail in Patent Owner’s opening brief (Paper 13 at 13-17), the instant Petition has complete overlap with respect to claim 1 of IPR2024-01357³ and Petitioners waited nearly *four months* after filing IPR2024-01357 before filing the present petition on December 9, 2024. Institution presents an unreasonable burden on the Board’s finite resources.

III. CONCLUSION

All six *Fintiv* factors support denying institution of IPR2025-00260, and Petitioners do not and cannot account for their decision not to raise their challenges

³ See analysis of *DexCom* and *Carucel*, *supra* at 3-4.

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

to claims 11-14 in IPR2024-01357. Patent Owner respectfully requests that the Board exercise its discretion to deny institution.

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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