

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASTERA MANUFACTURING LTD. and CHAUVET & SONS, LLC,
Petitioners,

v.

ELECTRALED INC.
Patent Owner.

IPR2025-01022
Patent No. 7,651,245 B2

**PETITIONERS' OPPOSITION TO
PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL**

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1005	TW94204571U (“Lin”)
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1013	Luxeon Application Brief AB05, 3, 10-11
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I. INTRODUCTION

Astera Manufacturing Ltd. (“Astera”) and Chauvet & Sons, LLC (“Chauvet”) (collectively, “Petitioners”) oppose Patent Owner’s Request for Discretionary Denial (Paper 8, “Request” or “Req.”). The Board is the appropriate forum to resolve issues regarding the patentability of U.S. Patent No. 7,651,245 B2 (“’245 patent”) for several reasons.

First, Petitioners demonstrate a clear and material error by the Office during prosecution. The Examiner allowed the challenged claims of the ’245 patent in a first office action after considering just five prior art references. The Examiner justified this action by identifying certain claim limitations as the basis for allowance. But the Petition demonstrates that those same features are undeniably present in the asserted prior art. The Director consistently has held that it is an appropriate use of Board resources to review exactly this type of error.

Second, the District Court’s scheduled trial dates do *not* indicate when trial will occur. The related district court cases are pending in the Eastern District of Texas, but the cases belong in the Southern District of Florida. Patent Owner and the named inventors of the ’245 patent are in Florida. Petitioners’ relevant witnesses and evidence also are in Florida. Given the lack of any connection to the Eastern District of Texas, the District Court is likely to grant Petitioners’ motions to transfer the cases, thereby negating the scheduled trial dates.

Third, Patent Owner has *no* settled expectations regarding the '245 patent. Patent Owner's lawsuits against Petitioners in July 2024 are the first time Patent Owner asserted the '245 patent. Moreover, ten months later, Patent Owner filed subsequent lawsuits against Petitioners for infringement of a related patent based on some of the same accused products. Patent Owner's staggered infringement lawsuits are not consistent with the notion of settled expectations.

II. DISCRETIONARY DENIAL IS NOT APPROPRIATE

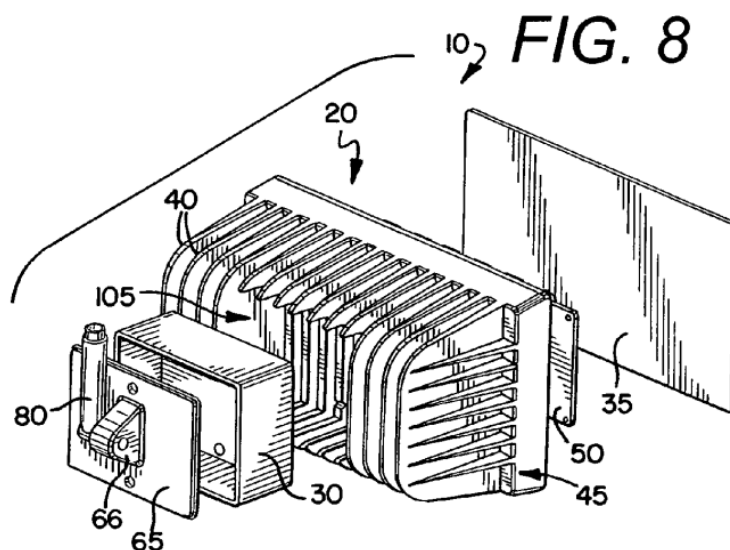
Based on a holistic assessment of all the evidence and arguments presented, discretionary denial of the Petition is *not* warranted.

A. The Office Materially Erred

The Office committed “a material error” in allowing claims 21–28 of the '245 patent, and “it is an appropriate use of Office resources to review the potential error.” *See Anthony Inc. v. ControlTec, LLC*, IPR2025-00559, Paper 12 at 2 (Director July 16, 2025). The Examiner allowed the challenged claims in a first office action after considering just five prior art references. And, as explained below, the prior art relied upon in the Petition discloses the exact features the Examiner deemed allowable. Because the Examiner clearly erred by performing only a cursory examination of the challenged claims, the '245 patent is particularly apt for review by the Board.

1. The Office's examination of the '245 patent was deficient.

The '245 patent identifies its allegedly novel concept as a light emitting diode (“LED”) fixture that includes a power supply positioned within a housing having an arrangement of fins extending from the housing to dissipate heat. Paper 3 (“Pet.”), 5–6; Ex. 1001 (“’245”), 1:48–55, 2:2–7. For example, the ’245 patent’s Figure 8 below shows an “array of fins 40” that “define[] a rear receptacle or pocket 105” for receiving “box 30” and the “power supply.” Pet. 5–6; ’245, 4:18–21, Fig. 8.



Pet. 5–6; '245, Fig. 8.

The Office did *not* perform an adequate examination of the '245 patent. The applicant presented original claims 1–28. Ex. 1002 (“FH”), 16–19. In the first office action, the Examiner allowed claims 1–20 and stated that dependent claims

26–28 also were allowable if rewritten in independent form. *Id.* at 60. Original dependent claim 27 recited “wherein the fins define a receptacle and the power module is positioned within the receptacle.” *Id.* at 19. This is the same feature shown above in the ’245 patent’s Figure 8.

In response, the applicant rewrote original dependent claim 27 as new independent claim 29 and added new dependent claims 30–36. *Id.* at 77–79 (“Claim 29 includes, among other things, the subject matter of allowable dependent Claim 27.”). The Examiner promptly allowed the new claims, which issued as claims 21–28 (i.e., the challenged claims). *Id.* at 87. The Examiner allowed those claims without a rejection, after considering only five prior art references. *Id.* at 62, 87.

2. The prior art discloses the exact features deemed allowable by the Examiner.

In allowing the challenged claims, the Examiner identified the following claim limitations as the basis for allowance:

[1] a housing including a flange, an internal receiver, a frontal lens and an array of fins extending rearward from the flange to define a rear receptacle that extends forward towards the flange, [2] the housing further including a rear cover that encloses the rear receptacle; . . . a power supply residing within the rear receptacle and enclosed by the cover.

Id. at 88. The Petition demonstrates that Lin¹ expressly discloses all the limitations of independent claim 21, including those identified by the Examiner in the reasons for allowance.

First, Lin discloses a housing with a flange, an internal receiver, a frontal lens, and an array of fins that define a rear receptacle. Pet. 13–17. In particular, the annotated version of Lin’s Figure 2 below shows how Lin discloses a housing including a flange, an internal receiver, and a frontal lens.

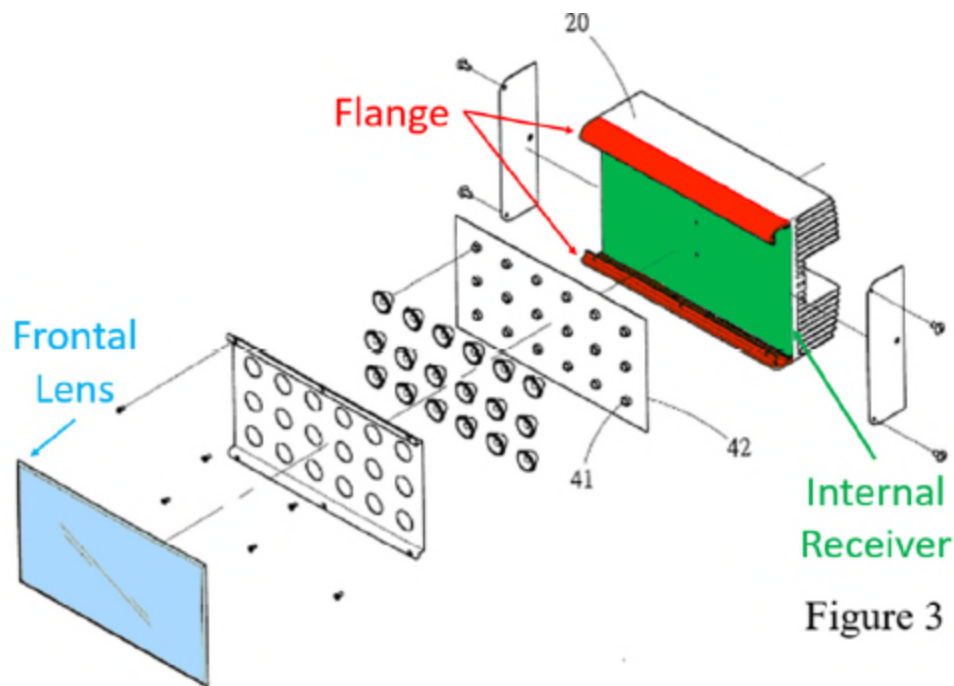
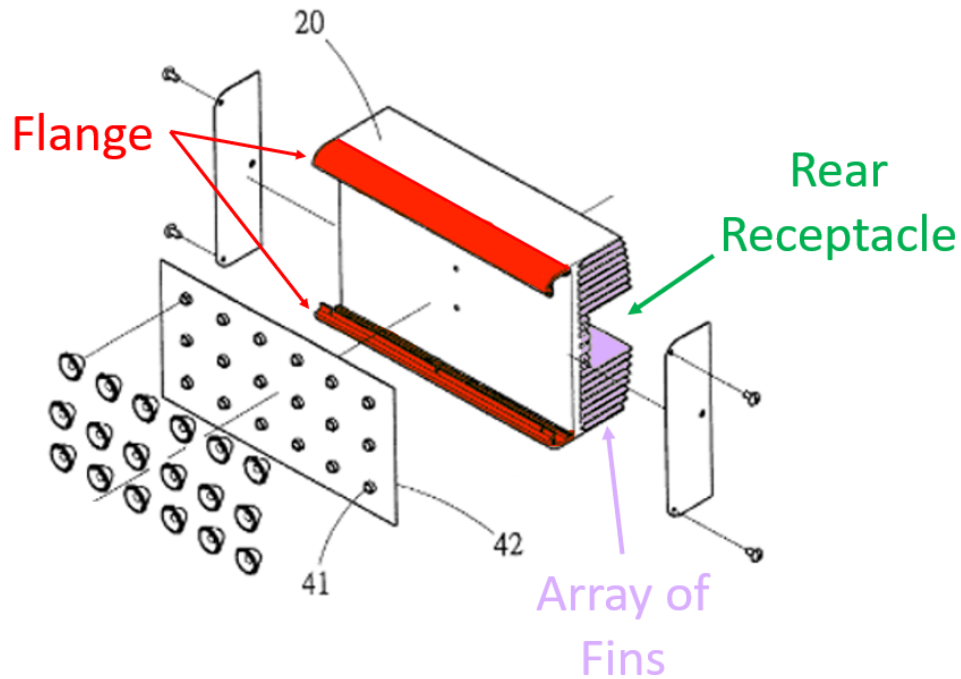


Figure 3

Id. at 13–16; Ex. 1006 (“Lin”), 4:18–30, 4:33–5:19, 6:21–26, Figs. 2–3. Further, the annotated version of Lin’s Figure 3 below shows how Lin’s housing includes an array of fins extending rearward from the flange to define a rear receptacle that

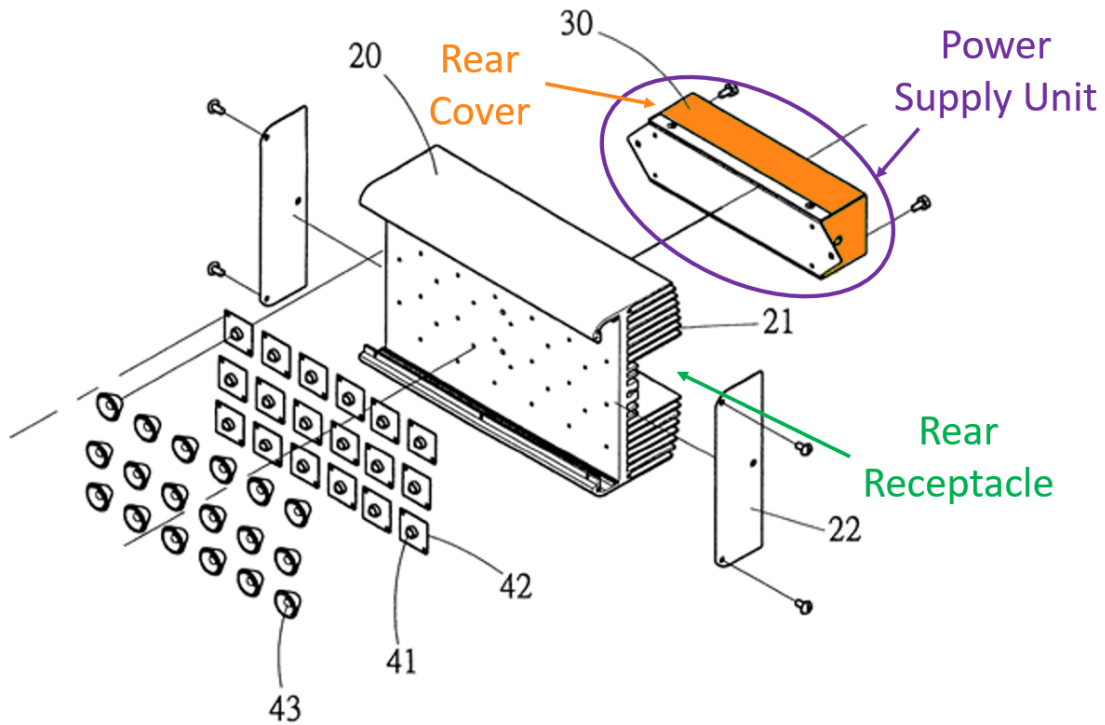
¹ Lin is Taiwanese Publication No. M277876, published on October 11, 2005. Ex. 1006, 18.

extends toward the flange portion. Pet. 18–19; Lin, 4:4–10, 4:18–32, 6:1–5, Figs. 1–3.

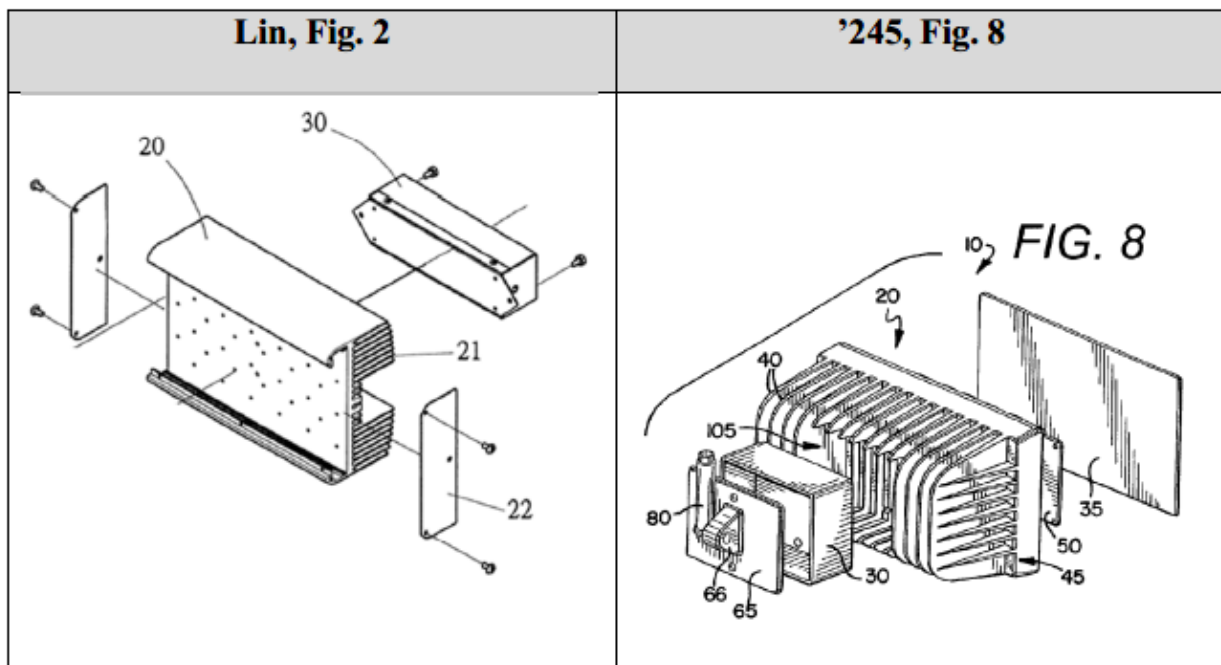


Pet. 18–19; Lin, Fig. 3 (annotated).

Second, Lin discloses a power supply residing within the rear receptacle and enclosed by a cover. Pet. 23–24. The annotated version of Lin’s Figure 2 below shows how Lin discloses power supply unit 30 residing in the rear receptacle defined by heat dissipation fins 21 and enclosed by a cover. *Id.*; Lin, 4:4–10, 4:18–32, 5:11–19, Figs. 1–3.



Pet. 23–24; Lin, Fig. 2 (annotated). In fact, as highlighted below, Lin’s Figure 2 depicts the exact same features as the ’245 patent’s Figure 8.



Pet. 19; Lin, Fig. 2; ’245, Fig 8.

In sum, Lin discloses the limitations in claim 21 that the Examiner found allowable. Lin was not previously presented to, or considered by, the Office. See '245, code (56). And Patent Owner does not identify any deficiencies in Lin's disclosure. See Req. 1–17. Thus, the evidence of record demonstrates that the Office's first action allowance of the challenged claims was a material error. It is an appropriate use of the Board's resources to review this mistake.

3. The Director previously referred petitions to the Board to review similar errors during examination.

The Director previously denied a request for discretionary denial so that the Board could review the same type of error that the Examiner made in this case. In *Anthony*, IPR2025-00559, Paper 12 at 2, the Director held that “[a]lthough the challenged patents have been in force for approximately eighteen and seventeen years, Petitioner appears to show a material error by the Office, and it is an appropriate use of Office resources to review that potential error.” Specifically, the Director explained that the “patent examiner issued a *notice of allowance* of both patent applications as the *first office action*,” and “Petitioner persuasively explains that the patent examiner erred by overlooking the teachings of Carter.” *Id.* (emphasis added). As discussed, in this case, the Examiner issued a first office action allowance and erred by overlooking Lin's disclosure.

Further, the Director consistently has denied requests for discretionary denial when the examiner overlooked prior art that discloses the features deemed

allowable by the examiner. In *Taiwan Semiconductor Manufacturing Co. Ltd. v. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11 at 3–4 (Director Sept. 3, 2025), the Director determined that “Petitioner persuasively demonstrates that the patent examiner overlooked certain teachings in Chien770 that appear to disclose the claimed features that the patent examiner indicated were not taught by the prior art of record.” Similarly, in *Eunsung Global Corp. v. HydraFacial LLC*, IPR2025-00445, Paper 14 at 3 (Director July 10, 2025), the Director held that “Petitioner persuasively demonstrates that the patent examiner overlooked certain teachings in Karasiuk that appear to disclose the allowable features of the claims.” Like those cases, the Examiner here erred by allowing the challenged claims when Lin discloses the exact features that the Examiner deemed allowable.

B. Discretionary Denial is Not Warranted Under *Fintiv*

The scheduled trial date in the related district court cases² does *not* warrant denial of the Petition. The Director has held that allowing the Board to review a material error by the Office outweighs concerns about a scheduled district court trial that may precede the Board’s final written decision. *Padagis US LLC v.*

Neurelis, Inc., IPR2025-00464, Paper 12 at 2–3 (Director July 16, 2025); *Microsoft*

² Patent Owner asserts the ’245 patent against Petitioners in following district court cases: 1) *ElectraLED Inc. v. Astera LED Technology GmbH*, Case No. 2-24-cv-00512 (E.D. Tex.); and 2) *ElectraLED Inc. v. Chauvet & Sons, LLC*, No. 2-24-cv-00511 (E.D. Tex.) (collectively, “related district court cases”). Paper 7, 2.

Corp. v. Partec Cluster Competence Center GmbH, IPR2025-00318, Paper 9 at 2–3 (Director June 12, 2025). In fact, the Director referred a petition to the Board to review a material error by the Office even when the scheduled trial date preceded the Board’s final written decision deadline by seven months. *Padagis*, IPR2025-00464, Paper 12 at 2–3. Thus, here, the Office’s material error in allowing the challenged claims outweighs any potential concerns about the District Court’s scheduled trial date.

Moreover, even considering the factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–16 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”), discretionary denial is not warranted. As explained below, *Fintiv* factors 1–4 and 6 all weigh against discretionary denial.

1. Factor 1 weighs against discretionary denial because the district court cases are likely to be stayed.

Fintiv factor 1 weighs against discretionary denial because a stay is likely. As discussed for factor 2, Petitioners filed motions requesting that the related district court cases be transferred to the Southern District of Florida. Ex. 1014; Ex. 1015. The transfer motions are fully briefed after venue discovery, but the District Court has not yet decided the motions. Ex. 1016. With the claim construction hearing currently set for October 10, 2025, the District Court is likely to stay these cases pending resolution of Petitioners’ transfer motions. The District Court recently stayed another case in the same situation. Specifically, in

Spinelogik, Inc. v. Globus Medical, Inc., No. 2:23-cv-00529, slip op. at 1 (E.D. Tex. Jan. 24, 2025) (J. Payne), the District Court stayed the “case pending resolution of the Motion to Transfer” about three weeks before the claim construction hearing. Ex. 1017. That case has been stayed for eight months, and the District Court just canceled the scheduled trial date. *Id.*; Ex. 1018.

A stay of the related district court cases pending resolution of Petitioners’ transfer motions is consistent with Federal Circuit precedent. For example, the Federal Circuit explained that “a *Markman* hearing and claim construction order are two of the most important and time intensive substantive tasks,” and disposal of a transfer motion “should unquestionably take top priority.” *In re Apple Inc.*, 979 F.3d 1332, 1338 (Fed. Cir. 2020). Thus, the Federal Circuit has held that a “stay of merits proceedings is appropriate relief if the district court cannot decide a venue motion quickly enough to avoid burdening the moving party with unnecessary expense and prejudice.” *In re Netflix, Inc.*, No. 2021-190, 2021 WL 4944826, at *1 (Fed. Cir. Oct. 25, 2021).

Further, as discussed for factor 2, when the District Court resolves the transfer motions, the related district court cases are likely to be transferred to the Southern District of Florida. *See* Section II.B.2. And the evidence indicates that after a transfer, the Southern District of Florida is likely to grant a motion to stay. For example, the Southern District of Florida stated that “stays pending [*inter*

partes] reviews are granted routinely ‘in order to avoid inconsistent results, obtain guidance from the PTAB, or avoid needless waste of judicial resources.’” *Targus Int’l LLC v. Grp. III Int’l, Inc.*, No. 20-cv-21435, 2021 WL 542675, at * 1 (S.D. Fla. Jan. 8, 2021). In addition, courts in the Southern District of Florida have granted a majority of motions to stay pending an *inter partes* review. Ex. 1019.

2. Factor 2 weighs against discretionary denial because the District Court’s trial dates are highly uncertain.

Fintiv factor 2 weighs against discretionary denial because the scheduled trial date in the related district court cases is likely to change. The District Court’s current trial dates are April 6, 2026, in the Astera case and April 20, 2026, in the Chauvet case. Ex. 2001, 1; Ex. 2002, 1. The median time to trial statistics, however, indicate that trial will occur later in August 2026. Ex. 1020 (25.1 months from filing to trial). Petitioners’ pending transfer motions will likely delay the District Court’s trial date even further. Ex. 1014; Ex. 1015. As discussed for factor 1, the District Court recently stayed a case for eight months (and counting) pending resolution of a transfer motion. Ex. 1017; Ex. 1018.

Moreover, the evidence strongly indicates that the District Court is likely to grant Petitioners’ transfer requests, thereby negating the scheduled trial date. Patent Owner is a Florida company with its principal place of business in Clearwater, Florida. Ex. 1021 ¶1. Chauvet is headquartered in Davie, Florida. Ex. 1022 ¶3. Astera’s exclusive distributor is a Florida company with its principal place of

business in Davie, Florida. Ex. 1023 ¶11. In addition, the named inventors of the '245 patent reside in the Tampa Bay area of Florida. '245, code (75).

Thus, all the relevant witnesses and other evidence are located in or near the Southern District of Florida. In contrast, the parties have no physical places of business in the Eastern District of Texas. Ex. 1022 ¶¶4–6; Ex. 1023 ¶7. This is exactly the scenario where the District Court typically grants a transfer. *See, e.g.*, Ex. 1024 (*Jawbone Innovations, LLC v. Amazon.com, Inc.*, No. 2:21-cv-00435, slip op. at 6–7 (E.D. Tex. Sept. 21, 2022) (J. Gilstrap) (granting motion to transfer where the witnesses and other evidence relating to the accused products were located in California and inventors were located in California)); Ex. 1025 (*The Phelan Grp., LLC v. Mercedes-Benz Grp. AG*, No. 2:23-cv-00607, slip op. at 5–6, 8–9, 12 (E.D. Tex. Feb. 14, 2025) (J. Gilstrap) (granting motion to transfer where the witnesses and other evidence relating to the accused products were located in Georgia); *Intelligent Automation Design, LLC v. Zimmer Biomet Holdings, Inc.*, No. 5:16-cv-11, 2016 WL 4424967 at *2–3, 5 (E.D. Tex. July 21, 2016) (granting transfer motion where all relevant witness and other evidence were located in Florida); *Groupchatter, LLC v. Itron, Inc.*, No. 6:15-cv-900, 2016 WL 2758480, at *3, 5 (E.D. Tex. May 12, 2016).

Patent Owner asserts that it identified witnesses with relevant information and other sources of proof in the Eastern District of Texas. Req. 5–6. Patent Owner

also asserts that Chauvet maintains a regular and established place of business there. *Id.* at 6. Patent Owner, however, simply cites to docket entries in the related district court cases. *See id.* at 5–6. Patent Owner provides no specific explanation or exhibits to support its assertions. *See id.* Patent Owner’s attorney argument does not outweigh the actual evidence presented by Petitioners showing that the related district court cases belong in the Southern District of Florida.

For the reasons discussed, the District Court’s trial date is highly uncertain. Because the evidence of record directly calls into doubt whether the district court trials will occur before the Board’s final written decision, factor 2 weighs against discretionary denial.

3. Factor 3 weighs against discretionary denial because there has been minimal investment in the district court cases.

Fintiv factor 3 weighs against discretionary denial because the parties and the District Court have invested minimal resources in the related district court cases. So far, the parties prepared *preliminary* infringement and invalidity contentions, *proposed* claim constructions, and claim construction briefs. Ex. 2001, 4–5; Ex. 2002, 3–4; Exs. 2003–2006. The parties have made no other significant investments relating to the patentability of the ’245 patent.

Patent Owner alleges that by the time of the Board’s institution decision, the District Court will have held a claim construction hearing and fact discovery will be complete. Req. 8. But, as discussed, the pending transfer motions will likely

delay the scheduled deadlines for the claim construction hearing and discovery.

See Section II.B.1.

Further, Patent Owner's reliance on the scheduled deadlines is not indicative of Patent Owner's actual investment. Patent Owner proposed no terms for construction and provided no technical tutorial to the District Court. Ex. 1026; Ex. 1027. Thus, Patent Owner invested minimal resources in the claim construction process. Patent Owner also has provided little fact discovery. To date, Patent Owner produced only the '245 patent, its file history, and a handful of other documents, and provided no substantive interrogatory responses. Ex. 1028. Further, Patent Owner has requested extensions, failed to submit briefing, and even failed to attend a scheduled deposition, which demonstrates its lack of investment in these cases. *See, e.g.*, Ex. 1016 (failing to file sur-reply after requesting extension); Ex. 1034, 3:20–4:2 (failing to attend deposition of Astera witness).

As a result of the minimal actual investment in the related district court cases, factor 3 weighs against discretionary denial.

4. Factor 4 weighs against discretionary denial based on Petitioners' Sotera stipulation.

Fintiv factor 4 weighs against discretionary denial because Petitioners' stipulation mitigates any concerns about overlap with the related district court cases. Specifically, Petitioners stipulate that "if the Board institutes this IPR proceeding, Petitioners will not pursue an invalidity defense in their respective

district court cases that the claims subject to the instituted IPR are invalid on any grounds that were raised or that reasonably could have been raised in the IPR.”

Pet. 96. Petitioners’ “broad stipulation ensures that an *inter partes* review is a ‘true alternative’ to the district court proceeding[s].” *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (precedential).

Patent Owner posits that Petitioners’ stipulation “does not cover potential invalidity theories based on system or product prior art” that Petitioners “could bring” in the related district court cases. Req. 15. Patent Owner points to Petitioners’ identification of the Chauvet LED-PAR83 product in its preliminary invalidity contentions. *Id.* at 14. The prior art asserted in the Petition, however, does not “correspond[]” to the Chauvet LED-PAR83 product. *Cf.* Interim Director Discretionary Process, Section I.D, *available at* <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process> (“relying on corresponding system art in a co-pending proceeding”). For example, the Petition does not rely on the Chauvet LED-PAR83 User Manual. Pet. 4–5; Ex. 2005, 7–8; Ex. 2006, 7–9. Thus, Petitioners’ stipulation mitigates concerns of potential overlap.

In addition, the Petition challenges claims 21–28, whereas the related district court cases only involve claim 21. Pet. 4–5; Ex. 2005, 1; Ex. 2006, 1. Claims 22–28 contain limitations not found in claim 21, and addressing the validity

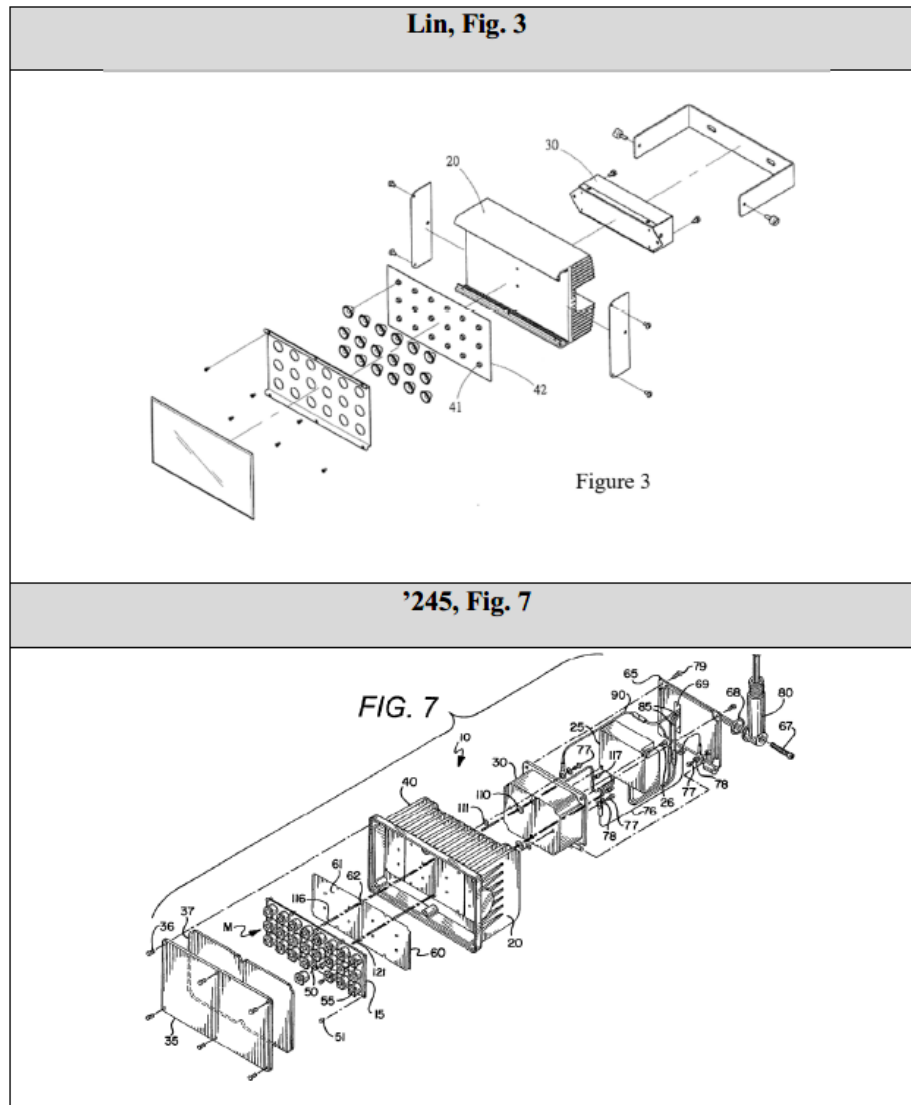
of claim 21 in the related district court cases would not resolve issues regarding claims 22–28. *See* '245, 10:46–12:3.

Based on the lack of overlap between the Petition and the related district court cases, factor 4 weighs against discretionary denial.

5. Factor 6 weighs against discretionary denial.

Fintiv factor 6 weighs against discretionary denial for two reasons. First, as discussed previously, the Office only cursorily examined claims 21–28 and materially erred in issuing them. *See* Section II.A. As discussed, reviewing this error outweighs concerns about overlap with the District Court. *See Padagis*, IPR2025-00464, Paper 12 at 2–3; *Microsoft*, IPR2025-00318, Paper 9 at 2–3.

Second, the Petition presents compelling merits. As explained above, the Petition demonstrates that Lin discloses all the limitations of the challenged claims, including those identified by the Examiner as the basis for allowance. *See* Section II.A. In fact, as noted in the Petition, Lin's Figure 3 shows an LED fixture with the same features as the '245 patent's Figure 7.



Pet. 9–11. Patent Owner does not raise any disputes about the merits of the Petition. *See* Req. 16–17.

C. Patent Owner Has No Settled Expectations

The Petition should *not* be denied based on Patent Owner’s alleged settled expectations. The Director consistently has held that allowing the Board to review a material error by the Office outweighs a patent owner’s settled expectations. *See Anthony*, IPR2025-00559, Paper 12 at 2; *Taiwan Semiconductor*, IPR2025-00847,

Paper 11 at 3–4; *Eunsung*, IPR2025-00445, Paper 14 at 2–3; *Skullcandy, Inc. v. Earin AB*, IPR2025-00690, Paper 9 at 2 (Director July 31, 2025); *Activision Blizzard, Inc. v. Milestone Entm’t, LLC*, IPR2025-00708, Paper 13 at 2–3 (Director Aug. 14, 2025). The Director has referred petitions to the Board to review a material error during examination even when the challenged patents have been in force for over fifteen years. *See Anthony*, IPR2025-00559, Paper 12 at 2 (“Although the challenged patents have been in force for approximately eighteen and seventeen years, Petitioner appears to show a material error by the Office.”); *Taiwan Semiconductor*, IPR2025-00847, Paper 11 at 3–4 (“Although the challenged patent has been in force for fifteen years, Petitioner appears to show a material error by the Office.”). Thus, the Office’s material error in allowing the challenged claims in this case outweighs any concerns about settled expectations.

Moreover, Patent Owner does not have settled expectations regarding the ’245 patent. Despite Patent Owner’s claim that the ’245 patent has been in force for over 15 years, the complaints filed against Petitioners in July 2024 are the first time Patent Owner asserted the ’245 patent. Ex. 1029. Patent Owner’s decision not to assert the ’245 patent for over 15 years provided the public, including Petitioners, with a reasonable expectation that Patent Owner would not assert it.

In addition, Patent Owner’s conduct is not consistent with the notion of settled expectations. Patent Owner initially filed complaints alleging infringement

of the '245 patent against Petitioners in July 2024. Ex. 1021; Ex. 1030. Ten months later, in May 2025, Patent Owner filed new complaints against Petitioners alleging infringement of another patent, U.S. Patent No. 9,618,187 B2 (“the '187 patent”). Ex. 1031; Ex. 1032. The '187 patent is in the same family as the '245 patent. Ex. 1033 (“'187”), code (63). Patent Owner’s new lawsuits identify some of the same accused products as its earlier lawsuits.³ Patent Owner should not be permitted to assert its own settled expectations while at the same time staggering its infringement lawsuits against Petitioners.

III. CONCLUSION

Based on a holistic assessment of all the evidence and arguments presented, the Board should *not* exercise its discretion to deny the Petition.⁴

Date: September 19, 2025

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³ Patent Owner, for example, alleges infringement of the '245 patent and the '187 patent by Astera’s AX9 Power Par product and by Chauvet’s SlimPar Pro QZ12 USB and SlimPar Pro Q USB products. Ex. 1021 ¶21; Ex. 1030 ¶40; Ex. 1031 ¶46; Ex. 1032 ¶44.

⁴ To the extent the Interim Director Discretionary Process is found improper for any reason, Petitioners reserve their right to seek an appropriate remedy.

CERTIFICATE OF SERVICE

The undersigned certifies that, in accordance with 37 C.F.R. § 42.6(e) and 37 C.F.R. § 42.105, the foregoing **PETITIONERS' OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** and exhibits thereto were served on counsel of record via electronic mail on September 19, 2025, as follows:

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