

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HOME DEPOT USA, INC.,
Petitioner,

v.

LYNK LABS, INC.,
Patent Owner.

CASE: PGR2022-00009
U.S. PATENT NO. 10,932,341

PATENT OWNER'S PRELIMINARY RESPONSE

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EXHIBIT LISTING

Exhibit	Description
2001	Lynk Labs Motion for Expedited Scheduling Conference, 1:21-cv-05021 (N.D. Ga.) (Dkt. 60) (Dec. 22, 2021)
2002	Home Depot's Preliminary Invalidity Contentions (Aug. 18, 2021)
2003	Lynk Labs Opposition to Home Depot's Motion to Transfer Venue, 6:21-cv-00097 (W.D. Tex.) (Dkt. 47) (Nov. 29, 2021)
2004	Home Depot USA, Inc.'s Motion to Stay, 1:21-cv-05021 (N.D. Ga.) (Dkt. 56) (Dec. 21, 2021)
2005	Order Setting <i>Markman</i> Hearing, 6:21-cv-00097 (W.D. Tex.) (Dkt. 48) (Nov. 29, 2021)
2006	Joint Claim Construction Statement, 6:21-cv-00097 (W.D. Tex.) (Dkt. 49) (Nov. 30, 2021)

I. INTRODUCTION

Patent Owner, Lynk Labs, Inc., (“Lynk” or “Patent Owner”), submits this Patent Owner Preliminary Response (“POPR”) pursuant to 37 C.F.R. § 42.207(a) to the Post-Grant Review (“PGR”) petition (“Petition”) filed by Home Depot USA, Inc. (“Petitioner”) for Claims 1–5, 7–12, and 14–19 (“Challenged Claims”) of U.S. Patent 10,932, 341 (“the ’341 Patent,” Ex. 1001).

The Board should deny institution for several reasons.

First, institution of PGR would demand an untimely and inefficient proceeding that would effectively “second guess” the result of a jury trial that may have already concluded in the co-pending litigation. *See NHK Spring Co. v. Intriplex Techs., Inc.*, IPR2018-00752, Paper 8 at 11–21 (PTAB Sept. 12, 2018) (Precedential); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 2–3 (PTAB March 20, 2020) (Precedential). The ’341 Patent is being asserted against Petitioner in co-pending litigation in the Northern District of Georgia, *Lynk Labs, Inc. v. Home Depot USA, Inc. et al.*, Case No. 1:21-cv-05021-MHC (“Georgia Litigation”). In the Georgia Litigation, Patent Owner has moved for expedited scheduling in light of the substantial amount of work completed before the case was transferred from the Western District of Texas (*Lynk Labs, Inc. v. Home Depot USA, Inc. et al.*, Case No. 6:21-cv-00097 (W.D. Tex.)) (“Texas Litigation”). Ex. 2001; Ex. 2003. The Board

should exercise its discretion under 35 U.S.C. § 324(a) to deny institution in the interests of efficiency and fairness.

Second, the Petition fails to satisfy the threshold for institution because it does not show that it is more likely than not that any challenged claim is unpatentable. Petitioner's Grounds for challenging the '341 Patent should be rejected because the prior art does not disclose or teach the claimed user actuated switch capable of switching a voltage level input of LED circuits, or switching an additional LED circuit on or off. In other words, the prior art does not teach a single switch that is both switchable by a user and capable of achieving the claimed functions.

These reasons are independent and the Board should deny institution for either or both of these reasons.

II. BACKGROUND

The '341 Patent includes twenty (20) claims, of which three (3) claims are independent claims. The three independent Claims 1, 8, and 15, generally recite an LED lighting device comprising a first operating LED circuit and at least one additional LED circuit, at least one of which includes at least two LEDs connected in series or parallel, the additional LED circuit being configured to emit light of a different color than the first operating LED circuit. The LED lighting device also includes a switch capable of (a) switching a voltage level input to at least one of the

first operating LED circuit or the at least one additional LED circuit, or (b) switching the at least one additional LED circuit on or off, and wherein (a) or (b) is selectable by a user switching the switch. These claims also recite that the LED device is configured to connect to an AC voltage source.

The Petition challenges seventeen claims—the Challenged Claims—under five total grounds, Grounds 1–5. Ground 1 alleges that Claims 3, 10, and 17 lack written description under 35 U.S.C. §112. Ground 2 alleges that Claims 4, 11, and 18 are indefinite under 35 U.S.C. §112. Ground 3 alleges that Claims 1, 3, 5, 7–8, 10, 12, 14–15, and 17 are anticipated by Bruning (Ex. 1004). Ground 4 alleges that Claims 1–3, 5, 7–10, 12, 14–17, 19 are obvious over the combination of Browning and Kabel (Ex. 1005). Ground 5 alleges that Claims 1–2, 5, 7–9, 12, 14–16, and 19 are obvious over the combination of Dowling (Ex. 1006) and Mueller (Ex. 1007).

III. THE '341 PATENT IS INELIGIBLE FOR PGR BECAUSE PETITIONER FAILED TO SHOW ANY CLAIM HAD AN EFFECTIVE FILING DATE ON OR AFTER MARCH 16, 2013

The Petition argues that “[t]he 341 patent is eligible for PGR if the 341 patent, or any of its priority applications, contains or contained at any time a claim with an effective filing date on or after March 16, 2013.” Petition at 16 (citing AIA § 3(n)(1)). The Petition has not demonstrated that any claim of the '341 Patent or its

priority applications have an effective filing date on or after March 16, 2013. The Petition should therefore be denied.

The '341 Patent was filed as Appl. No. 16/740,295 on January 10, 2020. The '295 Application is part of a series of continuation applications going back to Appl. No. 13/322,796, filed as application no. PCT/US2010/001597 (the "'597 Application") on May 28, 2010. Ex. 1018. The '597 Application is itself a continuation-in-part of an earlier-filed application. Thus, if the '597 Application or its parent applications support the claims in the '341 Patent and its intervening applications, PGR is inappropriate.

A. Claims 3, 10 and 17 of the '341 Patent

The Petition first argues that none of the "Pre-AIA Applications" provide support for Claims 3, 10 and 17 of the '341 Patent. Petition at 17–20. Claims 3, 10 and 17 of the '341 Patent recite "wherein the switching of the switch provides at least two different DC forward voltages to at least one of the first operating LED circuit or the at least one additional LED circuit." Ex. 1001, 12:30–33, 13:1–4, 14:13–16.

The '597 Application expressly discloses a "multi-voltage AC or DC operable LED device" (Ex. 1018, [0024]) that allows for "forward voltage drive selection." Ex. 1018, [0025]. Thus, the '597 Application discloses a switch that can provide at

least two different DC forward voltages to an LED circuit as required by the claims. Further, the '597 Application describes the scenario in which a switch providing a second, different forward voltage would not only be possible, but would be beneficial. Ex. 1018, [0028], [0030] (describing scenarios where an LED device is “driven with at least two different DC forward voltages” and provides “a first forward voltage drive level when the two single voltage LED circuits are connected in parallel and a second forward voltage drive level ... when the at least two LED circuits are connected in series.”).¹ In these embodiments, the second DC forward voltage is different than the first DC forward voltage. Ex. 1018, [0028], [0030] (describing the second forward voltage level as “twice the level of the first forward voltage drive level”).

The Petition’s arguments with respect to Claims 3, 10 and 17 do not address these clear supporting disclosures. Petition, 17–20. Instead, the Petition argues that “these claims include embodiments wherein the two different voltages are applied to only one of the LED circuits” and therefore “there is no disclosure of a switch providing two different voltages to one ‘or’ the other LED circuit as claimed.” Petition, 19–20. Petitioner’s argument does not track the language of the claims.

¹ All emphasis added unless otherwise indicated.

Claims 3, 10 and 17 require a switch that “provides at least two different DC forward voltages *to at least one of* [two LED circuits].” Because the claims provide different voltages to “at least one of” the two circuits, they are broad enough to allow for different voltages to one or both of the LED circuits. It need not be limited to only one circuit. Further, as discussed above, the ’597 Application discloses “multi-voltage AC or DC operable LED device” with “forward voltage drive selection.” Ex. 1018, ¶¶ [0024-25]. Thus, the ’597 Application clearly supports a switch providing different forward voltages to a single LED circuit.

B. Claims 4, 11 and 18 of the ’341 Patent

The Petition next argues that none of the “Pre-AIA Applications” provide support for Claims 4, 11 and 18 of the ’341 Patent. Petition at 20–21. Claims 4, 11 and 18 of the ’341 Patent recite “wherein the switch is connected between the AC voltage power source and the LED lighting device.” These limitations are clearly supported and disclosed in the ’597 Application. For example, Figs. 7 and 9 clearly disclose 2-way switch 60 connected between an AC power source and an LED lighting device. Ex. 1018, Figs. 7, 9, [0057]–[0058].

Petitioner’s argument, however, is not that these claims have an effective filing date on or after March 16, 2013 (as would be required to file a PGR); instead, Petitioner is arguing that the claims are indefinite as impossible to perform. Petition,

20–21. Respectfully, any supposed impossibility is not relevant for the analysis of whether a PGR is appropriate, which is limited here to whether the priority claim is supported by pre-2013 applications. *See* AIA § 3(n)(1). Under Petitioner’s argument, these claims are not entitled to any priority date at all, much less a priority date on or after March 16, 2013.

To the extent this issue was relevant, there is nothing impossible about the interpretation of Claims 4, 11 and 18. These claims simply indicate that the switch is connected to the AC voltage power source. This is a natural arrangement for an LED device containing a switch. While the independent claims characterize the LED device as “comprising” the switch, a POSITA would understand that Claims 4, 11 and 18 are simply specifying where in the LED device the switch would be connected relative to the power source. In other words, the claims are directed to a switch that acts as the interface between the AC voltage power source and the LED lighting device. *See, e.g.*, Ex. 1001, Figs. 7, 9 (showing a switch located between a voltage source and the rest of a LED device). By acting as the interface, this switch is both *a part of* the LED lighting device (as the independent claims require) and *between* the AC voltage power source and the LED lighting device (as the dependent claims require). Thus, Claims 4, 11 and 18 are supported by at least the ’597 Application, which was filed before 2013.

C. Claims 1–15 of the '001 Patent

Finally, Petitioner argues that Claims 1–15 of U.S. Pat. No. 10,537,001 (the “’001 Patent,” which is the patent that issued from the ’341 Patent’s parent application) are not supported by any applications filed before March 16, 2013. Petition, 21–23. First, Petitioner argues that no “Pre-AIA Application” discloses a “switch that is selectable to ‘independently switch on or off’ at least a first LED circuit or an additional LED circuit” as required by the independent claims of the ’001 Patent. Petition at 21 (quoting Ex. 1020, 12:16–21, 13:30–23).

As discussed above, the ’597 Application expressly discloses a “multi-voltage AC or DC operable LED device” (Ex. 1018, [0024]) that allows for “forward voltage drive selection.” Ex. 1018, [0025]. Further, the ’597 Application discloses a “switching means that connects and/or disconnects at least one additional LED circuit to and/or from a first LED circuit.” Ex. 1018, [0015]. *See also* Ex. 1018, [0018] (“It would further be advantageous to provide multi-brightness LED devices that can be switched to different levels of brightness by simply switching additional circuits on or off in addition to a first operation circuit within a single chip and or LED package.”) and [0057] (“Figure 7 discloses a schematic diagram similar to the multi-voltage and/or multi-brightness LED device 50 shown in Figure 6 integrated within a lamp 58 and connected to a switch 60 to control the brightness level of the

multi-voltage and/or multi-brightness LED lighting device 50.”). While the Petition emphasizes the claim term “independently,” the examples discussed above disclose allowing a user to independently “connect[] and/or disconnect[]” LED circuits on and off. Accordingly, the independent claims of the ’001 Patent are supported by at least the ’597 Application.

The Petition further argues that the dimmer switch of ’001 Patent, Claim 15 is not supported in any application prior to March 16, 2013. Petition, 22–23. This is incorrect. The dimmer switch is disclosed and supported in at least Provisional Application No. 61/217,215, filed May 28, 2009. Ex. 1014, [0022] (“the LED circuit driver may be coupled to a dimmer switch that regulates voltage or frequency or may have integrated circuitry that allows for adjustability of the otherwise relatively fixed voltage and/or relatively fixed frequency output of the LED circuit driver.”).

Petitioner argues that the ’215 Provisional does not support Claim 15 because the dimmer of Claim 15 “adjusts a voltage of the mains power source” while the ’215 Provisional discusses a dimmer that “is coupled to the driver and adjusts the output of the driver.” Petition, 23. Petitioner’s distinction is not meaningful. The ’215 Provisional discusses that LED devices can be driven using mains power sources. Ex. 1014, [0009] (“LEDs can be ... **driven with high voltage low frequency mains AC power sources**...”); [0021] (“whether the **LED circuit driver**

is a mains power source”). Thus, Claim 15 is claiming the disclosed and supported scenario where the circuit driver is a mains power source. Claim 15 is therefore supported by applications filed before March 16, 2013.

Finally, the Petition argues that '001 Patent Claim 9 is not supported by any application prior to March 16, 2013, because '001 Patent Claim 6 requires an “LED lighting device is configured to connect to a driver” and Claim 9 requires an LED lighting device “further comprises the driver.” Petition at 23. This is incorrect for several reasons. First, the “Pre-AIA Applications” clearly support a driver. *See, e.g.,* Ex. 1014, [0021], [0022]; Ex. 1018, [0025], [0030] (describing different drive settings for LED lighting devices). Second, there is nothing inconsistent in the structure of the claims. Independent Claim 6 of the '001 Patent does not specify where the driver is located; dependent Claim 9 is simply narrowing the independent claim by specifying the driver is part of the LED lighting device. Accordingly, the Board should reject this argument.

Petitioner has not shown that any claim had an effective filing date on or after March 16, 2013. The claims of the '341 Patent and its parent applications are fully supported by at least the '597 Application. The '597 Application was filed before March 16, 2013. Therefore, the '341 Patent is not subject to PGR and this Petition should be dismissed.

IV. THE PETITION SHOULD BE REFUSED BECAUSE PETITIONER FILED MULTIPLE AIA PETITIONS AGAINST THE SAME CLAIMS OF THE SAME PATENT WITHOUT JUSTIFICATION AND IN VIOLATION OF PTAB PROCEDURE

Petitioner has chosen to file an IPR alleging the same arguments as Grounds 3–5 in the present PGR Petition. *See Home Depot*, IPR2022-00143, Paper 1. As the Board has recognized, “[m]ultiple, staggered petitions challenging the same patent and same claims raise the potential for abuse.” *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357 et al., Paper 19 at 17 (Sept. 6, 2017). In *General Plastic*, the Board outlined seven factors to consider when exercising discretion to grant or deny institution, including: (a) the finite resource of the Board, (b) the requirement to issue a FWD not later than 1 year from institution, (c) whether the same petitioner previously filed a petition directed to the same claims of the same patent, (d) whether the petitioner knew or should have known of the prior art at the time the first petition was filed, (e) whether the petitioner has received the POPR or institution decision of the first petition prior to filing the second petition, (f) the length of time between when petitioner learned of the prior art of the second petition and the filing of the second petition, and (g) whether the petitioner adequately explains the time between petitions. *General Plastic*, IPR2016-01357 et al., Paper 19 at 9–10.

As this PGR is the first of the two petitions, not all factors apply. However, the two Petitions are filed by the same Petitioner, against the same claims, asserting the same prior art. In fact, the two Petitions present verbatim arguments, but for the exclusion of Grounds directed to 35 U.S.C. §112. *See Home Depot*, IPR2022-00143, Paper 1.

The July 2019 Trial Practice Guide (“Practice Guide”) confirms “one petition should be sufficient to challenge the claims of a patent,” and that “cases where two petitions are necessary is rare.” Practice Guide at 26. When a petitioner files multiple petitions directed to the same claims, the petitioner should identify (1) the ranking of the petitions in the order it wishes the Board to consider the merits, and (2) an explanation of the differences between the petitions and why the Board should institute additional petitions. Practice Guide at 27. Petitioner has neither addressed the ranking of its Petitions nor explained any difference between the two petitions (which it cannot as the second is a verbatim copy of the prior art grounds in this Petition). The present Petition should be denied institution because Petitioner has not followed those procedures and has not justified the filing of two overlapping petitions.

Petitioner is asking the Board to duplicate its work, reviewing the same patents and the same claims over the same prior art. The Board should not be

required to duplicate the work to be performed as a result of Petitioner's attempt to hedge its arguments. *General Plastic*, IPR2016-01357 et al., Paper 19 at 9–10.

V. NO CONSTRUCTION OF CLAIMS IS NECESSARY FOR THIS PETITION

Regarding the interpretation of claims in this Petition, the *Phillips* claim construction standard applies. *See* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340 (Oct. 11, 2018) (codified at 37 C.F.R. § 42.100(b)). At this stage, the Board need not construe terms unless the construction is relevant to the Institution Decision. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd. et al.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (Board “need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’”) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.* 200 F.3d 795, 803 (Fed. Cir. 1999)). Patent Owner acknowledges the constructions proffered by Petitioner, however does not acquiesce to these constructions. Should review be instituted, Patent Owner reserves the right to proffer constructions for any claim term at that time. Patent Owner contends that the terms of the claims can, at least at this stage, be given their plain and ordinary meaning for purposes of resolving Petitioner's arguments.

VI. THE PETITION FAILS TO SHOW THAT IT IS MORE LIKELY THAN NOT THAT ANY CLAIM OF THE '341 PATENT IS UNPATENTABLE

The Petition challenges certain claims of the '341 Patent on two types of grounds. Grounds 1 and 2 assert Claims 3, 10, and 17, and Claims 4, 11, and 18, respectively, are indefinite and therefore unpatentable under 35 U.S.C. §112. Petition at 29–33. The Petition also asserts that independent Claims 1, 8, and 15 and certain Claims which depend on these claims are unpatentable under 35 U.S.C. §§ 102 and 103 over Bruning (Ground 3, based on §102), Bruning and Kabel (Ground 4, based on §103), and Dowling and Mueller (Ground 5, based on §103). Petition at 33–83.

A. The Grounds Based on § 112 (Grounds 1–2) Do Not Establish Unpatentability is More Likely than Not

The Petition fails to establish that Claims 4–5, 11–12, and 17–18 are indefinite or lack written description or enablement because these Claims are supported by the specification and are not directed to impossible subject matter as Petitioner suggests.

1. Claims 3, 10, and 17 are Supported and Enabled by the Written Description of the '341 Patent

Claims 3, 10, and 17 claim “The LED lighting device of claim [1, 8, or 15, respectively], wherein the switching of the switch provides at least two different DC forward voltages to at least one of the first operating LED circuit or the at least one additional LED circuit.” Ex. 1001, cls. 3, 10, 17. Petitioner focuses exclusively on

its definition of “forward voltage” and fails to explain how the claimed “switch provid[ing] at least two different DC forward voltages” is not enabled by the ’341 Patent. Petition at 30. In fact, the ’341 Patent expressly describes the scenario in which a switch providing a second, different forward voltage would not only be possible, but would be beneficial. Ex. 1001, 4:33–53, 5:16–6:3 (describing scenarios where an LED device provides “a first forward voltage drive level when the two single voltage LED circuits are connected in parallel and a second forward voltage drive level ... when the at least two LED circuits are connected in series.”). Further, the second DC forward voltage is different than the first DC forward voltage. Ex. 1001, 4:33–53, 5:16–6:3 (describing the second forward voltage level as “twice the level of the first forward voltage drive level”).

According to Petitioner, Claims 3, 10, and 17 are directed to “impossible subject matter,” yet the ’341 Patent clearly describes a lighting device in which a switch providing a different voltage based on different configurations of circuits within a lighting device is plausible. Petition at 30. Similarly, even under Petitioner’s construction of the term “forward voltage,” the “minimum voltage difference required between the anode and cathode of the LEDs in the claimed circuit to allow current to flow through the LEDs” would change as the configuration and

therefore demands of the LED circuit change. These claims, therefore, are not directed towards “impossible subject matter” as Petitioner contends.

Finally, Petitioner’s indirect attempt to read any of the embodiments described in the ’341 Patent into Claims 3, 10, and 17 should be rejected. Petition at 31–32. Despite Petitioner’s assertion that “none of the four embodiments disclose or enable the full breadth of these claims,” the subject matter is clearly described in the specification sections quoted above. Petition at 32; Ex. 1001, 4:33–53, 5:16–6:3.

Because the Petition fails to establish Claims 3, 10, and 17 are indefinite, lack written description support or are not enabled, Ground 1 fails to fulfill Petitioner’s burden and the Petition should be denied.

2. Claims 4, 11, and 18 are Supported and Enabled by the Written Description of the ’341 Patent

Claims 4, 11, and 18 claim “The LED lighting device of claim [1, 8, or 15, respectively], wherein the switch is connected between the AC voltage power source and the LED lighting device.” Ex. 1001, cls. 4, 11, 18. According to the Petition, these Claims are indefinite as “drawn to impossible subject matter” because “[t]he switch cannot be both part of the LED lighting device and connected between that device and something else.” Petition at 33. Despite the specification explicitly enabling this claim, Petitioner also asserts “the claims are invalid for lack of written description and lack of enablement.” Petition at 33; *see also* Ex. 1001, 11:36–39.

Petitioner fails to consider that the claimed switch may act as the interface between the AC voltage power source and the LED lighting device. *See, e.g.*, Ex. 1001, Figs. 7, 9 (showing a switch located between a voltage source and the rest of a LED device). By acting as the interface, this switch is both *a part of* the LED lighting device (as the independent claims require) and *between* the AC voltage power source and the LED lighting device (as the dependent claims require).

Therefore, the additional limitation placed on the switch in Claims 4, 11, and 18 is both enabled by the '341 Patent and is non-impossible, valid subject matter.

B. The Grounds Based on §§ 102 and 103 (Grounds 3–5) Do Not Establish Unpatentability is More Likely than Not

The Petition fails to establish that the Challenged Claims would have been anticipated or obvious because: (1) the alleged prior art in each Ground fails to disclose the claimed switch of the Challenged Claims; (2) the Petition does not identify the differences between the claimed subject matter and the relied-upon references, as required for assessing obviousness under *Graham v. John Deere Co.*, 383 U.S. 1 (1966); and (3) an undue burden is shifted to the Board by the Petition's failure to adhere to the proper analytical framework for assessing obviousness.

1. The Legal Framework for Assessing Unpatentability

“In [AIA reviews], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid*

Tech., 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. §312(a)(3) (requiring *inter partes* review petitions to identify “with particularity...the evidence that supports the grounds for the challenge to each claim”)). Section 322(a)(3) contains an identical requirement, that post-grant review petitions identify “with particularity...the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. §322(a)(3). The burden of persuasion in a PGR “never shifts to the patentee.” *See DynamicDrinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). Moreover, Petitioner should not “place the burden on [the Board] to sift through information presented by the Petitioners, determine where each element [of the challenged claims] is found in [the cited references], and identify any differences between the claimed subject matter and the teachings of [the cited references.]” *Google Inc. v. Everymd.com LLC*, IPR2014-00347, Paper 9 at 25 (PTAB May 22, 2014).

To anticipate a claim under 35 U.S.C. §102, “a prior art reference must ‘disclose all elements of the claim within the four corners of the document,’ and it must ‘disclose those elements arranged as in the claim.’ ” *Microsoft Corp. v. Biscotti, Inc.*, 878 F.3d 1052, 1068 (Fed. Cir. 2017) (citing *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008)). Accordingly, “the dispositive question regarding anticipation [i]s whether one skilled in the art would reasonably

understand or infer from the [prior art reference's] teaching" that every claim element was disclosed in that single reference. *See Fujian Sanan Group Co., Ltd. et al v. Epistar Corporation*, IPR2018-00970, Paper 9 at 8 (PTAB November 20, 2018) (citing *Net MoneyIN, Inc.*, 545 F.3d at 1369) ("[A] patent challenger cannot rely on portions from different embodiments in a prior-art document to demonstrate anticipation."); *see also Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368 (Fed. Cir. 2003).

A claim is unpatentable under §103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective indicia of non-obviousness (i.e., secondary considerations). *Graham*, 383 U.S. at 17–18. "To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning,

based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

Finally, a petition seeking to establish obviousness based on more than one reference, as is the case here, “must articulate sufficient reasoning with rational underpinning to combine the teachings.” *Wilson Elec., LLC. v. Cellphone-Mate, Inc.*, IPR2018-01778, Paper 10 at 15 (PTAB April 23, 2019) (citing *KSR Int’l*, 550 U.S. at 418).

2. Ground 3: The Petition Does Not Establish That Independent Claims 1, 8 and 15 Would Have Been Anticipated by Bruning

The independent claims of the ’341 Patent recite “a switch capable of at least one of: (a) switching a voltage level input to at least one of the first operating LED circuit or the at least one additional LED circuit, or (b) switching the at least one additional LED circuit on or off, wherein (a) or (b) is selectable by a user switching the switch.” Ex. 1001, cls. 1, 8, 15. Petitioner relies on two components in Bruning to disclose the claimed switch: Q1 and the “panel light setting.” Petition at 37.

As an initial matter, Ground 4 confirms Bruning does not disclose a switch as the reference “does not explicitly describe how the ‘panel light setting’ is implemented.” Petition at 54. In other words, Bruning does not disclose how a user would perform the claimed switching operation on the “panel light setting.” Instead, Ground 4 requires the “manually-activatable slider bar” of Kabel to augment the

disclosure of the Bruning's "panel light setting." Petition at 54 ("Bruning discloses that the user controls a "panel light setting" in order to adjust the maximum light output of the red, green, and blue LED sub-arrays in the backlight, **but does not explicitly describe how the "panel light setting" is implemented.**"), 58. Petitioner's reliance on Kabel confirms Bruning alone does not disclose this element, resulting in Bruning failing to anticipate these Claims. *Microsoft*, 878 F.3d at 1068.

Regarding the two components of Bruning that Petitioner identifies as meeting the claim limitation (switch Q1 and the "panel light setting"), neither component, either alone or in combination, is a switch selectable by a user for switching a voltage level input or switching an additional circuit on or off, as required in each of Claims 1, 8, and 15. First, the Claims require that a user be able to modify the switch by the "user switching the switch." Ex. 1001, cls. 1, 8, 15. As both Bruning and the Petition confirm, switch Q1 is a transistor "controlled by controller 224," and is therefore not capable of being switched by a user. Ex. 1004, [0038]. This can be seen clearly in Figures 4, 4b, 4c, and 4d, which denote switches Q1, Q2, Q3, Q4, and Q5 with the transistor symbol. Figure 4 is reproduced below.

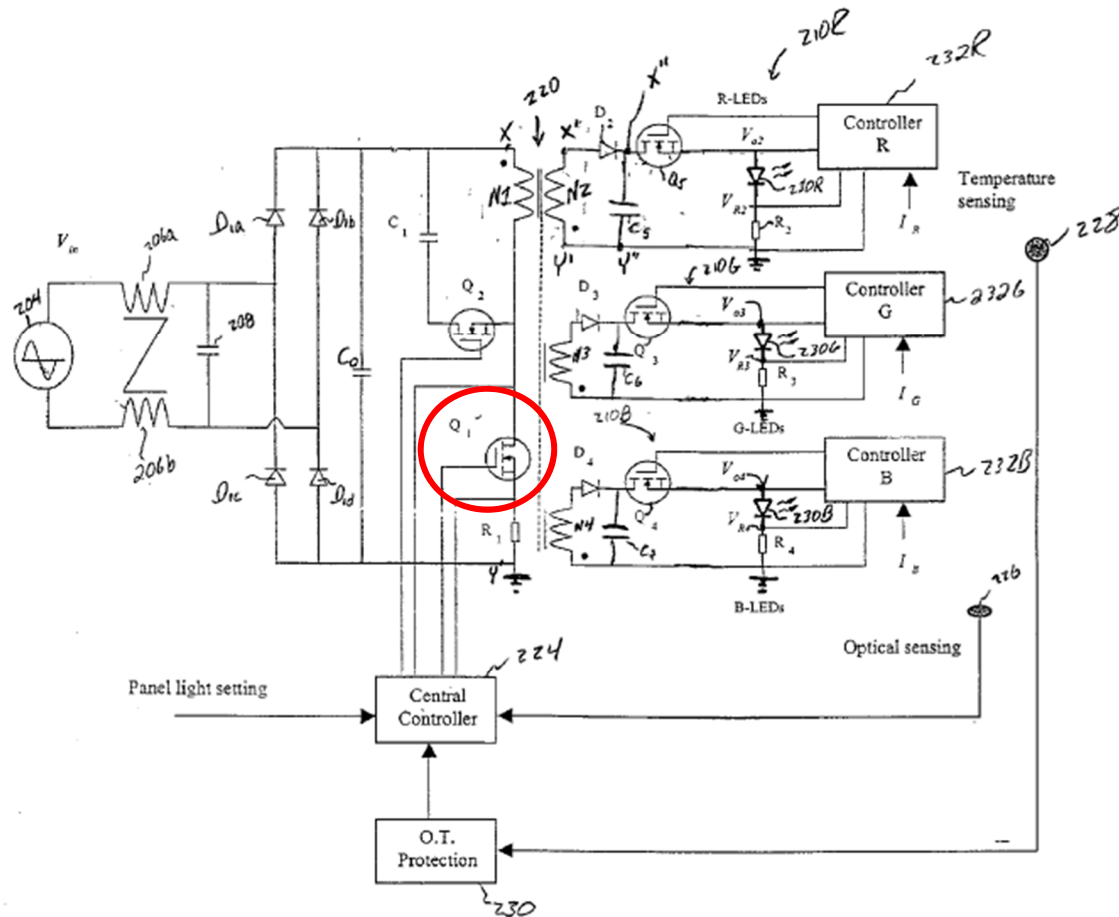


Fig. 4

Ex. 1004, Fig. 4 (annotated); *see also* Ex. 1004, Figs. 4b, 4c, 4d; Petition at 38–39. Indeed, it would be impossible for a user to perform the switching function of transistor Q1, which has cycles “each having a period on the order of **10 microseconds**.” Ex. 1004, [0033]. Because transistor Q1 of Bruning does not allow for a user to switch the transistor, it fails to anticipate these claims. Ex. 1004, [0038].

The Petition also cites the “panel light setting” as a switch that anticipates the claimed switch. Petition 39–40. Bruning, however, never describes the panel light

setting as a switch. Instead, the only reference to this component in Bruning describes it as an “input” to central controller 224, and does not disclose a switch that switches the voltage level input of any LED circuit or switches a circuit on or off. Ex. 1004, [0038]. This input line feeds into controller 224 which “adjusts the duty cycle of [transistor] Q1.” Ex. 1004, [0038]. This panel light setting, therefore, fails to disclose the claimed switch that switches the voltage level input of any LED circuit or switches any circuit on or off.

Bruning, therefore, fails to disclose “a switch capable of at least one of: (a) switching a voltage level input to at least one of the first operating LED circuit or the at least one additional LED circuit, or (b) switching the at least one additional LED circuit on or off, wherein (a) or (b) is selectable by a user switching the switch,” and therefore fails to anticipate Claims 1, 8, and 15. Institution should therefore be denied under 35 U.S.C. §324(a).

3. Ground 4: The Petition Does Not Establish That Independent Claims 1, 8, and 15 Would Have Been Obvious Over Bruning In View Of Kabel

The Petition fails to show that the combination of Bruning and Kabel teaches all the elements of independent Claims 1, 8, or 15. As such, the Petition does not fulfill the legal requirement for assessing obviousness. Institution should therefore be denied under 35 U.S.C. §324(a).

- a. The Petition Fails to Show That the Bruning-Kabel Combination Teaches the Claimed Switch of Claims 1, 8, and 15

As described above in Section VI.B.2, Bruning fails to disclose the claimed switch capable of switching a voltage level input of any LED circuit or switching any circuit on or off, and therefore fails to anticipate these claims. For substantially the same reasons, Bruning in view of Kabel fails to render the claimed switch obvious. Institution should therefore be denied under 35 U.S.C. §324(a).

In particular, the Petition relies first on transistor Q1, however this transistor does not allow “a user [to] switch[] the switch” as Claims 1, 8, and 15 require. Petition at 58 (referencing Ground 3). *See* Section VI.B.2. Further, the Petition presents no additional argument to suggest why it would have been obvious for this transistor to meet the claimed limitations. Indeed, it would be impossible for a user to perform the switching function of transistor Q1, which has cycles “each having a period on the order of **10 microseconds**.” Ex. 1004, [0033]. This component, therefore, fails to render the claimed switch capable of switching a voltage level input of any LED circuit or switching any circuit on or off obvious.

The Petition also relies on a “panel light setting” to render the claimed switch obvious. Petition at 58 (referencing Ground 3). This component, however, is merely an input to central controller 224 and is not a switch at all. *See* Section VI.B.2. In

an attempt to remedy the failure of Bruning to describe the claimed switch, the Petition turns to the “manually-activatable slider bar” of Kabel. Petition at 58–60.

Kabel describes a user interface 24 that is used for adjusting the brightness of a laptop display backlight. *See, e.g.*, Ex. 1005, Abstract. There is nothing in Kabel about using the slider bar to switch on or off an LED circuit, a function claimed in Claims 1, 8, and 15. Rather, Kabel uses the slider bar exclusively to provide a dimming function. *See* Petition 59–60 (collecting references regarding the dimming function of the slider bar); *see also* Ex.1005, [0028] (explaining low brightness settings are achieved by dimming the back light 12 “to its lowest level **before it turns off**”). The Petition also fails to describe how the dimming function described in either Bruning or Kabel performs the claimed “switching a voltage level input to at least one of the first operating LED circuit or the at least one additional LED circuit.” Because Petitioner has a non-delegable burden to identify with particularity, the evidence that supports their assertion, and they have not done so with this claim element, the Petition is deficient. 35 U.S.C. § 322(a)(3); *see also Intelligent Bio-Sys.*, 821 F.3d at 1369.

Claims 1, 8, and 15 require the switch be capable of switching a voltage level input to at least one of the LED circuits or switching the LED circuit on or off, and the Petition fails to rigorously explain how the prior art teaches these functions. As

a result, the Petition fails to explain how the prior art renders obvious the claimed “switch capable of at least one of (a) switching a voltage level input to at least one of the first operating LED circuit or the at least one additional LED circuit, or (b) switching the at least one additional LED circuit on or off.”

In addition to failing to teach a switch that switches voltage level input and switching LED circuits on or off, the Bruning-Kabel combination also fails to describe how the claimed switch achieves these functions by “a user switching the switch.” In particular, the user interface 24 of Kabel provides input to a controller 22, which is what ultimately performs the function of dimming the display. Ex. 1005, [0026] (“The controller 22...drives the pixels of the display module 16.... The user interface 24 may be any type of device that provides input to the controller 22....”). Because the Claims require the switching be “selectable by a user switching the switch” and the brightness is selected by the controller and not by a user switching the switch, Kabel also fails to describe the claimed switch. Because Bruning and Kabel fail to teach “a switch capable of at least one of: (a) switching a voltage level input to at least one of the first operating LED circuit or the at least one additional LED circuit, or (b) switching the at least one additional LED circuit on or off, wherein (a) or (b) is selectable by a user switching the switch,” it is not more likely than not that Claims 1, 8, and 15 are unpatentable as obvious.

b. The Petition Does Not Identify the Differences Between the Claimed Subject Matter and the Cited References

The Petition does not follow the framework set forth in *Graham* and entirely fails to address *Graham*'s second factor. Rather than resolving the *Graham* factors and then considering obviousness against this background, the Petition's obviousness analysis first postulates the proposed Bruning-Kabel combination and then considers the claimed subject matter against this postulated combination. Specifically, the Petition provides a summary of the primary reference, Bruning (Petition at 53, 33–34), then provides a summary of the secondary reference, Kabel (Petition at 53), and then describes the proposed Bruning-Kabel combination (Petition at 54–58). The Bruning-Kabel combination is proposed without identifying the differences between the claimed subject matter and either Bruning or Kabel (i.e., without consideration to *Graham*'s second factor), as demonstrated above in Section VI.B.3.a.

Notably, the Petition does not acknowledge which aspects of the claimed subject matter are absent from Bruning and it is unclear which aspects of the claimed subject matter necessitate the teachings from the secondary reference, Kabel. The Petition, for example, does not state which aspects of the claimed subject matter Bruning and Kabel independently disclose, or fail to disclose, with respect to independent Claims 1, 8, and 15. The Petition instead compares the subject matter

of independent Claims 1, 8, and 15 on an element-by-element basis exclusively to a “reference” that does not actually exist, i.e., the proposed Bruning-Kabel combination.

By comparing the claims exclusively to the hypothetical Bruning-Kabel combination, the Petition fails to identify the differences between the claims and the prior art per *Graham*’s second factor. *See Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20 at 20 (PTAB March 6, 2019) (denying institution for lack of particularity and stating “[c]ritically, however, the Petition fails to specify what Petitioner regards as the difference(s) between [the primary references] and the challenged claims....”) (*citing Graham*, 383 U.S. at 17.)

By not resolving *Graham*’s second factor, Petitioner’s obviousness analysis for Ground 4 is flawed.

c. The Petition’s Obviousness Analysis Places an Undue Burden on the Board

By forsaking the established framework from *Graham*, the Petition places a significant burden on the Board. The Board has consistently denied institution in similar instances.

In *Google Inc. v. Everymd.com*, for example, the Board disapproved of the petitioner’s dissociated use of summaries, quotations, and figures from the prior art and found that such an approach “[did] not address meaningfully the scope and

content of the prior art, and any differences between the claimed subject matter and the prior art.” IPR2014-00347, Paper 9 at 24–25. The Board observed that this approach “place[s] the burden on us to sift through the information presented by Petitioners, determine where each element of [the challenged claim] is found in [the prior art], and identify any differences between the claimed subject matter and the teachings of [the prior art].” *Id.*; *see also Adaptics*, IPR2018-01596, Paper 20 at 20; *see also Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016).

Similarly, this Petition places a significant burden on the Board to resolve the second *Graham* factor. The Board will be required to study Bruning and Kabel to ascertain what Bruning and Kabel do and do not teach with respect to the claimed subject matter. Stated differently, Petitioner has shifted a substantial amount of work to the Board (and Patent Owner), which stands in stark contradiction to the requirement of the patent statute’s directive for PGR petitions to identify “**with particularity** ... the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 322(a)(3); *see also Intelligent Bio-Sys.*, 821 F.3d at 1369.

The Petition fails to show with particularity why the claims are allegedly unpatentable, and the Board is not obligated to conduct the obviousness analyses that are the duty of the Petitioner. *See Google*, IPR2014-00347, Paper 9 at 24–25.

4. Ground 5: The Petition Does Not Establish That Independent Claims 1, 8, and 15 Would Have Been Obvious Over Dowling In View Of Mueller

The Petition fails to show that the combination of Dowling and Mueller teaches all the elements of independent Claims 1, 8, or 15. As such, the Petition does not fulfill the legal requirement for assessing obviousness. Institution should therefore be denied under 35 U.S.C. §324(a).

a. The Petition Fails to Show That the Dowling-Mueller Combination Teaches the Claimed Switch of Claims 1, 8, and 15

Petitioner asserts that mode switch or two-way switch 190 of Dowling renders obvious the claimed “switch capable of at least one of: (a) switching a voltage level input to at least one of the first operating LED circuit or the at least one additional LED circuit, or (b) switching the at least one additional LED circuit on or off, wherein (a) or (b) is selectable by a user switching the switch.” Petition at 70–73. This two-way switch, however, fails to teach each of the claimed limitations and therefore does not render the claim obvious. In particular, while the claim requires the switch that is both “selectable by a user switching the switch” and performs one of the claimed switching functions, the Petition does not allege how two-way switch 190 performs any switching function.

Instead, two-way switch 190 is part of the embodiment disclosed in Fig. 8 of Dowling which does not disclose or discuss the various modes that two-way switch 190 may select. Ex. 1006, [0062]. To the extent two-way switch 190 may select the modes discussed with respect to Fig. 1, the two-way switch 190 corresponds to the user interface 1, shown in Fig. 1. Ex. 1006, Fig. 1. User interface 1 shown in Fig. 1 controls a processor 2, which executes a program stored in the memory 6 to generate signals which controllers 3 convert into a form suitable for driving the LEDs. Ex. 1006, [0038]. While user interface 1 of Dowling (which may correspond to two-way switch 190) may be capable of receiving input from a user (e.g., changing a mode), it does not switch any LED circuits as the claim describes. Instead, user interface 1 is “used to select a program from the memory 6” or for a similar function. Ex. 1006, [0042]. Indeed, the citations which Petitioner relies on identify the modes as being “under control of a program executing on the processor 2 of Fig. 1,” which then sends a signal to controller 3 to enter one of the modes described in Dowling. Petition 71–72; Ex. 1006, [0044]–[0047].

The actual switching of the LEDs in the Dowling embodiment cited by the Petitioner is performed by controllers 3, not by user interface 1. Ex. 1006, Fig. 1 (showing user interface 1 connected to processor 2, which is connected to three controllers 3, each of which is connected to LED 4), [0040] (describing the

controllers as different types of electronic componentry, such as transistors). These controllers 3, are not, however, “selectable by a user switching the switch,” which the Claims explicitly require.

Furthermore, the Claims of the '341 Patent require that the claimed switch has “at least two positions each of which is connected to at least one circuit.” Ex. 1001, 7:42–45. Dowling does not indicate that controllers 3 contain “at least two positions each of which is connected to at least one circuit.” Ex. 1001, 7:42–45; Ex. 1006, Fig. 1 (showing each controller 3 connected to only one LED circuit 4). Because these controllers are the only alleged switching device in Dowling that are connected to and are capable of switching the LED circuits—either switching the voltage level input or switching the circuits on or off—Dowling fails to teach and fails to render obvious a switch that is selectable by a user and is capable of switching a voltage level input of LED circuits or switching an LED circuit on or off, features required of the switch claimed in Claims 1, 8, and 15.

Because the proposed Dowling-Mueller combination fails to teach each limitation, it is not more likely than not to render Claims 1, 8, and 15 unpatentable.

b. The Petition’s Reason to Look to Mueller was Inapplicable to Dowling

The Petition’s purported reason for looking to Mueller was inapplicable to Dowling. Therefore, the combination was not obvious.

In particular, the Petition claims Dowling “does not expressly teach how to convert [AC to DC] voltage,” and therefore POSITA would have looked to Mueller for an AC to DC converter, including Mueller’s bridge rectifiers and transformers. Petition at 65. The Petition is wrong. Dowling expressly discloses “an AC to DC converter.” Ex. 1006, ¶58. Therefore, there was no reason shown for POSITA to look to Mueller for this, much less to Mueller’s bridge rectifiers and transformers.

Where a feature provided by one reference is redundant with a feature already possessed by another reference, the Federal Circuit has held “hindsight provides the only discernable reason to combine the prior art references.” *Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d. 1342, 1369 (Fed. Cir. 2012). *See also Ex parte Toy*, Appeal No. 2004-000931, Ser. No. 10/180,355 (BPAI Apr. 21, 2004) (reversing obviousness rejection for impermissible hindsight where the primary “prior art ... already possesses” the same advantage purported to provide the rationale to combine).

Likewise, because the AC to DC converter allegedly provided by Mueller is redundant with the AC to DC converter already possessed by Dowling, hindsight provides the only discernible reason to combine them. The Petition’s only reason to combine the references—Dowling’s supposed lack of an AC to DC converter—is disproven by Dowling itself.

c. The Petition Does Not Identify the Differences Between the Claimed Subject Matter and the Cited References

The Petition does not follow the framework set forth in *Graham* and entirely fails to address *Graham*'s second factor. Rather than resolving the *Graham* factors and then considering obviousness against this background, the Petition's obviousness analysis first postulates the proposed Dowling-Mueller combination and then considers the claimed subject matter against this postulated combination. Specifically, the Petition provides a summary of the primary reference, Dowling (Petition at 61–62), then provides a summary of the secondary reference, Mueller (Petition at 62), and then describes the proposed Dowling-Mueller combination (Petition at 63–67). The Dowling-Mueller combination is proposed without identifying the differences between the claimed subject matter and either Dowling or Mueller (i.e., without consideration to *Graham*'s second factor), as demonstrated above in Section VI.B.4.a. For example, the Petition claims Dowling “does not expressly teach how to convert [AC to DC] voltage.” Petition at 65. Dowling does, however, expressly disclose “an AC to DC converter.” Ex. 1006, ¶58.

By comparing independent Claims 1, 8, and 15 on an element-by-element basis exclusively to a “reference” that does not actually exist, i.e., the proposed Dowling-Mueller combination, the Petition fails to identify the differences between the claims and the prior art per *Graham*'s second factor. *See Adaptics Ltd. v. Perfect*

Co., IPR2018-01596, Paper 20 at 20 (PTAB March 6, 2019) (denying institution for lack of particularity and stating “[c]ritically, however, the Petition fails to specify what Petitioner regards as the difference(s) between [the primary references] and the challenged claims....”) (citing *Graham*, 383 U.S. at 17.)

By not resolving the *Graham*’s second factor, Petitioner’s obviousness analysis for Ground 5 is flawed.

d. The Petition’s Obviousness Analysis Places an Undue Burden on the Board

By forsaking the established framework from *Graham*, the Petition places a significant burden on the Board. The Board has consistently denied institution in similar instances. *See, e.g., Everymd.com*, IPR2014-00347, Paper 9 at 24–25.

Similarly, this Petition places a significant burden on the Board to resolve the second *Graham* factor. The Board will be required to study Dowling and Mueller to ascertain what Dowling and Mueller do and do not teach with respect to the claimed subject matter. Stated differently, Petitioner has shifted a substantial amount of work to the Board (and Patent Owner), which stands in stark contradiction to the requirement of the patent statute’s directive for PGR petitions to identify “**with particularity** ... the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 322(a)(3); *see also Intelligent Bio-Sys.*, 821 F.3d at 1369.

The Petition fails to show with particularity why the claims are allegedly unpatentable, and the Board is not obligated to conduct the obviousness analyses that are the duty of the Petitioner. *See Google*, IPR2014-00347, Paper 9 at 24–25.

5. Because the Petition Does Not Establish That Any of Independent Claims are Unpatentable, the Grounds Challenging the Dependent Claims Must Also Fail.

In addition to challenging independent Claims 1, 8, and 15, the Petition challenges dependent Claims 2, 3, 5, 7, 9, 10, 12, 13, 14, 16, 17, and 19. Claims 2, 3, 5, and 7 depend from Claim 1, Claims 9, 10, 12, and 14 depend from Claim 8, and Claim 16, 17, and 19 depend from Claim 15. Because the Petition fails to show a reasonable likelihood of invalidating independent Claims 1, 8, or 15, the Grounds challenging the dependent Claims also fail to show a reasonable likelihood of success. The Petition therefore fails to set forth any Ground that warrants institution.

VII. THE BOARD SHOULD DENY INSTITUTION BECAUSE OF CO-PENDING LITIGATION INVOLVING THE '341 PATENT

The Board “is permitted, but never compelled” to institute an AIA proceeding. *Harmonic Inc. v. Avid Tech.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016); *see also* 35 U.S.C. § 324(c) (“Director shall determine whether to institute a post-grant review”); 37 C.F.R. § 42.208(c) (“Post-grant review shall not be instituted unless the Board decides that the information presented in the petition demonstrates that it is more likely than not that at least one of the claims challenged in the petition is

unpatentable.”). The Board may apply this discretion in consideration of “the integrity of the patent system, [and] the efficient administration of the Office” 35 U.S.C. § 326(b). The Board has denied institution “to minimize the duplication of work by two tribunals to resolve the same issue.” *Intel Corp. v. VLSI Tech. LLC*, IPR2019-01192, Paper 15 at 11 (PTAB Jan. 9, 2020).

In *Fintiv*, the Board outlined six factors that inform its decision “to deny institution in view of an earlier trial date in [a] parallel proceeding.” IPR2020-00019, Paper 11 at 6. The *Fintiv* analysis applies to both *inter partes* review (“IPR”) and PGR proceedings based on the similar discretion afforded to the Director in the governing statutes. *Supercell Oy v. Gree, Inc.*, PGR2020-00039, Paper No. 14 at 7 (PTAB Sept. 14, 2020); *see also, e.g., Daiichi Sankyo, Inc. v. Seagen Inc.*, PGR2021-00042, Paper 12 at 9–20 (PTAB June 24, 2021). In the *Fintiv* analysis, the Board weighs and considers the holistic effect of each of the following factors: (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 (“FWD”); (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 (collectively, “*Fintiv* factors”). *Id.* at 5–15.

Pursuant to the *Fintiv* factors, institution should be denied because the ’341 Patent is asserted against Petitioner in the co-pending Georgia Litigation and the Georgia Litigation is likely to resolve invalidity issues on overlapping issues prior to any FWD (if this proceeding is instituted). Denying institution of PGR is consistent with recent Board decisions, preserves the integrity of the patent system, promotes the efficient administration of Office resources, and minimizes duplicative work by two different tribunals. *See id.*; *Samsung Elecs. Co., Ltd. v. Ancora Techs., Inc.*, IPR2020-01184, Paper 11 at 18 (PTAB Jan. 5, 2021); *Google LLC v. Personalized Media Commc’ns, LLC*, IPR2020-00724, Paper 19 at 6, 11 (PTAB Aug. 31, 2020).

A. Factor 1: The District Court Has Not Issued a Stay

When a Petitioner represents it will move to stay a district court lawsuit if PGR is instituted, *Fintiv* factor 1 should be viewed as neutral. *See Sand Revolution II, LLC v. Continental Intermodal Grp. Trucking LLC*, IPR2019-01393, Paper 24 at 7 (PTAB June 16, 2020); *MediaTek Inc. v. Nippon Tel. and Tel. Corp.*, IPR2020-01607, Paper 12 at 12 (PTAB April 2, 2021) (“Petitioner represents it will move to

stay the District Court Lawsuit if institution is granted but does not know how the District Court will rule ... [t]hus, this factor should be viewed as neutral.”).

Petitioner moved to stay the Georgia Litigation on December 21, 2021. Ex. 2004. In light of the substantial work that has already been completed by the parties before the case was transferred, Patent Owner has moved for an expedited schedule and opposed the requested stay. Ex. 2001.

The first *Fintiv* factor is merely neutral because the Board cannot know whether the judge in the Georgia Litigation will in fact grant its motion to stay, especially considering substantial work has already completed before the case was transferred to this venue. *Sand Revolution II*, IPR2019-01393, Paper 24 at 7; *MediaTek*, IPR2020-01607, Paper 12 at 12; *see also Wonderland Nurserygoods Co. v. Kids II, Inc.*, No. 1:13-CV-01114-ELR, 2016 WL 3958733, at *3 (N.D. Ga. Feb. 10, 2016) (“If a stay is entered pending resolution of IPR, the final determination may not be speedy, particularly when the district court litigation has reached an advanced stage prior to institution of the IPR.”).

B. Factor 2: Proximity of the Scheduled Trial Date to the Board’s Statutory Deadline for Written Decision

The institution decision will issue by May 31, 2022. 35 U.S.C. § 324(c)(1). If instituted, the FWD will issue by May 31, 2023. 35 U.S.C. § 326(a)(11). Before the case was transferred to Georgia, the parties were on track to go to trial on

December 7, 2022, more than *five full months* prior to when a FWD is expected to issue (if PGR is instituted). Ex. 1013, 4. While it is improper to speculate as to how a particular judge might rule, it is worth recognizing the trajectory that the parties were on before the case was transferred. *Fintiv*, IPR2020-00019, Paper 15 at 12 (PTAB May 13, 2020) (informative). Because the parties were preparing for trial more than *five full months* prior to any FWD if the PGR is instituted, *Fintiv* factor two weighs in favor of discretionarily denying institution. Ex. 1013, 4.

C. Factor 3: The Parties and Court Will Have Invested Substantial Resources in the Texas and Georgia Litigations Prior to the Institution Decision

“[D]istrict court claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.” *Fintiv*, IPR2020-00019, Paper 11 at 9–10. The *Fintiv* analysis also considers “the amount and type of [all] work already completed” to determine whether “the parallel proceeding is more advanced...and instituting would lead to duplicative costs.” *Id.*

Considering the substantial work invested by both parties prior to the case being transferred, institution would certainly lead to duplicative costs. For example, in the Texas case, all claim construction briefing was complete and a joint claim construction statement was submitted. Ex. 2006. Indeed, the parties were only a few days from the scheduled *Markman* hearing when Petitioner/Defendant’s Motion

to Transfer was granted. Ex. 2005 (setting the *Markman* hearing for December 20, 2021 before transfer was granted on December 8, 2021). If the Georgia court picks up where the Texas court left off, a *Markman* hearing is imminent and trial is likely to come before a FWD is due. If, on the other hand, the Georgia court decides to begin anew, the work completed in Texas will be re-done in Georgia, and will be duplicated a third time in this venue. Either way, there will be substantial duplication of resources in the PGR if instituted, such that denial of institution is appropriate.

In addition, Petitioner's delay in filing its Petition has resulted in significantly more work being undertaken by the parties and both the Texas and Georgia courts. The case cited in the Petition notes it is reasonable for Petitioner to file its Petition "approximately three months after first receiving notice of Patent Owner's infringement positions for all asserted claims." *Dish Network L.L.C. v. Broadband iTV, Inc.*, IPR2020-01359, Paper 15 at 20 (PTAB Feb. 12, 2021); Petition at 7. Petitioner delayed more than *five months* after being served with Patent Owner's infringement contentions, and nearly nine months after service of the complaint. Ex. 1012; Ex. 1011. Petitioner cannot justify the additional delay which has resulted in the parties having expended significant resources in both the Texas Litigation and Georgia Litigation, and will result in even more resources being expended prior to an institution decision.

The third *Fintiv* factor weighs in favor of discretionarily denying institution.

D. Factor 4: The Issues Raised in the Petition Overlap Substantially with Issues Raised in the Georgia Litigation

There is significant overlap between the references and invalidity arguments that Petitioner expects both the Board and the Court to evaluate. For example, Petitioner raises §112 challenges against both Claims 3 and 4 in the Texas Litigation. Ex. 1002, 18. Petitioner raises the same challenges in Grounds 1 and 2 in the present Petition. Petitioner has also based their preliminary invalidity position on Dowling and Mueller, the same prior art asserted in Ground 5. Ex. 1002, 3, 5. Further, Petitioner challenges three independent claims, two of which (Claims 1 and 8) are asserted against Petitioner/Defendant in the Georgia Litigation. The third challenged independent claim, Claim 15, contains significant similarities to independent Claims 1 and 8. Therefore, at least three of the five Grounds in this Petition are direct duplications of the invalidity positions Petitioner/Defendant has raised in the related District Court litigation.

The extensive similarities between the issues raised in the present Petition and those raised in the related litigation needlessly duplicates work to be done by the Court, the Board, and Patent Owner. The mere existence of non-overlapping claims does not support an assertion that there will be no overlap between issues raised in this Petition and the related litigation, especially since the non-overlapping claims

also depend on asserted Claims 1, 8, and substantially similar Claim 15. *See Samsung*, IPR2020-01184, Paper 11 at 20.

Further, while Petitioner has stipulated that they would not pursue the same grounds in the related litigation, they have chosen to pursue the same grounds in a separate *inter partes* review petition. *See Home Depot USA, Inc. v. Lynk Labs, Inc.*, IPR2022-00143, Paper 1 (Nov. 24, 2021). Petitioner electing to pursue these grounds in related challenges highlights that the stipulation holds no weight. As such, *Fintiv* factor four weighs in favor of denying institution.

E. Factor 5: Petitioner is a Defendant in the Georgia Litigation

Petitioner is the defendant in the Georgia Litigation, which weighs in favor of discretionary denial. *See Sand Revolution*, Paper 24 at 12–13 (“Although it is far from an unusual circumstance that a petitioner in *inter partes* review and a defendant in a parallel district court proceeding are the same ... this factor weighs in favor of discretionary denial.”); *Samsung*, IPR2020-01184, Paper 11 at 22, 23 (“[I]t is undisputed that Petitioner is a co-defendant in the parallel litigation ... [t]herefore, this factor weighs in favor of exercising our discretion to deny institution under § 314(a).”). This factor thus favors discretionarily denying institution. Section 314(a) covering *inter partes* reviews conveys the same requirements as section 324(a) covering PGRs, but for a different threshold standard (“reasonably likely”

standard versus “more likely than not” standard). *Compare* 35 U.S.C. §314(a) with 35 U.S.C. §324(a).

F. Factor 6: Other Considerations That Influence the Board’s Exercise of Discretion Weigh in Favor of Denying Institution

The final *Fintiv* factor is a “catchall” that takes into account any other relevant circumstances. “The decision whether to exercise discretion to deny institution under § 314(a) is based on ‘a balanced assessment of all relevant circumstances in the case, including the merits.’” *Verizon*, IPR2020-01292, Paper 13 at 17–18 (citing Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019)). Petitioner argues that “[t]he Challenged Claims are clearly invalid.” Petition at 9. Petitioner’s subjective opinion regarding the strength of this position, however, does not tip the factors in favor of institution. *See Samsung*, IPR2020-01184, Paper 11 at 24.

To the contrary, there are multiple reasons Petitioner’s invalidity grounds lack merit.

First, Petitioner’s §112-directed Grounds ignore sections of the written description that enable the Challenged Claims. In particular, the ’341 Patent describes a switch that changes the forward voltage in response to the LED circuits being switched from being arranged in parallel to being arranged in series.

Second, Petitioner's prior art-related Grounds fail to show a switch that is selectable by a user that also switches the voltage level input of an LED circuit or switches an LED circuit on or off. The switches Petitioner relies on direct a second switch, such as a transistor or other controller, to actual perform the switching function. As independent Claims 1, 8, and 15 explain the same switch is both selectable by a user and performs these functions, Petitioner's prior art fails to anticipate or render obvious these claims.

This factor therefore weighs in favor of denying institution.

G. Holistic Assessment of *Fintiv* Factors

The *Fintiv* factors are to be assessed holistically. *Fintiv*, Paper 11 at 6. In light of the transfer of the case from Texas to Georgia, there is some uncertainty as to the schedule in the related litigation. However, even before transfer was granted, Petitioner delayed preparation of the present Petition. The Petition was filed five months after the infringement contentions were served. Petition at 7. Compared to the Board's finding that a three-week delay was reasonable in *Apple Inc. v. Koss Corporation*, IPR2021-00255, Paper 22 at 14 (PTAB June 3, 2021), a five-month delay is not a reasonable delay. This delay is material to the holistic analysis because it substantially increases the investment required by both parties and the Court in the Georgia Litigation leading up to the date of the institution decision. Even now, the

parties have completed claim construction briefing. Regardless of whether this investment directly relates to the validity issues, they are reflective of the inefficiency caused by Petitioner's delay. *Fintiv*, IPR2020-00019, Paper 11 at 5–6 (finding that a holistic consideration of the factors should focus on “efficiency, fairness, and the merits.”).

The holistic assessment shows that the Board should exercise its discretion to deny institution.

VIII. CONCLUSION

For the reasons set forth above, the PGR should not be instituted.

Dated: February 28, 2022

Respectfully submitted,

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CERTIFICATION UNDER 37 C.F.R. § 42.24(d)

Under the provisions of 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the word count for the foregoing Patent Owner's Preliminary Response totals 10,580 words, which is less than the 18,700 words allowed under 37 C.F.R. § 42.24(b)(1).

Dated: February 28, 2022

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CERTIFICATION OF SERVICE UNDER 37 C.F.R. § 42.6(E)(4)

I hereby certify that on February 28, 2022, I caused a true and correct copy of the foregoing to be served on the following counsel for Petitioner by electronic mail to the following email addresses:

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