

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 PGR2023-000016
U.S. Patent No. 11,297,705

PATENT OWNER REQUEST FOR DIRECTOR REVIEW

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION	1
II. ISSUES OF LAW AND POLICY PRESENTED.....	1
III. ARGUMENT.....	3
A. FOR THE FIRST CHALLENGED LIMITATION, THE BOARD MISCHARACTERIZES PO’S ARGUMENT AS “OBVIOUSNESS”	4
B. THE BOARD INCORRECTLY ASSERTS THAT THE PO HAS NOT ADDRESSED THE “SPECIFIC CLAIM LANGUAGE” AND “ITS CONTEXT WITHIN THE CLAIM”	9
C. THE BOARD’S DETERMINATION ON THE SECOND CHALLENGED LIMITATION IS ERRONEOUS.....	11
IV. CONCLUSION	15

TABLE OF AUTHORITIES

Page(s)

CASES

<i>Ariad Pharm., Inc. v. Eli Lilly and Co.</i> , 593 F.3d 1336 (Fed. Cir. 2010)	5, 10
<i>PowerOasis, Inc. v. T-Mobile USA, Inc.</i> , 522 F.3d 1299 (Fed. Cir. 2008)	7
<i>University of Rochester v. G.D. Searle & Co.</i> , 358 F.3d 916 (Fed. Cir. 2004)	6

STATUTES

35 U.S.C. § 102	2
35 U.S.C. § 120	3
35 U.S.C. § 121	3
35 U.S.C. § 282	2
35 U.S.C. § 321	2
35 U.S.C. § 365	3

AGENCY DECISIONS

<i>Mylan Pharms. Inc. v. Yeda Res. & Dev. Co.</i> , PGR2016-00010, Paper 9 (PTAB Aug. 15, 2016)	2
<i>Trican Industries, Inc. v. Little Giant Ladder Systems, LLC</i> , PGR2021-00044, Paper 10 (PTAB Aug. 3, 2021)	2, 10
<i>US Endodontics, LLC v. Gold Standard Instruments, LLC</i> , PGR2015-00019, Paper 17 (PTAB Jan. 29, 2016)	2

I. INTRODUCTION

On August 8, 2023, the Board issued a Decision Granting Institution of Post-Grant Review (“DI” or “Institution Decision”) in PGR2023-000016. The Board determined that U.S. Pat. No. 11,297,705 (“the ’705 Patent”) is eligible for post-grant review (“PGR”) because certain claims of the ’705 Patent are allegedly not entitled to a priority date before March 16, 2013. DI, Paper 8, 19-31.

The Board’s analysis focused on two claim limitations from the ’705 Patent claims: (1) “wherein the switch is electrically connected between the DC voltage output and at least one of the first operating LED circuit or the at least one additional LED circuit” (claims 1, 8, 15); and (2) “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” (claims 3, 10, 17). The Board’s analysis ignored express disclosure in the priority applications. The Board instead characterized the claim limitations in a manner that is inconsistent with the disclosure in the priority applications. The Board’s §112 analysis is incorrect, and institution should therefore be denied.

II. ISSUES OF LAW AND POLICY PRESENTED

PGRs allow a patent to be challenged under § 102 and § 103 on the basis of a wide range of prior art beyond patents and printed publications, including prior art in public use, on sale, and otherwise available to the public. 35 U.S.C. §§ 102,

321(b). PGRs also permit a patent to be challenged under numerous other statutory provisions, including patent-eligibility (§ 101), written description and enablement ((§ 112(a)), and definiteness (((§ 112(b)). 35 U.S.C. § 321(b).

Additionally, the scope of challenges permissible for PGRs is commensurate with validity challenges that can be presented in district court (35 U.S.C. § 282(b)(2)), creating the risk that in some cases validity issues might not be decided in the most efficient manner if there is both a PGR and a district court action.

For these reasons, the AIA restricted PGRs to only patents having an effective filing date after March 16, 2013. AIA § 6(f)(2)(A). Further, a PGR can only be lodged within the first nine months of a patent's issue date. 35 U.S.C. § 321(c).

The Petitioner has the burden of establishing eligibility for post-grant review. *See Trican Industries, Inc., v. Little Giant Ladder Systems, LLC*, PGR2021-00044, Paper 10, 14 (PTAB Aug. 3, 2021); *Mylan Pharms. Inc. v. Yeda Res. & Dev. Co.*, PGR2016-00010, Paper 9, 10 (PTAB Aug. 15, 2016); *US Endodontics, LLC v. Gold Standard Instruments, LLC*, PGR2015-00019, Paper 17, 9–12 (PTAB Jan. 29, 2016).

The AIA provides that the post-grant review provisions set forth in § 6(d) apply only to patents subject to the first-inventor-to-file provisions of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (September 16, 2011) (“AIA”). *See* AIA § 6(f)(2)(A) (provisions of Section 6(d) “shall apply only to patents described in section 3(n)(1)”). For the '705 Patent to be eligible for post-

grant review, the Petitioner must demonstrate that the application for the '705 Patent (and/or that a priority patent or application of the '705 Patent under 35 U.S.C. §§ 120, 121, or 365(c)) contains or contained at any time at least one claim that was not entitled to an effective filing date before March 16, 2013. *See* AIA § 3(n)(1).

III. ARGUMENT

As decided by the DI, post-grant eligibility turned on whether two limitations from issued claims in the '705 Patent are supported by priority applications that were filed before March 16, 2013. DI, 19-31.

As discussed above, the burden is on Petitioner to prove PGR eligibility. *Trican*, PGR2021-00044, Paper 10 at 14. In the instant PGR, Petitioner provided unsupported allegations that pre-AIA priority documents do not support the challenged limitations supported by conclusory expert opinions that merely copy and paste from the Petition. Pet., 13-18, Ex. 1002 [Neikirk Decl.], ¶¶33-47. In the Patent Owner Preliminary Response (“POPR”), Patent Owner (“PO”) provided detailed explanations of where the pre-AIA priority documents supported the allegedly-missing limitations, supported by legal and factual analysis. The DI accepted each of the Petition’s bare allegations, disregarded the reasoned analysis provided in the POPR and in some places faulted the POPR for not addressing arguments that were not in the Petition. Thus, the DI effectively and improperly placed the burden on the PO to disprove PGR eligibility.

A. FOR THE FIRST CHALLENGED LIMITATION, THE BOARD MISCHARACTERIZES PO’S ARGUMENT AS “OBVIOUSNESS”

The first limitation addressed in the DI is whether “wherein the switch is electrically connected between the DC voltage output and at least one of the first operating LED circuit or the at least one additional LED circuit” from independent claims 1, 8, and 15 of the ’705 Patent is supported by PCT Application No. PCT/US2010/001597 (Ex. 1018, filed 5/28/2010) (hereinafter “the ’597 PCT”) and/or U.S. Provisional Application No. 61/217,215 (Ex. 1014, filed 5/28/2009) (hereinafter “the ’215 Provisional”). *See* Pet., 13-15; POPR, 39-46; DI, 19-25.

Throughout the POPR, PO provides citations to priority documents demonstrating § 112 support for the challenged limitation. For example, the PO states that “the ’215 Provisional *discloses* this limitation.” POPR, 39-40 (emph. added). The PO proceeds to explain how the ’215 Provisional’s description of a dimmer switch between an LED driver and an LED circuit discloses the claimed limitation. POPR, 39-40 (citing Ex. 1014 [’215 Provisional], ¶¶[0018]-[0022]). PO is explaining that the limitation is met because it is disclosed in the priority document, *not because it is obvious*.

PO also explains that the above limitation is disclosed in the ’215 Provisional because the disclosed embodiments “can be combined with each other” (POPR, 41 (citing Ex. 1014, ¶[0016])) such that “the ’215 Provisional teaches its different

embodiments can be combined, including the dimmer switch.” POPR, 41. Thus, the inventor disclosed the claimed combination of elements in the ’215 Provisional. *Ariad Pharm., Inc., v. Eli Lilly and Co.*, 593 F.3d 1336, 1351 (Fed. Cir. 2010) (the written description requirement is satisfied if the specification reasonably conveys to a POSITA that the inventor had possession of the subject matter at issue). Again, PO is explaining that the priority document discloses the limitation at issue, not that it renders it obvious.

In response to the Petitioner’s assertion that the dimmer switch in the ’215 Provisional is coupled to an AC voltage output, not the DC voltage output as claimed in the ’705 Patent, the PO identifies multiple citations disclosing LED drivers providing a *DC* voltage output to LED circuits. POPR, 41-42 (citing Ex. 1014, ¶ [0019]) (LED driver with “relatively fixed” “output voltage of 12V”). Elsewhere, the ’215 Provisional discloses an LED circuit driver providing a “relatively fixed voltage,” (i.e., DC voltage), and additionally it discloses an LED circuit driver with a bridge rectifier¹ that outputs DC voltages to LED circuits. POPR, 42 (citing Ex. 1014, ¶[0022], Figs. 16-19). The ’215 Provisional also discloses “drivers according

¹ The Petition agrees that a bridge rectifier provides a DC output voltage.

to the invention are described as providing ‘relatively constant’ or ‘fixed’ voltage,” i.e., they provide DC voltage. Ex. 1014, ¶[0017]. Accordingly, the ’215 Provisional discloses a dimmer switch between a DC voltage output and the LED circuits. Thus, PO again explains what the ’215 Provisional expressly discloses, not what it renders obvious.

The Board erroneously concludes that the PO is not demonstrating the priority documents provide literal § 112 support for the challenged limitations but is instead “argu[ing] that such disclosure would have rendered the limitation obvious to the skilled artisan.” DI, 23. The Board misstates PO’s position. As demonstrated above, nowhere does the PO argue a claim limitation is supported because it is obvious. The Board’s evidence for this charge is PO’s statement that “the ’215 Provisional clearly *teaches* the dimmer switch *can be* placed at the output of the LED driver.” DI, 23 (citing POPR, 40) (Board italics). However, the PO’s use of “teaches” here is plainly synonymous with “discloses,” and the DI provides no evidence or authority for its position that “teaches” means “render obvious.”² The PO’s statement that the

² See, e.g., *University of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, n.5 (Fed. Cir. 2004) (“the role of the specification is to teach, both what the invention is (written description) and how to make and use it (enablement)”).

dimmer switch “can be placed at the output of the LED driver” reflects that the ’215 Provisional discloses an embodiment where the dimmer switch *is* placed at the output of the LED driver, not that it would be merely obvious to place it there. This is supported by the language of the ’215 Provisional, which states:

[T]he LED circuit driver may be coupled to a dimmer switch that regulates voltage ... that allows for adjustability of the otherwise relatively fixed voltage ... output of the LED circuit driver. The LED circuits get brighter as the voltage ... of the LED circuit driver output is increased to the LED circuits.

Ex. 1014, ¶[0022]. The passage plainly discloses a dimmer switch that is connected to the DC output of an LED circuit driver because the dimmer switch provides adjustability of the voltage delivered to the LED circuits. *See* POPR, 40. *See PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306 (Fed. Circ. 2008) (“disclosure does not have to provide *in haec verba* support in order to satisfy the written description requirement”). Accordingly, the PO demonstrates that the ’215 Provisional provides literal support for the disputed limitation of claims 1, 8, and 15, not that it is obvious.

The Board again argues that the PO relies on an obviousness-based written description argument because the PO allegedly fails to explain how the ’215 Provisional “actually or inherently discloses” the claimed switch between the DC voltage output of the LED driver and an LED circuit. DI, 23-24. The Board

misunderstands PO's statement that the dimmer switch "could be" combined with "other LED circuits in the specification." DI, 23 (citing POPR, 40-41). The PO's argument is not that it would be obvious to combine various embodiments. Rather, PO's point is that by its very terms the '215 Provisional discloses that its embodiments are intended to be combined, including the dimmer embodiment with the LED circuit embodiments.

For example, ¶[0019] of the '215 Provisional describes an LED circuit driver "for providing a relatively fixed voltage" such as "an output voltage of 12V ... as a relatively constant output to a load having one or more LED circuits." Ex. 1014, ¶[0019]. An "LED circuit" can be regulated "to the known relatively fixed voltage ... of the LED circuit driver." Ex. 1014, ¶[0021]. Paragraph [0022] provides that: "According to other aspects of the invention, the LED circuit driver may be coupled to a dimmer switch that regulates voltage ... that allows for adjustability of the otherwise relatively fixed voltage ... output of the LED circuit driver." Thus, the '215 Provisional discloses that the dimmer switch embodiment is coupled to the LED circuit driver disclosed in the other embodiments of the document.

Accordingly, '215 Provisional paragraphs [0019]-[0022] disclose a dimmer switch that is electrically connected between the DC output of an LED driver and one or more LED circuits. Thus, the priority document expressly discloses the disputed limitation.

B. THE BOARD INCORRECTLY ASSERTS THAT THE PO HAS NOT ADDRESSED THE “SPECIFIC CLAIM LANGUAGE” AND “ITS CONTEXT WITHIN THE CLAIM”

In addressing the first limitation (“wherein the switch is electrically connected between the DC voltage output ...”), the Board also asserts that the PO does not “sufficiently address the specific language” of the limitation and “its context within the claim as a whole” because the ’215 Provisional allegedly does not disclose that the switch “also ‘switch[es] a voltage level input to at least one of the first operating LED circuit or the at least one additionally LED circuit’ or ‘switch[es] the at least one additional LED circuit on or off’”. DI, 22. This ignores PO’s arguments and the plain language of the priority documents.

The ’215 Provisional indicates that the dimmer switch “regulates voltage” to “allow[] for adjustability of the relatively fixed voltage” DC output of the LED driver delivered to the LED circuits (i.e., a “first operating LED circuit or at least one additional LED circuit.”). Ex. 1014, ¶[0022]. That is, the dimmer switch of the ’215 Provisional can “switch[] a voltage level input” to an LED circuit or “switch[] [an] LED circuit on or off” as recited elsewhere in the claim.

While the Board criticizes PO for not addressing how the “switch must also ‘switch[] a voltage level input to at least one of the first operating LED circuit or the at least one additional LED circuit’ or ‘switch[] the at least one additional LED circuit on or off,’ as recited, for example, in claim 1,” (DI, 22), nothing in the Petition

argued these limitations lacked support. Pet., 13-15. PO cannot be faulted for failing to address arguments with respect to claim 1 that the Petition did not make. The burden is on Petitioner to establish PGR eligibility, not on PO to disprove it. *Trican*, PGR2021-00044, Paper 10 at 14.

The Board’s observation that only three of the twenty-one figures in the ’215 Provisional depicts a switch and that those three figures disclose a switch connecting to an AC (not DC) voltage output is irrelevant. DI, 22. The written description requirement can be satisfied by words alone. *See Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010). As discussed above, ¶¶[0019]-[0022] expressly disclose a dimmer switch that is coupled between an LED driver providing a “relatively fixed [i.e., DC)] voltage output” and one or more LED circuits. Additionally, Figures 16-19 of the ’215 Provisional (which “can be combined” with the dimmer embodiment (Ex. 1014, ¶[0016])) depict bridge rectifiers providing a fixed (DC) voltage output.³ POPR, 42. These figures provide further confirmation that the ’215 Provisional discloses a dimmer switch connected to a DC voltage

³ The Petition acknowledges that bridge rectifiers provide a DC voltage output. Pet., 10.

output of a driver on one hand and to LED circuits on the other pursuant to the limitation at issue.

C. THE BOARD’S DETERMINATION ON THE SECOND CHALLENGED LIMITATION IS ERRONEOUS

The second limitation challenged by the Petitioner is whether “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” in claims 3, 10, and 17 of the ’705 Patent is supported by the ’597 PCT and/or ’215 Provisional. Pet., 16-18; POPR, 46-51; DI, 25-31.

The language of claims 3, 10, and 17 encompasses the scenario of the switch providing at least two different selectable DC forward voltages to the first recited LED circuit. DI, 28. The Board found that the limitation at issue allegedly did not find support in the ’597 PCT for the claimed switch providing at least two different selectable DC forward voltages to the claimed LED circuit. DI, 28-29.

The DI ignores the fact that two LED circuits connected together constitute a larger LED circuit. The ’597 PCT describes a “multi-voltage” DC LED device providing for “forward voltage drive selection.” Ex. 1018, ¶[0025]. The multi-voltage DC LED device is a circuit made up of at least two constituent “single voltage series LED circuits,” each having a “forward voltage” of 6V, 12V, 24V, 120V or other DC voltage level. *Id.* When the single voltage LED circuits in the

multi-voltage LED device are connected in parallel, the multi-voltage LED device (i.e., an LED circuit) is driven with a “first forward voltage drive level.” *Id.* When the single voltage LED circuits are connected in series, the multi-voltage LED device is driven with a “second forward voltage drive level.” *Id.* In other words, the multi-voltage LED device is itself a circuit that can be switched to receive at least two different DC forward voltages. POPR, 46-47. Accordingly, the ’597 PCT provides support for the disputed limitation of a switch for switching between two different selectable DC forward voltages provided to an LED circuit.

The ’215 Provisional provides an independent basis for § 112 support of the claimed “switch provid[ing] at least two different [] forward voltages” to the LED circuit. Specifically, the ’215 Provisional discloses a dimmer switch receiving the voltage output of an LED driver and adjusting the voltage level delivered to the LED circuits. Ex. 1014, ¶[0022]. The dimmer switch is expressly described as providing more than one different forward voltage to an LED circuit depending on the desired brightness. *Id.* (“adjust[ing] of the otherwise relatively fixed voltage” delivered to the LED circuits that “get brighter as the voltage ... is increased”). POPR, 48, 50. The ’215 Provisional also describes a multi-voltage LED chip with at least two constituent LED circuits each having a specified forward voltage so there are at least “two different forward voltages.” *Id.*, ¶[0012]. The multi-voltage LED chip “operates on a switch having at least two positions each of which is connected to at

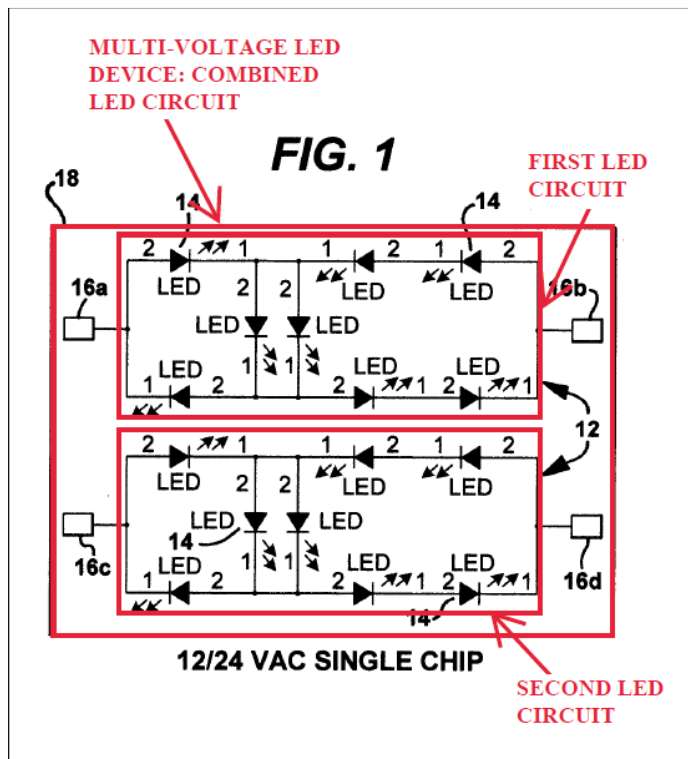
least one circuit within” the multi-voltage LED chip. *Id.*, ¶[0013]. *See* POPR, 50-51. Thus, the ’215 Provisional teaches a switch connected to one circuit or multiple circuits for providing multiple different forward voltage levels. Accordingly, claims 3, 10, and 17 of the ’705 Patent are supported by the ’215 Provisional.

The Board errs because it fails to recognize that the multi-voltage LED device of the ’597 Patent is itself a circuit notwithstanding that it is constructed of other circuits. The Board states:

The cited portions of the ’597 PCT disclose “a first forward voltage drive level when the two single voltage LED *circuits* are connected in parallel and a second forward voltage drive level that is twice the level of the first forward voltage drive level when the at least two LED *circuits are connected in series.*” (cite omitted) That is, the forward voltage drive level in the ’597 PCT depends on whether the (at least) two single voltage LED circuits are connected together in parallel or in series.

ID, 28, 29 (Board italics).

As illustrated below, a first LED circuit and a second LED circuit are combined into an overall LED circuit that is the multi-voltage LED device:



Ex. 1018 ('597 PCT), Fig. 1 (annotated). The contacts are configured so the combined LED circuit of Figure 1 can receive a first forward voltage of 12 V or a second forward voltage of 24 V. *Id.*, ¶[0051].

The Board's reasoning overlooks that the multi-voltage LED device is itself a combined LED circuit that supports switching between a first forward voltage drive level and a second forward voltage drive level as claimed. Accordingly, the second disputed limitation is supported by the pre-AIA applications.

IV. CONCLUSION

For the foregoing reasons, PO requests that the Director grant review of the issues presented herein and reverse the Board's decision that the '705 Patent is eligible for post-grant review.

Respectfully submitted,

/Stephen M. McBride/
Stephen M. McBride, Reg. No. 78,396
CARMICHAEL IP, PLLC

Date: August 18, 2023

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this Request for Director Review complies with the 15-page limit exclusive of the parts exempted as provided in 37 C.F.R. § 42.24(a).

Dated: August 18, 2023

Respectfully,

/Stephen M. McBride/

CERTIFICATE OF SERVICE

Pursuant to the Interim Process for Director Review, on August 18, 2023,
the undersigned served a copy of the foregoing **PATENT OWNER REQUEST
FOR DIRECTOR REVIEW** to the Director of the USPTO, and to lead and back
up counsel of record at the following email addresses:

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This Request for Director Review will also be filed with the PTAB via the
PTACTS system.

Respectfully,

/Stephen M. McBride/