UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMBILIGHT INC,
Petitioner,

v.

LANNRAY OPTOELECTRONICS (ZHENJIANG) CO. LTD.,
Patent Owner.

PGR2026-00053
U.S. Patent No. 12,502,870

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF POST GRANT REVIEW OF U.S. PATENT NO. 12,502,870

TABLE OF EXHIBITS

Exhibit No.	Description
2001	Declaration of Ziyong (Sean) Li
2002	Ambilight Inc. website, "About", Chinese language, accessible at https://www.ambilight.com/about.html (last visited July 10, 2026)
2003	Declaration of Jian Wang
2004	Furcifer Inc. website, viewable at https://furciferinc.com/overview (last visited July 10, 2026)
2005	Ambilight Inc., Statement of Information, Corporation, State of California, File No. BA20260362899 (filed February 14, 2026)
2006	Declaration of Yinyin Zhou
2007	Chinese Enterprise Credit Information Publicity Report for Shenzhen Ambilight Technology Co., Ltd. (深圳市光羿科技有限公司)
2008	Chinese Enterprise Credit Information Publicity Report for Ambilight Intelligent Technology (Suzhou) Co., Ltd. (光羿智能科技（苏州）有限公司)
2009	Chinese Enterprise Credit Information Publicity Report for Nanjing Echerial New Materials Co., Ltd. (南京宜凯瑞新材料有限公司)
2010	Chinese Enterprise Credit Information Publicity Report for Suzhou Ambilight Technology Co., Ltd. (苏州光羿科技有限公司)
2011	RESERVED
2012	RESERVED
2013	RESERVED
2014	Declaration of Flora Zhang
2015	Certified English translation of Chinese Enterprise Credit Information Publicity Report for Ambilight Intelligent Technology (Suzhou) Co., Ltd. (光羿智能科技（苏州）有限公司)
2016	Certified English translation of Chinese Enterprise Credit Information Publicity Report for Nanjing Echerial New Materials Co., Ltd. (南京宜凯瑞新材料有限公司)
2017	Certified English translation of Chinese Enterprise Credit Information Publicity Report for Shenzhen Ambilight Technology Co., Ltd. (深圳市光羿科技有限公司)

Exhibit No.	Description
2018	Certified English translation of Chinese Enterprise Credit Information Publicity Report for Suzhou Ambilight Technology Co., Ltd. (苏州光羿科技有限公司)
2019	RESERVED
2020	RESERVED
2021	RESERVED
2022	Certified English translation of Ambilight Inc. website, "About" accessible at https://www.ambilight.com/about.html (last visited July 10, 2026)
2023	RESERVED
2024	RESERVED
2025	Declaration of Yu Han
2026	U.S. Patent No. 11,969,970
2027	U.S. Patent No. 12,030,277
2028	Assignment Data for U.S. Patent No. 12,502,870. USPTO Assignment Center, accessed at https://assignmentcenter.uspto.gov/ (last visited July 24, 2026)
2029	Bill of Lading for MAEU261238016
2030	Bill of Lading for EGLV142450069977
2031	European Patent Register, EP4209836, "EP About This File," accessed at https://register.epo.org/application?number=EP21863193&lng=en&tab=main (last visited July 29, 2026)
2032	European Patent Register, EP4209836, document type "Information on Entry into the European Phase," dated January 13, 2023, accessed at https://register.epo.org/application?number=EP21863193&lng=en&tab=doclist (last visited July 29, 2026)
2033	European Patent Register, EP4209836, document type "Request for Entry Into the European Phase," dated March 17, 2023, accessed at https://register.epo.org/application?number=EP21863193&lng=en&tab=doclist (last visited July 29, 2026)
2034	European Patent Register, EP4209836, document type "Copy of the International Search Report," dated March 10, 2022, accessed at https://register.epo.org/application?number=EP21863193&lng=en&tab=doclist (last visited July 29, 2026)

Exhibit No.	Description
2035	European Patent Register, EP4209836, document type "Copy of the Translated International Search Report," dated March 10, 2022, accessed at https://register.epo.org/application?number=EP21863193&lng=en&tab=doclist (last visited July 29, 2026)
2036	Google Patent webpage for U.S. Patent No. 12,502,870, accessed at https://patents.google.com/patent/US12502870B2/en (last visited July 29, 2026)
2037	Declaration of Carlton Hemphill

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37 C.F.R. § 1.290(b) 16

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I. INTRODUCTION

Patent Owner LannRay Optoelectronics (Zhenjiang) Co. Ltd. ("LannRay" or "Patent Owner") respectfully requests that the Director exercise discretion to deny institution of the Petition filed by Ambilight Inc. ("Petitioner") challenging claims 1–12 of U.S. Patent No. 12,502,870 (the "'870 Patent"). Institution should be denied based on the case-specific considerations identified in the Director's memoranda.

First, the unpatentability challenge is weak. The '870 Patent has a single independent claim, claim 1, and every obviousness ground in the Petition depends on a single reference, Gauthier (EX1004), to supply all of the limitations of that claim. Xu (EX1005) and Tonar (EX1006) are invoked only for dependent-claim features. Yet Gauthier does not disclose each and every limitation of claim 1: for example, the requirement of elements [1.4] and [1.5] that an edge protection material seal "***the*** exposed portion" of the inner surface of the opposing electrode layer. Because claims 2–12 all depend from claim 1, these gaps defeat every challenged claim across every ground. Petitioner's written description ground fares no better, and in fact contradicts its own obviousness case. The Director's March 26, 2025 memorandum treats "[t]he strength of the unpatentability challenge" as a discretionary consideration, and a challenge that fails at the level of the sole independent claim does not warrant institution.

Second, the Petition relies on conclusory expert testimony, rather than on the four corners of the prior art, to patch the holes—another consideration the Director's memorandum identifies as bearing on discretion. Petitioner's declarant offers merely conclusory argument, and he does so while taking mutually contradictory positions depending on which ground the testimony is offered to support.

Third, the considerations added by the Director's March 11, 2026 memorandum favor denial. Petitioner is not a domestic manufacturer or a small business, but the United States-facing arm of a large, China-based electrochromic manufacturing enterprise whose products are made abroad and imported into the United States.

Fourth, Petitioner was aware of the '870 Patent family long before the application leading to the '870 Patent was filed and could have timely filed a third-party submission but instead chose to wait for issuance.

For these reasons, and as set forth below, Patent Owner respectfully requests that the Director deny institution.

II. DIRECTOR'S MEMORANDA

Pursuant to the Director's March 26, 2025 Memorandum, *Interim Processes for PTAB Workload Management* (the "March 26, 2025 Memorandum") and the Director's March 11, 2026 Memorandum, *Additional Discretionary Institution*

Considerations – U.S. Manufacturing and Small Business Use of AIA Proceedings (the "March 11, 2026 Memorandum"), Patent Owner LannRay Optoelectronics (Zhenjiang) Co. Ltd. ("LannRay" or "Patent Owner") respectfully submits that institution should be denied. This filing is timely made following the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response (Paper 3), dated June 9, 2026.

The Director's March 26, 2025 Memorandum identifies several non-exclusive considerations relevant to discretionary denial, including the strength of the unpatentability challenge; and the extent of the petition's reliance on expert testimony. *See* March 26, 2025 Memorandum, at 2-3. The March 11, 2026 memorandum adds further considerations directed to domestic manufacturing and small-business status. *See* March 11, 2026 Memorandum. Both memoranda reinforce that institution is not automatic even where a petition satisfies the threshold statutory standard. Discretionary denial is warranted here based on the case-specific considerations identified in the Director's memoranda.

III. DISCRETIONARY FACTORS FAVOR DENIAL OF INSTITUTION

A. The Strength of the Unpatentability Challenge Favors Denial

The '870 Patent contains a single independent claim. (EX1001, claim 1.) Claims 2–12 each depend, directly or indirectly, from claim 1. (EX1001, claims 2-12.) Every obviousness ground in the Petition rises or falls with Gauthier

(EX1004). Ground 2 challenges claims 1–12 over Gauthier alone. (Pet., 1, 17-64.) Grounds 3 and 4 add Xu (EX1005) and Tonar (EX1006) only to address features recited in dependent claims 2, 3, and 5; neither reference is offered to cure any gap in claim 1. (Pet., 1, 64-90.) As a result, if Gauthier does not disclose a limitation of claim 1, that failure defeats not only claim 1 but every claim that depends from it, across all grounds.

That failure is exposed in claim 1 as shown by the requirement of elements [1.4] and [1.5] that the edge protection materials seal "***the*** exposed portion" of the inner surface of the opposing electrode layer. Because Petitioner bears the burden of showing that it is more likely than not that at least one challenged claim is unpatentable, 35 U.S.C. § 324(a), and must identify where each limitation is found "with particularity," 35 U.S.C. § 322(a)(3); 37 C.F.R. § 42.204(b)(4), these deficiencies weigh heavily in favor of denial.

1. The Petition Concedes That Gauthier Does Not Seal "The Exposed Portion" (Elements [1.4] and [1.5])

Claim 1 is not satisfied by any seal placed somewhere in an offset edge region. Element [1.2] requires that an edge of the first electrode layer be cut "such that a portion of an inner surface of the second electrode layer is exposed," and element [1.4] then requires "a first edge protection material sealing ***the*** exposed portion of the inner surface of the second electrode layer." (EX1001, claim 1.) Elements [1.3] and [1.5] mirror that structure. (*Id*.) The definite article in [1.4] and

[1.5] takes its antecedent from [1.2] and [1.3], respectively. The claim therefore requires the edge protection material to seal the portion that the recited cut exposed—not a residual sliver of it.

Petitioner concedes it cannot meet that requirement. In mapping element [1.4], the Petition states that "Gauthier's first seal 64 . . . is applied to the ***remaining*** exposed portion of the conductive coating on electrode-bearing substrate 56 not occupied by busbar 58a and seals the exposed portion." (Pet., 31-32 (emphasis added); EX1003, ¶ 106.) Petitioner thus admits on the face of the Petition that Gauthier's busbar occupies part of the exposed portion and that seal 64 covers only what is left over. That is an admission of non-disclosure, not a showing of disclosure.

Gauthier confirms the concession. Gauthier removes substrate material for one stated purpose—to create a busbar platform: "A portion of substrates 54, 56 has been removed to expose the conductive coating where the busbars may be applied." (EX1004, 10:54-61.) Gauthier elsewhere explains that "cutting the first and second substrates to form offset edges, and removing a portion of the switching material provide a platform for mounting busbars separated from the cut edge of the switching material and directly on the transparent conductive layer on the interior side." (EX1004, 5:62-66; *Id.*, 5:65-6:6.) In other words, not all exposed surface in Gauthier is sealed; certain inner electrode surface remains exposed to

receive a busbar, and a busbar sits on it. This is but one example where the Petition does not meet its burden and should be denied.

2. The Written Description Ground Is Self-Defeating

Ground 1 rests on a lexical observation, not a structural one: that the specification "does not include the word 'cut,' 'cutting,' any other variant thereof." (Pet., 14.) Claim 1 is an apparatus claim, and the question is whether the structure is described. *See Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

Petitioner answers that question in Patent Owner's favor. In its own summary of the patent, Petitioner annotates Figure 9 to state that "First electrode layer 901a is cut to expose portion of second electrode layer 901b, then exposed portion is sealed by seal 905," and that "Second electrode layer 901b is cut to expose portion of first electrode layer 901a, then exposed portion is sealed by seal 915." (Pet., 7-8; EX1003, ¶¶ 49-50.) Petitioner further concedes that "[t]he first and second edge protection materials (yellow) seal the exposed portions of the inner surfaces of the first and second electrode layers (901a, 901b), respectively." (Pet., 8; EX1003, ¶¶ 51-53.) Petitioner has read the complete claimed arrangement directly out of Figure 9.

Petitioner also concedes that a POSA derives the structure from the disclosure, arguing that "[a] POSA would read the '870 Patent and understand that

the structure that exposes a portion of the inner surfaces of the first and second electrodes is formed by laminating the electrodes together in an off-set fashion." (Pet., 15; EX1003, ¶¶ 68-69.) Whether the staggered structure is produced by cutting or by offset lamination is a process question that does not bear on possession of the apparatus. Indeed, Petitioner's arguments, at best, are directed to method claims, of which the '870 Patent has none.

Moreover, Petitioner's arguments seek a *de facto* claim construction for the term "cut", despite stating no construction is necessary and that all terms should be given plain and ordinary meaning. (Pet., 11-12.) Petitioner states that a "POSA would understand that cutting portions . . . would require additional time, effort, expense and expertise, while running the risk of damaging or harming the electrodes." (Pet., 15; EX1003, ¶ 70.) This is charged language that inherently advances some definition of "cut", and neither the Petition nor its cited support supply the supposed plain and ordinary definition that forms the basis of this ground. (Pet., 12-16; EX1003, ¶¶ 62-73.)

3. The Petition's "Examiner Error" Theory Confirms Its Weakness

Discretionary denial is appropriate when "the same or substantially the same prior art or arguments previously were presented to the Office." 35 U.S.C. § 325(d). Under *Advanced Bionics*, the Board applies a two-part test when considering denial of institution: "(1) whether the same or substantially the same

art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims." *Advanced Bionics, LLC v. Med-EL Elktromedizinische Gerate GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential). The "Director may exercise his discretion" to deny institution where "petitioner fails to show that the Office erred." *Id*. Factors for consideration in exercising discretion under § 325(d) include "the ***extent*** to which the asserted art was evaluated during examination," and "whether Petitioner has pointed out sufficiently ***how*** the Examiner erred in its evaluation of the asserted prior art." *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) (emphasis added).

Here, the factors support discretionary denial under § 325(d) because Petitioner's "Examiner Error" theory undercuts itself. Petitioner acknowledges that "Gauthier's corresponding PCT publication is WO 2014/134714 A2 . . . and is cited on the face of the '870 Patent," having been submitted in an Information Disclosure Statement dated March 15, 2024. (Pet., 9-10; EX1002 at 30-35 of PDF.) The same disclosure was before the Office, and Petitioner's disagreement with how the Examiner weighed it is a merits dispute, not a material error.

In fact, this is the ***third*** time the Examiner has been confronted with the Gauthier reference. The ’870 Patent (at issue here) is a continuation of U.S. Patent No. 11,969,970 (the “’970 Patent”), which itself is a continuation of U.S. Patent No. 11,571,878 (the “’878 Patent”). (EX1001, (63); EX2026, (63); EX2037, ¶ 3.) U.S. Patent No. 12,030,277 (the “’277 Patent”), a sibling of the ’870 Patent, is ultimately also a continuation of the ’878 Patent. (EX2037, ¶ 4; EX2027, (63).) The ’870 Patent, the ’970 Patent, and the ’277 Patent have three things in common: (1) they are ***all*** ultimately continuations of the ’878 Patent and therefore rely on a common specification; (2) they ***all*** cite Gauthier (WO 2014/134714 A2) as a reference, and (3) they were ***all*** examined by the ***same*** Examiner—Jack Dinh. (EX1001, (56), (63), Cover Page; EX2026, (56), (63), Cover Page; EX2027, (56), (63), Cover Page; EX2037, ¶¶ 3-4.) Thus, the Examiner had three bites at the apple to review the specification in view of Gauthier’s disclosure to determine whether it was applicable and whether it should be used in a rejection. In each of the three instances the Examiner considered the reference and concluded that Gauthier ***did not*** apply. It is even more evident considering that the ’870 Patent does not include a laundry list of cited references that make consideration of each reference unmanageable, but instead includes a handful of cited references from which the Examiner could thoroughly consider the contents of each. And like Gauthier, many of these references were also previously before the same Examiner during

prosecution of the ’970 and ’277 Patents—giving adequate time for consideration in view of the common specification. (EX1001, (56); EX2026, (56); EX2027, (56); EX2037, ¶¶ 3-4.)

Accordingly, this is not a case where the Examiner (i.e. the Patent Office) “did not do his job” as Petitioner boldly asserts. Indeed, outside of the conclusory expert opinion used to supplement missing limitations, Petitioner relies solely on Gauthier for its independent claim 1 arguments. The sole reliance on Gauthier (1) indicates that any additional prior art searching performed by Petitioner apparently did not locate any new references for the independent claim, and (2) confirms that the most pertinent art was previously put forth and considered by the Office. Petitioner broadly states that the Examiner was “mistaken” because Gauthier discloses the limitations, (Pet., 10) but beyond merely disagreeing with the Examiner’s analysis Petitioner does not adequately state specifically “***how*** the Examiner erred in its evaluation.” *Becton*, IPR2017-01586, Paper 8 at 17–18. “If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.” *See Advanced Bionics*, IPR2019-01469, Paper 6 at 9. The

Examiner's reasoning should not be disturbed based on the subjective lens of a party seeking to invalidate a patent to clear perceived market hurdles.[1]

* * *

Because these deficiencies appear on the face of Gauthier and the Petition's own evidence, they present no genuine factual dispute for the Board to resolve in Petitioner's favor at institution, *see* 37 C.F.R. § 42.208(c), and they cannot be cured by new argument or evidence on reply, 37 C.F.R. § 42.23(b); *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016).

B. The Petition's Extensive Reliance on Expert Testimony Favors Denial

The Petition's dependence on the declaration of Dr. Colin Wolden (EX1003) is substantial, and that reliance matters under the Director's March 26, 2025 memorandum. *See* March 26, 2025 Memorandum, at 2. This is not a case in which the cited reference straightforwardly discloses each limitation and the expert merely supplies background context. Rather, the Petition turns to expert opinion to carry the final, dispositive analytical step from Gauthier to the challenged claims

[1]Patent Owner's statement here is more than mere conjecture. This is the second of Patent Owner's patents that Petitioner has recently filed petition on, the sudden onslaught of which was likely triggered by assignment from the original assignee—a company co-founded by the founder of Petitioner—to LannRay. *See Ambilight Inc. v. LannRay Optoelectronics (Zhenjiang) Co. Ltd.*, IPR2026-00367, Paper 7 at 12-15 (P.T.A.B. Jul. 24, 2026); EX2037, ¶ 5; EX2003, ¶¶ 4-10; EX2028.

on precisely the limitations that Gauthier does not disclose. Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight. 37 C.F.R. § 42.65(a); *see also TQ Delta, LLC v. Cisco Sys., Inc.*, 942 F.3d 1352, 1358-59 (Fed. Cir. 2019) ("Conclusory expert testimony does not qualify as substantial evidence.").

1. The Declaration Fills the [1.4] and [1.5] Gap With Assertion Rather Than Disclosure

The Petition's [1.4] and [1.5] analysis rests on EX1003, ¶¶ 106-115. But the underlying Gauthier passages the declarant cites affirmatively contradict the conclusion drawn from them. Gauthier states that its seal is placed "in a space 62 between the busbar and switching material," (EX1004, 9:59-63); that the seal's function is "sealing the switching material, and physically separating the busbar from the switching material," (EX1004, 5:67-6:5); and that contact with the conductive coating serves to aid "in maintaining the position of the first seal, to ensure a suitable seal for the switching material," (EX1004, 10:51-60). None of these passages describes sealing the exposed inner surface of the opposing electrode. The declarant's contrary conclusion—reproduced nearly verbatim as attorney argument at pages 31-35 of the Petition—is opinion untethered to the disclosure it cites, and is entitled to no weight under § 42.65(a). *See TQ Delta*, 942 F.3d at 1358-59. Nor can it be reconciled with Petitioner's own admission that seal

64 covers only "the remaining exposed portion . . . not occupied by busbar 58a." (Pet., 31-32; EX1003, ¶ 106.)

C. Petitioner's Foreign-Based Manufacturing and Non-Small-Entity Status Favor Denial

The Director's March 11, 2026 memorandum directs the Board to consider the extent to which the products at issue are manufactured in the United States or tied to investments in domestic manufacturing, and the parties' small-business status. *See* March 11, 2026 Memorandum, at 2. Petitioner is not a small domestic manufacturer; rather, it is the United States-facing arm of a large, vertically integrated electrochromic manufacturing enterprise headquartered in China, whose relevant products are made abroad and imported into the United States. The considerations outlined in the March 11, 2026 memorandum favor denial here.

Petitioner presents itself and its affiliates as a single enterprise. Petitioner's own website describes one company "[f]ounded in 2017" with "branches in USA, Shenzhen and Suzhou," designating its United States site a "Center for Basic Research," its Shenzhen site a "Materials R&D and Innovation Center," and its Suzhou site an "Engineering and Manufacturing Center." (EX2001, ¶ 3; EX2002; EX2025, ¶ 4; EX2022, 1, 3.) The enterprise touts itself as "the world's first innovative tech company that has achieved mass production of large-area curved electrochromic products," using a "roll-to-roll process for the efficient mass production of flexible film-based products." (EX2001, ¶ 3; EX2002; EX2025, ¶ 4;

EX2022, 1.) By Petitioner's own account, its manufacturing is performed in China, while its United States presence is devoted to research.

The scale of that Chinese manufacturing operation is substantial and documented. Ambilight Intelligent Technology (Suzhou) Co., Ltd.—wholly owned by the group's parent, Ambilight (HK) Limited, and whose director and manager is Petitioner's founder, Chao Wang—has registered capital of USD 140 million. (EX2006, ¶¶ 5-7, 9; EX2008; EX2014, ¶ 2; EX2015, 1-2.)[2] Chinese environmental authorities approved its project to "produce 5 million sets of intelligent electrochromic devices per year," and a further project "designed to produce 1,500,000 m^2 of intelligent electrochromic films per year." (EX2006, ¶¶ 5-7, 9; EX2008; EX2014, ¶ 2; EX2015, 6, 11.) The entity holds special-equipment, fire-protection, and pollutant-discharge permits consistent with a full-scale manufacturing facility, and reported its "[p]rimary business activities" as the "[m]anufacture of plastic films." (EX2006, ¶¶ 5-7, 9; EX2008; EX2014, ¶ 2; EX2015, 11-15, 17.) Its social-insurance filings report 247 employees in 2024. (EX2006, ¶¶ 5-7, 9; EX2008; EX2014, ¶ 2; EX2015, 18.) This is a signature manufacturing operation, not a small business. Petitioner's reliance on its Chinese

[2]Petitioner's failure to identify all real parties-in-interest as required by 35 U.S.C. § 322 (a)(2) and 37 C.F.R. § 42.8(b)(1) will be addressed in detail by Patent Owner in its Preliminary Response. *See generally Corning Optical Commc'ns RF, LLC v. PPC Broadband, Inc.*, IPR2014-00440, Paper 68 (P.T.A.B. Aug. 18, 2015).

affiliates is confirmed through its own import records which show that it receives shipments from Ambilight Intelligent Technology (Suzhou) Co. Ltd.[3] (EX2001, ¶¶ 6-7; EX2029; EX2030.)

These facts also foreclose any claim to small-business solicitude. A group in which a single affiliate already employs 247 people and holds USD 140 million in registered capital—sitting beneath a common parent, Ambilight (HK) Limited, that also owns the group's other electrochromic entities—cannot credibly be characterized as a small business. (EX2006, ¶¶ 5-11; EX2007; EX2008; EX2009; EX2010; EX2014, ¶¶ 2-3; EX2015, 2; EX2016, 2; EX2017, 2; EX2018, 2; EX2025, ¶¶ 2-3.) Because Petitioner is neither a domestic manufacturer nor a small business, and is instead using an AIA proceeding as a competitive tool on behalf of a foreign manufacturing enterprise, the considerations set out in the Director's March 11, 2026 memorandum weigh in favor of denial. Exploiting Patent Office resources is not, and should not be, the first option chosen by a company seeking to enter the U.S. market.

D. Petitioner was Aware of the '870 Patent Family and Chose Not to Utilize Third-Party Submissions for References to be Considered

[3]While the shipper name in EX2029 and EX2030 is "Guangyi Intelligent Technology," this is because the Chinese characters for "Ambilight" are phonetically translated to English as "Guangyi".

The Office allows third parties to submit "for consideration and entry in the record of a patent application, any patents, published patent applications, or other printed publications of potential relevance to the examination of the application." 37 C.F.R. § 1.290(a); *see also* MPEP 1134.01. The timing requirements for submissions are set forth in 37 C.F.R. § 1.290(b), but are not recited herein because Petitioner's prior knowledge of the '870 Patent family removes doubt over whether it could have complied.

On March 17, 2023, Petitioner's Chinese affiliate, Shenzhen Ambilight Technology Co. Ltd.,[4] requested entry of its PCT application, PCT Publication No. WO2022048122, into the European phase before the European Patent Office. (EX2037, ¶¶ 7-8; EX2032; EX2033.) Among the filed documents is the International Search Report for WO2022048122 (International Application No. PCT/CN2021/079013), mailed June 3, 2021, which cites CN111399300A as a "Document[] Considered to be Relevant." (EX2037, ¶¶ 9-10; EX2034; EX2035, 2-3.) As shown in the International Search Report, CN111399300A is the patent family member of U.S. Patent Application Publication No. 2020150507 (issuing as the '878 Patent), and accordingly is in the same family as the '870 Patent. (EX2037, ¶¶ 9-10;

[4]As stated above, "Guangyi" is the phonetical translation of the Chinese name for Ambilight. Should there be any doubt, the Applicant info for EP4209836 (European phase for WO2022048122) lists the same address as that for Shenzhen Ambilight Technology Co. Ltd. (EX2037, ¶ 6; EX2006, ¶ 5-8; EX2007; EX2017, 2; EX2025, ¶ 2; EX2031, 1.)

EX2034; EX2035, 3.) Thus, Petitioner was aware of the '870 Patent family at least as early as June 3, 2021, giving it ample time to monitor subsequent application filings, search for pertinent references, and be ready to submit a third party filing soon after the application published on July 4, 2024. (EX1001, (65).) Petitioner, instead, tactically waited to submit references until after the patent issued to better control the narrative.[5] This is especially the case where the specifications are shared across the family. Rewarding such behavior would not be a judicious use of Office resources when the Examiner could otherwise have had the opportunity to weigh the merits untethered to competitive decision-making.

IV. CONCLUSION

For at least the reasons above, discretionary denial is appropriate based on the considerations identified in the Director's memoranda. Petitioner's unpatentability challenge rests on a single reference—Gauthier—for the independent claim, using conclusory expert opinion to supply missing limitations, and casts aspersions on the Examiner's handling of the references while ultimately disagreeing with the merits rather than a material error. Moreover, Petitioner's foreign-based manufacturing facilities, non-small entity status, and prior knowledge of the patent

[5]Petitioner's founder and Chief Executive Officer, Chao Wang, at the time also served as a Manager of Shenzhen Ambilight Technology Co. Ltd., a position providing knowledge and awareness of search reports conducted on patent application filings. (EX2001, ¶ 5; EX2005, 1; EX2006, ¶¶ 5-8; EX2007; EX2017, 3; EX2025, ¶ 2.)

family satisfy additional considerations warranting denial. Patent Owner respectfully requests that the Director deny institution.

Date: August 6, 2026

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE WITH PAGE LIMIT

I certify that this Request For Discretionary Denial complies with the type-volume limits of section II.C.iii of the Interim Director Discretionary Process (https://www.uspto.gov/patents/ptab/interim-director-discretionary-process, last visited July 24, 2026) because it contains fewer than 20 pages, excluding the parts of this brief that are exempted by 37 C.F.R. § 42.24(a)(1), according to the word processing system used to prepare this brief.

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CERTIFICATE OF SERVICE

I hereby certify that on August 6, 2026, a true and correct copy of the foregoing was served by electronic mail upon the following counsel of record for Petitioners:

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