

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JIAWEI TECHNOLOGY (HK) LTD.,
JIAWEI TECHNOLOGY (USA) LTD., and
SHENZHEN JIAWEI PV LIGHTING CO., LTD.,
Petitioner,

v.

LIGHTING SCIENCE GROUP CORP.,
Patent Owner.

Case IPR2018-00262
Patent 8,672,518 B2

Before KEVIN F. TURNER, PATRICK M. BOUCHER, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and
Granting Petitioner's Motion for Joinder
35 U.S.C. § 314(a) and 37 C.F.R. § 42.122

Jiawei Technology (HK) Ltd., Jiawei Technology (USA) Ltd., and
Shenzhen Jiawei Photovoltaic Lighting Co, Ltd. (collectively, "Petitioner")
filed a Petition (Paper 1, "Pet.") requesting an *inter partes* review of
claims 1, 3–8, and 11–14 of U.S. Patent No. 8,672,518 B2 (Ex. 1001, "the

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'518 Patent"). Petitioner also filed a Motion for Joinder requesting that we join Jiawei Technology (HK) Ltd., Jiawei Technology (USA) Ltd., and Shenzhen Jiawei Photovoltaic Lighting Co, Ltd. as parties with Technical Consumer Products, Inc., Nicor Inc., and Amax Lighting in *Tech. Consumer Prods., Inc. v. Lighting Science Group Corp.*, Case IPR2017-01285 ("the '1285 IPR").¹ Paper 3 ("Joinder Mot.").

In the '1285 IPR, we instituted an *inter partes* review as to claims 1, 3–8, and 11–14 of the '518 Patent on four grounds of unpatentability. '1285 IPR, Paper 10. Subsequently, in response to *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1351 (2018), we instituted review of claim 10 on two additional grounds. '1285 IPR, Paper 19. According to Petitioner, the Petition filed in this proceeding is "substantively identical" to the petition from the '1285 IPR and asserts identical arguments and grounds of unpatentability against the same patent claims, "except for claim 10." Joinder Mot. 1–3. Petitioner also represents that, if it is allowed to join the '1285 IPR, it would agree to consolidated filing with Technical Consumer Products, Inc., Nicor Inc., and Amax Lighting "to minimize burden and schedule impact." *Id.* at 2. Petitioner does not indicate whether Technical Consumer Products, Inc. Nicor Inc. and Amax Lighting oppose Petitioner's Motion for Joinder.

Patent Owner, Lightning Science Group Corp. ("Patent Owner"), filed neither a preliminary response nor a response to Petitioner's Motion for Joinder.

¹ In IPR2018-00270, Leedarson Lighting Co., Ltd. and Leedarson America, Inc. also filed a motion for joinder related to the '1285 IPR. We grant that motion concurrent with this Decision, as discussed below. *See infra* § II.

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a). Under 35 U.S.C. § 314(a), we may not authorize an *inter partes* review unless the information in the petition and any preliminary response “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons that follow, we institute an *inter partes* review as to claims 1, 3–8, and 10–14 of the ’518 Patent on all grounds instituted in the ’1285 IPR. We also *grant* Petitioner’s Motion for Joinder.

I. INSTITUTION OF INTER PARTES REVIEW

In the ’1285 IPR, we ultimately instituted an *inter partes* review as to claims 1, 3–8, and 10–14 of the ’518 Patent on the following grounds of unpatentability: (1) claims 1, 3, 6–8, 11, 12, and 14 under 35 U.S.C. § 103 as being unpatentable over Soderman² and Wegner;³ (2) claims 4, 5, and 13 under 35 U.S.C. § 103 as unpatentable over Soderman, Wegner, and Silescent;⁴ (3) claims 1, 3, 5–8, 11, 12, and 14 under 35 U.S.C. § 103 as unpatentable over Zhang⁵ and Wegner; and (4) 4 and 13 under 35 U.S.C. § 103 as unpatentable over Zhang, Wegner, and Silescent; and (5) claim 10

² U.S. Patent No. 7,980,736 B2 (filed Nov. 13, 2007) (issued Jul. 19, 2011) (Ex. 1013, “Soderman”).

³ U.S. Patent No. 7,993,034 B2 (filed Sep. 22, 2008) (issued Aug. 9, 2011) (Ex. 1015, “Wegner”).

⁴ Silescent Lighting Corp., Silescent S100 LP2 Product Sheet and Installation Guide (Jun. 2009) (Ex. 1016, “Silescent”).

⁵ U.S. Patent No. 7,722,227 B2 (filed Oct. 10, 2008) (issued May 25, 2010) (Ex. 1014, “Zhang”).

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as obvious under 35 U.S.C. § 103(a) over Soderman, Barnett,⁶ and/or Van Elmpt;⁷ and (6) claim 10 as obvious under 35 U.S.C. § 103(a) over Zhang, Barnett, and/or Van Elmpt. '1285 IPR, Papers 10, 19. As mentioned above, the Petition filed in this proceeding is essentially the same as the Petition filed in the '1285 IPR, "except for claim 10," and Petitioner limited the asserted grounds in this proceeding to only those grounds originally instituted in the '1285 IPR. Joinder Mot. 1–3, 6–7; *compare* Pet. 3–54, *with* '1285 IPR, Paper 1, 3–62.

The Petition is essentially the same as and only pertains to the originally instituted grounds in the '1285 IPR. We conclude that the information presented in the Petition establishes that there is a reasonable likelihood that Petitioner would prevail on its assertion that (1) claims 1, 3, 6–8, 11, 12, and 14 under 35 U.S.C. § 103 as being unpatentable over Soderman and Wegner; (2) 4, 5, and 13 under 35 U.S.C. § 103 as unpatentable over Soderman, Wegner, and Silescent; (3) claims 1, 3, 5–8, 11, 12, and 14 under 35 U.S.C. § 103 as unpatentable over Zhang and Wegner; and (4) claims 4 and 13 under 35 U.S.C. § 103 as unpatentable over Zhang, Wegner, and Silescent. We also utilize our discretion to institute in this proceeding the grounds later added to the '1285 IPR, namely, (5) claim 10 as obvious under 35 U.S.C. § 103(a) over Soderman, Barnett, and/or Van Elmpt; and (6) claim 10 as obvious under 35 U.S.C. § 103(a) over Zhang, Barnett, and/or Van Elmpt.

⁶ U.S. Patent Publication No.2002/0113244 A1 (filed Feb. 11, 2002) (published Aug. 22, 2002) (Ex. 1019, "Barnett").

⁷ PCT Int'l Pub. No. WO 2010/004503 A1 (filed July 6, 2009) (published Jan. 14, 2010) (Ex. 1020, "Van Elmpt").

Pursuant to § 314, we institute an *inter partes* review as to these claims of the '518 Patent on all grounds instituted in the '1285 IPR for the reasons stated in our Institution Decision from the '1285 IPR and in our subsequent Order. *See* '1285 IPR, Papers 10, 19.

II. GRANTING PETITIONER'S MOTION FOR JOINDER

The AIA created administrative trial proceedings, including *inter partes* review, as an efficient, streamlined, and cost-effective alternative to district court litigation. 35 U.S.C. § 315(c) provides (emphasis added):

JOINDER.—If the Director institutes an *inter partes* review, *the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311* that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

“Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested.” 37 C.F.R. § 42.122(b). Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. The Board determines whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations. *See Sony Corp. of Am. v. Network-1 Security Solutions, Inc.*, Case IPR2013-00495, slip op. at 3 (PTAB Sept. 16, 2013) (Paper 13) (“*Sony*”). When exercising its discretion, the Board is mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. *See* 35 U.S.C.

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