

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LEEDARSON LIGHTING CO., LTD. and
LEEDARSON AMERICA, INC.,
Petitioner,

v.

LIGHTING SCIENCE GROUP CORP.,
Patent Owner.

Case IPR2018-00270
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

Leedarsen Lighting Co., Ltd., and Leedarsen America, Inc.
(collectively, "Petitioner") filed a Petition (Paper 1, "Pet.") requesting an
inter partes review of claims 1, 3–8, and 10–14 of U.S. Patent No. 8,672,518
B2 (Ex. 1001, "the '518 Patent"). Petitioner also filed a Motion for Joinder
requesting that we join Leedarsen Lighting Co., Ltd., and Leedarsen

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America, Inc. 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. Joinder Mot. 1–3. Petitioner acknowledges as a difference that the instant Petition “make[s] clear and express the incorporation of the art and argument in Grounds 1 and 4 (with respect to independent claim 1) into Grounds 3 and 6 (regarding dependent claims 10), respectively. *Id.* at 1. We address the raised distinctions below.

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.

¹ In IPR2018-00262, Jiawei Technology (HK) Ltd. Jiawei Technology (USA) Ltd. and Shenzhen Jiawei Photovoltaic Lighting Co., Ltd. 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.

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

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 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

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”).

unpatentable over Zhang⁵ and Wegner; and (4) claims 4 and 13 under 35 U.S.C. § 103 as unpatentable over Zhang, Wegner, and Silescent; and (5) claim 10 as obvious under 35 U.S.C. § 103(a) over Soderman, Barnett⁶, and/or Van Elmpt;⁷ and (6) claim 10 as obvious under 35 U.S.C. § 103(a) over Soderman, 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, with respect to the originally instituted grounds, and Petitioner asserts to correct “an apparent clerical error” with respect to those later-added grounds in the '1285 IPR. Joinder Mot. 1–2, 3–4; *compare* Pet. 3–67, *with* '1285 IPR, Paper 1, 3–62.

The Petition is essentially the same as and mostly 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 are unpatentable under 35 U.S.C. § 103 over Soderman and Wegner; (2) claims 4, 5, and 13 are unpatentable under 35 U.S.C. § 103 over Soderman, Wegner, and Silescent; (3) claims 1, 3, 5–8, 11, 12, and 14 are unpatentable under 35 U.S.C. § 103 over Zhang and Wegner; and (4) claims 4 and 13 are unpatentable under 35 U.S.C. § 103 over Zhang, Wegner, and Silescent.

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

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”).

Some of the grounds of the instant Petition seek to “simply add[] a single statement that makes clear that the Petitioner[is] relying on the already provided art and argument for the independent claim elements of claim 1 by from two already instituted grounds.” Joinder Mot. 8–9. We agree that these grounds are not substantively distinguishable from similar grounds presented against claim 10 in the ’1285 IPR. As such, even with the explicit inclusion of Wegner, we are not persuaded that these alternative grounds raise any different issues than the grounds applied against claim 10 in the ’1285 IPR, which were instituted therein.

Thus, we also utilize our discretion to institute in this proceeding grounds similar to the grounds later added to the ’1285 IPR, namely, (5) claim 10 as obvious under 35 U.S.C. § 103(a) over Soderman, Wegner, Barnett, and/or Van Elmpt; and (6) claim 10 as obvious under 35 U.S.C. § 103(a) over Zhang, Wegner, Barnett, and/or 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

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