

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

SATCO Products, INC.,
Petitioner,

v.

LIGHTING SCIENCE GROUP CORP.,
Patent Owner

Case No.: IPR2017-01643
Patent No.: 8,672,518

**PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR
INTER PARTES REVIEW**

Filed on behalf of:

Patent Owner Lighting Science Group Corp.

By: Eric D. Hayes
Garret A. Leach
Kyle M. Kantarek
Kirkland & Ellis LLP
300 N. LaSalle
Chicago, IL 60654
Phone: 312-862-2000
Email: eric.hayes@kirkland.com

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION	1
II. SUMMARY OF ARGUMENT.....	1
III. OVERVIEW OF THE '518 PATENT	2
IV. CLAIM CONSTRUCTION.....	3
A. "Heat Spreader" And "Heat Sink"	3
V. THE BOARD SHOULD DENY INSTITUTION ON GROUND 1 RELYING on tickner.	4
A. Tickner Does Not Disclose The Thermal Communication Limitation.	4
1. Petitioner Does Not Identify the Heat Spreader Required By the Claims.....	4
2. If Petitioner Identified the Claimed Heat Spreader As Element 310a in Tickner, It Has Not Identified the Thermal Communication Required By the Claim	6
VI. THE BOARD SHOULD DENY INSTITUTION ON GROUND 2 RELYING on ticknER IN LIGHT OF ULE 5000.....	8
A. Tickner In View Of ULE 5000 Does Not Disclose The H/D Limitation.	8
1. Petitioner Offers No Reason or Motivation to Combine Tickner and ULE 5000 or Reasonable Expectation of Success in Doing So.....	8
2. ULE 5000 Merely Discloses the Overall Dimensions of an "LED Light Engine"	12
VII. THE BOARD SHOULD DENY INSTITUTION ON GROUND 3 RELYING ON TICKNER IN LIGHT OF CHOU, LIGHTOLIER, AND SUNG.....	13

A.	Tickner In View Of Chou, Lightolier, And Sung Does Not Disclose The Rotational Retention Limitation.....	14
1.	Lightolier Is Offered As Evidence of Prior Public Use or Sale and Is Not a Proper Basis for IPR.....	15
2.	Petitioner Offers No Reason or Motivation to Combine Tickner, Chou, Lightolier, and Sung or Reasonable Expectation of Success in Doing So	16
3.	Chou Does Not Disclose “The Heat Spreader and the Heat Sink In Combination Define a Base” as Required by the Rotational Retention Limitation	18
4.	Chou Does Not Disclose “Engagement Tabs” As Required by the Rotational Retention Limitation	19
B.	Tickner Cannot Properly Be Combined With Chou Such That Petitioner’s Arguments Regarding Claim 11 Fail.....	21
C.	Tickner Does Not Render Obvious “At Least One Twist-On Wire Connector” Required By Claim 12.	21
VIII.	THE BOARD SHOULD DENY INSTITUTION ON GROUND 4 RELYING ON CHOU IN VIEW OF TICKNER.....	24
A.	Petitioner Offers No Reason Or Motivation To Combine Chou And Tickner Or Reasonable Expectation Of Success In Doing So	24
IX.	THE BOARD SHOULD DENY INSTITUTION ON GROUND 5 RELYING ON Zhang IN VIEW OF TICKNER.	26
A.	Petitioner Offers No Reason Or Motivation To Combine Zhang And Tickner Or Reasonable Expectation Of Success In Doing So	26
B.	Zhang Does Not Disclose The Heat Spreader Limitation.....	29
C.	Zhang Does Not Disclose The Thermal Communication Limitation	31
X.	CONCLUSION	33

TABLE OF AUTHORITIES

Page

Cases

<i>Apotex Inc. v. Wyeth LLC</i> , IPR2014-00115, Paper No. 94 (P.T.A.B. Apr. 20, 2015).....	9
<i>Generation Brands LLC v. Lighting Sci. Grp. Corp.</i> , 2017 WL 506575 (P.T.A.B. Feb. 6, 2017)	13
<i>Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.</i> , 821 F.3d 1359 (Fed. Cir. 2016)	6
<i>KSR Int’l Co. v. Teleflex, Inc.</i> , 550 U.S. 398 (2007).....	passim
<i>Millennium Pharm., Inc. v. Sandoz Inc.</i> , 862 F.3d 1356 (Fed. Cir. 2017)	22
<i>Mintz v. Dietz & Watson, Inc.</i> , 679 F.3d 1372 (Fed. Cir. 2012)	9
<i>Proctor & Gamble Co. v. Teva Pharms. USA, Inc.</i> , 566 F.3d 989(Fed. Cir. 2009)	9, 11, 16, 27
<i>Quad Envtl. Techs. Corp. v. Union Sanitary Dist.</i> , 946 F.2d 870 (Fed. Cir. 1991)	15
<i>Qualcomm Inc. v. ParkerVision Inc.</i> , IPR2015-01819, Paper No. 8 (P.T.A.B. Mar. 8, 2016)	passim
<i>Spears v. Holland</i> , Interf. No. 104,681, Paper No. 30 (B.P.A.I. Mar. 13, 2002).....	6, 19, 31, 33
<i>Velander v. Garner</i> , 348 F.3d 1359 (Fed. Cir. 2003)	22
<i>Volkswagen Grp. of Am., Inc. v. Velocity Patent LLC</i> , IPR2015-00276, Paper No. 8 (P.T.A.B. Jun. 1, 2015)	passim
<i>Wowza Media Sys., LLC v. Adobe Sys. Inc.</i> , IPR2013-00054, 2013 WL 5653113 (P.T.A.B. Apr. 8, 2013)	19, 31, 33

Statutes

35 U.S. C. § 311	15
35 U.S.C. § 103	8, 16, 22, 27
35 U.S.C. § 103(a)	22
35 U.S.C. § 301	15, 16
35 U.S.C. § 302	15
35 U.S.C. § 311(b)	15
37 C.F.R. § 42.104(b)(4).....	18, 30, 32
37 C.F.R. § 42.104(b)(5).....	18, 20, 31, 32
37 C.F.R. § 42.22(a)(2).....	18, 30, 32

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.