

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TECHNICAL CONSUMER PRODUCTS, INC., NICOR INC.,
AMAX LIGHTING, JIAWEI TECHNOLOGY (HK) LTD.,
JIAWEI TECHNOLOGY (USA) LTD., SHENZHEN JIAWEI PV
LIGHTING CO., LTD., LEEDARSON LIGHTING CO., LTD., and
LEEDARSON AMERICA, INC.,
Petitioner,

v.

LIGHTING SCIENCE GROUP CORP.,
Patent Owner.

Case IPR2017-01285¹
Patent 8,672,518 B2

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

TURNER, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
Inter Partes Review
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

¹ IPR2018-00262 and IPR2018-00270 are joined with this proceeding.

I. INTRODUCTION

Technical Consumer Products, Inc., Nicor Inc., and Amax Lighting (collectively, “Petitioner”) filed a Petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 1, 3–8, and 10–14 (“the challenged claims”) of U.S. Patent No. 8,672,518 B2 (Ex. 1001, “the ’518 Patent”). Lighting Science Group Corp. (“Patent Owner”) acknowledged the filing of the Petition (Paper 6), but did not file a preliminary response. We determined that the information presented in the Petition established that there was a reasonable likelihood that Petitioner would prevail in challenging claims 1, 3–8, and 10–14 of the ’518 Patent as unpatentable under 35 U.S.C. § 103(a). Pursuant to 35 U.S.C. § 314, we instituted this *inter partes* review on November 1, 2017, as to all of the challenged claims, except claim 10, but not all the grounds presented the Petition. Paper 10 (“Dec. on Inst.”).

During the course of trial, Patent Owner filed a Patent Owner Response (Paper 17, “PO Resp.”), and Petitioner filed a Reply to the Patent Owner Response (Paper 21, “Pet. Reply”). A consolidated oral hearing with related Cases IPR2017-01280 and IPR2017-01287 was held on September 6, 2018, and a transcript of the hearing is included in the record. Paper 32 (“Tr.”).

Before the consolidated oral hearing, the United States Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on less than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018). Following *SAS*, the U.S. Patent and Trademark Office (“Office”) issued “Guidance on the impact of SAS on AIA trial proceedings,” in which the Office took the policy position that a decision granting institution will institute on all of the challenged claims in

the petition *and* all the grounds presented in the petition.² The U.S. Court of Appeals for the Federal Circuit has since endorsed this Office policy by explaining that “‘the petitioner’s petition, not the Director’s discretion, is supposed to guide the life of the litigation’ and ‘that the petitioner’s contentions, not the Director’s discretion, define the scope of the litigation all the way from institution through to conclusion.’” *Adidas AG v. Nike, Inc.*, 894 F.3d 1256, 1258 (Fed. Cir. 2018) (quoting *SAS*, 138 S. Ct. at 1356–1357). In accordance with *SAS* and Office policy, we issued an Order modifying our Decision on Institution entered on November 1, 2017, to include review of all challenged claims and all grounds presented by Petitioner in its Petition. Paper 19.

In addition, two additional petitioners sought institution of similar grounds of unpatentability against claims 1, 3–8, and 10–14 of the ’518 Patent: (1) Jiawei Technology (HK) Ltd., Jiawei Technology (USA) Ltd., and Shenzhen Jiawei Photovoltaic Lighting Co, Ltd. (“Jiawei”); and (2) Leedarson Lighting Co., Ltd., and Leedarson America, Inc. (“Leedarson”). *See* Papers 22, 23. We instituted review of all of the challenged claims and all grounds with respect to both new petitioners and joined the instituted proceedings, i.e., IPR2018-00262 and IPR2018-00270, with the instant proceeding. *Id.* Both new petitioners were joined under specific conditions in “understudy” roles. *Id.*

We have jurisdiction under 35 U.S.C. § 6. This decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of

² Available at <https://www.uspto.gov/patentsapplication-process/patent-trial-and-appeal-board/trials/guidance-impactsas-aia-trial>.

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claims 1, 3–8, and 11–14 of the '518 Patent. For the reasons discussed below, we hold that Petitioner has demonstrated by a preponderance of the evidence that these claims are unpatentable under § 103(a).

A. Related Matters

Additional petitions were filed seeking *inter partes* review of U.S. Patent No. 8,967,844 B2 (“the '844 Patent”), co-pending Case IPR2017-01280, and of U.S. Patent No. 8,201,968 B2 (“the '968 Patent”), co-pending Case IPR2017-01287. Pet. 1. The '518 Patent issued from a continuation-in-part of U.S. Patent Application No. 12/775,310, from which the '968 Patent issued, and '844 Patent issued from a continuation of the '518 Patent.

The '968, '518, and '844 Patents have been asserted in the following proceedings: *Lighting Sci. Grp. Corp. v. Cree, Inc.*, Case No. 6:13-cv-00587 (M.D. Fla. filed Apr. 10, 2013); *Lighting Sci. Grp. Corp. v. Cooper Lighting, LLC*, Case No. 6:14-cv-00195 (M.D. Fla. filed Feb. 6, 2014); *Lighting Sci. Grp. Corp. v. Sea Gull Lighting Prods. LLC*, Case No. 6:16-cv-00338 (M.D. Fla. filed Feb. 25, 2016); *Lighting Sci. Grp. Corp. v. U.S.A. Light & Elec., Inc.*, Case No. 6:16-cv-00344 (M.D. Fla. filed Feb. 26, 2016); *Lighting Sci. Grp. Corp. v. Hyperikon, Inc.*, Case No. 6:16-cv-00343 (M.D. Fla. filed Feb. 26, 2016); *Lighting Sci. Grp. Corp. v. Nicor Inc.*, Case No. 6:16-cv-00413 (M.D. Fla. filed Mar. 10, 2016); *Lighting Sci. Grp. Corp. v. Sunco Lighting, Inc.*, Case No. 6:16-cv-00677 (M.D. Fla. filed Apr. 21, 2016); *Lighting Sci. Grp. Corp. v. Panor Corp.*, Case No. 6:16-cv-00678 (M.D. Fla. filed Apr. 21, 2016); *Lighting Sci. Grp. Corp. v. S E L S, Inc.*, Case No. 6:16-cv-00679 (M.D. Fla. filed Apr. 21, 2016); *Lighting Sci. Grp. Corp. v. EEL Co., Ltd.*, Case No. 6:16-cv-00680 (M.D. Fla. filed Apr. 21, 2016); *Lighting Sci. Grp.*

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Corp. v. Globalux Lighting LLC, Case No. 6:16-cv-00681 (M.D. Fla. filed Apr. 21, 2016); *Lighting Sci. Grp. Corp. v. Hubbell Inc.*, Case No. 6:16-cv-01084 (M.D. Fla. filed June 22, 2016); *Lighting Sci. Grp. Corp. v. American De Rosa Lamparts, LLC*, Case No. 6:16-cv-01087 (M.D. Fla. filed June 21, 2016); *Lighting Sci. Grp. Corp. v. Titch Indus., Inc.*, Case No. 6:16-cv-01228 (M.D. Fla. filed July 7, 2016); *Lighting Sci. Grp. Corp. v. Tech. Consumer Prods., Inc.*, Case No. 6:16-cv-01255 (M.D. Fla. filed July 13, 2016); *Lighting Sci. Grp. Corp. v. Satco Prods., Inc.*, Case No. 6:16-cv-01256 (M.D. Fla. filed July 13, 2016); *Lighting Sci. Grp. Corp. v. Amax Lighting*, Case No. 6:16-cv-01321 (M.D. Fla. filed July 22, 2016); *Lighting Sci. Grp. Corp. v. Wangs Alliance Corp.*, Case No. 6:16-cv-01320 (M.D. Fla. filed July 22, 2016); *Lighting Sci. Grp. Corp. v. Halco Lighting Techs., LLC*, Case No. 6:16-cv-02188 (M.D. Fla. filed Dec. 21, 2016); *Lighting Sci. Grp. Corp. v. Shenzhen Jiawei Photovoltaic Lighting*, Case No. 6:16-cv-03886 (N.D. Cal. filed July 11, 2016); and *Lighting Sci. Grp. Corp. v. Leedarson Lighting Co.*, Case No. 6:17-cv-00826 (M.D. Fla. filed May 9, 2017). Pet. 1–2; Paper 6, 1–3; Paper 27.

Generation Brands LLC previously filed petitions for *inter partes* review of the '844 Patent and the '968 Patent in IPR2016-01546 and IPR2016-01478, respectively. Pet. 1. After our decisions to institute *inter partes* reviews in these cases, both cases were settled and terminated. *See id.*; Paper 6, 1. In addition, Satco Products, Inc., filed petitions for *inter partes* review of the '844 Patent and the '968 Patent in IPR2017-01639 and IPR2017-01638, respectively, where we instituted *inter partes* reviews in these cases, which are still pending.

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