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

PRIME WIRE & CABLE, INC.	)	
	)	
Petitioner,	)	
	)	
v.	)	**Case: IPR2018-**
	)	**Patent No.: 9,320,122**
CANTIGNY LIGHTING CONTROL, LLC.	)	
	)	**EXHIBIT 1056**
Patent owner	)	
	)	
JASCO PRODUCTS, INC.	)	
	)	
Licensee	)	

DECLARATION OF JOSEPH MAYO IN SUPPORT OF THE PETITION FOR *INTER PARTES* REVIEW OF U.S. PAT. NO. 9,320,122

My name is Joseph Mayo. I am over 18 and in all ways qualified to make this declaration. I hereby make the following declaration.

I. Background & Qualifications

1. I am a registered patent agent (reg. no. 53,288) and have prosecuted over 500 patent applications to allowance. I am also a Sun Certified Enterprise Architect and Java programmer. I am also an electrical engineer, and received my education and BSEE from the Massachusetts Institute of Technology (MIT) in 1983. After college, I worked in the software and electronics industry for 19 years (from 1983-2002) before turning my attention to a patent prosecution

practice focused on the arts of programmable electronics.

2. I am very familiar with programming electronics and circuitry, including timers, which are the mechanisms of operation in the technology of U.S. Pat. No. 9,320,122 ("the '122 Patent")[Ex. 1001].

3. A copy of my curriculum vitae, which describes in further detail my qualifications, responsibilities, employment history, and etcetera are attached.

II. Retention

4. I have been retained by Petitioner to offer an objective opinion about whether a person of skill in the art at the time of invention would have found the claims of the '122 patent either anticipated or obviousness in light of certain art provided to me by Petitioner. I have been compensated at my standard hourly rate of $350.00. My compensation is in no way contingent on the results of this or any other proceedings related to the above-captioned matter.

III. Information Provided To Me

5. In proceedings before the USPTO, I understand that the claims of an unexpired patent are to be given their broadest reasonable interpretation in view of the specification from the perspective of one of ordinary skill in the field. I have been informed that the '122 patent has not expired. In comparing the '122 patent to the known prior art, I have carefully considered the '122 patent and the '122 patent's file history from my perspective as one of skill in the art using my

experience and knowledge in the relevant field. I observed that CANTIGNY Lighting Control, LLC ("CANTIGNY") is the listed owner of the '122 patent. In the '122 patent file history [Ex. 1002], I observed a citation of "claim scope statements" [Ex. 1003] under 37 CFR § 1.501 ("Rule 501 statements") which informed my reading of the '122 patent because it shows how the rights holders have interpreted the scope of their claims in the marketplace. Similarly, I have also reviewed the complaints filed in the two lawsuits for alleged infringement of the '122 patent, namely: (1) *Cantigny v. Jasco*, Civil Action No. 16-cv-05794 (in the Norther District of Illinois) [Ex. 1004-1010]; and (2) *Jasco v. Prime*, Civil Action No. 5:18-cv-44 (in the Western District of North Carolina) [Ex. 1013-1024].

6. I observed that the application for the '122 patent was filed on Nov. 18, 2015, but that it claims to be related as a "divisional" to now U.S. Pat. No. 9,226,373 (issued Dec. 20, 2014) ("the '373 parent"). So, I also reviewed the '373 parent to assist my reading of the '122 patent and its claims. I immediately observed that the '122 patent has been rewritten relative to the '373 parent. Importantly, I observed that only the new matter added to the '122 specification provides the antecedent basis of subject matter in the '122 claims. For reasons discussed below, it is my opinion that the '122 claims were not entitled to the priority of the '373 parent because there is not a sufficient written description in

the ‘373 parent for the subject matter of the ‘122 claims. So, for purposes of this declaration, I take Nov. 18, 2015 or actual filing date of the ‘122 claims to determine whether a reference constitutes prior art.

7. I understand that a claim is invalid (or should not be allowed) if its subject matter is anticipated or obvious under 35 U.S.C. §§ 102 and 103 respectively. I further understand that anticipation of a claim requires that every element of a claim be disclosed expressly or inherently in either a single prior art reference or multiple corroborating references, as claimed. MPEP 2131 and 2131.01.

8. I understand that a claim is “obvious” for purposes of 35 U.S.C. § 103 when the claimed subject matter has elements that are technically different than the elements of comparable prior art, but there is a rational explanation as to why the differences between the elements of the claims and the prior art are not meaningful or are otherwise insignificant to a person of relevant skill in the art before the claims were filed. MPEP 2141-2144. In particular, I understand that a claim is obvious if it alters prior art by way of mere substitution of one element for another known element in the field and that combination yields predictable results. *Id.* While it may be helpful to identify a reason one of skill in the art might have altered the prior art to arrive at the claimed invention, common sense should guide and no rigid requirement of finding a teaching suggestion or

motivation to combine is required. *Id.* But, if there is an express teaching of the alteration of prior art to arrive at the claimed invention, the claim is *prima facie* obvious, which I understand to mean the claim must be proved unobvious or else it is invalid. *Id.* I further understand that a claim may be obvious if common sense directs one to combine multiple prior art references or add missing features to produce the alleged invention recited in the claims. *Id.* I understand that a person of ordinary skill in the art is a person of ordinary creativity, not an automaton. *Id.*

IV. The '122 patent (Ex. 1001)

9. The '122 patent specification describes several embodiments of a programmable ON/OFF timers. The '122 patent has 20 total claims, including three independent claims (claims 1, 8, and 15). The '122 patent claims speak to ON/OFF timers with two separate timing programs tied to buttons. In some cases, timing patterns can be customized, in other cases it is pre-stored. The patent has 20 total claims, including three independent claims (claims 1, 8, and 15). Two independent claims are apparatus claims for timers, and one independent claim is a method claim tied to using a timer for an electrical apparatus.

10. In addition to reading the claims, I have also reviewed Rule 501 statements [Ex. 1003] to inform my understanding of the claimed subject matter.

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