

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

PRIME WIRE & CABLE, INC.)
)
Petitioner,)
)
v.)
)
CANTIGNY LIGHTING)
CONTROL, LLC.)
)
Patent owner)
)
JASCO PRODUCTS, INC.)
)
Licensee)

**Case: IPR2018-01592
Patent No.: 9,320,122**

EXHIBIT 1003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Patent No. 9,320,122 §
§
Issued: Apr. 19, 2016 §
§
For: PROGRAMMABLE LIGHT § **37 CFR 1.501 Citation of prior art and**
TIMER AND A METHOD § **written statements in patent files**
OF IMPLEMENTING A §
PROGRAMMABLE LIGHT §
TIMER §
§
Patentee: Cantigny Lighting §
Control, LLC §
§
Art Unit: 2841 (for §

Rule 501 citation of prior art and written “claim scope statements”
in U.S. Pat. No. 9,320,122

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Cantigny Lighting Control, LLC’s (“Cantigny”) owns U.S. Patent No. 9,320,122 (“the ‘122 patent”)(Real/Frame: 038505/0163).¹ Mid-2016, Cantigny sued Jasco Products Company, LLC (“Jasco”) for infringement of the ‘122 patent in the District Court for the Northern District of Illinois, Eastern Division (Civil Action No. 16-cv-05794). Cantigny’s complaint in that lawsuit contains multiple

¹ Cantigny “holds total legal ownership” of the ‘122 patent. The inventor and patent attorney of record, John Joseph King, formed Cantigny as “a vehicle for the development of consumer products using his inventions in light timing technology.” Document #1, page 1, ¶ 1, *Cantigny v. Jasco* (case no. 1:16-cv-05794).

infringement contentions and associated “claim scope statements” that are now made of record pursuant to 35 U.S.C. § 301 and 37 C.F.R. § 1.501 (“rule 501”). Importantly, Cantigny’s overreach on the scope of its claims causes the claims to encompass prior art that was not considered by the USPTO before it decided to allow the ‘122 patent. Such prior art was presumably overlooked during the Examiner’s patentability search and examination of the patented technology because the USPTO and Cantigny took a much narrower position on the claims during prosecution than Cantigny now takes in the Federal Courts and in the marketplace. Moving forward, fairness, equity, and rule 501 demand that Cantigny either (1) explain its forum-dependent positions on claim scope and state for the record the limitations of its claims via its own Rule 501 citation or (2) otherwise be held to its invalidatingly expansive positions on claim scope during any reexaminations or *inter partes* reviews of this patent. *See* MPEP § 2202 (“The basic purpose for citing written claim scope statements is to ensure that the patent owner takes consistent positions regarding the scope of the claims of a particular patent in the courts and before the Office.”).

March 14, 2018
Date

Respectfully Submitted,

Bryce A. Johnson
/Bryce A. Johnson/
Reg. No. 74,733

Table of Contents

| | | |
|-----------|---|----|
| I. | Background & Introduction | 3 |
| II. | Requirements for Rule 501 citations of prior art & “claim scope statements” | 8 |
| A. | Prior art that has a bearing on the patentability of the ‘122 patent claims | 9 |
| B. | Claim scope statements made in Federal Court..... | 11 |
| <u>1.</u> | Any other documents, pleadings, or evidence from the proceeding in which the statement was filed that address the written statement | 18 |
| <u>2.</u> | The forum & proceeding in which patent owner filed each statement..... | 19 |
| <u>3.</u> | The specific papers and portions of the papers submitted that contain the statements | 19 |
| <u>4.</u> | How each statement submitted is a statement in which patent owner took a position on the scope of any claim in the patent..... | 20 |
| C. | Explanation –Patent Owner Statements:..... | 21 |
| D. | Explanation –Patent Owner Statements:..... | 28 |
| <u>1.</u> | At least independent claims 1 and 15 of the ‘122 patent are invalid under AIA 35 U.S.C. § 102 (a)(1) for being anticipated by “Timex Digital ON-OFF Lamp Timer” (published Oct. 14, 2004) by BookOfJoe, in view of Cantigny’s “claim scope statements” | 28 |
| <u>2.</u> | At least independent claims 1 and 15 of the ‘122 patent are invalid under AIA 35 U.S.C. § 102 (a)(1) for being anticipated by Data Sheet for “4980 Programmable repeat cycle ON-OFF timer” (published Oct. 1, 2010) by <i>Artisan Controls Corporation</i> , in view of Cantigny’s “claim scope statements” | 35 |
| <u>3.</u> | At least independent claim 8 of the ‘122 patent is invalid under AIA 35 U.S.C. § 102 (a)(1) for being anticipated by Data Sheet for “5100 | |

configurable countdown timer” (published Aug. 21, 2013) by *Artisan Controls Corporation*, in view of Cantigny’s “claim scope statements” ...42

4. At least the independent claims of the ‘122 patent are invalid under AIA 35 U.S.C. § 102 (a)(1) for being anticipated by U.S. Pat. No. 4,279,012(issued Jul. 14, 1981) by *Beckerdorff et al.* for a “programmable appliance controller” in view of Cantigny’s “claim scope statements”48

III. Reexamination Expected.54

IV. Identity of Submitter54

V. Certificate of Service.54

CERTIFICATE OF SERVICE1

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.