

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COLEMAN CABLE, LLC, JIAWEI TECHNOLOGY (HK) LTD., JIAWEI
TECHNOLOGY (USA) LTD., SHENZHEN JIAWEI PHOTOVOLTAIC
LIGHTING CO, LTD., ATICO INTERNATIONAL (ASIA) LTD., ATICO
INTERNATIONAL USA, INC., SMART SOLAR, INC., and TEST RITE
PRODUCTS CORP.,
Petitioner,

v.

SIMON NICHOLAS RICHMOND,
Patent Owner.

Case IPR2014-00935
Patent 8,089,370 B2

Before WILLIAM V. SAINDON, JUSTIN T. ARBES, and
BARRY L. GROSSMAN, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

DECISION

Final Written Decision
35 U.S.C. § 318(a); 37 C.F.R. § 42.73

I. INTRODUCTION

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. With respect to the grounds asserted in this trial, we have considered the papers submitted by the parties and the evidence cited therein. For the reasons discussed below, we determine that Petitioner has shown, by a preponderance of the evidence, that the subject matter of claims 1–7, 9, 10, 14, 17–20, 23, 28, 43, 45 and 48–50 of U.S. Patent No. 8,089,370 B2 (Ex. 1001, “the ’370 patent”) is unpatentable. In addition, we deny-in-part and dismiss-in-part both Petitioner’s and Patent Owner’s Motions to Exclude Evidence, and we grant Petitioner’s Motion to Seal.

A. *Procedural History*

Coleman Cable, LLC, Jiawei Technology (HK) Ltd., Jiawei Technology (USA) Ltd., Shenzhen Jiawei Photovoltaic Lighting Co, Ltd., Atico International (Asia) Ltd., Atico International USA, Inc., Smart Solar, Inc., and Test Rite Products Corp. (collectively “Petitioner”) filed a Corrected Petition to institute an *inter partes* review (Paper 10, “Pet.”) of claims 1–7, 9, 10, 14, 17–20, 23, 28, 43, 45 and 48–50 of the ’370 patent. Pet. 1. Petitioner included a declaration of Peter W. Shackle, Ph.D. (Ex. 1002). We instituted an *inter partes* review of all the challenged claims, claims 1–7, 9, 10, 14, 17–20, 23, 28, 43, 45 and 48–50, on December 22, 2014. Paper 19 (“Dec. on Inst.”). Patent Owner then filed its Response to Petitioner’s Petition (Paper 29, “PO Resp.”), to which Petitioner filed its Reply (Paper 44, “Pet. Reply”). An oral hearing was held on September 21, 2015. Paper 64 (“Tr.”).

Patent Owner alleged that Petitioner failed to list all real parties in interest, and we authorized the parties to brief the issue. Paper 32 (Motion to Terminate); Paper 38 (Opposition); Paper 42 (Reply). We denied the Motion to Terminate.

Paper 52.

There are several outstanding motions decided herein. Patent Owner filed a Motion to Exclude Evidence. Paper 50 (“PO Mot. Excl.”); *see also* Paper 57 (Petitioner’s Opposition, “Pet. Opp. to PO Mot. Excl.”); Paper 60 (Patent Owner’s Reply, “PO Reply in support of PO Mot. Excl.”). Likewise, Petitioner filed a Motion to Exclude Evidence. Paper 49 (“Pet Mot. Excl.”); *see also* Paper 54 (Patent Owner’s Opposition, “PO Opp. to Pet. Mot. Excl.”); Paper 59 (Petitioner’s Reply, “Pet. Reply in support of Pet. Mot. Excl.”). Lastly, Petitioner filed a Motion to Seal. Paper 36 (“Pet. Mot. Seal”). Patent Owner did not file an opposition.

B. Related Proceedings

Petitioner states that Patent Owner has filed a number of lawsuits alleging infringement of the ’370 patent. Pet. 3–4. Petitioner also filed three petitions for *inter partes* review of patents, owned by the same Patent Owner as named in this Petition, involving similar technology to that disclosed in the ’370 patent. These three *inter partes* reviews are IPR2014-00936 (instituted); IPR2014-00937 (denied); and IPR2014-00938 (instituted).

C. The ’370 Patent

The ’370 patent is titled “Illuminated Wind Indicator.” Ex. 1001, 1. The disclosed illuminated wind indicator is a modified wind chime having a solar powered, rechargeable light emitting pendulum. In this manner, power can be accumulated during the day and used to provide illumination at night. *Id.* at col. 5, ll. 11–16.

As shown in Figure 1 of the ’370 patent, reproduced below, wind indicator 10 includes light device 12 and chime portion 14, light device 12 and chime portion 14 being suspended on support 16 provided with spike 18. *Id.* at col. 5, ll.

22–26.

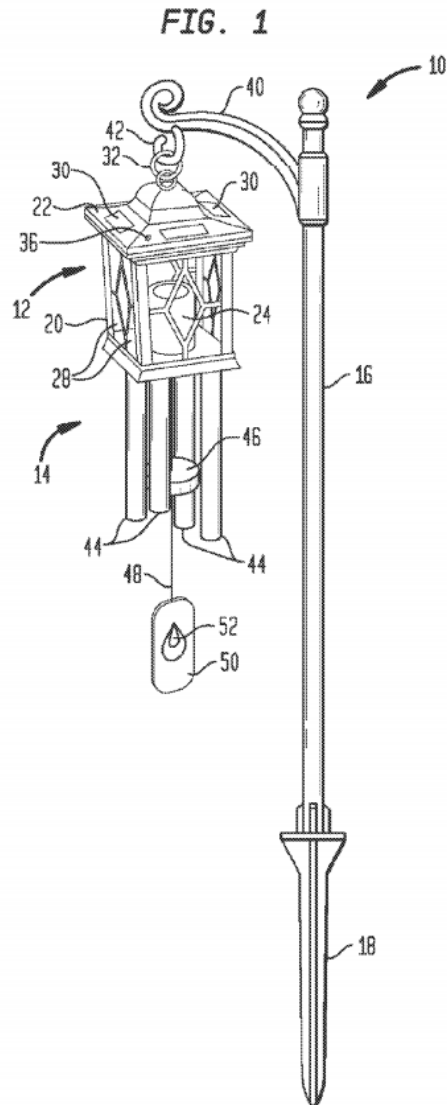


Fig. 1 from the '370 patent
is a perspective view of wind indicator 10.

As shown generally in Figure 1, light device 12 includes housing 20, lid 22, and light source 24. *Id.* at col. 5, ll. 27–31. Solar panels 30 convert solar energy to electrical power. *Id.* at col. 5, ll. 38–39. Chime portion 14 includes chime members 44 and a pendulum assembly suspended from housing portion 20. *Id.* at col. 5, ll. 57–60. In the example shown in Figure 1, the pendulum assembly includes striker disc 46 suspended using electrical wires 48, which pass from light

device 12 through striker disc 46 to pendulum 50. *Id.* at col. 5. ll. 60–64.
Electrical wires 48 may be electrically connected to second light emitting element 52 disposed inside pendulum 50. *Id.* at col. 5, l. 65–col. 6, l. 1.

D. Illustrative Claim

Among the challenged claims, claims 1, 5, 17, 18, 19, 28, 43 and 45 are independent claims. Claim 1 is directed to a “solar lamp;” claim 5 is directed to an “illuminated wind indicator;” claim 17 is directed to a “solar light module for illuminating a wind chime;” claim 18 is directed to a “lighting apparatus;” and claims 19, 28, 43 and 45 are directed to an “illuminated wind indicator.” Claim 1 is illustrative of the claimed invention and is reproduced below.

1. A solar lamp comprising:
 - a riser portion;
 - a connecting frame connected to said riser portion;
 - at least one light source, wherein said at least one light source emits light directed above at least part of said riser portion;
 - an at least partially light transmissive lens extending to cover at least part of said at least one light source and wherein light emitted from said at least one light source causes at least part of said lens to illuminate;
 - a surround frame attached to said lamp proximate to the intersection of said connecting frame and said riser portion such that some of said light passes through said lens to illuminate at least part of said surround frame from below at least part of said surround frame;
 - electrical connections for at least one rechargeable power source, wherein said riser portion positions said connections above a ground surface;
 - an activation circuit to provide power to said at least one light source from said at least one rechargeable power source only at low light levels; and
 - at least one photovoltaic panel, wherein said at least one photovoltaic panel is electrically connected to said at least one light source via said at least one rechargeable power source,

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