

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JIAWEI TECHNOLOGY (HK) LTD., JIAWEI TECHNOLOGY (USA) LTD.,
SHENZHEN JIAWEI PHOTOVOLTAIC LIGHTING CO., LTD., ATICO
INTERNATIONAL (ASIA) LTD., ATICO INTERNATIONAL USA, INC.,
CHIEN LUEN INDUSTRIES CO., LTD., INC. (CHIEN LUEN FLORIDA),
CHIEN LUEN INDUSTRIES CO., LTD., INC. (CHIEN LUEN CHINA),
COLEMAN CABLE, LLC, NATURE'S MARK, RITE AID CORP.,
SMART SOLAR, INC., and TEST RITE PRODUCTS CORP.,
Petitioner,

v.

SIMON NICHOLAS RICHMOND,
Patent Owner.

Case IPR2014-00936
Patent 7,196,477 B2

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

SAINDON, *Administrative Patent Judge*.

DECISION

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

Granting Motion to Seal
37 C.F.R. § 42.55

Denying-in-Part and Dismissing-in-Part Motions to Exclude
37 C.F.R. § 42.64(c)

I. BACKGROUND

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 1–29 of U.S. Patent No. 7,196,477 B2 (Ex. 1001, “the ’477 patent”) is unpatentable. In addition, we deny-in-part and dismiss-in-part Petitioner’s and Patent Owner’s Motions to Exclude Evidence, and we grant Petitioner’s Motion to Seal.

A. Procedural History

Petitioner filed a revised Petition to institute an *inter partes* review (Paper 14, “Pet.”) of the ’477 patent on June 30, 2014. Pet. 1. Patent Owner filed a Preliminary Response. Paper 20 (“Prelim. Resp.”). We instituted an *inter partes* review of claims 1–29 of the ’477 patent on December 16, 2014. Paper 21 (“Dec. on Inst.”). Patent Owner then filed his Response to Petitioner’s Petition (Paper 31, “PO Resp.”), to which Petitioner filed its Reply (Paper 48, “Pet. Reply”). An oral hearing was held on September 21, 2015. Paper 66 (“Tr.”).

Patent Owner alleged that Petitioner failed to list all real parties in interest and we authorized the parties to brief the issue. Paper 34 (Motion to Terminate); Papers 42, 43 (Opposition); Paper 46 (Reply). We denied Patent Owner’s Motion to Terminate. Paper 56.

There are several outstanding motions decided herein. Patent Owner filed a Motion to Exclude Evidence. Paper 53 (“PO Mot. Excl.”); *see also* Paper 60 (Petitioner’s Opposition, “Pet. Opp. PO Mot. Excl.”); Paper 62 (Patent Owner’s Reply, “PO Reply PO Mot. Excl.”). Likewise, Petitioner filed a Motion to Exclude Evidence. Paper 55 (“Pet. Mot. Excl.”); *see also* Paper 58 (Patent Owner’s Opposition, “PO Opp. Pet. Mot. Excl.”); Paper 61 (Petitioner’s Reply, “Pet. Reply Pet. Mot. Excl.”). Lastly, Petitioner filed a Motion to Seal. Paper 40 (“Pet. Mot. Seal”). Patent Owner did not file an opposition to Petitioner’s Motion to Seal.

B. Related Matters

Petitioner states that Patent Owner has asserted a number of lawsuits against the Petitioner companies alleging infringement of the ’477 patent. Pet. 3–4; Paper 18, 3; Paper 19, 3–4. Petitioner and Patent Owner also are involved in other *inter partes* reviews: IPR2014-00935 (U.S. Patent No. 8,089,370 B2) (instituted), IPR2014-00937 (U.S. Patent No. 8,362,700 B2, “the ’700 patent”) (denied), and IPR2014-00938 (U.S. Patent No. 7,429,827 B2, “the ’827 patent”) (instituted). Pet. 4; Paper 19, 1. The ’700 patent is a continuation-in-part of the ’827 patent, which is a continuation-in-part of the ’477 patent.

C. The ’477 Patent

The ’477 patent describes a solar powered light that produces light of varying color. Ex. 1001, 1:6–8. According to the ’477 patent, producing light of a variable color is known, and solar powered “garden lights” are known. *Id.* at 1:12–20. The claimed invention “overcome[s] or substantially ameliorate[s] at least one of the . . . disadvantages” of the prior

art, which includes “difficulty in adjusting the various lighting functions” and “not producing a uniform desired colour.” *Id.* at 1:21–30.

D. Exemplary Claims

Of the claims challenged, claims 1 and 20 are independent. Claim 1 is reproduced below.

1. A lighting device to produce light of varying colour, said device including:
 - a body including a spike;
 - a lens mounted on the body and generally enclosing a chamber having an upper rim surrounding a top opening, and a bottom region;
 - a cap assembly including securing means to releasably engage the rim so that the cap assembly can be selectively removed from the lens; said assembly including:
 - a base; and
 - a circuit having at least two lamps of different colours to produce a desired colour including a varying colour, the lamps being mounted to direct light into said chamber, connections for at least one rechargeable battery to power the circuit and a solar cell mounted on a surface of the assembly so as to be exposed to light and operatively associated with the connections to charge the battery, and a switch operated to control delivery of electric power from the battery to operate said circuit, the switch being exposed to provide for access thereto by a user.

E. Prior Art and Asserted Grounds

References	Basis under 35 U.S.C.	Claims Challenged
Chliwnyj, ¹ Wu, ² and Hung ³	§ 103	1, 2, 4–9, 20–22, and 26
Chliwnyj, Wu, Hung, and Pu ⁴	§ 103	10–12, 23–25, and 27–29
Chliwnyj, Wu, Hung, and Xu ⁵	§ 103	3 and 13–16
Chliwnyj, Wu, Hung, Xu, and Pu	§ 103	17–19

II. MOTIONS

A. Petitioner's Motion to Seal

Petitioner moves to seal Exhibits 1018 and 1031, portions of Exhibits 1021, 1042–1044, and 1046, and portions of its Opposition to Patent Owner's Motion to Terminate.⁶ Pet. Mot. Seal 2. Petitioner proposes entry of the Default Protective Order. *Id.* at 5; *see Office Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,769–71 (Aug. 14, 2012). Petitioner has provided redacted versions of Exhibits 1021, 1042–1044, and 1046. Pet. Mot. Seal 2.

The Exhibits generally relate to an internal corporate resolution, listings of financial account numbers, and invoices for attorney fees. *See* Pet. Mot. Seal 3–4. The redacted versions of these documents, upon which

¹ U.S. Patent No. 5,924,784, issued July 20, 1999 (Ex. 1005).

² U.S. Patent Application Publication No. US 2003/0201874 A1, published Oct. 30, 2003, filed Apr. 24, 2002 (Ex. 1006).

³ PCT Application WO 91/02192, published Feb. 21, 1991 (Ex. 1016).

⁴ Chinese Patent Publication No. CN 2522722Y, published Nov. 27, 2002 (Ex. 1008) (certified translation).

⁵ Chinese Patent Publication No. CN 2541713Y, published Mar. 26, 2003 (Ex. 1012) (certified translation).

⁶ Petitioner filed two such oppositions, Papers 42 and 43, but neither appears to have been filed with confidentiality restrictions.

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