

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.

IPR2014-00938
Patent 7,429,827 B2

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

SAINDON, *Administrative Patent Judge*.

DECISION
Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Petitioner filed a revised petition to institute an *inter partes* review of claims 24–35 of U.S. Patent No. 7,429,827 B2 (Ex. 1001, “the ’827 patent”). Paper 13, 1. We instituted an *inter partes* review of claims 24–30 and 35 of the ’827 patent but denied review of claims 31–34. Paper 20 (“Decision” or “Dec.”). Our denial of review of claims 31–34 was premised on Petitioner’s failure to offer a construction of a term critical to understanding the scope of claims 31–34, “color changing cycle,” and consequent failure to meet its burden under 37 C.F.R. § 42.104(b)(3)–(5). Dec. 16–17. In its Request for Rehearing of claims 31–34¹ (Paper 22, “Req. Reh’g”), Petitioner now offers new arguments, not found in its Petition, directed to a “color changing cycle.” For this, and other reasons expressed below, we deny Petitioner’s request and do not modify our Decision.

II. DISCUSSION

A. *Applicable Standards of Review*

An *inter partes* review may be instituted if it is determined that there is a “reasonable likelihood that the petitioner would prevail.” 35 U.S.C. § 314(a). When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). In pertinent part, 37 C.F.R. § 42.71(d) states:

The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion,

¹ Petitioner includes claim 35 in its request, but we consider Petitioner’s inclusion of claim 35 to be a typographical error because we instituted review on claim 35.

an opposition, or a reply.

B. Summary of Our Prior Decision

In general, the challenged claims of the '827 patent (claims 24–35) recite a “lighting device to produce light of varying colour.” Claims 31–34, at issue in this Request for Rehearing, further specify that the device produces “a continuous color changing cycle.” In our Decision, we separately addressed claims 31–34 from claims 27–29 and 35 because of “the differences in scope” between the claims. Dec. 15. With respect to claims 31–34, we noted that Petitioner failed to construe the term “color changing cycle.” *Id.* at 16. Indeed, we noted that Petitioner provided no cogent discussion of “color changing cycle” or how the limitation is taught or suggested by the cited prior art. Instead, Petitioner merely provided citations in a claim chart. Finding no discernable discussion of “color changing cycle” in the prior art or in the Petition, we determined that Petitioner failed to meet its burden to construe the claims and explain how they read on the prior art. *Id.* at 16–17. As a consequence, we denied review of claims 31–34.

C. Petitioner’s Contentions

Petitioner first contends that Patent Owner admitted that the plain and ordinary meaning of “cycle” does not require repetition. Req. Reh’g. 6–9. First, we did not adopt any construction of the term by Patent Owner. In addition, we did not construe “color changing cycle,” let alone construe it to require any particular form of repetition. Instead, we simply stated that the term “cycle” implied some pattern, and that the prior art to which Petitioner cited admonishes patterns. Dec. 16–17. Accordingly, the form of repetition, if any, implied by the term “cycle,” was not germane in our reason to deny institution of claims 31–34. What was germane was Petitioner’s failure to address the claim term sufficiently. *Id.* at 16 (“Petitioner does not provide a claim construction of ‘color changing

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cycle,’ . . . nor does Petitioner explain how it believes that term reads on what Chliwnyj discloses”); *id.* at 17 (“It is Petitioner’s burden to explain how the challenged claims are to be construed and how they read on the prior art”). In view of the above, Petitioner’s arguments regarding repetition are unpersuasive.

At footnote 2 of the Request for Rehearing, Petitioner offers new evidence regarding how “cycle” may read on the prior art. Req. Reh’g. 3. We could not have misapprehended or overlooked evidence that was not part of the record at the time of the Decision, and Petitioner has not shown good cause for considering the new exhibit, which existed well before Petitioner filed its Petition, at this stage of the proceeding. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012) (in deciding a request for rehearing, “[e]vidence not already of record at the time of the decision will not be admitted absent a showing of good cause”).

At pages 8–12 of the Request for Rehearing, Petitioner offers new arguments regarding the construction of “color changing cycle” and new arguments regarding how this term may read on the prior art. The proper time to have made these arguments was in the Petition, not in the Request for Rehearing. Because we could not have overlooked arguments not presented in the Petition, Petitioner’s arguments here do not persuade us we overlooked any arguments in the Petition.

At page 12, Petitioner argues that the prior art reference Chliwnyj does not teach away from repeating cycles. Our Decision characterized Chliwnyj as “admonish[ing] prior art lights that have a perceptible ‘pattern.’” Dec. 16–17. To the extent that this passage in our Decision may be mischaracterized, we hereby clarify that this passage is not characterizing Chliwnyj as “teaching away” from a “color changing cycle.” As Petitioner correctly points out, mere discussion of

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prior art as inferior is not a teaching away. Req. Req'g. 12 (citing *In re Gurley*, 27 F.3d 551, 552–553 (Fed. Cir. 1994)). Notwithstanding, we remain convinced that Petitioner's failures in its Petition under 37 C.F.R. § 42.104(b)(3)–(5) regarding the “color changing cycle” limitation justify our decision to deny review of claims 31–34.

III. CONCLUSION

For the foregoing reasons, Petitioner has not shown that the Board abused its discretion by not instituting *inter partes* review of claims 31–34.

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