

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND THE 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 IPR2014-00938
Patent No. 7,429,827

PATENT OWNER'S RESPONSE TO REVISED PETITION FOR *INTER PARTES* REVIEW UNDER 35 U.S.C. § 311 *ET SEQ.* AND 37 C.F.R. § 42.100 *ET SEQ.* (CLAIMS 24 – 30 AND 35 OF U.S. PATENT NO. 7,429,827)

Table of Contents

I. INTRODUCTION.....	1
II. THE LEVEL OF SKILL IN THE ART.....	3
III. PETITIONER’S ASSESSMENT OF THE LEVEL OF ORDINARY SKILL IN THE ART IS TOO HIGH.....	10
IV. DR. SHACKLE IS NOT QUALIFIED TO TESTIFY	14
V. CLAIM CONSTRUCTION.....	15
A. “Varying Colour”	15
B. “Lamp”	19
C. “Desired Colour”	19
D. “Securing Means”	19
E. “Switch Being Accessible by a User”	20
VI. THE BOARD SHOULD FIND CHALLENGED CLAIMS 24 - 30 PATENTABLE.....	21
A. GROUNDS 1 and 2 (Claims 24 – 26, 27 – 29 and 35).....	21
1. Chliwnyj and Pu Would Not Have Been Combined to Teach the Claimed Accessible Switch of Claims 27 and 35.....	21
2. Chliwnyj and Pu Would Not Have Been Combined to Teach the Claimed Selection Switches of Claim 24	29
B. GROUND 3: The Blue and Green LED of Lau is Not Combinable with the Limited Gamut of Color Comprising the Disclosed Red, Amber, or Yellow LEDs of Chliwnyj.....	31
VII. CONCLUSION	42

Table of Authorities

Cases

<i>DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.</i> , 567 F.3d 1314 (Fed. Cir. 2009)	31
<i>IDC, LLC v. Adventive, et al.</i> , 09-cv-2495 (D.N.J.)	4, 16, 20
<i>In re Cortright</i> , 165 F.3d 1353 (Fed. Cir. 1999)	15
<i>In re NTP, Inc.</i> , 654 F.3d 1279 (Fed. Cir. 2011)	15
<i>In re Suitco Surface, Inc.</i> , 603 F.3d 1255 (Fed. Cir. 2010)	15
<i>KSR Int'l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007)	3, 30
<i>Microsoft Corp. v. Proxyconn, Inc.</i> , Case No. 2015-1542 (Fed. Cir. June 16, 2015)	15
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005)	3
<i>Ryko Mfg. Co. v. Nu-Star, Inc.</i> , 950 F.2d 714 (Fed. Cir. 1991)	3
<i>Shaw Indus. Grp, Inc. v. Automated Creel Systems, Inc.</i> , IPR2013-00132, Paper No. 44 (PTAB July 24, 2014)	31

I. INTRODUCTION

On December 16, 2014, the Board instituted the 936 IPR against U.S. Pat. No. 7,429,827 (the “827 Patent”) on the following Grounds 1-3 (938 IPR, Decision (Paper 20), at 20, cited here as “Dec. [page]”), and declined to institute review of the remaining grounds. Simon Nicholas Richmond (“Patent Owner”) respectfully submits the following timely Response to the Petition filed by Petitioner upon which the Board has instituted IPR of Claims 24 – 30 (the “Challenged Claims”) of 827 Patent.

Petitioner misapplies the reference Pu (Exs. 1008, 1009) in combination with the references Chliwnyj (Ex. 1005) and Wu (Ex. 1006) as support for selection and accessible switches of Claims 24 and 27, and 35, respectfully. There is no rationale that would have made it obvious to use switches that are accessible and capable of selection of different modes in the memorial devices disclosed in Chliwnyj. To the contrary, the evidence of record shows that it would be contrary to the stated object of the invention to “provide a solar-powered simulated-flame memorial with full power management to keep the ‘eternal flame’ going as long as possible” with a switch that is accessible and capable of selection. Persons of ordinary skill would have been deterred from implementing switches placed in the manner disclosed in Pu, because the locations of switches would have failed to

yield predictable results, and, in fact, would have changed how the device of Chliwnyj in a manner that is contrary to the teachings of Chliwnyj.

Patent Owner will show the Board, through the following arguments and the additional evidence submitted, including the declaration of Patent Owner's expert Dr. Alfred Ducharme (cited as "Duchm. Dec. [paragraph no.]"), that persons of ordinary skill and creativity in the art ("POSA") could not have with a reasonable expectation of success utilized the claimed "three lamps comprising a diode that emits red light, a diode that emits blue light and a diode that emits green light" of Claim 30 in Chliwnyj. Chliwnyj teaches a flame simulation utilizing a limited color gamut composed of the combinations of red, amber, and orange colors. The Board in finding that "red, blue, and green can be used to create any color" did not consider that the lighting effect of Chliwnyj is not intended to produce "any color," but to produce a flame simulation that "uses multiple LEDs as controlled lighting elements to give the appearance of flame motion, typically when viewed through a diffuser." Chliwnyj, 5: 12 – 14. The addition of the light sources producing the colors blue and green would have departed from the limited gamut of color range disclosed in Chliwnyj, which is essential to Chliwnyj's operation.

Furthermore, Petitioner has incorrectly assessed the level of skill in the art as too high, and this has led the Board to an incorrect conclusion of obviousness. It would have been unpredictable from the perspective of person of ordinary skill in

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.