

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
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Petitioner filed a revised petition to institute an *inter partes* review (Paper 13, “Pet.”) of claims 24–35 of U.S. Patent No. 7,429,827 B2 (Ex. 1001, “the ’827 patent”). Pet. 1. Petitioner included a declaration of Dr. Peter Shackle (Ex. 1002). Patent Owner filed a Preliminary Response. Paper 19 (“Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” We have reviewed the Petition, Preliminary Response, and the evidence cited therein. For the reasons discussed below, we determine that Petitioner has demonstrated a reasonable likelihood of showing that claims 24–30 and 35 of the ’827 patent are unpatentable. We further determine that Petitioner has not demonstrated a reasonable likelihood of showing that claims 31–34 are unpatentable.

A. *Related Matters*

Petitioner states that Patent Owner has asserted a number of lawsuits against the Petitioner companies alleging infringement of the ’827 patent. Paper 18, 3–4; Paper 17, 3. Petitioner also asserts it is challenging two other patents in the same family as the ’827 patent: U.S. Patent No. 7,196,477 (IPR2014-00936) and U.S. Patent No. 8,362,700 (IPR2014-00937). Pet. 5; Paper 17, 2.

The ’700 patent is a continuation-in-part of the ’827 patent, which is a continuation-in-part of the ’477 patent.

B. *The ’827 Patent (Ex. 1001)*

The ’827 patent describes a solar powered light that produces light of varying color. Ex. 1001, 1:11–13. According to the ’827 patent, producing light

of a varying color is known, and solar powered “garden lights” are known. *Id.* at 1:17–25. 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 1:26–35.

C. Exemplary Claims

Of the claims challenged, claims 24, 27, 32, and 35 are independent. Claims 24 and 32 are reproduced below.

24. A lighting device to produce light of varying colour, said device comprising:
a lens generally enclosing a chamber;
a circuit including:
at least two lamps of different colours to produce a desired colour, the lamps being mounted to direct light into said chamber;
connections for at least one rechargeable battery to power the circuit;
a solar cell mounted on a surface so as to be exposed to light and operatively associated with the connections to charge the battery;
a light sub-circuit having an integrated circuit for controlling said lamps to produce lighting effects, and a selection switch, said selection switch being connected to said integrated circuit and operable to select a desired lighting effect; and
a volatile memory retained for a period of time and associated with said integrated circuit, said memory causing operation of said circuit to produce said lighting effects.

32. A lighting device to produce light of varying color, said device including:
a lens;
a circuit having

at least two lamps of different colors mounted to direct light through said lens,
 an activation sub-circuit to provide power to said lamps only at low light levels, and
 a light sub-circuit to independently control delivery of power to each of said lamps so as to vary intensity of light emitted over time to produce a continuous color changing cycle,
 connections for at least one rechargeable battery to power said circuit, and
 at least one solar cell mounted so as to be exposed to light and operatively associated with said connections to charge said battery; and a spike for positioning said connections above a ground surface.

D. Prior Art and Asserted Grounds

References	Basis under 35 U.S.C.	Claims Challenged
Chliwnyj ¹ , Wu ² , Pu ³ , Dowling ⁴	§ 102	24–26
Chliwnyj and Wu	§ 103	27–29 and 31–35
Chliwnyj, Wu, and Lau ⁵	§ 103	30
Richmond ⁶ and Shalvi ⁷	§ 102	27 and 35

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

⁴ U.S. Patent No. 7,064,498 B2, issued June 20, 2006, filed Mar. 13, 2001 (Ex. 1010).

⁵ U.S. Patent No. 6,431,719 B1, issued Aug. 13, 2002 (Ex. 1011).

⁶ Australian Patent App. No. AU 2002100505 A4, published Nov. 21, 2002 (Ex. 1012).

⁷ U.S. Patent No. 6,120,165, issued Sept. 19, 2000 (Ex. 1013).

II. ANALYSIS

A. *Petitioner's Prior Civil Action*

Under 35 U.S.C. § 315(a)(1), no *inter partes* review may be instituted if a petitioner filed a civil action challenging the validity of a claim of a patent before filing its petition. Patent Owner alleges that Petitioner filed a civil action challenging the validity of at least one claim of the '827 patent before the Petition was filed. Prelim. Resp. 4. That action was voluntarily dismissed under Federal Rule of Civil Procedure 41(a)(1). *Id.* at 4–5. Patent Owner maintains, however, that this dismissal is not effective to remove the jurisdictional bar of § 315(a)(1). *Id.* at 5–15.

In scenarios analogous to this one, panels of the Board have held that these earlier court filings, later dismissed without prejudice, are treated as if they had never existed, and do not bar petitions for *inter partes* review under § 315(a)(1). *See, e.g., Cyanotech Corp. v. Bd. of Trs. of the Univ. of Ill.*, Case IPR2013-00401, slip op. at 9–12 (PTAB Dec. 19, 2013) (Paper 17); *Clio USA, Inc. v. Procter & Gamble Co.*, Case IPR2013-00450, slip op. at 5–8 (PTAB Jan. 9, 2014) (Paper 14); *Butamax™ Adv. Biofuels LLC v. Gevo, Inc.*, Case IPR2013-00539, slip op. at 6–8 (PTAB Mar. 4, 2014) (Paper 9). For the same reasons, we hold that the Petitioner is not barred under § 315(a)(1) because the earlier district court case was dismissed without prejudice under Federal Rule of Civil Procedure 41(a)(1).

B. *Claim Construction*

We interpret the claims of an unexpired patent using the broadest reasonable interpretation in light of the specification of the patent. 37 C.F.R. § 42.100(b). Under the broadest reasonable interpretation standard, claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic*

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