

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 IPR2015-00580
Patent 7,429,827

**Reply to
Opposition to
Motion for Joinder with
IPR2014-00938**

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Petitioner respectfully motioned the Board to use its discretion to join IPR2015-00580 (“the ’580 IPR”) with IPR2014-00938 (“the ’938 IPR”). The patent owner’s arguments against joinder are unavailing. Specifically, in the ’938 IPR, the Board did not institute review of claims 31–34, holding that the ’938 petition did not address sufficiently the construction of “*cycle*.” ’938 IPR, paper 20 at 16–17. Petitioner then moved for rehearing, which the Board denied by deeming the arguments to be new. Thus, the patent owner is incorrect that the Board already considered the rehearing arguments, to the extent they overlap with any arguments in the ’580 petition. Opp. at 5–8 and ’938 IPR, paper 27 at 1 and 4. Ultimately, three reasons justify joinder: (1) conserving judicial resources, (2) the ’580 petition contains new arguments to address the “*cycle*” term that the Board found lacking in the ’938 IPR, and (3) joinder will have a negligible impact on the ’938 IPR schedule.

I. Joining the Petitions Is Appropriate and Will Conserve Resources

The ’580 petition applies a new ground to claims 31–34 to address the patent owner’s narrowed construction of “*cycle*,” but uses the identical scope of prior art applied to instituted claim 30. The only difference between the instituted and non-instituted claims is the use of “*continuous color changing cycle*” instead of “*varying color*,” which the patent owner admitted mean substantially the same thing. Ex. 1109 at 24. Accordingly, the petitioner requests that the Board resolve efficiently the patentability of all substantially similar claims in a joined IPR.

In addition, joinder would not materially add to the patent owner's or Board's workloads, as the two IPRs are very similar and rely on the same art. Conversely, denying joinder would be inefficient and necessarily duplicate briefing at the District Court, as the petitioner would challenge claims 31–34 there, possibly resulting in different claim constructions and inconsistent positions. *See also, Target Corp. v. Destination Maternity Corp.*, IPR2014-00508 (Paper 28, at 12 (joinder avoids parallel litigation on the same issues)). By using its discretion to join the petitions, the Board can reach a just, speedy and inexpensive resolution that consolidates briefing and discovery.

II. The '580 Petition Raises Substantially New Arguments to Address the Issue that the Board Found Lacking in the '938 Petition

The patent owner stated that joinder is inappropriate because Lau does not remedy the deficiencies of Chliwnyj. Opp. at 9. The patent owner is incorrect. The '580 petition demonstrates that both Chliwnyj and Lau use microcontrollers to drive LEDs to produce light patterns. *See e.g.*, petition at 28–30 and 42–51. To the extent that the light patterns must repeat to constitute a “*color changing cycle*,” and to the extent that Chliwnyj did not clearly teach repeating light patterns, Chliwnyj did teach that they were well known, and Chliwnyj in combination with Wu and Lau demonstrates that it was obvious to repeat a “*color changing cycle*” to produce a “visual effect [that] is both pleasing and comforting.” *Id.* Therefore, the '580 petition is not deficient as

alleged by the patent owner and, moreover, presents substantially different arguments to overcome § 325(d).

The Board did not consider the petitioner's arguments in the motion for rehearing, deeming them to be impermissible new arguments. Consequently, and contrary to the patent owner's arguments, the rehearing was not a "second bite." Opp. at 1, 4-5-8, 11, 13, 15. And, in any event, the Board permits petitioners to seek a second review of a patent. *See, e.g.*, 157 Cong. Rec. S5370-S5378, S5376 (AIA § 18 petitions (*i.e.*, CBMs) allow a "second bite"; Congress did the same with joinder in 35 U.S.C. § 315(c); *see also*, *Target II*, at 12) (permitting joinder).

The patent owner's inconsistent position regarding the meaning of "*cycle*" further supports providing petitioners a chance to respond. Although petitioners must do their best in their first petitions to consider possible patent owner arguments, it would be unjust to require, and impossible for, petitioners to anticipate all patent owner arguments, particularly where, as here, the patent owner makes an argument inconsistent with its previous position. Opp. at 8-9. The petitioner could not reasonably foresee the patent owner adopting a narrowed construction of "*cycle*," *i.e.*, requiring repetition, because (1) the specification neither expressly nor implicitly requires repetition, and (2) the patent owner never made this argument in litigation, and, in fact, offered a broader construction. This unforeseeable and inconsistent statement warrants a second petition, which the Board has discretion to grant. 157 Cong. Rec. S1360, 1376 (factors for granting joinder include, "the breadth or

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