

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.

IPR2015-00580
Patent 7,429,827 B2

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

SAINDON, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108
Denying Petitioner's Motion for Joinder
37 C.F.R. § 42.122

I. INTRODUCTION

Petitioner requests *inter partes* review of claims 31–34 of U.S. Patent No. 7,429,827 B2 (Ex. 1001, “the ’827 patent”). Paper 10, 1 (“Pet”). Accompanying the Petition is a timely Motion for Joinder under 35 U.S.C. § 315(c) to a pending *inter partes* review of the ’827 patent. Pet. 1, 5; *see also* Paper 11 (Petitioner’s Motion for Joinder (“Mot. Joinder”)); *Jiawei Tech. (HK) Ltd. v. Simon Nicholas Richmond*, Case IPR2014-00938 (PTAB Dec. 16, 2014) (Paper 20, instituting *inter partes* review of claims 24–30 and 35 of the ’827 patent but not claims 31–34). Patent Owner filed an opposition to Petitioner’s Motion for Joinder (Paper 20, “Opp. Mot. Joinder”), to which Petitioner filed a reply (Paper 21, “Reply Mot. Joinder”). Patent Owner did not file a preliminary response.

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.” Upon consideration of the above-mentioned papers, we do not institute an *inter partes* review on any challenged claim, and we deny Petitioner’s Motion for Joinder.

A. Related Matters

The ’827 patent is subject to the aforementioned *inter partes* review, IPR2014-00938. Pet. 1. We granted Petitioner’s petition for *inter partes* review in IPR2014-00936 (U.S. Patent No. 7,196,477) and we denied Petitioner’s petition for *inter partes* review in IPR2014-00937 (U.S. Patent

No. 8,362,700). Pet. 4. The '700 patent is a continuation-in-part of the '827 patent, which is a continuation-in-part of the '477 patent.

A number of cases pending before the U.S. District Court for the District of New Jersey were consolidated into *Simon Nicholas Richmond v. Jiawei Technology (HK) Ltd.*, Case No. 3:13-cv-1944 (MLC-DEA) (D.N.J.). Paper 14, 3–4.

B. Asserted Ground and Prior Art

Petitioner asserts that claims 31–34 of the '827 patent are unpatentable in view of Chliwnyj,¹ Wu,² and Lau.³ Pet. 6.⁴

II. ANALYSIS

C. The First Petition—IPR2014-00938

In IPR2014-00938, we determined that, *inter alia*, Petitioner had not shown a reasonable likelihood that claims 31–34 were unpatentable in view of Chliwnyj and Wu, but that Petitioner had shown a reasonable likelihood that claim 30, which depends from independent claim 27, is unpatentable in view of Chliwnyj, Wu, and Lau. *Jiawei Tech. (HK) Ltd.*, Case IPR2014-00938, Paper 20 at 20. We denied *inter partes* review of claims 31–34 because those claims included a limitation—“color changing cycle”—that

¹ U.S. Patent No. 5,924,784, issued July 20, 1999 (Ex. 1105).

² U.S. Patent Application Publication No. 2003/0201874 A1, published Oct. 30, 2003 (Ex. 1106).

³ U.S. Patent No. 6,431,719 B1, issued Aug. 13, 2002 (Ex. 1107).

⁴ Claim 31 depends from independent claim 27; claims 33 and 34 depend from independent claim 32.

we were unpersuaded was shown in Chliwnyj. *Id.* at 16–17. We noted that Petitioner had not provided a claim construction of that limitation. *Id.*

D. The Second Petition—IPR2015-00580

In the instant proceeding, Petitioner provides proposed constructions for the limitation “color changing cycle.” Pet. 17–21. Petitioner alleges that, in view of its proposed constructions and the additional analysis provided, it has shown a reasonable likelihood that claims 31–34 are unpatentable over Chliwnyj, Wu, and Lau. *Id.* at 21–51. Petitioner further alleges that these arguments are not substantially similar to the ones it presented in IPR2014-00938. *Id.* at 51–52.

E. Analysis

According to 35 U.S.C. § 325(d):

In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.

As explained above, the prior art presented in the instant proceeding—Chliwnyj, Wu, and Lau—also was presented in the earlier proceeding, IPR2014-00938. The only difference is that Petitioner used the specific combination of references to argue that claim 30, not claims 31–34, are unpatentable. There is no question, however, that Chliwnyj, Wu, and Lau were available to Petitioner at the time of filing the earlier Petition, and actually presented to the Office as prior art to the ’827 patent. Further, Petitioner’s arguments in the instant proceeding are substantially similar to

those it made in the earlier proceeding, relying on Lau instead of Chliwnyj for the “color changing cycle” limitation but presenting a similar analysis for all other limitations of claims 31–34. *Compare* Pet. 21–51, with *Jiawei Tech. (HK) Ltd.*, Case IPR2014-00938, Paper 13 at 31–39. Under the circumstances, we are persuaded to exercise our discretion under 35 U.S.C. § 325(d) to deny the Petition because the same prior art and substantially the same arguments were presented previously to the Office.

Further, the proposed ground directed to claims 31–34 amounts to a second bite at the apple for Petitioner—Petitioner offers now a claim construction it could have offered in IPR2014-00938. Petitioner alleges that Patent Owner admitted in district court that the claim term “varying colour,” found, for example, in independent claim 27, means substantially the same thing as “color changing cycle,” found in the claims now challenged. Pet. 17–18; *but see* Opp. Mot. Joinder 7 (denying that Patent Owner admitted such a construction). Petitioner asserts that Patent Owner in its Preliminary Response in IPR2014-00938 made statements “inconsistent” with its alleged prior position in district court and that Petitioner “could not have reasonably anticipated” this inconsistency. Mot. Joinder 6.

Petitioner’s argument is unconvincing. In general, a petitioner must propose those claim constructions necessary to support its burden of showing a reasonable likelihood of success. *See* 37 C.F.R. § 42.104(b)(3) (the petition must state “[h]ow the challenged claim is to be construed”); *see also* 35 U.S.C. § 314(a) (petitioner must show, in its petition, “a reasonable likelihood” of prevailing). Petitioner, however, did not propose a construction for “color changing cycle” in its Petition in IPR2014-00938.

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