

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

POLYGROUP LIMITED,
Petitioner,

v.

WILLIS ELECTRIC CO., LTD.,
Patent Owner.

Case IPR2016-01613
Patent 9,044,056 B2¹

Before WILLIAM V. SAINDON, JEREMY M. PLENZLER, and
BARBARA A. PARVIS, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*, for the Board,
PLENZLER, *Administrative Patent Judge*, dissenting.

FINAL WRITTEN DECISION
Finding No Claims Unpatentable
Granting Motion to Amend In Part, Dismissing as Moot In Part
Denying Patent Owner's Motion to Exclude

¹ The grounds raised in IPR2016-00803 are consolidated with IPR2016-01613.

SAINDON, *Administrative Patent Judge*, for the Board:

I. INTRODUCTION

We have jurisdiction under 35 U.S.C. § 6. The evidentiary standard is a preponderance of the evidence. *See* 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

As was explained in further detail in Paper 13, this proceeding is a consolidation of Petitioner’s challenges in two petitions of claims 1, 2, 4, 5, 11, 13, and 16–19 of U.S. Patent No. 9,011,056 B2 (Ex. 1001, “the ’056 patent”).² We instituted an *inter partes* review on all challenged claims on all challenged grounds (Paper 33, “Dec. on Inst.”). During trial, Patent Owner filed a Response (Paper 52, “PO Resp.”) and Petitioner filed a Reply (Paper 70, “Pet. Reply”). An oral hearing was held (Paper 113, “Tr.”).

Patent Owner canceled claim 1 by non-conditionally moving to amend that claim with proposed substitute claim 21. Paper 117; Paper 88 (Patent Owner’s Motion to Amend, “Mot.”). Reviewing the arguments and evidence before us, we determine that Petitioner has not established by a preponderance of the evidence that claims 2, 4, 5, 11, 13, and 16–19 of the ’056 patent are unpatentable. We grant Patent Owner’s Motion to Amend, with proposed substitute claim 21 being entered in favor of original claim 1. The remainder of Patent Owner’s motion to amend, which is contingent, is dismissed as moot.

² As used herein, “Petition I” or “Pet. I” refers to the petition originally filed in IPR2016-00802, now Paper 25. “Petition II” or “Pet. II” refers to the petition originally filed in IPR2016-01613, Paper 2.

A. Related Matters

Both parties have asserted patents and have filed petitions against the other party. The '056 patent has been asserted against Petitioner in *Willis Elec. Co. v. Polygroup Ltd.*, No. 0:15-cv-03443-WMW-KMM (D. Minn., filed Aug. 28, 2015). Paper 2, 71; Paper 4. Petitioner previously filed a petition (Pet. II) challenging certain independent claims of the '056 patent in IPR2016-00802 (Pet. II 71–72), which was granted (Pet. II 71–72; Paper 4); the challenges raised in that proceeding are a part of this proceeding, per agreement of the parties. *See* Paper 12 (requesting merger of challenges to '056 patent); Paper 13 (granting request).

Petitioner has filed other petitions challenging Patent Owner's patents containing similar subject matter and which were also asserted against Petitioner. U.S. Patent No. 8,454,186 ("the '186 patent") is challenged in IPR2016-00800, IPR2016-01609, and IPR2016-01610. Paper 4. U.S. Patent No. 8,454,187 is challenged in IPR2016-00801, IPR2016-01611, and IPR2016-01612. *Id.* U.S. Patent No. 8,936,379 is challenged in IPR2016-01615, IPR2016-01616, and IPR2016-01617. *Id.* U.S. Patent No. 9,066,617 is challenged in IPR2016-01783. *Id.* U.S. Patent No. 8,974,072 is challenged in IPR2016-01781 and IPR2016-01782. *Id.*

Petitioner has asserted patents against Patent Owner in *Polygroup Macau Ltd (BVI) v. Willis Electric Co., Ltd.*, No. 3:15-cv-00552 (W.D.N.C.). *Id.*

Patent Owner has filed petitions challenging U.S. Patent Nos. 8,863,416, 6,794,825, 9,119,495, and 8,959,810, owned by Petitioner, in IPR2017-00309, IPR2017-00330, IPR2017-00331, IPR2017-00334, and IPR2017-00335.

B. The '056 Patent

The '056 patent is directed to a modular artificial tree (e.g., a Christmas tree) with electrical connectors. Ex. 1001, (54). An electrical connection runs up the trunk of the tree to provide a source of electricity for light strings draped over the branches. *See id.* at Figs. 2, 3. Physically connecting the trunk sections during assembly of the tree also electrically connects the trunk sections. *Id.* at (57), Fig. 3.

C. Challenged Claims

Petitioner challenges claims 1, 2, 4, 5, 11, 13, and 16–19 of the '056 patent. Claim 1 is reproduced below.

A lighted artificial tree, comprising:

a first tree portion aligned along a central vertical axis, the first tree portion including:

a first trunk body having a first end, a second end,

a first electrical connector positioned in the second end of the first trunk body and including a first electrical terminal positioned in line with the central vertical axis, and a second electrical terminal; and

a second tree portion aligned with the central vertical axis, the second tree portion including:

a second trunk body including a first end and a second end, the first end configured to couple with the second end of the first trunk body of the first tree portion;

a second electrical connector positioned in the first end of the second trunk body and including a first electrical terminal and a second electrical terminal, the second electrical terminal defining a ring shape that encircles the first electrical

terminal, the second electrical connector configured to couple with the first electrical connector of the first trunk body;

a light string electrically connected to the first and the second electrical terminals of the second electrical connector,

wherein upon the first tree portion being coupled to the second tree portion along the central vertical axis, the first electrical connector is coupled to the second electrical connector, such that the first electrical terminal of the first electrical connector is electrically connected to the first electrical terminal of the second electrical connector, and the second electrical terminal of the first electrical connector is electrically connected to the second electrical terminal of the second electrical connector.

D. Prior Art and Asserted Grounds

Petitioner asserts that claims 1, 2, 4, 5, 11, 13, and 16–19 of the '056 patent are unpatentable under 35 U.S.C. § 103 on the following grounds:

References	Claim(s) Challenged	Petition ³
Miller, ⁴ Otto, ⁵ and Jumo ⁶	1	I
Hicks, ⁷ Otto, and McLeish ⁸	1 and 5	I

³ See *supra* n.2 for cross references to petition number and paper number.

⁴ U.S. Patent No. 4,020,201, issued Apr. 26, 1977 (Ex. 1006).

⁵ German Utility Model Patent G 84 36 328.2, published Apr. 4, 1985 (translated copy) (Ex. 1008).

⁶ French Patent No. 1,215,214, issued Nov. 16, 1959 (translated copy) (Ex. 1009). The inventor is not listed on the face of the patent and instead lists Société Nouvelle des Établissements Jumo.

⁷ U.S. Pat. App. Pub. No. US 2007/0230174 A1, published Oct. 4, 2007, (Ex. 1007).

⁸ U.S. Patent No. 7,066,739 B2, issued June 27, 2006 (Ex. 1010).

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.