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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LEEDARSON LIGHTING CO., LTD. and
LEEDARSON AMERICA, INC.,
Petitioner,

v.

LIGHTING SCIENCE GROUP CORP.,
Patent Owner.

Case IPR2018-00271
Patent 8,967,844 B2

Before KEVIN F. TURNER, PATRICK M. BOUCHER, and JOHN A. HUDALLA, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review and
Granting Petitioner's Motion for Joinder
35 U.S.C. § 314(a) and 37 C.F.R. §§ 42.108, 42.122

Leedarson Lighting Co., Ltd., and Leedarson America, Inc. (collectively, "Petitioner") filed a Petition (Paper 1, "Pet.") requesting an *inter partes* review of claims 1–5, 7–9, 11, 12, 14, 16, 17, 19, and 21–24 of U.S. Patent No. 8,967,844 B2 (Ex. 1001, "the '844 patent"). Petitioner also filed a Motion for Joinder ("Joinder Mot.") requesting that we join

Leedarson Lighting Co., Ltd., and Leedarson America, Inc. as parties with Technical Consumer Products, Inc., Nicor Inc., and Amax Lighting in *Tech. Consumer Prods., Inc. v. Lighting Science Group Corp.*, Case IPR2017-01280 ("the '1280 IPR").[1] Paper 3.

In the '1280 IPR, we instituted an *inter partes* review as to claims 1–5, 7–9, 11, 12, 14, 16, 17, 19, and 21–24 of the '844 patent on five grounds of unpatentability. '1280 IPR, Paper 10. According to Petitioner, the Petition filed in this proceeding is "substantively identical" to the petition from the '1280 IPR and asserts identical arguments and grounds of unpatentability against the same patent claims. Joinder Mot. 1–3. Petitioner also represents that, if it is allowed to join the '1280 IPR, it would agree to consolidated filing with Technical Consumer Products, Inc., Nicor Inc., and Amax Lighting "to minimize burden and schedule impact." *Id.* at 2. Petitioner does not indicate whether Technical Consumer Products, Inc., Nicor Inc., and Amax Lighting oppose Petitioner's Motion for Joinder.

Patent Owner, Lightning Science Group Corp. ("Patent Owner"), filed neither a preliminary response nor a response to Petitioner's Motion for Joinder.

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a). Under 35 U.S.C. § 314(a), we may not authorize an *inter partes* review unless the information in the petition and any preliminary response "shows that there is a

[1] In IPR2018-00261, Jiawei Technology (HK) Ltd., Jiawei Technology (USA) Ltd., and Shenzhen Jiawei Photovoltaic Lighting Co., Ltd. also filed a motion for joinder related to the '1280 IPR. We grant that motion concurrent with this Decision, as discussed below. *See infra* § II.

reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." For the reasons that follow, we institute an *inter partes* review as to claims 1–5, 7–9, 11, 12, 14, 16, 17, 19, and 21–24 of the '844 patent on the same grounds instituted in the '1280 IPR. We also *grant* Petitioner's Motion for Joinder.

I. INSTITUTION OF INTER PARTES REVIEW

In the '1280 IPR, we instituted an *inter partes* review as to claims 1–5, 7–9, 11, 12, 14, 16, 17, 19, and 21–24 of the '844 patent on the following grounds of unpatentability: (1) claims 1–3, 5, 7, 8, 9, 11, 12, 14, 16, and 21–24 as obvious under 35 U.S.C. § 103(a) over Chou[2] and Wegner;[3] (2) claim 8 as obvious under 35 U.S.C. § 103(a) over Chou, Zhang,[4] and Wegner; (3) claims 1, 2, 8, 9, 16, 21, and 22 as obvious under 35 U.S.C. § 103(a) over Zhang; (4) claims 3 and 4 as obvious under 35 U.S.C. § 103(a) over Zhang, Soderman,[5] and Silescent;[6] and (5) claims 11, 17, and 19 as obvious under 35 U.S.C. § 103(a) over Zhang and Wegner. '1280 IPR, Paper 10, 26. As mentioned above, the Petition filed in this proceeding is

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[2] U.S. Patent No. 7,670,021 B2 to Chou, filed May 20, 2008, issued Mar. 2, 2010 (Ex. 1012, "Chou").

[3] U.S. Patent No. 7,993,034 B2 to Wegner, filed Sept. 22, 2008, issued Aug. 9, 2011 (Ex. 1016, "Wegner").

[4] U.S. Patent No. 7,722,227 B2 to Zhang et al., filed Oct. 10, 2008, issued May 25, 2010 (Ex. 1015, "Zhang").

[5] U.S. Patent No. 7,980,736 B2 to Soderman et al., filed Nov. 13, 2007, issued July 19, 2011 (Ex. 1013, "Soderman").

[6] Silescent Lighting Corporation, S100 LP2 Product Sheet and Installation Guide (Ex. 1014, "Silescent").

essentially the same as the Petition filed in the '1280 IPR, and Petitioner limited the asserted grounds in this proceeding to only those grounds originally instituted in the '1280 IPR. Joinder Mot. 1–3, 6–7; *compare* Pet. 3–58, *with* '1280 IPR, Paper 1, 3–58.

Given that we are granting Petitioner's Motion for Joinder below and the Petition is essentially the same as and only pertains to the instituted grounds in the '1280 IPR, we conclude that the information presented in the Petition establishes that there is a reasonable likelihood that Petitioner would prevail on its assertion that (1) claims 1–3, 5, 7, 8, 9, 11, 12, 14, 16, and 21–24 would have been obvious over Chou and Wegner; (2) claim 8 would have been obvious over Chou, Zhang, and Wegner; (3) claims 1, 2, 8, 9, 16, 21, and 22 would have been obvious over Zhang; (4) claims 3 and 4 would have been obvious over Zhang, Soderman, and Silescent; and (5) claims 11, 17, and 19 would have been obvious over Zhang and Wegner. Pursuant to § 314, we institute an *inter partes* review as to these claims of the '844 patent on the same grounds instituted in the '1280 IPR for the reasons stated in our Institution Decision from the '1280 IPR. *See* '1280 IPR, Paper 10.

II. GRANTING PETITIONER'S MOTION FOR JOINDER

The AIA created administrative trial proceedings, including *inter partes* review, as an efficient, streamlined, and cost-effective alternative to district court litigation. 35 U.S.C. § 315(c) provides (emphasis added):

> JOINDER.—If the Director institutes an inter partes review, *the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311* that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing

> such a response, determines warrants the institution of an inter partes review under section 314.

"Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested." 37 C.F.R. § 42.122(b). Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. The Board determines whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations. *See Sony Corp. of Am. v. Network-1 Security Solutions, Inc.*, Case IPR2013-00495, slip op. at 3 (PTAB Sept. 16, 2013) (Paper 13) ("*Sony*"). When exercising its discretion, the Board is mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b).

As the moving party, Petitioner has the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b). A motion for joinder should (1) set forth the reasons why joinder is appropriate; (2) identify any new ground(s) of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *See Sony* at 3. Petitioner should address specifically how briefing and/or discovery may be simplified to minimize schedule impact. *See Kyocera Corp. v. SoftView LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15) (representative).

Petitioner's Motion is timely because it was filed on December 1, 2017, which is within one month of our November 1, 2017, institution of the '1280 IPR. *See* 37 C.F.R. § 42.122 ("Any request for joinder must be filed,

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