

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TECHNICAL CONSUMER PRODUCTS, INC.,
NICOR INC., and AMAX LIGHTING,
Petitioner,

v.

LIGHTING SCIENCE GROUP CORP.,
Patent Owner.

Case IPR2017-01280
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
35 U.S.C. § 314(a) and 37 C.F.R. § 42.108

Technical Consumer Products, Inc., Nicor Inc., and Amax Lighting (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”) pursuant to 35 U.S.C. §§ 311–319. Petitioner proffered a Declaration of Dr. Zane

Coleman (Ex. 1002) with its Petition. Patent Owner, Lighting Science Group Corp. (“LSG”), did not file a Preliminary Response to the Petition.

Under 35 U.S.C. § 314(a), the Director may not authorize an *inter partes* review unless the information in the Petition and Preliminary Response “shows that there is a 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 1–5, 7–9, 11, 12, 14, 16, 17, 19, and 21–24 of the ’844 patent on all grounds of unpatentability presented.

I. BACKGROUND

A. *Related Proceedings*

The parties identify the following proceedings related to the ’844 patent (Pet. 1–2; Paper 6, 1–3):

Lighting Sci. Grp. Corp. v. Sea Gull Lighting Prods. LLC, Case No. 6:16-cv-00338 (M.D. Fla. filed Feb. 25, 2016);

Lighting Sci. Grp. Corp. v. U.S.A. Light & Elec., Inc., Case No. 6:16-cv-00344 (M.D. Fla. filed Feb. 26, 2016);

Lighting Sci. Grp. Corp. v. Hyperikon, Inc., Case No. 6:16-cv-00343 (M.D. Fla. filed Feb. 26, 2016);

Lighting Sci. Grp. Corp. v. Nicor Inc., Case No. 6:16-cv-00413 (M.D. Fla. filed Mar. 10, 2016);

Lighting Sci. Grp. Corp. v. Sunco Lighting, Inc., Case No. 6:16-cv-00677 (M.D. Fla. filed Apr. 21, 2016);

Lighting Sci. Grp. Corp. v. Panor Corp., Case No. 6:16-cv-00678 (M.D. Fla. filed Apr. 21, 2016);

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Lighting Sci. Grp. Corp. v. S E L S, Inc., Case No. 6:16-cv-00679
(M.D. Fla. filed Apr. 21, 2016);

Lighting Sci. Grp. Corp. v. EEL Co., Ltd., Case No. 6:16-cv-00680
(M.D. Fla. filed Apr. 21, 2016);

Lighting Sci. Grp. Corp. v. Globalux Lighting LLC, Case No. 6:16-cv-00681 (M.D. Fla. filed Apr. 21, 2016);

Lighting Sci. Grp. Corp. v. Hubbell Inc., Case No. 6:16-cv-01084
(M.D. Fla. filed June 22, 2016);

Lighting Sci. Grp. Corp. v. American De Rosa Lamparts, LLC, Case No. 6:16-cv-01087 (M.D. Fla. filed June 21, 2016);

Lighting Sci. Grp. Corp. v. Titch Indus., Inc., Case No. 6:16-cv-1228
(M.D. Fla. filed July 7, 2016);

Lighting Sci. Grp. Corp. v. Tech. Consumer Prods., Inc., Case No. 6:16-cv-01255 (M.D. Fla. filed July 13, 2016);

Lighting Sci. Grp. Corp. v. Satco Prods., Inc., Case No. 6:16-01256
(M.D. Fla. filed July 13, 2016);

Lighting Sci. Grp. Corp. v. Amax Lighting., Case No. 6:16-cv-01321
(M.D. Fla. filed July 22, 2016); and

Lighting Sci. Grp. Corp. v. Shenzhen Jiawei Photovoltaic Lighting,
Case No. 5:16-cv-03886 (N.D. Cal. filed July 11, 2016).

Petitioner also filed another petition for *inter partes* review of U.S. Patent No. 8,201,968 B2 (“the ’968 patent”), which also is owned by LSG, in co-pending Case IPR2017-01287. *See* Pet. 1. Petitioner additionally filed a petition for *inter partes* review of U.S. Patent No 8,672,518 B2 (“the ’518 patent”), which also is owned by LSG, in co-pending Case IPR2017-01285. *See id.* The provisional and non-provisional applications from

which the '968 patent and '518 patent issued are in the priority chain of the '844 patent. *See* Ex. 1001, at [60], [63], Cert. of Correction.

Generation Brands LLC previously filed petitions for *inter partes* review of the '844 patent and the '968 patent in IPR2016-01546 and IPR2016-01478, respectively. Pet. 1. After our decisions to institute *inter partes* review in these cases, both cases were settled and terminated. *See id.*; Paper 6, 1. Petitioner asserts its Petition in the instant case is substantially similar to the Petition filed by Generation Brands LLC in IPR2016-01546. *See* Pet. 1.

B. The '844 patent

The '844 patent relates to “low profile downlighting for retrofit applications.” Ex. 1001, 1:17–19. Figures 5 and 12 of the '844 patent are reproduced below.

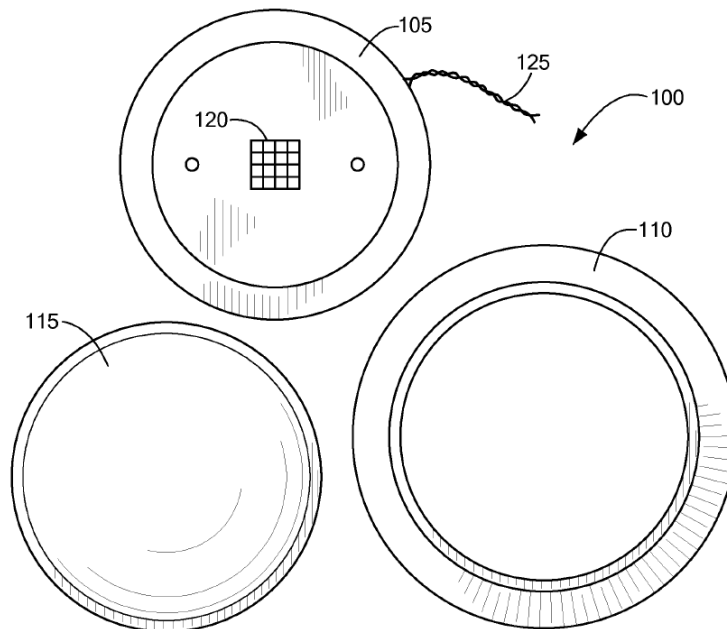


FIG. 5

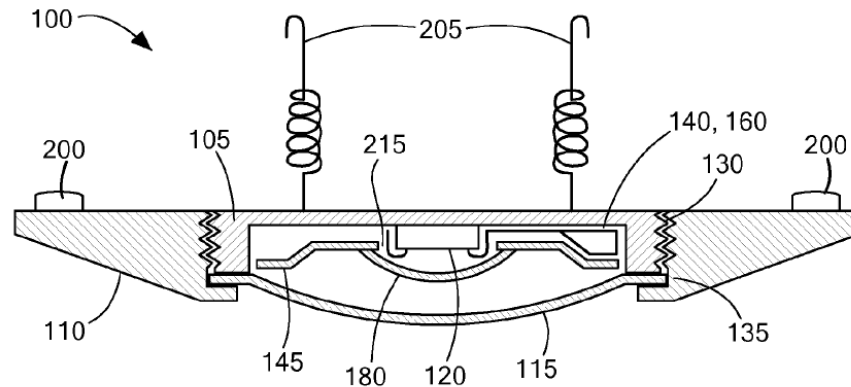


FIG. 12

Figure 5 depicts the separated components of luminaire 100, whereas Figure 12 depicts a section view of assembled luminaire 100. *Id.* at 3:63–65, 4:14–15. Luminaire 100 includes heat spreader 105, heat sink 110, and outer optic 115, light source 120, and electrical supply line 125. *Id.* at 5:37–44. Light source 120, which may be a plurality of LEDs, is disposed in thermal communication with heat spreader 105. *Id.* at 5:37–44, 6:11–14. Heat sink 110 is thermally coupled to and disposed diametrically outboard of heat spreader 105. *Id.* at 5:37–44. In addition, outer optic 115 is securely retained relative to at least one of heat spreader 105 and heat sink 110. *Id.* The combination of heat spreader 105, heat sink 110, and outer optic 115 has an overall height H and an overall outside dimension/diameter D such that the ratio of H/D is less than or equal to 0.25 (e.g., when $H=1.5$ inches and $D=7$ inches). *Id.* at 5:44–50.

Luminaire 100 may also include a power conditioner. *Id.* at 6:36–38. The power conditioner may be a circuit board having electronic components for receiving alternating current (AC) voltage from supply line 125 and delivering direct current (DC) voltage to the LEDs. *Id.* at 6:38–46. In one embodiment, the electronics of the power conditioner are contained within a

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