

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SATCO PRODUCTS, INC.,
Petitioner,

v.

LIGHTING SCIENCE GROUP CORP.,
Patent Owner.

Case IPR2017-01639
Patent 8,967,844 B2

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

HUDALLA, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
Inter Partes Review
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

Petitioner, Satco Products, Inc. (“Petitioner”), filed a Petition (Paper 11¹, “Pet.”) requesting an *inter partes* review of claims 1–3, 5, 7, 9–12, 14–17, and 19–24 of U.S. Patent No. 8,967,844 B2 (Ex. 1001, “the

¹ Petitioner filed the Petition multiple times in response to certain defects identified in the Notice of Filing Date Accorded to the Petition. *See* Paper 5. We refer to the version of the Petition at Paper 11.

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'844 patent") pursuant to 35 U.S.C. §§ 311–319. Patent Owner, Lighting Science Group Corp. ("Patent Owner"), filed a Preliminary Response (Paper 12, "Prelim. Resp.") to the Petition. Taking into account the arguments presented in the Patent Owner's Preliminary Response, we determined that the information presented in the Petition established that there was a reasonable likelihood that Petitioner would prevail in challenging claims 1–3, 5, 7, 9–12, 14–17, and 19–24 of the '844 patent on certain grounds of unpatentability presented. Pursuant to 35 U.S.C. § 314, we instituted this proceeding on January 12, 2018, as to claims 1–3, 5, 7, 9–12, 14–17, and 19–24 of the '844 patent. Paper 13 ("Institution Decision" or "Dec. on Inst.").

During the course of trial, Patent Owner filed a Patent Owner Response (Paper 17, "PO Resp."). Then, in light of the U.S. Supreme Court's decision in *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018), we modified the Institution Decision to institute on all of the grounds presented in the Petition. Paper 18 ("SAS Order"). The parties did not seek any modifications to the schedule or additional briefing in response to the SAS Order. Petitioner subsequently filed a Reply to the Patent Owner Response (Paper 19, "Pet. Reply").

Petitioner filed Declarations of Victor Roberts, Ph.D., with its Petition (Ex. 1002) and its Reply (Ex. 1018). Patent Owner filed a Declaration of Eric Bretschneider, Ph.D. (Ex. 2001) with its Response.

We have jurisdiction under 35 U.S.C. § 6. This decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of claims 1–3, 5, 7, 9–12, 14–17, and 19–24 of the '844 patent. For the reasons discussed below, Petitioner has demonstrated by a preponderance of the

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evidence that claims 1–3, 5, 7, 9, 10, 12, 14, 16, 17, and 20–24 of the '844 patent are unpatentable.

I. BACKGROUND

A. *Related Proceedings*

The parties identify the following proceedings related to the '844 patent (Pet. 1; Paper 3, 1–3; Paper 23, 1–3):

Lighting Sci. Grp. Corp. v. Cree, Inc., Case No. 6:13-cv-00587 (M.D. Fla. filed Apr. 10, 2013);

Lighting Sci. Grp. Corp. v. Cooper Lighting, LLC, Case No. 6:14-cv-00195 (M.D. Fla. filed Feb. 6, 2014);

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);

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

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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. Wangs Alliance Corp., Case No. 6:16-cv-01320 (M.D. Fla. filed July 22, 2016);

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

Lighting Sci. Grp. Corp. v. Halco Lighting Techs., LLC, Case No. 6:16-cv-02188 (M.D. Fla. filed Dec. 21, 2016);

Lighting Sci. Grp. Corp. v. Leedarson Lighting Co., Case No. 6:17-cv-00826 (M.D. Fla. filed May 9, 2017); 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 Patent

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Owner, in co-pending IPR2017-01638. *See* Paper 3, 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 Patent Owner, in co-pending IPR2017-01643. *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, [60], [63], Cert. of Correction.

Technical Consumer Products, Inc., Nicor Inc., and Amax Lighting (collectively, “TCP”) previously filed another petition for *inter partes* review of the ’844 patent in Case IPR2017-01280.² *See* Paper 3, 1. In that case, we issued a Final Written Decision holding claims 1–3, 5, 7–9, 11, 12, 14, 16, 17, 19, and 21–24 of the ’844 patent to be unpatentable. *See* IPR2017-01280, Paper 32. TCP also filed petitions for *inter partes* review of the ’968 patent and the ’518 patent in IPR2017-01287 and IPR2017-01285, respectively (*see* Paper 3, 1), and we have issued Final Written Decisions in those cases, as well. *See* IPR2017-01285, Paper 34; IPR2017-01287, Paper 31.

Generation Brands LLC previously filed petitions for *inter partes* review of the ’844 patent and the ’968 patent in IPR2016-01546 and IPR2016-01458, respectively. *See id.* After our decisions to institute *inter partes* review in these cases, both cases were settled and terminated. *See id.*

² IPR2018-00261 and IPR2018-00271 were ultimately joined with IPR2017-01280, and Jiawei Technology (HK) Ltd., Jiawei Technology (USA) Ltd., Shenzhen Jiawei Photovoltaic Lighting Co., Ltd., Leedarson Lighting Co., Ltd., and Leedarson America, Inc. were joined as Petitioner entities in a limited capacity. *See* IPR2018-00261, Paper 7; IPR2018-00271, Paper 7.

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