

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*.

DECISION

Institution of *Inter Partes* Review
35 U.S.C. § 314(a) and 37 C.F.R. § 42.108

Petitioner, Satco Products, Inc. (“Petitioner”), filed a Petition
(Paper 11¹, “Pet.”) requesting an *inter partes* review of claims 1–3, 5, 7, 9–

¹ Petitioner filed the Petition multiple times in response to certain defects being identified in the Notice of Filing Date Accorded to the Petition. *See* Paper 5. For purposes of this Decision, we refer to the version of the Petition at Paper 11. In addition, Petitioner filed a motion asking us to

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12, 14–17, and 19–24 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 Victor Roberts, Ph.D. (Ex. 1002) with its Petition. Patent Owner, Lighting Science Group Corp. (“Patent Owner”), filed a Preliminary Response (Paper 12, “Prelim. Resp.”) to the Petition.

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 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 1–3, 5, 7, 9–12, 14–17, and 19–24 of the ’844 patent on certain grounds of unpatentability presented.

I. BACKGROUND

A. *Related Proceedings*

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

excuse its late response to the identified defects. *See* Papers 6, 10. Petitioner’s motion is *granted*.

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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);

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);

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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 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, at [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. *See* Paper 3, 1. TCP also filed petitions for *inter partes* review of the ’968 patent and the ’518 patent in IPR2017-01287 and IPR2017-01285, respectively. *See id.* We instituted *inter partes* review in all three of these cases, and each case is pending.

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.*

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.

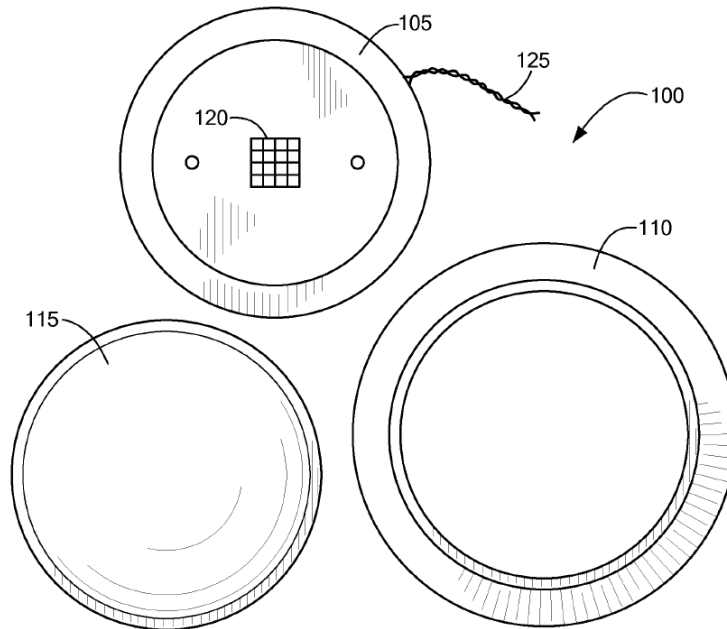


FIG. 5

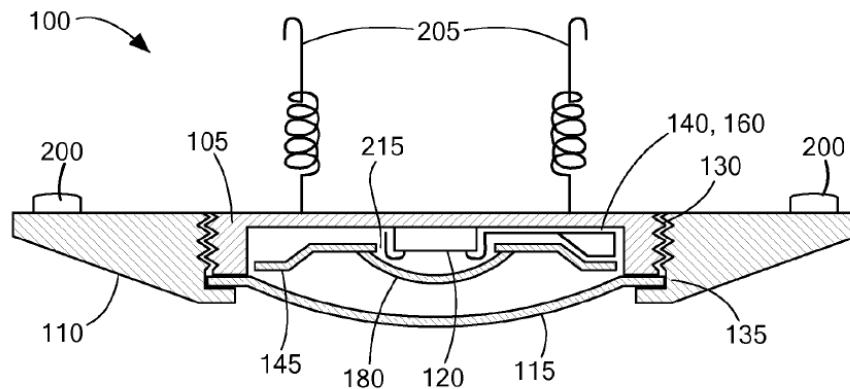


FIG. 12

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

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