

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TCL CORPORATION; TCL MULTIMEDIA TECHNOLOGY
HOLDINGS, LTD.; and TTE TECHNOLOGY, INC.;
Petitioner,

v.

LEXINGTON LUMINANCE LLC,
Patent Owner.

Case IPR2017-01780
Patent 6,936,851 B2

Before JUSTIN T. ARBES, STACEY G. WHITE, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

TCL Corporation, TCL Multimedia Technology Holdings, Ltd., and TTE Technology, Inc. (collectively, “Petitioner”) filed a Petition (Paper 2, “Pet.”) to institute an *inter partes* review of claims 1–3 and 15–18 of U.S. Patent No. 6,936,851 B2 (Ex. 1001, “the ’851 patent”) pursuant to 35 U.S.C. §§ 311–19. Lexington Luminance LLC (“Patent Owner”) filed a Patent Owner Preliminary Response. Paper 7 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). *Inter partes* review may be instituted if “the information presented in the petition filed under section 311 and any response filed under section 313 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.” 35 U.S.C. § 314(a).

Upon consideration of the Petition, Patent Owner’s Preliminary Response, and the associated evidence, we conclude that the Petition relies on the same prior art that was presented previously to the Office and exercise our discretion under 35 U.S.C. § 325(d) to deny institution of an *inter partes* review.

A. *Related Proceedings*

The parties indicate that the ’851 patent is being asserted in the following action: *Lexington Luminance LLC v. TCL Multimedia Tech. Holdings, Ltd.*, No. 1-16-cv-11458 (D. Mass). Pet. 43; Paper 6, 2.

Petitioner and Patent Owner also identify various district court proceedings that are no longer pending in which the ’851 patent was asserted: (1) *Lexington Luminance LLC v. Feit Electric Co., Inc.*, No. 1:12-cv-11554 (D. Mass.); (2) *Lexington Luminance LLC v. Osram Sylvania, Inc.*,

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No. 1:12-cv-11551 (D. Mass.); (3) *Lexington Luminance LLC v. Lighting Sci. Group Corp.*, No. 1:12-cv-11552 (D. Mass.); (4) *Lexington Luminance LLC v. Amazon.com Inc.*, No. 1:12-cv-12216 (D. Mass.); (5) *Lexington Luminance LLC v. Google, Inc.*, No. 1:12-cv-12218 (D. Mass.); (6) *Lexington Luminance LLC v. Samsung Elecs. Co., Ltd.*, No. 1-16-cv-11138, (D. Mass.); and (7) *Lexington Luminance LLC v. LG Elecs., Inc.*, No. 1:12-cv-12175, (D. Mass.). Paper 6, 2–3.

Patent Owner also identifies a decision by the United States Court of Appeals for the Federal Circuit—*Lexington Luminance LLC v. Amazon.com Inc.*, 601 F. App’x 963 (Fed. Cir. 2015)—and *ex parte* Reexamination Control No. 90/012,964, both of which involved the ’851 patent. *Id.* at 3.

The ’851 patent also has been the subject of three petitions for *inter partes* review, all of which have been denied. *See LG Innotek Co. v. Lexington Luminance LLC*, Case IPR2017-00052 (PTAB Mar. 30, 2017) (“IPR2017-00052”) (Paper 7) (Decision Denying Institution of *Inter Partes* Review); *Samsung Elecs. Co., Ltd. v. Lexington Luminance LLC*, Case IPR2017-00539 (PTAB June 20, 2017) (“IPR2017-00539”) (Paper 8) (Decision Denying Institution of *Inter Partes* Review); *Samsung Elecs. Co., Ltd. v. Lexington Luminance LLC*, Case IPR2017-00540 (PTAB June 20, 2017) (“IPR2017-00540”) (Paper 8) (Decision Denying Institution of *Inter Partes* Review); *see also* Pet. 2 n.1; Paper 6, 2.

B. Asserted Ground of Unpatentability

Petitioner asserts the following ground of unpatentability:

Reference	Basis ¹	Challenged Claims
Niki ²	§ 103(a)	1–3 and 15–18

Pet. 4–5.

II. ANALYSIS

A. Prior Challenges to Related Patents

As noted above, two other petitioners previously filed petitions seeking *inter partes* review of the claims of the '851 patent. Two of those petitions, IPR2017-00052 and IPR2017-00539 (collectively, “the Niki Petitions”), *inter alia*, challenged claims 1–3 and 15–18 of the '851 patent as being unpatentable as obvious based on Niki. *See* IPR2017-00052, Paper 2, 3 (Petition); IPR2017-00539, Paper 2, 3 (Petition). The third petition, IPR2017-00540 challenged the claims of the '851 patent based on different prior art. IPR2017-00540, Paper 2, 3 (Petition).

B. The Parties' Contentions

Petitioner challenges claims 1–3 and 15–18 of the '851 patent as being unpatentable as obvious over Niki. Pet. 4–5. Petitioner argues although Niki “has been previously included within IPR petitions filed by other petitioners, the present Petition presents Niki in a new and different

¹ The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. § 100 *et seq.* effective on March 16, 2013. Because the '851 patent issued from an application filed before March 16, 2013, we apply the pre-AIA versions of the statutory bases for unpatentability.

² U.S. Patent No. 6,870,191 B2 (filed July 24, 2002, issued Mar. 22, 2005) (Ex. 1008, “Niki”).

light, and it includes additional arguments not presented in the previous proceedings.” *Id.* at 2–3 (footnote omitted). More specifically, Petitioner asserts “the Petition and supporting evidence focus on the limited written description provided by the ’851 patent for the whereby clause claim element,^[3] and corresponding and comprehensive disclosure within Niki.” *Id.* at 3. Petitioner avers “[t]his argument was not presented in the prior IPR challenges to the ’851 patent.” *Id.* at 4.

Petitioner further argues “it is unjust for [the] prior and independent petitions to be used to deprive this petitioner of its opportunity to be heard (and thus, defend itself from [Patent Owner’s] aggression) on its novel application of the Niki prior art.” *Id.* at 3.

Patent Owner argues that the Board should deny institution under 35 U.S.C. § 325(d) because the same art was previously considered and rejected by the Board in the Niki Petitions. Prelim Resp. 5–7. Patent Owner further argues “Niki was before the Examiner during a recent reexamination proceeding filed by a third party” which provides an “independent basis on which the Board should exercise its discretion to deny the Petition.” *Id.* at 6–7 (citing Ex. 2002, 176).^{4,5}

³ Independent claims 1, 3, and 15 recite “whereby said plurality of inclined lower portions are configured to guide extended lattice defects away from propagating into the active layer.”

⁴ The Preliminary Response contains a typographical error and cites Exhibit 2003. We have corrected that typographical error above.

⁵ The cited page is an Information Disclosure Statement (IDS) citing Niki. Ex. 2002, 176. Because, for the reasons discussed *infra*, we exercise our discretion under 35 U.S.C. § 325(d) based on the Board’s prior consideration of Niki in the earlier proceedings, we need not address whether, or under what circumstances, merely citing a reference in an Information Disclosure

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