Trials@uspto.gov
Tel: 571-272-7822

Paper No. 7
Entered: May 14, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JIAWEI TECHNOLOGY (HK) LTD.,
JIAWEI TECHNOLOGY (USA) LTD., and
SHENZHEN JIAWEI PV LIGHTING CO., LTD.,
Petitioner,

v.

LIGHTING SCIENCE GROUP CORP.,
Patent Owner.

Case IPR2018-00261
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

Jiawei Technology (HK) Ltd., Jiawei Technology (USA) Ltd., and Shenzhen Jiawei Photovoltaic Lighting Co., Ltd. (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 Jiawei Technology (HK) Ltd., Jiawei Technology (USA) Ltd., and Shenzhen Jiawei Photovoltaic Lighting Co., Ltd. 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"). 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. 2–5. Petitioner also represents that, if it is allowed to join the '1280 IPR, it will assume a passive or "understudy" so long as Technical Consumer Products, Inc., Nicor Inc., and Amax Lighting remain active parties in the '1280 IPR. *Id.* at 6–7. Petitioner indicates that Technical Consumer Products, Inc., Nicor Inc., and Amax Lighting will not oppose Petitioner's Motion for Joinder. *Id.* at 7.

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 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[1] and Wegner;[2] (2) claim 8 as obvious under 35 U.S.C. § 103(a) over Chou, Zhang,[3] 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,[4] and Silescent;[5] 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 essentially the same as the Petition filed in the '1280 IPR, and Petitioner

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

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

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

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

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

limited the asserted grounds in this proceeding to only those grounds originally instituted in the '1280 IPR. Joinder Mot. 2–5; *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 November 30, 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,

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.