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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TECHNICAL CONSUMER PRODUCTS, INC., NICOR INC., AMAX LIGHTING, JIAWEI TECHNOLOGY (HK) LTD., JIAWEI TECHNOLOGY (USA) LTD., SHENZHEN JIAWEI PV LIGHTING CO., LTD., LEEDARSON LIGHTING CO., LTD., and LEEDARSON AMERICA, INC.,
Petitioner,

v.

LIGHTING SCIENCE GROUP CORP.,
Patent Owner.

Case IPR2017-01280[1]
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

[1] IPR2018-00261 and IPR2018-00271 are joined with IPR2017-01280. All citations to the record are made with reference to IPR2018-01280 unless otherwise specified.

Technical Consumer Products, Inc., Nicor Inc., and Amax Lighting (collectively, "Lead 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. Patent Owner, Lighting Science Group Corp. ("Patent Owner"), did not file a Preliminary Response to the Petition. We determined that the information presented in the Petition established that there was a reasonable likelihood that Lead Petitioner would prevail in challenging claims 1–5, 7–9, 11, 12, 14, 16, 17, 19, and 21–24 of the '844 patent under 35 U.S.C. § 103(a). Pursuant to 35 U.S.C. § 314, we instituted this proceeding on November 1, 2017, as to claims 1–5, 7–9, 11, 12, 14, 16, 17, 19, and 21–24 of the '844 patent. Paper 10 ("Dec. on Inst.").

Jiawei Technology (HK) Ltd., Jiawei Technology (USA) Ltd., and Shenzhen Jiawei Photovoltaic Lighting Co., Ltd. (collectively, "Jiawei") filed a similar petition and motion for joinder in Case IPR2018-00261. *See* IPR2018-00261, Papers 1, 3. We instituted an *inter partes* review and joined Jiawei as parties to this case in a limited capacity. *See* IPR2018-00261, Paper 7. Leedarson Lighting Co., Ltd., and Leedarson America, Inc. (collectively, "Leedarson") also filed a similar petition and motion for joinder in Case IPR2018-00271. *See* IPR2018-00271, Papers 1, 3. We instituted an *inter partes* review and joined Leedarson as parties to this case in a limited capacity. *See* IPR2018-00271, Paper 7. Henceforth, we refer collectively to Lead Petitioner, Jiawei, and Leedarson as "Petitioner."

During the course of trial, Patent Owner filed a Patent Owner Response (Paper 17, "PO Resp."), and Petitioner filed a Reply to the Patent

Owner Response (Paper 21, "Pet. Reply"). An oral hearing was held on September 6, 2018, and a transcript of the hearing is included in the record. Paper 31 ("Tr.").

Petitioner filed Declarations of Dr. Zane Coleman (Ex. 1002) and Daryl Soderman (Ex. 1003) with its Petition. Patent Owner filed a Declaration of Eric Bretschneider, Ph.D. (Ex. 2001) with its Patent Owner Response. The parties also filed transcripts of the depositions of Dr. Coleman (Ex. 2002), Mr. Soderman (Ex. 2004), and Dr. Bretschneider (Ex. 1023).

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 1–5, 7–9, 11, 12, 14, 16, 17, 19, and 21–24 of the '844 patent. For the reasons discussed below, Petitioner has demonstrated by a preponderance of the evidence that claims 1–3, 5, 7–9, 11, 12, 14, 16, 17, 19, and 21–24 of the '844 patent are unpatentable. Petitioner has not demonstrated by a preponderance of the evidence that claim 4 of the '844 patent is unpatentable.

I. BACKGROUND

A. Related Proceedings

The parties identify the following proceedings related to the '844 patent (Pet. 1–2; Paper 6, 1–3; Paper 25, 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);

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-cv-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);

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

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

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

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 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 Patent Owner, in co-pending Case IPR2017-01285. *See id.* We instituted *inter partes* reviews in these cases. 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.

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. Lead Petitioner asserts its Petition in the instant case is

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.