

Date: August 5, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EVERSTAR MERCHANDISE CO. LTD.,
Petitioner

v.

WILLIS ELECTRIC CO., LTD.,
Patent Owner

Case PGR2019-00055
Patent 10,119,664

**PETITION FOR POST-GRANT REVIEW OF U.S. PATENT NO. 10,119,664
UNDER 35 U.S.C. §§ 321-329 AND 37 C.F.R. § 42.200 ET SEQ.**

TABLE OF CONTENTS

I. INTRODUCTION1

II. MANDATORY NOTICES2

 A. Real Parties-In-Interest Under 37 C.F.R. §42.8(b)(1)2

 B. Related Matters Under 37 C.F.R. §42.8(b)(2)2

 C. Lead and Backup Counsel Under 37 C.F.R. §42.8(b)(3).....2

 D. Service Information Under 37 C.F.R. §42.8(b)(4).....2

III. PAYMENT OF FEES.....2

IV. GROUNDS FOR STANDING AND RELIEF REQUESTED3

 A. Grounds for Standing Under 37 C.F.R. § 42.204(a)3

 B. Identification of Statutory Grounds for Each Claim3

V. BACKGROUND AND PRELIMINARY MATTERS6

 A. The Prosecution History of the '664 Patent6

 B. Level of Ordinary Skill.....8

 C. Claim Construction.....8

VI. OVERVIEW OF PRIOR ART9

 A. Gao (Ex. 1003)9

 B. Lin (Ex. 1004)9

 C. Won (Ex. 1005)11

 D. Kumada (Ex. 1006)12

 E. Sylvania (Ex. 1007).....15

 F. UL 2002 Standards (Ex. 1008).....17

VII. THE CHALLENGED CLAIMS ARE UNPATENTABLE.....17

 A. GROUND 1: Claims 1-2 and 5-10 are obvious over Sylvania in view of Gao (and optionally the UL 2002 Standards).....18

 i. Commercial Sale of Sylvania’s Net Light Set.....18

 ii. Independent Claim 119

 iii. Claim 2.....51

 iv. Claim 5.....53

 v. Claim 6.....53

vi.	Claim 7.....	55
vii.	Claim 8	55
viii.	Claim 9	58
ix.	Claim 10.....	60
B.	GROUND 2: Claims 1-10 are obvious over Kumada in view of Gao and Lin (and optionally the UL 2002 Standards).	61
i.	Independent Claim 1	61
ii.	Claim 2.....	81
iii.	Claim 3.....	82
iv.	Claim 4.....	85
v.	Claim 5.....	85
vi.	Claim 6.....	86
vii.	Claim 7	87
viii.	Claim 8	87
ix.	Claim 9.....	88
x.	Claim 10.....	90
C.	GROUND 3: Claims 1-10 are obvious over Won in view of Gao and Kumada (and optionally the UL 2002 Standards).	93
i.	Independent Claim 1	93
ii.	Claim 2.....	108
iii.	Claim 3.....	109
iv.	Claim 4.....	110
v.	Claim 5.....	110
vi.	Claim 6.....	110
vii.	Claim 7	111
viii.	Claim 8	112
ix.	Claim 9	113
x.	Claim 10	114
VIII.	CONCLUSION.....	115

PETITIONER'S LIST OF EXHIBITS

Exhibit No.	Description
1001	U.S. Patent No. 10,119,664 (“Chen”)
1002	U.S. Patent No. 10,119,664 Prosecution History
1003	CN 203910314 (“Gao”)
1004	Canadian Pat. App. Pub. No. CA2238113 (“Lin”)
1005	U.S. Pat. No. 6,217,193 (“Won”)
1006	U.S. Pat. No. 6,367,951 (“Kumada”)
1007	2008 Sylvania Net Light Set
1008	Underwriters Laboratories Standard for Safety for Seasonal and Holiday Decorative Products, UL 588, 18 th Ed., dated February 15, 2002 (UL 2002 Standards)
1009	Declaration of Stephen D. Fantone, Ph.D.
1010	Declaration of William E. Shelleman
1011	U.S. Pat. No. 8,692,120 (“Debladis”)
1012	U.S. Pat. No. 5,216,205 (“Fujii”)
1013	U.S. Pat. Pub. No. 2013/0062095 (“Huang”)

I. INTRODUCTION

Everstar Merchandise Co., Ltd. (Petitioner) respectfully requests Post-Grant Review of U.S. Patent No. 10,119,664 (the “’664 patent”) (Ex. 1001) and the cancellation of claims 1-10 (the “Challenged Claims”).

Net lights such as the ones claimed have been on sale for years, long before the application for the ’664 patent was filed. In 2008, Petitioner purchased a net light product with the claimed structure and characteristics save for a reinforced intermediate conductive wire. Reinforced conductive wires, as claimed, further have been known well-before the date of the alleged ’664 invention, and the UL standards for decorative lighting have even contemplated the use of wires with a reinforced polymer strand since at least 2002. Further, Patent Owner filed the application that led to the ’664 patent years after filing a series of applications in another patent family that cover substantially the same subject matter, and yet Patent Owner failed to bring the most relevant of those co-pending applications to the Patent Office’s attention. The ’664 patent represents a brazen attempt to unlawfully extend a monopoly for an alleged invention that should not have been granted patent protection in the first instance, as decorative lighting products and art with the claimed features were known and available long before the priority date. The Challenged Claims of the ’664 patent are unpatentable.

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.