

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.

PGR2019-00056
Patent 10,222,037 B2

Before DEBRA K. STEPHENS, STACEY G. WHITE, and
JEFFREY W. ABRAHAM, *Administrative Patent Judges*.

ABRAHAM, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision
Determining No Challenged Claims Unpatentable
35 U.S.C. § 328(a)

Dismissing Patent Owner's Motion to Exclude
37 C.F.R. § 42.64(c)

Granting Joint Motion to Seal
37 C.F.R. § 42.54

I. INTRODUCTION

A. *Background and Summary*

Everstar Merchandise Co., Ltd. (“Petitioner”) filed a petition for post-grant review (Paper 1, “Pet.”) of claims 1–33 (the “challenged claims”) of U.S. Patent 10,222,037 B2 (Ex. 1001, “the ’037 patent”). Willis Electric Co., Ltd. (“Patent Owner”) timely filed a Preliminary Response (Paper 6, “Prelim. Resp.”). Pursuant to 35 U.S.C. § 324, the Board instituted trial on February 20, 2020, after determining, based on the information presented in the papers and evidence before us at that time, it was more likely than not that at least one challenged claim was unpatentable over the cited art. Paper 7 (“Institution Decision” or “Inst. Dec.”).

After institution, Patent Owner filed a Response to the Petition (Paper 15, “PO Resp.”), Petitioner filed a Reply to Patent Owner’s Response (Paper 21, “Reply”), and Patent Owner filed a Sur-reply (Paper 25, “Sur-reply”).

Patent Owner also filed a Motion to Exclude (Paper 31, “Mot.”), Petitioner filed an Opposition to Patent Owner’s Motion to Exclude (Paper 32, “Mot. Opp.”), and Patent Owner filed a Reply in Support of its Motion to Exclude (Paper 36, “Mot. Reply”).

The parties also filed a Joint Motion to Seal Exhibit 1026. Paper 37.

On December 16, 2020, the parties presented arguments at an oral hearing for this proceeding and for IPR2019-01485. The transcripts of the hearings have been entered into the record. Paper 38 (“PGR Tr.”); Paper 39 (“IPR Tr.”).

We have jurisdiction under 35 U.S.C. § 6. We issue this Final Written Decision pursuant to 35 U.S.C. § 328(a) and 37 C.F.R. § 42.73. Based on the record before us, we conclude that Petitioner has not shown, by a

preponderance of the evidence, that claims 1–33 of the '037 patent are unpatentable.

B. Related Matters

Petitioner states that there are no other judicial or administrative matters that would affect, or be affected by, a decision in this proceeding. Pet. 1.

Patent Owner indicates that U.S. Patents 9,140,438 B2, 9,157,588 B2, 9,243,788 B2, and 9,671,097 B2 are related to the '037 patent. PO Resp. 4; Paper 4, 1. In particular, those patents and the '037 patent claim priority to U.S. Provisional Patent Application 61/877,854. PO Resp. 4; Paper 4, 1. Patent Owner also indicates that U.S. Patent 9,157,588 B2 is the subject of IPR2019-01485 (institution granted on Feb. 20, 2020) and U.S. Patent 9,671,097 B2 is the subject of IPR2019-01484 (institution denied on Feb. 20, 2020). Paper 4, 2; IPR2019-01484, Paper 7; IPR2019-01485, Paper 7.

C. The '037 Patent (Ex. 1001)

The '037 patent, titled “Decorative Lighting With Reinforced Wiring,” issued March 5, 2019. Ex. 1001, codes (45), (54). The '037 patent states that decorative lighting, such as seasonal holiday lighting, “often comprises one or more strings of lights constructed of multiple wires, lamp assemblies and an electrical connector or power plug.” Ex. 1001, 1:34–36. According to the '037 patent, a typical light string may be constructed of wire that includes copper strands twisted together and covered with an insulating polymer. Ex. 1001, 1:40–44. The '037 patent explains that a decorative light string needs to be able to “withstand physical abuse with limited risk of breakage,” because breakage of the wiring “could result in

shock or electrocution to persons coming into contact with the decorative lighting.” Ex. 1001, 1:53–59.

The '037 patent identifies two previously known methods of increasing the mechanical strength of wires: (1) relying on large gauge wiring and (2) twisting pairs of wires together. Ex. 1001, 1:60–61, 2:1–3. These methods, however, “tend[] to drive up material cost and make lighting heavier and bulkier.” Ex. 1001, 5:66–6:2. To overcome these shortcomings, the '037 patent is directed to “internally reinforced, electrically-conducting wires having superior tensile strength and elongation,” wherein the wire includes one or more reinforcing strands or threads and one or more conductor strands surrounded by an insulating layer or jacket. Ex. 1001, 6:6–9, 6:29–33.

One embodiment of the reinforced decorative lighting wire of the '037 patent is shown in Figure 3, reproduced below:

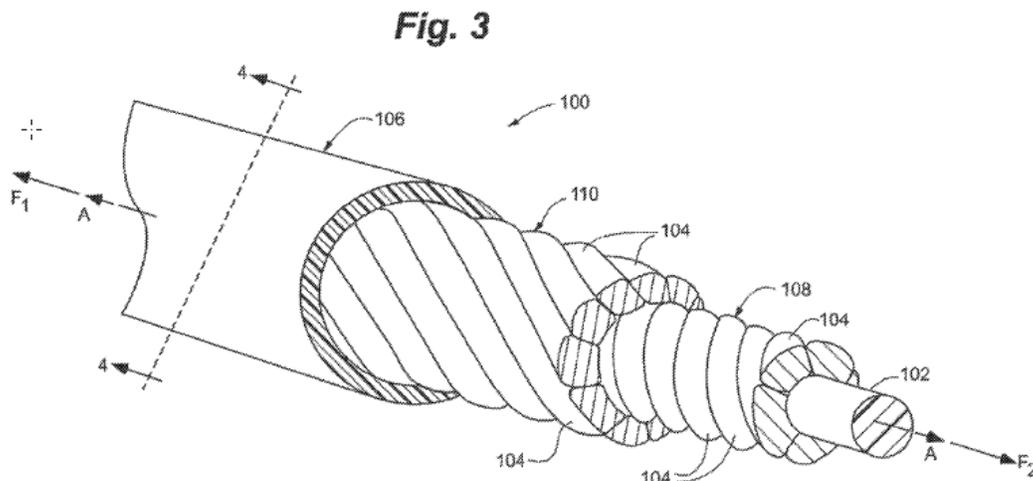
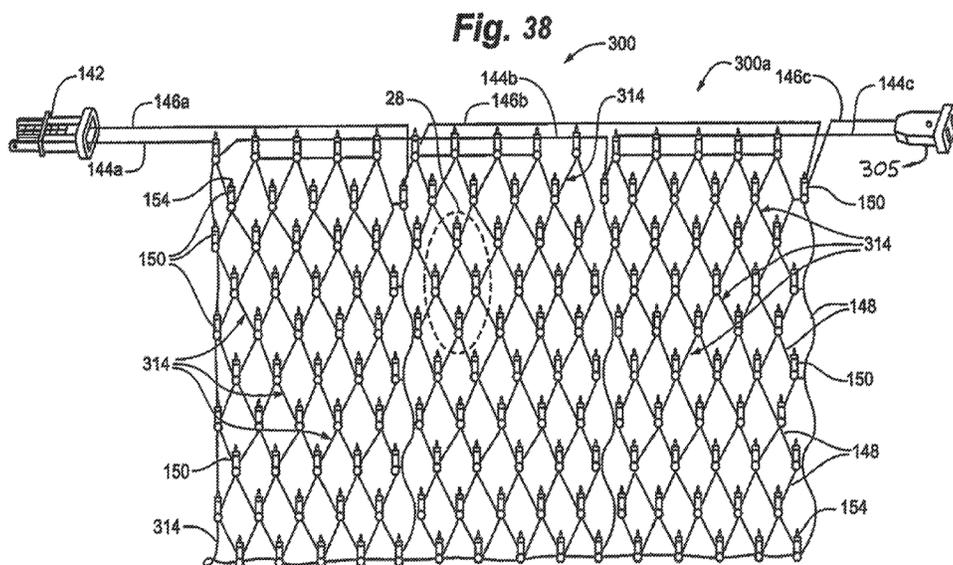


Figure 3 shows a perspective view of reinforced decorative wire 100 comprising reinforcing strand 102, conductor strands 104, and insulating layer 106. Ex. 1001, 3:51–52, 6:29–33. The '037 patent indicates that

“reinforcing strands 102 and conductor strands 104 may be arranged in a variety of manners, and in a variety of quantities, dependent upon a number of factors, including desired wire properties, including, but not limited to, tensile strength, resistivity and conductivity.” Ex. 1001, 6:36–41.

The '037 patent discloses the use of reinforced wiring in “net light” configurations, wherein a patterned array of lamp elements and reinforced wire form a two dimensional lighting structure. Ex, 1001, 36:29–33. The '037 patent states that “[k]nown net lights typically require some kind of reinforcing strands wrapped about the various wiring segments . . . to provide additional strength,” but the use of its reinforced wire reduces or eliminates the need for such reinforcing strands to be wrapped around the net wires. Ex. 1001, 36:33–43.

One embodiment of the reinforced-wire net light of the '037 patent is depicted in Figure 38, reproduced below.



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.