NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

AMP PLUS, INC., DBA ELCO LIGHTING,
Appellant

v.

DMF, INC.,
Cross-Appellant

2021-1595, 2021-1636

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. IPR2019-01094.

Decided: November 10, 2022

JOSEPH ROGER RICK TACHE, Buchalter, A Professional Corporation, Irvine, CA, argued for appellant. Also represented by KARI BARNES, ROGER L. SCOTT.

DAVID W. LONG, ErgoniQ, LLC, McLean, VA, argued for cross-appellant. Also represented by BEN M. DAVIDSON, Davidson Law Group, Calabasas, CA; KEVIN B. LAURENCE, Laurence & Phillips IP Law, Washington, DC.

Before STOLL, BRYSON, and CUNNINGHAM, *Circuit Judges*.

BRYSON, *Circuit Judge*.

Appellant AMP Plus, Inc., d/b/a ELCO Lighting ("ELCO") petitioned for *inter partes* review ("IPR") of U.S. Patent No. 9,964,266 ("the '266 patent"), which is owned by appellee DMF, Inc. In its Final Written Decision, the Patent Trial and Appeal Board determined that a number of the challenged claims of the '266 patent were not unpatentable, but that claim 17 was unpatentable. Both parties appealed the Board's decision. We affirm in part, vacate in part, and remand.

I

The '266 patent is generally directed to a "compact recessed lighting system" that can be installed in a standard electrical junction box. '266 patent, Abstract. The '266 patent discloses a "unified casting" that houses a light source and a "driver" that powers the light source. *Id.* at col. 2 ll. 7–10, col. 3, ll. 25–46. The casting, driver, and light source are all sized so that they can fit within a junction box. *See id.* at col. 2, line 65 through col. 3, line 11. Claim 1 of the '266 patent is representative of the claimed invention. It recites as follows:

> 1. A compact recessed lighting system, comprising:
>
> a light source module for emitting light;
>
> a *driver* for powering the light source module to emit light, the driver including an electronic device to at least one of supply and regulate electrical energy to the light source module;
>
> a unified casting with a heat conducting closed rear face, a heat conducting sidewall and an open front face wherein the heat conducting sidewall is joined to the heat conducting closed rear face at one end and defines the open front face of the unified

casting at another end, wherein the heat conducting sidewall has a first dimension between the heat conducting closed rear face and the open front face of less than 2 inches and extends 360 degrees around a center axis of the unified casting to define a first cavity that extends forward from the heat conducting closed rear face to the open front face of the unified casting and outward to the heat conducting sidewall, wherein the light source module and the driver are positioned inside the first cavity while being coupled to the heat conducting closed rear face of the unified casting such that the light source module is closer to the closed rear face of the unified casting than the open front face of the unified casting, and wherein the unified casting includes a *plurality of elements positioned proximate to the open front face so as to align with corresponding tabs of a standard junction box* and thereby facilitate holding the unified casting up against the standard junction box when the unified casting is installed in the standard junction box; and

a reflector positioned inside the first cavity of the unified casting and coupled to and surrounding the light source module such that the reflector directs light produced by the light source module into an area surrounding the compact recessed lighting system while enclosing the driver from exposure to the area surrounding the compact recessed lighting system,

wherein the heat conducting closed rear face and the heat conducting sidewall of the unified casting significantly dissipate heat generated by the light source module during operation of the light source module.

Id. at claim 1 (emphasis added to disputed limitations).

Claim 22 also plays a role in this appeal. It recites as follows:

> 22. A compact recessed lighting system, comprising:
>
> a light source module for emitting light;
>
> a driver for powering the light source module to emit light, the driver including an electronic device to at least one of supply and regulate electrical energy to the light source module;
>
> a unified casting with a closed rear face, a sidewall and an open front face wherein the sidewall is joined to the closed rear face at one end and defines the open front face of the unified casting at another end, wherein the sidewall extends 360 degrees around a center axis of the unified casting to define a cavity that extends forward from the closed rear face to the open front face of the unified casting and outward to the sidewall, wherein the light source module and the driver are positioned inside the cavity of the unified casting such that the light source module is closer to the closed rear face of the unified casting than the open front face of the unified casting; and
>
> a reflector positioned inside the cavity of the unified casting and coupled to and surrounding the light source module such that the reflector directs light produced by the light source module into an area surrounding the compact recessed lighting system while enclosing the driver from exposure to the area surrounding the compact recessed lighting system,

> wherein:
>
> the light source module is a light emitting diode (LED) module;
>
> the sidewall of the unified casting has fins formed on its outside surface; and
>
> the system further comprises a plurality of wires connected to the driver and connected to a first connector of a pair of complimentary [sic] keyed or interlocking connectors, such that in operation the first connector is coupled to a second connector of the pair of complimentary [sic] keyed or interlocking connectors, *wherein the second connector is coupled to electricity from an electrical system of a building* in which the compact recessed lighting system is installed.

Id. at claim 22 (emphasis on disputed limitation).

In its IPR petition, ELCO asserted three prior art references. Two of the references, "Imtra 2011" and "Imtra 2007," were catalogs published by Imtra Corporation detailing various lighting fixtures that Imtra sold for use on boats or in other marine applications. J.A. 391–403 (Imtra 2011); J.A. 431–38 (Imtra 2007). The third reference, U.S. Patent No. 9,366,418 ("Gifford"), describes a non-recessed lighting system that can be attached to a standard junction box. Gifford, Abstract & Fig. 1. ELCO raised three grounds of invalidity in the petition: anticipation by Imtra 2011 ("Ground 1"); obviousness in view of the combination of Imtra 2011 and Imtra 2007 ("Ground 2"); and obviousness in view of the combination of Imtra 2011, Imtra 2007, and Gifford ("Ground 3").

In its Final Written Decision, the Board found that Imtra 2011 disclosed all limitations of the challenged claims except for the "plurality of elements" limitation. *See*

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