

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HONEYWELL INTERNATIONAL INC.,

Petitioner,

v.

CREE, INC.,

Patent Owner.

Case IPR2015-01361

Patent 8,860,058

**PATENT OWNER'S PRELIMINARY RESPONSE
UNDER 37 C.F.R. § 42.107**

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I. CLAIM CONSTRUCTION

The '058 patent will expire before the Board would be expected to provide a Final Written Decision if *inter partes* review were instituted. Accordingly, the Board's review of the claims is similar to that of a district court. *In re Rambus, Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012).

The table below provides Petitioner's and Patent Owner's proposed constructions for certain terms, each of which is consistent with the positions made in district court (though no ruling has been made at this point).

Term	Petitioner's Proposed Construction	Patent Owner's Proposed Construction
down-converting	transforming light from a shorter wavelength form to a longer wavelength form	transforming a higher frequency, shorter wavelength form of energy to a lower frequency, longer wavelength form of energy
luminophoric medium	a material, which in response to radiation emitted by a device, emits light by fluorescence and/or	a material, which in response to radiation emitted by a solid state device emits light by fluorescence and/or

	phosphorescence	phosphorescence
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There is no substantial dispute concerning these two terms.

II. PETITION IS NON-COMPLIANT

The Petition relies on exhibits 1007 and 1008 as primary references. These exhibits, however, are not printed publications as required by 35 U.S.C. § 311(b) and 37 C.F.R. § 42.104(b)(4). Instead, they are file history copies of translations for what are known as the Tadatsu and Tabuchi references. The Petitioner, inexplicably, failed to submit the *actual* Tadatsu and Tabuchi references. In addition, even if Petitioner had submitted the actual Tadatsu and Tabuchi references, the translations it provided are themselves non-compliant, because they lack the required affidavits of accuracy. C.F.R. § 42.63(b) (“[w]hen a party relies on a document . . . in a language other than English, a translation of the document into English and an affidavit attesting to the accuracy of the translation *must* be filed *with* the document” (emphases added); *See* IPR2014-01121, -01122, -01123, Paper 25 (Feb. 24, 2015) at 4.

III. PETITION PRESENTS REDUNDANT GROUNDS

Though not stated explicitly, Tadatsu (Ex. 1007) and Tabuchi (Ex. 1008) are each presented as primary references under 102(b). Pet. at 8-9. Thus each has the same issues in terms of qualifying as prior art, inability to backdate, and the like.

All invalidity ground presented in the Petition rely on substituting the actual LED chip of Tadatsu and of Tabuchi with the later-developed LED chip of Nakamura (Ex. 1006). Consequently, this purported difference is moot and not part of the actual combinations relied on in the Petition's analysis. Pet. at 15-59. See, e.g., *Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.*, CBM2012-00003, Order (Redundant Grounds), Paper 7 at 2 (Oct. 25, 2012) (“[M]ultiple grounds, which are presented in a redundant manner by a petitioner who makes no meaningful distinction between them, are contrary to the regulatory and statutory mandates, and therefore are not all entitled to consideration.”) The grounds presented in the instant Petition are therefore redundant.

Respectfully submitted,

Date: September 17, 2015

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CERTIFICATE OF SERVICE

I hereby certify that, on September 17, 2015, I caused a true and correct copy of the following materials:

- Patent Owner's Preliminary Response Under 37 C.F.R. §42.107

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