

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CURRENT LIGHTING SOLUTIONS, LLC,
and
HLI SOLUTIONS, INC.,
Petitioners,
v.

ALSI HOLDINGS, LLC,
Patent Owner.

Inter Partes Review Case No. IPR2023-00125
U.S. Patent No. 9,699,854

**PATENT OWNER'S PRELIMINARY SUR-REPLY
IN IPR2023-00125**

PATENT OWNER'S EXHIBIT LIST

<u>Exhibit Number</u>	<u>Description</u>
2001	Reserved
2002	Reserved
2003	Reserved
2004	Scheduling Order
2005	Claim Construction Order
2006	U.S. Patent No. 7,034,450
2007	U.S. Patent Application Publication No. 2006/0285083
2008	U.S. Patent No. 7,789,534

I. Petitioners Have Not Established U.S. Pat. Pub. No. 2008/0089069 To Medendorp (“Medendorp”) As Prior Art

Petitioners cite MPEP §§901.03 and 2136 in an attempt to qualify Medendorp as prior art under 35 U.S.C. §102(e). Preliminary Reply, 1-2. But this does not establish Medendorp as prior art under 35 U.S.C. §103 or for any other use in this IPR.

As previously articulated, Petitioners offer no evidence that Medendorp is prior art to the '854 Patent. *See* Paper 7, 17. Further, Petitioners offer no explanation as to how Medendorp is be relevant to the challenged claims. *See id.*, 21.

To withstand denial, a petition must set forth the exhibit number of the supporting evidence relied upon to support the challenge and **the relevance of the evidence to the challenge raised**, including identifying specific portions of the evidence that support the challenge. *See* 37 C.F.R. §42.104(b)(5) (emphasis added). Failing that, the Board may exclude or give no weight to the evidence. *See id.*

The MPEP states:

Obviousness is a question of law based on underlying factual inquiries.

The factual inquiries enunciated by the Court are as follows: (A)

Determining the scope and content of the prior art; (B) Ascertaining the differences between the claimed invention and the prior art; ...

MPEP §2141.II. A 35 U.S.C. 103 reference must be analogous art to the claimed invention. *See In re Bigio*, 381 F.3d 1320, 1325, 72 USPQ2 1209, 1212 (Fed. Cir.

2004). “A reference is analogous art to the claimed invention if: (1) the reference is from the same field of endeavor as the claimed invention...; or (2) the reference is reasonably pertinent to the problem faced by the inventor....” MPEP §2141.01(a). Further, “[a]scertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole.” *Id.*, §2141.02.

Petitioners have the burden to establish that a reference that serves as the basis of a ground of unpatentability asserted in an *inter partes* review qualifies as prior art. *See* 37 C.F.R. §42.20(c). Instead, Petitioners merely contend in conclusory fashion that Medendorp is prior art under 35 U.S.C. §102(e). Petitioners provided no explanation as to Medendorp’s relevancy or any consideration of Medendorp as a whole to “[a]scertain[] the differences between the prior art and the claims at issue.” For at least these reasons, Petitioners have not established Medendorp as prior art under 35 U.S.C. §103 for use in this IPR.

It is not the Board’s role to identify Medendorp’s relevancy, determine its scope and content, or “[a]scertain[] the differences between the prior art and the claims at issue.” Yet that is exactly what Petitioners are seeking to have the Board do here. That approach, however, would improperly shift the burden from the Petitioners onto the Board. *See* 37 C.F.R. §42.20(c). These elements must be set forth in the Petition and Petitioners have failed to do so.

II. Petitioners' *Sotera* Stipulation and Conference Call Transcript

Patent Owner acknowledges that Petitioners filed a single modified, limited *Sotera* stipulation on March 21, 2023 in the related district court litigation. *Compare* EX1047 *with* Petition, 95-96. The modified stipulation is conditioned on institution of *all* three of the following IPRs: "IPR2023-00145, IPR2023-00198, **and** IPR2023-00125." EX1056 (emphasis added).

Further, as of March 27th, 2023, Petitioners have not filed a transcript of the conference call authorizing this supplemental briefing.

Dated: March 27, 2023

Respectfully submitted,

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U.S. Patent No. 9,699,854

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. §42.24(d), I hereby certify that the foregoing PATENT OWNER'S PRELIMINARY SUR-REPLY IN IPR2023-00125 contains 563 words, excluding the parts of the paper exempted by 37 C.F.R. §42.24(a), as measured by the word-processing system used to prepare this paper.

Dated: March 27, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

The undersigned hereby certifies that PURSUANT TO 37 C.F.R. §42.8(a)(2) the foregoing PATENT OWNER'S PRELIMINARY SUR-REPLY IN IPR2023-00125 is being served electronically via e-mail on March 27, 2023, in its entirety on the following counsel of record for Petitioners:

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