

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

ALSI HOLDINGS, LLC,  
Patent Owner.

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

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**PATENT OWNER'S PRELIMINARY RESPONSE  
TO PETITION FOR *INTER PARTES* REVIEW  
OF U.S. PAT. NO. 9,699,854**

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**PATENT OWNER'S EXHIBIT LIST**

<b><u>Exhibit Number</u></b>	<b><u>Description</u></b>
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2004	Scheduling Order
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Patent Owner ALSI Holdings, LLC (“ALSI” or “Patent Owner”) respectfully submits this Preliminary Response to Current Lighting Solutions, LLC and HLI Solutions, Inc.’s (collectively “Current” or “Petitioners”) above-captioned Petition for *Inter Partes* Review of U.S. Patent No. 9,699,854 (“the ’854 Patent”).

## **I. INTRODUCTION**

Institution should be denied because Petitioners have failed to establish they have a reasonable likelihood of demonstrating that even a single challenged claim is unpatentable.

Petitioners’ Ground 1 relies on U.S. Patent No. 6,641,284 to Stopa (“Stopa”) in view of U.S. Patent No. 6,318,886 to Stopa (“Stopa II”) and the knowledge of a person of ordinary skill in the art (POSITA) to challenge claims 1-15 and 18-20. Petitioners’ Ground 2 relies on U.S. Patent Publication No. 2008/0089069 to Medendorp (“Medendorp”) in view of U.S. Patent No. 6,257,735 to Baar (“Baar”) and the knowledge of a POSITA to challenge claims 1-2, 6-9, 13, 15, and 18-20. Petitioners’ Ground 3 relies on U.S. Patent Publication No. 2007/0121343 to Brown (“Brown”) in view of Stopa and the knowledge of a POSITA to challenge claims 1-2, 6-15, 18, and 20.

None of Petitioners’ proposed combinations teach or suggest all of the limitations required by every challenged claim. In addition, Grounds 2 and 3 rely on references that have not been established as prior art and these Grounds must fail



as a matter of law. Petitioners have also failed to provide any statement regarding how any of the cited references are relevant to any challenge raised in the Petition. Because the Petition fails to address novel and critical requirements of the challenged claims, the Petition has no reasonable likelihood of prevailing on any challenged claim.

The Petition's lack of merit further supports Patent Owner's request that the Board deny institution in exercise of its discretion under 35 U.S.C. §314(a). The Board should exercise discretionary denial because the scheduled jury trial in the related district court case will determine the same issues as raised in the Petition – and that district court trial is scheduled to be completed more than four months before any Final Written Decision here. The case has not been stayed, and Petitioner has not moved for a stay pending this proceeding. The challenged claims here are asserted in the district court litigation. Claim construction proceedings are complete and the *Markman* hearing has already been held with the district court issuing a claim construction order. The court and the parties have invested and will continue to invest substantial resources even before the institution decision deadline. Parallel proceedings on this timeline, with a complete overlap of issues, would waste resources, and risk inconsistent results. Under these circumstances, discretionary denial under §314(a) is warranted.

Furthermore, all of the references relied on in the Petition have either been fully considered by the Office or are substantially the same art applied in substantially the same arguments before the Office during prosecution of the '854 Patent. Yet, the Office still identified the claims of the '854 Patent as allowable and the Petition fails to articulate any error by the Office. The Board should exercise its discretion to terminate this proceeding under §325(d), as all Grounds asserted in this Petition rely upon “the same or substantially the same prior art or arguments” previously “presented to the Office.”

## **II. THE '854 PATENT**

The '854 Patent relates to “lighting fixtures incorporating LEDs configured in a manner to amplify and direct light produced by such lighting fixtures.” EX1001, 1:22-25. In summary, the '854 Patent discloses:

As described in detail herein, a lighting fixture for use, for example, as a streetlight or an office light is disclosed and which provides useful light at a distance using only a small number of LEDs. Such a light fixture incorporates a relatively simple heat dissipating mechanism in accordance with this disclosure. In one embodiment, a light emitting diode (LED) lighting arrangement for a lighting fixture is provided. The LED arrangement includes a lighting strip having a plurality of light emitting diodes (LEDs) and a reflector that can be mounted to the

lighting strip comprising multi-faceted side walls extending away from the light strip. Each of the light emitting diodes desirably has a diode base and a light emitting portion. The multi-faceted side walls of the reflector cause light produced by the plurality of light emitting diodes (LEDs) to be amplified and formed into a uniform beam.

*Id.* 2:19-34.

The '854 Patent consistently and repeatedly discloses a lighting fixture and a lighting arrangement as distinct structures. *See id.*, 6:8-23, 8:1-5, 10:45-47, and 14:16-26. In addition, the '854 Patent also discloses a reflector as a distinct structure. *See id.*, 6:20-22, 8:8-10, 8:16-25, 10:50-53, 11:41-60, and 17:31-19:34. The lighting fixture, the lighting arrangement, and the reflector each being a distinct structure is significant because the '854 Patent discloses and refers to a “base” portion of each of these structures.

For example, the '854 Patent discloses “[l]ighting fixture 1 generally includes a housing 2 comprising a base plate 3 having a front side 5 and a rear side 7.” *Id.*, 6:13-15. The '854 Patent also discloses “[e]ach light emitting sub-assembly 104 includes a lighting strip 109 comprised of one or more surface-mounted LEDs 111 mounted to a circuit board substrate or base member 142.” *Id.*, 8:5-8. Similarly, the '854 Patent discloses “the reflector assembly includes a base member 184 and a pair

of desirably integral side walls 185 extend from opposite sides of the base member 184 at an angle.” *Id.*, 17:34-37.

The ’854 Patent further discloses that a side wall of the reflector may be multi-faceted with multiple angles. *See id.*, 17:31-19:34 and 19:60-20:15. For example:

Each side wall 185 of reflector assembly 141 includes a first facet or first portion 186 defining a first angle  $\theta$  with the base portion 184 of reflector 141 adjacent the bottom portion of light emitting portion 187 of LED 111, and a second facet or second portion 188 that defines a second angle  $\Phi$  with first portion 186.

*Id.*, 17:41-46.

The ’854 Patent also discloses that “[r]eflector assembly 141 is mounted to lighting strip 109 such that a bottom edge of each side wall 185 extends from a bottom portion of light emitting portion 187 of LED 111.” *Id.*, 17:38-41. The ’854 Patent explains:

In addition, the arrangement of reflector 141 extending from base member 184 allows all of the light produced by LEDs 111 to be reflected and amplified by reflector 141. The angles in side walls 185 of reflector 141 along with the arrangement of reflector 141 such that it extends from the bottom portion of light emitting portion 187 of LED 111 allows lighting fixture 101 to produce useable light while using a

small number of LEDs 111 (e.g., the exemplary embodiment illustrated in FIG. 4 has eight LEDs 111 per lighting strip 109 and four lighting strips 109 for a total of thirty-two LEDs 111).

*Id.*, 54-64.

Challenged Independent claim 1 of the '854 Patent recites:

[1.a] A light emitting diode (LED) lighting arrangement for a lighting fixture, comprising:

[1.b] a base plate;

[1.c] a lighting strip coupled to the base plate, the lighting strip comprising a plurality of light emitting diodes (LEDs) arranged along a substantially planar surface of the lighting strip;

[1.d] at least one reflector sheet comprising:

[1.e] a first multi-faceted side wall of the at least one reflector sheet extending along the lighting arrangement along an entire length of the lighting strip with a first edge adjacent a first side of the lighting strip and extending at an angle along an entire length of the lighting strip; and

[1.f] a second multi-faceted side wall of the at least one reflector sheet extending along the lighting arrangement along an entire length of the lighting strip, the second side wall having a first edge adjacent a second,

opposite side of the lighting strip at an angle that extends along an entire length of the lighting strip,

[1.g] wherein the first and second multi-faceted side walls extend away from the lighting strip at an angle and are configured to cause light produced by the plurality of light emitting diodes (LEDs) to be amplified and formed into a uniform beam, and

[1.h] wherein the coupling between the lighting strips and the base plate provides heat transfer between the lighting strips and the base plate such that heat produced by the plurality of LEDs comprised in the lighting strip is conducted to the base plate for transfer to the ambient environment.

EX1001, Cl. 1 (with brackets indicating the element numbering used in the Petition for clarity). Challenged Independent claim 15 recites similar limitations. *See id.*, Cl. 15.

Petitioners incorrectly assert that “[t]he multi-faceted reflector design is therefore met by any reflector that does not have side-walls that are completely straight.” Petition, 4. Such an assertion over-simplifies the clear disclosure of the ’854 Patent and the plain language of the claims. In contrast, the recited reflector requires not only multi-faceted side-walls, but a base member or portion such that “a first multi-faceted side wall” has “a first edge adjacent a first side of the lighting

strip and extending at an angle along an entire length of the lighting strip” and “a second multi-faceted side wall” has “a first edge adjacent a second, opposite side of the lighting strip at an angle that extends along an entire length of the lighting strip.” *See* EX1001, Cl. 1.

### **III. PROSECUTION HISTORY**

The '854 Patent issued on July 4, 2017 from U.S. Patent Application No. 13/692,402 (“’402 Application”) filed December 3, 2012. The '402 application was a continuation of U.S. Patent Application No. 12/341,798 (“’798 Application”), now U.S. Patent No. 8,322,881 (“’881 Patent”) and claimed priority to U.S. Provisional Patent Application Nos. 61/015,713 filed December 21, 2007, 61/094,558 filed September 5, 2008, and 61/094,571 filed September 5, 2008. *See* EX1002, 2. Of note, Petitioners do not challenge that the '854 Patent has a priority date of at least December 21, 2007. *See* Petition, 3.

On April 23, 2013, an Information Disclosure Statement (“IDS”) was filed that included Medendorp as well as U.S. Patent Application No. 2005/0111220 to Smith (“Smith”). *See* EX1002, 97, 99. As part of a Non-Final Office Action mailed June 24, 2013, the Examiner confirmed that she considered all of the references in the IDS not only by indicating as such, but by basing a rejection on Smith. *See id.*, 110-139. Patent Owner also notes that Medendorp was previously considered by the same Examiner during examination of the '798 Application and is listed on the

face of the '881 Patent. As such, Medendorp is presumed to have been fully considered by the Examiner. *See* 37 C.F.R. §1.106(b); *see also* *Vovomart (HK) Enterprises Co., Ltd. et al. v. Office Kick, Inc.*, PGR2022-00048, Paper 14 at 14 (P.T.A.B. Jan. 12, 2023).

In response to an Examiner Interview conducted on March 15, 2016, then pending independent claims 1, 10, and 16 were amended as part of a response dated May 25, 2016. *See id.*, 348-359. In a subsequent Office Action dated September 9, 2016, the Examiner acknowledged that Smith did not disclose the amended claims while raising a new rejection based on U.S. Patent Application No. 2007/0002565 to Han. *See id.*, 365-378.

An After Final Amendment was filed on December 7, 2016 amending the claims as reflected in the issued claims. *See id.*, 385-395. The Examiner's Statement of Reasons for Allowance states:

Regarding independent claims 1 and 10, the prior art fails to teach or suggest a light emitting diode (LED) lighting arrangement for a lighting fixture comprising at least one reflector sheet comprising a first multi-faceted side wall of the at least one reflector sheet and a second multi-faceted side wall of the at least one reflector sheet, wherein the first and second multi-faceted side walls extend away from the lighting strip at an angle, and wherein the coupling/contact between the lighting strips



and the base plate provides heat transfer between the lighting strips and the base plate such that heat produced by the plurality of LEDs comprised in the lighting strip is conducted to the base plate for transfer to the ambient environment in combination with the remaining limitations of the claims.

*Id.*, 406.

#### **IV. CLAIM CONSTRUCTION**

##### **A. Legal Standard**

Under *Phillips*, patent claims should be interpreted in light of the intrinsic evidence, including the specification and file history, and “the ordinary and customary meaning of a claim term is the meaning the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 1317 (Fed. Cir. 2005); *see also* 83 Fed. Reg. 51341 (Oct. 11, 2018) (adopting *Phillips* standard for AIA proceedings before the Board).

Patent Owner notes that a claim construction order has been issued in the related district court litigation. *See* EX2005. While that order is not controlling in this proceeding, that order is based on the same *Phillips* standard and is highly informative.

Below, Patent Owner addresses Petitioners' proposed construction of "at an angle". For all other terms, the plain and ordinary meaning of those terms is sufficient for the Board to analyze Petitioners' Grounds at this stage. The Petition fails to demonstrate a reasonable likelihood that it would prevail under the plain and ordinary meaning of the claims.

### **B. Level of Ordinary Skill**

The Petition indicates:

A person of ordinary skill in the art of the '854 Patent ("POSITA") would have at least a bachelor's degree in a relevant scientific field, e.g., physics, materials science or engineering, or electrical engineering, and two or more years of experience in the lighting design field dealing particularly with LED fixtures for lighting applications.

Petition, 2-3. For the purpose of this Preliminary Response, applying this level of skill is sufficient for the Board to evaluate the Petition Grounds. Should the Board institute trial, Patent Owner reserves the right to provide its own POSITA definition and support for that definition in its §42.120 Response, including expert testimony regarding the appropriate definition along with that Response.

### **C. "at an angle"**

As a preliminary matter, independent claims 1 and 15 each recite three distinct occurrences of "at an angle". Specifically, 1) a first multi-faceted side wall ... with

a first edge adjacent a first side of the lighting strip and extending at an angle along an entire length of the lighting strip; 2) a second multi-faceted side wall ... having a first edge adjacent a second, opposite side of the lighting strip at an angle; and 3) wherein the first and second multi-faceted side walls extend away from the lighting strip at an angle. Petitioners appear to be referring only to the third recitation, but do not make this clear. *See* Petition, 12-13. If the term “at an angle”, which occurs three times, were construed to mean “at a same angle”, at least the first two occurrences would no longer make any sense. Alternatively, to construe only the third occurrence as having a different meaning would improperly challenge the patent drafter’s clear intent to use the same term consistently.

Petitioners acknowledge that the district court has construed this term as “plain and ordinary meaning.” Petition, 12. Yet, Petitioners assert that “at an angle” must be the same angle for both side walls. *Id.* Such a position challenges well known claim drafting principles as well as settled law.

As a general rule, the terms “a” or “an” mean “one or more.” *See, e.g., 01 Communique Lab’y, Inc. v. LogMeIn, Inc.*, 687 F.3d 1292, 1297 (Fed. Cir. 2012). The plain language of the claims does not depart from these general rules. There must be evidence of “clear intent” to limit the term “a” or “an” to “one.” *LogMeIn*, 687 F.3d at 1297. Here, there is no evidence of intent, much less clear intent, to define “an angle” as “the same angle.”

Further, claim differentiation would also dictate a broader plain and ordinary construction. When a dependent claim adds a particular limitation, there is a presumption that the limitation in question is not found in the independent claim. *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 910 (Fed. Cir. 2004) (“[W]here the limitation that is sought to be read into an independent claim already appears in a dependent claim, the doctrine of claim differentiation is at its strongest.”). Here, dependent claim 6 is directed to side walls that are “symmetrical about an axis of symmetry that runs through a center of the base member.” This dependent claim thus covers same-angled side walls. Under claim differentiation theory, independent claim 1 is broader than the corresponding dependent claim and includes differently-angled side walls. *See, e.g., Phillips*, 415 F.3d 1303, 1324-25 (Fed. Cir. 2005) (reversing the district court’s narrow construction of the independent claim term “baffle” as “extend[ing] inward from the stell shell walls at an oblique or acute angle to the wall face” because certain dependent claims already limited “baffle” as proposed, rendering the corresponding independent claim as broader).

Petitioners reliance on the specification is also misplaced. To limit the scope of claims based on the specification, statements in the specification must “rise[] to the level of ‘a clear and unmistakable disclaimer.’” *Cont’l Cirs. LLC v. Intel Corp.*, 915 F.3d 788, 797 (Fed. Cir. 2019) (quoting *Thorner v. Sony Computer Ent. Am. LLC*, 669 F.3d 1362, 1366-67 (Fed. Cir. 2012)). Petitioners fail to point to anything

in the specification that “clearly and unmistakably disclaims differently angled side walls. *See* Petition, 12-13. To the contrary, the ’854 Patent discloses “the side walls of the reflector ... may be symmetrical about an axis of symmetry that runs through a center of the base member.” *See* EX1001, 3:27-29. As such, asymmetrical arrangements are also within the scope of the invention.

Petitioners attempt to impermissibly add a limitation not recited in the claims via claim construction. This attempt should be rejected. As determined by the district court, “at an angle” should be provided the plain and ordinary meaning while each occurrence should be treated as a distinct recitation.

**V. INSTITUTION SHOULD BE DENIED BECAUSE PETITIONER HAS FAILED TO SHOW A REASONABLE LIKELIHOOD OF SUCCESS ON ANY CHALLENGED CLAIM**

Because the references relied upon by Petitioners do not disclose required limitations from those claims, the petition must be denied.

**A. Petitioner’s cited references**

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. The Board may exclude or give no weight to the evidence

where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.

37 C.F.R. §42.104(b)(5). Yet, as detailed further below, Petitioners fail to provide any statement as to how each of the relied upon references is relevant to the challenges raised in the Petition. Generally, Petitioners fail to provide any discussion, with particularity, of how each reference may be prior art or is relevant to the challenges raised in the Petition.

The Federal Circuit has clarified:

The term “burden of proof” has been used to describe two distinct concepts: the burden of persuasion and the burden of production. The burden of persuasion is “the ultimate burden assigned to a party who must prove something to a specified degree of certainty.” *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326 (Fed. Cir. 2008). In an IPR, “the burden of persuasion is on the petitioner to prove ‘unpatentability by a preponderance of the evidence,’ and that burden never shifts to the patentee.” *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (quoting 35 U.S.C. §316(e)). In contrast, the burden of production, or “going forward with evidence,” is a shifting one, “the allocation of which depends on where in the process of trial the issue arises.” *Id.*, at 1379

(quoting *Tech. Licensing*, 545 F.3d at 1327). The burden of production may be met either by “producing additional evidence” or by “presenting persuasive argument based on new evidence or evidence already of record.” *Tech. Licensing*, 545 F.3d at 1327.

*Google LLC v. IPA Technologies Inc.*, 34 F.4<sup>th</sup> 1801, 1085 (Fed. Cir. 2022).

The Federal Circuit has also stated:

But it is still a system that is predicated on a petition followed by a trial in which the petitioner bears the burden of proof. Given that framework, we find no support for the PTO’s position that the Board is free to adopt arguments on behalf of petitioners that could have been, but were not, raised by the petitioner during an IPR. Instead, the Board must base its decision on arguments that were advanced by a party, and to which the opposing party was given a chance to respond.

*In re Magnum Oil Tools International, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016).

The Federal Circuit further clarified “it is the petition, not the Board’s discretion, that defines the metes and bounds of an [IPR].” *Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1336 (Fed. Cir. 2020). In addition, the Supreme Court held that the petition “guide[s] the life of the litigation” in an IPR proceeding. *SAS Institute v. Iancu*, 138 S. Ct. 1348, 1356, 200 L.Ed.2d 695 (2018).

Petitioners note “Patent Owner has stated the priority date is December 21, 2007 – i.e., the earliest claimed provisional application filing.” Petition, 3. Yet, Petitioners make no claim about whether December 21, 2007 is the earliest priority date that could be afforded the ’854 Patent. Petitioners also do not provide any argument or evidence regarding a priority date of any of their cited references. Petitioners provide nothing more than attorney argument that each reference “qualifies as prior art under 35 U.S.C. §102.” Petition, 8-11. While various dates may be visible on the face of each reference, Petitioners do not direct the Board to any particular date and Patent Owner is not fairly apprised of what, if any, argument and/or evidence Petitioner might rely on to support this attorney argument. Patent Owner should not have to speculate about Petitioners’ understanding of a reference and whether or not Petitioners intended to advance a particular argument. As such, the Petition does not adequately “define[] the metes and bounds” and cannot “guide the life of the litigation” in this IPR proceeding. It would be improper for the Board to adopt any argument or evidence not provided by Petitioners in the Petition. *See Magnum Oil*, 829 F.3d at 1381.

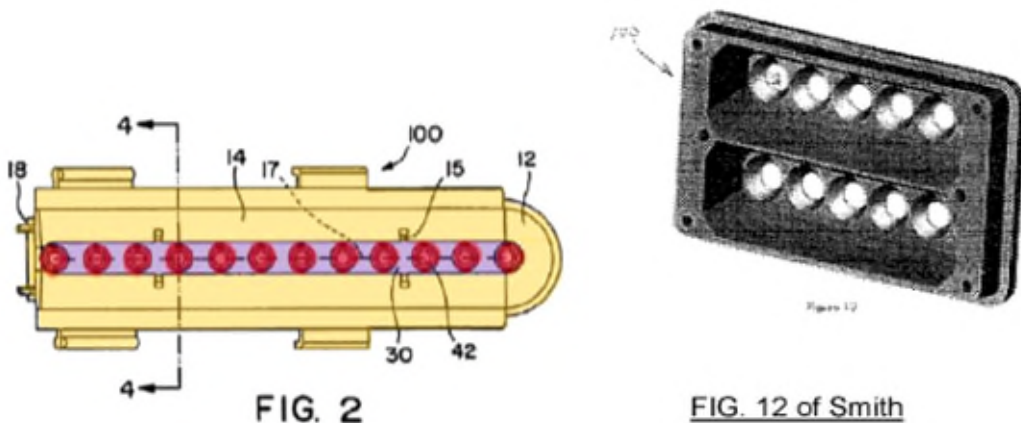
Petitioners have not met their burden of production for at least Grounds 2 and 3, and these Grounds must fail as a matter of law. As discussed in greater detail below, the Petition does not provide any argument or evidence as to how at least Medendorp or Brown may be prior art to the ’854 Patent. To the contrary,



Medendorp is not prior art under either 35 U.S.C. §§102(a) or (b) and Brown is not prior art at least under 35 U.S.C. §102(b). And without sufficient argument or evidence presented in the Petition that Petitioners intended to rely on an earlier date or what that earlier date might be, Patent Owner should not need to address whether Medendorp and/or Brown may be antedated by prior conception and reduction to practice. Petitioners also have not described the relevance of any of the references, all of the references should be excluded under 37 C.F.R. §42.104(b)(5), and all of the Grounds must fail as a matter of law.

**i. Stopa**

Assuming, *arguendo*, that Stopa is prior art under 35 U.S.C. §102(b), Stopa is cumulative art to Smith, which the Office has already considered and determined not to disclose the limitations of the '854 Patent. For example, Stopa and Smith both disclose parabolic reflectors, as shown in the figures below:



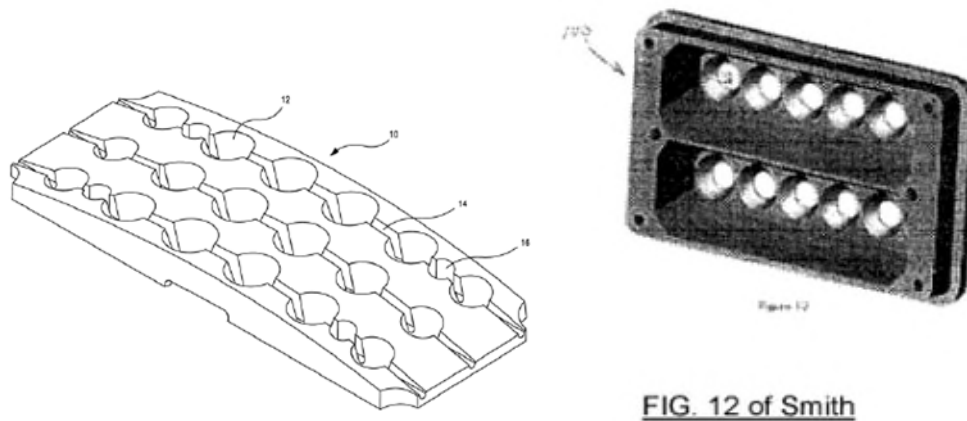
*See* Petition, 8; *see also* EX1002, 302, 357 (citing EX1009, FIG. 12). As such, even if Stopa is prior art, Stopa fails to teach or suggest those limitations for which Stopa is relied upon in the Petition as discussed in greater detail below.

In addition, Petitioners have not provided any description of how Stopa may be relevant to the challenges raised. While the Petition cites to various specific portions of Stopa, Petitioners do not articulate how those portions, in particular, or Stopa generally is relevant. For example, Petitioners do not assert that Stopa is analogous art, is in the same field of endeavor, or otherwise relates to the '854 Patent.

For at least these reasons, Stopa should be excluded and any Ground based on Stopa should fail.

## **ii. Stopa II**

Assuming, *arguendo*, that Stopa II is prior art under 35 U.S.C. §102(b), Stopa II is cumulative art to Smith, which the Office has already considered and determined not to disclose the limitations of the '854 Patent. For example, Stopa II and Smith both disclose conical reflectors, as shown in the figures below:



*See* Petition, 9; *see also* EX1002, 302, 357 (citing EX1009, FIG. 12). As such, even if Stopa II is prior art, Stopa II fails to teach or suggest those limitations for which Stopa II is relied upon in the Petition as discussed in greater detail below.

In addition, Petitioners have not provided any description of how Stopa II may be relevant to the challenges raised. While the Petition cites to various specific portions of Stopa II, Petitioners do not articulate how those portions, in particular, or Stopa II generally is relevant. For example, Petitioners do not assert that Stopa II is analogous art, is in the same field of endeavor, or otherwise relates to the '854 Patent.

For at least these reasons, Stopa II should be excluded and any Ground based on Stopa II should fail.

### **iii. Medendorp**

Medendorp published on April 17, 2008, after the filing of the earliest provisional application on December 21, 2007. *See* EX1022. Petitioners do not

contend that the '854 Patent should not be afforded a priority date of at least December 21, 2007. As such, Medendorp is not prior art under either 35 U.S.C. §§102(a) or (b). And while Medendorp may be afforded a priority date earlier than April 17, 2008, Petitioners do not advocate for or provide any evidence in support of an earlier date.

Petitioners have the burden of proof 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) (“The moving party has the burden of proof to establish that it is entitled to the requested relief.”). In this case, Petitioners have not met this burden. Even if, *arguendo*, Medendorp were afforded an earlier priority date, Petitioners have presented no evidence or argument as to what that earlier date may be or whether the '854 Patent could not be afforded an even earlier priority date. *See Magnum Oil*, 829 F.3d at 1381. As such, Petitioners have not established that Medendorp is prior art under 35 U.S.C. §102(e).

In addition, as discussed elsewhere, Medendorp is listed on the face of the '854 Patent and is presumed to have been fully considered by the Office. *See* 37 C.F.R. §1.106(b); *see also Vovomart (HK) Enterprises Co., Ltd. et al. v. Office Kick, Inc.*, PGR2022-00048, Paper 14 at 14 (P.T.A.B. Jan. 12, 2023). Petitioners also have not provided any description of how Medendorp may be relevant to the challenges raised. While the Petition cites to various specific portions of Medendorp,

Petitioners do not articulate how those portions, in particular, or Medendorp generally is relevant. For example, Petitioners do not assert that Medendorp is analogous art, is in the same field of endeavor, or otherwise relates to the '854 Patent.

For at least these reasons, Medendorp is not prior art to the '854 Patent, should be excluded, and any Ground based on Medendorp should fail.

#### **iv. Baar**

Assuming, *arguendo*, that Baar is prior art under 35 U.S.C. §102(b), Baar is cumulative art to other references which the Office has already considered and determined not to disclose the limitations of the '854 Patent. In addition, Petitioners have not provided any description of how Baar may be relevant to the challenges raised. While the Petition cites to various specific portions of Baar, Petitioners do not articulate how those portions, in particular, or Baar generally is relevant. For example, Petitioners do not assert that Baar is analogous art, is in the same field of endeavor, or otherwise relates to the '854 Patent.

For at least these reasons, Baar should be excluded and any Ground based on Baar should fail.

#### **v. Brown**

Brown published on May 31, 2007, less than one year prior to the filing of the earliest provisional application on December 21, 2007. *See* EX1036. Petitioners do not contend that the '854 Patent should not be afforded a priority date of at least

December 21, 2007. As such, Brown is not prior art under 35 U.S.C. §102(b). Furthermore, Petitioners have presented no evidence or argument that Patent Owner could not antedate Brown's publication date or filing date based on earlier conception and reduction to practice. *See Magnum Oil*, 829 F.3d at 1381. As noted above, Petitioners have the burden of proof 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 and Petitioners have not established that Brown is prior art under either 35 U.S.C. §§102(a) or (e).

In addition, Petitioners have not provided any description of how Brown may be relevant to the challenges raised. While the Petition cites to various specific portions of Brown, Petitioners do not articulate how those portions, in particular, or Brown generally is relevant. For example, Petitioners do not assert that Brown is analogous art, is in the same field of endeavor, or otherwise relates to the '854 Patent.

For at least these reasons, Brown is not prior art to the '854 Patent, should be excluded, and any Ground based on Brown should fail.

**B. There is no reasonable likelihood that Petitioners will prevail in their contention that the challenged claims are rendered obvious by Stopa in view of Stopa II and the knowledge of a POSITA (Ground 1)**

As discussed elsewhere, Stopa and Stopa II are cumulative art to Smith. The Office has already determined that the claims of the '854 Patent distinguish over

Smith. Likewise, the claims of the '854 Patent also distinguish over Stopa and Stopa II for at least the same reasons. As such, there is no reasonable likelihood that Petitioners will prevail with Ground 1.

Regardless, Patent Owner discusses below additional distinguishing features of the claims of the '854 Patent over Stopa and Stopa II.

**i. Petitioners have not shown a motivation to combine Stopa and Stopa II**

Petitioners maintain:

To a POSITA, combining the two references would have been nothing more than applying the known techniques disclosed in Stopa II to improve the light intensity from the reflector assembly of Stopa. (EX. 1003, ¶214.)

Petition, 49. Yet, to the contrary, Stopa explicitly discloses that “applying the known techniques disclosed in Stopa II” would render the light fixture of Stopa inoperable for its intended purpose. For example, Stopa discloses:

While a conical reflector (or other reflector having axial symmetry aligned with the optical axis of the light source) might produce points of greater light intensity, these points will not typically be integrated into a large area of light emission or exhibit wide viewing angle properties. Further, conical reflectors tend to produce stray light that is

effectively lost. An LED light source in accordance with the present invention captures more light and directs that light to contribute to the desired light pattern. Further, the light produced by a plurality of point source LEDs is integrated into a highly visible area of light emission.

EX1038, 7:43-53.

To be clear, Stopa is directed to a light fixture that produces light “integrated into a highly visible area of light emission” and Stopa II produces “essentially a series of bright points of light.” *Id.*, 2:50-51. As such, the proposed combination of Stopa and Stopa II would render Stopa inoperable for its intended purpose and is, therefore, improper. Stopa further confirms this fundamental difference by explaining:

As exemplified by the '886, '717 and '329 patents discussed above, reflectors for light assemblies are typically configured to complement the form of the light source, e.g., point light sources are provided with reflectors having axial symmetry and linear light sources are provided with reflectors having linear symmetry.

*Id.* 2:63-3:1. For at least this reason, the proposed combination of Stopa and Stopa II is improper.

In addition, Stopa explicitly criticizes Stopa II and teaches away from the proposed combination. For example, Stopa discloses:



Thus, the light output of a plurality of point light source LEDs is effectively integrated and amplified into a continuous area or band of light. Testing has proven that such an area or band of light is more visible to the human eye than a distinct point of light, even if the point is several times more intense. The human eye is better able to retain a fix on the position of the larger light source as well as judge the distance to the light source.

*Id.*, 7:13-20. That is, rather than “improve the light intensity”, Stopa discloses that “effectively integrated and amplified” light is preferable to “a distinct point of light, even if the point is several times more intense.” For at least this reason, the proposed combination of Stopa and Stopa II is improper.

Petitioners have not shown any motivation to combine Stopa and Stopa II. To the contrary, the proposed combination would render Stopa inoperable for its intended purpose and Stopa explicitly criticizes Stopa II and teaches away from the proposed combination.

For at least these reasons, Petitioners have not shown a motivation to combine Stopa and Stopa II. As such, Petitioners have not demonstrated a reasonable likelihood of success under Ground 1.

**C. There is no reasonable likelihood that Petitioners will prevail in its contention that the challenged claims are rendered obvious**

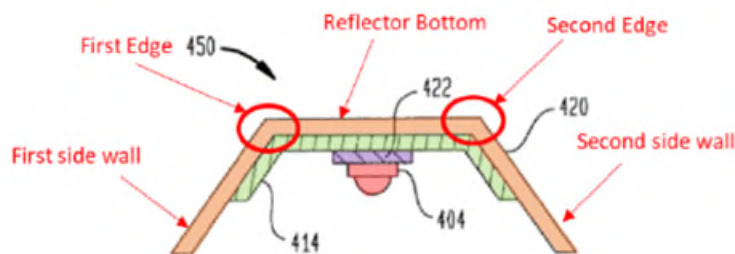
**by Medendorp in view of Baar and the knowledge of a POSITA  
(Ground 2)**

As discussed elsewhere, Medendorp is not prior art to the '854 Patent, Medendorp has already been considered by the Office, and Baar is cumulative art to other art already presented and considered by the Office. As such, there is no reasonable likelihood that Petitioners will prevail with Ground 2.

Regardless, Patent Owner discusses below additional distinguishing features of the claims of the '854 Patent over Medendorp and Baar.

- i. Petitioners have not shown that Medendorp and Baar disclose “a first multi-faceted side wall ... with a first edge adjacent a first side of the lighting strip” and “a second multi-faceted side wall ... having a first edge adjacent a second, opposite side of the lighting strip”**

Petitioners state “Medendorp discloses a *lighting strip* (purple) with a *first side/second side* that are adjacent – or near to – the *first edge/second edge*.” Petition, 55 (emphasis in original). Yet, the claims do not recite “or near to”. Below is the annotated FIG. 5 provided in the Petition:



*Id.* As clearly shown, the “First Edge” and the “Second Edge” are not adjacent the lighting strip 422. *See* EX1022, ¶ [0024] (“the LEDs 404 is thermally coupled by

metal core, FR4, or fiberglass board 422”). As such, Medendorp does not disclose “a first edge adjacent a first side of the lighting strip” or “a first edge adjacent a second, opposite side of the lighting strip.”

For at least this reason, Petitioners have failed to meet their burden of showing a reasonable likelihood that Medendorp and Baar disclose these limitations as recited in independent claims 1 and 15. Dependent claims 2, 6-9, 13, and 18-20 also incorporate these limitations. As such, Petitioners have not demonstrated a reasonable likelihood of success under Ground 2.

**ii. Petitioners have not shown that Medendorp and Baar disclose “a first multi-faceted side wall” and “a second multi-faceted side wall”**

Petitioners acknowledge Medendorp “does not expressly disclose a *multi-faceted side wall reflector*.” Petition, 55 (emphasis in original). To address this deficiency, Petitioners rely on Baar. However, Petitioners also acknowledge “Baar’s *first and second multi-faceted sidewalls* extend from the edges of the reflector bottom.” *Id.*, 56 (emphasis in original). As such, even if the proposed combination of Medendorp and Baar were proper, the combination would still not result in first and second side walls with edges adjacent first and second edges of a lighting strip.

For at least these reasons, Petitioners have failed to meet their burden of showing a reasonable likelihood that Medendorp and Baar disclose these limitations as recited in independent claims 1 and 15. Dependent claims 2, 6-9, 13, and 18-20

also incorporate these limitations. As such, Petitioners have not demonstrated a reasonable likelihood of success under Ground 2.

**iii. Petitioners have not shown a motivation to combine Medendorp and Baar**

The proposed combination of Medendorp and Baar is improper because Petitioners fail to provide sufficient motivation to combine these two references. Petitioners state “Medendorp’s LED lighting strip could replace the fluorescent bulb which would have been used within Baar’s multi-faceted side wall reflector.” *Id.*, 56-57. Petitioners also state “[a] POSITA would have understood Medendorp’s retrofitting assembly could be installed in Baar’s reflector as shown below.” *Id.*, 57; *see also* 70-71. Yet, Petitioners provide no statement about “why” a POSITA would combine Medendorp and Baar. *See Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (“[O]bviousness concerns whether a skilled artisan not only *could have made* but *would have been motivated to make* the combinations or modifications of prior art to arrive at the claimed invention”). Instead, Petitioners state “[o]nce employed, a POSITA would have known Medendorp discloses all elements of limitation [1.4] including *first/second multi-faceted sidewalls*.” *Id.* In light of this statement, the only motivation to combine would be impermissible hindsight.

In a recent decision denying institution, the Board determined that even though the petitioner had identified two references with similar or related structures that could be swapped, the fact they could be swapped was insufficient. *See Guardant Health Inc. v. University of Washington*, IPR2022-01159, Paper 17, at 11 (P.T.A.B Jan. 13, 2023) (“To the extent Petitioner argues that an ordinarily skilled artisan *could have* swapped Kinde’s Y-shaped adapters with Craig’s, that is insufficient for our analysis.”) (emphasis in original).

Patent Owner notes that Medendorp discloses:

According to another aspect a solid state lighting subassembly comprises: a plurality of light emitting diodes (LEDs); a thermally isotropic mount supporting the plurality of light emitting diodes; and anisotropic material thermally conducting heat from one or more of said plurality of LEDs and the thermally isotropic mount in a preferential direction to more effectively utilize said mount as a heat sink.

...a plurality of LEDs 404 are mounted on a metal core or FR4 board 422 in thermal contact with a sheet of anisotropic heat spreading material 414 which is attached by an adhesive backing, such as a thermal adhesive, glued or otherwise attached to a luminaire or other reflector 420. The combination of LEDs 404, metal core or FR4 board

412, anisotropic heat spreading material 414 and luminaire 420 forms a subassembly 450.

EX1022, ¶¶[0010], [0024]. Medendorp further discloses “plural subassemblies are assembled into an overall fixture, such as the fixture 400 of FIG. 4.” *Id.* ¶[0032]. To be clear, Medendorp’s “LED lighting solution” is the combination of LEDs, heat spreading material, and heat dissipating reflector.

In contrast to this clear disclosure of combined subassembly of reflector, LEDs, and heat spreading material, Petitioners mischaracterize Medendorp as “how to install a heat spreading material and lighting strip (with linear row of LEDs) into the reflector of pre-existing fluorescent fixtures.” Petition, 50. This is because Petitioners’ proposed combination involves “to retrofit Baar’s pre-existing fluorescent bulbs with the LED lighting solution of Medendorp.” *Id.* Yet, Medendorp explicitly teaches away from this proposed combination.

Medendorp discloses:

With respect to heat dissipation, the fluorescent bulbs 102, 106 and 108 extend the length of box 102 as indicated by the dashed lines for their subassemblies in FIG. 1. With their large surface areas, they very effectively transfer heat to the surrounding air and subassemblies so that heat dissipation is not a problem for fluorescent lighting fixtures of this kind. By contrast, when a fluorescent bulb is replaced by a series

of high power LEDs, such as the LEDs 300 of FIG. 3, as represented by xs in FIG. 1, heat dissipation becomes an issue.

EX1022, ¶[0005]. That is, Medendorp explicitly discredits the proposed combination of replacing only a fluorescent bulb with LEDs because “heat dissipation becomes an issue.” As such, the proposed combination of Medendorp and Baar is improper.

For at least this reason, Petitioners have failed to meet their burden of showing a motivation to combine Medendorp and Baar. As such, Petitioners have not demonstrated a reasonable likelihood of success under Ground 2.

**D. There is no reasonable likelihood that Petitioners will prevail in its contention that the challenged claims are rendered obvious by Brown in view of Stopa and the knowledge of a POSITA (Ground 3)**

As discussed elsewhere, Stopa is cumulative art to Smith. The Office has already determined that the claims of the '854 Patent distinguish over Smith. Likewise, the claims of the '854 Patent also distinguish over Stopa for at least the same reasons. In addition, as discussed above in §V(A)(v), Petitioners have not shown that Brown is prior art to the '854 Patent. As such, there is no reasonable likelihood that Petitioners will prevail with Ground 3.

Regardless, Patent Owner discusses below additional distinguishing features of the claims of the '854 Patent over Brown and Stopa.

**i. Petitioners have not shown that Brown and Stopa disclose  
“a base plate”**

Petitioners acknowledge “Brown discloses the reflector may further include ‘narrow ribs on the rear of the unit’ (‘SA<sub>2</sub>’) attached to the back panel.” Petition, 72 (citing EX1036, ¶ [0028]). That is, Petitioners admit that Brown does not disclose “a base plate”. To address this deficiency, Petitioners then attempt to show that a POSITA would have known that a heat sink and reflector could be constructed separately, to include presenting a mock up of a combination of Brown’s FIGs. 1 and 3. *See id.*, 73-74. Yet again, Petitioners do not provide any indication of why a POSITA would modify the clear disclosure of Brown in the proposed fashion. *See Belden* at 1072; *see also Guardant Health*, at 11. For at least this reason, this proposed modification is improper.

To further address this deficiency, Petitioners propose combining Brown and Stopa. *See id.*, 74. However, the only motivation to combine these two disparate disclosures is impermissible hindsight. Brown explicitly discloses “[t]he back plane and the reflector could of course also be made out of a same sheet folded along two lines to create two reflector wings.” EX1036, ¶ [0026]. In contrast, Stopa explicitly discloses “the rear of the reflector 10 (adjacent the focal axis 17) is configured as an open slot.” EX1038, 5:8-9. Neither Brown nor Stopa provide any motivation to combine these two disparate configurations and Petitioners do not provide any



explanation of why these two contradictory structures should be combined. *See Belden* at 1072; *see also Guardant Health*, at 11. As such, the only motivation to combine is impermissible hindsight and the proposed combination is improper.

Petitioners alternatively point to a “retaining device” as being the recited base plate. *See* Petition, 75-76. However, even if such “retaining device” were properly considered to be the base plate as recited, Brown does not disclose that the “retaining device” provides any heat transfer functionality as recited elsewhere in the claims.

For at least these reasons, Petitioners have failed to meet their burden of showing a reasonable likelihood that Brown and Stopa disclose this limitation as recited in independent claims 1 and 15. Dependent claims 2, 6-14, 18, and 20 also incorporate this limitation. As such, Petitioners have not demonstrated a reasonable likelihood of success under Ground 3.

**ii. Petitioners have not shown that Brown and Stopa disclose  
“a lighting strip coupled to the base plate”**

As discussed above, neither Brown alone nor Brown in combination with Stopa disclose a base plate as recited in independent claims 1 and 15. As such, Brown and Stopa cannot disclose a lighting strip coupled to such non-existent base plate. Contrary to Petitioners’ assertions, Brown explicitly discloses:

A linear array of LEDs protected by a LED substrate is mounted on a back panel. A reflector is mounted edge to edge with the back plane on

each side of the LED array in a gutter-like shape with the LED array in the bottom.

EX1036, ¶ [0026]. As clearly disclosed by Brown, the lighting strip is attached to the reflector. Stopa is not relied on to address this deficiency in Brown.

For at least these reasons, Petitioners have failed to meet their burden of showing a reasonable likelihood that Brown and Stopa disclose this limitation as recited in independent claims 1 and 15. Dependent claims 2, 6-14, 18, and 20 also incorporate this limitation. As such, Petitioners have not demonstrated a reasonable likelihood of success under Ground 3.

**iii. Petitioners have not shown that Brown and Stopa disclose “a first multi-faceted side wall of the at least one reflector sheet” and “a second multi-faceted side wall of the at least one reflector sheet”**

Petitioners state “[a] POSITA would therefore understand Brown’s sidewalls could be designed to have a parabolic or elliptical shape – i.e., not constant curvature design.” Petition, 79 (citing EX1003, ¶¶ 345-349). But again, Petitioners do not provide any discussion of why a POSITA might modify the design of Brown. That a reference could be modified is not sufficient motivation to perform the modification. *See Belden* at 1072; *see also Guardant Health*, at 11. As such, the only reason to modify Brown is impermissible hindsight. Stopa is not relied on to address this deficiency in Brown.

For at least these reasons, Petitioners have failed to meet their burden of showing a reasonable likelihood that Brown and Stopa disclose these limitations as recited in independent claims 1 and 15. Dependent claims 2, 6-14, 18, and 20 also incorporate these limitations. As such, Petitioners have not demonstrated a reasonable likelihood of success under Ground 3.

**VI. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER SECTION 314(a)**

The Board is granted the discretion to decline to institute *inter partes* review whenever it deems the circumstances warrant doing so. *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“the PTO is permitted, but never compelled, to institute an IPR proceeding”); *see also* 35 U.S.C. §314(a); *Oil States Energy Servs. LLC v. Greene’s Energy Grp., LLC*, 138 S. Ct. 1365, 1371 (2018) (“The decision whether to institute *inter partes* review is committed to the Director’s discretion.”). The Board has declined to institute in cases where a parallel district court trial would determine the same issues before the requested Board trial, rendering the review cumulative and inefficient. *See, e.g., NHK Spring Co., Ltd. v. Intri-Plex Technologies, Inc.*, IPR2018-00752, slip op., 20 (P.T.A.B. Sept. 12, 2018) (Paper 18) (Precedential) (quoting *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, 16-17 (Paper No. 19) (P.T.A.B. Sept. 6, 2017) (Precedential)); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 12 (P.T.A.B.

Mar. 20, 2020) (precedential) (setting forth six factors Board will consider when exercising discretion to deny institution in view of a parallel proceeding).

Here, the factors weigh overwhelmingly in support of discretionary denial. Accordingly, the Board should exercise discretion to deny institution so that the cumulative issues Petitioners have raised in both the district court and the Petition can be decided efficiently, with the least amount of duplication and at the next available opportunity under the facts and circumstances here: in the district court.

**A. The investment of the court and the parties in the district court litigation, addressing identical issues to be decided before the Board’s Final Written Decision, warrants discretionary denial under 35 U.S.C. §314(a)**

This proceeding involves facts that strongly support discretionary denial. There is no stay, and thus nothing to “allay[] concerns about inefficiency and duplication of efforts.” *Fintiv*, Paper 11 at 6. This proceeding and the parallel district court litigation overlap on the substantive issues to be decided—both with respect to Petitioners’ invalidity arguments and proposed claim construction. A jury trial, which is set by court order for August 28, 2023, will be completed before the statutory date for a final written decision in this proceeding. EX2004, 5 (entering Scheduling Order setting trial date for August 28, 2023). The court and the parties’ investment in the parallel proceeding is substantial—the district court held *Markman* hearing and has issued its claim construction ruling, general fact discovery

will have closed, and expert discovery will be almost complete before the statutory date for an institution decision here. *Id.*, 2-4 (setting *Markman* hearing for August 29, 2022, general fact discovery to commence on August 30, 2022 and close on March 27, 2023, and expert discovery to commence on April 3, 2023 and close on May 22, 2023).

**i. Petitioner has not moved to transfer the district court case and no stay is pending (*Fintiv* factor 1)**

With no request for a stay pending nor any cause for a stay to be issued, this factor weights in favor of discretionary denial. *Fintiv*, Paper 11 at 8.

**ii. The district court has set a trial date—not an “estimate”—which precedes this Board’s Final Written Decision (*Fintiv* factor 2)**

Petitioners have acknowledged that a final written decision will occur after the district court trial. *See* Petition, 95 (“While a final written decision in this matter would not occur until after the currently scheduled trial”). The district court issued an Order setting the jury trial date. EX2004. A pretrial hearing is set for August 7, 2023, and a trial date is set for August 28, 2023. EX2004, 5 (entering Scheduling Order on June 1, 2022). As such, the trial in the district court will be completed before the statutory deadline of January 28, 2024 for the Board’s Final Written Decision here. Specifically, the trial will commence five months before any final written decision. As recent as January 19, 2023, a difference of at least four months

has been found to weigh heavily in favor of denying institution. *See Ericsson Inc. et al v. Collision Communications, Inc.*, IPR2022-01233, Paper 12 at 13 (P.T.A.B Jan. 19, 2023) (“Even if we assume trial would not occur until August 2023, that weighs in favor of denying institution, given that we would not expect to issue a final written decision until at least four months later.”). Therefore, factor 2 weighs in favor of exercising discretion to deny institution. *Fintiv*, Paper 11 at 9 (finding factor 2 weighs in favor of exercising discretion to deny institution where the district court’s trial date is earlier than the projected statutory deadline).

There is no reason for the Board to hold proceedings that would duplicate those in the district court (*see Fintiv* factor 4 below) and that would take longer to complete. Indeed, as discussed herein, there are reasons for the Board ***not*** to hold such proceedings.

**iii. The substantial investment in the parallel proceeding by the court and the parties favors institution denial (*Fintiv* factor 3)**

Factor 3 also weighs in favor of discretionary denial because substantial resources have already been expended in the district court case. *Fintiv*, Paper 11 at 11. This factor further supports exercising discretion to deny institution because the district court has already issued at least one substantive order—a claim construction order—related to the ’854 Patent. *Id.*, 9-10.

The parties have exchanged detailed infringement and invalidity contentions. *See, e.g.*, EX2005. Claim construction has already been completed. By the time of the Board's institution decision, the district court will have already expended substantial resources to gain familiarity with the patent, patent claims, and file history.

General fact discovery has been underway. All remaining fact discovery will be completed and expert discovery will be underway by the statutory deadline for institution. EX2004, 4. Given the completion of *Markman* proceedings, as well as the parties' investment in infringement and invalidity contentions, the level of investment and effort already expended favors discretionary denial in this case. *See Apple, Inc. v. Fintiv, Inc.*, IPR2020-0019 (P.T.A.B. May 13, 2020) Paper 15 at 14 (informative) (finding denial favored under factor 3 where *Markman* order had been issued and fact discovery was in its early stages).

Patent Owner further notes that Petitioner delayed filing this petition for more than eleven months after the initial filing of the district court litigation. Specifically, the district court litigation was initiated on November 16, 2021 and this petition was not filed until November 2, 2022. *See* Paper 6, 1. As such, this factor weighs decidedly in favor of discretionary denial. *See Ericsson*, Paper 12 at 15.

**iv. The overlap of issues raised in the Petition favors institution denial (*Fintiv* factor 4)**

All of the issues raised in the Petition are already presented, and are already being litigated, between the same parties in the United States District Court for the Western District of Texas in Case No. 6:21-cv-01187. Because this proceeding involves complete overlap of the substantive issues to be decided in the parallel district court case, factor 4 favors discretionary denial, as detailed further below.

Petitioners purport to consent to a full *Sotera* stipulation. In an attempt to clarify such consent, Petitioners actually provide an even broader unconditional stipulation stating:

*...Petitioner will not pursue in the parallel district court litigation or other parallel proceedings the same grounds as raised in this Petition or any grounds that Petitioner could have reasonably raised before the PTAB.* To re-iterate, Petitioner agrees to not pursue any of the same grounds raised in this Petition, any grounds raised within Petitioner's invalidity contentions, or any grounds Petitioner could have reasonably raised before the PTAB in the parallel district court litigation or any other parallel proceeding.

Petition, 96 (emphasis in original). Unlike *Sotera*, the clear language of this stipulation does not include any conditions, particularly the condition of "if IPR is instituted". See *Sotera Wireless, Inc. v. Masimo Corp.*, No. IPR2020-01019, Paper 12 at 17 (P.T.A.B. Dec. 1, 2020) (precedential, designated Dec. 17, 2020).



Furthermore, the clear language does state “any grounds raised within Petitioner’s invalidity contentions,” in reference to Petitioners’ final invalidity contentions filed in the district court litigation. Yet, to date, Petitioners have taken no action to withdraw any invalidity contentions or file Petitioners’ stipulation in the parallel district court litigation. *See Sotera* at 13 (“Petitioner filed a stipulation in the District Court.”). As such, it is unclear to what extent Petitioners intend to honor this broad unconditional stipulation.

Without any action on the part of Petitioners to effect Petitioners’ stipulation in the district court litigation, such stipulation should be ignored (as Petitioners have so far done). And without any stipulation, factor 4 favors discretionary denial.

**v. The petitioner and the defendant are the same party  
(*Fintiv* factor 5)**

Petitioners are the defendants in the parallel litigation, and Patent Owner, ALSI Holdings, LLC., is the plaintiff. EX2004. Thus, factor 5 also weighs in favor of denying institution. *Fintiv*, Paper 11, 13-14.

**vi. Discretionary denial is appropriate where, as here, merits  
of the grounds are lacking (*Fintiv* factor 6)**

Contrary to Petitioners’ assertions, the merits of the grounds are exceptionally weak. As discussed above, Petitioners provide no support or explanation for whether any of Petitioners’ cited references are prior art. To the contrary, Patent Owner has shown above that at least one reference is not prior art and the corresponding

Grounds must fail as a matter of law. In addition, where Petitioners' Grounds do rely on prior art, Patent Owner has clearly shown that the prior art fails to render obvious any of the claims of the '854 Patent.

Accordingly, Patent Owner respectfully requests that the Board apply its discretion to deny institution here.

**VII. DISCRETIONARY DENIAL IS WARRANTED UNDER SECTION 325(d)**

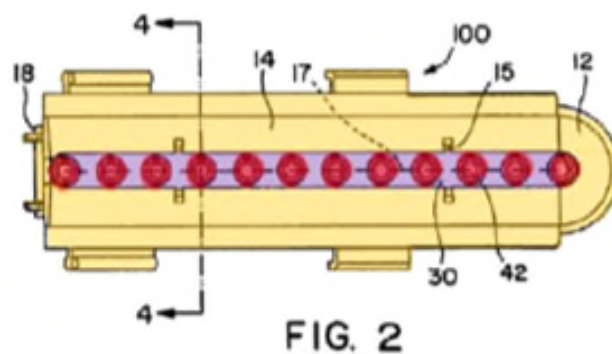
Under 35 U.S.C. §325(d), the Board has discretion to “reject the [IPR] petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” This discretion “involves a balance between several competing interests,” including “the interests in conserving the resources of the Office and granting patent owners repose on issues and prior art that have been considered previously.” *Hospira, Inc. v. Genentech, Inc.*, IPR2017-00739, Paper 16 at 18 (P.T.A.B. July 27, 2017) (“Informative”). In this respect 37 C.F.R. §42.1 sets forth the PTO’s intention “to secure the just speedy, and inexpensive resolution of every proceeding.”

Petitioners have not provided any indication that the relied on references are any different than the prior art previously considered by the Office nor that the arguments presented in the Petition are any different than those previously presented to the Office. *See Vovomart*, Paper 14 at 7, 13. Petitioners also have not provided

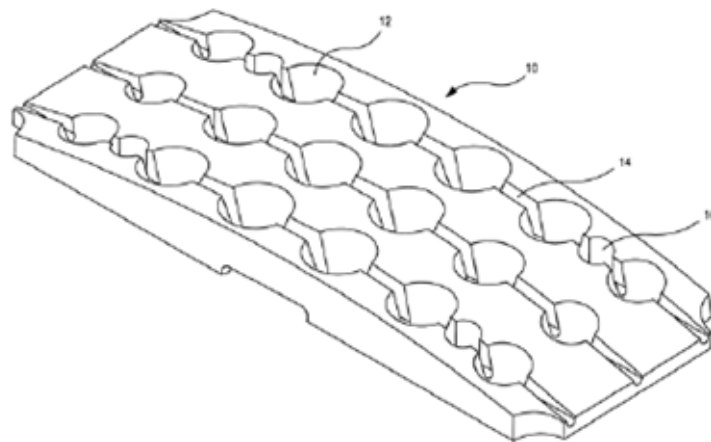
any indication that the Office erred in a material manner. *See id.*, Paper 14 at 7, 14. The two-part framework of *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, 7-9 (P.T.A.B. Feb. 13, 2020) weighs in favor of discretionary denial.

**A. The Same or Substantially the Same Art and Arguments Were Presented to the Office**

As presented in the Petition, Stopa discloses a parabolic reflector as shown in the figure below from the Petition.



Petition, 8. Similarly, Stopa II discloses a conical reflector as shown in the figure below from the Petition.



Petition, 9.

However, the parabolic and conical reflectors of Stopa and Stopa II are nothing different from and are cumulative to the reflectors of Smith. The below figure from Smith was reproduced in at least two Office Action Responses during prosecution of the '854 Patent.

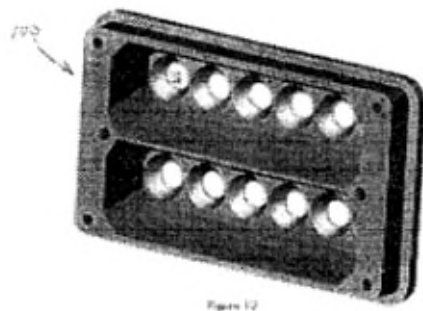


FIG. 12 of Smith

*See* EX1002, 302, 357 (citing EX1009, FIG. 12).

As clearly shown, Ground 1 based on Stopa and Stopa II has already been presented to and considered by the Office. Petitioners do not direct the Board to any

material differences between Stopa and Stopa II or Smith. As such, Stopa and Stopa II are substantially the same as Smith.

Ground 2 is based on a combination of Medendorp and Baar. However, as discussed above, Medendorp was considered by the Examiner during prosecution of the '854 Patent. *See* EX1002, 135. More specifically, Medendorp is listed on the face of the '854 Patent and is presumed to have been fully considered by the Examiner. *See* 37 C.F.R. §1.106(b); *see also* *Vovomart*, Paper 14 at 14. And while Baar was not included in the IDS filed April 23, 2013 or specifically considered by the Examiner, at least one reference, U.S. Patent No. 7,275,841 to Kelly ("Kelly"), contains a similar disclosure to Baar, was included in the IDS, and is presumed to have been fully considered based on being listed on the face of the '854 Patent. *See id.*; *see also* EX1002, 131. Petitioners do not direct the Board to any material differences between Baar and Kelly or any other art previously considered by the Office. As such, Medendorp and Baar are substantially the same as previously considered art and Ground 2 was previously presented to and considered by the Office.

Ground 3 is based on a combination of Brown and Stopa. As discussed above, Stopa is cumulative art to Smith, which formed the basis of multiple rejections. Similarly, Brown's disclosure is similar and cumulative to other references, including Medendorp, Baar, and Kelly. Petitioners do not direct the Board to any

material differences between Brown and Stopa or the other previously considered references. As such, Brown and Stopa are substantially the same as previously considered art and Ground 3 was previously presented to and considered by the Office.

**B. The Office Did Not Err in a Material Manner**

Petitioners do not claim that the Office erred in a material manner. *See Vovomart*, Paper 14 at 14 (“Indeed, Petitioner makes no argument in the Petition directed specifically to Section 325(d).... Thus, Petitioner does not explicitly assert any material error was made by the Office during prosecution of the ’367 patent and does not otherwise explain how the Examiner erred.”). To the contrary, Petitioners point to the fact that the Examiner maintained a total of five rejections based on Smith. *See* Petition, 6. *Advanced Bionics* states that “[i]f reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.” *Advanced Bionics*, Paper 6 at 9. As such, the Office did not err.

As clearly shown here, substantially the same art and arguments were presented during examination, considered by the Examiner, and ultimately found not to render the claims unpatentable. Furthermore, no error has been identified in relation to the Examiner’s examination of the challenged claims. Petitioners provide no explanation as to why the Board should reanalyze the same art and arguments

considered during prosecution. *See Unified Patents Inc. v. Berman*, IPR2016-01571, Paper 10 at 11-12 (P.T.A.B. Dec. 4, 2016) (“Petitioner fails to present any argument distinguishing the examiner’s prior consideration of [other prior art] or to provide a compelling reason why we should readjudicate substantially the same prior art and arguments ...”).

For the foregoing reasons, the Board should exercise its discretion to deny institution under §325(d).

### **VIII. CONCLUSION**

For the reasons set forth above, Petitioner has not demonstrated a reasonable likelihood of success on its obviousness argument for any claim in the ’854 Patent. Accordingly, the petition should be denied.

Dated: February 9, 2023

Respectfully submitted,

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**CERTIFICATE OF COMPLIANCE**

Pursuant to 37 C.F.R. §42.24(d), I hereby certify that the foregoing PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR INTER PARTES REVIEW OF U.S. PAT. NO. 9,699,854 contains 10,256 words, excluding the parts of the petition exempted by 37 C.F.R. §42.24(a), as measured by the word-processing system used to prepare this paper.

Dated: February 9, 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 RESPONSE TO PETITION FOR INTER PARTES REVIEW OF U.S. PAT. NO. 9,699,854 is being served electronically via e-mail on February 9, 2023, in its entirety on the following counsel of record for Petitioners:

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