

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.

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

Case No.: IPR2023-00125

PETITIONERS' PRELIMINARY REPLY

Updated List of Exhibits

Exhibit No.	Description	Identifier
1001	USPN 9,699,854	'854 Patent
1002	The '854 Patent File History	'854 File History
1003	Declaration of Dr. Jack Josefowicz	
1004	Curriculum Vitae of Dr. Jack Josefowicz	
1005	USPN 8,322,881	
1006	U.S. Provisional App. No. 61/094,571	'571 Provisional
1007	U.S. Provisional App. No. 61/094,558	'558 Provisional
1008	U.S. Provisional App. No. 61/015,713	'713 Provisional
1009	U.S. Patent App. No. 2005/0111220	Smith
1010	U.S. Provisional App. No. 60/960,473	'473 Provisional
1011	U.S. Patent No. 223,898	
1012	How the Energy Independence and Security Act of 2007 Affects Light Bulbs _ US EPA - https://www.epa.gov/mercury/how-energy-independence-and-security-act-2007-affects-light-bulbs#:~:text=Basics%20of%20the%20Energy%20Independence,that%20are%20not%20energy%20efficient	
1013	Recycling and Disposal of CFLs and Other Bulbs that Contain Mercury _ US EPA - https://www.epa.gov/cfl/recycling-and-disposal-cfls-and-other-bulbs-contain-mercury	
1014	Disposal of Fluorescent Light Ballasts (FLB) _ US EPA - https://www.epa.gov/pcbs/disposal-fluorescent-light-ballasts-flb	
1015	Nakamura, <i>The Roles of Structural Imperfections in InGaN-Based Blue Light-Emitting Diodes and Laser Diodes</i> , Science Magazine, Vol. 281, pp. 956-961 at 956-957 (August 14, 1998)	Nakamura
1016	Nakada et. al., <i>Improved Characteristics of InGaN Multiple-Quantum-Well Light-Emitting Diode by GaN/AlGaIn distributed Reflector Grown on Sapphire</i> , Applied Physics Letters, Vol. 76, No. 14, pp. 1804-1806 (April 3, 2000)	Nakada

Exhibit No.	Description	Identifier
1017	USPN 5,578,839	
1018	Nakamura et al., “ <i>Candela-Class High-Brightness InGaN/AlGaN Double-Heterostructure Blue-Light-Emitting Diodes</i> ,” Appl. Phys. Lett. 64, pp. 1687-1689 (1994)	
1019	Mueller-Mach et al., <i>Highly efficient all-nitride phosphor-converted white light emitting diode</i> , Physica Status Solidi (A) Applications and Materials, Vol. 202, Issue 9, pp. 1727-1732 at 1728 (June 6, 2005)	
1020	USPN 7,223,998	
1021	USPN 7,405,093	
1022	U.S. Patent Publication No. 2008/0089069	Medendorp
1023	USPN 5,857,767	
1024	USPN 7,144,135	
1025	USPN 2,422,378	
1026	USPN 3,123,308	Franck
1027	USPN 4,041,306	Compton
1028	USPN 7,144,135	
1029	USPN 2,908,197	
1030	Michael Gauvin et al., “Multi-CPU architecture speeds ray tracing,” https://www.laserfocusworld.com/software-accessories/software/article/16553028/multicpu-architecture-speeds-ray-tracing	
1031	National Lighting Product Information Program, Parking Lot and Area Luminaires, Vol. 9(1) (2004)	
1032	Final Claim Construction - ALSI Holdings, LLC v. Current Lighting Solutions, LLC d/b/a GE Current, 6:21-cv-1187	
1033	IES Standard for Roadway Lighting, RP-8-00 (2005)	
1034	IES Standard for Roadway Lighting, RP-8-14 (2014)	
1035	ALSI infringement contentions for the '854 Patent	
1036	U.S. Patent Pub. No. 2007/0121343	Brown
1037	USPN 6,257,735	Baar
1038	USPN 6,641,284	Stopa

Exhibit No.	Description	Identifier
1039	Lumen (unit) – McGraw Hill Dictionary of Scientific and Technical Terms	
1040	USPN 7,198,386	
1041	U.S. Patent App. No. 2007/0002565	Han
1042	USPN 7,766,508	
1043	USPN 7,847,486	
1044	USPN 7,648,257	Villard
1045	USPN 6,318,886	Stopa II
1046	ALSI v. Current Lighting et al., DN50 – Scheduling Order	Scheduling Order
1047 NEW	Notice of <i>Sotera</i> Stipulation, ALSI v. Current Lighting et al., Case No. 6:21-cv-01187-ADA (W.D. Texas) (DN 99)	

The Medendorp publication (US 2008/0089069 A1) is prior art to challenged U.S. Patent No. 9,699,854 (“the ’854 Patent”) under 35 U.S.C. § 102(e). Petitioners identified Medendorp as prior art under 35 U.S.C. § 102. (Pet. at 2.) Medendorp lists only two dates applicable for determining its status as prior art – a publication date of April 17, 2008 and a filing date of October 11, 2006. (Ex. 1022.)¹

While the ’854 Patent claims priority to three provisional applications, the earliest priority date stated is the December 21, 2007 filing date of Provisional Application No. 61/015,713. (Ex. 1001 at 1; Ex. 1008.) Patent Owner contends the challenged claims of the ’854 Patent should be afforded this December 2007 priority date. (Ex. 1035 at C1.) For the purpose of this proceeding, Petitioners are not contesting the December 21, 2007 priority date for the challenged claims.

Per the MPEP: “Under pre-AIA 35 U.S.C. 102(e)(1) ... a U.S. patent application publication under 35 U.S.C. 122(b) is considered to be prior art as of the earliest effective U.S. filing date of the published application.” MPEP § 901.03. “Pre-AIA 35 U.S.C. 102(e) is mostly utilized when the publication or issue date is too recent for the reference to be applied under pre-AIA 35 U.S.C. 102(a) or pre-AIA 35 U.S.C. 102(b).” MPEP § 2136.

Since Petitioners are not disputing the December 21, 2007 priority date in this

¹ Both dates listed are self-authenticating. F.R.E. § 902(1), (4) & (5).

proceeding, they were relying on Medendorp's October 11, 2006 filing date to qualify the reference as prior art under 35 U.S.C. § 102. Medendorp is therefore § 102(e) prior art as "an application for patent [11/548,357], published under section 122(b) [US 2008/0089069 A1], by another [Nicholas W. Medendorp] filed in the United States [October 11, 2006] before the invention [December 21, 2007] by the applicant for patent [James J. Wassel]." 35 U.S.C. § 102(e).

In discussing the prior art "status" of Medendorp, Petitioners' Declarant expressly relied on Medendorp's October 11, 2006 filing date to determine Medendorp was prior art under 35 U.S.C. § 102. (Ex. 1003 at ¶99.) Thus, Petitioners' Declarant provided additional notice to Patent Owner that Petitioners were relying on Medendorp's October 11, 2006 filing date.

Medendorp is therefore being used as prior art under § 102(e) to render the challenged claims unpatentable.

Respectfully submitted,

Dated: March 21, 2023

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Certificate of Service

The undersigned hereby certifies that on March 21, 2023, a complete and entire copy of **PETITIONERS' PRELIMINARY REPLY and EXHIBIT 1047**, was served via electronic mail by serving the correspondence email address of record as follows:

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Certificate of Compliance Pursuant to 37 C.F.R. § 42.24

This paper complies with the type-volume limitation of 37 C.F.R. § 42.24. The paper contains 385 words, excluding the parts of the paper exempted by §42.24(a).

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