

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JIAWEI TECHNOLOGY (HK) LTD., JIAWEI TECHNOLOGY (USA) LTD.,
SHENZHEN JIAWEI PHOTOVOLTAIC LIGHTING CO., LTD., ATICO
INTERNATIONAL (ASIA) LTD., ATICO INTERNATIONAL USA, INC.,
CHIEN LUEN INDUSTRIES CO., LTD., INC. (CHIEN LUEN FLORIDA),
CHIEN LUEN INDUSTRIES CO., LTD., INC. (CHIEN LUEN CHINA),
COLEMAN CABLE, LLC, NATURE'S MARK, RITE AID CORP., SMART
SOLAR, INC., AND TEST RITE PRODUCTS CORP.,
Petitioner,

v.

SIMON NICHOLAS RICHMOND,
Patent Owner.

IPR2014-00937
Patent 8,362,700 B2

Before WILLIAM V. SAINDON, JUSTIN T. ARBES, and
BARRY L. GROSSMAN, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*.

DECISION
Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Petitioner filed a revised petition to institute an *inter partes* review of claims 1–11, 13–15, 24–34, and 45–47 of U.S. Patent No. 8,362,700 B2 (Ex. 1001, “the ’700 patent”). Paper 14, 1. We denied institution of *inter partes* review of all challenged claims. Paper 22 (“Decision” or “Dec.”). Our denial of review these claims was premised on Petitioner’s failure to offer a construction and analysis of a term critical to understanding the scope of independent claims 1 and 45–47, “color changing cycle,” and consequent failure to meet its burden under 37 C.F.R. § 42.104(b)(3)–(5). Dec. 7–8, 9–10. In its Request for Rehearing (Paper 23, “Req. Reh’g”), Petitioner now offers new arguments, not found in its Petition, directed to a “color changing cycle.” For this, and other reasons expressed below, we deny Petitioner’s request and do not modify our Decision.

II. DISCUSSION

A. *Applicable Standards of Review*

An *inter partes* review may be instituted if it is determined that there is a “reasonable likelihood that the petitioner would prevail.” 35 U.S.C. § 314(a). When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). In pertinent part, 37 C.F.R. § 42.71(d) states:

The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

B. Summary of Our Prior Decision

In general, each of the challenged independent claims of the '700 patent recites a lighting device that produces light of varying color. In our Decision, we noted that Petitioner failed to construe the term “color changing cycle.” *Id.* at 7, 9. Indeed, we noted that Petitioner provided no cogent discussion of “color changing cycle” or how the limitation is taught or suggested by the cited prior art. Instead, Petitioner merely provided citations in a claim chart. Finding no discernable discussion of “color changing cycle” in the prior art or in the Petition, we determined that Petitioner failed to meet its burden to construe the claims and explain how they read on the prior art. *Id.* at 7–8, 10. As a consequence, we denied review of all challenged claims.

C. Petitioner’s Contentions

Petitioner requests that a particular member of this three-judge panel serve as authoring judge. *See* Req. Reh’g at 1, n.1. This request is improper. Judges in this proceeding are assigned according to Standard Operating Procedure 1 (rev. 13, 2009) (available at www.uspto.gov).

Petitioner contends that the Petition “defined” the term “color changing cycle.” *Id.* at 2. Petitioner likewise contends that we should have “analyze[d] the petition’s express definition of the plain meaning of ‘color changing cycle.’” *Id.* at 2–3 (citing to pages 21–22, 42, and 53 of the Petition). Petitioner provided no such definition, however. Page 42 of the Petition contains a mere repetition of the claim language. Pages 21–22 and 53 of the Petition are simply claim charts, which do not explain how the claim terms read on the prior art.¹ Further, Petitioner’s

¹ If the claim charts did include any discussion as to how the claim term was to be construed, they would have been rejected as improper. *See* Paper 12, 2 (rejecting Petitioner’s first Petition as improper for containing arguments in the claim charts).

purported interpretation of “color changing cycle”—“ramp up and down the intensity of the light emitted over time by said at least two light sources”—merely repeats the language in claims 1 and 46 preceding “color changing cycle.” Accordingly, Petitioner does not persuade us we overlooked its “express definition.”

Petitioner next contends that its analysis was “relying on and applying the ordinary and customary meaning” of “color changing cycle,” and argues that it need not construe every term. *Id.* at 3. We agree that a petitioner need not construe explicitly every term, but that is not the issue here. The issue here is whether Petitioner had made a threshold showing in its Petition. Petitioner failed to include any cogent analysis involving the “color changing cycle” claim limitation. Dec. 7–8, 9–10. The only treatment Petitioner gave that claim limitation was to point to portions of the prior art in claim charts. The correspondence between the claim limitation and the things described at the cited portions of Petitioner’s claim chart, however, was unclear. *Id.* Petitioner may not need to provide a claim construction if such correspondence is sufficiently clear, but that was not the case here, and Petitioner failed to explain this insufficiency.

Petitioner then contends that we used a “narrow definition” of “color changing cycle” in our Decision. Req. Reh’g. 9. Likewise, Petitioner contends that the “sole basis” of our Decision to deny *inter partes* review as being based on our purported “narrow definition.” *Id.* at 9–10. Both of these contentions are mischaracterizations of our Decision. Our basis for denying the Petition, as explained in the Decision, was Petitioner’s failure to address properly the “color changing cycle” limitation of each independent claim. Dec. 8 (“It is Petitioner’s burden to explain how the challenged claims are to be construed and how they read

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on the prior art.”); *id.* at 9 (“Petitioner . . . does not provide an explanation of how it reads the ‘color changing cycle’ limitation on Richmond.”).

Petitioner now attempts to provide a late explanation for how the prior art describes the “color changing cycle” limitation (*id.* at 4–9) and disputes our analysis of the prior art in the Decision (*id.* at 9–13). Petitioner’s late explanation is a new argument; we could not have overlooked arguments we had not seen in the Petition. Likewise, Petitioner’s complaints about our analysis do not undo Petitioner’s failure to address the claim language in the Petition. We have reviewed our Decision and are not persuaded to modify it.

III. CONCLUSION

For the foregoing reasons, Petitioner has not shown that we abused our discretion by not instituting *inter partes* review of the ’700 patent.

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