

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MAXLITE, INC.,
Petitioner,

v.

JIAXING SUPER LIGHTING ELECTRIC APPLIANCE CO., LTD.,
Patent Owner.

IPR2020-00181
Patent 9,723,662 B2

Before BRYAN F. MOORE, JENNIFER S. BISK, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

A. Background

MaxLite, Inc. ("Petitioner") filed a Petition requesting *inter partes* review of claims 1, 2, 5–7, 9, 10, 15–18, 21, 23, 24, 29–32, 34–39, 41, and

42 (the “challenged claims”) of U.S. Patent No. 9,723,662 B2 (Ex. 1001, the “’662 patent”). Paper 1 (“Pet.”). Jiaxing Super Lighting Electric Appliance Co., Ltd. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). We denied institution on all grounds on May 26, 2020. Paper 7 (“the Decision”, “Decision Denying Institution”, “Inst. Dec.”).

Petitioner filed a Request for Rehearing in which Petitioner argues that the Decision overlooks certain matters in denying review of the challenged claims regarding the anticipation by Zhang and OSRAM respectively. Paper 8 (“Rehearing Request”, “Reh’g Req.”). For the reasons set forth below, the Request for Rehearing is *denied*.

II. ANALYSIS

When considering a request for rehearing, we review the Decision for an abuse of discretion. 37 C.F.R. § 42.71(c). The party requesting rehearing bears the burden of showing that the Decision should be modified, and “[t]he request must specifically identify all matters the party believes [we] misapprehended or overlooked.” 37 C.F.R. § 42.71(d).

Petitioner argues that we 1) misapprehended and overlooked that the Petition relies on Figure 18A for its anticipation theory and that the Petition did not rely on Figures 7, 10, and 14, and the Figure 18A alone discloses the claimed “pre-heat process,” 2) incorrectly found Petitioner had not shown the claimed “rectifier” in ground 2, and 3) misconstrued the “filter” limitation. Req. Reh’g 2–12. We disagree because the Decision Denying Institution relies on Petitioner’s ground 1 anticipation theory as presented in the Petition and Petitioner did not present a theory that Figure 18A alone practiced the claimed “pre-heat process” nor did it argue, outside of Figures 7 and 10, that the claimed “pre-heat process” was not required to be shown.

Additionally, we did not misconstrue Petitioner's contention regarding the "rectifier" limitation. Finally, because the "rectifier" limitation is found in all claims challenged by OSRAM in ground 2, failure to show the "rectifier" limitation is sufficient to deny institution.

A. Petitioner's Alleged Reliance on Figure 18A Alone

1. New Claim Construction

In the Decision, we determined "Petitioner [had] not explained sufficiently [in the Petition] that Figures 2, 7, 10, 14, 18, and 18A are compatible embodiments such that they teach the limitations [particularly the pre-heat limitation] of claim 1 arranged in the same way as the '662 patent without the need to pick and choose disparate disclosures." Inst. Dec. 12. Claim 1 recites "each of the first bi-pin terminal and the second bi-pin terminal configured to allow a current to flow from one pin to the other pin via the filament-simulating circuit during a *pre-heat process* executed by a ballast," (hereinafter "the pre-heat limitation," or "the pre-heating limitation"). Ex. 1001, 6:29–33 (emphasis added). On rehearing, Petitioner puts forth a construction for the pre-heat limitation, arguing "based on the claim language itself, the pre-heat limitation merely adds the requirement that the filament-simulating circuit be configured in a particular way, i.e. 'to allow current to flow from one pin to the other via the filament simulating circuit,' when a particular condition placed upon it, i.e. 'during a pre-heat process executed by a ballast.'" Reh'g Req. 3–4. Nevertheless, Petitioner could have, but did not, put forth such a construction in its Petition. See 37 C.F.R. § 42.104(b). Thus, to the extent Petitioner attempts to clarify the plain and ordinary meaning of the limitation above in the Request for Rehearing, Petitioner's arguments come too late.

It is Petitioner's burden to explain how challenged claims are to be construed and how the claims read on the prior art. 37 C.F.R. § 42.104(b)(3)–(5). Petitioner did not propose construing the pre-heat limitation explicitly in the Petition. *See* Paper 1. Nor did Petitioner seek leave to file a reply to the arguments by Patent Owner in its Preliminary Response. Instead, Petitioner's arguments have been raised in the Request for Rehearing for the first time. We could not have misapprehended or overlooked evidence that was not presented by Petitioner in the context of the limitation at issue.

Additionally, Petitioner did not argue that the pre-heat process was simply a “condition” placed on the filament-stimulating circuit in its analysis in the Petition. To the contrary, the way Petitioner presented its contentions showed that the Petition treated the pre-heat process as limiting. Petitioner argued that the ballast described in Figures 7 and 10 were “*necessarily* used in ballasts that have a pre-heat starting mode.” Pet. 26 (emphasis added). Additionally, Petitioner argued Zhang “discloses a configuration with a ballast *using* a pre-heat process.” *Id.* at 27 (emphasis added). Additionally, Petitioner argued that if Zhang was not shown to explicitly teach pre-heating, it was inherent—i.e., Petitioner asserts, in an alternative, that “the pre-heat process is *necessarily* present.” *Id.* at 27 n. 2 (emphasis added). We considered and rejected Petitioner's contentions based on these assertions. Inst. Dec. 10–12.

The Petition guides the proceeding. *See Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1335–36 (Fed. Cir. 2020). Our reviewing court explains that “Congress chose to structure a process in which it's the petitioner, ... who gets to define the contours of the proceeding,” and that

“the statute envisions that a petitioner will seek an *inter partes* review of a particular kind—one guided by a petition describing each claim challenged and the ground on which the challenge to each claim is based.” *Id.* at 1335 (quoting *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018) (internal quotations omitted)). “Although the Board is not limited by the exact language of the petition, *see, e.g., Sirona Dental Sys. GmbH v. Institut Straumann AG*, 892 F.3d 1349, 1356 (Fed. Cir. 2018), “the Board does not ‘enjoy[] a license to depart from the petition and institute a *different* *inter partes* review of his own design.’” *Id.* at 1336 (quoting *SAS*, 138 S. Ct. at 1356).

Petitioner chose to present evidence that the pre-heat process occurred in Zhang rather than simply *could* occur based on the configuration of the system. Patent Owner was then on notice of that contention and relied on that contention to draft its Preliminary Response. *See generally* Prelim. Resp. Rehearing is not an opportunity for Petitioner to recast its Petition.

2. Petitioner’s Contention is Recast under New Claim Construction

On rehearing, Petitioner attempts to recast the Petition as presenting a contention as to claim 1 in line with its new claim construction—one in which pre-heating was a “condition” not required to be shown. Reh’g Req. 4–6. To this end, Petitioner asserts in its Rehearing Request that the first three paragraphs of the Petition’s contention regarding the pre-heat limitation (“the three paragraphs”) are sufficient to show Zhang meets the claim language under its new construction presented in the Rehearing Request. *Id.* According to the Rehearing Request, the Petition, in the first paragraph, provides an annotated version of Figure 18A that “considers

whether the claimed filament-simulating circuit is configured as required by the claim.” *Id.* at 5. The Rehearing Request then asserts that in the second paragraph (and in part of the first paragraph) the Petition explains why the filament simulating circuit is needed for the pre-heat process. *Id.* Finally, according to the Rehearing Request, the third paragraph examines the impedances in Zhang in view of Figure 18A “including that the lamp two bi-pin connectors support that it is configured as required by the pre-heat limitation.” *Id.* at 6.

Thus, the Rehearing Request focuses on the part of the Petition that does not discuss Figures 7 and 10 and asserts that this part of the Petition shows that the configuration of Zhang is in line with the configuration required by the claim. As explained above, Petitioner did not argue such a claim construction in the Petition. Thus, the discussion of the three paragraphs does not change the Decision’s outcome because this discussion does not purport that these paragraphs alone (without the discussion of Figures 7 and 10 in the Petition) show that Zhang discloses a pre-heat process as would be required under the claim construction set forth in the Petition. Thus, this part of the Rehearing Request does not persuade us that we misapprehended Petitioner’s contentions.

*3. Allegedly “Only Relying” on the Teaching of the
Filament Simulating Circuit in Figures 7 and 10*

As to the Petition’s discussion of Figures 7 and 10, the Rehearing Request asserts “[t]he Petition makes clear that Petitioner is not relying on the configuration of the filament-simulating circuits of Figures 7 and 10; it is only relying on the teaching of a filament simulating circuit that ‘include[s] a resistor R1 coupled in parallel with the capacitor C1.’” Pet. 25. We

disagree. Other than a quotation from Zhang, the Petition simply states “[f]urther, in connection with Figures 7 and 10, which disclose parallel resistor/capacitor embodiments of the filament-imitating impedance that are equivalent to the filament-imitating impedance of Figure 18, Zhang discloses the following [then quotes Zhang].” Pet. 25–26 (citing Ex. 1005, 6:19–30, 7:17–25¹; Ex. 1003 ¶ 64).

Thus, the Petition does not suggest that Petitioner is “only relying” on the teaching of the filament simulating circuit in Figures 7 and 10 but rather asserts that the impedances in Figures 7 and 10 are equivalent to those of Figure 18A citing Petitioner’s declarant’s testimony. Pet. 25–26. The cited paragraph of Petitioner’s declarant’s testimony similarly states “Figures 7 and 10 disclose an embodiment of the filament-imitating impedance with a resistor and a capacitor in parallel, equivalent to the embodiment of Figure 18.” Ex. 1003 ¶ 64. Thus, we are not persuaded the Petition made clear that Petitioner was “only relying on the teaching of a filament simulating circuit that includes a resistor R1 coupled in parallel with the capacitor C1.” Reh’g Req. 7.

The Decision addresses the contention presented in the Petition that “the filament-imitating impedance [of Figures 7 and 10] are equivalent to the filament-imitating impedance of Figure 18.” For example, the Decision states this assertion of “equivalence” is not explained. We stated in the Decision that “Petitioner does not ‘address the structural differences between the identified filament-imitating impedances of the various figures, such as

¹ The Petition appears to have a typographic error. After a quotation from Zhang, the Petition cites to “Ex. 1001” which is the challenged patent instead of “Ex. 1005” which is Zhang.

Figure 7 and 10 containing a single resistor and capacitor whereas Figure 18 contains two resistors and two capacitors, as well as the different arrangement of those components in each figure relative to the ballast connection ports.” Inst. Dec. 11 (quoting Prelim. Resp. 10–11). On rehearing, Petitioner does not address this determination by the Board; rather, Petitioner asserts, for the first time on rehearing, it is relying on only specific parts of Figures 7 and 10.

In the Decision we addressed the contentions, as to Figures 7 and 10, as presented in the Petition, and explained they were not persuasive. Inst. Dec. 10–11. *See Nestlé Purina Petcare Co. v. Oil-Dri Corp. of Amer.*, Case IPR2015–00737, Paper 39 at 8 (PTAB Feb. 9, 2017) (Rehearing Decision) (“Merely disagreeing with our analysis or conclusions does not serve as a proper basis for a request for rehearing.”). As to Petitioner’s position that it is relying on only specific parts of Figures 7 and 10, as explained above, we disagree that the Petition stated this alleged position. Thus, it is inappropriate to submit new arguments and/or new evidence with a request for rehearing. *See* 37 C.F.R. § 42.71(d).

4. Figure 7 and 10 Allegedly Only “Further Evidence”

Petitioner also asserts “the Petition’s reliance on those particular passages [regarding Figures 7 and 10] provides further evidence as to what Figure 18A discloses.” Reh’g Req. 8. Thus, Petitioner appears to suggest Figures 7 and 10 are unnecessary to its contention and are only “further evidence.” As explained above, we are not persuaded that is the case.

To the extent that Petitioner’s statement is meant to argue that Figures 7 and 10 *literally* show what Figure 18A discloses, Petitioner needed to explain how and why that is so. Although Petitioner points out similarities

between the figures at issue, Petitioner has not *explained* adequately how embodiments of Figure 18 and Figures 7 and 10 are combined in Zhang such that they could be considered together in an anticipation analysis. *Compare NetMoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (stating in order to establish anticipation, “it is not enough that the prior art reference ... include multiple, distinct teachings that the artisan might somehow combine to achieve the claimed invention”) *with WM. Wrigley Jr. Co. v. Cadbury Adams USA LLC*, 683 F.3d 1356 (Fed. Cir. 2012) (distinguishing *NetMoneyIN* because, in contrast to the reference in *NetMoneyIN*, which disclosed “two separate payment protocols, each of which contained only a subset of the components claimed in the patent at issue,” the prior art reference in *Wrigley* envisions using the claimed components in a single product). Thus, we are not persuaded by this argument.

In the Rehearing Request, Petitioner attempts to explain why the embodiments in Figures 7 and 10 are consistent with Figure 18A, however, that explanation was not included in the Petition or the testimony of the Petitioner’s declarant. *See* Reh’g Req. 7 n. 2. It is inappropriate to submit new arguments and new evidence with a request for rehearing. *See* 37 C.F.R. § 42.71(d). Thus, for the reasons above, we are not persuaded that we misapprehended Petitioner’s reliance on Figures 7, 10, and 14. Thus, “Petitioner has not explained sufficiently [in the Petition] that Figures 2, 7, 10, 14, 18, and 18A are compatible embodiments such that they teach the limitations of claim 1 arranged in the same way as the ’662 patent without the need to pick and choose disparate disclosures,” as determined in the Decision. Inst. Dec. 12.

5. Zhang’s Figure 14 is Allegedly a “General Description”

Petitioner also argues the “Petition’s citation to Zhang at 8:8-24 is not a description of Figure 14 as the Board implies (Institution Order at 11), but is instead a description of how ‘[s]ome ballasts perform filament test in which a filament is tested.’” Reh’g Req. 8 (quoting Ex. 1005 at 8:8–24). The Rehearing Request continues that “[t]here can be no argument that Figure 14 of Zhang includes a ballast; thus this description in Zhang is a general description of how ballasts work.” *Id.* Nevertheless, the specification states “Figure 14 illustrates [an arrangement of] a filament-imitating impedance . . . [s]uch an arrangement can be used to accommodate such a test.” Thus, the text is not a “general description of how ballasts work,” but a description of a particular arrangement disclosed in Figure 14. Thus, we are not persuaded by this argument.

6. Petitioner Asserts the Board should Reconsider Ground 1 Based Only on Figure 18A

Petitioner also argues that if “the Board [were] to reconsider Ground 1 based only on Figure 18A, it would find that [Petitioner] has met its burden in demonstrating that the pre-heat limitation is met by Zhang.” Reh’g Req. 8. Because we do not determine that we misapprehended Petitioner’s explicit reliance on disparate embodiments in Figures 7 and 10, we do not need to reevaluate its evidence regarding Figure 18A alone. Moreover, as explained above, this argument is premised on Petitioner’s new claim construction, which is not a proper basis for rehearing. *See supra* § II.A.1.

7. Summary

For the reasons above, we are not persuaded that we misapprehended or overlooked anything such that we should grant rehearing as to ground 1.

B. OSRAM's Alleged Disclosure of the Claimed Rectifier

Petitioner argues on rehearing that the “Petition conclusively showed that OSRAM contains a rectifier consisting of the eight diodes D1-D8. Although [Petitioner] grouped these diodes differently than OSRAM, that grouping is irrelevant to the analysis however, because all eight diodes together are identified as the claimed ‘rectifier.’” Reh’g Req. 9–10 (internal citations omitted). Nevertheless, the Decision acknowledged that

Although Petitioner contends “[t]he first and second rectifiers together make up the claimed ‘rectifier’” (Pet. at 61), Petitioner appears to rely on its declarant’s description of two rectifiers to meet the claim language of claim 21. *Id.* at 59–61. Petitioner appears to refer back to its declarant’s recasting of Osram for the “the first and second rectifiers.” *Id.* (citing Ex. 1003 ¶¶ 136–37) (identifying the diodes in Osram that make up the “first” and “second” rectifiers).

Inst. Dec. 16. In other words, we considered whether Petitioner relied on all eight diodes generically and found the Petition explicitly relied on its declarant’s description of two rectifiers. *See* Inst. Dec. 14–16. “In an [*inter partes* review], the petitioner has the burden from the onset to show *with particularity* why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “*with particularity* ... the evidence that supports the grounds for the challenge to each claim”)) (emphasis added).

Based on the Petition’s contents, Patent Owner was on notice as to the two rectifiers and relied on that contention to draft its Preliminary Response. *See generally* Prelim. Resp. Rehearing is not an opportunity for Petitioner to recast its Petition. That is, we cannot consider a new contention as to the

rectifier that was not presented perspicuously in the Petition. A request for rehearing is not merely the opportunity for the requester to reargue positions, elaborate on previous positions, or to disagree with the analysis or conclusions of the panel. *See Nestlé Purina Petcare Co.*, IPR2015–00737, Paper 39 at 8 (“Merely disagreeing with our analysis or conclusions does not serve as a proper basis for a request for rehearing.”).

Petitioner also asserts the Decision “did not consider whether the eight diodes together meet the rectifier limitation. Instead, it considered whether Petitioner demonstrated that four of the eight diodes alone would also meet the limitation.” Reh’g Req. 10 (citing Inst. Dec. 16). However, there was no reason for the Decision to consider such a scenario when it was not presented sufficiently by the Petition. We explicitly state in the Decision that we found that Petitioner relies on “declarant’s description of *two* rectifiers to meet the claim language,” i.e. two rectifiers of four diodes each having a total of eight diodes. Inst. Dec. 16.

Although Patent Owner’s arguments in its Preliminary Response appear to focus on whether four diodes alone would meet the claim language (“Petitioner makes no attempt to show how the four diodes D1, D2, D5, and D6 constitute a rectifier,” Prelim. Resp. 31), Patent Owner’s arguments also focus on one of the two (first and second) rectifiers that the Petition relies on (“Petitioner cannot avail itself of OSRAM’s disclosure of two rectifiers,” Prelim Resp. 32). *See* Prelim. Resp. 31–32; *see also* Pet. 60 (quoting Ex. 1014 [OSRAM], ¶ 2 (“two rectifiers are realized”)). In the Decision, we relied on the fact that the Petition did not explain how its reading of OSRAM, i.e. reordering both groups of four diodes, would meet the claim language. Inst. Dec. 16 (“Petitioner is relying on a reading of Osram that is

quite different than (and arguably inconsistent with) Osram’s express disclosure.”). Thus, the Decision focuses on the sufficiency of the explanation in the Petition rather than whether the Petition recites four or eight diodes.

For the reasons above, we are not persuaded that we misapprehended or overlooked anything such that we should grant rehearing as to ground 2.

C. The Filter Limitation Was Allegedly Misconstrued

Because we determine Petitioner failed to show that OSRAM anticipates claims 21, 23, 24, 30, 36, 37, 39, 41, and 42 (i.e., all of the claims challenged in ground 2) as to the limitation of a “rectifier” we do not need to reach the limitation of “a filter” in those claims. Thus, we are not persuaded that we misapprehended or overlooked anything regarding the limitation to “a filter” that could have changed the result of the Decision.

III. CONCLUSION

The Request for Rehearing does not demonstrate that we misapprehended or overlooked any matters raised in the Petition in declining to institute review that could have changed that result. 35 U.S.C. § 314(a).

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Request for Rehearing is DENIED.

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