

Mixed Bag At PTAB For Light Bulb Co. Challenging LED Patent

By Britain Eakin

Law360 (October 22, 2019, 2:22 PM EDT) -- Feit Electric Company has scored a partial victory in its challenge to a Signify Holding BV patent, with the Patent Trial and Appeal Board invalidating three claims in a patent covering light-emitting diodes as obvious while upholding the validity of two other claims.

The board on Friday determined that one prior art reference, coupled with expert testimony, rendered three claims of the patent obvious. In one case, the board said it was persuaded by Feit Electric's assertion that the reference contains a similar component to something described in the patent at issue.

"Based on the entire trial record, we determine that petitioner has proven that claims 22 and 30 are unpatentable by a preponderance of the evidence," the decision said. The board likewise said that Feit Electric was able to prove that a third challenged claim was unpatentable.

The two claims the board said were not invalid were in means-plus-function format, or written in a way that describes a means for performing a certain function. In trying to prove obviousness, the board said that Feit Electric did not sufficiently explain why a skilled artisan would have been motivated to combine two prior art references.

"We agree with patent owner that, considering the differences in function, structure, and application of the cited art, petitioner has not provided a sufficient obviousness rationale for combining" the references, the decision said.

The board also said that Feit Electric improperly introduced a new rationale of obviousness in its reply, which the decision noted is not allowed according to the Federal Circuit's September ruling in *Henny Penny Corp. v. Frymaster LLC*.

In that opinion, the Federal Circuit said the PTAB rightfully held Henny Penny Corp. to the arguments it raised in its petition challenging a Frymaster patent after determining it had impermissibly raised a new rationale for obviousness in its reply.

The board said here that the reference Feit Electric cited with its new theory "does not adequately support the obviousness rationale stated in the petition."

The patent relates to powering LED arrays in cars. As described in the board's decision, "the invention is

a driver circuit for light emitting diodes ... that use pulse-width modulation," which the board said "purports to overcome the disadvantages of other designs."

Los Angeles-based Feit Electric petitioned the PTAB to review the patent back in April 2018 after Signify Holding, previously known as Philips Lighting Holding BV, asked the International Trade Commission to investigate Feit and a slew of other lighting companies in 2017.

Philips had asked the ITC for a permanent limited exclusion order barring those companies from importing LED power supplies and lighting devices that Signify Holding said infringed five of its patents.

The commission terminated its investigation with respect to the patent at issue here, with an administrative law judge making an initial finding of infringement of five claims of one of the other patents Signify Holding asserted.

The parties petitioned for review of that determination, with the commission ultimately holding on July 23 that Signify Holding had failed to show any violation of Section 337 of the Tariff Act.

This is not the first time the validity of this patent has been before the board. In 2015, Wangs Alliance Corporation challenged four claims of the patent, with the board also returning mixed results in that case.

According to the board's final written decision in the Wangs challenge, the board invalidated two of the four challenged claims as anticipated but upheld the other two, including one of the means-plus-functions claims Feit Electric unsuccessfully challenged here.

Counsel for Feit Electric declined to comment.

Counsel for Signify Holding did not respond to a request for comment.

The patent-in-suit is U.S. Patent No. 6,586,890.

U.S. Patent Trial and Appeal Board Judges Trevor M. Jefferson, Miriam L. Quinn and Jason M. Repko sat on the panel.

Feit Electric Company is represented by Michael D. Specht, Joseph E. Mutschelknaus and Daniel E. Yonan of Sterne Kessler Goldstein & Fox.

Signify Holding is represented by Frank A. DeCosta III and Forrest A. Jones of Finnegan Henderson Farabow Garret & Dunner LLP.

The case is Feit Electric Company Inc. v. Signify Holding BV f/k/a Philips Lighting Holding Inc., case number IPR 2018-00921, at the U.S. Patent Trial and Appeal Board.

--Editing by Jack Karp.