

Filed on behalf of: Signify Holdings B.V.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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LUMINEX INTERNATIONAL COMPANY LTD.,  
and MENARD, INC.,  
Petitioners,

v.

SIGNIFY HOLDINGS B.V.,  
Patent Owner.

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Case IPR2024-00101  
U.S. Patent No. 10,299,336

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**PATENT OWNER'S REQUEST FOR  
DIRECTOR REVIEW OF FINAL WRITTEN DECISION**

## **I. INTRODUCTION**

Pursuant to 37 C.F.R. § 42.71(d), Patent Owner Signify Holdings B.V. (“Signify”) requests Director Review of the Final Written Decision’s (“FWD”, Paper 47) ruling that claims 13 and 15 of U.S. Patent No. 10,299,336 (“336 patent”) are obvious over U.S. Patent No. 7,192,160 (“Reiff”, Ex. 1013).

A stable *inter partes* review system should not produce an unpatentability finding that looks nothing like the Petition that started the proceeding. Here, the Board’s obviousness rationale bears no resemblance to the single unpatentability theory explained in the Petition—an anticipation analysis which the Board agreed with Signify was not supported. To justify adopting an obviousness theory absent from the Petition, the Board cited that the Petition “identified” the challenge based on Reiff as “anticipates under § 102 and/or renders obvious under § 103.” FWD, 145. But mere inclusion of the words “and/or obvious under § 103” should not allow the Board to articulate an unpatentability ground never explained in the Petition. Here, the FWD not only permitted a new theory post-institution, but also manufactured rationales not presented even in Petitioner’s Reply, and placed the burden on Signify to disprove the unarticulated and unsupported challenge.

Accordingly, the FWD presents an important policy issue for the Director—whether any “identification” of a ground that includes the catch-all “and/or obvious § 103” is sufficient (i) to allow a petitioner to later introduce an obviousness theory

absent from the petition and (ii) to allow the Board to supplement the petitioner's belated theory in the FWD. Separate from the policy considerations, the facts of this case also present an abuse of discretion. Signify requests the Director address these issues and reverse the finding of obviousness of claims 13 and 15 in the FWD.

## II. RELEVANT LAW

Director Review of a Board's final decision is warranted if the decision presents "(a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law."<sup>1</sup>

Neither the Board nor the Director "enjoys a license to depart from the petition and institute a *different* inter partes review of his own design." *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 365, 369-70 (2018) (emphasis in original). Instead, "the petition [is] the centerpiece of the proceeding both before and after institution." *Id.* For this reason, 35 U.S.C. § 312(a)(3) requires that an IPR petition "identif[y], in writing and *with particularity*, ... the grounds on which the challenge to each claim is based."<sup>2</sup> Similarly, Rule 42.22(a) requires that a petition "include ... [a] *full statement of the reasons* for the relief requested, including a *detailed explanation* of the significance of the evidence." 37 C.F.R. § 42.22(a).

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<sup>1</sup> <https://www.uspto.gov/patents/ptab/decisions/director-review-process>.

<sup>2</sup> All emphases is added unless otherwise noted.

### III. FACTUAL BACKGROUND

#### A. **Petition**

The Petition contains contradictory “identifications” of the Reiff-based ground. The Table of Contents and the header to the analysis of Reiff do not refer to obviousness, and plainly state: “Ground 3: Claims 13 and 15 Are Anticipated by Reiff.” Pet., iii, 82. The Petition also includes the chart below, numbering its Grounds 1a, 1b, 2 and 3 and identifying the Reiff-based ground as Ground 3:

Ground	Claim(s)	Basis
1a	1, 3, 6-9, 11-13, 15, and 17-19	Chaimberg anticipates under §102 and/or renders obvious under §103
1b	2, 4, 5, 10, 14, 16, and 20	Chaimberg alone or in view of Roberge renders obvious under §103
2	1, 2-5, 7, 9-13, 15, 16, 19, and 20	Halliwell anticipates under §102 and/or renders obvious under §103
3	13 and 15	Reiff anticipates under §102 and/or renders obvious under §103

Petition (“Pet.”, Paper 1), 15.<sup>3</sup> Finally, the text in the body of Ground 3 summarily concludes that claims 13 and 15 are “therefore anticipated by and/or would have been obvious over Reiff.” Pet., 89.

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<sup>3</sup> The Petition devoted 67 of its 75 remaining pages to Grounds 1a, 1b and 2, clearly prioritizing those grounds over Ground 3. Signify established that claims 13, 15 and 16 were entitled to a priority date that rendered the Chaimberg and Halliwell references inapplicable, and leaving only Ground 3 for claims 13 and 15. FWD, 59.

The actual analysis and element-by-element explanation should control. At best, the Petition’s stray references to obviousness over Reiff suggest the use of incorrect boiler-plate language untethered from the actual arguments. Here, the element-by-element explanation for Ground 3 asserts and describes only how each claim element is purportedly “disclosed” by Reiff, with no alternative obviousness analysis. *See* Pet., 84 (“Reiff discloses the preamble of claim 13.”), 86 (“Reiff discloses [element 13b]”), 87 (“Reiff discloses [element 13c]”), 88 (“Reiff discloses [element 13d]”), 89 (dependent claim 15).

Relevant here, claim 13’s preamble and element [13d] pertain to a single luminaire that can switch between light of different CCT (Correlated Color Temperature) values. The concept of CCT describes the “warmth” or “coolness” of white light, and has no applicability to colored light like red or blue. FWD, 141 (citing Int’l Comm. on Illumination (Ex. 2050), 6). Thus, claim 13 is directed toward a luminaire switch to switch between multiple white light sources with different CCTs, ***not*** between white and non-white light sources (*e.g.*, red or blue) which would have no CCT value.

Nevertheless, the Petition asserts that Reiff disclosed this subject matter in its Fig. 2 embodiment (Pet., 84, 88 (citing Ex. 1013, Fig. 2 and 4:28-36)), which describes a luminaire that can switch between two different colored light sources—“a white fluorescent light” and “a ‘colored’ LED light source” (Ex. 1013, 4:28-36).

According to the Petition, Reiff's luminaire emits either a "white light or a specialized light including red or blue 'invisible' light required in some military applications." Ex. 1013, Abstract (cited in Pet., 82, 84). The Petition then reasons that "[e]ach of the light sources emits a different color of light,' thus, each light source emits light at a different CCT." Pet., 84, 88. The Petition's analysis of Reiff is premised entirely on the false assumption that non-white light sources have a CCT value, and nowhere asserts that Reiff suggests a luminaire configured to switch between *two white light sources*.

In addition, claim 13's element [13b] requires a "coupling feature disposed on the body [of a switch] ... configured to electrically couple to an electrical cable." The Petition asserts that Reiff's "control box 64" was the claimed "body" and stated that "[b]ecause the control box 64 is located on the electrical cable 56, it is *necessarily* electrically coupled to electrical cable 56, and *therefore must include* at least one coupling feature." Pet., 86. The Petition failed to address where Reiff's coupling feature was allegedly "disposed" ("on the body" or otherwise). *Id.*, 86-87.

The Petition never acknowledges any aspect of any claim element as missing from Reiff, much less explain with particularity how any differences between Reiff and the claims would have been obvious. The Petition's *only* indications of any obviousness-based theory over Reiff are the stray "identifications" cited by the

Board—which contradict the other “identifications” and the only analysis provided with any “particularity” (*i.e.*, the Petition’s anticipation ground).

## **B. Petitioner’s Reply**

For the preamble and element [13d], Petitioner’s Reply (Paper 35) repeated its anticipation theory that “Reiff Discloses A CCT Switch”—*i.e.*, that Reiff taught switching between white and non-white light sources (*e.g.*, red or blue), and that “light emitted by a red or blue LED *does* have a CCT, which would necessarily be different from a fluorescent white light’s CCT” (original emphasis). Reply, 31-32.

In a single paragraph, the Reply then argues (for the first time) that Reiff also uses the term “color” to refer to “white light, not just monochromatic colors.” Reply, 32-33. Based solely on this observation, the Reply concludes *in one sentence*: “Thus, Reiff’s disclosure of selecting between light sources with different ‘colors’ encompasses selecting between fluorescent light source 30 (white light) and LED light source 32 (also white, though a different color than fluorescent light source 30).” Reply, 33. The Reply ignored the fact that Reiff does not disclose switching between two white light sources in any of its embodiments, and did not cite any expert testimony whatsoever to support this pure attorney argument. *Id.*

For element [13b], the Reply changed its inherency argument (“necessarily” (Pet., 86)) to a theory that a POSA “would have understood” the feature to be present based on evidence not cited in the Petition, and again failed to demonstrate that the

purported coupling feature was “disposed on” any switch body. Reply, 30.

### **C. Final Written Decision**

The FWD’s analysis relied on stray references to “obviousness” and an unarticulated obviousness theory that could not have been predicted by any reasonable reading of the Petition. Indeed, for the preamble and element [13d], the FWD conceded that “Reiff does not discuss CCT” and accepted that Reiff’s Fig. 2 embodiment, relied upon in the Petition, was not sufficient. FWD, 144-45, 154 (“does not disclose every element of claim 13 ‘arranged as in the claim’”). However, the FWD asserted “Petitioner does not advance only an anticipation theory for Reiff and rely only on Reiff’s Figure 2.” FWD, 145. The Board cited to the Petition’s page 15 chart (shown above) “identifying” § 103. *Id.* (citing Pet., 15). According to the Board, Petitioner “argue[d] that claim 13 would have been obvious over Reiff” at pages 84 and 88 of the Petition, and pages 31 and 33 of the Reply. *Id.* None of those pages argue obviousness. *See* Pet., 84 (“Reiff discloses the preamble”); *id.* 88 (“Reiff discloses [element 13d]”); Reply 31 (“Reiff discloses a CCT switch”); *id.* 33 (“Reiff discloses ... selecting between fluorescent light source 30 (white light) and LED light source 32 (also white...)”).

The FWD’s key obviousness conclusion comes on page 144: “Reiff’s disclosures about light fixtures with two different sources of white light and ‘[e]ach of the light sources emit[ting] a different color of light’ teach switching between



different colors of white light, including switching between white light with different CCT values.” FWD, 144. Nothing in the Petition’s Reiff analysis even remotely discusses a light fixture with “two different sources of white light” let alone the concept of “different colors of white light.” Pet., 84-89.<sup>4</sup>

The FWD also went well beyond what Petitioner summarily concluded in Reply. For example, the FWD interpreted Reiff’s claim 2 to find that white is a “color” as used in Reiff, but then extrapolated that Reiff teaches “different colors of white light” even though claim 2 was never cited in the briefing and requires selecting “white” and a “color” *other than* white to meet the claim. FWD, 143-45 (citing Ex. 1013, 7:59-61)). In fact, the FWD relied on several parts of Reiff never cited by either party. *Id.*, 134, 136, 142-45 (citing Ex. 1013, 1:53-55, 1:63-2:16, 2:23-28, 3:20-40, 5:62-6:17, 6:34-35). The FWD also repeatedly relied on Petitioner’s expert testimony that Petitioner did not cite or rely on in Reply. FWD, 142-44 (citing Ex. 1027, ¶¶ 108, 122, 125, 126).

The FWD went even further by determining that a POSA would have been motivated to select two significantly different white light sources, because otherwise

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<sup>4</sup> This is most likely because Reiff does not disclose using two white lights in the same fixture, nor does it ever describe “different colors” of the same “color” light (be it white, red, blue or any other “color” in Reiff).

switching “would produce only an insubstantial change in chromaticity.” FWD, 144. The FWD then placed the burden on Signify to prove otherwise. *Id.* (“Although Patent Owner discusses the possibility that two different light sources of white light could supply light with the same CCT value, Patent Owner does not indicate a reason for doing so when implementing Reiff’s teachings.”).

Regarding element [13b], the FWD stated explicitly that “Petitioner does not establish for § 102 that the ‘at least one first coupling feature’ in Reiff’s switch 66 is ‘disposed on the body’ instead of ‘disposed in the body.’” FWD, 151. Nevertheless, and despite the Petition only arguing that Reiff would “necessarily” have the required coupling feature for anticipation (Pet., 86), the FWD concluded that “Petitioner establishes for § 103 that Reiff teaches limitation 13b.” *Id.*

#### **IV. ARGUMENT**

The FWD’s decision that claims 13 and 15 are obvious over Reiff should be reversed on Director Review for three reasons.

**First**, the mere “identification” of the term “obvious” in a chart purporting to list the grounds of the petition is not sufficient to meet 37 C.F.R. §§ 42.22(a). Neither is a throw-away concluding statement that an entire claim is “and/or obvious under § 103” after arguing only that each element is fully disclosed. Allowing Petitioner to attempt “a detailed explanation of the significance of the evidence” for the first time in Reply (even if the Reply’s single, conclusory sentence still arguing

anticipation could be considered such an attempt here) is an abuse of discretion that the Director should bar as an important matter of policy.

In *Adaptics*, the Board acknowledged that “the Petition asserted ‘If [the applied references] are not anticipatory, [then] the challenged claims are obvious,’” but faulted the petitioner for not specifying “the difference(s) between [the applied references] and the challenged claims.” *Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20 at 20 (PTAB Mar. 6, 2019) (informative). Here, the Petition did even less, and for the same reasons as in *Adaptics*, failed to specify “what [p]etitioner regard[ed] as the difference(s) between [the primary reference(s)] and the challenged claims.” *Id.* at 20 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (requiring that the differences between the prior art and the claims at issue be ascertained as part of an obviousness analysis)).

Instead, the Petition relied upon Reiff’s Fig. 2 embodiment, which allows selection between “a white fluorescent light” and “a ‘colored’ LED light source” (Ex. 1013, 4:28-36) such as “a specialized light including red or blue ‘invisible’ light” (Ex. 1013, Abstract). Pet., 82, 84; *see also* Ex. 1013, 5:62-66 (“fluorescent lamp 30 emitting white light and LEDs 32 emitting red, blue, or UV light”). The Petition’s analysis ignores the fundamental concept (accepted by the FWD) that light other than white light (*e.g.*, red and blue light) does not have a CCT. FWD, 141.

Critically, the Petition lacked any proposal to combine or modify any

embodiment in Reiff to arrive at a luminaire that switched between two white light sources. Pet., 84 (“[e]ach of the light sources emits a different color of light,’ thus, each light source emits light at a different CCT.”); *Graham*, 383 U.S. at 17. By contrast, the Petition’s other grounds asserting single-reference obviousness demonstrate that Petitioner knew such theories required explanation. *See, e.g.*, Pet., 34 (explaining how Chaimberg “does not expressly describe” claim 7’s requirement but that “such an arrangement would have been obvious to a POSA”).

For element [13b], the Reply offered that a “POSA would have understood Reiff’s switch 66 as having coupling features for electrically coupling to ... sections of cable 56 so switch 66 receives” power. Reply, 30. The Petition did not advance any obviousness argument, and instead argued that the feature is “necessarily” present. Pet., 86-87. The Petition failed to address the location of the coupling feature, much less demonstrate it was “disposed on the body.” *Id.* That anticipation argument was found by the Board to be wrong at institution (Inst. Dec., 60-61) and in the FWD (FWD, 151).

Thus, the Board should not have allowed (let alone created) any arguments that claims 13 and 15 were obvious over Reiff, as Petitioner chose not to include any in the Petition (or even, arguably, in Reply). *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 775 (Fed. Cir. 2018) (finding proper the rejection of an obviousness argument first raised in the reply, as “petitioner ... had an opportunity

to present this argument in its petition, but chose not to”).

**Second**, the Board improperly supplemented Petitioner’s threadbare, unsupported reply argument into a step-by-step (and incorrect) obviousness analysis. For example, the FWD used Reiff’s claim 2 to argue that “white” could be selected as a “color” for both light sources recited in independent claim 1. FWD, 143-44. But Petitioner never even cited to claim 2 (even in Reply), and never argued that claim 2 (which requires each source “emit[] a different color of light” (Ex. 1013, 7:47-61)) suggests using two light sources both emitting the same color (white). *See* Reply, 32-33.

Indeed, even accepting white as a “color” as used in Reiff, every embodiment in Reiff teaches that its two light sources should emit light of two **different** colors. Reiff’s first embodiment (Fig. 1) has only one light source. Ex. 1013, 5:16. Reiff’s second embodiment (the Fig. 2 embodiment relied on in the petition) uses one fluorescent light source (emitting white light) and a second LED light source (emitting red, blue or UV light). *Id.*, 5:62-66. Reiff’s third embodiment (Figs. 5-6) discloses one row of white LEDs and one row of red LEDs and switching “the light fixture between various colors of light to be emitted,” *i.e.*, between white and red. *Id.*, 6:31-60. Finally, Reiff’s fourth embodiment (Figs. 7-7A) discloses a luminaire that switches between two fluorescent lights 30 and 30’, with one of those fluorescent lights having been deliberately covered with a red or blue plastic material

“in order to provide both white and red or blue light,” *i.e.*, to ensure it is ***not*** switching between two white light sources. *Id.*, 6:61-7:21.

The FWD also concluded that its two-white-light-source fixture would not have the same CCT values because “Reiff instructs that switching between the two different light sources produces a ***substantial*** change in chromaticity or wavelength, e.g., from white to red, white to blue, or white to infrared” but that “two different sources of white light ... with the same CCT value ... would produce only an ***insubstantial*** change in chromaticity.” FWD at 144. Petitioner never made any argument about “substantial” or “insubstantial” chromaticity changes in the Reply.

The FWD’s key analysis that this element is obvious over Reiff is found on pages 143-145, finding that:

1. Because “white” is one of the colors recited in Reiff (*e.g.*, in claim 2), a POSA could implement Reiff by using two light sources with the same “color” (white);
2. The “color” produced by the two white lights would need to be “different” for the two white lights to produce a “substantial” change in chromaticity;
3. Two white lights with the same CCT value would appear different (*e.g.*, one with a “slightly greenish/yellowish tint” and the other with a “slightly pinkish/purplish tint”), but that difference would only be “an insubstantial change in chromaticity”;

4. Thus, it would be obvious for a POSA to implement Reiff using two white light sources with different CCTs.

FWD, 143-144. Aside from being factually unsupported and wrong, the steps up this obviousness staircase are indisputably **not** found or explained in the Petition or the Reply. Moreover, the FWD went significantly beyond anything cited by the Petition or the Reply, establishing a clear abuse of discretion. *See supra*, Sec. III.C.

As an important policy issue, the Director should expressly prohibit FWDs from expanding and supplementing grounds never explained with particularity by petitioners, let alone through an unarticulated obviousness ground. Doing so runs counter to prior Federal Circuit and Board rulings.

In *Magnum Oil*, the Federal Circuit faulted a FWD that allowed a Petitioner, post-institution, to borrow an obviousness theory from one set of references and apply it to another set of references. *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1378 (Fed. Cir. 2016) (also warning against shifting the burden to the patent owner). The Court rejected a suggestion on appeal 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.” *Id.* at 1381. The Court also rejected an argument that the Board’s obviousness finding was proper “because this argument ***could have*** been included in a properly-drafted petition.” *Id.* at 1380-81 (quotations omitted); *see also Adaptics*, IPR2018-01596, Paper 20 at 18 (“the Petition suffers from a lack of

particularity”); *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 14 (PTAB Aug. 24, 2022) (precedential) (“Petitioner does not provide sufficient evidence or persuasive reasoning to support ... [its] assertions.”); *Nearmap US, Inc. v. Pictometry Int’l Corp.*, IPR2024-00729, Paper 9 at 20-21 (PTAB Oct. 10, 2024). At the very least, the Board’s actions in this case establish an inconsistency in Board policy that requires the Director’s attention.

***Third***, the proper remedy upon Director Review is reversal of the FWD on claims 13 and 15. When the FWD’s reliance on obviousness is properly rejected, all other challenges to claims 13 and 15 have been decided. For Ground 3, the FWD already found that the anticipation theories in the Petition failed with respect to the preamble, element [13b], and element [13d]. FWD, 144-45, 151, 154 (“does not disclose every element of claim 13 ‘arranged as in the claim’”). For the other Grounds, the FWD also found that the primary references do not constitute prior art for claims 13, 15, and 16. FWD, 59. Accordingly, there is nothing for the Board to determine on remand, and claims 13 and 15 should be added to claims 8, 16, and 17 as claims found not unpatentable.

## **V. CONCLUSION**

The FWD impermissibly adopted, and expanded, an obviousness analysis absent from the Petition. Signify requests that the Director review these actions and issue an Order reversing the finding of unpatentability for claims 13 and 15.



September 10, 2025

Respectfully submitted,

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## **CERTIFICATE OF SERVICE**

I certify that a copy of the foregoing was served to Petitioner by causing it to be sent by email to counsel for Petitioner at the following email addresses:

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Respectfully submitted,

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